

TURDIN v. TRILOBITE, LTD., Concurrent Use No. 94002505 (TTAB January 24, 2014).  
Before Zervas, Kuhlke and Adlin, Administrative Trademark Judges.

Background:

Mr. Turdin ("Turdin") applied for registration of the service mark TRILOBITE PICTURES for "motion picture film production, and animation services," which application was initially refused registration because of likelihood of confusion with two earlier applications filed by Trilobite, Ltd. ("Trilobite") for the mark TRILOBITE, one for "audio recording and production" and the other for "video production services; video recording services." Turdin opposed the Trilobite applications and ultimately sought a federal concurrent use registration for the mark TRILOBITE PICTURES restricted to New York City and Connecticut. The Trademark Trial and Appeal Board consolidated and converted the oppositions to a concurrent use proceeding.

At trial, the evidence confirmed that Turdin began good faith use of his mark (in Connecticut) prior to Trilobite Ltd.'s filing date. Turdin also established that he used his mark in New York City. However, the Board found that Trilobite used its TRILOBITE mark in New York City by virtue of its correspondence, contracts and interaction with clients there and that such use was prior to Turdin's use in New York City. The Board noted that Trilobite's services "need not be actually performed in New York City to find that it has used TRILOBITE in New York City." Trilobite was unable to prove that it had used its mark in Connecticut.

The Board ruled that Trilobite was entitled to an unrestricted federal registration for its mark and Turdin's concurrent use application was refused.

Issue/Holding:

Did Turdin carry his burden to show a lack of confusion under concurrent use of the marks in the overlapping areas of New York City and Connecticut? No.

Discussion:

Turdin satisfactorily showed that he made lawful concurrent commercial use of TRILOBITE PICTURES (in Connecticut) before the filing date of Trilobite's prior applications, but he also had the burden to demonstrate that consumer confusion is not likely to result from his continued use of TRILOBITE PICTURES in Connecticut and New York City.

In finding that confusion is likely between the two marks when used in New York City, the Board found the dominant portion of the TRILOBITE PICTURES mark and the TRILOBITE mark to be identical. The Board also found the services overlapping in part and otherwise commercially related, and the channels of trade and classes of customers to be the same.

Although Turdin was the prior user in Connecticut and there was no evidence that Trilobite had used its mark there, Turdin presented no evidence sufficient to show that Connecticut was "sufficiently distinct geographically" such that confusion would not arise. The Board was ultimately persuaded by the testimony of Trilobite's President that there is "quite an overlap of people who live in the Connecticut area and work in New York, so I find that sometimes I don't know if they're in Connecticut actually or in New York."