

# **CHAPTER 1100 CONCURRENT USE PROCEEDINGS**

## **1101 IN GENERAL**

- 1101.01 NATURE OF PROCEEDING
- 1101.02 CONTEXT FOR USPTO DETERMINATION OF CONCURRENT RIGHTS

## **1102 GENERATION OF PROCEEDING**

- 1102.01 MEANS OF GENERATION
- 1102.02 BASES FOR CONCURRENT REGISTRATION – BOARD DETERMINATION  
COURT DETERMINATION

## **1103 REQUIREMENTS FOR CONCURRENT USE APPLICATION**

- 1103.01 APPLICATION BASED ON BOARD DETERMINATION
  - 1103.01(a) Application Must Assert Use in Commerce*
  - 1103.01(b) Jurisdictional Requirement*
  - 1103.01(c) Application Must Meet Requirements Applicable to Non-Restricted Application*
  - 1103.01(d) Application Must Identify Nature and Extent of Restriction Sought*
    - 1103.01(d)(1) In General
    - 1103.01(d)(2) Geographic Restrictions
    - 1103.01(d)(3) Mode of Use Restrictions
  - 1103.01(e) Application Must Identify Excepted Users and Their Asserted Rights*
  - 1103.01(f) Other Requirements*
- 1103.02 APPLICATION BASED ON PRIOR BOARD DECISION
- 1103.03 APPLICATION BASED ON COURT DETERMINATION

## **1104 PARTIES TO PROCEEDING; INVOLVED APPLICATIONS, REGISTRATIONS**

## **1105 APPLICATIONS AND REGISTRATIONS NOT SUBJECT TO PROCEEDING**

## **1106 COMMENCEMENT OF PROCEEDING**

- 1106.01 MARKING OF CONCURRENT USE APPLICATION
- 1106.02 PUBLICATION OF CONCURRENT USE APPLICATION; OPPOSITION  
PERIOD
  - 1106.03 PREPARING THE RECORD FOR THE INVOLVED APPLICATION AN  
REGISTRATION FILES
  - 1106.04 PREPARING CONCURRENT USE NOTICES
  - 1106.05 LOCATING EXCEPTED USERS

## **1107 ANSWER; DEFAULT**

**1108 ISSUE IN CONCURRENT USE PROCEEDING; BURDEN OF PROOF**

**1109 CONDUCT OF PROCEEDING**

1109.01 SAMPLE TRIAL SCHEDULES – CASES COMMENCED ON OR AFTER  
NOVEMBER 1, 2007

**1110 SETTLEMENT PROVIDING FOR CONCURRENT REGISTRATION**

**1111 EFFECT OF ABANDONMENT OF INVOLVED APPLICATION**

**1112 EFFECT OF ADVERSE DECISION IN OPPOSITION OR CANCELLATION**

**1113 “CONVERSION” OF OPPOSITION OR CANCELLATION PROCEEDING TO  
CONCURRENT USE PROCEEDING**

1113.01 CONVERSION OF OPPOSITION PROCEEDING

1113.02 CONVERSION OF CANCELLATION PROCEEDING

**1114 ALTERATION OF RESTRICTIONS ON CONCURRENT REGISTRATION**

## 1101 In General

**15 U.S.C. § 1052** *No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it -*

\* \* \* \*

*(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: Provided, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to*

*(1) the earliest of the filing dates of the applications pending or of any registration issued under this chapter;*

*(2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or*

*(3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.*

**15 U.S.C. § 1067(a)** *In every case of interference, opposition to registration, application to register as a lawful concurrent user, or application to cancel the registration of a mark, the Director shall give notice to all parties and shall direct the Trademark Trial and Appeal Board to determine and decide the respective rights of registration. ...*

**15 U.S.C. § 1068** *In such proceedings the Director may refuse to register the opposed mark, may cancel the registration, in whole or in part, may modify the application or registration by limiting the goods or services specified therein, may otherwise restrict or rectify with respect to the register the registration of a registered mark, may refuse to register any or all of several interfering marks, or may register the mark or marks for the person or persons entitled thereto, as the rights of the parties under this chapter may be established in the proceedings: Provided, That in the case of the registration of any mark based on concurrent use, the Director shall*

*determine and fix the conditions and limitations provided for in subsection (d) of section 1052 of this title. ...*

## **1101.01 Nature of Proceeding**

A concurrent use registration proceeding (hereafter referred to as a “concurrent use proceeding”) is an inter partes proceeding in which the Board determines whether one or more applicants is entitled to a concurrent registration, that is, a restricted registration, with conditions and limitations fixed by the Board, as to the mode or place of use of the applicant's mark or the goods and/or services on or in connection with which the mark is used. Restrictions are generally to claimed geographic areas of use. [Note 1.]

Trademark Act § 2(d), 15 U.S.C. § 1052(d), governs the Board’s determination of registrability in a concurrent use proceeding. That section provides, in part, that if the Director (acting through the Board):

*... determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to ...*

a certain specified date (normally, prior to the earliest application filing date of the application(s), or 1946 Act registration(s) (if any), involved in the proceeding, or prior to July 5, 1947, in the case of an involved registration under the Acts of 1881 or 1905.) [Note 2.] See TBMP § 1103.01(b).

The proviso of Trademark Act § 2(d), 15 U.S.C. § 1052(d), sets out two requirements for issuance of a concurrent use registration in a proceeding before the Board. [Note 3.] A concurrent use applicant needs to meet the jurisdictional requirement of use in commerce prior to the applicable date specified in Trademark Act § 2(d). For information concerning the dates specified in Trademark Act § 2(d) and a discussion of the jurisdictional requirement, see TBMP § 1103.01(b). A concurrent use applicant also must show that use of the mark for which it seeks a concurrent registration will not result in a likelihood of confusion. [Note 4.] There is no provision in the Lanham Act to allow for concurrent use registrations in the dilution context. [Note 5.]

For concurrent use proceedings commenced on or after November 1, 2007, the Board has adopted a modified disclosure and conferencing regime. [Note 6.] For further information regarding disclosures and discovery conferences, see TBMP § 401.

### **NOTES:**

1. *See, e.g., Trademark Act § 2(d), Trademark Act § 17, and Trademark Act § 18, 15 U.S.C. § 1052(d), 15 U.S.C. § 1067, and 15 U.S.C. § 1068; 37 CFR § 2.133(c); Nobelle.com LLC v.*

*Qwest Communications International Inc.*, 66 USPQ2d 1300, 1307 (TTAB 2003) (“A concurrent use registration, by its very nature, contemplates that the registered mark can and does function to identify more than one source . . . because each source’s use of the mark is subject to conditions and limitations which eliminate likelihood of confusion . . .”); *Weiner King, Inc. v. Wiener King Corp.*, 615 F.2d 512, 204 USPQ 820, 831 (CCPA 1980) (the conditions and limitations imposed by Trademark Act § 2(d) are for the purpose of preventing consumer confusion); *Terrific Promotions Inc. v. Vantex Inc.*, 36 USPQ2d 1349, 1353 (TTAB 1995); *Pinocchio's Pizza Inc. v. Sandra Inc.*, 11 USPQ2d 1227, 1229 (TTAB 1989); *Women's World Shops Inc. v. Lane Bryant Inc.*, 5 USPQ2d 1985, 1988 (TTAB 1988); *Ole' Taco Inc. v. Tacos Ole, Inc.*, 221 USPQ 912, 916 (TTAB 1984).

2. See Trademark Act § 17, 15 U.S.C. § 1067.

3. See *In re Beatrice Foods Co.*, 429 F.2d 466, 166 USPQ 431, 436 (CCPA 1970); *Over the Rainbow, Ltd. v. Over the Rainbow, Inc.*, 227 USPQ 879, 882 (TTAB 1985).

4. See *Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723, 1725 (TTAB 1990); *Over the Rainbow, Ltd. v. Over the Rainbow, Inc.*, 227 USPQ 879, 882 n.4 (TTAB 1985). Cf. *Nobelle.com LLC v. Qwest Communications International Inc.*, 66 USPQ2d 1300, 1307 (TTAB 2003) (petitioner asserting that concurrent use registration should be deemed abandoned because it is used by multiple parties “must do more than merely show that the registered mark is being used concurrently by the concurrent use registrants in accordance with the conditions and limitations set forth in their concurrent use registrations.”).

5. *Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car Inc.*, 330 F.3d 1333, 66 USPQ2d 1811, 1819 (Fed. Cir. 2003).

6. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42244-7 (August 1, 2007).

## **1101.02 Context for USPTO Determination of Concurrent Rights**

**37 CFR § 2.99(h)** *The Trademark Trial and Appeal Board will consider and determine concurrent use rights only in the context of a concurrent use registration proceeding.*

**37 CFR § 2.133(c)** *Geographic limitations will be considered and determined by the Trademark Trial and Appeal Board only in the context of a concurrent use registration proceeding.*

Within the U.S. Patent and Trademark Office (“USPTO”), the Board determines the right to a concurrent registration. [Note 1.] Concurrent registration rights are considered and determined by the Board only in the context of a concurrent use proceeding. [Note 2.]

A registration cannot be restricted territorially by amendment under Trademark Act § 7(e), 15 U.S.C. § 1057(e), and 37 CFR § 2.173(a). [Note 3.] Thus, a cancellation proceeding may not be settled by amending the involved registration to include territorial restrictions. [Note 4.] However, the registrant may agree to entry of judgment against it in the cancellation proceeding

or voluntarily surrender its registration for cancellation and thereafter apply for a registration as a lawful concurrent user. [Note 5.] *See also* TBMP § 1114. The cancellation proceeding may be suspended to allow registrant time to file a concurrent use application, and terminated when registrant's concurrent use application has been published for opposition purposes and no opposition is filed, or all oppositions filed are dismissed or withdrawn. *See* TBMP § 1113.02.

Moreover, a Trademark Act § 7(e) amendment may generally not be used to remove a concurrent use restriction from a registration. However, removal of a concurrent use restriction by amendment under Trademark Act § 7(e) may be permitted where an entity which was the only exception to registrant's right to exclusive use of its registered mark assigns its rights in its mark to registrant, so that all rights in the mark are merged in registrant. [Note 6.]

#### NOTES:

1. *See* Trademark Act § 2(d), Trademark Act § 17, and Trademark Act § 18, 15 U.S.C. § 1052(d), 15 U.S.C. § 1067, and 15 U.S.C. § 1068.
2. *See* Trademark Act § 2(d), Trademark Act § 17, and Trademark Act § 18, 15 U.S.C. § 1052(d), 15 U.S.C. § 1067, and 15 U.S.C. § 1068. *See also* 37 CFR § 2.99(h) and 37 CFR § 2.133(c); *Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car Inc.*, 330 F.3d 1333, 66 USPQ2d 1811, 1815 (Fed. Cir. 2003); *Stock Pot Restaurant, Inc. v. Stockpot, Inc.*, 737 F.2d 1576, 222 USPQ 665, 669 (Fed. Cir. 1984) (attempt to interject concurrent use proceeding into cancellation unavailing), *aff'g*, 220 USPQ 52 (TTAB 1983); *Mother's Restaurant Inc. v. Mama's Pizza, Inc.*, 723 F.2d 1566, 221 USPQ 394, 400 (Fed. Cir. 1983) (concurrent use not available in cancellation by way of counterclaim); *Rosso & Mastracco, Inc. v. Giant Food Inc.*, 720 F.2d 1263, 219 USPQ 1050, 1053 (Fed. Cir. 1983); *Selfway, Inc. v. Travelers Petroleum, Inc.*, 579 F.2d 75, 198 USPQ 271, 277 (CCPA 1978) (concurrent rights can only be adjudicated in concurrent use proceeding); *Holmes Oil Co. v. Myers Cruizers of Mena Inc.*, 101 USPQ2d 1148, 1149 (TTAB 2011) (in concurrent use proceedings, the Board determines entitlement to a registration, generally with a geographic restriction); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1106 n.3 (TTAB 2007) (no consideration given in cancellation proceeding to proposed counterclaim to partially cancel petitioner's pleaded registrations by further limiting the geographic scope thereof).
3. *See In re Forbo*, 4 USPQ2d 1415, 1415 (Comm'r 1984).
4. *See, e.g., Chichi's, Inc. v. Chi-Chi's, Inc.*, 222 USPQ 831, 832 (Comm'r 1984) (a decision in the cancellation proceeding adverse to respondent would not preclude respondent from filing a new application seeking concurrent registration with petitioner).
5. *See Chichi's, Inc. v. Chi-Chi's, Inc.*, 222 USPQ 831, 832 (Comm'r 1984).
6. *See In re Alfred Dunhill Ltd.*, 4 USPQ2d 1383, 1384 (Comm'r 1987) (geographic restriction removed by amendment when excepted rights assigned to registrant).

## 1102 Generation of Proceeding

### 1102.01 Means of Generation

A concurrent use proceeding before the Board may be generated only by filing an application with the Office under Trademark Act § 1(a), 15 U.S.C. § 1051(a), for registration as a lawful concurrent user (hereafter referred to as a “concurrent use application”). [Note 1.] The Board determines and decides the applicant’s right to a concurrent use registration under Trademark Act § 17, 15 U.S.C. § 1067. A concurrent use application is an application in which applicant concedes that its use of the mark is not exclusive and provides the USPTO with all the information applicant has regarding others who are using the same or similar mark. [Note 2.] Specifically, Trademark Act § 1(a)(3)(D), 15 U.S.C. § 1051(a)(3)(D) provides:

... in the case of every application claiming concurrent use, the applicant shall—

- (i) state exceptions to the claim of exclusive use; and
- (ii) shall specify, to the extent of the verifier’s knowledge—
  - (I) any concurrent use by others;
  - (II) the goods on or in connection with which and the areas in which each concurrent use exists;
  - (III) the periods of each use; and
  - (IV) the goods and area for which the applicant desires registration.

In addition to the above statutory requirements, the applicant shall state in the application the area, the goods or services, and the mode of use for which applicant seeks registration; and also shall state, to the extent of the applicant’s knowledge, the concurrent lawful use of the mark by others, setting forth their names and addresses; registrations issued to or applications filed by such others, if any; the areas of such use; the goods or services on or in connection with which such use is made; the mode of such use; and the periods of such use. [Note 3.]

For further information concerning the requirements for a concurrent use application, see TBMP § 1103.

#### NOTES:

1. See *Chichi's, Inc. v. Chi-Chi's, Inc.*, 222 USPQ 831, 832 (Comm’r 1984) (Commissioner has no power to order the commencement of a concurrent use proceeding absent a concurrent use application; respondent in cancellation proceeding may agree to entry of judgment against it or voluntarily surrender its registration for cancellation and then apply for a registration as a lawful concurrent user, and may also request that the district court determine the respective concurrent rights of the parties). Cf. *J&D Home Improvement Inc. v. Basement Doctor Inc.*, 65 USPQ2d 1958 (D. Del. 2003) (federal district courts lack original jurisdiction over matters regarding

concurrent use of trademark). *See also Inland Oil & Transport Co. v. IOT Corp.*, 197 USPQ 562, 563 (TTAB 1977); *Hollowform, Inc. v. Delma Aeh*, 180 USPQ 284, 286 (TTAB 1973), *aff'd*, 515 F.2d 1174, 185 USPQ 790 (CCPA 1975).

2. *See* Trademark Act § 1(a)(1)(A), Trademark Act § 1(a)(3)(D)(i), and Trademark Act § 1(a)(3)(D)(ii)(I-IV), 15 U.S.C. § 1051(a)(1)(A), 15 U.S.C. § 1051(a)(3)(D)(i) and 15 U.S.C. § 1051(a)(3)(D)(ii)(I-IV). *See also* Trademark Act § 2(d), 15 U.S.C. § 1052(d); 37 CFR § 2.42; TMEP § 1207.04.

3. *See* 37 CFR § 2.42.

## **1102.02 Bases for Concurrent Registration – Board Determination; Court Determination**

There are two bases upon which a concurrent registration may be issued.

First, a concurrent registration may be issued when the Board determines, in a concurrent use proceeding, that an applicant is entitled to a concurrent registration. Such determination may have been made in a prior concurrent use proceeding or will be made in the to-be-instituted concurrent use proceeding. *See* TBMP § 1101.01 and TBMP § 1103.01.

Second, a concurrent use registration may be issued “when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce.” [Note 1.]

These two types of concurrent use registrations are the only means by which a geographically restricted registration may be obtained. *See* TBMP § 1101.02. Thus, for example, an applicant may not, by including a geographical restriction in its identification of goods and/or services, obtain a geographically restricted registration without a concurrent use proceeding. [Note 2.]

If an application seeking concurrent registration on the basis of the Board's decision in a prior concurrent use proceeding meets certain requirements, in addition to those necessary for all concurrent use applications [Note 3], the registration sought, if otherwise appropriate, will be issued based on the Board's prior decision. *See* TBMP § 1103. A new concurrent use proceeding before the Board will not be necessary, because of the legal principles of *res judicata* and *stare decisis*. [Note 4.] For information concerning the requirements for an application seeking a concurrent registration on the basis of the Board's decision in a prior concurrent use proceeding, see TBMP § 1103.02.

