

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. 78287919
Filed: August 15, 2003
Applicant: Three Boys Enterprises, LLC
Mark: NATIONAL BARN COMPANY
Published: June 28, 2005

Eric McWilliams, Paralegal:

A concurrent use proceeding involving the above-identified application 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. Three Boys Enterprises, LLC [Three Boys] is in the position of plaintiff in the proceeding.

Keane Construction, Inc. [Keane], the applicant referred to in the above-identified application as an exception to the otherwise exclusive rights of Three Boys, is being notified on this date of the institution of the concurrent use proceeding and is being supplied with a copy of your application, in accordance with the provisions of Rule 2.99. Keane is in the position of defendant in the proceeding. As the owner of an application (serial no. 78287913), Keane is not required to file an answer but may do so under Rule 2.99. The Trademark Trial and Appeal

Board has set March 11, 2007 as the due date for any such answer.

You are requested to advise the Board of any relevant applications or registrations, other than those already referenced herein, which should be included in this concurrent use proceeding. Your response, if any, should be in writing and should be filed on or before **40 days from the mailing date above**.

While a deadline has been set for defendant Keane to file its optional answer, and discovery and testimony periods are set forth 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. However, before addressing the content of the applications and co-existence agreement, the Board notes that both involved applicants are represented by the same attorney. As noted in TBMP section 114.08, when parties with adverse interests are represented by the same attorney, the Board will notify counsel and the parties in writing of the possible conflict of interest. Counsel, Three Boys and Keane are therefore referred to Patent and Trademark Rule 10.66.

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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