

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: April 15, 2014

Concurrent Use No. 94002584

Bay Billiards, Inc.
(Serial No. 85331348)

v.

CIM/Huntington, LLC
(Registration No. 3676946)

By the Board:

Bay Billiards, Inc. (hereinafter also “applicant”) filed an application for a concurrent use registration of the mark SHOREBREAK PIZZA • SPORTS • BILLIARDS for “restaurant, sports bar and cocktail lounge services.”¹ In its application, applicant recites its area of use as “all of the United States except for the geographic area west of Texas, Oklahoma, Colorado, Nebraska, South Dakota and North Dakota.”

Applicant named CIM/Huntington, LLC (hereinafter also “registrant”) as the sole exception to its exclusive right to use its mark. Registrant’s mark is SHOREBREAK for “hotel services, hotels.”² While applicant did not specifically identify registrant’s territory of use, applicant implies that it

¹ Application Serial No. 85331348, filed May 26, 2011, claiming a date of first use anywhere and a date of first use in commerce of September 1, 2003.

² Registration No. 3676946, issued on September 1, 2009, claiming a date of first use anywhere and a date of first use in commerce of May 12, 2009.

comprises the “geographic area west of Texas, Oklahoma, Colorado, Nebraska, South Dakota and North Dakota.”

The application published on September 13, 2013 as one seeking a geographically restricted registration. This concurrent use proceeding commenced on January 9, 2014. Shortly thereafter, on February 18, 2014, applicant filed a copy of the parties’ executed “Settlement and Co-Existence Agreement” whereby registrant consents to issuance to applicant of a geographically unrestricted registration.

In their agreement, the parties state that there are differences in the markets for each mark (Prelim. Stmt. E); that neither party is aware of actual confusion (Prelim. Stmt. F); and that both parties believe that there is no likelihood of confusion to be caused by their continued use of their respective marks (Prelim. Stmt. F). The parties agree that registrant will not use its mark for restaurant and/or bar services, except those located within its hotel (§1.a.); that applicant will not use its mark for hotel services or hotels (§1.b.); that registrant consents to applicant’s worldwide use and registration of its mark in connection with its identified services (§2.a.); that applicant consents to registrant’s worldwide use and registration of its mark for its identified services (§2.b.); and that, while the parties do not believe confusion is likely, the parties agree to take reasonable steps to ensure no confusion occurs as a result of the use of their marks (§2.c.).

Implicit in the parties' agreement is an amendment to applicant's application to seek an unrestricted registration. By virtue of the executed agreement, registrant's consent to such an amendment is of record. In view thereof, application Serial No. 85331348 is amended to delete the geographic restrictions. Trademark Rule 2.133(a).

Accordingly, this concurrent use proceeding is dissolved.³ However, inasmuch as applicant's application published reciting geographic restrictions, application Serial No. 85331348 must be republished as a geographically unrestricted application. See, e.g., TMEP § 1505.03(a) (Oct. 2013). The application is hereby forwarded to the Publication Division of this Office for republication.

³ Although applicant requested that the concurrent use proceeding be dismissed with prejudice in view of the parties' settlement, the procedure in a situation such as the one present in this case is to dissolve the proceeding in favor of a geographically unrestricted registration. See, e.g., TBMP § 1106.05 (2013).