CHAPTER 1100 CONCURRENT USE PROCEEDINGS

CONCURRENT USE PROCEEDINGS

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 Commissioner 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; (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 Commissioner 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 Commissioner 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. *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 Commissioner shall give notice to all parties and shall direct a Trademark Trial and Appeal Board to determine and decide the respective rights of registration. ...*

15 U.S.C. §1068. *In such proceedings the Commissioner 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 hereunder may be established in the proceedings: Provided, That in the case of the registration of any mark based on concurrent use, the Commissioner shall determine and fix the conditions and limitations provided for in subsection (d) of section 2 of this Act. ...*

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 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. *See, for example*, Sections 2(d), 17, and 18 of the Act, 15 U.S.C. §§1052(d), 1067, and 1068; *Houlihan v. Parliament Import Co.*, 921 F.2d 1258, 17 USPQ2d 1208 (Fed. Cir. 1990); *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306 (Fed. Cir. 1987); *Weiner King, Inc. v. Wiener King Corp.*, 615 F.2d 512, 204 USPQ 820 (CCPA 1980); *Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587 (TTAB 1995); *Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723 (TTAB 1990); *Pinocchio's Pizza Inc. v. Sandra Inc.*, 11 USPQ2d 1227 (TTAB 1989); *Women's World Shops Inc. v. Lane Bryant Inc.*, 5 USPQ2d 1985 (TTAB 1988); *Over the Rainbow, Ltd. v. Over the Rainbow, Inc.*, 227 USPQ 879 (TTAB 1985); and *Ole' Taco Inc. v. Tacos Ole, Inc.*, 221 USPQ 912 (TTAB 1984).

The Board's determination of registrability in a concurrent use proceeding is governed by Section 2(d) of the Act. That section provides, in part, that if the Commissioner (acting through the Board--*see* Section 17 of the Act, 15 U.S.C. §1067):

> ... 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--see: TBMP §1102.02(a)(2)). *See, for example, Fleming Companies v. Thriftway Inc.*, 26 USPQ2d 1551 (S.D.Ohio 1992); *Houlihan v. Parliament Import Co.*, 921 F.2d 1258, 17 USPQ2d 1208 (Fed. Cir. 1990); *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306 (Fed. Cir. 1987); *In re Beatrice Foods Co.*, 429 F.2d 466, 166 USPQ 431 (CCPA 1970); *Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587 (TTAB 1995); *DataNational Corp. v. BellSouth Corp.*, 18 USPQ2d 1862 (TTAB 1991); *Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723 (TTAB 1990); and *Over the Rainbow, Ltd. v. Over the Rainbow, Inc.*, 227 USPQ 879 (TTAB 1985).

1101.02 Context for PTO 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 PTO, the right to concurrent registration is determined by the Board. *See* Sections 2(d), 17, and 18 of the Act, 15 U.S.C. §§1052(d), 1067, and 1068. Concurrent rights are considered and determined by the Board only in the context of a concurrent use proceeding. *See, for example*, 37 CFR §§2.99(h) and 2.133(c); *Stock Pot Restaurant, Inc. v. Stockpot, Inc.*, 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984); *Mother's Restaurant Inc. v. Mama's Pizza, Inc.*, 723 F.2d 1566, 221 USPQ 394 (Fed. Cir. 1983); *Rosso & Mastracco, Inc. v. Giant Food Inc.*, 720 F.2d 1263, 219 USPQ 1050 (Fed. Cir. 1983); *Selfway, Inc. v. Travelers Petroleum, Inc.*, 579 F.2d 75, 198 USPQ 271 (CCPA 1978); *American Security Bank v. American Security and Trust Co.*, 571 F.2d 564, 197 USPQ 65 (CCPA 1978); *Giant Food Inc. v. Malone & Hyde, Inc.*, 522 F.2d 1386, 187 USPQ 374 (CCPA 1975); *Hollowform, Inc. v. Delma AEH*, 515 F.2d 1174, 185 USPQ 790 (CCPA 1975);

Snuffer & Watkins Management Inc. v. Snuffy's Inc., 17 USPQ2d 1815 (TTAB 1990); *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Village Inn Pizza Parlors, Inc. v. Los Tios Mexican Restaurants, Inc.*, 215 USPQ 476 (TTAB 1982); U.S. Soil, Inc. v. Colovic, 214 USPQ 471 (TTAB 1982); *May Department Stores Co. v. Prince*, 200 USPQ 803 (TTAB 1978); and *Zimmerman v. Holiday Inns of America, Inc.*, 123 USPQ 86 (TTAB 1959).

A registration cannot be restricted territorially by amendment under Section 7(e) of the Act, 15 U.S.C. §1057(e), and 37 CFR §2.173(a), nor may a Section 7(e) amendment generally be used to remove a concurrent use restriction from a registration. However, removal of a concurrent use restriction by amendment under Section 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. *See* TBMP §1113, and cases cited therein.

1101.03 Bases for Concurrent Registration

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

First, a concurrent registration may be issued when the Board has determined, in a concurrent use proceeding, that an applicant for concurrent registration is entitled thereto. *See* TBMP §1101.01, and authorities cited therein.

Second, a concurrent 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." *See* Section 2(d) of the Act, 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 (CCPA 1976); *Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 130 USPQ 412 (CCPA 1961), *cert. denied*, 369 U.S. 864, 133 USPQ 702 (1962); *Morgan Services Inc. v. Morgan Linen Services Inc.*, 12 USPQ2d 1841 (TTAB 1989); *In re Forbo*, 4 USPQ2d 1415 (Comm'r 1984); *In re Alfred Dunhill Ltd.*, 4 USPQ2d 1383 (Comm'r 1987); and *Chichi's, Inc. v. Chi-Chi's, Inc.*, 222 USPQ 831 (Comm'r 1984).

