

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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WINTER

March 13, 2019

Opposition No. 91234377

Foundation Investments Incorporated

v.

Cosmo Entertainment, LLC

Concurrent Use No. 94002838

Cosmo Entertainment, LLC

v.

Foundation Investments Incorporated

BY THE TRADEMARK TRIAL AND APPEAL BOARD:

Joint Motion to Dismiss in Favor of Concurrent Use Proceeding

Applicant Cosmo Entertainment, LLC (“Cosmo”) seeks to register the mark DELILAH, in standard characters, for “restaurant, bar and cocktail lounge services” in International Class 43 (“Cosmo’s services”).¹ In its notice of opposition, Opposer Foundation Investments Incorporated (“Foundation”) alleges a likelihood of confusion

¹ Application Serial No. 87239699, filed on November 17, 2016, based on Cosmo’s intent to use in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). Cosmo’s amendment to allege use sets forth October 13, 2016 as it dates of first use anywhere and in commerce.

based on its common law rights accruing from its prior use (since May 21, 1993) of the mark DELILAH'S in connection with "operating a bar and cocktail lounge" (Notice of Opposition, ¶¶ 1-2). In addition, Foundation alleges that it has filed a trademark application for registration of the trademark DELILAH'S for "bar and cocktail lounge services" (*Id.* at ¶ 3).² No answer has been filed in this opposition proceeding.

This case now comes up for consideration of the parties' joint, stipulated motion (filed September 4, 2018,³ pursuant to the parties' agreement) to dismiss this opposition without prejudice in favor of converting same to a concurrent use proceeding. Cosmo also requests that its application be amended to limit the geographic scope of the application to all of the United States other than the States of Illinois, Wisconsin, Indiana, Michigan and Kentucky.

In support of their motion, the parties state that concurrently with this motion, Foundation has submitted a request to the Trademark Examining Attorney for its application to limit the geographic scope of the application only to the States of Illinois, Wisconsin, Indiana, Michigan and Kentucky; and in view thereof, the parties request that Foundation's application be joined as part of the to-be-instituted concurrent use proceeding and that action on said concurrent use proceeding be

² Application Serial No. 87436640, filed on May 4, 2017, based on use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging May 21, 1993, as both the date of first use anywhere and the date of first use in commerce.

³ The Board's delay in addressing this matter is regretted. The Board treats the proceeding as having been suspended since the filing date of the subject motion. *See* Trademark Rule 2.117(c).

suspended until after the opposition period for Foundation's application, or if an opposition is filed, until after that opposition has been dismissed.

Cosmo and Foundation have entered into a Coexistence and Concurrent Use Agreement, along with a third party, Delilah's Distilling Company, a copy of which is attached to the joint motion (20 TTABVUE 6). Pursuant to that executed agreement, Cosmo agreed, inter alia, to amend the involved application to exclude Foundation's territory from the geographic scope of rights covered by its application; and Foundation agreed, inter alia, to amend its application to one for concurrent use with a geographical restriction comprising the States of Illinois, Wisconsin, Indiana, Michigan and Kentucky ("Foundation's Territory"). The Board construes the agreement to provide that Foundation will be identified as the excepted user in Cosmo's application; and Cosmo will be identified in Foundation's application as its excepted user.

The parties also request that the concurrent use proceeding be suspended indefinitely until after the opposition period for Foundation's application. Upon amendment of the involved application, or immediately upon order of the Board, the parties request that this opposition be dismissed without prejudice, and a concurrent use proceeding be instituted for the parties' respective applications. The motion is **GRANTED** to the extent noted below. Trademark Rule 2.73.

Opposition No. 91234377 Is Dismissed without Prejudice

Geographic limitations will be considered and determined by the Board only in the context of a concurrent use registration proceeding. Trademark Rule 2.133(c). In

view of the parties' stipulation, Opposition No. 91234377 is dismissed without prejudice in favor of a concurrent use proceeding between Foundation and Cosmo. TBMP § 1113.01 (2018).

A Concurrent Use Proceeding Instituted

A concurrent use proceeding is hereby instituted under the provisions of Section 2(d) of the Trademark Act with respect to Application Serial No. 91234377. As set forth above, concurrent use Applicant Cosmo recites use of the DELILAH mark for Cosmo's services in the United States, except for the States of Illinois, Wisconsin, Indiana, Michigan and Kentucky, with Foundation identified as an exception to its exclusive use of the DELILAH mark.

Proceeding Suspended

Inasmuch as the potential for likelihood of confusion with Cosmo's application has resulted in the suspension of Foundation's application pending the disposition of Cosmo's application, and the Board does not yet have jurisdiction over Foundation's application pursuant to Trademark Rule 2.84, this proceeding cannot resolve both parties' rights to concurrent use registration at this time. Accordingly, the now instituted concurrent use proceeding is **SUSPENDED** to allow Foundation to amend its application to seek concurrent use registration with Cosmo's application so that it may be approved for publication, published for opposition, and be subject to the Board's jurisdiction through this concurrent use proceeding.

If Foundation's application is successfully opposed or is abandoned, this concurrent use proceeding will resume with Foundation as an excepted user relying

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on its common law rights. Accordingly, this proceeding is **SUSPENDED** pending the disposition of Foundation's application Serial No. 87436640.⁴

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⁴ This order takes the place of a complaint in the concurrent use proceeding. When proceedings resume, the Board will address the filing of an answer.