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THE TTAB

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

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Mailed: February 24, 2020

**Opposition No. 91249349 (dismissed)**

*3 Square, Inc.*

*v.*

*San Pasqual Casino Development Group, Inc.*

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**Opposition No. 91239139 (Parent)**

**Concurrent Use No. 94002916**

*San Pasqual Casino Development Group, Inc.*

*v.*


*3 Square, Inc.*

**By the Trademark Trial and Appeal Board:**

This case now comes before the Board for consideration of the motion, filed July 10, 2019, by San Pasqual Casino Development Group, Inc. (“Applicant”) to dismiss the notice of opposition and convert the proceeding to a concurrent use proceeding. 3 Square, Inc. (“Opposer”) has filed a brief in opposition to the motion.

By way of background, on December 13, 2013, Applicant filed applications for concurrent use registration of the standard character mark BLD for “restaurant

services” in International 43<sup>1</sup> and the standard character mark BLD’S for “bar and restaurant services” in International Class 43.<sup>2</sup> The applications include the following concurrent use information: “Registration limited to the area comprising the entire United States except for 77450 Beverly Blvd, Los Angeles California 90036, and a ten mile radius thereof.”

On July 3, 2019, Opposer filed a consolidated notice of opposition to registration of the applications on the grounds of likelihood of confusion based on Opposer’s alleged prior common law use of the mark BLD in connection with restaurant services. Opposer also pleads ownership of pending application Serial No. 85588233 for the design mark ,<sup>3</sup> and Serial No. 85586768 for the standard character mark BLD.<sup>4</sup> Both of Opposer’s pleaded applications are for “restaurant and catering services” in International Class 43.

By its motion, Applicant seeks to dismiss the present opposition and convert it to a concurrent use proceeding to determine whether Applicant’s involved concurrent use applications are entitled to concurrent use registrations with Opposer as the

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<sup>1</sup> Application Serial No. 86143341 is based on a claim of use in commerce under Trademark Act Section 1(a), 15 U.S.C. § 1051(a). Applicant claims June 17, 2009 as the date of first use anywhere and the date of first use in commerce.

<sup>2</sup> Application Serial No. 86143373 is based on a claim of use in commerce under Section 1(a). Applicant claims October 30, 2007 as the date of first use anywhere and date of first use in commerce.

<sup>3</sup> The application was filed on April 3, 2012 based on an allegation of use in commerce under Trademark Act Section 1(a), 15 U.S.C. 1051(a). The application includes the following color claim and description of the mark: “The color(s) brick red and white is/are claimed as a feature of the mark. The mark consists of ‘bld’ written in stylized lower-case white lettering that is displayed symmetrically in the center of a vertically oriented brick-red rectangle.”

<sup>4</sup> The application was filed on April 2, 2012, based on an allegation of use in commerce under Trademark Act Section 1(a).

excepted user. Applicant also moves to consolidate Opposition No. 91239139 with the resultant concurrent use proceeding. Opposer argues that there is no basis for dismissing the opposition because a concurrent use proceeding has not been instituted and Applicant has not specified any parties as an exception in its application. 6 TTABVUE 2. Opposer also argues that the proceeding should not be instituted because the Board already determined in a prior cancellation that Opposer has prior rights in the mark BLD and that Applicant's use of its marks is likely to cause confusion.<sup>5</sup> *Id.* Opposer further argues that because Applicant had actual knowledge of Opposer's prior rights when it filed the involved applications "Applicant cannot meet the requirements of Section 2(d), which make concurrent use proceedings available only in situations where confusion, mistake or deception is not likely to result from the continued lawful use of the marks at issue." *Id.* at 3.

#### **I. Conversion to Concurrent Use**

Where an applicant seeks a geographically restricted registration in which it names an opposer to that registration as an excepted user to its exclusive right to use the mark, the appropriate forum for adjudication of the respective rights of the parties is a concurrent use proceeding. Therein, the named excepted user may attempt to establish that applicant is not entitled to the concurrent use registration sought. *See* Trademark Rule 2.99(h); *Inland Oil & Trans. Co. v. IOT Corp.*, 197 USPQ

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<sup>5</sup> Opposer cites Cancellation No. 92056703 but has not provided a copy of the decision with its response.

562, 564 (TTAB 1977); *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1108 (June 2019).

