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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91239139
Party	Plaintiff San Pasqual Casino Development Group, Inc.
Correspondence Address	HILARY A BROOKS BROOKS QUINN LLC 6513 132ND AVE NE #378 KIRKLAND, WA 98033 UNITED STATES Email: hillary@brooksquinn.com, docketing@brooksquinn.com
Submission	Other Motions/Papers
Filer's Name	Delfina S. Homen
Filer's email	docketing@brooksquinn.com, delfina@brooksquinn.com, hillary@brooksquinn.com
Signature	/Delfina S. Homen/
Date	06/19/2018
Attachments	Opposer Motion to Suspend Proceedings.pdf(94594 bytes) Exhibit A.pdf(172618 bytes) Exhibit B.pdf(157159 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

SAN PASQUAL CASINO DEVELOPMENT GROUP, INC.,	)	Opposition No. 91239139
Opposer,	)	
v.	)	
3 SQUARE, INC.,	)	
Applicant.	)	

OPPOSER'S MOTION TO SUSPEND PROCEEDINGS

Pursuant to 37 C.F.R. §§ 2.117(c) and 2.146(g), TBMP § 510.03(a), and TMEP § 1705.06, Opposer San Pasqual Casino Development Group, Inc. ("Opposer") hereby requests that the Board suspend this opposition proceeding pending decision on Opposer's Petitions to the Director, filed with respect to Opposer's pending App. Ser. Nos. 86/143,373 and 86/143,341 on June 19, 2018. (*See* Exhibits A-B.)

Good cause exists for the requested suspension. Opposer's pending applications are pled as part of this proceeding. Opposer has challenged Applicant 3 Square, Inc.'s ("Applicant") applications on the basis that Applicant is not entitled to the geographically unrestricted registrations Applicant will receive if Applicant's applications are allowed to register. (*See* Not. Opp., 1 TTABVUE, ¶¶ 21-25, 60-71.) Opposer's pending applications seek concurrent use registration of Opposer's marks excepting, if proved, Applicant's area of prior geographic use of the marks in Applicant's applications.

Opposer's pending applications were suspended by the Office on April 16, 2014, pending disposition of Applicant's applications, and a third earlier-filed application from third party Big League Dreams. On May 9, 2018, Petitioner submitted a response to the suspension letter that

resulted in withdrawal of the likelihood of confusion advisory as to the Big League Dreams application. However, the suspension was continued based on the instant proceeding.

Per TBMP 1104, the applications involved in a concurrent use proceeding are 1) the concurrent use application (here, Opposer's applications), and 2) every earlier-filed conflicting unrestricted application identified in the concurrent use application as owned by an exception to the concurrent use applicant's claim of exclusive use (here, Applicant's applications). TBMP 1104 also provides that "[i]f any identified application has not yet been published in the Official Gazette, or has been published but has not yet cleared the opposition period, the [concurrent use] proceeding will be instituted." *See also* TMPB § 1106.03 (same).

Because the only applications that remain cited against Opposer's pending applications are Applicant's unrestricted applications challenged in this proceeding, both of which were identified in Opposer's applications as owned by an exception to Opposer's claim of exclusive use, and both of which have not yet cleared the opposition period, a concurrent use proceeding is due to be instituted. TBMP §§ 1104, 1106.03. Indeed, 37 C.F.R. § 2.99(b) explicitly states that "[i]f it appears that the applicant is entitled to have the mark registered, subject to a concurrent use proceeding, the mark will be published in the Official Gazette as provided by § 2.80." *See also* 37 C.F.R. § 2.80 ("The mark will also be published in the case of an application to be placed in . . . concurrent use proceedings, if otherwise registerable.").

Despite the rules clearly providing for publication of Opposer's pending applications without further delay, the examining attorney erroneously continued suspension of Opposer's pending applications. Accordingly, pursuant to 37 C.F.R. § 2.146(a)(3), Opposer filed Petitions to the Director on June 19, 2018 (*see* Exhibits A-B), requesting that Opposer's applications be removed from suspension, approved for publication, marked as concurrent use applications, and

published in the Official Gazette, so that a concurrent use proceeding between Opposer's applications and Applicant's unrestricted applications can be instituted without further delay. *See* TMEP § 716.03 (stating an applicant's recourse following an examining attorney's continued suspension is a petition to the director).