1102 Generation of Proceeding

1102.01 Means of Generation

A concurrent use proceeding before the Board may be generated only by way of an application for registration as a lawful concurrent user (hereafter referred to as a "concurrent use application"). *See Chichi's, Inc. v. Chi-Chi's, Inc.*, 222 USPQ 831 (Comm'r 1984); *Inland Oil & Transport Co. v. IOT Corp.*, 197 USPQ 562 (TTAB 1977); *Hollowform, Inc. v. Delma AEH*, 180 USPQ 284 (TTAB 1973), *aff'd*, 515 F.2d 1174, 185 USPQ 790 (CCPA 1975); Janet E. Rice, *TIPS FROM THE TTAB: Concurrent Use Applications and Proceedings*, 72 Trademark Rep. 403 (1982); and Rany L. Simms, *TIPS FROM THE TTAB: The Concurrent User as Opposer*, 67 Trademark Rep. 654 (1977). A concurrent use application is an application in which applicant (1) concedes that its use is not exclusive, (2) specifies the goods and/or services and area or mode of use for which it desires registration, (3) identifies, as exceptions to its claim of exclusive use, one or more persons (unrelated to applicant) which use the same or similar mark, for the same or similar goods or services, concurrently with applicant, and (4) provides, to the extent of the applicant's knowledge, certain information concerning use of the mark by each listed concurrent user. *See* Sections 1(a)(1)(A) and 2(d) of the Act, 15 U.S.C. §§1051(a)(1)(A) and 1052(d); 37 CFR §2.42; and TMEP §§202.04(c); 1207.04(b); and 1207.04(d). For further information concerning the requirements for a concurrent use application, *see* TBMP §1102.02.

There are two types of concurrent use applications, namely, the application seeking concurrent registration on the basis of a Board determination, in a prior or to-be-instituted concurrent use proceeding, of registrability; and the application seeking concurrent registration on the basis of a prior court determination of concurrent rights. These two types of concurrent use applications are the only means by which a geographically restricted registration may be obtained. *See* TBMP §§1101.02 and 1101.03. 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. *See In re Home Federal Savings & Loan Ass'n*, 213 USPQ 68 (TTAB 1982).

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--*see* 37 CFR §2.42, and TBMP §1102.02), the registration sought, if otherwise appropriate, will be issued based on the Board's prior decision. A new concurrent use proceeding before the Board will not be necessary, because of the legal principles of res

judicata and stare decisis. *Cf.* 37 CFR §2.99(f). For information concerning the requirements for an application seeking concurrent registration on the basis of the Board's decision in a prior concurrent use proceeding, *see* TBMP §1102.02(a)(4).

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. *See* 37 CFR §2.99(f). For information concerning the requirements for an application seeking concurrent registration on the basis of a prior court determination of concurrent rights, *see* TBMP §1102.02(b).

1102.02 Requirements for Concurrent Use Application

15 U.S.C. §1051(a) *The owner of a trademark used in commerce may apply to register his or her trademark under this Act on the principal register hereby established:*

(1) By filing in the Patent and Trademark Office--

(A) a written application, in such form as may be prescribed by the Commissioner, ... Provided, That in the case of every application claiming concurrent use the applicant shall state exceptions to his claim of exclusive use, in which he shall specify, to the extent of his knowledge, any concurrent use by others, the goods on or in connection with which and the areas in which each concurrent use exists, the periods of each use, and 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 Commissioner 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; (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 Commissioner 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 Commissioner 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(b) *An application under section 1(b) of the Act may not be amended so as to be treated as an application for a concurrent registration until an acceptable amendment to allege use under §2.76 or statement of use under §2.88 has been filed in the application, after which time such an amendment may be made, provided the application as amended satisfies the requirements of §2.42. The examiner 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) When it is determined that the mark is ready for publication, the applicant may be required to furnish as many copies of his application, specimens and drawing as may be necessary for the preparation of notices for each applicant, registrant or user specified as a concurrent user in the application for registration.

(c) Upon receipt of the copies required by paragraph (b) of this section, the examiner shall forward the application for concurrent use registration for publication in the Official Gazette as provided by §2.80. If no opposition is filed, or if all oppositions that are filed are dismissed or withdrawn, the Trademark Trial and Appeal Board shall prepare a notice for the applicant for concurrent use registration and for each applicant, registrant or user specified as a concurrent user in the application. The notices for the specified parties shall state the name and address of the applicant and of the applicant's attorney or other authorized representative, if any, together with the serial number and filing date of the application.

(d)(1) The notices shall be sent to each applicant, in care of his attorney or other authorized representative, if any, to each user, and to each registrant. A copy of the application shall be forwarded with the notice to each party specified in the application.

(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 mailing 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 mailing 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 Commisssioner 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 to register under section 1(b) of the Act of 1946 are subject to concurrent use registration proceedings only after an acceptable amendment to allege use under §2.76 or statement of use under §2.88 has been filed.

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

1102.02(a) Application Based on Board Determination

1102.02(a)(1) Application Must Assert Use in Commerce

CONCURRENT USE PROCEEDINGS

A basic requirement for any concurrent use application (whether it is to be based on a Board determination, through a concurrent use proceeding, of applicant's right to concurrent registration, or whether it is based 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. Section 2(d) of the Act, 15 U.S.C. §1052(d), provides, in pertinent part:

> [I]f the Commissioner 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 Commissioner 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*." (emphasis added)

See also 37 CFR §2.99(g), and *Fleming Companies v. Thriftway Inc.*, 26 USPQ2d 1551 (S.D.Ohio 1992) (use must be lawful).