Similarly, if an application seeking concurrent registration on the basis of a prior court determination of concurrent rights meets certain requirements, in addition to those necessary for all concurrent use applications, the registration sought, if otherwise appropriate, will be issued based on the court determination, without any concurrent use proceeding before the Board. [Note 5.] For information concerning the requirements for an application seeking a concurrent registration on the basis of a prior court determination of concurrent rights, see TBMP § 1103.03.

**NOTES:**

1. See Trademark Act § 2(d), 15 U.S.C. § 1052(d). See also 37 CFR § 2.99(f); *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630, 635 (CCPA 1976) (district court found applicant entitled to restricted registration); *Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 130 USPQ 412, 419-20 (CCPA 1961) (court ordered restricted registration); *In re Alfred Dunhill Ltd.*, 4 USPQ2d 1383 (Comm'r 1987); *In re Forbo*, 4 USPQ2d 1415, 1415 (Comm'r 1984).
2. See *In re Home Federal Savings & Loan Ass'n.*, 213 USPQ 68, 69 (TTAB 1982).
3. See 37 CFR § 2.42.
4. Cf. 37 CFR § 2.99(f).
5. See 37 CFR § 2.99(f).

**1103 Requirements for Concurrent Use Application**

**15 U.S.C. § 1051(a)(1)** *The owner of a trademark used in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director, and such number of specimens or facsimiles of the mark as used as may be required by the Director.*

**(3)(D)** ... *except that, in the case of every application claiming concurrent use, the applicant shall –*

**(i)** *state exceptions to the claim of exclusive use; and*

**(ii)** *shall specify, to the extent of the verifier's knowledge --*

**(I)** *any concurrent use by others;*

**(II)** *the goods on or in connection with which and the areas in which each concurrent use exists;*

**(III)** *the periods of each use; and*

**(IV)** *the goods and area for which the applicant desires registration.*

\* \* \* \*

**15 U.S.C. § 1052** *No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it -*

\* \* \* \*

*(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: Provided, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to*

*(1) the earliest of the filing dates of the applications pending or of any registration issued under this chapter;*

*(2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or*

*(3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.*

**37 CFR § 2.42 Concurrent use.** *An application for registration as a lawful concurrent user shall specify and contain all the elements required by the preceding sections. The applicant in addition shall state in the application the area, the goods, and the mode of use for which applicant seeks registration; and also shall state, to the extent of applicant's knowledge, the concurrent lawful use of the mark by others, setting forth their names and addresses; registrations issued to or applications filed by such others, if any; the areas of such use; the goods on or in connection with which such use is made; the mode of such use; and the periods of such use.*

**37 CFR § 2.73 Amendment to recite concurrent use.** *An application that includes section 1(a) of the Trademark Act as a filing basis, or for which an acceptable allegation of use under § 2.76 or § 2.88 has been filed, may be amended to an application for concurrent use registration, provided that the application as amended meets the requirements of § 2.42. The trademark examining attorney will determine whether the application, as amended, is acceptable.*

**37 CFR § 2.99 Application to register as concurrent user.**

*(a) An application for registration as a lawful concurrent user will be examined in the same*

*manner as other applications for registration.*

*(b) If it appears that the applicant is entitled to have the mark registered, subject to a concurrent use proceeding, the mark will be published in the Official Gazette as provided by § 2.80.*

*(c) If no opposition is filed, or if all oppositions that are filed are dismissed or withdrawn, the Trademark Trial and Appeal Board will send a notification to the applicant for concurrent use registration (plaintiff) and to each applicant, registrant or user specified as a concurrent user in the application (defendants). The notification for each defendant shall state the name and address of the plaintiff and of the plaintiff's attorney or other authorized representative, if any, together with the serial number and filing date of the application. If a party has provided the Office with an e-mail address, the notification may be transmitted via e-mail.*

*(d)(1) Within ten days from the date of the Board's notification, the applicant for concurrent use registration must serve copies of its application, specimens and drawing on each applicant, registrant or user specified as a concurrent user in the application for registration, as directed by the Board. If any service copy is returned to the concurrent use applicant as undeliverable, the concurrent use applicant must notify the Board within ten days of receipt of the returned copy.*

*(2) An answer to the notice is not required in the case of an applicant or registrant whose application or registration is specified as a concurrent user in the application, but a statement, if desired, may be filed within forty days after the issuance of the notice; in the case of any other party specified as a concurrent user in the application, an answer must be filed within forty days after the issuance of the notice.*

*(3) If an answer, when required, is not filed, judgment will be entered precluding the specified user from claiming any right more extensive than that acknowledged in the application(s) for concurrent use registration, but the applicant(s) will remain with the burden of proving entitlement to registration(s).*

*(e) The applicant for a concurrent use registration has the burden of proving entitlement thereto. If there are two or more applications for concurrent use registration involved in a proceeding, the party whose application has the latest filing date is the junior party. A party whose application has a filing date between the filing dates of the earliest involved application and the latest involved application is a junior party to every party whose involved application has an earlier filing date. If any applications have the same filing date, the application with the latest date of execution will be deemed to have the latest filing date and that applicant will be the junior party. A person specified as an excepted user in a concurrent use application but who has not filed an application shall be considered a party senior to every party that has an application involved in the proceeding.*

*(f) When a concurrent use registration is sought on the basis that a court of competent jurisdiction has finally determined that the parties are entitled to use the same or similar marks in commerce, a concurrent use registration proceeding will not be instituted if all of the*

*following conditions are fulfilled:*

*(1) The applicant is entitled to registration subject only to the concurrent lawful use of a party to the court proceeding; and*

*(2) The court decree specifies the rights of the parties; and*

*(3) A true copy of the court decree is submitted to the examiner; and*

*(4) The concurrent use application complies fully and exactly with the court decree; and*

*(5) The excepted use specified in the concurrent use application does not involve a registration, or any involved registration has been restricted by the Director in accordance with the court decree.*

*If any of the conditions specified in this paragraph is not satisfied, a concurrent use registration proceeding shall be prepared and instituted as provided in paragraphs (a) through (e) of this section.*

*(g) Registrations and applications to register on the Supplemental Register and registrations under the Act of 1920 are not subject to concurrent use registration proceedings. Applications under section 1(b) of the Act of 1946 are subject to concurrent use registration proceedings only after the applicant files an acceptable amendment to allege use under § 2.76 or § 2.88. Applications based solely on section 44 or section 66(a) of the Act are not subject to concurrent use registration proceedings.*

*(h) The Trademark Trial and Appeal Board will consider and determine concurrent use rights only in the context of a concurrent use registration proceeding.*

### **1103.01 Application Based on Board Determination**

An application for concurrent registration based on a Board determination must:

**(1)** assert use in commerce of the mark sought to be registered [Note 1], *see also* TBMP § 1103.01(a);

**(2)** meet jurisdictional requirements [Note 2], *see also* TBMP § 1103.01(b);

**(3)** state the geographic area, goods and/or services, and (if applicable) mode of use for which applicant seeks registration of the mark [Note 3];

**(4)** state, to the extent of applicant's knowledge, the concurrent lawful use of the mark by others, setting forth their names and addresses; their areas of use; the goods and/or services on or in connection with which their use is made; the mode of their use; the periods of their use; and the registrations issued to or applications filed by them, if any [Note 4]; and

**(5)** specify and contain all the elements required by the rules of practice in trademark cases for a

non-restricted application. [Note 5.] *See also* TBMP § 1103.01(c).

When it is determined that applicant is entitled to have its mark registered, subject to a concurrent use proceeding, the mark will be published for opposition. If no opposition is filed, or if all oppositions that are filed are dismissed or withdrawn, the Board will send notification to the applicant and to each entity that has been named as an excepted user by the applicant of the institution of the concurrent use proceeding. Within ten days from the date the Board notifies the excepted users (applicant, registrant or common law user) of the institution of the proceeding, the concurrent use applicant must serve copies of its application, specimens and drawing on each excepted user (applicant, registrant or common law user) specified in the application as a concurrent user. [Note 6.]

For information concerning applicant's obligation to assert use in commerce, see TBMP § 1103.01(a).

For information concerning applicant's obligation to meet certain jurisdictional requirements, see TBMP § 1103.01(b).

#### **NOTES:**

1. Trademark Act § 2(d), 15 U.S.C. § 1052(d). *See* 37 CFR § 2.99(g).
2. *See* Trademark Act § 2(d), 15 U.S.C. § 1052(d).
3. *See* 37 CFR § 2.42. *See also* Trademark Act § 1(a)(3)(D), 15 U.S.C. § 1051(a)(3)(D).
4. *See* 37 CFR § 2.42.
5. *See* 37 CFR §§ 2.32-2.41.
6. *See* 37 CFR § 2.99(b). *Cf.* 37 CFR § 2.99(c).

#### **1103.01(a) Application Must Assert Use in Commerce**

A basic requirement for any concurrent use application (whether it is to be based on a Board determination or on a prior court determination of applicant's concurrent use rights) is that it must assert use in commerce of the mark sought to be registered.

Trademark Act § 2(d), 15 U.S.C. § 1052(d), provides, in pertinent part:

*[I]f the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons **when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the***

*applications pending or of any registration issued under this Act; ... Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks **in commerce**.* [Note 1.] (Emphasis added.)

In an application based on use in commerce under Trademark Act § 1(a), 15 U.S.C. §1051(a), the applicant may seek concurrent use registration at the time the application is filed or in a subsequent amendment. [Note 2.]

If a concurrent use application is filed as an intent-to-use application under Trademark Act § 1(b), 15 U.S.C. § 1051(b), rather than as a use application under Trademark Act § 1(a), 15 U.S.C. § 1051(a), the applicant may not amend the application to seek concurrent use until use is effected. [Note 3.] Thus, an intent-to-use application for an unrestricted registration may be amended to seek concurrent registration only after an acceptable allegation of use under 37 CFR § 2.76 or 37 CFR § 2.88 has been filed in the application. [Note 4.]

Applications based solely on Trademark Act § 44, 15 U.S.C. § 1126 or Trademark Act § 66(a), 15 U.S.C. § 1141f(a), are not subject to concurrent use registration proceedings. [Note 5.] Thus, an application for registration under the provisions of Trademark Act § 44, may not seek concurrent registration unless the application also includes, as a second basis for registration, an allegation of use in commerce pursuant to Trademark Act § 1(a), 15 U.S.C. § 1051(a), or, in the case of an application based also on Trademark Act § 1(b), 15 U.S.C. § 1051(b), an allegation of use under 37 CFR § 2.76 or 37 CFR § 2.88. [Note 6.] Where the second basis for registration is Trademark Act § 1(b), the allegation of use must be filed prior to amendment of the application to seek concurrent use registration. [Note 7.]

## NOTES:

1. Trademark Act § 2(d), 15 U.S.C. § 1052(d). See 37 CFR § 2.99(g); *Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (concurrent use applicant's use of mark during pendency of registrant's federal registration is not lawful, but use of mark following cancellation of federal registration is lawful as it is not subject to former constructive notice effects of that registration; "constructive notice ... exists, and lasts, only as long as the federal registration giving rise to that constructive notice remains in effect."); *Fleming Companies v. Thriftway Inc.*, 809 F. Supp. 38, 26 USPQ2d 1551, 1553 (S.D. Ohio 1992) (use must be lawful), *aff'g* 21 USPQ2d 1451 (TTAB 1991).
2. TMEP § 1207.04(b).
3. See 37 CFR § 2.99(g); TMEP § 1207.04(b).
4. See 37 CFR § 2.73.
5. 37 CFR § 2.99(g). See TMEP § 1207.04(b); Miscellaneous Changes to Trademark Rules of Practice, 73 Fed. Reg. 67759 (November 17, 2008).

6. See TMEP § 1207.04(b).

7. See 37 CFR § 2.73.

### **1103.01(b) Jurisdictional Requirement**

An application seeking concurrent registration through a concurrent use proceeding before the Board, must allege use in commerce “prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under [the Trademark Act of 1946]; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947.” [Note 1.] As a practical matter, this means that an application seeking concurrent registration through a concurrent use proceeding normally must assert a date of first use in commerce prior to the earliest application filing date of the application(s) or 1946 Act registration(s) involved in the proceeding, (or prior to July 5, 1947, in the case of an involved registration under the Acts of 1881 or 1905).

This requirement is jurisdictional in nature. [Note 2.] If it is not met, i.e., if the asserted date of first use is not prior to the cut-off date as described in the preceding paragraph, applicant normally is not entitled to a concurrent registration, and the trademark examining attorney in charge of the application should refuse registration.

However, an application for concurrent registration need not meet the jurisdictional requirement, that is, need not assert use in commerce prior to the earliest application filing date of the application(s), or registration(s) (if any), involved in the proceeding (or prior to July 5, 1947 if relevant) under two circumstances. The first circumstance exists where the owner of such application(s) or registration(s) consents to the grant of a concurrent registration to the concurrent use applicant. [Note 3.] The second circumstance exists where there is an application seeking concurrent registration based on a final determination, by a court of competent jurisdiction, that applicant is entitled to concurrently use its mark. [Note 4.] See TBMP § 1103.03.

#### **NOTES:**

1. See Trademark Act § 2(d), 15 U.S.C. § 1052(d).

2. See *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306, 1308 (Fed. Cir. 1987) (a valid application cannot be filed at all without lawful use in commerce and for purposes of concurrent use proceeding, such lawful use must begin prior to the filing date of any application with which concurrent use is sought); *CDS Inc. v. I.C.E.D. Management, Inc.*, 80 USPQ2d 1572, 1580 n.12 (TTAB 2006) (priority is not normally an issue in concurrent use proceedings; question is whether concurrent use applicant has met the jurisdictional requirement of establishing use in commerce prior to the filing date of the defendant's application); *Ole' Taco Inc. v. Tacos Ole, Inc.*, 221 USPQ 912, 915 (TTAB 1984) (applicant's “innocent use without notice of registrant's use and activity” prior to registrant's filing date meets the jurisdictional

requirement); *The Pennsylvania Fashion Factory, Inc. v. Fashion Factory, Inc.*, 215 USPQ 1133, 1136 (TTAB 1982) (jurisdictional requirement met); *In re Beatrice Foods Co.*, 429 F.2d 466, 166 USPQ 431, 436 (CCPA 1970) (applicant's lawful use outside of conflicting claimant's area is jurisdictional in nature and must begin prior to filing date by conflicting claimant; extent of such actual use in commerce is irrelevant so long as it is more than a token use); *Fleming Companies v. Thriftway Inc.*, 809 F. Supp. 38, 26 USPQ2d 1551, 1553 (S.D. Ohio 1992) (plaintiff did not use mark in expanded territory prior to defendant's registration and therefore could not be "lawful" user), *aff'g* 21 USPQ 1451 (TTAB 1991); *Morgan Services Inc. v. Morgan Linen Services Inc.*, 12 USPQ2d 1841, 1842 (TTAB 1989) (assignees (excepted users) stand in the shoes of the assignor (concurrent use applicant) for purposes of determining jurisdictional requirement and therefore assignee's acquisition of rights through territorial assignment meets jurisdictional requirement); *My Aching Back Inc. v. Klugman*, 6 USPQ2d 1892, 1894 (TTAB 1988) (jurisdictional requirement not met where applicant was not a lawful concurrent user since applicant used mark after filing date of excepted user's registration and therefore had constructive notice of use of same mark for same goods by another party); *Over the Rainbow, Ltd. v. Over the Rainbow, Inc.*, 227 USPQ 879, 882 (TTAB 1985) (jurisdictional requirement met where excepted users had no registration or application). *Cf. The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1592 (TTAB 1995) (where Board declined to institute concurrent use proceeding).

3. See Trademark Act § 2(d), 15 U.S.C. § 1052(d).

4. See *In re Home Federal Savings and Loan Association*, 213 USPQ 68, 69 (TTAB 1982).

### **1103.01(c) Application Must Meet Requirements Applicable to Non-Restricted Application**

A concurrent use application must specify and contain all the elements required by the rules of practice in trademark cases for a non-restricted application. [Note 1.]

#### **NOTES:**

1. See 37 CFR §§ 2.32-2.41. See also *DataNational Corp. v. BellSouth Corp.*, 60 F.3d 1565, 35 USPQ2d 1554, 1558-59 (Fed. Cir. 1995) (before an applicant may obtain a concurrent use registration, it must first satisfy requirements which apply to any application whether restricted or unrestricted; applicant may not obtain concurrent use registration where designation is generic in non-territory), *aff'g* 18 USPQ2d 1862, 1866 (TTAB 1991); *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306, 1308 (Fed. Cir. 1987) (a valid application cannot be filed at all without lawful use in commerce and for purposes of concurrent use proceeding, such lawful use must begin prior to the filing date of any application with which concurrent use is sought); *In re Beatrice Foods Co.*, 429 F.2d 466, 166 USPQ 431, 436 (CCPA 1970) (extent of such use in commerce is irrelevant so long as it is more than a token use).