Suspending these proceedings pending the Director's decision on Opposer's Petitions would conserve resources of the parties and the Board. This proceeding is still in its infancy, with no party having taken any discovery, and indeed, Opposer's Motion to Strike Applicant's Answer remains pending. If the Director grants Opposer's Petition, Opposer's applications will be published as concurrent use applications so that a concurrent use proceeding between Opposer's applications and Applicant's applications can be instituted, allowing the Board to consider the geographic restrictions necessary for either party to have a registration under the circumstances involved here. *See* 37 C.F.R. § 2.99(h) (Board "will consider and determine concurrent use rights only in the context of a concurrent use registration proceeding").

Further, owing to the common questions of law and fact that would be present as between this proceeding and a concurrent use proceeding involving the same applications, this proceeding should be consolidated with the concurrent use proceeding. *See* TMEP § 511; Fed. R. Civ. P. 42(a). Consolidation would save the parties and the Board time, effort, and expense, particularly as opposed to seeing the instant opposition through to completion and *then* taking up the concurrent use proceeding. Owing at least to the very early stages of this proceeding, there is no prejudice or inconvenience to Applicant from suspending this proceeding pending the Director's decision, nor would there be any prejudice or inconvenience to Applicant from consolidating this proceeding with the concurrent use proceeding that is due to be instituted but is erroneously being held up by the continued suspension of Opposer's applications.

Notably, as the owner of the challenged applications, only Applicant can convert this opposition proceeding to a concurrent use proceeding by amending its unrestricted applications to applications seeking concurrent use excepting Opposer's area of prior use. *See* TBMP § 1113.01. Applicant has not done so, leaving Opposer with no ability to have its concurrent use rights decided absent removal of Opposer's applications from suspension and publication of Opposer's applications so that a concurrent use proceeding can be instituted.

Accordingly, Opposer respectfully requests that the Board suspend this proceeding pending the Director's decision on Opposer's Petitions filed with respect to Opposer's pending applications.

Dated this 19th day of June, 2018.

Respectfully submitted,

BROOKS QUINN, LLC

/Hillary A. Brooks/
Hillary A. Brooks
Registration No. 45,815
Attorney for Opposer

BROOKS QUINN, LLC
6512 132nd Ave. NE #378
Kirkland, WA 98033
(503) 629-1559

CERTIFICATE OF ELECTRONIC FILING

The undersigned hereby certifies that the **OPPOSER'S MOTION TO SUSPEND PROCEEDINGS** was electronically filed with the Trademark Trial and Appeal Board on June 19, 2018.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing **OPPOSER'S MOTION TO SUSPEND PROCEEDINGS** was served upon Applicant on June 19, 2018, by forwarding said copy via email to counsel for Applicant at the following email addresses:

Michael A. Grow
Chiara Giuliani
Michael.Grow@arentfox.com
Chiara.Giuliani@arentfox.com

By: /Delfina S. Homen/
Delfina S. Homen

EXHIBIT A

PTO Form No Form Number (Rev 01/2012)

OMB No. 0651-0054 (Exp 12/31/2020)

2.146 Petition to the Director

The table below presents the data as entered.

Input Field	Entered
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LITERAL ELEMENT	BLD
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
FORM TEXT	

PETITION TO THE DIRECTOR PURSUANT TO 37 C.F.R. § 2.146(a)(3)

In re Application Ser. No. 86/143,341

Statement of Facts

The subject application, Ser. No. 86/143,341, filed December 13, 2013, seeks concurrent use registration of the mark BLD for "restaurant services." The subject application identifies as the excepted user, if proved, 3 Square, Inc., and identifies as exceptions to the claim of exclusive use, if proved, the marks shown in 3 Square's geographically unrestricted Application Ser. No. 85/586,768 for the mark BLD (filed April 2, 2012), and in 3 Square's geographically unrestricted Application Ser. No. 85/588,233 for the mark BLD (& design) (filed April 3, 2012), both for "restaurant and catering services."

On April 16, 2014, the Office suspended action on the subject application pending disposition of 3 Square's applications, and a third earlier-filed application from third party Big League Dreams.

On May 9, 2018, Petitioner submitted a response to the suspension letter, arguing 1) continued

suspension based on the Big League Dreams application was unwarranted because the Office had determined there is no likelihood of confusion between Big League Dreams' services and similar services to those of Petitioner, and 2) continued suspension based on 3 Square's applications was unwarranted because 3 Square is the excepted user, its applications are the excepted applications and have not yet cleared the opposition period, and accordingly, per TBMP 1104, a concurrent use proceeding between the subject application and 3 Square's applications is due to be instituted.