Applicant, in each of the involved applications, names Opposer and its pending applications as exceptions to Applicant's claim of exclusive use as follows:

Exceptions to the claim of exclusive use, if proved, include: the marks shown in U.S. Trademark Application Serial No. 85588233 for the mark BLD (& design) and U.S. Trademark Application Serial No. 85586768 for the mark BLD, both for restaurant and catering services, and both owned by 3 Square, Inc., at 7450 Beverly Blvd., Los Angeles California 90036, and a ten miles radius thereof, from the period July 17, 2006 to present.<sup>6</sup>

By identifying Opposer as an exception to its exclusive right to use, Applicant has, in effect, admitted that it is not entitled to a territorially unrestricted registration. *See Inland Oil & Transp. Co., supra*. Thus, Opposer's arguments are without merit. Opposer, as the defendant in the concurrent use proceeding, will have the opportunity to show that Applicant is not entitled to the geographically limited concurrent use registration it seeks. *See, e.g., Boi Na Braza, LLC v. Terra Sul Corp.*, 110 USPQ2d 1386, 1388 & n.8 (TTAB 2014) (noting that, had defendant not opposed plaintiff's geographically restricted application, a concurrent use proceeding would have been instituted earlier and defendant would have maintained the option to contest plaintiff's application).

In view of the foregoing, the Board finds that a concurrent use proceeding is the appropriate forum for the parties to adjudicate their respective rights. Accordingly,

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<sup>6</sup> See Applicant's March 25, 2014 Response to Office Action in each of the involved applications. The file of the involved applications automatically forms part of the record in this proceeding. Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1).

Applicant's motion to dismiss the opposition is **GRANTED**. The opposition is dismissed without prejudice in favor of a concurrent use proceeding.

## II. Consolidation

With respect to the request of San Pasquale Casino Development Group to consolidate related Opposition No. 91239139 with the concurrent use proceeding, the Board notes that consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. *See, e.g., Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991). When cases involving common questions of law or fact are pending before the Board, the Board may order consolidation of the cases. *See Fed. R. Civ. P. 42(a); Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991); and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991). In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense which may be gained from consolidation, against any prejudice or inconvenience which may be caused thereby.

In this case, the parties to Opposition No. 91239139 and the newly instituted concurrent use proceeding are identical and the issues are clearly related. Although consolidation of a concurrent use proceeding with an opposition proceeding is unusual, the Board finds consolidation appropriate under the circumstances here. Accordingly, the motion to consolidate is granted. Concurrent Use No. 94002916 and Opposition No. 91239139 are hereby **consolidated** and may be presented on the

same record and briefs. See *Hilson Research Inc. v. Society for Human Resource Management*, *supra*; and *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989).

Because the Board is likely to determine the issues in Opposition No. 91239139 prior to determination of the concurrent use proceeding, the Board file will be maintained in Opposition No. 91239139 as the “parent case.” From this point on, only a single copy of all motions and submissions should be filed, and each submission should be filed in the parent case only, but caption all consolidated proceeding numbers, listing and identifying the parent case first. However, inasmuch as these proceedings are being consolidated prior to the filing of an answer in the concurrent use proceeding, a separate answer should be filed in the concurrent use proceeding before commencing the practice of filing a single copy of all submissions in the parent case.<sup>7</sup> An answer must be filed through ESTTA, the Board’s Electronic System for Trademark Trials and Appeals. See Trademark Rules 2.106(b)(1) and 2.114(b)(1).

Despite being consolidated, each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file.

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<sup>7</sup> The parties should promptly inform the Board of any other Board proceedings or related cases within the meaning of Fed. R. Civ. P. 42, so that the Board can consider whether further consolidation is appropriate.

**NATURE OF A CONCURRENT USE PROCEEDING**

The parties should note that the only issue properly before the Board in a concurrent use proceeding concerns the concurrent use applicant's entitlement to concurrent registration. The specific territorial rights to which any common law users are entitled are not before the Board except to the extent that their registration rights may be limited by the territorial rights to which applicant proves entitlement. As a common law user, any registration rights of Opposer can be determined only if and when its application(s) become involved in a concurrent use proceeding. TBMP §§ 1104 and 1108.

**NOTICE OF INSTITUTION OF A CONCURRENT USE PROCEEDING**

Applicant in application Serial Nos. 86143341 and 86143373 has applied for a concurrent use registration for the trademarks or service marks set forth below.