If a concurrent use application is filed as an intent-to-use application under Section 1(b) of the Act, 15 U.S.C. §1051(b), rather than as a use application under Section 1(a) of the Act, 15 U.S.C. §1051(a), the application is void. *See* 37 CFR §2.99(g); TMEP §1207.04(b); and Marc A. Bergsman, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: Concurrent Use and Intent-to-Use Applications*, 83 Trademark Rep. 416 (1993). However, an intent-to-use application for an unrestricted registration may be amended to seek concurrent registration when an acceptable amendment to allege use under 37 CFR §2.76, or an acceptable statement of use under 37 CFR §2.88, has been filed in the application. *See* 37 CFR §2.73(b), and Marc A. Bergsman, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: Concurrent Use and Intent-to-Use Applications*, *supra*.

An application for registration under the provisions of Section 44 of the Act, 15 U.S.C. §1126, may not seek concurrent registration unless the application also includes, as a second basis for registration, an allegation of use in commerce pursuant to Section 1(a) of the Act. *See* TMEP §1207.04(b).

1102.02(a)(2) Jurisdictional Requirement

An application seeking concurrent registration based on a Board determination, through a concurrent use proceeding, of applicant's right thereto, must allege use in commerce "prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this 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." *See* Section 2(d) of the Act, 15 U.S.C. §1052(d). *See also Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306 (Fed. Cir. 1987); *In re Beatrice Foods Co.*, 429 F.2d 466, 166 USPQ 431 (CCPA 1970); *Morgan Services Inc. v. Morgan Services Inc.*, 12 USPQ2d 1841 (TTAB 1989); *My Aching Back Inc. v. Klugman*, 6 USPQ2d 1892 (TTAB 1988); *Over the Rainbow, Ltd. v. Over the Rainbow, Inc.*, 227 USPQ 879 (TTAB 1985); and *In re Home Federal Savings & Loan Ass'n*, 213 USPQ 68 (TTAB 1982). 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) (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).

This requirement is jurisdictional in nature. *See Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306 (Fed. Cir. 1987); *In re Beatrice Foods Co.*, 429 F.2d 466, 166 USPQ 431 (CCPA 1970); *Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587 (TTAB 1995); *Morgan Services Inc. v. Morgan Services Inc.*, 12 USPQ2d 1841 (TTAB 1989); *My Aching Back Inc. v. Klugman*, 6 USPQ2d 1892 (TTAB 1988); and *Over the Rainbow, Ltd. v. Over the Rainbow, Inc.*, 227 USPQ 879 (TTAB 1985). If it is not met, 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 if the owner of such application(s) or registration(s) consents to the grant of a concurrent registration to the applicant. *See* Section 2(d) of the Act, 15 U.S.C. §1052(d).

In addition, the jurisdictional requirement does not apply to 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. *See* TBMP §1102.02(b), and authorities cited therein.

1102.02(a)(3) Other Requirements

A concurrent use application must specify and contain all the elements required by those of the rules of practice in trademark cases preceding 37 CFR §2.42. *See* 37 CFR §2.42.

In addition, the applicant must:

(1) State in the application the area, goods and/or services, and (if applicable) mode of use for which applicant seeks registration--*see* 37 CFR §2.42. *See also* Section 1(a) of the Act, 15 U.S.C. §1051(a).

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), of the scope of the registration sought by applicant, and the extent of applicant's acknowledgment of the concurrent rights of others. *See* 37 CFR §§2.99(d)(1) and 2.99(d)(3); *In re Wells Fargo & Co.*, 231 USPQ 95 (TTAB 1986); and *In re El Chico Corp.*, 159 USPQ 740 (TTAB 1968). *See also Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224 (TTAB 1993).

The vast majority of concurrent use applications seek a registration which 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. For

example, if applicant believes that it is the prior user as against the other party or parties to the proceeding, applicant is likely, as the prior user, to seek registration for all of the United States except for the subsequent user's area of actual use and (possibly) natural expansion. 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 prior user to expand into all of the United States except for the subsequent user'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. *See, for example, Weiner King, Inc. v. Wiener King Corp.*, 615 F.2d 512, 204 USPQ 820 (CCPA 1980), and *Pinocchio's Pizza Inc. v. Sandra Inc.*, 11 USPQ2d 1227 (TTAB 1989). If the concurrent use applicant is a subsequent user, it normally will seek registration not only for its area of actual use but also for its area of natural expansion. 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 applicant 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. *See* Sections 15 and 33(b)(5) of the Act, 15 U.S.C. §§1065 and 1115(b)(5); *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630 (CCPA 1976); and *Thriftimart, Inc. v. Scot Lad Foods, Inc.*, 207 USPQ 330 (TTAB 1980).

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 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; etc. *See, for example, Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630 (CCPA 1976); *Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 130 USPQ 412 (CCPA 1961), *cert. denied*, 369 U.S. 864, 133 USPQ 702 (1962); *Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587 (TTAB 1995); and *In re Wells Fargo & Co.*, 231 USPQ 95 (TTAB 1986). 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. *See, for example,* Section 2(d) of the Act, 15 U.S.C. §1052(d); *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630 (CCPA 1976); and *Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 130

USPQ 412 (CCPA 1961), *cert. denied*, 369 U.S. 864, 133 USPQ 702 (1962). 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 likelihood of confusion from the continued concurrent use of the marks. *See* Section 2(d) of the Act, 15 U.S.C. §1052(d); *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630 (CCPA 1976); and *Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587 (TTAB 1995).

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. *See Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587 (TTAB 1995).

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. *See Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587 (TTAB 1995). If an applicant which 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. *See Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587 (TTAB 1995). For information concerning a claim for partial opposition or partial cancellation, i.e., a request to restrict, *see* TBMP §311.