On June 2, 2018, the examining attorney issued a new letter continuing the suspension. Although the examining attorney withdrew the likelihood of confusion advisory as to the Big League Dreams application, the examining attorney continued the suspension, citing pending Opp. No. 91239139 and claiming that proceeding "pertains to an issue that could directly affect whether applicant's mark can be registered," citing 15 U.S.C. § 1052, 37 C.F.R. § 2.83, and TMEP §§ 716.02(a), (c)-(d), 1208 *et seq.* The examining attorney further conclusorily stated that "Applicant's arguments as to granting concurrent use have been considered and found unpersuasive."

Pending Opp. No. 91239139 was filed by Petitioner on January 25, 2018, against 3 Square's geographically unrestricted applications, which were allowed only following 3 Square's cancellation of Petitioner's prior registrations for BLD and BLD'S based on priority. Because Opp. No. 91239139 remains pending against 3 Square's unrestricted applications, those applications, which are cited in Petitioner's subject application, have not yet cleared the opposition period.

No other bars to registration have been cited against the subject application.

Points to be Reviewed

Petitioner requests that the Director review whether the examining attorney acted properly in continuing suspension of the subject application. *See* TMEP §§ 716.03, 1704.

Action Requested

Petitioner requests that the subject application be removed from suspension, approved for publication, marked as a concurrent use application, and published in the Official Gazette, so that a concurrent use proceeding between Petitioner's subject application and the 3 Square unrestricted applications can be instituted without further delay. *See* TBMP §§ 1104, 1106.01, 1106.02, 1106.03; 37 C.F.R. § 2.99(b).

Argument in Support

Following the examining attorney's withdrawal of the likelihood of confusion advisory as to the Big League Dreams application, the only earlier-filed applications that remain cited against the subject application are 3 Square's unrestricted applications, both of which were identified in Petitioner's application as owned by 3 Square, an exception to Petitioner's claim of exclusive use.

Per TBMP 1104, the applications involved in a concurrent use proceeding are 1) the concurrent use application (here, Petitioner's subject application), and 2) every earlier-filed conflicting unrestricted application identified in the concurrent use application as owned by an exception to the concurrent

use applicant's claim of exclusive use (here, 3 Square's geographically unrestricted applications). TBMP 1104 also provides that "[i]f any identified application has not yet been published in the Official Gazette, *or has been published but has not yet cleared the opposition period*, the [concurrent use] proceeding *will be instituted*." *Id.* (emphasis added); *see also* TBMP § 1106.03 (same).

Because the only applications that remain cited against Petitioner's application are 3 Square's earlier-filed, unrestricted applications, both of which were identified in Petitioner's application as owned by an exception to Petitioner's claim of exclusive use, and both of which have not yet cleared the opposition period, a concurrent use proceeding is due to be instituted. TBMP §§ 1104, 1106.03. Indeed, 37 C.F.R. § 2.99(b) explicitly states that "[i]f it appears that the applicant is entitled to have the mark registered, subject to a concurrent use proceeding, the mark *will be published* in the Official Gazette as provided by § 2.80." (emphasis added.) *See also* 37 C.F.R. § 2.80 ("The mark will also be published in the case of an application to be placed in . . . concurrent use proceedings, if otherwise registerable.").

Despite the rules clearly providing for publication of Petitioner's application without further delay, the examining attorney has erroneously continued suspension, citing Opposition No. 91239139, filed by Petitioner against 3 Square's unrestricted applications. The examining attorney argues continued suspension is proper because Opposition No. 91239139 "pertains to an issue that could directly affect whether applicant's mark can be registered," citing 15 U.S.C. § 1052, 37 C.F.R. § 2.83, and TMEP §§ 716.02(a), (c)-(d), and 1208 *et seq*. However, neither the pendency of Opposition No. 91239139, nor any of these cited provisions support continuing suspension, making continued suspension of Petitioner's application a clear error and an abuse of discretion.

Opposition No. 91239139 was filed *by Petitioner against 3 Square's unrestricted applications*. It is not a proceeding involving some other mark that might block Petitioner's ability to register its mark; it involves the excepted user's applications that will be involved in a concurrent use proceeding, once Petitioner's application is allowed to publish. Nor can Opposition No. 91239139 "result in a decision that supports a refusal of registration of applicant's mark," because the Board "will consider and determine concurrent use rights *only* in the context of a concurrent use registration proceeding." 37 C.F.R. § 2.99(h) (emphasis added). As the owner of the applications challenged in Opposition No. 91239139, only 3 Square can convert Opposition No. 91239139 to a concurrent use proceeding by amending its unrestricted applications to applications seeking concurrent use excepting Petitioner's area of prior use. *See* TBMP 1113.01. 3 Square has steadfastly refused to do so, leaving Petitioner with no ability to have its concurrent use rights decided absent removal of the subject application from suspension and publication of the application so that a concurrent use proceeding can be instituted. Petitioner's and 3 Square's concurrent use rights will not be determined in Opposition No. 91239139, but rather will only be determined in a concurrent use proceeding, which cannot be instituted unless and until suspension is lifted and Petitioner's application is published.

