

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: September 9, 2015

Opposition No. 91216132

Hanscomb Limited

v.

Hanscomb Consulting, Inc.

**George C. Pologeorgis,
Interlocutory Attorney:**

This proceeding now comes before the Board for consideration of Applicant's motion (filed May 28, 2015) to amend its involved intent-to-use application to a concurrent use application. The motion is fully briefed.

Decision

For the reasons set forth below, Applicant's motion to amend its application is **DENIED**.

Applications to register under Trademark Act § 1(b), 15 U.S.C. § 1051(b), i.e., intent-to-use applications, are subject to concurrent use proceedings **only after an acceptable allegation of use** under Trademark Rules 2.76 or 2.88 has been filed. *See* Trademark Rule 2.99(g); *see also* TBMP §1103.01(a) (2015) (emphasis added). Further, applicants may not file an amendment to allege use in an application

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under Trademark Act § 1(b) that is the subject of an opposition in an effort to qualify for concurrent use registration. TBMP § 1105.

Moreover, Trademark Rule 2.76(a) provides that an applicant may not file an amendment to allege use after the date the application has been approved for publication. Applications are in a “blackout period” while an opposition is pending. TBMP § 1105; TMEP § 1104.03(b).

Here, Applicant’s involved application was filed as an intent-to-use application under Section 1(b) of the Trademark Act and is currently subject to this pending opposition proceeding. As such, Applicant’s application is deemed to be in the “blackout period” noted above and therefore Applicant is precluded, under Board rules, from seeking to amend its intent-to-use application to a concurrent use application or submitting an amendment to allege use in order to convert its involved intent-to-use application to a concurrent use application during the course of this opposition proceeding. Furthermore, the Board cannot dismiss this opposition in favor of a concurrent use proceeding since Applicant has yet to file an allegation of use and cannot do so during the course of this case for the reasons stated above.

In view thereof, Applicant’s motion to amend its involved intent-to-use application to a concurrent use application is hereby **DENIED**.¹

¹ Should the parties to this opposition wish to go forward with concurrent use registrations, Applicant may consider abandoning its opposed application and refile it as a use-based, concurrent use application. If the abandonment is with Opposer’s consent, judgment will not be entered against Applicant, and the opposition can be dismissed without prejudice. *See* Trademark Rule 2.135.

Trial Schedule

Proceedings are hereby resumed.² Remaining trial dates are reset as follows:

Plaintiff's 30-day Trial Period Ends	10/23/2015
Defendant's Pretrial Disclosures Due	11/7/2015
Defendant's 30-day Trial Period Ends	12/22/2015
Plaintiff's Rebuttal Disclosures Due	1/6/2016
Plaintiff's 15-day Rebuttal Period Ends	2/5/2016

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. Trademark Rule 2.125.

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

² The Board notes that Applicant filed its motion to amend its application after the deadline for Opposer to serve its pretrial disclosures. To the extent Opposer has not yet served its pretrial disclosures on Applicant, it should do so immediately and no later than **September 16, 2015**.