Name of Applicant: San Pasqual Casino Development Group, Inc.

Applicant's address: 16300 Nyemii Pass Rd.  
Valley View, California 92082

Applicant's Marks:

Application Serial No. 86143341 BLD

Good or Services  
Class 43: Restaurant services

Filing Date: December 13, 2013

Territory of Use: The area comprising the entire United States except for 7450 Beverly Blvd., Los Angeles, CA 90036, and a ten miles radius thereof.

Application Serial No. 86143373 BLD'S

Goods or Services  
Class 43: Bar and restaurant services

Filing Date: December 13, 2013

Territory of Use: The area comprising the entire United States except for 7450 Beverly Blvd., Los Angeles, CA 90036, and a ten miles radius thereof.

Attorney: Hillary A. Brooks  
Brooks Quinn LLC  
6513 132<sup>nd</sup> Ave. NE #378  
Kirkland, WA 98033

In its applications, Applicant (plaintiff in the concurrent use proceeding) has recited as an exception to its allegation of exclusive use of the marks, use by 3 Square, Inc. of identical or very similar marks. These identical or very similar marks, the services and the territory of use, *as acknowledged* in the referenced applications, are set out below in a summary of details of the applications.

Application Serial No. 85586768

The Mark: BLD

Goods or Services: Restaurant and catering services, in Class 43

The Territory of Use: The area comprising 7450 Beverly Blvd., Los Angeles CA 90036, and a ten miles radius thereof.

Application Serial No. 85588233

The mark: 

Goods or Services: Restaurant and catering services in Class 43





## **FILING AN ANSWER**

Trademark Rule 2.99 provides that:

An answer to the notice is not required in the case of an applicant or registrant whose application or registration is specified in the application to register as a concurrent user in the application, but a statement, if desired, may be filed within forty days after the mailing of the notice; in the case of any other party specified as a concurrent user in the application, an answer must be filed within forty days after the mailing of the notice.

As the owner of application Serial Nos. 85588233 and 85586768 **is not required to file an answer** but may do so under Trademark Rule 2.99. The Trademark Trial and Appeal Board has set April 4, 2020 as the due date for any such answer. (*See* Patent and Trademark Rule 2.196 for expiration of this or any deadline falling on a Saturday, Sunday or federal holiday.) If filed, the answer should be directed to the allegations relating to concurrent use recited in the plaintiff's application identified herein.

If defendant chooses to file an answer, the defendant must file the answer through ESTTA (Electronic System for Trademark Trials and Appeals), unless ESTTA is unavailable due to technical problems or extraordinary circumstances are present. An answer filed on paper under these limited circumstances must be accompanied by a Petition to the Director (and the required fee under Trademark Rule 2.6). *See* Trademark Rule 2.126(b).

## **DUTY TO MAINTAIN ACCURATE CORRESPONDENCE INFORMATION**

Throughout this proceeding, the parties, and their attorneys or representatives, must notify the Board of any correction or update of physical address and email address, and should use the ESTTA change of address form. *See* Trademark Rule 2.18(b); TBMP § 117.

## **SERVICE OF ANSWER AND OF ALL SUBMISSIONS**

The service of the answer, and all other submissions in this proceeding, and of all matters that are required to be served but not required to be filed in the proceeding record, **must be by email** unless the parties stipulate otherwise. Trademark Rule 2.119(b). In the absence of a stipulation, service may be by other means only under the limited circumstances and in a manner specified in Trademark Rule 2.119(b). Regarding the signing and service of all submissions, *see* TBMP §§ 113-113.04. The answer, and all other submissions, must include proof of service. As noted in TBMP § 113.03, proof of service may be in the following certificate of service form:

*I hereby certify that a true and complete copy of the foregoing (insert title of submission) has been served on (insert name of counsel or party) by emailing (or insert other stipulated or allowed method of delivery) said copy on (insert date of transmission) to: (insert name and email address(es) of counsel or party).*

*Signature*\_\_\_\_\_

*Date*\_\_\_\_\_

## **SETTLEMENT NEGOTIATIONS BEFORE FILING ANSWER**

It is noted that most concurrent use proceedings result in a negotiated settlement and the parties are encouraged to promptly begin discussion of settlement. If the parties choose to begin settlement talks prior to the due date for the answer, they may stipulate to a suspension to accommodate settlement talks.