Turning to the provisions cited as support for continuing suspension, 15 U.S.C. § 1052 includes subsection (d), which expressly provides for the concurrent use registration Petitioner seeks. This statute does not support continuing suspension.

Nor does 37 C.F.R. § 2.83 support continued suspension. While subsection (a) of § 2.83 provides

for publication of the mark with the earliest effective filing date, and subsection (c) provides for suspension of the later-filed application until the published application is registered or abandoned, § 2.83 is not directed to concurrent use applications. 37 C.F.R. § 2.99, which *is* directed to concurrent use applications, expressly states in subsection (b) that "[i]f it appears that the applicant is entitled to have the mark registered, subject to a concurrent use proceeding, the mark *will be published* in the Official Gazette as provided by § 2.80." (emphasis added.) Where, as here, the application identified in a concurrent use application as an exception to the concurrent use applicant's claim of exclusive use has been published but has not yet cleared the opposition period, a concurrent use proceeding *will be instituted*. TBMP § 1104, 1106.03. Continued suspension under these circumstances is clear error and an abuse of discretion.

Nor do any of the cited subsections of TMEP § 716.02 (nor any other subsections of that rule) support continued suspension. TMEP § 716.02 provides that under 37 C.F.R. § 2.67, the examining attorney "has the *discretion* to suspend an application 'for *good and sufficient cause*.'" (emphasis added.) In other words, just because one of TMEP § 716.02's subsections is implicated does not mean the examining attorney *must* suspend the application, but *to* suspend, the examining attorney must have "good and sufficient cause."

Subsection (a) of TMEP § 716.02 is not implicated here, nor does it provide "good and sufficient cause" for continuing suspension. This subsection allows an *applicant* who has a prior *registration* cited against it on likelihood of confusion grounds to *petition to cancel* the prior registration and seek suspension of its application while the cancellation is pending. Opposition No. 91239139, cited as the basis for continuing suspension, is *not* a petition to cancel a prior registration cited against Petitioner. Rather, it is an opposition to registration of 3 Square's unrestricted applications, and it was necessitated by the now more-than-four-years-long suspension of Petitioner's application.[1] Further, it appears that subsection (a) is intended to be invoked by *applicants* as a basis for *requesting* suspension, not by examining attorneys as a basis for continuing suspension.

Subsection (c) of TMEP § 716.02 also does not provide "good and sufficient cause" for continuing suspension. This subsection states that the examining attorney may suspend a later-filed application pending disposition of an earlier-filed application. But as discussed *supra*, where, as here, the application identified in a concurrent use application as an exception to the concurrent use applicant's claim of exclusive use has been published but has not yet cleared the opposition period, a concurrent use proceeding *will be instituted*. TBMP § 1104, 1106.03; *see also* 37 C.F.R. § 2.99(b) ("If it appears that the applicant is entitled to have the mark registered, subject to a concurrent use proceeding, the mark *will be published* in the Official Gazette as provided by § 2.80." (emphasis added)).

Subsection (d) of TMEP § 716.02 also does not provide "good and sufficient cause" for continuing suspension. This subsection states that "[i]f an examining attorney learns of a proceeding pending before the [Board] . . . that may result in a decision that supports a refusal of registration of applicant's mark, the examining attorney *must* issue the refusal and give the applicant an opportunity to respond *before* suspending the application." (emphasis added.) The only proffered basis for continuing suspension is Opposition No. 91239139, filed by Petitioner against 3 Square's unrestricted applications, such that 3 Square's applications have not cleared the opposition period. Again, where, as here, the application identified in a concurrent use application as an exception to the concurrent use applicant's claim of exclusive use has been published but has not yet cleared the

opposition period, a concurrent use proceeding will be instituted. TBMP § 1104, 1106.03; *see also* 37 C.F.R. § 2.99(b).

Further, TMEP § 716.02(d) requires the examining attorney to issue a refusal and give the applicant an opportunity to respond *before* suspending the application. Here, the examining attorney learned of Opposition No. 91239139 and suspended Petitioner's application, *without* first issuing a refusal and giving Petitioner an opportunity to respond. Thus the continued suspension fails to comply with the requirements of TMEP § 716.02(d), and is accordingly an abuse of discretion.

