

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

Vigil

Mailed: July 29, 2019

Opposition No. 91235287

Level Up, LLC

v.

Hakkasan Holdings, LLC

By the Trademark Trial and Appeal Board:

On October 24, 2018, Opposer filed a consented motion to 1) suspend the proceedings, 2) remand the opposed application, Serial No. 87230621, so that applicant may file an amendment to allege use. Once the amendment is accepted the parties wish to amend the application to a concurrent use application and convert the opposition to a concurrent use proceeding. As discussed below, because the amendment to allege use is impermissible under the Office's rules, the motion to remand is denied.

RELEVANT LEGAL AUTHORITY

Only applications based on use in commerce are subject to concurrent use registration proceedings. *See* Trademark Act §2(d), 15 U.S.C. §1052(d); *see also In re Beatrice Foods Co.*, 429 F.2d 466, 166 USPQ 431, 436 (CCPA 1970). Thus, the use basis is a statutory requirement of concurrent use applications.

An amendment to allege use may be filed before approval for publication, and a statement of use may be filed after the notice of allowance issues, but neither may be filed during the period known as the "blackout" period, occurring between approval for publication and issuance of the

notice of allowance. *See* Trademark Rule 2.76(a)(1), 37 C.F.R. §2.76(a)(1). The “blackout” period has been integral to processing intent to use applications, and the Director has denied petitions to waive the rule. *See In re Sovran Fin. Corp.*, 25 USPQ2d 1537, 1538 (Comm’r Pats. 1991); *see also Hanscomb Ltd. v. Hanscomb Consulting Inc.*, 2015 WL 12766228, at *3 (TTAB Sept. 14, 2015).¹

DECISION

Because the amendment to allege use is not permissible under Trademark Rule 2.76(a)(1), Opposer’s consented motion for remand is DENIED.

ALTERNATIVE PROCEDURE

The parties may consent to an alternative procedure that allows Applicant to retain its filing date. The parties may stipulate that Opposer will withdraw the opposition without prejudice² and that once the notice of allowance issues for the formerly opposed application, Applicant will file simultaneously a statement of use and an amendment to seek a concurrent use registration listing Opposer as the exception. With the statement of use and amendment to seek a concurrent use registration, Applicant should include a request that, upon approval of the statement of use and amendment to concurrent use, the Board is notified so the Board may initiate institution of the concurrent use proceeding.³

¹ Opposition No. 91216132, 22 TTABVUE.

² Opposer would be relinquishing the opportunity to oppose the application, but the withdrawal without prejudice may allow Opposer later to petition to cancel.

³ In an ordinary amendment to concurrent use during examination of the application, publication of the concurrent use application would trigger institution of the concurrent use proceeding before the Board.

A concurrent use registration only will issue following 1) a concurrent use proceeding before the Board or 2) issuance of a court decree. Trademark Act §2(d); 15 U.S.C. §1052(d); Trademark Rule 2.99.⁴

SUSPENDED

Proceedings are suspended for thirty days to allow the parties time to inform the Board of how they wish to proceed, failing which, dates will be reset.

⁴ If the concurrent use application were to issue as a registration without either a court decree or a concurrent use proceeding before the Board, it would have registered inadvertently, and could be subject to cancellation on that basis by a request directed to the Office of the Deputy Commissioner for Trademark Examination Policy. *See* TMEP §1609.10(a).