(2) 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--*See* 37 CFR §2.42. *See also* Section 1(a) of the Act, 15 U.S.C. 1051(a); *Gallagher's Restaurants Inc, v. Gallagher's Farms*

Inc., 3 USPQ2d 1864 (TTAB 1986); *In re Wells Fargo & Co.*, 231 USPQ 106 (TTAB 1986); and *In re El Chico Corp.*, 159 USPQ 740 (TTAB 1968).

It is not necessary that an applicant for concurrent registration 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. *See Rosso & Mastracco, Inc. v. Giant Food Inc.*, 720 F.2d 1263, 219 USPQ 1050 (Fed. Cir. 1983), and *Pennsylvania Fashion Factory, Inc. v. Fashion Factory, Inc.*, 215 USPQ 1133 (TTAB 1982). *See also In re Sun Refining & Marketing Co.*, 23 USPQ2d 1072 (TTAB 1991). *Cf. SCOA Industries Inc. v. Kennedy & Cohen, Inc.*, 188 USPQ 411 (TTAB 1975).

(3) When it is determined that applicant's mark is ready for publication, applicant may also be required to furnish a copy of its application, specimens and drawing for each applicant, registrant or user specified in the application as a concurrent user--*see* 37 CFR §2.99(b). Cf.: 37 CFR §2.99(c).

The additional application copies required by 37 CFR §2.99(b) are used by the Board, when it institutes a concurrent use proceeding, to provide each specified concurrent user with information concerning 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. *See* TBMP §1105.

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.

For information concerning the examination, by the Trademark Examining Attorney, of a concurrent use application, *see* TMEP §§1207.04(d)(i) and 1207.04(d)(ii).

1102.02(a)(4) 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 §1102.02(a)(1), and authorities cited therein. The application must also specify and contain all the elements required by those of the rules of practice in trademark cases preceding 37 CFR §2.42; and must comply with the requirements of 37 CFR §2.42 (described in TBMP §1102.02(a)(3)), 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. *See* 37 CFR §2.42. In addition, the applicant should, of course, submit a copy of the Board decision upon which it relies.

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 (that is, seeks registration for the same or a more limited geographic area, or mode of use, and for substantially the same mark and 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), or seeks registration for the same or a more limited area, or mode of use, than that accorded to applicant in the prior decision, and for a mark and goods and/or services less similar to those of the other party or parties than applicant's mark and goods and/or services in the prior proceeding (*cf. Missouri Silver Pages Directory Publishing Corp. v. Southwestern Bell Media, Inc.*, 6 USPQ2d 1028 (TTAB 1988); *Carl Karcher Enterprises, Inc. v. Gold Star Chili, Inc.*, 222 USPQ 979 (TTAB 1983), *recon. denied*, 222 USPQ 727 (TTAB 1983); and *Place for Vision, Inc. v. Pearle Vision Center, Inc.*, 218 USPQ 1022 (TTAB 1983)); 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, of applicant's entitlement thereto, 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. *Cf.* 37 CFR §2.99(f). If any of the conditions is 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, through some happenstance, has not already been 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 sends out, with the notice of institution, 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 five conditions specified above are satisfied, so that a new concurrent use proceeding is not necessary, there is no need for applicant to furnish the extra copies of its application, specimens and drawing referred to by 37 CFR §2.99(b) (*cf.* TBMP §1102.02(a)(3)). 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 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 the five conditions are not all satisfied, so that a new concurrent use proceeding is necessary, applicant normally will be required, at least if its mark is determined to be ready for publication, to furnish as many copies of its application, specimens and drawing as may be necessary for the preparation of notices for each applicant, registrant or user specified as a concurrent user in the application. *See* 37 CFR §2.99(b). 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.

The Board does not determine, in a concurrent use proceeding, the right to concurrent registration of a party which is included in the proceeding only as a common law concurrent user, i.e., a party which does not own an involved application or registration. *See* TBMP §1107, and cases cited therein. A party which 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.

1102.02(b) Application Based on Court Determination

An application for concurrent registration on the basis of a final determination, by a court of competent jurisdiction, that applicant is entitled to concurrently use its mark in commerce, must assert use in commerce of the mark sought to be registered. *See* TBMP §1102.02(a)(1), and authorities cited therein. The

application must also specify and contain all the elements required by those of the rules of practice in trademark cases preceding 37 CFR §2.42; and must comply with the requirements of 37 CFR §2.42 (described in TBMP §1102.02(a)(3)), 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. *See* 37 CFR §2.42. In addition, the applicant must, of course, 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:

(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 (*see Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630 (CCPA 1976), and *Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 130 USPQ 412 (CCPA 1961), *cert. denied*, 369 U.S. 864, 133 USPQ 702 (1962)); 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 Commissioner in accordance with the court decree.

If any of the five conditions specified above is not satisfied, a concurrent use registration proceeding will be prepared and instituted. *See* 37 CFR §2.99(f), and T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, 74 Trademark Rep. 269 (1984). If the first four conditions are met, but an involved registration has not already been restricted by the Commissioner in accordance with the court decree, a concurrent use proceeding will be instituted solely for the purpose of restricting the involved registration in accordance with the court decree.

In such cases, the Board sends out, with the notice of institution, an order to 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 five conditions specified above are satisfied, so that a concurrent use proceeding is not necessary, there is no need for applicant to furnish the extra copies of its application, specimens and drawing referred to by 37 CFR §2.99(b) (*cf.* TBMP §1102.02(a)(3)). 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 the five conditions are not all satisfied, so that a concurrent use proceeding is necessary, applicant normally will be required, at least if its mark is determined to be ready for publication, to furnish as many copies of its application, specimens and drawing as may be necessary for the preparation of notices for each applicant, registrant or user specified as a concurrent user in the application. *See* 37 CFR §2.99(b). 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.