Finally, TMEP § 1208 *et seq*. also does not support continuing suspension. Those sections deal with earlier-filed conflicting marks. But again, here, the earlier-filed conflicting marks are the marks in 3 Square's unrestricted applications, which are cited in Petitioner's application as owned by an exception to Petitioner's claim of exclusive use. Thus, as discussed *supra*, per TBMP §§ 1104 and 1106.03, as well as 37 C.F.R. § 2.99(b), Petitioner's application should be published so that a concurrent use proceeding may be instituted.

The continued suspension also violates TMEP § 716.03. Under that section, if the examining attorney suspends action on an application, and the applicant believes the suspension is improper, the applicant may file a request to remove the application from suspension, stating the reasons why suspension is improper and attaching relevant evidence. Petitioner did exactly this on May 9, 2018. TMEP § 716.03 goes on to state that "[i]f not persuaded by the request, the examining attorney must issue a new suspension action that *addresses the applicant's arguments and explains the reasons why the request is not granted*." (emphasis added.)

The letter continuing suspension conclusorily states, "Applicant's arguments as to granting concurrent use have been considered and found unpersuasive." It fails to explain *why* Petitioner's arguments were unpersuasive. This is a clear error under TMEP § 716.03, particularly where, under the circumstances here, the rules indicate Petitioner's application should be published, not linger in suspension even more years than it already has.

Moreover, Petitioner did not ask the examining attorney to "grant concurrent use." Clearly the examining attorney cannot do so; only the Board can do so, and only through a concurrent use proceeding. *See* 37 C.F.R. § 2.99(h). However, the examining attorney can, and should, lift the suspension, approve the application for publication, and mark the application as a concurrent use application, so that it can be published in the Official Gazette. *See* TBMP §§ 1104, 1106.01, 1106.02, 1106.03; 37 C.F.R. § 2.99(b). What the examining attorney can *not* do, but did here, is continue suspension indefinitely.

For all of these reasons, the continued suspension of Petitioner's application is clear error and an abuse of discretion. Accordingly, Petitioner respectfully requests that the Director reverse the examining attorney's suspension and direct the examining attorney to approve Petitioner's application for publication so that it can be published in the Official Gazette without further delay.

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[1] Notably, the Office did not determine there is no likelihood of confusion between Big League Dreams' services and services similar to Petitioner's until April 17, 2018, when it approved Big League Dreams' application for publication. This was nearly three months after Petitioner filed

Opposition No. 91239139 against 3 Square's unrestricted applications, which was necessitated by their impending registration without any appropriate geographical restrictions while Petitioner's application was still suspended over 3 Square's applications *and* the Big League Dreams application. Since the Big League Dreams application was still pending when the time to oppose 3 Square's unrestricted applications came, Petitioner could not have gotten the suspension lifted prior to filing the opposition.

PAYMENT SECTION	
NUMBER OF CLASSES	1
PETITION FEE	100
TOTAL FEES DUE	100
SIGNATURE SECTION	
DECLARATION SIGNATURE	/Hillary A. Brooks/
SIGNATORY'S NAME	Hillary A. Brooks
SIGNATORY'S POSITION	Attorney of record, Washington bar member
SIGNATORY'S PHONE NUMBER	503-629-1559
DATE SIGNED	06/19/2018
SUBMISSION SIGNATURE	/Hillary A. Brooks/
SIGNATORY'S NAME	Hillary A. Brooks
SIGNATORY'S POSITION	Attorney of record, Washington bar member
SIGNATORY'S PHONE NUMBER	503-629-1559
DATE SIGNED	06/19/2018
AUTHORIZED SIGNATORY	YES

EXHIBIT B

PTO Form No Form Number (Rev 01/2012)

OMB No. 0651-0054 (Exp 12/31/2020)

2.146 Petition to the Director

The table below presents the data as entered.

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STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
FORM TEXT	

PETITION TO THE DIRECTOR PURSUANT TO 37 C.F.R. § 2.146(a)(3)

In re Application Ser. No. 86/143,373

Statement of Facts

The subject application, Ser. No. 86/143,373, filed December 13, 2013, seeks concurrent use registration of the mark BLD'S for "bar and restaurant services." The subject application identifies as the excepted user, if proved, 3 Square, Inc., and identifies as exceptions to the claim of exclusive use, if proved, the marks shown in 3 Square's geographically unrestricted Application Ser. No. 85/586,768 for the mark BLD (filed April 2, 2012), and in 3 Square's geographically unrestricted Application Ser. No. 85/588,233 for the mark BLD (& design) (filed April 3, 2012), both for "restaurant and catering services."

