

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: August 24, 2016

Cancellation No. 92062555

Sweet P's Barbeque & Soul House, LLC

v.

Paul Dzubnar

Concurrent Use No. 94002698

Sweet P's Barbeque & Soul House, LLC

v.

Paul Dzubnar

Before Mermelstein, Bergsman and Heasley,
Administrative Trademark Judges.

By the Board:

On July 6, 2016, Petitioner filed the parties' joint motion to: (1) resume the above-captioned cancellation proceeding; (2) convert the cancellation to a concurrent use proceeding; and (3) accept the parties' concurrent use agreement. 12 TTABVUE.

A cancellation proceeding may 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. *See* TBMP § 1113.02 (2016).

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In this case, Petitioner, in its involved application Serial No. 86692033, seeks a concurrent use registration for the mark SWEET P'S in standard characters, for "Restaurant and catering services" in International Class 43, claiming exclusive right to use the mark "in the area comprising Colorado, Kansas, Missouri, Illinois, Indiana, Ohio, West Virginia, Virginia, Kentucky, Tennessee, North Carolina, South Carolina, Georgia, Florida, Alabama, Mississippi, Arkansas, Louisiana, Texas, Oklahoma, and New Mexico," and naming Respondent as an exception to its exclusive right to use. Petitioner's application has survived the opposition period and is ready to be considered in a concurrent use proceeding.

Respondent's involved Registration No. 4786688, the subject registration in the above-captioned cancellation proceeding, is for the mark SWEET PEA'S in standard characters for "Bar and restaurant services" in International Class 43. In the parties' concurrent use agreement, Respondent agrees to restrict its registration to the area comprising "Washington, Idaho, Montana, North Dakota, South Dakota, Minnesota, Wisconsin, Michigan, Pennsylvania, New York, Vermont, New Hampshire, Maine, Massachusetts, Rhode Island, Connecticut, New Jersey, Delaware, Maryland, Iowa, Nebraska, Wyoming, Utah, Arizona, California, Nevada, Oregon, Alaska, and Hawaii" and acknowledges Petitioner as an exception to its exclusive right to use the mark in commerce. The parties' geographic territories are entirely separate.

In view of the foregoing, the motion is granted. *See* TBMP § 1113. The above-captioned cancellation proceeding is dismissed without prejudice. *See* Trademark 2.114(c). Concurrent Use No. 94002698 is instituted by this order with Petitioner as

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the concurrent use applicant/plaintiff and Respondent as the named concurrent use registrant/defendant.

Following institution of a concurrent use proceeding, the parties ordinarily are invited to file statements under Trademark Rule 2.99. However, in this instance, the Board can assess the parties' respective rights to registration based on the consent agreement entered into between the parties.

In this case, the parties agreed to the grant of a geographically restricted registration to Petitioner and to the geographic restriction of Respondent's registration. *See* paragraph 3. The parties have agreed that they will "take all appropriate precautions to prevent consumer confusion by use of their respective marks, and in the event evidence of actual confusion should arise, the [p]arties will negotiate in good faith and make appropriate adjustments with regard to advertising and use of their marks to eliminate the confusion." Paragraph 2. 12 TTABVUE 5.

Based on the foregoing, we find that (1) Petitioner is entitled to the concurrent use registration it seeks in its involved application; and (2) Respondent's involved registration shall be geographically restricted in accordance with the parties' concurrent use agreement.

Judgment: Sweet P's Barbeque & Soul House, LLC shall be granted a concurrent use registration based upon its application Serial No. 86692033, for the mark SWEET P'S in standard characters, for "Restaurant and catering services," restricted to the territory "comprising Colorado, Kansas, Missouri, Illinois, Indiana, Ohio, West Virginia, Virginia, Kentucky, Tennessee, North Carolina, South Carolina, Georgia,

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Florida, Alabama, Mississippi, Arkansas, Louisiana, Texas, Oklahoma, and New Mexico.”

Registration No. 4786688 for the mark SWEET PEA’S standard characters for “Bar and restaurant services,” owned by Paul Dzubnar, shall be restricted to the area “comprising Washington, Idaho, Montana, North Dakota, South Dakota, Minnesota, Wisconsin, Michigan, Pennsylvania, New York, Vermont, New Hampshire, Maine, Massachusetts, Rhode Island, Connecticut, New Jersey, Delaware, Maryland, Iowa, Nebraska, Wyoming, Utah, Arizona, California, Nevada, Oregon, Alaska, and Hawaii.”