## **SUBMIT ALL FILINGS ONLINE VIA ESTTA**

Submissions **must** be filed via ESTTA, the Board's online filing system, unless ESTTA is unavailable due to technical problems or extraordinary circumstances are present. Trademark Rule 2.126(a). Submissions may be filed in paper form **only** under the **limited** circumstances specified in Trademark Rule 2.126(b), with a required written explanation. ESTTA is accessible at the Board's web page: <http://estta.uspto.gov/>. The page has instructions and tips. ESTTA offers various forms, some of which may require attachments and/or a fee. For technical questions, a party may call 571-272-8500 or email [ESTTA@uspto.gov](mailto:ESTTA@uspto.gov). This proceeding involves several deadlines, and due to potential technical issues, parties should not wait until the deadline to submit filings. The Board may **decline to consider** an untimely submission. Moreover, Trademark Rule 2.126 sets forth the required form and format for all submissions (*e.g.*, page limitations), and the Board may **decline to consider** any submission that does not comply with this rule, including, but not limited to motions, briefs, exhibits, and deposition transcripts.

## **CONFERENCE, DISCOVERY, DISCLOSURE AND TRIAL SCHEDULE**

The schedule for this case, including the deadline for the answer, the parties' conference, disclosures, discovery, trial and briefing is set out below and is also viewable in the Board's TTABVUE system at the following web address:

<http://ttabvue.uspto.gov/ttabvue/>.

Time to Answer	4/4/2020
Deadline for Discovery Conference	5/4/2020
Discovery Opens	5/4/2020
Initial Disclosures Due	6/3/2020
Expert Disclosures Due	10/1/2020
Discovery Closes	10/31/2020
Plaintiff's Pretrial Disclosures Due	12/15/2020
Plaintiff's 30-day Trial Period Ends	1/29/2021
Defendant's Pretrial Disclosures Due	2/13/2021
Defendant's 30-day Trial Period Ends	3/30/2021
Plaintiff's Rebuttal Disclosures Due	4/14/2021
Plaintiff's 15-day Rebuttal Period Ends	5/14/2021
Plaintiff's Opening Brief Due	7/13/2021
Defendant's Brief Due	8/12/2021
Plaintiff's Reply Brief Due	8/27/2021

### **PARTIES ARE REQUIRED TO HOLD DISCOVERY CONFERENCE**

The parties are required to schedule and hold a discovery conference by the deadline in the schedule of this order, or as reset by the Board. In the conference, the parties are required to discuss, at a minimum, (1) the nature and basis of their claims and defenses, (2) the possibility of settling the case or at least narrowing the scope of claims or defenses, and (3) arrangements for disclosures, discovery, preserving discoverable information, and introduction of evidence at trial. For guidance, *see* Fed. R. Civ. P. 26(f), Trademark Rule 2.120(a)(2)(i) and TBMP §§ 401.01 and 408.01(a).

The parties must hold the conference in person, by telephone or by a means on which they agree. A Board interlocutory attorney or administrative trademark judge will participate in the conference either upon request of any party made no later than ten

(10) days prior to the conference deadline, or when the Board deems it useful to have Board involvement. *See* Trademark Rule 2.120(a)(2)(i). A request for Board participation must be made either through ESTTA, or by telephone call to the assigned interlocutory attorney named on the TTABVue record for this proceeding.

A party requesting Board participation should first determine possible dates and times when all parties are available. A conference with the Board attorney's participation will be by telephone in accordance with the Board's instructions.

For efficiency, the parties may stipulate to various procedural and substantive disclosure, discovery and trial matters (e.g., modification of deadlines and obligations) upon written stipulation and approval by the Board. Trademark Rule 2.120(a)(2)(iv) provides a non-exhaustive list of matters to which parties may stipulate. The best practice is to reduce all stipulations to writing. If email service is not practical, such as for voluminous document production in discovery, the parties should discuss in the conference how production will be made. The parties, and their attorneys or representatives, have a duty to cooperate in the discovery process. TBMP § 408.01.