## **1103.01(d) Application Must Identify Nature and Extent of Restriction Sought**

### **1103.01(d)(1) In General**

**15 U.S.C. § 1051(a)(3)(D)** ... in the case of every application claiming concurrent use, the applicant shall –

(i) state exceptions to the claim of exclusive use; and

(ii) shall specify, to the extent of the verifier's knowledge—

(I) any concurrent use by others;

(II) the goods on or in connection with which and the areas in which each concurrent use exists;

(III) the periods of each use; and

(IV) the goods and area for which the applicant desires registration.

**37 CFR § 2.42** **Concurrent use.** An application for registration as a lawful concurrent user shall specify and contain all the elements required by the preceding sections. The applicant in addition shall state in the application the area, the goods, and the mode of use for which applicant seeks registration; and also shall state, to the extent of the applicant's knowledge, the concurrent lawful use of the mark by others, setting forth their names and addresses; registrations issued to or applications filed by such others, if any; the areas of such use; the goods on or in connection with which such use is made; the mode of such use; and the periods of such use.

The applicant must state in the application the geographic area, goods and/or services, and (if applicable) mode of use for which applicant seeks registration of the mark. [Note 1.] The application must provide, to the extent of applicant's knowledge, the concurrent lawful use of the mark by others, setting forth their names and addresses; their areas of use; the goods and/or services on or in connection with which their use is made; the mode of their use; the periods of their use; and the registrations issued to, or applications filed by them, if any. For information concerning statements by the concurrent use applicant regarding use of the mark by others, see TBMP § 1103.01(e).

The statement in the application of the area, goods and/or services, and (if applicable) mode of use for which applicant seeks registration serves to give notice, both when the mark is published for opposition (assuming it is approved for publication) and when a concurrent use proceeding is thereafter instituted (if no opposition is filed, or if all oppositions filed are dismissed or withdrawn), of the scope of the registration sought by applicant. The statement setting forth the concurrent lawful use of the mark by others serves to give notice of the extent of applicant's acknowledgment of the concurrent rights of others. [Note 2.]

## NOTES:

1. See 37 CFR § 2.42. See also Trademark Act § 1(a), 15 U.S.C. § 1051(a)(3)(D).
2. See 37 CFR § 2.99(d)(1) and 37 CFR § 2.99(d)(3); *In re Wells Fargo & Co.*, 231 USPQ 95, 105-06 (TTAB 1986); *In re El Chico Corp.*, 159 USPQ 740, 741 (TTAB 1968). See also *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1230 (TTAB 1993) (at late stage in contested concurrent use proceeding, Board will generally not permit concurrent use applicant to enlarge territory for which it seeks registration).

### **1103.01(d)(2) Geographic Restrictions**

Generally, concurrent rights arise when a party, in good faith, and without knowledge of a prior party's use in another geographic area, adopts and uses the same or similar mark for the same or similar goods or services within its own geographic area. [Note 1.] The vast majority of concurrent use applications seek a registration that is restricted geographically.

The area for which registration is sought is usually more extensive than the area in which the applicant is actually using its mark. If an applicant for concurrent registration believes that it is the prior user as against the other party or parties to the proceeding, applicant may, as the prior user, seek registration for all of the United States except for the subsequent user's area of actual use and (possibly) natural expansion. [Note 2.] If applicant is not the prior user, but believes that the prior user, through its failure to expand over a long period of time, has abandoned its right as a prior user to expand into all of the United States except for the applicant's area of actual use and natural expansion, applicant may seek registration for all of the United States except for the prior user's area of actual use. [Note 3.] If the concurrent use applicant is a subsequent user not seeking registration for the entire United States because it does not believe that the prior user has abandoned its rights, the concurrent use applicant normally will seek registration not only for its area of actual use but also for its area of natural expansion. In any case, even where the concurrent use applicant is the prior user, if another party to the proceeding owns a registration of its mark, the right to use of which has become incontestable, any registration issued to the concurrent use applicant will be limited to the concurrent use applicant's area of actual use prior to actual or constructive notice of registrant's rights, unless the parties stipulate otherwise. [Note 4.]

The description of the geographic area sought by the concurrent use applicant should be sufficiently definite. If the excepted area is less than an entire state, it should be described in terms of counties or in other specific and definite terms. [Note 5.]

## NOTES:

1. See *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306, 1307 (Fed. Cir. 1987) (issue of likelihood of confusion was properly resolved by looking at the concurrent use applicant's area of actual use, not merely the area claimed in its application); *Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723, 1726 (TTAB 1990) (actual use in a territory is not necessary to establish rights in that territory and depends on a number of factors). See also

*Weiner King, Inc. v. Wiener King Corp.*, 615 F.2d 512, 204 USPQ 820, 829 (CCPA 1980) (mere knowledge of the existence of the prior user should not, in itself, constitute bad faith); *In re Beatrice Foods Co.*, 429 F.2d 466, 166 USPQ 431, 436 (CCPA 1970); *Fleming Companies v. Thriftway Inc.*, 809 F. Supp. 38, 26 USPQ2d 1551, 1553 (S.D. Ohio 1992) (plaintiff did not use mark in expanded territory prior to defendant's registration and therefore could not be "lawful" user), *aff'g* 21 USPQ 1451 (TTAB 1991); *DataNational Corp. v. BellSouth Corp.*, 18 USPQ2d 1862, 1866 (TTAB 1991), *aff'd*, 60 F.3d 1565, 35 USPQ2d 1554 (Fed. Cir. 1995); *Over the Rainbow, Ltd. v. Over the Rainbow, Inc.*, 227 USPQ 879, 884 (TTAB 1985) (primary concern in concurrent use proceeding is the avoidance of likelihood of confusion; here, confusion inevitable; applicant unable to establish its entitlement to registration in area claimed, where senior user was national franchise).

2. See *Pinocchio's Pizza Inc. v. Sandra Inc.*, 11 USPQ2d 1227, 1229 (TTAB 1989) (as a general rule prior user is entitled to registration covering entire United States except for geographic area in which subsequent user has actually used the mark plus an area shown to be within the natural expansion of its business, but rule is not absolute); *Ole' Taco Inc. v. Tacos Ole, Inc.*, 221 USPQ 912, 916 (TTAB 1984) (subsequent user may obtain registration for area of actual use as well as area of natural expansion and subsequent user who adopts in good faith is not necessarily precluded from further expansion after learning of prior user); *Zimmerman v. Holiday Inns of America, Inc.*, 123 USPQ 86, 87 (TTAB 1959) (acknowledged the right of the subsequent user to operate in areas into which it had expanded after notice of the existence of the prior user). Cf. *Terrific Promotions Inc. v. Vantex Inc.*, 36 USPQ2d 1349, 1353 (TTAB 1995) (where good faith subsequent user that had vigorously expanded under mark was given most of U.S.).

3. See, e.g., *Weiner King, Inc. v. Wiener King Corp.*, 615 F.2d 512, 204 USPQ 820, 832 (CCPA 1980); *Pinocchio's Pizza Inc. v. Sandra Inc.*, 11 USPQ2d 1227, 1228 (TTAB 1989). Cf. *Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305, 1307-8 (TTAB 1984) (applicant not entitled to concurrent use registration where user abandoned application for mark but not its right to continue using mark).

4. See Trademark Act § 15 and Trademark Act § 33(b)(5), 15 U.S.C. § 1065 and 15 U.S.C. § 1115(b)(5); *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630, 633 (CCPA 1976) (court determination of rights); *Thriftmart, Inc. v. Scot Lad Foods, Inc.*, 207 USPQ 330, 334 (TTAB 1980) (agreement by parties found to obviate likelihood of confusion).

5. See *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1230 (TTAB 1993) (description excepting "the San Francisco Bay area" indefinite); *In re El Chico Corp.*, 159 USPQ 740, 741 (TTAB 1968) (merely stating that there are various users in various states for similar services is insufficient).

### **1103.01(d)(3) Mode of Use Restrictions**

In very rare instances, a concurrent use applicant may seek concurrent registration based only on conditions or limitations as to the mode of use of its mark [Note 1] or as to the goods and/or services on or in connection with which the mark is used, i.e., a restriction as to the form in which it may use its mark; a limitation as to the trade channels in which its goods are sold; a

requirement that the mark always be used in conjunction with a particular trade dress or house mark, or a specified disclaimer of affiliation. [Note 2.] Usually, “mode of use” cases arise before the federal district courts, which, for equitable reasons, may permit a continuation of concurrent use even if there is some resulting confusion. Notwithstanding the likelihood of confusion, a party to the court proceeding may obtain concurrent registration on the basis of such a court determination, if its application is otherwise acceptable for registration. [Note 3.] In contrast, when concurrent registration is sought by way of a concurrent use proceeding before the Board, the Board cannot allow registration if it finds that there would be a likelihood of confusion from the continued concurrent use of the marks. [Note 4.]

An applicant seeking registration on the basis of “mode of use” conditions or limitations should request concurrent registration only if its application includes a condition or limitation not capable of being incorporated into the applicant's drawing of its mark and/or identification of goods or services, and into the drawing and/or identification of any conflicting application or registration which may be owned by another. [Note 5.]

Where an applicant seeks registration on the basis of “mode of use” conditions or limitations which are incorporated, or are capable of being incorporated, into the applicant's drawing of its mark and/or identification of goods or services, and into the drawing and/or identification of any conflicting application or registration which may be owned by another, a concurrent use proceeding is unnecessary and will not be instituted by the Board. The application should be presented as a regular application, not as a concurrent use application. [Note 6.] If an applicant that has incorporated mode of use conditions or limitations into its drawing and/or identification is unable to obtain a registration in the absence of corresponding conditions or limitations in a conflicting application or registration, and the owner thereof is not willing to amend its application or registration to include the conditions or limitations, applicant's remedy lies in an opposition or a petition for cancellation, respectively, to restrict the application or registration appropriately. [Note 7.]

For information concerning a claim for partial opposition or partial cancellation, i.e., a request to restrict, see [TBMP § 309.03\(d\)](#).

#### **NOTES:**

1. See *The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1589 n.4 (TTAB 1995) (mode of use refers to “the manner of displaying the mark, e.g., where the mark is displayed only in a certain stylization, or only in conjunction with a particular trade dress or house mark, or only in conjunction with a disclaimer of affiliation.”).
2. See, e.g., *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630, 632 (CCPA 1976) (restrictions, *inter alia*, to form of mark and geographic area of use); *Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 130 USPQ 412, 419-20 (CCPA 1961) (restrictions, *inter alia*, to form of mark and types of goods). Cf. *The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1592 (TTAB 1995) (request for concurrent use registration based on asserted dissimilarity of trade channels denied); *In re Wells Fargo & Co.*, 231 USPQ 95 (TTAB 1986) (court imposed geographic restriction and mode of use requirements involving,

*inter alia*, trade dress and advertising).

3. See, e.g., Trademark Act § 2(d), 15 U.S.C. §1052(d); *Nobelle.com LLC v. Qwest Communications Int'l Inc.*, 66 USPQ2d 1300, 1302 n.4 (TTAB 2003) (mode of use restrictions in nine concurrent use registrations issued in accord with opinions and orders entered by federal district court in antitrust litigation); *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630, 635 (CCPA 1976) (application presenting mark in plain typed capital letters did not violate judgment but accompanying specimen showing mark in prohibited script did); *Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 130 USPQ 412, 416 (CCPA 1961).

4. See Trademark Act § 2(d), 15 U.S.C. § 1052(d); *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630, 635 (CCPA 1976) (“[T]he sentence referring to court determinations is independent of the opening words of the proviso referring to the Commissioner’s determination that confusion, etc., is ‘not likely.’ We do not consider those words to be a limitation on the provision for granting concurrent registrations on the basis of determinations of right to use by courts of competent jurisdiction.”).

5. See *The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1591 (TTAB 1995) (refusing to institute concurrent use proceeding where sole basis for applicant's request for institution thereof is the asserted dissimilarity in the trade channels in which the parties’ services are offered; “Concurrent use proceedings shall be reserved for those situations where the proposed conditions and limitations cannot be incorporated into the drawing of the mark or the identification of goods, and cannot be considered under the main clause of Section 2(d).”). See also *Ex parte Crossett Lumber Co.*, 89 USPQ 29, 30 (USPTO 1951) (no concurrent use proceeding instituted where only proposed restriction was to have parties use same mark with different additional wording by each).

6. See *The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587,1590-91 (TTAB 1995) (“Any ‘conditions and limitations’ as to the parties’ marks and/or goods which are incorporated into the parties’ respective drawings and identifications of goods and/or services can and must be considered as part of the basic likelihood of confusion analysis under the main clause of Section 2(d).”).

7. See *The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1591 n.7 (TTAB 1995) (“If the mark and/or goods conditions or limitations which might avoid a finding of likelihood of confusion are not already present in a conflicting registration, and the owner of the registration is not willing to amend its registration to incorporate the conditions or limitations, applicant's remedy lies in a petition for partial cancellation to restrict the registration;” concurrent use proceeding not instituted where only limitation was trade channels that could be adequately dealt with under main clause of Trademark Act § 2(d) in ordinary ex parte or inter partes proceeding).

### **1103.01(e) Application Must Identify Excepted Users and Their Asserted Rights**

In addition to the requirement that the applicant must provide certain information about its own mark, see TBMP §§ 1103.01(d)(1)-(3), the applicant must state in the application, to the extent

of applicant's knowledge, the concurrent lawful use of the mark by others, setting forth their names and addresses; their areas of use; the goods and/or services on or in connection with which their use is made; the mode of their use; the periods of their use; and the registrations issued to or applications filed by them, if any. [Note 1.]

In specifying a concurrent use applicant's extent of its knowledge of the concurrent rights of others, [Note 2] it is not necessary that it list, as exceptions to its claim of exclusive use, every entity known to it to be using the same or similar mark for the same or similar goods or services. Rather, applicant's duty is to list any entity known to it to be a senior user of a clearly conflicting mark, as well as any junior user known to it to have clearly conflicting rights which are clearly established, as, for example, by court decree, by settlement agreement, or by a registration. [Note 3.]

#### **NOTES:**

1. See 37 CFR § 2.42. See also Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243 (August 1, 2007) (“The amended trademark rules continue the requirement that the concurrent use applicant provide correspondence address information for excepted parties.”).

2. See 37 CFR § 2.42. See also Trademark Act § 1(a), 15 U.S.C. § 1051(a); *Gallagher's Restaurants Inc. v. Gallagher's Farms Inc.*, 3 USPQ2d 1864, 1866 (TTAB 1986) (motion to amend concurrent use application to add additional users denied where it was filed late in proceeding, existence of the users were known to applicant years earlier, and applicant failed to specify the marks or the goods/services allegedly used by those parties); *In re Wells Fargo & Co.*, 231 USPQ 106, 116 (TTAB 1986) (concurrent use registration denied where, inter alia, applicant failed to specify areas of use and services of excepted user); *In re El Chico Corp.*, 159 USPQ 740, 741 (TTAB 1968) (merely stating that there are various users in various states for similar services is insufficient).

3. See *Rosso & Mastracco, Inc. v. Giant Food Inc.*, 720 F.2d 1263, 219 USPQ 1050, 1053 (Fed. Cir. 1983) (no requirement to investigate and report all possible users; senior user ordinarily need not identify junior users in the oath unless rights of a junior user have been “clearly established”); *Pennsylvania Fashion Factory, Inc. v. Fashion Factory, Inc.*, 215 USPQ 1133, 1137 (TTAB 1982) (duty to investigate only known prior users; existence of other users came to applicant's attention after applicant began use and then only as result of computer-generated search report). See also *In re Sun Refining & Marketing Co.*, 23 USPQ2d 1072, 1073 (TTAB 1991) (obligated to amend declaration to acknowledge rights recognized by the terms of a settlement agreement). Cf. *SCOA Industries Inc. v. Kennedy & Cohen, Inc.*, 188 USPQ 411, 414 (TTAB 1975) (no duty to identify other user where there are arguable differences between the marks).

#### **1103.01(f) Other Requirements**

**37 CFR § 2.99(b)** *If it appears that the applicant is entitled to have the mark registered, subject to a concurrent use proceeding, the mark will be published in the Official Gazette as provided by*

§ 2.80.