On April 16, 2014, the Office suspended action on the subject application pending disposition of 3 Square's applications, and a third earlier-filed application from third party Big League Dreams.

On May 9, 2018, Petitioner submitted a response to the suspension letter, arguing 1) continued suspension based on the Big League Dreams application was unwarranted because the Office had determined there is no likelihood of confusion between Big League Dreams' services and similar services to those of Petitioner, and 2) continued suspension based on 3 Square's applications was

unwarranted because 3 Square is the excepted user, its applications are the excepted applications and have not yet cleared the opposition period, and accordingly, per TBMP 1104, a concurrent use proceeding between the subject application and 3 Square's applications is due to be instituted.

On June 2, 2018, the examining attorney issued a new letter continuing the suspension. Although the examining attorney withdrew the likelihood of confusion advisory as to the Big League Dreams application, the examining attorney continued the suspension, citing pending Opp. No. 91239139 and claiming that proceeding "pertains to an issue that could directly affect whether applicant's mark can be registered," citing 15 U.S.C. § 1052, 37 C.F.R. § 2.83, and TMEP §§ 716.02(a), (c)-(d), 1208 *et seq.* The examining attorney further conclusorily stated that "Applicant's arguments as to granting concurrent use have been considered and found unpersuasive."

Pending Opp. No. 91239139 was filed by Petitioner on January 25, 2018, against 3 Square's geographically unrestricted applications, which were allowed only following 3 Square's cancellation of Petitioner's prior registrations for BLD and BLD'S based on priority. Because Opp. No. 91239139 remains pending against 3 Square's unrestricted applications, those applications, which are cited in Petitioner's subject application, have not yet cleared the opposition period.

No other bars to registration have been cited against the subject application.

Points to be Reviewed

Petitioner requests that the Director review whether the examining attorney acted properly in continuing suspension of the subject application. *See* TMEP §§ 716.03, 1704.

Action Requested

Petitioner requests that the subject application be removed from suspension, approved for publication, marked as a concurrent use application, and published in the Official Gazette, so that a concurrent use proceeding between Petitioner's subject application and the 3 Square unrestricted applications can be instituted without further delay. *See* TBMP §§ 1104, 1106.01, 1106.02, 1106.03; 37 C.F.R. § 2.99(b).

Argument in Support

Following the examining attorney's withdrawal of the likelihood of confusion advisory as to the Big League Dreams application, the only earlier-filed applications that remain cited against the subject application are 3 Square's unrestricted applications, both of which were identified in Petitioner's application as owned by 3 Square, an exception to Petitioner's claim of exclusive use.

Per TBMP 1104, the applications involved in a concurrent use proceeding are 1) the concurrent use application (here, Petitioner's subject application), and 2) every earlier-filed conflicting unrestricted application identified in the concurrent use application as owned by an exception to the concurrent use applicant's claim of exclusive use (here, 3 Square's geographically unrestricted applications). TBMP 1104 also provides that "[i]f any identified application has not yet been published in the Official Gazette, *or has been published but has not yet cleared the opposition period*, the

[concurrent use] proceeding *will be instituted*." *Id.* (emphasis added); *see also* TBMP § 1106.03 (same).

Because the only applications that remain cited against Petitioner's application are 3 Square's earlier-filed, unrestricted applications, both of which were identified in Petitioner's application as owned by an exception to Petitioner's claim of exclusive use, and both of which have not yet cleared the opposition period, a concurrent use proceeding is due to be instituted. TBMP §§ 1104, 1106.03. Indeed, 37 C.F.R. § 2.99(b) explicitly states that "[i]f it appears that the applicant is entitled to have the mark registered, subject to a concurrent use proceeding, the mark *will be published* in the Official Gazette as provided by § 2.80." (emphasis added.) *See also* 37 C.F.R. § 2.80 ("The mark will also be published in the case of an application to be placed in . . . concurrent use proceedings, if otherwise registerable.").

Despite the rules clearly providing for publication of Petitioner's application without further delay, the examining attorney has erroneously continued suspension, citing Opposition No. 91239139, filed by Petitioner against 3 Square's unrestricted applications. The examining attorney argues continued suspension is proper because Opposition No. 91239139 "pertains to an issue that could directly affect whether applicant's mark can be registered," citing 15 U.S.C. § 1052, 37 C.F.R. § 2.83, and TMEP §§ 716.02(a), (c)-(d), and 1208 *et seq.* However, neither the pendency of Opposition No. 91239139, nor any of these cited provisions support continuing suspension, making continued suspension of Petitioner's application a clear error and an abuse of discretion.

