

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark: THE STRONG ARM

Applicant: Brian Loncar, P.C.

CONCURRENT USE STATEMENT  
AND VERIFICATION OF APPLICATION

Applicant hereby advises as follows:

1. Applicant seeks registration of the Trademark for “legal services” in Class 045, in the geographic area comprising of Texas, with the exception of the 26 northernmost counties that make up the Texas Panhandle, and Bailey, Lamb, Hale, Floyd, Motley, and Cottle Counties in Texas (the “Loncar Geographic Area”), as more specifically depicted in the Coexistence and Concurrent Use Agreement attached hereto as Exhibit A (the Agreement”). Applicant uses the Trademark applied for herein on signs, business materials, brochures, Internet websites and through other means in connection with the providing of its aforesaid legal services.

2. The Trademark is a unique word mark that has been used concurrently by Applicant and Franklin D. Azar and Associates, P.C. (“Azar”) since at least as early as June 30, 2003 in connection with legal services, well before any application for registration for the Trademark was filed. Azar has the right to use the Trademark in the United States outside of the Loncar Geographic Area.

3. Azar, the concurrent user of the Trademark, is a Colorado corporation with its principal office at 14426 East Evans Avenue, Aurora, Colorado 80014. Azar is the owner of United States Reg. No. 4,087,845 for the Trademark (filed on June 14, 2011) and has the right to use the Trademark on signs, business materials, brochures, Internet websites and through other means in connection with rendering legal services in the United States with the exception of the state of Texas, as defined in the Agreement. Azar, as more specifically set forth in the Agreement, has consented to the grant of a concurrent use registration to Applicant for the Trademark.

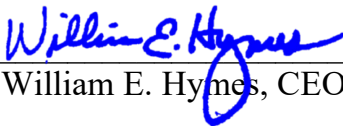
4. The verification of the present application should be replaced by the following verified statement:

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he is properly authorized to execute this verification on behalf of the Applicant; that subject to the terms of the Agreement between

Applicant and Azar, owner of U.S. Reg. No. 4,087,845, Applicant claims the exclusive right to use the mark shown in the application and for the services described therein in the Loncar Geographic Area; he believes the Applicant to be the owner of the service mark sought to be registered; he believes Applicant to be entitled to use such mark in commerce; to the best of his knowledge and belief, no other person, firm, corporation, or association has the right to use the mark in commerce in the Loncar Geographic Area, either in the identical form hereof or in such near resemblance thereto as to be likely, when used on or in connection with the services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his own knowledge are true, and all statements made on information and belief are believed to be true.

Dated May 25, 2020

Brian Loncar, P.C.

By:   
William E. Hynes, CEO

# **EXHIBIT A**

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

BRIAN LONCAR, P.C.	§	
	§	
Plaintiff,	§	
	§	
v.	§	Civil Action No. 3:18-cv-02821-L
	§	
FRANKLIN D. AZAR AND	§	JURY DEMAND
ASSOCIATES, P.C.	§	
Defendant.	§	

**COEXISTENCE AND CONCURRENT USE AGREEMENT**

THIS COEXISTENCE AND CONCURRENT USE AGREEMENT (“Agreement”) is entered into on May 6, 2020, by and between Brian Loncar, P.C., 424 S. Cesar Chavez Blvd., Dallas, Texas 75201 (“**Loncar**”), and Franklin D. Azar and Associates, P.C., a Colorado corporation of 14426 East Evans Avenue, Aurora, Colorado 80014 (“**Azar**”)(Azar and Loncar referred to singularly as a “Party” or together as the “Parties”).

WHEREAS, Azar has used the trademark “The Strong Arm” (“**THE STRONG ARM**”) in association with the promotion and sale of legal services in the United States. Azar’s use of THE STRONG ARM has generally been in all jurisdictions other than the state of Texas (the “**Azar Geographic Area**”).

The term “**Loncar Geographic Area**” is the geographic area comprising of Texas, with the exception of the 26 northernmost counties that make up the Texas Panhandle, and Bailey, Lamb, Hale, Floyd, Motley, and Cottle Counties in Texas. The Loncar Geographic Area is pictured in **Exhibit A**.

WHEREAS, Loncar has promoted and sold legal services in association with THE STRONG ARM in the Loncar Geographic Area. The Loncar Geographic Area and/or the Azar Geographic Area are referred to as the **Geographic Areas**.