**37 CFR § 2.80 Publication for opposition.** *If, on examination or reexamination of an application for registration on the Principal Register, it appears that the applicant is entitled to have his mark registered, the mark will be published in the Official Gazette for opposition. The mark will also be published in the case of an application to be placed in interference or concurrent use proceedings, if otherwise registrable.*

**37 CFR § 2.99(c)** *If no opposition is filed, or if all oppositions that are filed are dismissed or withdrawn, the Trademark Trial and Appeal Board will send a notification to the applicant for concurrent use registration (plaintiff) and to each applicant, registrant or user specified as a concurrent user in the application (defendants). ...*

**37 CFR § 2.99 (d)(1)** *Within ten days from the date of the Board's notification, the applicant for concurrent use registration must serve copies of its application, specimens and drawing on each applicant, registrant or user specified as a concurrent user in the application for registration, as directed by the Board. If any service copy is returned to the concurrent use applicant as undeliverable, the concurrent use applicant must notify the Board within ten days of receipt of the returned copy.*

When it is determined that an applicant is entitled to have its mark registered, subject to a concurrent use proceeding, the mark will be published for opposition. If no opposition is filed, or if all oppositions that are filed are dismissed or withdrawn, the Board will send notification to the applicant and to each entity that has been named as an excepted user by the applicant, of the institution of the concurrent use proceeding. Within ten days from the date the Board notifies the excepted users (i.e., applicant, registrant or common law user) of the institution of the proceeding, the concurrent use applicant must serve copies of its application, specimens and drawing on each excepted user (i.e., applicant, registrant or common law user) specified in the application as a concurrent user. [Note 1.] See TBMP § 1106.

When an application seeking concurrent registration by way of a concurrent use proceeding before the Board is approved for publication, it is marked (by the trademark examining attorney) with the following statement:

SUBJECT TO CONCURRENT USE PROCEEDING WITH \_\_\_\_\_. APPLICANT CLAIMS EXCLUSIVE RIGHT TO USE THE MARK IN THE AREA COMPRISING \_\_\_\_\_.

The first blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the first blank space. The second blank is filled in with the area for which applicant seeks registration, together with any other conditions or limitations to which registration would be restricted.

For information concerning the examination by the trademark examining attorney of a concurrent use application, see TMEP § 1207.04(d) and TMEP § 1207.04(e)(i).

**NOTES:**

1. See 37 CFR §§ 2.99(b)-(d).

### **1103.02 Application Based on Prior Board Decision**

An application seeking concurrent registration on the basis of the Board's final decision in a prior concurrent use proceeding, see TBMP § 1102.01, must assert use in commerce of the mark sought to be registered. See TBMP § 1103.01(a). The application must also specify and contain all the requirements of 37 CFR § 2.42 (described in TBMP § 1103.01), namely, the requirements that applicant state in the application the area, goods and/or services, and (if applicable) mode of use for which applicant seeks registration, and also state, to the extent of applicant's knowledge, the concurrent lawful use of the mark by others, setting forth their names and addresses, their areas of use, the goods and/or services on or in connection with which their use is made, the mode of their use, the periods of their use, and the registrations issued to or applications filed by them, if any. [Note 1.] In addition, the applicant should submit a copy of the Board decision upon which it relies to ensure that the processing of its application is not delayed. Although the Board may obtain a copy of the prior Board decision upon which the applicant relies, this is not always possible.

When an application for concurrent registration is based on a final determination by the Board, in a prior concurrent use proceeding, that applicant is entitled to a concurrent registration of its mark, a new concurrent use proceeding will not be instituted, that is, the application (if found otherwise acceptable, published, and not opposed, or opposed unsuccessfully) will be forwarded to issue without having to go through a new concurrent use proceeding, provided that the following conditions are met:

- (1) The applicant is entitled to registration subject only to the concurrent lawful use of a party or parties to the prior concurrent use proceeding; and
- (2) The Board's prior decision specifies applicant's right to concurrent registration; and
- (3) A copy of the Board's prior decision is submitted to the trademark examining attorney; and
- (4) The concurrent use application complies with the Board's prior decision, in that it seeks registration for the same, or a more limited, geographic area or mode of use than granted to applicant in the prior decision; seeks registration for substantially the same mark or one less confusingly similar to those of the other party or parties in the prior proceeding; and seeks registration for substantially the same goods and/or services as, or more limited goods and/or services than those listed in the Board's prior specification of applicant's entitlement to concurrent registration [Note 2]; and
- (5) The excepted use specified in the concurrent use application does not involve a registration,

or any involved registration has been restricted in accordance with the Board's prior decision.

If an application seeking concurrent registration on the basis of the Board's determination in a prior concurrent use proceeding meets all of the conditions specified above, a new concurrent use proceeding is unnecessary, because of the legal principles of res judicata and stare decisis. [Note 3.] If any of the conditions are not satisfied, a new concurrent use proceeding will be prepared and instituted. In the event that the first four conditions are met, but an involved registration was not restricted in accordance with the Board's prior decision, a new concurrent use proceeding will be instituted solely for the purpose of restricting the involved registration in accordance with the Board's decision. In such cases, the Board's institution order includes an order to the concurrent use applicant to serve copies of its application, specimens and drawing on the involved registrant within ten days, and an order to the registrant to show cause why its registration should not be restricted in accordance with the Board's prior decision. If no good cause is shown, the registration is ordered restricted, applicant is found entitled to the registration sought, and the concurrent use proceeding is dissolved.

If all of the above conditions are satisfied so that a new concurrent use proceeding is not necessary, applicant need not serve copies of its application, specimens and drawing on the excepted users (i.e., registrant, applicant or common law user) specified in the concurrent application as provided in 37 CFR § 2.99(d)(1). Cf. TBMP §§ 1103.01(c)-(f).

When and if the application is approved for publication, it is marked (by the trademark examining attorney) with the following statement:

REGISTRATION LIMITED TO THE AREA COMPRISING \_\_\_\_\_ PURSUANT TO CONCURRENT USE PROCEEDING NO. \_\_\_\_\_. CONCURRENT REGISTRATION WITH \_\_\_\_\_.

The area specified in the Board's prior decision as the area for which applicant is entitled to registration is inserted in the first blank, together with any other conditions or limitations imposed by the Board. The second blank is filled in with the number of the prior concurrent use proceeding. The third blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the prior concurrent use proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the third blank space.

If all of the conditions are not satisfied, a new concurrent use proceeding is necessary. When and if the application is approved for publication, it is marked (by the trademark examining attorney) with the following statement:

SUBJECT TO CONCURRENT USE PROCEEDING WITH \_\_\_\_\_. APPLICANT CLAIMS EXCLUSIVE RIGHT TO USE THE MARK IN THE AREA COMPRISING \_\_\_\_\_.

The first blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the proceeding. If any such party does not own an

application or registration of its involved mark, then the name and address of the party is inserted in the first blank space. The second blank is filled in with the area for which applicant seeks registration.

Applicant will be required, following notification of the proceeding, to serve copies of its application, specimens and drawing on each applicant, registrant or user specified as a concurrent user in the application. [Note 4.] See TBMP § 1106.

The Board does not determine, in a concurrent use proceeding, the right to concurrent registration of a party that is included in the proceeding only as a common law concurrent user, i.e., a party that does not own an involved application or registration. See TBMP § 1108. A party that was included in a prior concurrent use proceeding only as a common law concurrent user may not thereafter obtain a concurrent registration on the basis of the Board's decision in the prior proceeding, without going through a new concurrent use proceeding.

#### **NOTES:**

1. See 37 CFR § 2.42.
2. Cf. regarding comparison of marks and goods/services in context of prior registration defense, *Missouri Silver Pages Directory Publishing Corp. v. Southwestern Bell Media, Inc.*, 6 USPQ2d 1028, 1030-31 (TTAB 1988); *Carl Karcher Enterprises, Inc. v. Gold Star Chili, Inc.*, 222 USPQ 979, 981 (TTAB 1983), *recon. denied*, 222 USPQ 727 (TTAB 1983); *Place for Vision, Inc. v. Pearle Vision Center, Inc.*, 218 USPQ 1022, 1023 (TTAB 1983).
3. Cf. 37 CFR § 2.99(f).
4. See 37 CFR § 2.99(d)(1).

### **1103.03 Application Based on Court Determination**

**37 CFR § 2.99(f)** *When a concurrent use registration is sought on the basis that a court of competent jurisdiction has finally determined that the parties are entitled to use the same or similar marks in commerce, a concurrent use registration proceeding will not be instituted if all of the following conditions are fulfilled:*

*(1) The applicant is entitled to registration subject only to the concurrent lawful use of a party to the court proceeding; and*

*(2) The court decree specifies the rights of the parties; and*

*(3) A true copy of the court decree is submitted to the examiner; and*

*(4) The concurrent use application complies fully and exactly with the court decree; and*

*(5) The excepted use specified in the concurrent use application does not involve a registration,*

*or any involved registration has been restricted by the Director in accordance with the court decree.*

*If any of the conditions specified in this paragraph is not satisfied, a concurrent use registration proceeding shall be prepared and instituted as provided in paragraphs (a) through (e) of this section.*

An application for concurrent registration that is based on a final determination by a court of competent jurisdiction must assert use in commerce of the mark sought to be registered. *See* TBMP § 1103.01(a). The application must also specify and contain all the elements required for an unrestricted registration [Note 1], as well as the additional requirements for concurrent use, namely, the requested geographic area, the goods and/or services, and (if applicable) mode of use for which applicant seeks registration, and also state, to the extent of applicant's knowledge, the concurrent lawful use of the mark by others, setting forth their names and addresses, their areas of use, the goods and/or services on or in connection with which their use is made, the mode of their use, the periods of their use, and the registrations issued to or applications filed by them, if any. [Note 2.] In addition, the applicant must submit a copy of the court decree upon which it relies.

When an application for concurrent registration is based on a final determination by a court of competent jurisdiction that applicant is entitled to concurrently use its mark, a concurrent use proceeding will not be instituted, that is, the application (if found otherwise acceptable, published, and not opposed, or opposed unsuccessfully) will be forwarded to issue without having to go through a concurrent use proceeding, provided that all of the following conditions, specified in 37 CFR § 2.99(f), are met, namely:

- (1) The applicant is entitled to registration subject only to the concurrent lawful use of a party or parties to the court proceeding; and
- (2) The court decree specifies the rights of the parties; and
- (3) A true copy of the court decree is submitted to the trademark examining attorney; and
- (4) The concurrent use application complies fully and exactly with the court decree, [Note 3] and
- (5) The excepted use specified in the concurrent use application does not involve a registration, or, if it does, the involved registration has been restricted by the Director in accordance with the court decree.

If any of the above conditions are not satisfied, a concurrent use registration proceeding will be prepared and instituted. [Note 4.] In such case, the concurrent use applicant must serve copies of its application, specimens and drawing on the excepted users (i.e., registrant, applicant or common law user) specified in the concurrent application as provided by 37 CFR § 2.99(d)(1). If the first four conditions are met, but the Director, in accordance with the court decree, has not already restricted an involved registration, a concurrent use proceeding will be instituted solely

for the purpose of restricting the involved registration in accordance with the court decree. In such case, the Board sends out an order instituting the proceeding and directing the registrant to show cause why its registration should not be restricted in accordance with the court decree. If no good cause is shown, the registration is ordered restricted, applicant is found entitled to the registration sought, and the concurrent use proceeding is dissolved.

If all of the above conditions are satisfied, so that a concurrent use proceeding is not necessary, applicant need not serve copies of its application, specimens and drawing on the excepted users (i.e., registrant, applicant or common law user) specified in the concurrent application as provided by 37 CFR § 2.99(d)(1). Cf. TBMP §§ 1103.01(c)-(f).

When and if the application is approved for publication, it is marked (by the trademark examining attorney) with the following statement:

REGISTRATION LIMITED TO THE AREA COMPRISING \_\_\_\_\_.  
PURSUANT TO THE DECREE OF \_\_\_\_\_. CONCURRENT  
REGISTRATION WITH \_\_\_\_\_.

The area granted to applicant by the court is inserted in the first blank, together with any other conditions or limitations imposed by the court. The second blank is filled in with the name of the court, proceeding number, and date of decree. The third blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the court proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the third blank space.

If all of the conditions are not satisfied, a concurrent use proceeding is necessary. When and if the application is approved for publication, it is marked (by the trademark examining attorney) with the following statement:

SUBJECT TO CONCURRENT USE PROCEEDING WITH \_\_\_\_\_.  
APPLICANT CLAIMS EXCLUSIVE RIGHT TO USE THE MARK IN THE AREA  
COMPRISING \_\_\_\_\_.

The first blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the first blank space. The second blank is filled in with the area for which applicant seeks registration.

Following notification of the proceeding, applicant will be required, to serve copies of its application, specimens and drawing on each applicant, registrant or user specified as a concurrent user in the application. [Note 5.] See TBMP § 1106.

**Jurisdictional requirement, and requirement that there be no likelihood of confusion need not be met.** An application for concurrent registration on the basis of a court determination of applicant's right to concurrently use its mark in commerce does not need to meet the

jurisdictional requirement of use in commerce prior to the applicable date specified in Trademark Act § 2(d), 15 U.S.C. § 1052(d). For information concerning the dates specified in Trademark Act § 2(d), see TBMP § 1103.01(b). Similarly, such an application is not subject to the requirement that the Director determine, prior to issuance of a concurrent registration, that confusion, mistake, or deception is not likely to result from the continued concurrent use by the parties of their marks. These two requirements are conditions precedent to the issuance of a concurrent registration by way of a concurrent use proceeding before the Board, but they are not conditions precedent to the issuance of a concurrent registration on the basis of a court decree. The sentence in Trademark Act § 2(d) permitting the Director to issue concurrent registrations when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce is wholly independent of these two provisions. Thus, a concurrent registration may (and should, if otherwise appropriate) be issued on the basis of a court decree even though the application for registration does not claim use in commerce prior to the applicable date specified in Trademark Act § 2(d), and even though there is likelihood of confusion by reason of the concurrent use of the marks of the parties to the court proceeding. [Note 6.]

#### **NOTES:**

1. The application must comply with the requirements of 37 CFR § 2.42, described in TBMP §§ 1103.01(c)-(f) and 37 CFR § 2.32 et. al.
2. See 37 CFR § 2.42.
3. See *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630, 635 (CCPA 1976) (application was properly limited geographically and as to the form of the mark, but the specimens appeared to violate the judgment); *Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 130 USPQ 412, 419-20 (CCPA 1961).
4. See 37 CFR § 2.99(f).
5. 37 CFR § 2.99(d)(1).
6. See *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630 (CCPA 1976); TMEP § 1207.04(f). Cf. *Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 130 USPQ 412, 416-17 (CCPA 1961). For information concerning the examination by the trademark examining attorney of a concurrent use application, see TMEP § 1207.04.

### **1104 Parties to Proceeding; Involved Applications, Registrations**

The parties to a concurrent use proceeding are the concurrent use applicant(s), (hereinafter “applicant”) and all of those persons listed in the concurrent use application(s) as exceptions to applicant's claim of exclusive use (hereinafter “excepted users”). The persons listed as excepted users may themselves own one or more federal applications (either for concurrent registration with applicant, or for an unrestricted registration) or federal registrations for a conflicting mark, or may simply be common law users of a conflicting mark. Thus, a concurrent use proceeding

may involve the concurrent use applicant(s) and one or more other applicants, and/or one or more registrants, and/or one or more common law concurrent users. Often, the only parties to a concurrent use proceeding are the concurrent use applicant, and a common law user that does not own an involved application or registration. [Note 1.]

If, after the commencement of a concurrent use proceeding, the concurrent use applicant learns of another person with conflicting concurrent rights, the applicant may file a motion to amend its application to list that person as an additional exception to applicant's claim to exclusive use. If the motion is granted, the person listed in the amendment will be added as a party to the proceeding and will be notified of the proceeding by the Board. [Note 2.] Similarly, if the concurrent use applicant learns that a person listed as an exception to applicant's claim of exclusive use has abandoned its mark, or if the person assigns its rights in its mark to the applicant, the applicant may file a motion to amend its application to delete reference to that person. The motion should include an explanation of the facts that serve as the basis for the motion. If the motion is granted, the amendment will be entered, and the person in question will be dropped as a party to the proceeding. [Note 3.]

The applications and/or registrations involved in a concurrent use proceeding include the concurrent use application(s); every conflicting unrestricted application which is identified in the concurrent use application(s) as being owned by a person listed as an exception to the concurrent use applicant's claim of exclusive use, and which has a filing date prior to the filing date of the concurrent use application(s); every conflicting registration identified in the concurrent use application(s) as being owned by a person listed as an exception to the concurrent use applicant's claim of exclusive use; and every registration claimed by the concurrent use applicant(s) in the concurrent use application(s), unless there is no conflict between the mark(s) in such registration(s) and the mark(s) of the other party or parties to the proceeding. [Note 4.] If any identified application has not yet been published in the Official Gazette, or has been published but has not yet cleared the opposition period, the proceeding will be instituted, with the owner of that application being included as a common law user, rather than as an applicant. The Board may, in its discretion, suspend proceedings in the concurrent use proceeding until the unpublished application either becomes abandoned, or is published in the Official Gazette and survives the opposition period; at which time it may be added to the proceeding, and the position of its owner will be changed from that of common law user to applicant. *See TBMP § 1106.* Further, when the Board institutes the concurrent use proceeding, inquiry will be made as to whether any party owns any other application or registration which is for the same or similar mark, and same or similar goods and/or services, and thus should be added to the proceeding. A conflicting application or registration identified in response to this inquiry normally will be added to the proceeding.