Opposition No. 91239139 was filed *by Petitioner against 3 Square's unrestricted applications*. It is not a proceeding involving some other mark that might block Petitioner's ability to register its mark; it involves the excepted user's applications that will be involved in a concurrent use proceeding, once Petitioner's application is allowed to publish. Nor can Opposition No. 91239139 "result in a decision that supports a refusal of registration of applicant's mark," because the Board "will consider and determine concurrent use rights *only* in the context of a concurrent use registration proceeding." 37 C.F.R. § 2.99(h) (emphasis added). As the owner of the applications challenged in Opposition No. 91239139, only 3 Square can convert Opposition No. 91239139 to a concurrent use proceeding by amending its unrestricted applications to applications seeking concurrent use excepting Petitioner's area of prior use. *See* TBMP 1113.01. 3 Square has steadfastly refused to do so, leaving Petitioner with no ability to have its concurrent use rights decided absent removal of the subject application from suspension and publication of the application so that a concurrent use proceeding can be instituted. Petitioner's and 3 Square's concurrent use rights will not be determined in Opposition No. 91239139, but rather will only be determined in a concurrent use proceeding, which cannot be instituted unless and until suspension is lifted and Petitioner's application is published.

Turning to the provisions cited as support for continuing suspension, 15 U.S.C. § 1052 includes subsection (d), which expressly provides for the concurrent use registration Petitioner seeks. This statute does not support continuing suspension.

Nor does 37 C.F.R. § 2.83 support continued suspension. While subsection (a) of § 2.83 provides for publication of the mark with the earliest effective filing date, and subsection (c) provides for suspension of the later-filed application until the published application is registered or abandoned, § 2.83 is not directed to concurrent use applications. 37 C.F.R. § 2.99, which *is* directed to concurrent

use applications, expressly states in subsection (b) that "[i]f it appears that the applicant is entitled to have the mark registered, subject to a concurrent use proceeding, the mark *will be published* in the Official Gazette as provided by § 2.80." (emphasis added.) Where, as here, the application identified in a concurrent use application as an exception to the concurrent use applicant's claim of exclusive use has been published but has not yet cleared the opposition period, a concurrent use proceeding *will be instituted*. TBMP § 1104, 1106.03. Continued suspension under these circumstances is clear error and an abuse of discretion.

Nor do any of the cited subsections of TMEP § 716.02 (nor any other subsections of that rule) support continued suspension. TMEP § 716.02 provides that under 37 C.F.R. § 2.67, the examining attorney "has the *discretion* to suspend an application 'for *good and sufficient cause*.'" (emphasis added.) In other words, just because one of TMEP § 716.02's subsections is implicated does not mean the examining attorney *must* suspend the application, but *to* suspend, the examining attorney must have "good and sufficient cause."

Subsection (a) of TMEP § 716.02 is not implicated here, nor does it provide "good and sufficient cause" for continuing suspension. This subsection allows an *applicant* who has a prior *registration* cited against it on likelihood of confusion grounds to *petition to cancel* the prior registration and seek suspension of its application while the cancellation is pending. Opposition No. 91239139, cited as the basis for continuing suspension, is *not* a petition to cancel a prior registration cited against Petitioner. Rather, it is an opposition to registration of 3 Square's unrestricted applications, and it was necessitated by the now more-than-four-years-long suspension of Petitioner's application.[1] Further, it appears that subsection (a) is intended to be invoked by *applicants* as a basis for *requesting* suspension, not by examining attorneys as a basis for continuing suspension.

Subsection (c) of TMEP § 716.02 also does not provide "good and sufficient cause" for continuing suspension. This subsection states that the examining attorney may suspend a later-filed application pending disposition of an earlier-filed application. But as discussed *supra*, where, as here, the application identified in a concurrent use application as an exception to the concurrent use applicant's claim of exclusive use has been published but has not yet cleared the opposition period, a concurrent use proceeding *will be instituted*. TBMP § 1104, 1106.03; *see also* 37 C.F.R. § 2.99(b) ("If it appears that the applicant is entitled to have the mark registered, subject to a concurrent use proceeding, the mark *will be published* in the Official Gazette as provided by § 2.80." (emphasis added)).

