

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Baxley

Mailed: June 23, 2016

Opposition No. 91226641

West Broad Properties Fund, LLC, Series 2

v.

Strayhan Investments, Inc.

Cancellation No. 92060688

Nodding Head Brewery

v.

Strayhan Investments, Inc.

(as consolidated)

By the Trademark Trial and Appeal Board:

Strayhan Investments, Inc. (“Strayhan”) seeks a geographically restricted registration for the mark MONKEY KNIFE FIGHT in standard characters for “Beer, ale, lager, stout and porter; Beers” in International Class 32.¹ In the above-captioned opposition proceeding, West Broad Properties Fund, LLC, Series 2 (“Opposer”) opposes registration of Strayhan’s mark on the ground of likelihood of confusion with

¹ Application Serial No. 86543458, filed February 23, 2015, based on an assertion of use in commerce under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), and alleging July 1, 2006 as the date of first use anywhere and the date of first use in commerce. The concurrent use statement indicates that Applicant seeks a registration “within the United States excluding the city of Philadelphia, Pennsylvania” and names “CURT DECKER NODDING HEAD BREWERY” of Philadelphia, Pennsylvania as an exception to its exclusive use of the mark.

its previously used mark MONKEY KNIFE FIGHT for “Beer, ale, lager, stout, porter, [and] shandy.”² Strayhan, in its answer, denied the salient allegations of the notice of opposition and asserted affirmative defenses.

Strayhan also owns a geographically unrestricted registration for the same mark for the same goods.³ In Cancellation No. 92060688, Nodding Head Brewery (“Petitioner”) filed a petition to cancel that registration on grounds of likelihood of confusion with its previously used mark MONKEY KNIFE FIGHT for “Beer, ale, lagers” and fraud in the declaration of the application for that registration.

The cancellation proceeding was suspended in a March 25, 2015 order pending final determination of a concurrent use proceeding involving Strayhan’s involved concurrent use application. In that order, the Board presumed that Strayhan would either agree to entry of judgment against itself in the cancellation proceeding or to voluntarily surrender its registration. However, Strayhan has not agreed to judgment in the cancellation proceeding or surrendered its geographically unrestricted registration.

Because the above-captioned proceedings involve common questions of law or fact, the Board hereby orders their consolidation. *See* Fed. R. Civ. P. 42(a); *Regatta Sport*

² Opposer’s mark is the subject of geographically unrestricted application Serial No. 86757005, filed September 15, 2015, based on an assertion of use in commerce under Section 1(a), and alleging November 12, 2001 as the date of first use anywhere and date of first use in commerce.

³ Registration No. 4478085, issued February 4, 2014, with a June 28, 2013 constructive use filing date, and alleging July 1, 2006 as the date of first use anywhere and date of first use in commerce.

Ltd. v. Telux-Pioneer Inc., 20 USPQ2d 1154 (TTAB 1991); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991); TBMP § 511 (2015). The consolidated cases may be presented on the same record and briefs. *See Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989); *Hilson Research Inc. v. Society for Human Resource Management*, 26 USPQ2d 1423 (TTAB 1993).

The Board file will be maintained in Opposition No. 91226641 as the "parent" case. As a general rule, from this point onward, only a single copy of any submission should be filed herein. That copy should include all of the consolidated proceeding numbers in the caption thereof. Strayhan, however, should file its answer in the Board file for the cancellation proceeding at the appropriate time.

Despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleading; a copy of the decision shall be placed in each proceeding file.

On June 8, 2016, Strayhan filed a consented motion to convert the above-captioned opposition to a concurrent use proceeding. Therein, Strayhan contends that Petitioner is Opposer's predecessor-in-interest. Notwithstanding Opposer's consent, the Board elects to decide the motion to convert on the merits. *See TBMP § 502.04 (2015)*.

TBMP § 1113.01 states in relevant part as follows (citations omitted):

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. This action may be taken by the Board upon its own initiative, or upon motion.

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

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

(4) When an opposition is filed against an application for an unrestricted registration, the applicant may file a motion to amend its application to one for concurrent registration, reciting opposer as an exception to applicant's claim of exclusive use, together with a motion to terminate the opposition in favor of a concurrent use proceeding. If opposer consents to the amendment, the opposition will be dismissed without prejudice, and the concurrent use proceeding will be instituted. 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.

The first option is inapplicable to the circumstances herein. Petitioner, and not Opposer, named as the sole exception to Strayhan's claim of the exclusive use of the mark MONKEY KNIFE FIGHT in the involved concurrent use application. Although Opposer alleges that Petitioner is its predecessor-in-interest, there is no documentation which establishes any relationship between Petitioner and Opposer or chain of title in the MONKEY KNIFE FIGHT mark. *Cf.* Patent and Trademark Rule 3.73(b); TBMP § 512.

The second option is also inapplicable in this case. Although the record indicates that, on September 15, 2015, Opposer filed an application to register the mark MONKEY KNIFE FIGHT for "Beer, ale, lager, stout, porter, [and] shandy" in International Class 32, Opposer's application is geographically unrestricted and does not name Strayhan as an exception to its exclusive use of the mark. The third option is unavailable because Strayhan has not amended its application to specify Opposer as an additional excepted user. The fourth option is inapplicable because Strayhan's involved application is geographically restricted.⁴

Based on the foregoing, the motion to convert the above-captioned opposition proceeding to a concurrent use proceeding is denied. Proceedings herein are suspended for until September 1, 2016 to allow the parties time in which to take

⁴ A cancellation proceeding may also be terminated in favor of a concurrent use proceeding, if (1) one party has a concurrent use application reciting the adverse party in the cancellation proceeding as an exception to its claim of exclusive use; (2) the application is published in the Official Gazette for opposition; and (3) no opposition is filed, or all oppositions filed are dismissed or withdrawn. *See* TBMP § 1113.02. In view of the pendency of the above-captioned opposition, conversion of the cancellation to a concurrent use proceeding is also inappropriate.

Opposition No. 91226641

necessary steps to be able to convert one of the above-captioned proceedings to a concurrent use proceeding.