

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Ryan

MAILED: March 5, 2004

Concurrent Use No. 94001236

Po-Boyz, Ltd.

v.

Antone's Import Company

Karyn K. Ryan, Interlocutory Attorney
Trademark Trial and Appeal Board.

This case now comes up for resolution of issues
relative to the following:

- (1) the Board's December 18, 2001 order to show cause,
to the extent directed at registrant;
- (2) registrant's October 15, 2002 motion to suspend
proceedings and to take discovery; and,
- (3) the Board's July 31, 2003 order to show cause
directed at applicant.

Background

On December 18, 2001, the Board instituted this
concurrent use proceeding and ordered the parties to show
cause within thirty days why, pursuant to the December 20,
1996 final order of the U.S. Bankruptcy Court for the
Southern District of Texas, Houston Division, Po-Boyz,
Ltd.'s concurrent use applications should not issue, and why

Antone's Import Company's ("Antone's") registrations should not be geographically restricted.

Registrant Antone filed and was granted several requests to extend its time to respond to the Board's December 18, 2001 show cause order.

On October 15, 2002, registrant Antone filed a motion to suspend proceedings to allow for time to serve discovery on the concurrent use applicant, Po-Boyz, Ltd. In its motion, Antone contends, *inter alia*, that the discovery is needed to enable registrant "to fully respond to the [Board's December 18, 2001 show cause] order." In response, applicant Po-Boyz, Ltd. filed and was granted an extension until December 30, 2002 to submit its response to the motion to suspend and to take discovery. No further extension or other response was received by applicant Po-Boyz, Ltd. within the permitted time.

The Board, on July 31, 2003, issued an order which did not expressly rule on the registrant's October 15, 2002 motion to suspend and to take discovery. Instead, the Board's order required concurrent use applicant Po-Boyz, Ltd. to show cause why default judgment should not be entered against applicant Po-Boyz, Ltd. based on applicant Po-Boyz, Ltd.'s apparent loss of interest in this case. Applicant Po-Boyz, Ltd. filed a response on August 29, 2003.

THE BOARD'S JULY 31, 2003 ORDER TO SHOW CAUSE IS SET ASIDE

In response to the Board's July 31, 2003 order, applicant states that it has not lost interest in this case and intentionally had not filed any further papers in response to registrant Antone's October 15, 2002 motion. Applicant argues that its inaction was justified because it had understood that no response was necessary in order for the Board to treat registrant's October 15, 2002 motion as conceded under Trademark Rule 2.127(a).

Applicant's point is well taken. The circumstances recounted by applicant Po-Boyz, Ltd. set forth sufficient cause for its failure to file a timely response to Antone's October 15, 2002 motion. Accordingly, the July 31, 2003 order to show cause is hereby set aside.

THE BOARD'S DECEMBER 18, 2001 ORDER SET ASIDE; MOTION TO SUSPEND AND TAKE DISCOVERY IS MOOT; CONCURRENT USE PROCEEDING SHALL GO FORWARD

We turn now to the October 15, 2002 motion of registrant Antone. As stated in our July 31, 2003 order, the gist of Antone's motion is that, in order to fully respond to the Board's December 18, 2001 show cause order, Antone needs to first conduct discovery because:

"the [B]ankruptcy [Co]urt order upon which the concurrent use applications are based does not find that concurrent use applicant owns the marks; . . . the

[B]ankruptcy [C]ourt order must be read in context of other proceedings between the parties and their predecessors; . . . the concurrent use applications did not include documents which support a finding that the [B]ankruptcy [C]ourt determined the ownership of the marks; . . . discovery is necessary to support the concurrent use applicant's 'interpretation' that the [B]ankruptcy [C]ourt found that concurrent use applicant owned the marks."

As we consider this in relation to applicant Po-Boyz, Ltd.'s August 29, 2003 submission, the adversarial nature of this proceeding is revealed. It is now obvious that there are unresolved issues between the parties regarding their predecessors' settlement of this dispute. Additionally, questions remain as to whether any issues in this case have been resolved by another proceeding (or other proceedings) involving the parties or their predecessor(s). Obviously, this is not a clean case where the parties have agreed to settlement terms on specific territorial restrictions.

Under the circumstances, we find this case to be more complicated than initially presented in the concurrent use applications. This is underscored by the fact that registrant Antone perceives a need to conduct discovery on these issues and applicant Po-Boyz, Ltd. has not objected to this.

In view thereof, we find that registrant Antone has shown sufficient cause for discharging the Board's December 18, 2003 show cause order. We see no reason for shortcutting this proceeding or the discovery process

normally accorded to parties in concurrent use proceedings. Accordingly, this case shall now go forward under the standard operating procedures applicable to concurrent use proceedings.

Inasmuch as we have construed registrant's motion to suspend and to take discovery as its response to the Board's first show cause order, we need not consider the issue of suspension, which is now moot.

DISCOVERY IS NOW OPEN; THE CLOSE OF DISCOVERY AND TESTIMONY PERIODS ARE SET FORTH AS INDICATED BELOW.

The Board's December 18, 2001 order served as notice of this concurrent use proceeding. Proceedings herein will be conducted in accordance with the Rules of Practice in Trademark Cases, as set out in Title 37 of the Code of Federal Regulations. Rule 2.99 thereof provides that:

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 day after the mailing of the notice.

Registrant Antone is allowed **until thirty days** from the mailing date set forth on page one hereof to file an

answer in accordance with Rule 2.99. If filed, the answer should be directed to the allegations relating to concurrent use recited in the applications identified in the Board's December 18, 2001 notice.

Discovery is open; the close of discovery and trial dates are set as indicated below.

DISCOVERY PERIOD TO CLOSE: July 6, 2004

30-day testimony period for party in the position of plaintiff to close: **October 4, 2004**

30-day testimony period for party in the position of the defendant to close: **December 3, 2004**

15-day rebuttal period for party in the position of the plaintiff to close: **January 17, 2005**

IN EACH INSTANCE, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party WITHIN THIRTY DAYS after completion of the taking of testimony. Rule 2.125.

Briefs shall be filed in accordance with Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Rule 2.129.

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Notice Regarding TTAB Electronic Resources and New Rules

TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, and inter partes filings are now available at <http://estta.uspto.gov>. Images of TTAB proceeding files can be viewed using TTABVue at <http://ttabvue.uspto.gov>.

Parties should also be aware of changes in the rules affecting trademark matters, including rules of practice before the TTAB. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003) Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003). Notices concerning the rules changes are available at www.uspto.gov.

The second edition of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) has been posted on the USPTO web site at www.uspto.gov/web/offices/dcom/ttab/tbmp/.