However, if a party to the proceeding owns a conflicting application which seeks an unrestricted registration, and which was not filed until after the concurrent use application(s), the trademark examining attorney will suspend action on the subsequent unrestricted application (once the application is otherwise in condition for approval for publication) pending disposition of the concurrent use application(s). [Note 5.] In the event that the concurrent use application(s) matures into concurrent registration(s), the concurrent registration(s) will be cited, under Trademark Act § 2(d), 15 U.S.C. § 1052(d), as a reference(s) against the subsequent unrestricted

application. [Note 6.] Alternatively, if the owner of the subsequent unrestricted application amends it to seek concurrent registration, assuming it is otherwise in condition to be published, asserts use in commerce, and meets the jurisdictional requirement for concurrent registration, the application will be published for opposition. *See* TBMP § 1103.01(b). When the Board is informed of the amendment, it may suspend the concurrent proceeding pending the amended application clearing its opposition period. If no opposition is filed, or if all oppositions filed are dismissed or withdrawn, the application will be added to the concurrent use proceeding. If the Board is not advised of the amendment to concurrent use in time to add the application to the ongoing concurrent use proceeding, a new concurrent use proceeding will be instituted. [Note 7.]

The only issue properly before the Board in a concurrent use proceeding concerns the concurrent use applicant's entitlement to registration. The specific territorial rights to which any common law users are entitled are not before the Board except to the extent that their rights are limited by the territorial rights to which applicant proves entitlement. Because common law users do not own involved applications or registrations, any registration rights of a common law user can be determined only if and when such user files an application seeking concurrent registration and a concurrent use proceeding is instituted involving such application. *See* TBMP § 1108.

#### **NOTES:**

1. *See Fleming Companies Inc. v. Thriftway Inc.*, 21 USPQ2d 1451, 1456 (TTAB 1991); *Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723, 1725 n.5 (TTAB 1990) (unless named as an exception by the concurrent use applicant, a third-party's application may not be joined in a concurrent use proceeding for purposes of determining proper ownership thereof, but an unnamed party may amend its application to seek concurrent registration, in which case such application would become subject to its own concurrent use proceeding); *Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305, 1308 (TTAB 1984) (two concurrent use applicants).
2. *Cf. Gallagher's Restaurants Inc. v. Gallagher's Farms Inc.*, 3 USPQ2d 1864, 1866 (TTAB 1986) (motion to amend concurrent use application to add additional users denied where it was filed late in proceeding, existence of the users were known to applicant years earlier, and applicant failed to specify the marks or the goods/services allegedly used by those parties).
3. *Cf. Fleming Companies Inc. v. Thriftway Inc.*, 21 USPQ2d 1451, 1453 (TTAB 1991) (although abandonment of application without written consent of every adverse party precludes common law user from claiming any right to federal registration, inasmuch as user reserved right to continue using mark, it will not be dropped as party to concurrent use proceeding), *aff'd*, 809 F. Supp. 38, 26 USPQ2d 1551, 1553 (S.D. Ohio 1992); *Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305, 1307-08 (TTAB 1984) (applicant not entitled to concurrent use registration where user abandoned application for mark but not its right to continue using mark).
4. *See Holmes Oil Co. v. Myers Cruizers of Mena Inc.*, 101 USPQ2d 1148, 1149 (TTAB 2011); *Morgan Services Inc. v. Morgan Linen Services Inc.*, 12 USPQ2d 1841, 1842 (TTAB 1989).

5. *See Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1226 (TTAB 1993) (Board has no jurisdiction over user/registrant's application that was pending before examining attorney unless application is amended to seek concurrent use, and is published without successful opposition, and is added to the proceeding).

6. *See Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723, 1725 n.5 (TTAB 1990) (despite parties' treatment of third-party's application as being involved in concurrent use proceeding, it is not; Board makes no legal determination regarding ownership of trademark application, but as it was filed after concurrent use application and is pending before examining attorney, if it is not amended to seek concurrent use, applicant's concurrent registration will be a Trademark Act § 2(d) bar to an unrestricted registration to user).

7. *See Corporate Document Services Inc. v. I.C.E.D. Management Inc.*, 48 USPQ2d 1477, 1480 (TTAB 1998); *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1230 (TTAB 1993); *Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723, 1725 n.5 (TTAB 1990).

## **1105 Applications and Registrations Not Subject to Proceeding**

**37 CFR § 2.73** *An application that includes section 1(a) of the Trademark Act as a filing basis, or for which an acceptable allegation of use under § 2.76 or § 2.88 has been filed, may be amended to an application for concurrent use registration, provided that the application as amended meets the requirements of § 2.42. The trademark examining attorney will determine whether the application, as amended, is acceptable.*

**37 CFR § 2.99(g)** *Registrations and applications to register on the Supplemental Register and registrations under the Act of 1920 are not subject to concurrent use registration proceedings. Applications under section 1(b) of the Act of 1946 are subject to concurrent use registration proceedings only after the applicant files an acceptable allegation of use under § 2.76 or § 2.88. Applications based solely on section 44 or section 66(a) of the Act are not subject to concurrent use registration proceedings.*

**Applications on Supplemental Register.** Applications for registration on the Supplemental Register, registrations on the Supplemental Register, and registrations issued under the Act of 1920 are not subject to concurrent use proceedings. [Note 1.]

**Applications under Trademark Act §§ 44 or 66(a).** Applications for registration based solely on Trademark Act § 44 or Trademark Act § 66(a), 15 U.S.C. § 1126 or 15 U.S.C. § 1141f(a) are not subject to concurrent use proceedings. [Note 2.]

**Applications under Trademark Act § 1(b).** Applications to register under Trademark Act § 1(b), 15 U.S.C. § 1051(b), i.e., intent-to-use applications, are subject to concurrent use proceedings only after an acceptable allegation of use under 37 CFR § 2.76 or 37 CFR § 2.88 has been filed. [Note 3.] *See TBMP § 1103.01(a)*. If a concurrent use application is filed as an intent-to-use application under Trademark Act § 1(b) rather than as a use application under Trademark Act § 1(a), 15 U.S.C. § 1051(a), the applicant may not amend the application to seek concurrent use until use is effected. [Note 4.] Further, applicants may not file an amendment to

allege use in an application under Trademark Act § 1(b) that is the subject of an opposition in an effort to qualify for concurrent use registration. 37 CFR § 2.76(a) provides that an applicant may not file an amendment to allege use after the date the application has been approved for publication. Applications are in a “blackout period” while an opposition is pending. [Note 5.] Should the parties to an opposition wish to go forward with concurrent use registrations, applicant in the opposition may consider abandoning its opposed application and refiling it as a use-based, concurrent use application. If the abandonment is with opposer’s consent, judgment will not be entered against applicant, and the opposition can be dismissed without prejudice. [Note 6.] Opposer should also consider amending any pending application it may have to one seeking a concurrent use registration to enable a full adjudication of rights under the marks. For information regarding termination of the opposition in favor of a concurrent use proceeding, see TBMP § 1113.01.

**Limitations of rights as against incontestable marks.** An “incontestable registration,” that is, a registration of a mark the right to use of which has become incontestable pursuant to Trademark Act § 15, 15 U.S.C. § 1065, is subject to a concurrent use proceeding. However, any registration issued to the concurrent use applicant as against the owner of an incontestable registration will be limited (even if applicant is the prior user) to applicant's area of actual use prior to actual or constructive notice of registrant's rights, unless the parties stipulate otherwise. [Note 7.]

The five-year incontestability period for a registration is tolled with respect to an applicant's concurrent rights if, prior to expiration of the five-year period, the applicant files a proper concurrent use application (or an amendment converting its unrestricted application into one seeking concurrent use registration) naming the registrant as an exception to applicant's right of exclusive use. [Note 8.]

#### NOTES:

1. See Trademark Act § 26 and 15 U.S.C. § 46(b), 15 U.S.C. § 1094 and 15 U.S.C. § 1051; 37 CFR § 2.99(g).
2. See 37 CFR § 2.99(g).
3. See 37 CFR § 2.99(g). Cf. 37 CFR § 2.73.
4. See 37 CFR § 2.99(g); TMEP § 1207.04(b).
5. See TMEP § 1104.03(b).
6. See 37 CFR § 2.135.
7. See Trademark Act § 15 and Trademark Act § 33(b)(5), 15 U.S.C. § 1065 and 15 U.S.C. § 1115(b)(5); *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPT 630, 636 (CCPA 1976) (only the right to use may become incontestable, not the registration); *Thriftmart, Inc. v. Scot Lad Foods, Inc.*, 207 USPQ 330, 334 (TTAB 1980) (applicant involved in concurrent use

proceeding with registration with incontestable rights is normally only entitled to specific area in which it has established rights prior to actual or constructive notice of the registration).

8. *See Arman's Systems, Inc. v. Armand's Subway, Inc.*, 215 USPQ 1048, 1050 (TTAB 1982).

## **1106 Commencement of Proceeding**

### **1106.01 Marking of Concurrent Use Application**

When an application seeking concurrent registration by way of a concurrent use proceeding before the Board is approved for publication, it is marked (by the trademark examining attorney) with the following statement:

SUBJECT TO CONCURRENT USE PROCEEDING WITH \_\_\_\_\_. APPLICANT CLAIMS EXCLUSIVE RIGHT TO USE THE MARK IN THE AREA COMPRISING \_\_\_\_\_.

The first blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the first blank space. The second blank is filled in with the area for which applicant seeks registration.

If an application approved for publication seeks concurrent registration on the basis of the Board's determination, in a prior concurrent use proceeding, of applicant's entitlement thereto, and meets the conditions described in TBMP § 1103.02, so that a new concurrent use proceeding is unnecessary, the application is marked with the following statement:

REGISTRATION LIMITED TO THE AREA COMPRISING \_\_\_\_\_ PURSUANT TO CONCURRENT USE PROCEEDING NO. \_\_\_\_\_. CONCURRENT REGISTRATION WITH \_\_\_\_\_.

The area specified in the Board's decision as the area for which applicant is entitled to registration is inserted in the first blank, together with any other conditions or limitations imposed by the Board. The second blank is filled in with the number of the prior concurrent use proceeding. The third blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the prior concurrent use proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the third blank space.

If an application approved for publication seeks concurrent registration on the basis of a court determination of concurrent rights, and meets the conditions of 37 CFR § 2.99(f), *see* TBMP § 1103.03, so that a concurrent use proceeding is unnecessary, the application is marked with the following statement:

REGISTRATION LIMITED TO THE AREA COMPRISING \_\_\_\_\_ PURSUANT TO THE DECREE OF \_\_\_\_\_. CONCURRENT REGISTRATION WITH \_\_\_\_\_.

The area granted to applicant by the court is inserted in the first blank, together with any other conditions or limitations imposed by the court. The second blank is filled in with the name of the court, proceeding number, and date of decree. The third blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the court proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the third blank space.

## **1106.02 Publication of Concurrent Use Application; Opposition Period**

Once the trademark examining attorney has approved the mark for publication, and marked the application, it is then published, with the indicated statement, in the Official Gazette for opposition. The status of the application is changed to “Concurrent Use Proceeding Pending” on the date of publication and is reported to the Board. The application is then added to the Board’s electronic system and tracked until after the opposition period has passed.

If the application seeking concurrent registration based on a court decree meets the requirements of 37 CFR § 2.99(f), and is not opposed, or all oppositions filed are dismissed or withdrawn, the application goes to issue without the institution of a concurrent use proceeding. [Note 1.] *See* TBMP § 1103.03. Similarly, if the application seeking concurrent registration on the basis of a prior Board concurrent use determination meets the conditions described in TBMP § 1103.02, and is not opposed, or all oppositions filed are dismissed or withdrawn, the application goes to issue without the institution of a new concurrent use proceeding. [Note 2.] *See* TBMP § 1103.02 and TBMP § 1103.03.

Concurrent use proceedings will be instituted (1) if the application seeks concurrent registration by way of a concurrent use proceeding before the Board, and is not opposed, or all oppositions filed are dismissed or withdrawn [Note 3]; (2) if the application seeks concurrent registration on the basis of a court decree but does not meet the requirements of 37 CFR § 2.99(f); or (3) seeks concurrent registration on the basis of the Board’s decision in a prior concurrent use proceeding but does not meet the conditions described in TBMP § 1103.02, and the application is not opposed, or all oppositions filed are dismissed or withdrawn [Note 4.] *See* TBMP § 1103.02 and TBMP § 1103.03.

After the opposition period has expired, and no opposition is filed, or all oppositions filed are dismissed or withdrawn the Board then institutes the proceeding, identifies the defending users and sends notice thereof to each party. *See* TBMP § 1106.03 and TBMP § 1110.04. There is no fee for the institution of a concurrent use proceeding.

### **NOTES:**

1. 37 CFR § 2.99(f).
2. *Cf.* 37 CFR § 2.99(f).
3. *See* 37 CFR § 2.99(c).

4. See 37 CFR § 2.99(c) and 37 CFR § 2.99(f).

### **1106.03 Preparing the Record for the Involved Application and Registration Files**

The Board identifies and enters into the record any applications or registrations that are to be included in the concurrent use proceeding. For information concerning involved applications and registrations, see TBMP § 1104. If any such application has not yet been published in the Official Gazette, or has been published but has not yet cleared the opposition period, the proceeding will be instituted, with the owner of that application being included as a common law user, rather than as an applicant. The Board may, in its discretion, suspend proceedings in the concurrent use proceeding until the unpublished application either becomes abandoned, or is published in the Official Gazette and survives the opposition period. After the application survives the opposition period, it is added to the proceeding, and the position of its owner is changed from that of common law user to applicant. Cf. TBMP § 1104 and TBMP § 1108.

### **1106.04 Preparing Concurrent Use Notices**

There is no complaint in a concurrent use proceeding. Cf. TBMP § 1003. Instead, after the concurrent use application is published, the Board electronically tracks it until it clears its opposition period, the Board identifies all other applications and registrations, if any, to be included in the proceeding, and then the Board prepares notices for each concurrent use applicant and for each party.

The notice sent to each involved concurrent use applicant advises the applicant of the institution of the proceeding and gives the applicant ten days from the date of the order to serve a copy of its application, specimens of use, and drawing of the mark on each user identified in its application. [Note 1.] If any service copy is returned to the concurrent use applicant as undeliverable, the concurrent use applicant must notify the Board within ten days of receipt of the returned copy. [Note 2.] The concurrent use applicant must also file with the Board proof that it has effected proper service of the copies, but should not file a copy of the served documents themselves with the Board. [Note 3.]

A separate order is issued to the excepted users [Note 4], defending applicants or defending registrants, advising each party that the concurrent use proceeding is thereby instituted and supplying information concerning the filing of an “answer” to the notice and specifying a due date therefor. For information concerning the “answer” in a concurrent use proceeding, see TBMP § 1107. The institution order will set out the parties’ conference, disclosures, discovery, trial and briefing periods, unless there is more than one named excepted user, and none of them owns a trademark application or registration. See TBMP § 1109. In that case, the trial schedule is issued after all answers are filed; if any defending common law user fails to file an answer, judgment will be entered against that user as a defaulting user. See TBMP § 1107. The order will also allow the parties until a specified time to advise the Board of any relevant, but as yet uninvolved, application(s) and/or registration(s), which should be included in the proceeding.

The notice to each party listed as an exception to a concurrent use applicant's claim of exclusive use also specifies the name and address of the concurrent use applicant and the concurrent use applicant's attorney or other authorized representative, if any, together with the concurrent use applicant's mark, goods and/or services, application filing date and serial number, and claimed territory [Note 5]; the name and address of any other involved applicant or registrant; the name and address of any other involved applicant's attorney or other authorized representative, if any; the mark, goods and/or services, application filing date, application serial number, and claimed territory of any other involved application (if the application is unrestricted, the claimed territory will be described in the notice as "The entire United States"); the mark, goods and/or services, registration filing and issue date, registration number, and claimed territory of any other involved registration; and the name and address of any other involved party which is simply a common law concurrent user, i.e., does not own an involved application or registration of its mark.

The notices are sent to each involved applicant, in care of the applicant's attorney or other authorized representative, if any; to any involved user; and to any involved registrant. If an applicant is not represented by an attorney but the applicant has appointed a domestic representative, the Board will send the notice to the domestic representative unless the applicant has designated in writing another correspondence address. [Note 6.] In the case of an involved registration, the notice is sent to the registrant itself, or to the registrant's domestic representative if one is appointed, even if there is an attorney or other authorized representative of record in the application file after the mark has registered. [Note 7.]

If a party has provided the Office with an e-mail address, the notification may be transmitted via e-mail. [Note 8.] In any proceeding, an undelivered notice from the Board of the commencement of a proceeding may result in notice by publication in the Official Gazette, available for viewing at the USPTO's web site (<http://www.uspto.gov>). [Note 9.]

The Board no longer forwards a copy of each concurrent use applicant's involved application(s) with the notice to each party specified in the concurrent use application as an exception to applicant's claim of exclusive use. [Note 10.] The rules also dispense with the requirement that the concurrent use applicant provide the Board with copies of its concurrent use application, for service by the Board, on each excepted party. [Note 11.]

