

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
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General Contact Number: 571-272-8500

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Opposition No. 91225035

*Renata Foucré, Erin Hartman
and Heather Marlow*

v.

Early Recognition Is Critical, Inc.

Concurrent Use No. 94002693

Early Recognition Is Critical, Inc.

v.

*Renata Foucré, Erin Hartman
and Heather Marlow*

and

Community Initiatives

**Before Richey, Deputy Chief Administrative Trademark Judge,
and Zervas and Wellington, Administrative Trademark Judges.**

This proceeding is before the Board on:

- 1) the March 11, 2016 and March 18, 2016 renewed motion to strike affirmative defenses, filed by Renata Foucré, Erin Hartman and Heather Marlow (“Opposers”); and
- 2) the March 31, 2016 contested motion to amend involved application Serial No. 86603543 to one seeking concurrent use registration, filed by Early Recognition Is Critical, Inc. (“Applicant”).

Applicant's Involved Application

On April 20, 2015, Applicant filed application Serial No. 86603543 to register the mark HUCK CANCER (standard characters; CANCER disclaimed) for “organizing and conducting flying disc tournaments to raise awareness for cancer” in International Class 41. The application is based on use of the mark in commerce pursuant to Trademark Act Section 1(a), alleging a date of first use anywhere, and a date of first use in commerce, of March 20, 2012.

Opposers' Notice of Opposition; Opposers' Applications

Opposers filed a notice of opposition on the grounds of likelihood of confusion, and fraud on the USPTO. Opposers allege common law rights since March, 2010, in the mark HUCK CANCER in connection with “charitable services and charitable fundraising services,”¹ and assert two applications filed on August 28, 2015, based on use of the mark in commerce pursuant to Trademark Act Section 1(a), alleging a date of first use anywhere, and a date of first use in commerce, of March 6, 2010, to register the mark HUCK CANCER (standard characters, CANCER disclaimed), as follows:

- 1) Application Serial No. 86741105, for “charitable services, namely, organizing and conducting flying disc tournaments to raise awareness for cancer,” in International Class 35; and
- 2) Application Serial No. 86741106, for “charitable fundraising services by means of organizing and conducting flying disc tournaments; charitable fundraising services, namely, raising funds to support cancer patients and their families” in International Class 36.²

¹ 1 TTABVue 5.

² At present, application Serial Nos. 86741105 and 86741106 are suspended in ex parte examination pursuant to Trademark Rule 2.83(c) based on the earlier filing date of application Serial No. 86603543.

Applicant's Motion to Amend to a Concurrent Use Application

The Board will consider and determine concurrent use rights only in the context of a concurrent use registration proceeding. Trademark Rules 2.99(h) and 2.133(c); TBMP §§ 514 and 1101.02 (2016). An applicant whose geographically unrestricted use-based application is the subject of an opposition proceeding may file a motion to amend its application to one for a concurrent use registration, reciting oppose(s) as exception(s) to the applicant's claim of exclusive use, together with a motion to terminate the opposition in favor of a concurrent use proceeding. If the opposer does not consent to the amendment, the amendment may be approved and entered, and a concurrent use proceeding instituted, provided that applicant consents to entry of judgment against itself in the opposition with respect to its right to a geographically unrestricted registration. TBMP §§ 514.03 and 1113. In such cases, judgment will be entered against the applicant in the opposition, with respect to applicant's right to an unrestricted registration, the amendment will be approved, and a concurrent use proceeding involving the amended application will be instituted in one Board action. TBMP § 1113.01.

The Board has reviewed Opposers' brief in opposition to the motion to amend, including Opposers' request that the Board exercise its inherent power to control the disposition of cases and deny Applicant's motion to amend, or order Applicant to show cause why it has any non-frivolous basis to pursue a concurrent use registration.³

³ 14 TTABVUE 3.

Opposers' brief otherwise deviates from the procedural issue of whether Applicant may amend its application, and sets forth arguments and exhibits going to the merits of whether Applicant is entitled to a concurrent use registration. Nonetheless, in view of the findings set forth below, the Board grants Applicant's motion to amend the involved application.

We initially note that Applicant has met the jurisdictional requirement for seeking a concurrent use registration. TBMP § 1103.01(b). That is, Applicant alleges use in commerce (March 20, 2012) prior to the filing date (August 28, 2015) of Opposers' pending applications.

In its amendment, Applicant states:

[A]pplicant claims the right to exclusive use of the mark for the area comprising the entire United States, its territories and possessions with the exception of the County of San Francisco within the state of California.⁴

Applicant identifies Opposers Renata Foucré, Erin Hartman and Heather Marlow, individual U.S. citizens and joint owners of application Serial Nos. 86741105 and 86741106, as well as Community Initiatives, a California corporation, as exceptions to Applicant's exclusive right to use the mark HUCK CANCER.⁵ Applicant acknowledges that the amendment to its application is made without Opposers' consent, and consents to entry of judgment against itself in the opposition with respect to its right to a geographically unrestricted registration. Specifically, Applicant states:

⁴ 11 TTABVUE 3.