WHEREAS, on June 14, 2011, Azar filed an application for the registration of THE STRONG ARM word mark with the United States Patent and Trademark Office (“**USPTO**”). The claimed date of first use for this mark is June 30, 2003, in conjunction with “legal services.” On January 17, 2012, Azar’s trademark application was granted,



and THE STRONG ARM was placed on the Principal Register of the USPTO, U.S. Reg. No. 4,087,845 (the “TSA Registration”).

WHEREAS, Loncar initiated litigation against Azar in the case styled *Brian Loncar, P.C. v. Franklin D. Azar and Associates, P.C.*, Civil Action No. 3:18-CV-02821-IL filed in the United States District Court for the Northern District of Texas, Dallas Division (the “Litigation”). In the Litigation, Loncar asserted claims against Azar for, among other things, declaratory judgment of non-infringement, trademark cancellation, and concurrent use registration, and Azar asserted claims against Loncar for, among other things, trademark infringement and unfair competition.

WHEREAS, Loncar and Azar intend to resolve the Litigation and all other matters between the Parties. In doing so, the Parties agree that Loncar can use THE STRONG ARM exclusively in the Loncar Geographic Area, and Azar can exclusively use THE STRONG ARM in the Azar Geographic Area, such that the TSA Registration shall be limited to reflect Loncar’s use in the Loncar Geographic Area.

THEREFORE, for good and valuable consideration, the Parties agree as follows:

1. The Parties recognize and acknowledge that each Party can use the THE STRONG ARM in their respective Geographic Areas without interference from the other Party. Therefore, the Parties agree that Loncar can use the THE STRONG ARM to market, promote, advertise, provide, and sell its legal services in the Loncar Geographic Area, and Azar can use the THE STRONG ARM to market, promote, advertise, provide, and sell its legal services in the Azar Geographic Area.

2. Azar hereby agrees that Azar’s use of THE STRONG ARM shall be limited to the Azar Geographic Area, and acknowledges that Loncar may use THE STRONG ARM in association with the promotion and sale of legal services in the Loncar Geographic Area. Azar agrees that it will not directly market or advertise its legal services using THE STRONG ARM in the Loncar Geographic Area. In doing so, it agrees not to place any print, radio, television, or other such advertising within the Loncar Geographic Area, or that is otherwise directed to any location or persons within the Loncar Geographic Area.

3. Loncar hereby agrees that Loncar’s use of THE STRONG ARM shall be limited to the Loncar Geographic Area, and acknowledges that Azar may use THE STRONG ARM in association with the promotion and sale of legal services within the Azar Geographic Area. Loncar agrees that it will not directly market or advertise its legal services using THE STRONG ARM in the Azar Geographic Area. In doing so, it agrees not to place any print, radio, television, or other such advertising within the Azar Geographic Area, or that is otherwise directed to any location or persons within the Azar Geographic Area.



4. Loncar and Azar will respectively use THE STRONG ARM in a manner calculated to avoid confusion with the other and will cooperate in taking any and all reasonable actions to avoid such confusion.

5. The Parties recognize and acknowledge that they provide legal services and advertise as THE STRONG ARM in their distinct respective Geographic Areas and that they have coexisted while simultaneously using THE STRONG ARM since at least 2003.

6. The Parties are unaware of any actual confusion between them, their marks, or the services each provide in connection with THE STRONG ARM despite more than seventeen (17) years of coexistence.

7. The Parties agree and acknowledge that it is unlikely that concurrent use and registration of the THE STRONG ARM mark in their respective geographic areas will create confusion among consumers as to the source, origin, or sponsorship of the parties' respective services.

8. The conclusion that it is unlikely that there will be confusion between the marks is supported by the different geographic areas in which the Parties market their services in conjunction with THE STRONG ARM, the different clients the Parties serve, and that there is no known actual confusion during more than 17 years of concurrent use of THE STRONG ARM mark. The services of the respective parties are offered in non-overlapping geographic trade areas. Loncar services are offered in Texas, whereas the Azar services are offered in other parts of the United States.