The concurrent use proceeding commences when the Board sends the notices to the parties, and sets the schedule for conferencing, disclosures, discovery, trial and briefing for those cases commenced on or after November 1, 2007. [Note 12.] Where a concurrent use proceeding has been commenced solely to order a registrant, named as an excepted user in the proceeding, to show cause why its registration should not be restricted to comply with a decision in a prior Board proceeding or with a court decree, the Board does not include a trial schedule when it sends the notices to the parties.

#### **NOTES:**

1. See 37 CFR § 2.99(d)(1) and 37 CFR § 2.119(a).
2. See 37 CFR § 2.99(d)(1).

3. *See* 37 CFR § 2.119.
4. Excepted users are those parties identified by the applicant as users who are exceptions to applicant's claim of exclusive right to use the mark under Trademark Act § 2(d), 15 U.S.C. § 1052(d).
5. *See* 37 CFR § 2.99(c).
6. *Cf.* 37 CFR § 2.105(c) and 37 CFR § 2.119(d).
7. *Cf.* 37 CFR § 2.113(c).
8. *See* 37 CFR § 2.99(c); Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243 (August 1, 2007). The parties may also, by prior agreement, meet their service obligations by utilizing electronic means such as fax or e-mail. 37 CFR § 2.119(b).
9. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42244 (August 1, 2007).
10. *See* 37 CFR § 2.99(d)(1).
11. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243 (August 1, 2007).
12. *Cf.* 37 CFR § 2.93.

### **1106.05 Locating Excepted Users**

It is the responsibility of the concurrent use applicant, which has the burden of proving its entitlement to concurrent registration, to provide information concerning the current address of each specified excepted user, as well as information concerning each user's use of its particular mark in its particular area or mode of use. [Note 1.] *See* TBMP §§ 1103.01(c)-(f) and TBMP § 1108. The address used by the Board in mailing the notice to a specified excepted user is the address provided by the concurrent use applicant in its application, unless the user itself owns an involved application or registration which includes an address more current than the one provided by the concurrent use applicant.

If a notice or other communication sent by the Board to a specified excepted user is returned as undeliverable, the concurrent use applicant will be required to investigate further and furnish the correct address. If the excepted user owns an application or registration, additional notice may be given by publication in the Official Gazette for the period of time prescribed by the Director. [Note 2.] If, however, the excepted user does not own an application or registration, unless and until the concurrent use applicant furnishes the correct address for the user, the proceeding cannot go forward. [Note 3.] Alternatively, if, upon further investigation, the concurrent use applicant learns that a specified excepted user has abandoned its use of its mark, the concurrent use applicant may file a motion to amend its application to delete reference to that user. The

motion should include an explanation of the facts that serve as the basis for the motion. If the motion is granted, the amendment will be entered, and the user in question will be dropped as a party to the proceeding. *See* TBMP § 1104. Should it come to applicant's attention that all excepted users have abandoned their mark or assigned them to applicant, applicant may file a motion to amend its application to delete the excepted users and to a geographically unrestricted registration. If such a motion is granted, the concurrent use proceeding will be dissolved and the application will be republished as a geographically unrestricted application.

If the owner of a registration is listed as an excepted user and the concurrent use applicant is unable, after reasonable investigation, to locate the registrant, applicant may file a petition to cancel the registration owned by the user on the ground of abandonment. The concurrent use proceeding will be suspended pending the outcome of the petition to cancel. If the Board grants the petition to cancel on the ground that the registrant has abandoned use of its mark with no intent to resume use, the concurrent use proceeding will be resumed. The concurrent use applicant may then file a motion to amend its application to delete reference to the registrant as an exception to applicant's exclusive right to use the mark in commerce, and to seek a geographically unrestricted registration of the mark, if there are no other excepted users listed. If the applicant and the Board are unable to locate the registrant, notice of the filing of the petition to cancel will be published in the Official Gazette. [Note 4.] If the registrant fails to appear within the thirty-day period of time allowed by the notice, default judgment will be entered against the registrant on the claim of abandonment and the petition to cancel will be granted. The concurrent use applicant may then file a motion to amend its application to delete reference to the registrant as an exception to applicant's exclusive right to use the mark in commerce, and to seek a geographically unrestricted registration of the mark if there are no other excepted users listed.

#### **NOTES:**

1. *See* 37 CFR § 2.42 and 37 CFR § 2.99(e).
2. 37 CFR § 2.118. The period of time allowed by the notice is typically thirty days.
3. *Cf.* 37 CFR § 2.99(d)(1), which requires the concurrent use applicant to notify the Board of any service copy that has been returned to the concurrent use applicant as undeliverable, within ten days of applicant's receipt of the returned service copy.
4. *See* 37 CFR § 2.118.

#### **1107 Answer; Default**

There is no complaint in a concurrent use proceeding. *Cf.* TBMP § 1003. Instead, there is a notice which informs the parties of the institution of the proceeding, supplies information concerning the filing and due date of an "answer" to the notice, and sets conferencing, disclosure, discovery, trial, and briefing dates for those cases commenced on or after November 1, 2007. [Note 1.] Where a concurrent use proceeding has been commenced solely to order a registrant, named as an excepted user in the proceeding, to show cause why its registration

should not be restricted to comply with a decision in a prior Board proceeding or with a court decree, the Board does not include a trial schedule when it sends the notices to the parties. The notice takes the place of a complaint to the extent that it informs every specified person of the scope of the concurrent registration sought by each concurrent use applicant, and the extent of each concurrent use applicant's acknowledgment of the concurrent rights of others -- i.e., the essence of what each concurrent use applicant intends to prove at trial. *See* TBMP §§ 1103.01(c)-(f) and TBMP § 1106.

The Board no longer sends a copy of each involved concurrent use application with the notice to every person specified in the application. Instead, within ten days from the date of the Board's notification, the applicant for concurrent use registration must serve copies of its application, specimens and drawing on each excepted user identified as a concurrent user in the application for registration, and file with the Board proof of proper service of the copies. Copies of the served documents themselves should not be filed with the Board. The contents of the application file may also be viewed at the USPTO web site (<http://www.uspto.gov>). The concurrent use applicant must notify the Board within ten days of the date of receipt of a returned service copy, or of the date on which applicant learns that service has been ineffective. [Note 2.] *See* TBMP § 1103.01(f) and TBMP § 1106.04.

The "answer" in a concurrent use proceeding is a response to the notice. In the "answer," the answering party sets forth its position with respect to the registration(s) sought by the concurrent use applicant(s). [Note 3.]

An answer to the notice is not required of an applicant or registrant whose application or registration is involved in the proceeding, but such a party may file an answer if it so desires. *See* TBMP § 1104. Any other party specified as a concurrent user, e.g., a common law user, or a specified party who owns an application for an unrelated mark, which is not involved in the proceeding, and thus stands in the position of a common law user, must file an answer to avoid default. Any answer must be filed within 40 days after the mailing date of the notice, or within an extension of time for that purpose. *See* TBMP § 501 and TBMP § 509. [Note 4.]

If a party that is required, under 37 CFR § 2.99(d)(2), to file an answer fails to do so, judgment will be entered against that party precluding the party from claiming any right more extensive than that acknowledged by applicant in the involved concurrent use application(s). However, each concurrent use applicant still will have the burden of proving its entitlement to the registration(s) sought as against every party specified in its application(s), including any party against which default judgment for failure to answer has been entered. *See* TBMP § 1108. That is, the concurrent use applicant still will have to prove that there will be no likelihood of confusion by reason of the concurrent use by the parties of their respective marks, and, where necessary, that the parties have become entitled to use their marks as a result of their concurrent lawful use in commerce prior to the applicable date specified in Trademark Act § 2(d), 15 U.S.C. § 1052(d) [usually, this means use in commerce prior to the earliest application filing date of the application(s), or 1946 Act registration(s) (if any), involved in the proceeding (or prior to July 5, 1947, in the case of an involved registration under the Acts of 1881 or 1905)]. [Note 5.] *See* TBMP § 1103.01(b). Moreover, if, after the entry of default judgment against a party for failure to answer, the concurrent use applicant seeks to amend its application to narrow the extent of the

concurrent rights conceded therein to the defaulting party, the defaulting party will be allowed an opportunity to object thereto. If the amendment is permitted, the defaulting party will be allowed to contest the registration sought by the applicant, to the extent that the applicant claims a greater right, as against the defaulting party, than that previously claimed.

When default judgment for failure to file an answer is entered against a party to a concurrent use proceeding, the Board does not continue to send copies of all of the communications issued by the Board in the proceeding to that party, nor do the other parties to the proceeding need to continue serving copies of all papers which they file in the proceeding on the defaulting party. However, a copy of the Board's final decision in the case will be mailed to the defaulting party. Moreover, any request by the concurrent use applicant to amend its application to narrow the extent of the concurrent rights conceded therein to the defaulting party must be served upon that party. If the amendment is permitted, the Board will send a copy of its action on the request, and copies of all further communications issued by the Board in the proceeding, to the defaulting party, provided the Board has a serviceable address. Similarly, after approval of such an amendment, copies of all further papers filed by the other parties to the proceeding should be served on the defaulting party.

If a concurrent use proceeding involves only the concurrent use applicant and one or more specified common law excepted users which do not have an involved application or registration, and default judgment for failure to answer is entered against every specified user, applicant may prove its entitlement to registration as against the defaulting users by an “ex parte” type of showing. See TBMP § 1108 for information on how to prove entitlement by making an “ex parte” showing.

#### **NOTES:**

1. See Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243 (August 1, 2007).
2. See 37 CFR § 2.99(d)(1) and 37 CFR § 2.119.
3. See, e.g., *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1225-26 (TTAB 1993); *Fleming Companies v. Thriftway Inc.*, 21 USPQ2d 1451, 1453 (TTAB 1991), *aff'd*, 809 F. Supp. 38, 26 USPQ2d 1551 (S.D. Ohio 1992); *Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723 (TTAB 1990); *Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305, 1307 (TTAB 1984); *Ole' Taco Inc. v. Tacos Ole, Inc.*, 221 USPQ 912, 916 (TTAB 1984).
4. See 37 CFR § 2.99(d)(2); *Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305, 1307 (TTAB 1984) (concurrent use applicant may amend its application to one seeking an unrestricted registration upon showing that concurrent user has discontinued use of its mark, and not merely abandoned its application for registration).
5. See 37 CFR § 2.99(d)(3). See also *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1229 (TTAB 1993); *Precision Tune Inc. v. Precision Auto-Tune Inc.*, 4 USPQ2d 1095, 1096 (TTAB 1987); *Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305, 1307 (TTAB

1984).

## **1108 Issue in Concurrent Use Proceeding; Burden of Proof**

**37 CFR § 2.99(e)** *The applicant for a concurrent use registration has the burden of proving entitlement thereto. If there are two or more applications for concurrent use registration involved in a proceeding, the party whose application has the latest filing date is the junior party. A party whose application has a filing date between the filing dates of the earliest involved application and the latest involved application is a junior party to every party whose involved application has an earlier filing date. If any applications have the same filing date, the application with the latest date of execution will be deemed to have the latest filing date and that applicant will be the junior party. A person specified as an excepted user in a concurrent use application but who has not filed an application shall be considered a party senior to every party that has an application involved in the proceeding.*

**37 CFR § 2.116(b)** *... A party that is a junior party in an interference proceeding or in a concurrent use registration proceeding shall be in the position of plaintiff against every party that is senior, and the party that is a senior party in an interference proceeding or in a concurrent use registration proceeding shall be a defendant against every party that is junior.*

The issue to be determined in a concurrent use proceeding is the entitlement of the concurrent use applicant(s) to the registration(s) sought, and the extent, if any, to which every other involved application or registration should be restricted as a result thereof. The Board does not determine the right to registration of a party that is included in the proceeding only as a common law concurrent user (i.e., a party that does not own an involved application or registration). The specific territorial rights to which any common law users are entitled are not before the Board except to the extent that their rights may be limited by the territorial rights to which applicant proves entitlement. Any registration rights of a common law user can be determined only if such user were to file an application seeking concurrent registration and a concurrent use proceeding is instituted involving such application. [Note 1.]

Each applicant for concurrent registration has the burden of proving its entitlement thereto as against every other party specified in its application as an exception to its claim of exclusive right to use. [Note 2.] See TBMP § 1104. That is, a concurrent use applicant must prove that there will be no likelihood of confusion by reason of the concurrent use by the parties of their respective marks, and that the parties have become entitled to use their marks as a result of their concurrent lawful use in commerce prior to the applicable date specified in Trademark Act § 2(d), 15 U.S.C. § 1052(d) [usually, this means use in commerce prior to the earliest application filing date of the application(s), or 1946 Act registration(s) (if any), involved in the proceeding (or prior to July 5, 1947, in the case of an involved registration under the Acts of 1881 or 1905)]. [Note 3.] See TBMP § 1103.01(b) and TBMP § 1103.01(d)(2).

Any other party may attempt to prove any ground or basis for refusal of registration to the concurrent use applicant that may be asserted with respect to an application for an unrestricted registration in an opposition proceeding, as well as other matters, such as, that the concurrent use applicant is entitled to a concurrent registration covering only some of the area specified in its

application; that the concurrent use applicant is not entitled to registration at all because it is a bad faith junior user; that applicant does not meet the jurisdictional requirement of use of its involved mark prior to the applicable date specified in Trademark Act § 2(d), *see* TBMP § 1103.01(b); or that applicant's use of its mark is unlawful. [Note 4.]

In a concurrent use proceeding, a junior party stands in the position of plaintiff, in that it is the applicant-plaintiff that is seeking to reduce the geographic area of the senior party-defendant, thereby making the senior party stand in the position of defendant. [Note 5.] When there are two or more concurrent use applications involved in a concurrent use proceeding, the party whose application has the latest filing date is the junior party. A party whose application has a filing date between the filing dates of the earliest involved application and the latest involved application is a junior party to every party whose involved application has an earlier filing date. If any applications have the same filing date, the application with the latest date of execution will be deemed to have the latest filing date, and that applicant will be the junior party. A party which is specified in an involved concurrent use application as an excepted user, but which does not have an involved application, shall be considered a party senior to every party that has an application involved in the proceeding. [Note 6.]

**Ex Parte Showing:** When a concurrent use proceeding involves only the concurrent use applicant and one or more specified common law excepted users which do not have an involved application or registration, and default judgment for failure to answer is entered against every specified user, applicant still has the burden of proving its entitlement to the registration sought, i.e., that there exists no likelihood of confusion among consumers by reason of the concurrent use by the parties of their respective marks. [Note 7.]

In such case, the concurrent use applicant may prove its entitlement by making an ex parte showing. The availability of making an ex parte showing allows a concurrent use applicant the right to prove its entitlement to registration by less formal procedures (such as by the submission of affidavit evidence) than those (such as depositions upon oral examination) normally required for the introduction of evidence in an inter partes proceeding. [Note 8.] Such a showing usually suffices if the concurrent use applicant can address many of the factors the Board looks at in settlement agreements. *See* TBMP § 1110. In such a case, the Board, instead of setting formal trial dates, simply allows the concurrent use applicant time in which to submit proof of its entitlement to registration. [Note 9.] In the event the concurrent use applicant fails to make a sufficient ex parte showing, judgment is entered against the concurrent use applicant, the concurrent use proceeding is dissolved and registration to the concurrent use applicant is refused.

## NOTES:

1. *See Terrific Promotions Inc. v. Vantex Inc.*, 36 USPQ2d 1349, 1353 (TTAB 1995); *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1230 (TTAB 1993); *Fleming Companies v. Thriftway Inc.*, 21 USPQ2d 1451, 1456 (TTAB 1991), *aff'd*, 809 F. Supp. 38, 26 USPQ2d 1551 (S.D. Ohio 1992) (the only issue properly before the Board in a concurrent use proceeding concerns the concurrent use applicant's entitlement to registration); *Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723, 1725 n.5 (TTAB 1990) (unless named as an exception by the concurrent use applicant, a third-party's application may not be joined in a concurrent use

proceeding for purposes of determining proper ownership thereof, but unnamed party may amend its application to seek concurrent registration, in which case such application would become subject to its own concurrent use proceeding); *The Pennsylvania Fashion Factory, Inc. v. Fashion Factory, Inc.*, 215 USPQ 1133, 1136 (TTAB 1982) (applicant entitled to concurrent registration despite knowledge of existence of other users of mark that came to applicant's attention after it began use of its mark).