⁵ 11 TTABVUE 3-4.

[A]pplicant consents to entry of judgment against itself with respect to its right to an unrestricted registration and hereby moves to terminate this opposition proceeding in favor of a concurrent use proceeding involving the application as amended above.⁶

Inasmuch as Applicant has met the jurisdictional and procedural requirements for a concurrent use proceeding, Applicant's motion to amend its application Serial No. 86603543 to one for concurrent use registration is granted, and the amendment is approved. Judgment against Applicant is hereby entered in Opposition No. 91225035, and the **opposition is hereby dismissed without prejudice. Concurrent Use No. 94002693 is hereby instituted** under the provisions of Trademark Act Section 2(d), with Early Recognition Is Critical, Inc. as the concurrent use applicant (in the position of "plaintiff") and Renata Foucré, Erin Hartman and Heather Marlow, and Community Initiatives, as the named excepted users (in the position of "defendants"). TBMP § 1113.01.

The geographic scope of Applicant's concurrent use rights will be determined in the context of the concurrent use proceeding, which will be conducted in accordance with the Trademark Rules of Practice.⁷

⁶ 11 TTABVUE 5.

⁷ Whether the excepted user is a common law user, an applicant, or a registrant, the concurrent use applicant has the same burden of proof to demonstrate its entitlement to a concurrent use registration. Trademark Rule §2.99(e); TBMP §1108 ("Each applicant for concurrent registration has the burden of proving its entitlement thereto as against every other party specified in its application as an exception to its claim of exclusive right to use.").

In view of the dismissal of Opposition No. 91225035 in favor of Concurrent Use No. 94002693, Opposers' motion, and renewed motion, to strike Applicant's affirmative defenses are moot.

This order constitutes notice informing the parties of the institution of the concurrent use proceeding. Within ten (10) days from the mailing date of this order, Applicant must serve copies of its application, specimens and drawing on each excepted user identified as a concurrent user in the application for registration, and file with the Board proof of proper service of the copies. Copies of the served documents themselves should not be filed with the Board. Trademark Rule 2.99; TBMP §§ 1103.01(f) and 1107.

The "answer" in a concurrent use proceeding is a response to the notice. In the "answer," the answering party sets forth its position with respect to the registration(s) sought by the concurrent use applicant(s). TBMP § 1107. Opposers Renata Foucré, Erin Hartman and Heather Marlow, and Community Initiatives - the entities listed in the application as concurrent users - stand in the position of common law users, and accordingly must file an answer to avoid default. Accordingly, Opposers Renata Foucré, Erin Hartman and Heather Marlow, and Community Initiatives, are allowed until forty (40) days from the mailing date of this order to file respective answers. Trademark Rule 2.99(d)(2); TBMP § 1107.

In the event the parties desire to conclude the concurrent use proceeding based on a settlement agreement, the parties are referred to TBMP § 1110 and cases referenced therein for a discussion of operative provisions in concurrent use agreements.⁸

If any party to this concurrent use proceeding owns any other application or registration which is for the same or similar mark, and same or similar goods and/or services, the party should notify the Board so that it can determine whether the application or registration should be added to this proceeding. TBMP § 1104.

Schedule

In the concurrent use proceeding, dates are set as follows:

Time to Answer	8/31/2016
Deadline for Discovery Conference	9/30/2016
Discovery Opens	9/30/2016
Initial Disclosures Due	10/30/2016
Expert Disclosures Due	2/27/2017
Discovery Closes	3/29/2017
Plaintiff's Pretrial Disclosures	5/13/2017
Plaintiff's 30-day Trial Period Ends	6/27/2017
Defendant's Pretrial Disclosures	7/12/2017
Defendant's 30-day Trial Period Ends	8/26/2017
Plaintiff's Rebuttal Disclosures	9/10/2017
Plaintiff's 15-day Rebuttal Period Ends	10/10/2017

⁸ As noted, Opposers own two unrestricted applications with filing dates subsequent to the filing date of Applicant's application. If Opposers amend to seek concurrent registration(s), assuming the application(s) is/are otherwise in condition to be published, assert use in commerce, and meet the jurisdictional requirement for concurrent registration, the application(s) will be published for opposition. *See* TBMP § 1103.01(b). When the Board is informed of the amendment(s), it may suspend the concurrent proceeding pending the amended application(s) clearing the opposition period. If no opposition is filed, or if all oppositions filed are dismissed or withdrawn, the application(s) will be added to the concurrent use proceeding. TBMP § 1104.

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

Important! Effective June 24, 2016, a revised Standard Protective Order will be applicable to all TTAB proceedings with certain exceptions. See the TTAB home page for more information:

<http://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board-ttab>

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