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 Section 2(d) of the Act, 15 U.S.C. §1052(d) (for information concerning the dates specified in Section 2(d) of the Act, *see* TBMP §1102.02(a)(2)). Similarly, such an application is *not* subject to the requirement that the Commissioner 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 Section 2(d) permitting the Commissioner 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 Section 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. *See Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630 (CCPA 1976), and TMEP §1207.04(d)(ii). *Cf. Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 130 USPQ 412 (CCPA 1961), *cert. denied*, 369 U.S. 864, 133 USPQ 702 (1962).

For information concerning the examination, by the Trademark Examining Attorney, of a concurrent use application, *see* TMEP §§1207.04(d)(i) and 1207.04(d)(ii).

1103 Parties to Proceeding; Involved Applications, Registrations

The parties to a concurrent use proceeding are the concurrent use applicant(s), and all of those persons listed in the concurrent use application(s) as exceptions to applicant's claim of exclusive use. The persons listed as exceptions may themselves own one or more Federal applications (either for concurrent registration, 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 (either for concurrent registration or for unrestricted registration), and/or one or more registrants, and/or one or more common law

concurrent users which do not own an involved application or registration. Often, the only parties to a concurrent use proceeding are the concurrent use applicant, and a common law user which does not own an involved application or registration. *See Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305 (TTAB 1984).

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. *See Gallagher's Restaurants Inc. v. Gallagher's Farms Inc.*, 3 USPQ2d 1864 (TTAB 1986). 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 which 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.

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 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 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 (*see Morgan Services Inc. v. Morgan Linen Services Inc.*, 12 USPQ2d 1841 (TTAB 1989)). 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), action on the subsequent unrestricted application will be suspended by the Trademark Examining Attorney (once the application is otherwise in condition for approval for publication) pending disposition of the concurrent use application(s). *See Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224 (TTAB 1993), and *Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723 (TTAB 1990). In the event that the concurrent use application(s) matures into concurrent registration(s), the concurrent registration(s) will be cited, under Section 2(d) of the Act, as a reference(s) against the subsequent unrestricted application. *See Georgia-Southern Oil Inc. v. Richardson, supra*. Alternatively, if the owner of the subsequent unrestricted application amends it to seek concurrent registration, the application will be published for opposition and, if no opposition is filed, or if all oppositions filed are dismissed, the application will be added to the concurrent use proceeding, if the amendment is filed early enough so that addition to the concurrent use proceeding is feasible, or will be the subject of a new concurrent use proceeding, if the amendment is not filed early enough. *See Pro-Cuts v. Schilz-Price Enterprises Inc.*, *supra*, and *Georgia-Southern Oil Inc. v. Richardson, supra*.

1104 Applications and Registrations Not Subject to Proceeding

37 CFR §2.73(b) *An application under section 1(b) of the Act may not be amended so as to be treated as an application for a concurrent registration until an acceptable amendment to allege use under §2.76 or statement of use under §2.88 has been filed in the application, after which time such an amendment may be made, provided the application as amended satisfies the requirements of §2.42. The examiner 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 to register under section 1(b) of the Act of 1946 are subject to concurrent use registration proceedings only after an acceptable amendment to allege use under §2.76 or statement of use under §2.88 has been filed.*

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. See Sections 26 and 46(b) of the Act of

1946; 37 CFR §2.99(g); and T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing,* 74 Trademark Rep. 269 (1984).

Applications to register under Section 1(b) of the Act, 15 U.S.C. §1051(b), i.e., intent-to-use applications, are subject to concurrent use proceedings only after an acceptable amendment to allege use under 37 CFR §2.76, or an acceptable statement of use under 37 CFR §2.88, has been filed. *See* 37 CFR §2.99(g). *Cf.* 37 CFR §2.73(b), and TBMP §1102.02(a)(1). If a concurrent use application is filed as an intent-to-use application under Section 1(b) of the Act, 15 U.S.C. §1051(b), rather than as a use application under Section 1(a) of the Act, 15 U.S.C. §1051(a), the application is void. *See* 37 CFR §2.99(g); TMEP §1207.04(b); and Marc A. Bergsman, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: Concurrent Use and Intent-to-Use Applications,* 83 Trademark Rep. 416 (1993).

An "incontestable registration," that is, a registration of a mark the right to use of which has become incontestable pursuant to Section 15 of the Act, 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. *See* Sections 15 and 33(b)(5) of the Act, 15 U.S.C. §§1065 and 1115(b)(5); *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630 (CCPA 1976); and *Thriftimart, Inc. v. Scot Lad Foods, Inc.*, 207 USPQ 330 (TTAB 1980).

1105 Commencement of Proceeding

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 §1102.02(a)(4), 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 §1102.02(b)), 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.

The application is then published, with the indicated statement, in the *Official Gazette* for opposition. If the application seeks concurrent registration on the basis of a court decree, meets the requirements of 37 CFR §2.99(f), and is not opposed, or all oppositions filed are dismissed, the application goes to issue without a concurrent use proceeding. *See* 37 CFR §2.99(f), and TBMP §1102.02(b). Similarly, if the application seeks concurrent registration on the basis of the Board's determination, in a prior concurrent use proceeding, of applicant's

entitlement thereto; meets the conditions described in TBMP §1102.02(a)(4); and is not opposed, or all oppositions filed are dismissed, the application goes to issue without a new concurrent use proceeding. *See* TBMP §1102.02(a)(4). *Cf.* 37 CFR §2.99(f), and TBMP §1102.02(b).