## **PROTECTIVE ORDER FOR CONFIDENTIAL INFORMATION**

The Board's Standard Protective Order is automatically imposed in all *inter partes* proceedings, and is available at: <http://www.uspto.gov/trademarks-application-process/appealing-trademark-decisions/standard-documents-and-guidelines-0>. During their conference, the parties should discuss whether they will use an alternative or modified protective order, subject to approval by the Board. *See* Trademark Rule 2.116(g) and TBMP § 412. The standard order does not automatically protect confidential information; its provisions for designating confidential information must be utilized as needed by the parties. Trademark Rule 2.126(c) sets forth the procedure for filing confidential submissions.

## **ACCELERATED CASE RESOLUTION (ACR)**

During their conference, the parties are to discuss whether they wish to seek mediation or arbitration, and whether they can stipulate to the Board's Accelerated Case Resolution (ACR) process for a more efficient and cost-effective means of obtaining the Board's determination of the proceeding. For details, and examples of ACR proceedings, *see* TBMP § 528, and the Board's webpage: <http://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board-ttab>.

## **INITIAL DISCLOSURES AND DISCOVERY**

Regarding the deadline for and contents of initial disclosures, *see* Trademark Rules 2.120(a)(1) and (2)(i), and TBMP § 401.02. Regarding deadlines for serving and responding to discovery, *see* Trademark Rule 2.120(a)(3) and TBMP § 403.03. Certain provisions of Fed. R. Civ. P. 26 are applicable in modified form. Note that written discovery (interrogatories, requests for production, requests for admission) must be served early enough so that responses will be due no later than the close of discovery. Regarding the scope and limits of discovery, *see* TBMP 414; discoverable items may include documents, tangible things, and electronically stored information (ESI).

## **MOTIONS**

Certain provisions of Fed. R. Civ. P. 11 apply to all submissions in Board proceedings. *See* TBMP § 527.02. Regarding available motions, *see* TBMP Chapter 500. Regarding applicable deadlines to respond to motions, depending on the motion filed, *see* Trademark Rules 2.127(a) and (e)(1). When a party timely files a potentially dispositive motion the proceeding is suspended with respect to all matters not germane to the motion. *See* Trademark Rule 2.127(d). In addressing motions or other filings, if it appears to the Board that a telephone conference would be beneficial, the Board may, upon its own initiative or upon request made by a party, schedule a telephone conference. *See* Trademark Rule 2.120(j)(1) and TBMP § 502.06(a).



## **PRETRIAL DISCLOSURES, TRIAL AND BRIEFING**

Regarding the procedures and deadlines for pretrial disclosures and trial, and specifically the noticing, taking, serving and submitting of evidence and testimony, *see* Trademark Rules 2.120(k), 2.121, 2.122, 2.123 and 2.125, as well as TBMP Chapter 700. The parties should review these authorities. For example: witness testimony may be submitted in the form of affidavit or declaration subject to the right to oral cross examination; transcripts of testimony depositions, with exhibits, must be served on each adverse party within thirty (30) days after completion of taking the testimony; certified transcripts and exhibits must be filed, with notice of such filing served on each adverse party; and all notices of reliance must be submitted during the submitting party's assigned testimony period and must indicate generally the relevance of the evidence and associate it with one or more issues.

Main briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing is not required, but will be scheduled upon separate notice timely filed pursuant to Trademark Rule 2.129(a). Regarding briefs and oral hearings, *see* TBMP §§ 801-802.

## **LEGAL RESOURCES AVAILABLE AT WEB PAGE**

For a general description of Board proceedings, *see* TBMP §102.03. Proceedings are governed by the Trademark Rules of Practice in Parts 2 and 7 of Title 37 of the Code of Federal Regulations. These rules, the Manual of Procedure (TBMP), information on Accelerated Case Resolution (ACR) and Alternative Dispute

Opposition Nos. 91249349, 91239139, and Concurrent Use No. 94002916

Resolution (ADR), and many Frequently Asked Questions, are available on the Board's web page, at:

<http://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board-ttab>. The parties should check the web page for important changes, announcements, etc., many of which apply to proceedings already in progress.

#### **PARTIES NOT REPRESENTED BY COUNSEL**

This proceeding is similar to a civil action in a federal district court and can be complex. The Board strongly advises all parties to secure the services of an attorney who is familiar with trademark law and Board procedure. The Board cannot aid in the selection of an attorney. *See* TBMP § 114.02. The Board requires strict compliance with all applicable authorities whether or not the party is represented by counsel.