2. See 37 CFR § 2.99(e); *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306, 1309 (Fed. Cir. 1987) (concurrent use applicant not entitled to registration because, despite the fact that it does not seek registration for entire trading area, when its entire trading area is taken into account, confusion with senior user's mark is likely); *CDS Inc. v. I.C.E.D. Management Inc.*, 80 USPQ2d 1572, 1583-4 (TTAB 2006) (entitlement may still be shown even where parties both advertise on the Internet); *Terrific Promotions Inc. v. Vantex Inc.*, 36 USPQ2d 1349, 1352 (TTAB 1995) (mention of concurrent user in two in-flight airline magazines did not prevent issuance of concurrent use registrations); *Big M. Inc. v. United States Shoe Corp.*, 228 USPQ 614, 616 (TTAB 1985) (concurrent use applicant did not prove entitlement to registration where parties failed to agree to limit actual use to territorial scope of proposed concurrent use registrations); *Ole' Taco Inc. v. Tacos Ole, Inc.*, 221 USPQ 912, 917 (TTAB 1984) (applicant entitled to area of actual use plus reasonable area of probable expansion); *Handy Spot Inc. v. J. D. Williams Co.*, 181 USPQ 351, 352 (TTAB 1974) (parties' "mere naked consent agreement" fails to prove entitlement). Cf. *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305, 1308 (Fed. Cir. 1988) (in case involving consent agreement regarding parties' use of their respective marks in different territories, overlapping advertising and customer solicitation did not mandate determination that there was a likelihood of confusion.).

3. See Trademark Act § 2(d), 15 U.S.C. § 1052(d); 37 CFR § 2.99(e); *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306, 1307 (Fed. Cir. 1987) (concurrent use registration refused where junior user admitted use of mark in trading area of senior user; likelihood of confusion in concurrent use proceeding is to be determined on basis of actual territorial use of the respective marks, and not with respect to geographic area "claimed" in the application for concurrent use registration); *Weiner King, Inc. v. Wiener King Corp.*, 615 F.2d 512, 204 USPQ 820, 832 (CCPA 1980); *CDS, Inc. v. I.C.E.D. Management, Inc.*, 80 USPQ2d 1572, 1581 (TTAB 2006) (registrant is entitled to registration covering the entire United States, "including areas of its use and non-use, subject only to the exception of geographic areas where the junior user can prove prior use"); *Fleming Companies v. Thriftway Inc.*, 809 F. Supp. 38, 26 USPQ2d 1551, 1553 (S.D. Ohio 1992) (party is entitled to concurrent use registration for a given territory only if the party actually used the mark in that territory prior to registration by the other party; plaintiff did not use mark in expanded territory prior to defendant's registration and therefore could not be "lawful" user), *aff'g* 21 USPQ2d 1451, 1455 (TTAB 1991); *Terrific Promotions Inc. v. Vantex Inc.*, 36 USPQ2d 1349, 1353 (TTAB 1995) (good faith second user that has vigorously expanded under mark given most of U.S.); *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1229 (TTAB 1993); *Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723, 1725 (TTAB 1990) (actual use in a territory is not necessary to establish rights in that territory and depends on a number of factors); *Pinocchio's Pizza Inc. v. Sandra Inc.*, 11 USPQ2d 1227, 1229 (TTAB 1989) (as a general rule prior user is entitled to registration covering entire U.S. except

for geographic area in which subsequent user has actually used the mark plus an area shown to be within the natural expansion of its business, but rule is not absolute); *Over the Rainbow, Ltd. v. Over the Rainbow, Inc.*, 227 USPQ 879, 884 (TTAB 1985) (primary concern in concurrent use proceeding is the avoidance of likelihood of confusion; applicant unable to establish its entitlement to registration in area claimed where senior user was national franchise); *Faces, Inc. v. Face's, Inc.*, 222 USPQ 918, 920 (TTAB 1983); *Ole' Taco Inc. v. Tacos Ole, Inc.*, 221 USPQ 912, 915 (TTAB 1984).

4. See *DataNational Corp v. Bell South Corp.*, 60 F.3d 1565, 35 USPQ2d 1554, 1557-59 (Fed. Cir. 1995) (the term "use" means use as a trademark; a concurrent use applicant may claim less than the entire country as the place of use but only when there is actual or potential concurrent use of the mark by another lawful user that is not likely to cause confusion, and where mark is generic in the non-claimed area, there can be no lawful user in the non-claimed area), *aff'g* 18 USPQ2d 1862 (TTAB 1991); *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1480 (Fed. Cir. 1990) (allegation of bad faith adoption and use of mark in U.S. subsequent to user's adoption in foreign country); *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306, 1308 (Fed. Cir. 1987) (a valid application cannot be filed at all without lawful use in commerce and for purposes of claim of concurrent rights, such lawful use must begin prior to the filing date of any application with which concurrent use is sought); *Fleming Companies v. Thriftway Inc.*, 809 F. Supp. 38, 26 USPQ2d 1551 (S.D. Ohio 1992) (junior user was not lawful user in that it did not lawfully use the mark in expanded territory prior to defendant's registration), *aff'g* 21 USPQ2d 1451, 1455 (TTAB 1991); *Women's World Shops Inc. v. Lane Bryant Inc.*, 5 USPQ2d 1985, 1988 (TTAB 1988) (plaintiff's use, albeit geographically remote, was not lawful because plaintiff had actual knowledge of defendant's prior use); *Pagan-Lewis Motors, Inc. v. Superior Pontiac, Inc.*, 216 USPQ 897, 899 (TTAB 1982) (applicant's first use was neither innocent nor in good faith since applicant had constructive notice of user's mark).

5. See 37 CFR § 2.116(b).

6. See 37 CFR § 2.99(e).

7. 37 CFR § 2.99(d)(3).

8. See *Precision Tune Inc. v. Precision Auto-Tune Inc.*, 4 USPQ2d 1095, 1096 (TTAB 1987) (affidavit of officer of concurrent use applicant submitted vis-à-vis defaulted users). See also *Fleming Companies v. Thriftway Inc.*, 21 USPQ2d 1451, 1456 (TTAB 1991), *aff'd*, 809 F. Supp. 38, 26 USPQ2d 1551 (S.D. Ohio 1992).

9. For an example of proof of entitlement to concurrent registration in such a situation, see *Precision Tune Inc. v. Precision Auto-Tune Inc.*, 4 USPQ2d 1095, 1096 (TTAB 1987) (affidavit of officer of concurrent use applicant submitted vis-à-vis defaulted users).

## **1109 Conduct of Proceeding**

Once commenced, a concurrent use proceeding is conducted in the same general manner as an opposition or cancellation proceeding, except that, inter alia, there is no complaint (see TBMP

§ 1106.04 and TBMP § 1107), and thus no motions relating to the complaint, and the “answer” is not an answer in the usual sense of the word, and is not always required. *See* TBMP § 1107. For cases commenced on or after November 1, 2007, the parties are subject to disclosure and conferencing obligations. The issue to be decided by the Board is the entitlement of the concurrent use applicant(s) to the registration(s) sought, and the extent, if any, to which every other involved application or registration should be restricted as a result thereof. *See* TBMP § 1108. If an answer, when required, is not filed, default judgment is entered against the non-answering party, precluding that party from claiming any right more extensive than that acknowledged in the involved concurrent use application(s), but each concurrent use applicant will still have the burden of proving its entitlement to the registration(s) sought. *See* TBMP § 1107. In certain cases where default judgment is entered for failure to answer, a concurrent use applicant may be permitted to prove its entitlement to registration by less formal procedures than those normally required for the introduction of evidence in an inter partes proceeding. *See* TBMP § 1107.

In addition, parties may obtain expedited determination of concurrent use proceedings by stipulating to Accelerated Case Resolution (ACR). *See* TBMP § 528.05(a)(2) and TBMP § 702.04. However, and as noted above, in appropriate circumstances concurrent use cases may be resolved based upon an informal “ex parte” type of showing of entitlement to registration by applicant after default by common law excepted user(s) for failure to answer. *See* TBMP § 1108. As a result, concurrent use applicants are more likely to achieve expedited determination of concurrent use proceedings by means of the informal “ex parte” type of showing available only in such proceedings.

The order in which the parties offer evidence depends upon whether or not they own an involved application or registration, and, if two or more parties own an involved concurrent use application, the order in which the parties offer evidence also depends upon the filing dates of such applications. *See* TBMP § 1108.

In addition, for cases commenced on or after November 1, 2007, the conferencing, disclosure, trial and briefing schedule in a concurrent use proceeding involving three or more parties differs from that in an opposition or cancellation proceeding, because of the multiplicity of parties. Along with the concurrent use notice, the Board sends out an order setting dates in the case. Specifically, the Board sets a deadline for the discovery conference, disclosure dates, and the opening and closing date for discovery, and schedules testimony periods so that each party in the position of plaintiff will have a period for presenting its case in chief against each party in the position of defendant, each party in the position of defendant will have a period for presenting its case and meeting the case of each plaintiff, and each party in the position of plaintiff will have a period for presenting evidence in rebuttal. *See* TBMP § 701. The testimony periods are separated from the discovery period and from each other by 60-day intervals, with intervening deadlines for pretrial disclosures. Similarly, the Board schedules briefing periods so that each party in the position of plaintiff will have a period for filing a main brief on the case, each party in the position of defendant will have a period for filing a main brief and meeting the main brief of each plaintiff, and each party in the position of plaintiff will have a period for filing a reply brief. *See* TBMP § 801.02(e).

## 1109.01 Sample Trial Schedules - Cases Commenced On or After November 1, 2007

Set forth below is a sample trial and briefing schedule for a concurrent use proceeding involving parties A, B, C, D, and E, where A, B, C, and D are all concurrent use applicants, A's application has the latest filing date, B's application has the next-latest filing date, C's application has the next-latest filing date, D's application has the earliest filing date, and E is a specified concurrent user which does not own an involved application or registration (the trial and briefing schedule would look the same if E were a concurrent use applicant whose application had the earliest filing date, or if E owned an involved registration):

|  |            |
|--|------------|
| Mailing Date                             | 6/1/2010   |
|  |            |
| Time to Answer                           | 7/11/2010  |
| Deadline for Discovery Conference        | 8/10/2010  |
| Discovery Opens                          | 8/10/2010  |
| Initial Disclosures Due                  | 9/9/2010   |
| Expert Disclosures Due                   | 1/7/2011   |
| Discovery Closes                         | 2/6/2011   |
| A's Pretrial Disclosures Due             | 3/23/2011  |
| A's 30-day Trial Period Ends             | 5/7/2011   |
| B's Pretrial Disclosures Due             | 5/22/2011  |
| B's 30-day Trial Period Ends             | 7/6/2011   |
| C's Pretrial Disclosures Due             | 7/21/2011  |
| C's 30-day Trial Period Ends             | 9/4/2011   |
| D's Pretrial Disclosures Due             | 9/19/2011  |
| D's 30-day Trial Period Ends             | 11/3/2011  |
| E's Pretrial Disclosures Due             | 11/18/2011 |
| E's 30-day Trial Period Ends             | 1/2/2012   |
| A's Rebuttal Disclosures Due             | 1/17/2012  |
| A's 15-day Rebuttal Period Ends          | 2/16/2012  |
| B's Rebuttal Disclosures Due             | 3/2/2012   |
| B's 15-day Rebuttal Period Ends          | 4/1/2012   |
| C's Rebuttal Disclosures Due             | 4/16/2012  |
| C's 15-day Rebuttal Period Ends          | 5/16/2012  |
| D's Rebuttal Disclosures Due             | 5/31/2012  |
| D's 15-day Rebuttal Period Ends          | 6/30/2012  |
|  |            |
| Briefs on Final Hearing (37 CFR § 2.128) |            |
| shall become due as follows:             |            |
|  |            |

|  |            |
|--|------------|
| BRIEF FOR A is due                             | 8/29/2012  |
|  |            |
| BRIEF FOR B is due                             | 9/28/2012  |
|  |            |
| BRIEF FOR C is due                             | 10/28/2012 |
|  |            |
| BRIEF FOR D is due                             | 11/27/2012 |
|  |            |
| BRIEF FOR E is due                             | 12/27/2012 |
|  |            |
| REPLY BRIEFS, if any, shall be due as follows: |            |
| REPLY BRIEF FOR A is due                       | 1/11/2013  |
|  |            |
| REPLY BRIEF FOR B is due                       | 1/26/2013  |
|  |            |
| REPLY BRIEF FOR C is due                       | 2/10/2013  |
|  |            |
| REPLY BRIEF FOR D is due                       | 2/25/2013  |

Set forth below is another sample trial and briefing schedule for a concurrent use proceeding involving parties X, Y, and Z, where X is a concurrent use applicant, Y owns a registration which is involved in the proceeding, and Z is a specified concurrent user which does not own an involved application or registration:

|                                   |            |
|-----------------------------------|------------|
| Mailing Date                      | 6/1/2010   |
|                                   |            |
| Time to Answer                    | 7/11/2010  |
| Deadline for Discovery Conference | 8/10/2010  |
| Discovery Opens                   | 8/10/2010  |
| Initial Disclosures Due           | 9/9/2010   |
| Expert Disclosures Due            | 1/7/2011   |
| Discovery Closes                  | 2/6/2011   |
| X's Pretrial Disclosures Due      | 3/23/2011  |
| X's 30-day Trial Period Ends      | 5/7/2011   |
| Y's Pretrial Disclosures Due      | 5/22/2011  |
| Y's 30-day Trial Period Ends      | 7/6/2011   |
| Z's Pretrial Disclosures Due      | 7/21/2011  |
| Z's 30-day Trial Period Ends      | 9/4/2011   |
| X's Rebuttal Disclosures Due      | 9/19/2011  |
| X's 15-day Rebuttal Period Ends   | 10/19/2011 |

|  |            |
|--|------------|
| Briefs on Final Hearing (37 CFR § 2.128)       |            |
| shall become due as follows:                   |            |
| BRIEF FOR X is due                             | 12/18/2011 |
|  |            |
| BRIEF FOR Y is due                             | 1/17/2012  |
|  |            |
| BRIEF FOR Z is due                             | 2/16/2012  |
|  |            |
| REPLY BRIEFS, if any, shall be due as follows: |            |
| REPLY BRIEF FOR X is due                       | 3/2/2012   |

The trial and briefing schedule set forth immediately above would look the same if Y and Z were both specified concurrent users that did not own an involved application or registration. If X, Y, and Z were all concurrent use applicants, there would be a separate testimony period and pretrial disclosure due date for each party, and X and Y would each have a separate rebuttal testimony period; each party would also be allowed time to file a brief on the case, but only X and Y would be allowed time in which to file a reply brief.

Set forth below is a sample trial and briefing schedule used where A is a concurrent use applicant, and B, C, and D are named excepted users, none of which own a registration or pending trademark application. In this case, the trial schedule is issued only after the date for answer has passed, and if a defending user fails to file an answer, it will not be included on the schedule.

|                                   |            |
|-----------------------------------|------------|
| Deadline for Discovery Conference | 8/10/2010  |
| Discovery Opens                   | 8/10/2010  |
| Initial Disclosures Due           | 9/9/2010   |
| Expert Disclosures Due            | 1/7/2011   |
| Discovery Closes                  | 2/6/2011   |
| A's Pretrial Disclosures          | 3/23/2011  |
| A's 30-day Trial Period Ends      | 5/7/2011   |
| B's Pretrial Disclosures          | 5/22/2011  |
| B's 30-day Trial Period Ends      | 7/6/2011   |
| C's Pretrial Disclosures          | 7/21/2011  |
| C's 30-day Trial Period Ends      | 9/4/2011   |
| D's Pretrial Disclosures          | 9/19/2011  |
| D's 30-day Trial Period Ends      | 11/3/2011  |
| A's Rebuttal Disclosures          | 11/18/2011 |
| A's 15-day Rebuttal Period Ends   | 12/18/2011 |

With the exceptions noted above, the practices and procedures in cases commenced on or after November 1, 2007 for conducting discovery conferences, serving initial, expert, and pretrial disclosures, taking discovery, filing motions, introducing evidence, briefing the case, presenting oral arguments at final hearing, and seeking review of a decision of the Board, are essentially the same in a concurrent use proceeding as in an opposition or cancellation proceeding.

The practices and procedures for taking discovery, filing motions, introducing evidence, briefing the case, presenting oral arguments at final hearing, and seeking review of a decision of the Board, are essentially the same in a concurrent use proceeding as in an opposition or cancellation proceeding.

### **1110 Settlement Providing for Concurrent Registration**

Most concurrent use proceedings before the Board are not litigated to final decision on the merits, but rather are settled on the basis of an agreement between the parties which provides for the issuance to the concurrent use applicant(s) of the concurrent registration(s) sought. Such an agreement is usually filed by the concurrent use applicant(s) together with a request for issuance of the concurrent registration(s) sought.

The Board will not enter judgment on behalf of the concurrent use applicant(s), and find such applicant(s) entitled to concurrent registration on the basis of a settlement agreement, unless the terms of the agreement are sufficient to persuade the Board that confusion, mistake, or deception is not likely to result from the continued concurrent use by the parties of their marks. [Note 1.] If a concurrent use settlement agreement is determined to be insufficient, the Board generally will suspend proceedings and allow the parties time to submit a revised agreement correcting the deficiencies.