Subsection (d) of TMEP § 716.02 also does not provide "good and sufficient cause" for continuing suspension. This subsection states that "[i]f an examining attorney learns of a proceeding pending before the [Board] . . . that may result in a decision that supports a refusal of registration of applicant's mark, the examining attorney *must* issue the refusal and give the applicant an opportunity to respond *before* suspending the application." (emphasis added.) The only proffered basis for continuing suspension is Opposition No. 91239139, filed by Petitioner against 3 Square's unrestricted applications, such that 3 Square's applications have not cleared the opposition period. Again, where, as here, the application identified in a concurrent use application as an exception to the concurrent use applicant's claim of exclusive use has been published but has not yet cleared the opposition period, a concurrent use proceeding will be instituted. TBMP § 1104, 1106.03; *see also* 37 C.F.R. § 2.99(b).

Further, TMEP § 716.02(d) requires the examining attorney to issue a refusal and give the applicant an opportunity to respond *before* suspending the application. Here, the examining attorney learned of Opposition No. 91239139 and suspended Petitioner's application, *without* first issuing a refusal and giving Petitioner an opportunity to respond. Thus the continued suspension fails to comply with the requirements of TMEP § 716.02(d), and is accordingly an abuse of discretion.

Finally, TMEP § 1208 *et seq*. also does not support continuing suspension. Those sections deal with earlier-filed conflicting marks. But again, here, the earlier-filed conflicting marks are the marks in 3 Square's unrestricted applications, which are cited in Petitioner's application as owned by an exception to Petitioner's claim of exclusive use. Thus, as discussed *supra*, per TBMP §§ 1104 and 1106.03, as well as 37 C.F.R. § 2.99(b), Petitioner's application should be published so that a concurrent use proceeding may be instituted.

The continued suspension also violates TMEP § 716.03. Under that section, if the examining attorney suspends action on an application, and the applicant believes the suspension is improper, the applicant may file a request to remove the application from suspension, stating the reasons why suspension is improper and attaching relevant evidence. Petitioner did exactly this on May 9, 2018. TMEP § 716.03 goes on to state that "[i]f not persuaded by the request, the examining attorney must issue a new suspension action that *addresses the applicant's arguments and explains the reasons why the request is not granted*." (emphasis added.)

The letter continuing suspension conclusorily states, "Applicant's arguments as to granting concurrent use have been considered and found unpersuasive." It fails to explain *why* Petitioner's arguments were unpersuasive. This is a clear error under TMEP § 716.03, particularly where, under the circumstances here, the rules indicate Petitioner's application should be published, not linger in suspension even more years than it already has.

Moreover, Petitioner did not ask the examining attorney to "grant concurrent use." Clearly the examining attorney cannot do so; only the Board can do so, and only through a concurrent use proceeding. *See* 37 C.F.R. § 2.99(h). However, the examining attorney can, and should, lift the suspension, approve the application for publication, and mark the application as a concurrent use application, so that it can be published in the Official Gazette. *See* TBMP §§ 1104, 1106.01, 1106.02, 1106.03; 37 C.F.R. § 2.99(b). What the examining attorney can *not* do, but did here, is continue suspension indefinitely.

For all of these reasons, the continued suspension of Petitioner's application is clear error and an abuse of discretion. Accordingly, Petitioner respectfully requests that the Director reverse the examining attorney's suspension and direct the examining attorney to approve Petitioner's application for publication so that it can be published in the Official Gazette without further delay.

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[1] Notably, the Office did not determine there is no likelihood of confusion between Big League Dreams' services and services similar to Petitioner's until April 17, 2018, when it approved Big League Dreams' application for publication. This was nearly three months after Petitioner filed Opposition No. 91239139 against 3 Square's unrestricted applications, which was necessitated by their impending registration without any appropriate geographical restrictions while Petitioner's

application was still suspended over 3 Square's applications *and* the Big League Dreams application. Since the Big League Dreams application was still pending when the time to oppose 3 Square's unrestricted applications came, Petitioner could not have gotten the suspension lifted prior to filing the opposition.

PAYMENT SECTION	
NUMBER OF CLASSES	1
PETITION FEE	100
TOTAL FEES DUE	100
SIGNATURE SECTION	
DECLARATION SIGNATURE	/Hillary A. Brooks/
SIGNATORY'S NAME	Hillary A. Brooks
SIGNATORY'S POSITION	Attorney of record, Washington bar member
SIGNATORY'S PHONE NUMBER	503-629-1559
DATE SIGNED	06/19/2018
SUBMISSION SIGNATURE	/Hillary A. Brooks/
SIGNATORY'S NAME	Hillary A. Brooks
SIGNATORY'S POSITION	Attorney of record, Washington bar member
SIGNATORY'S PHONE NUMBER	503-629-1559
DATE SIGNED	06/19/2018
AUTHORIZED SIGNATORY	YES