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, a concurrent use proceeding is instituted. *See* 37 CFR §2.99(c). Similarly, 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 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 §1102.02(a)(4), and the application is not opposed, or all oppositions filed are dismissed, a concurrent use proceeding is instituted. *See* 37 CFR §§2.99(c) and 2.99(f), and TBMP §§1102.02(a)(4) and 1102.02(b).

After the opposition period has expired, and no opposition is filed, or all oppositions filed are dismissed, the file of a concurrent use application which must go through a concurrent use proceeding before the Board is forwarded to the Board for institution of the proceeding. There is no fee for the institution of a concurrent use proceeding.

The Board obtains the files of all of the other applications and registrations, if any, to be included in the proceeding. 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; and then, if the application is published and survives the opposition period, add it to the proceeding, and change the proceeding position of its owner from that of common law user to applicant (c*f.* TBMP §§1103 and 1107).

When the Board has obtained the files of all other applications and registrations, if any, to be included in the proceeding, the Board prepares a notice for each party advising the party that the concurrent use proceeding is thereby instituted; 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 §1106); and allowing the party 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 (*see* 37 CFR §2.99(c)); 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 applicant, as reflected in its 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 registrant, as reflected in its 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. A copy of each concurrent use applicant's involved application(s) is forwarded with the notice to each party specified in the concurrent use application as an exception to applicant's claim of exclusive use. *See* 37 CFR §2.99(d)(1).

The concurrent use proceeding commences when the Board mails the notices to the parties. *Cf.* 37 CFR §2.93.

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. *See* 37 CFR §§2.42 and 2.99(e). *See also* TBMP §§1102.02(a)(3) and 1107. 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. Unless and until the concurrent use applicant does so, the proceeding cannot go forward. 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. *See* TBMP §1103.

1106 Answer

There is no complaint in a concurrent use proceeding. *Cf.* TBMP §1003. Instead, there is a notice which informs the parties to the proceeding of the institution thereof, supplies information concerning the filing of an "answer" to the notice, and specifies a due date therefor. In addition, the notice, (including the copy of each involved concurrent use application, which is mailed with the notice to every person specified in the application) 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 §§1102.02(a)(3) and 1105.

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). *See, for example, Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224 (TTAB 1993); *Fleming Companies v. Thriftway Inc.*, 21 USPQ2d 1451 (TTAB 1991), *aff'd*, 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 (TTAB 1984); *Ole' Taco Inc. v. Tacos Ole, Inc.*, 221 USPQ 912 (TTAB 1984); T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, 74 Trademark Rep. 269 (1984); and Janet E. Rice, *TIPS FROM THE TTAB: Concurrent Use Applications and Proceedings*, 72 Trademark Rep. 403 (1982).

An answer to the notice is not required of an applicant or registrant whose application or registration is involved in the proceeding (for information concerning which applications and registrations are involved in a concurrent use proceeding, *see* TBMP §1103), but such a party may file an answer if it so desires. Any other party specified as a concurrent user in an involved concurrent use

application must file an answer to avoid default. *See* 37 CFR §2.99 (d)(2). *See also Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305 (TTAB 1984), and T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, 74 Trademark Rep. 269 (1984). Any answer filed must be filed within 40 days after the mailing date of the notice, or within an extension of time for the purpose. *See* 37 CFR §2.99(d)(2). *See also* TBMP §§501 and 509. *Cf.* TBMP §316.

If a party which 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 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. 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 (*see* TBMP §1102.02(a)(2)), 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 Section 2(d) of the Act, 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)]. *See* 37 CFR §2.99(d)(3). *See also Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224 (TTAB 1993); *Precision Tune Inc. v. Precision Auto-Tune Inc.*, 4 USPQ2d 1095 (TTAB 1987); *Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305 (TTAB 1984); and T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, 74 Trademark Rep. 269 (1984). 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.

If a concurrent use proceeding involves only a concurrent use applicant and one or more specified common law concurrent users which do not have an involved application or registration, and default judgment for failure to answer is entered against every specified user, or applicant has entered into a persuasive settlement agreement with every party against which default judgment has not been entered,

applicant may prove its entitlement to registration as against the defaulting users by an "ex parte" type of showing. That is, applicant may 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. *See Precision Tune Inc. v. Precision Auto-Tune Inc.*, 4 USPQ2d 1095 (TTAB 1987). *See also Fleming Companies v. Thriftway Inc.*, 21 USPQ2d 1451 (TTAB 1991), *aff'd*, 26 USPQ2d 1551 (S.D.Ohio 1992). In such a case, the Board, instead of setting formal trial dates, simply allows the concurrent use applicant time (usually 60 days) in which to submit proof of its entitlement to registration. For an example of proof of entitlement to concurrent registration in such a situation, *see Precision Tune Inc. v. Precision Auto-Tune Inc., supra*.

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 to that party copies of all of the communications issued by the Board in the proceeding, nor do the other parties to the proceeding need to continue serving on the defaulting party copies of all papers which they file in the proceeding. However, a copy of the Board's final decision in the case is 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's action on the request, and copies of all further communications issued by the Board in the proceeding, will be sent to the defaulting party by the Board. 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.

1107 Issue; 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 which is included in the proceeding only as a common law concurrent user, i.e., a party which does not own an involved application or registration (for information concerning the parties to a concurrent use proceeding, and the applications and registrations involved therein, *see* TBMP §1103). *See Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224 (TTAB 1993), and *Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723 (TTAB 1990). *See also Fleming Companies v. Thriftway Inc.*, 21 USPQ2d 1451 (TTAB 1991), *aff'd*, 26 USPQ2d 1551 (S.D.Ohio 1992).

