

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: January 30, 2007

Concurrent Use No. 94002206

Three Boys Enterprises, LLC

V.

Keane Construction, Inc.

To: Rachel Blue
Doerner, Saunders, Daniel & Anderson LLP
320 South Boston Avenue, Suite 500
Tulsa, OK 74103-3725

Re: Serial No. 78287913
Filed: August 15, 2003
Applicant: Keane Construction, Inc.
Mark: NATIONAL BARN COMPANY

Eric McWilliams, Paralegal:

The applicant in application Serial No. 78287919 has applied for a concurrent use registration for the mark NATIONAL BARN COMPANY. Details of that application are set forth below:

Name of applicant: Three Boys Enterprises, LLC [Three Boys]

Applicant's address: 1869 Highway 52 East
Portland, TN 37148

Applicant's mark: NATIONAL BARN COMPANY

Goods or services: Commercial, residential and agricultural building construction **in Class 37.**

Filing date: August 15, 2003

Territory of use: The area comprising Tennessee, Alabama, Kentucky, Virginia, North Carolina, South Carolina, Georgia,

Ohio, Pennsylvania, New York, West Virginia, Rhode Island, Delaware, Maryland and Florida.

Attorney: Rachel Blue
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In its application, Three Boys has recited as an exception to its allegation of exclusive rights to the use of said mark, use by Keane Construction, Inc. [Keane] of an identical or very similar mark. Keane's mark, goods or services, and territory of use, *as acknowledged in* the referenced application, are set out below in a summary of details of the application.

Your mark: NATIONAL BARN COMPANY

Your goods or services: Commercial, residential and agricultural building construction **in class 37**.

Your territory of use: Any area of use not specifically set out for use by Three Boys Enterprises, LLC

In this concurrent use case, Three Boys is in the position of plaintiff and Keane is in the position of defendant. In a typical concurrent use case, Keane, as defendant, would be provided with a copy of the application for concurrent use registration filed by Three Boys. However, in this case, Keane is represented by the same counsel that represents Three Boys. Accordingly, there is no need to forward such a copy. Because counsel represents both parties, who may ultimately have adverse interests, the Board refers counsel and the parties to TBMP Section 114.08 and Patent and Trademark Rule 10.66.

Since the Office has determined that Three Boys' mark appears entitled to registration, subject to a concurrent use proceeding with Keane, a concurrent use proceeding is hereby instituted under the provisions of Section 2(d) of the Trademark Act of 1946.

The proceeding 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, under which this notice is given, 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.

Keane is allowed until **40 days from the mailing date above** 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 application identified herein.

Keane is also requested to advise the Board of any relevant applications or registrations, other than those already listed herein, which should be included in this concurrent use proceeding. Keane's response, if any, should be in writing and should be filed on or before March 11, 2007.

While provision has been made for the filing of an answer by Keane, and discovery and testimony dates have been set out below, the Board notes that most concurrent use proceedings are settled without the need for a trial. Also, it appears that Three Boys and Keane have already reached an agreement that will allow the parties to coexist in the marketplace, by restricting their respective operations to distinct territories. The applications of Three Boys and Keane each include a reference to a coexistence agreement. In addition, counsel has faxed to the Board a copy of such co-existence agreement.

Accordingly, the Board has reviewed the faxed co-existence agreement and the respective applications in an attempt to expedite proceedings.

Turning to the content of the involved applications and the parties' co-existence agreement, the Board notes that the application of Keane (78287913) does not include a proper concurrent use statement and does not include an amended declaration, like that filed in the Three Boys application. Finally, the Board notes that the co-existence agreement faxed to the Board has typographical errors in the second of the two "Territory Restriction" paragraphs, and is undated.

The parties can help establish that there would be no likelihood of confusion among consumers and that each party is therefore entitled to the concurrent use registration it seeks by (1) filing an amendment in the Keane application to properly list Keane's claimed territory and a substitute declaration acknowledging that there is an exception to Keane's rights, and (2) filing a corrected co-existence agreement that includes a dated signature page. The statement of Keane's territory should read approximately as follows: "Applicant claims the exclusive right to use the mark in the entire United States and its territories, except for _____ [Keane should then list the states that comprise the Three Boys territory]. Subject to concurrent use proceeding with Three Boys Enterprises, LLC and application serial no. 78287919."

If the parties attend to these details, the Board may be able to enter a finding that each party is entitled to the concurrent use registration it seeks and the parties will not have to proceed to trial.

DISCOVERY AND TESTIMONY PERIODS ARE SET AS INDICATED BELOW.

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.

Discovery period to open: **2/19/07**

Discovery period to close: **8/18/07**

30-day testimony period for party
in position of plaintiff to close: **11/16/07**

30-day testimony period for party
in position of defendant to close: **1/15/08**

15-day rebuttal testimony period
to close: **2/29/08**

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.

NOTE: The Board allows parties to utilize telephone conferences to discuss or resolve many interlocutory matters that arise in inter partes cases. See TBMP § 502.06(a) (2d ed. rev. 2004).

If the parties to this proceeding are (or during the pendency of this proceeding, become) parties to another Board or civil proceeding involving related marks or other common issues of law or fact, they shall notify the Board immediately, so that the Board can consider consolidation or suspension of proceedings, if appropriate.

New Developments at the Trademark Trial and Appeal Board

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