Traditionally, the geographic territories set forth in a concurrent use settlement agreement are mutually exclusive. Some additional provisions that may be included in settlement agreements are: (1) agreement by each party not to use or advertise in the geographical area of the other party; (2) agreement that the parties will take whatever steps are necessary to prevent actual confusion; (3) establishment of a “buffer zone” between the geographical areas of the parties; (4) recitation of any specific differences between the respective marks and goods of the parties; (5) information concerning any particular aspects of the goods, services or channels of trade which may help to preclude likelihood of confusion; (6) agreement by the parties to use distinctly different packaging, labeling, signs, or others marks in association with the subject marks; and (7) information as to the length and extent of concurrent use, and whether, in the experience of the parties, such use has resulted in any actual confusion. [Note 2.] These factors are not all inclusive, and the parties may include any other relevant facts in demonstrating that there is no likelihood of confusion arising from the parties’ concurrent use of similar marks in their respective geographical areas.

The Board is aware that the advent of Internet advertising increases the geographic scope of a party’s advertising. However, measures may be taken to reduce the possibility of consumer confusion with respect to such advertising. Examples include: a statement on each party's website that it is not affiliated with the other party or parties; a statement on the website

indicating the party's specific geographic area of use; and displaying the subject mark on the website in close association with another mark or trade name or in a certain form. [Note 3.]

If a settlement agreement does not include every party to the proceeding, each concurrent use applicant still will have the burden of proving its entitlement to registration as against every party to the proceeding that is not also a party to the agreement, even if a default judgment for failure to answer has been entered against a non-included party. [Note 4.]

## NOTES:

1. See Trademark Act § 2(d), 15 U.S.C. § 1052(d); *In re Beatrice Foods Co.*, 166 USPQ 431, 437 (CCPA 1970) (agreements worked out by the parties in good faith should be considered by the Board); *Fleming Companies Inc. v. Thriftway Inc.*, 21 USPQ2d 1451, 1454 (TTAB 1991) (concurrent use applicant not entitled to registration including expanded area of geographic use in view of agreement entered into by its predecessor), *aff'd*, 809 F. Supp. 38, 26 USPQ2d 1551 (S.D. Ohio 1992); *Holmes Oil Co. v Myers Cruizers of Mena Inc.*, 101 USPQ2d 1148, 1150 (TTAB 2011) (persuasiveness of otherwise traditional consent agreement provided in resolution of concurrent use proceeding depends on reasons given that confusion is not likely); *Precision Tune Inc. v. Precision Auto-Tune Inc.*, 4 USPQ2d 1095, 1096 (TTAB 1987) (agreement persuasive); *Meijer, Inc. v. Purple Cow Pancake House*, 226 USPQ 280, 282 (TTAB 1985) (initial agreement deficient in view of, inter alia, provision allowing for “spill over” advertising); *The Pennsylvania Fashion Factory, Inc. v. Fashion Factory, Inc.*, 215 USPQ 1133, 1136 (TTAB 1982) (agreement between parties to concurrent use proceeding sufficient to show applicant’s entitlement to registration; existence of other known users of the same mark as set forth in the final paragraph of the agreement does not render agreement as having been made in bad faith); *Handy Spot Inc. v. J. D. Williams Co.*, 181 USPQ 351, 352 (TTAB 1974) (mere naked agreement wherein parties have not delineated measures taken to preclude likelihood of confusion is not persuasive).

For further information concerning settlement agreements offered in a concurrent use proceeding as a basis for the issuance of the concurrent registration(s) sought, see *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305, 1308 (Fed. Cir. 1988) (agreements to be given “substantial weight”). Cf. *Houlihan v. Parliament Import Co.*, 921 F.2d 1258, 17 USPQ2d 1208, 1212 (Fed. Cir. 1990) (agreements entitled to “great weight;” although the agreement did not contain explicit provisions designed to avoid confusion or explicit statement that concurrent use of the marks would not cause confusion, the provisions in the agreement reflected recognition by parties that concurrent use by marks in their respective, albeit in contiguous geographic areas, would not cause likelihood of confusion).

2. See *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305, 1308 (Fed. Cir. 1988) (agreement between parties given substantial weight); *In re Beatrice Foods Co.*, 166 USPQ 431, 437 (CCPA 1970) (“there can be no better assurance of the absence of any likelihood of confusion, mistake or deception than the parties’ promises to avoid any activity which might lead to such likelihood.”); *Holmes Oil Co. v Myers Cruizers of Mena Inc.*, 101 USPQ2d 1148, 1150 (TTAB 2011) (traditional consent agreement considered in concurrent use proceeding where only applicant's registration was to be geographically restricted

found sufficient); *Precision Tune Inc. v. Precision Auto-Tune Inc.*, 4 USPQ2d 1095, 1096 (TTAB 1987) (agreement persuasive to show no likelihood of confusion); *The Pennsylvania Fashion Factory, Inc. v. Fashion Factory, Inc.*, 215 USPQ 1133, 1134-35 (TTAB 1982) (agreement sufficient; concurrent use registration granted). *Cf. Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305, 1307-08 (TTAB 1984) (settlement agreement rescinded; concurrent use registration denied).

3. *See CDS Inc. v. I.C.E.D. Management Inc.*, 80 USPQ2d 1572, 1583-4 (TTAB 2006) (entitlement may still be shown even where parties both advertise on the Internet).

4. *See Precision Tune Inc. v. Precision Auto-Tune Inc.*, 4 USPQ2d 1095, 1096 (TTAB 1987) (ex parte type showing permitted); *Fleming Companies v. Thriftway Inc.*, 21 USPQ2d 1451, 1456 (TTAB 1991), *aff'd*, 809 F. Supp. 38, 26 USPQ2d 1551 (S.D. Ohio 1992).

### **1111 Effect of Abandonment of Involved Application**

After the commencement of a concurrent use proceeding, if an applicant whose application is the subject of the proceeding abandons its application without the written consent of each adverse party, judgment will be entered against the concurrent use applicant, the proceeding will be dissolved and registration to applicant will be refused. *See* TBMP § 603.

Similarly, where the concurrent use proceeding involves two or more applicants, and one of the applicants files an abandonment of its application without the written consent of each party, judgment is entered against the applicant who filed the abandonment without the written consent of each party, the proceeding is dissolved as to that applicant and registration to such applicant is refused. *See* TBMP § 603. However, where the abandoning applicant reserves its rights to continue using its mark, and the abandoning applicant is also specified as an excepted user in any other application involved in the proceeding, while judgment is entered against the abandoning applicant, the applicant remains a party to the proceeding as a common law concurrent user. Every other applicant that has listed the abandoning applicant as an excepted user will retain the burden of proving its entitlement to registration in view of the acknowledged rights of the abandoning applicant. [Note 1.]

For further information regarding the effect of abandonment of an involved application in a concurrent use proceeding, *see* TBMP § 603.

#### **NOTES:**

1. *Cf. Fleming Companies Inc. v. Thriftway Inc.*, 21 USPQ2d 1451, 1453 (TTAB 1991) (although abandonment of application without written consent of every adverse party precludes common law user from claiming any right to federal registration, inasmuch as user reserved right to continue using mark, it will not be dropped as party to concurrent use proceeding), *aff'd*, 809 F. Supp. 38, 26 USPQ2d 1551 (S.D. Ohio 1992); *Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305, 1307-8 (TTAB 1984) (applicant not entitled to concurrent use registration where user abandoned application for mark but not its right to continue using mark).

## **1112 Effect of Adverse Decision in Opposition or Cancellation**

A party which receives an adverse decision, in an opposition, cancellation, or interference proceeding, on the issue of priority of use is not precluded thereby from seeking a concurrent use registration, unless its first use in commerce was subsequent to the earliest application filing date of any conflicting application or registration owned by another party to the opposition, cancellation, or interference proceeding, and that other party does not consent to the grant of a concurrent registration to the applicant. The concurrent use registration must be sought by filing a new application seeking concurrent use with the prevailing party before the Board. [Note 1.] See TBMP § 1103.01(b).

### **NOTES:**

1. See Trademark Act § 2(d), 15 U.S.C. § 1052(d); *Rosso and Mastracco, Inc. v. Giant Food Inc.*, 720 F.2d 1263, 219 USPQ 1050, 1053 (Fed. Cir. 1983) (counterclaim to cancel registration denied). Cf. *U.S. Soil, Inc. v. Colovic*, 214 USPQ 471, 472 (TTAB 1982) (opposition cannot proceed where it has been established through prior litigation that applicant has superior rights, and where opposer only alleges that it has rights in certain geographic areas); *Home Federal Savings & Loan Ass'n v. Home Federal Savings & Loan Ass'n of Chicago*, 205 USPQ 467, 469 (TTAB 1979); *Cook's Pest Control, Inc. v. Sanitas Pest Control Corp.*, 197 USPQ 265, 271 n.5 (TTAB 1977); and *Chichi's, Inc. v. Chi-Chi's, Inc.*, 222 USPQ 831, 832 (Comm'r 1984) (a decision in the cancellation proceeding adverse to respondent would not preclude respondent from filing a new application seeking concurrent registration with petitioner).

## **1113 “Conversion” of Opposition or Cancellation Proceeding to Concurrent Use Proceeding**

### **1113.01 Conversion of Opposition Proceeding**

In certain situations, an opposition proceeding may be “converted” into a concurrent use proceeding. In these cases, the opposition proceeding is not actually transformed into a concurrent use proceeding. Rather, the opposition is terminated, usually by dismissal without prejudice, in favor of the concurrent use proceeding. The concurrent use proceeding, in turn, is instituted immediately. In fact, notice of the institution of the concurrent use proceeding is normally included in the order terminating the opposition proceeding. [Note 1.] When this occurs, the party that was in the position of defendant in the opposition proceeding, i.e., the applicant, becomes the party in the position of plaintiff in the concurrent use proceeding and is referred to as the applicant. The party that was in the position of plaintiff in the opposition proceeding, i.e., the opposer, becomes the party in the position of defendant in the concurrent use proceeding and is referred to as the excepted user.

An opposition may be terminated in favor of a concurrent use proceeding in the situations described below:

(1) When an opposition to a concurrent use application is filed by a party specified in the application as an exception to applicant's claim of exclusive use, the opposition may be

dismissed without prejudice in favor of a concurrent use proceeding. [Note 2.] This action may be taken by the Board upon its own initiative, or upon motion.

(2) When an opposition to a concurrent use application is filed by a party that is not specified in the application as an exception to applicant's claim of exclusive use, the Board may grant a motion to dismiss the opposition without prejudice in favor of a concurrent use proceeding if opposer files an application for concurrent registration, naming applicant as an exception to its claim of exclusive use. However, the opposition will be suspended and not be dismissed, and the concurrent use proceeding will not be instituted, until opposer's concurrent use application is published in the Official Gazette for opposition, and no opposition is filed, or all oppositions filed are dismissed.

(3) When an opposition to a concurrent use application is filed by a party that is not specified in the application as an exception to applicant's claim of exclusive use, and the opposer does not file an application for concurrent registration, the Board may grant a motion to dismiss the opposition without prejudice in favor of a concurrent use proceeding if applicant amends its application to specify the opposer as an additional exception to its claim of exclusive use. The Board may grant applicant's amendment to add opposer as an excepted user and dismiss the opposition without prejudice in a single order.

(4) When an opposition is filed against an application for an unrestricted registration, the applicant may file a motion to amend its application to one for concurrent registration, reciting opposer as an exception to applicant's claim of exclusive use, together with a motion to terminate the opposition in favor of a concurrent use proceeding. If opposer consents to the amendment, the opposition will be dismissed without prejudice, and the concurrent use proceeding will be instituted. [Note 3.] If opposer does not consent to the amendment, but applicant consents to entry of judgment against itself with respect to its right to an unrestricted registration, judgment will be entered against applicant, in the opposition, with respect to applicant's right to an unrestricted registration; the amendment will be approved; and a concurrent use proceeding involving the amended application will be instituted, all in one Board action. [Note 4.]

#### **NOTES:**

1. *Cf.* 37 CFR § 2.99(c) (in effect providing, inter alia, that when a concurrent use application has been published in the Official Gazette for opposition, a concurrent use proceeding will not be instituted unless no opposition is filed, or unless all oppositions that are filed are dismissed or withdrawn).

2. *See Inland Oil & Transport Co. v. IOT Corp.*, 197 USPQ 562, 564 (TTAB 1977) (applicant's motion to dismiss opposition and institute concurrent use granted; party named as exception filed opposition against concurrent use application; by setting forth opposer as exception to applicant's exclusive right to use, applicant has, in effect, admitted that it is not entitled to unrestricted registration).

3. *See, e.g., Holmes Oil Co. v Myers Cruizers of Mena Inc.*, 101 USPQ2d 1148, 1149 n.1

(TTAB 2011) (parties stipulated to terminate opposition proceeding in favor of concurrent use proceeding and to an amendment of the application to state geographic restrictions).

4. See *Terrific Promotions Inc. v. Vanlex Inc.*, 36 USPQ2d 1349, 1350 (TTAB 1995) (opposer objected to amendment; judgment entered; concurrent use proceeding instituted); *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1229 (TTAB 1993); *Faces, Inc. v. Face's, Inc.*, 222 USPQ 918, 920 (TTAB 1983) (applicant accepted judgment in opposition; concurrent use proceeding instituted).

## **1113.02 Conversion of Cancellation Proceeding**

In appropriate situations, a cancellation proceeding may also be terminated in favor of a concurrent use proceeding, if one party has a concurrent use application reciting the adverse party in the cancellation proceeding as an exception to its claim of exclusive use; the application is published in the Official Gazette for opposition; and no opposition is filed, or all oppositions filed are dismissed or withdrawn. [Note 1.] See TBMP § 1112.

### **NOTES:**

1. See *Chichi's, Inc. v. Chi-Chi's, Inc.*, 222 USPQ 831, 832 (Comm'r 1984) (a decision in the cancellation proceeding adverse to respondent would not preclude respondent from filing a new application seeking concurrent registration with petitioner).

## **1114 Alteration of Restrictions on Concurrent Registration**

A concurrent registration may be issued only pursuant to the decision of the Board in a concurrent use proceeding, or on the basis of a final determination, by a court of competent jurisdiction, that more than one person is entitled to use the same or similar marks in commerce. See TBMP § 1102.02. A registration cannot be restricted territorially by amendment under Trademark Act § 7(e), 15 U.S.C. § 1057(e), and 37 CFR § 2.173(a). [Note 1.]

Further, a concurrent registrant that wishes to alter the restriction to its registration may only do so, if at all, through an appropriate decision in a new concurrent use proceeding before the Board, or by order of a court of competent jurisdiction. A Trademark Act § 7(e) amendment cannot be used to alter a concurrent use restriction. [Note 2.]

However, removal of such a restriction by amendment under Trademark Act § 7(e) may be permitted where an entity that was the only exception to registrant's right to exclusive use of its registered mark assigns its rights in its mark to registrant, so that all rights in the mark are merged in registrant. [Note 3.] Requests to record changes to a Trademark Act § 66(a), 15 U.S.C. § 1141f(a) registration must be filed with the International Bureau. The amendment is not made under Trademark Act § 7. [Note 4.] See TBMP § 514.01, for further information regarding amendments to Trademark Act § 66(a) registrations.

In addition, if every concurrent user specified in a concurrent registration abandons its use of its involved mark, and owns no subsisting registration thereof, the owner of the remaining

concurrent registration may file a new application for an unrestricted registration of the mark. [Note 5.] See TBMP § 1104.

**NOTES:**

1. See *Morgan Services Inc. v. Morgan Linen Services Inc.*, 12 USPQ2d 1841, 1843 (TTAB 1989); *In re Alfred Dunhill Ltd.*, 4 USPQ2d 1383, 1384 (Comm'r 1987); *In re Forbo*, 4 USPQ2d 1415, 1415 (Comm'r 1984).
2. See *Morgan Services Inc. v. Morgan Linen Services Inc.*, 12 USPQ2d 1841, 1843 (TTAB 1989) (amendments to registrations cannot be made under 37 CFR § 2.173); *In re Alfred Dunhill Ltd.*, 4 USPQ2d 1383, 1384 (Comm'r 1987) (so-called assignment of concurrent rights does not provide basis for deleting restriction listed in concurrent users' registration); *In re Forbo*, 4 USPQ2d 1415, 1416 (Comm'r 1984) (registrant may not request territorial restriction by way of petition to Commissioner).
3. See *In re Alfred Dunhill Ltd.*, 4 USPQ2d 1383, 1384 (Comm'r 1987) (assignment of rights resulted in removal of limitation on concurrent user's exclusive right to use).
4. See 37 CFR § 7.22.
5. Cf. *Fleming Companies Inc. v. Thriftway Inc.*, 21 USPQ2d 1451, 1453 (TTAB 1991) (although abandonment of application without written consent of every adverse party precludes common law user from claiming any right to federal registration, inasmuch as user reserved right to continue using mark, it will not be dropped as party to concurrent use proceeding), *aff'd*, 809 F. Supp. 38, 26 USPQ2d 1551 (S.D. Ohio 1992); *Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305, 1307-8 (TTAB 1984) (applicant not entitled to concurrent use registration where user abandoned application for mark but not its right to continue using mark).