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. 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, where necessary (*see* TBMP §1102.02(a)(2)), 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 Section 2(d) of the Act, 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)]. *See, for example,* Section 2(d) of the Act, 15 U.S.C. §1052(d); 37 CFR §2.99(e); *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306 (Fed. Cir. 1987); *Fleming Companies v. Thriftway Inc.*, 21 USPQ2d 1451 (TTAB 1991), *aff'd*, 26 USPQ2d 1551 (S.D.Ohio 1992); *Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723 (TTAB 1990); *Faces, Inc. v. Face's, Inc.*, 222 USPQ 918 (TTAB 1983); *Ole' Taco Inc. v. Tacos Ole, Inc.*, 221 USPQ 912 (TTAB 1984); *Inland Oil*

& Transport Co. v. IOT Corp., 197 USPQ 562 (TTAB 1977); *Handy Spot Inc. v. J. D. Williams Co.*, 181 USPQ 351 (TTAB 1974); Janet E. Rice, *TIPS FROM THE TTAB: Concurrent Use Applications and Proceedings*, 72 Trademark Rep. 403 (1982); and Rany L. Simms, *TIPS FROM THE TTAB: The Concurrent User as Opposer*, 67 Trademark Rep. 654 (1977).

Any other party may attempt to prove any ground for refusal of registration which might be asserted with respect to an application for an unrestricted registration, 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 Section 2(d) of the Act, 15 U.S.C. §1052(d) (*see* TBMP §1102.02(a)(2)); that applicant's use of its mark is unlawful; etc. *See Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477 (Fed. Cir. 1990); *Fleming Companies v. Thriftway Inc.*, 21 USPQ2d 1451 (TTAB 1991), *aff'd*, 26 USPQ2d 1551 (S.D.Ohio 1992); *Women's World Shops Inc. v. Lane Bryant Inc.*, 5 USPQ2d 1985 (TTAB 1988); *Faces, Inc. v. Face's, Inc.*, 222 USPQ 918 (TTAB 1983); *Pagan-Lewis Motors, Inc. v. Superior Pontiac, Inc.*, 216 USPQ 897 (TTAB 1982); *Inland Oil & Transport Co. v. IOT Corp.*, 197 USPQ 562 (TTAB 1977); Janet E. Rice, *TIPS FROM THE TTAB: Concurrent Use Applications and Proceedings*, 72 Trademark Rep. 403 (1982); and Rany L. Simms, *TIPS FROM THE TTAB: The Concurrent User as Opposer*, 67 Trademark Rep. 654 (1977).

In a concurrent use proceeding, a junior party stands in the position of plaintiff, and a senior party stands in the position of defendant. *See* 37 CFR §2.116(b). 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. *See* 37 CFR §2.99(e). *See also* Janet E. Rice, *TIPS FROM THE TTAB: Concurrent Use Applications and Proceedings*, 72 Trademark Rep. 403 (1982).

1108 Conduct of Proceeding

Once commenced (*see* TBMP §1105), 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), and thus no motions relating to the complaint; the "answer" is not an answer in the usual sense of the word, and is not always required (*see* TBMP §1106); if an answer, when required, is not filed, default judgment is entered against the nonanswering 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 §1106); the issue 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 §1107); 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 filing dates of such applications (*see* TBMP §1107); and 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 §1106).

In addition, the trial and briefing schedule in a concurrent use proceeding involving three or more parties differs, because of the multiplicity of parties, from that in an opposition or cancellation proceeding. After the time for answer has passed, the Board sends out an order setting trial and briefing dates in the case (except in those default judgment situations where the concurrent use applicant is 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 §1106). Specifically, the Board sets a closing date for discovery (which opens when the notices of institution are served by the Board upon the parties), 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* 37 CFR §2.121(b)(2). *See also* TBMP §701. The testimony periods

are separated from the discovery period and from each other by 30-day intervals. 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).

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):

THE PERIOD FOR DISCOVERY TO CLOSE	: July 2, 1984
Testimony period for A to close (opening 30 days prior thereto)	: August 31, 1984
Testimony period for B to close (opening 30 days prior thereto)	: October 30, 1984
Testimony period for C to close (opening 30 days prior thereto)	: December 31, 1984
Testimony period for D to close (opening 30 days prior thereto)	: March 1, 1985
Testimony period for E to close (opening 30 days prior thereto)	: April 30, 1985
Rebuttal testimony period for A to close (opening 15 days prior thereto)	: June 14, 1985
Rebuttal testimony period for B to close (opening 15 days prior thereto)	: July 29, 1985

Rebuttal testimony period for C to close (opening 15 days prior thereto) : September 12, 1985

Rebuttal testimony period for D to close (opening 15 days prior thereto) : October 28, 1985

Briefs on final hearing (37 CFR 2.128) shall become due as follows:

Brief for A shall be due : December 27, 1985

Brief for B shall be due : January 26, 1986

Brief for C shall be due : February 25, 1986

Brief for D shall be due : March 27, 1986

Brief for E shall be due : April 26, 1986

Reply briefs, if any, shall be due as follows:

Reply brief for A shall be due : May 11, 1986

Reply brief for B shall be due : May 26, 1986

Reply brief for C shall be due : June 10, 1986

Reply brief for D shall be due : June 25, 1986

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:

THE PERIOD FOR DISCOVERY TO CLOSE : May 21, 1991

Testimony period for X to close (opening 30 days prior thereto) : July 22, 1991

Testimony period for Y to close (opening 30 days prior thereto	: September 20, 1991
Testimony period for Z to close (opening 30 days prior thereto)	: November 19, 1991
Rebuttal testimony period for X to close (opening 15 days prior thereto)	: January 3, 1992

Briefs on final hearing (37 CFR 2.128) shall become due as follows:

Brief for X shall be due	: March 3, 1992
Brief for Y shall be due	: April 2, 1992
Brief for Z shall be due	: May 4, 1992

Reply briefs, if any, shall be due as follows:

Reply brief for X shall be due	: May 19, 1992

The trial and briefing schedule set forth immediately above would look the same if Y and Z were both specified concurrent users which 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 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.