9. Upon acceptance of this Coexistence and Concurrent Use Agreement by the USPTO, Azar agrees that: (i) it will not file any opposition or cancellation proceeding against Loncar's THE STRONG ARM mark or otherwise contest Loncar's THE STRONG ARM mark in the Loncar Geographic Area; (ii) Azar consents to Loncar's rights to use and register the THE STRONG ARM mark for the Loncar Geographic Area; (iii) Azar shall take no action adverse to Loncar's rights to use and register the THE STRONG ARM mark throughout the Loncar Geographic Area; and (iv) Azar will not promote legal services in the Loncar Geographic area.

10. Upon acceptance of this Coexistence and Concurrent Use Agreement by the USPTO, Loncar agrees that: (i) it will not file any opposition or cancellation proceeding against Azar's THE STRONG ARM mark or otherwise contest Azar's THE STRONG ARM mark in the Azar Geographic Area; (ii) Loncar consents to Azar's rights to use and register the THE STRONG ARM mark in the Azar Geographic Area; (iii) Loncar shall take no action adverse to Azar's rights to use and register the THE STRONG ARM mark throughout the Azar Geographic Area; and (iv) Loncar will not promote legal services in the Azar Geographic area.



11. The Parties recognize that their respective websites and social media posts transcend the geographic boundaries described herein. Therefore, the Parties' respective websites and social media accounts and posts are excluded from the foregoing geographic restrictions. However, in order to avoid any confusion between the Parties' services, no Party may direct any social media or website traffic displaying THE STRONG ARM directly to the other Party's Geographic Area. These prohibited acts include displaying content or making posts that are specific to the other Party's Geographic Area or that specifically references a state, territory, region, city, or other location within the other Party's Geographic Area. Further, each Party is prohibited from employing any and all means to specifically target advertising in each other's Geographic Areas, such as using Google Ads location targeting or other geo-location targeted advertising in the other Party's Geographic Area.

12. The Parties agree that Loncar may file a concurrent use application with the USPTO regarding its use of THE STRONG ARM in the Loncar Geographic Area, and initiate a concurrent use proceeding in the Trademark Trial and Appeal Board. Loncar agrees that the foregoing concurrent use application and proceeding will be limited to the Loncar Geographic Area. Loncar further agrees not to file a concurrent use application and proceeding for any use outside of the Loncar Geographic Area, nor file any other application for the registration of THE STRONG ARM with the USPTO or in any other jurisdiction. Further, neither Party will challenge the other Party's trademark registration of THE STRONG ARM as described herein now or in the future.

13. Azar agrees to cooperate with Loncar throughout the application process and concurrent use proceeding. By way of example and without limitation, Azar's answer to the notice of any concurrent use proceeding will set forth Azar's consent to Loncar's concurrent use and the concurrent use limitation on the TSA Registration as set forth in this Agreement.

14. This Coexistence and Concurrent Use Agreement shall be filed in the USPTO as part of the concurrent use application and proceeding.

15. By entering into this Agreement, Loncar does not admit that: (i) Azar has exclusive rights to THE STRONG ARM throughout the Azar Geographic Area; or that (ii) Azar was the prior user of THE STRONG ARM in the Azar Geographic Area. Similarly, Azar does not admit that: (i) Loncar has exclusive rights to THE STRONG ARM throughout the Loncar Geographic Area; or that (ii) Loncar was the prior user of THE STRONG ARM in the Loncar Geographic Area.

16. Loncar has no obligation or duty to police or enforce any rights against third-party use of THE STRONG ARM in the Azar Geographic Area. Similarly, Azar has no obligation or duty to police or enforce any rights against third-party use of THE STRONG ARM in the Loncar Geographic Area.

17. The granting of the concurrent use registration in favor of Loncar is a material condition to the Parties' agreement to dismiss the Litigation. The Parties dismissed the Litigation in reliance upon the anticipated granting of the concurrent use registration by the USPTO.

18. This Agreement shall be binding upon and inure to the benefit of the Parties and their successors and assigns.

The Parties herein execute this Coexistence and Concurrent Use Agreement as of the date above.

BRIAN LONCAR, P.C.

By: William E. Hymes  
William E. Hymes

AND

FRANKLIN D. AZAR AND ASSOCIATES, P.C.

By: Franklin D. Azar  
Franklin D. Azar



**EXHIBIT A TO COEXISTENCE AND CONCURRENT USE AGREEMENT  
LONCAR GEOGRAPHICAL AREA**

# Loncar Geographic Area