With the exceptions noted above, 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.

1109 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 in 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. *See* Section 2(d) of the Act, 15 U.S.C. §1052(d); *Meijer, Inc. v. Purple Cow Pancake House*, 226 USPQ 280 (TTAB 1985); *Handy Spot Inc. v. J. D. Williams Co.*, 181 USPQ 351 (TTAB 1974); and Janet E. Rice, *TIPS FROM THE TTAB: Concurrent Use Applications and Proceedings*, 72 Trademark Rep. 403 (1982). For 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 (Fed. Cir. 1988); *In re Beatrice Foods Co.*, 429 F.2d 466, 166 USPQ 431 (CCPA 1970); *Meijer, Inc. v. Purple Cow Pancake House, supra*; *Handy Spot Inc. v. J. D. Williams Co., supra*; and Janet E. Rice, *TIPS FROM THE TTAB: Concurrent Use Applications and Proceedings, supra*. *See also Houlihan v. Parliament Import Co.*, 921 F.2d 1258, 17 USPQ2d 1208 (Fed. Cir. 1990).

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 which is not also a party to the agreement, even if a default judgment for failure to answer has been entered against a nonincluded party. *See Precision Tune Inc. v. Precision Auto-Tune Inc.*, 4 USPQ2d 1095 (TTAB 1987).

1110 Effect of Abandonment of Involved Application

For information concerning the effect of the abandonment of an application which is a subject of a concurrent use proceeding, *see* TBMP §603.

1111 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 concurrent 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; that other party does not consent to the grant of a concurrent registration to the applicant; and concurrent registration is sought by way of a concurrent use proceeding before the Board. *See* Section 2(d) of the Act, 15 U.S.C. §1052(d); *Chichi's, Inc. v. Chi-Chi's, Inc.*, 222 USPQ 831 (Comm'r 1984); *U.S. Soil, Inc. v. Colovic*, 214 USPQ 471 (TTAB 1982); *Home Federal Savings & Loan Ass'n v. Home Federal Savings & Loan Ass'n of Chicago*, 205 USPQ 467 (TTAB 1979); and *Cook's Pest Control, Inc. v. Sanitas Pest Control Corp.*, 197 USPQ 265 (TTAB 1977). For information concerning the jurisdictional requirement of Section 2(d) of the Act, *see* TBMP §1102.02(a)(2).

1112 "Conversion" of Opposition to Concurrent Use 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 decision terminating the opposition proceeding. *See* Janet E. Rice, *TIPS FROM THE TTAB: Newest TTAB Rule Changes; More Tips on Concurrent Use Proceedings*, 76 Trademark Rep. 252 (1986). *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).

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. *See Inland Oil & Transport Co. v. IOT Corp.*, 197 USPQ 562 (TTAB 1977). 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 which 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 not be dismissed, and the concurrent use proceeding instituted, unless 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 which 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 applicant amends its application to specify the opposer as an additional exception to its claim of exclusive use.

(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. 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. *See Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224 (TTAB 1993); *Faces, Inc. v. Face's, Inc.*, 222 USPQ 918 (TTAB 1983); Marc A. Bergsman, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: Concurrent Use and Intent-to-Use Applications*, 83 Trademark Rep. 416 (1993); and Janet E. Rice, *TIPS FROM THE TTAB: Newest TTAB Rule Changes; More Tips on Concurrent Use Proceedings*, 76 Trademark Rep. 252 (1986). *See also* Janet E. Rice, *TIPS FROM THE TTAB: Concurrent Use Applications and Proceedings*, 72 Trademark Rep. 403 (1982),

and Rany L. Simms, *TIPS FROM THE TTAB: The Concurrent User as Opposer*, 67 Trademark Rep. 654 (1977) (NOTE: these two articles were written at earlier stages in the development of the Board's practice concerning termination of an opposition in favor of a concurrent use proceeding).

For information concerning the possible "conversion" of an opposition to a concurrent use proceeding when the opposed application is an intent-to-use application in which an amendment to allege use has not been filed, *see* Marc A. Bergsman, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: Concurrent Use and Intent-to-Use Applications*, 83 Trademark Rep. 416 (1993).

In appropriate situtations, 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.

1113 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 §1101.03, and authorities cited therein. A registration cannot be restricted territorially by amendment under Section 7(e) of the Act, 15 U.S.C. §1057(e), and 37 CFR §2.173(a). *See Morgan Services Inc. v. Morgan Linen Services Inc.*, 12 USPQ2d 1841 (TTAB 1989); *In re Forbo*, 4 USPQ2d 1415 (Comm'r 1984); and *In re Alfred Dunhill Ltd.*, 4 USPQ2d 1383 (Comm'r 1987).

Further, a concurrent registrant which wishes to alter the restriction to its registration ordinarily may do so, if at all, only through an appropriate decision in a new concurrent use proceeding before the Board, or a new civil action before a court of competent jurisdiction; a Section 7(e) amendment cannot be used to alter a concurrent use restriction. *See Morgan Services Inc. v. Morgan Linen Services Inc.*, 12 USPQ2d 1841 (TTAB 1989); *In re Forbo*, 4 USPQ2d 1415 (Comm'r 1984); and *In re Alfred Dunhill Ltd.*, 4 USPQ2d 1383 (Comm'r 1987).

However, removal of such a restriction by amendment under Section 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. *See In re Alfred Dunhill Ltd.,* 4 USPQ2d 1383 (Comm'r 1987).

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.