

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
General Email: TTABInfo@uspto.gov

DelGizzi

August 20, 2020

Concurrent Use No. 94001076

*TMC Franchise Corp., (by assignment from
ExxonMobil Oil Corporation)¹
(Registration No. 2110223)*

v.

*Ronald D. Donohue
(Common law user)*

Louis Perry²
Faegre Drinker Biddle & Reath
300 N. Meridian St., Suite 2500
Indianapolis, IN 46204
louis.perry@faegredrinker.com

Heirs of Ronald D. Donahue
921 E. State Highway 51
Coweta, Oklahoma 74429

By the Board:

This case comes up for consideration of TMC Franchise Corp's ("TMC") motion to reopen this proceeding to remove the concurrent use restriction with respect to

¹ The change of name from Mobil Oil Corporation to ExxonMobil Oil Corporation has been recorded with the Assignment Recordation Branch of the Office at Reel/Frame 2441/0092 on July 23, 2001. The assignment from ExxonMobil Oil Corporation to TMC Franchise Corp. has been recorded at Reel/Frame 4052/0230 on August 26, 2009.

² Plaintiff's change of correspondence address is noted and the record of this proceeding has been updated to reflect the change.

Registration No. 2110223 for the mark ON THE RUN identified for use in connection with retail convenience services in International Class 42.

I. Background

TMC applied for registration of the mark ON THE RUN, for “retail convenience store services” in International Class 42, seeking concurrent use registration for the area comprising the entire United States except the state of Oklahoma. At publication, application Serial No. 74607695 contained the following concurrent use statement:

Subject to concurrent use proceeding with Ronald D. Donahue, an individual, located and doing business at 9221 East State Highway 51, Coweta, Oklahoma 74429, Applicant claims exclusive right to use the mark in the area comprising the entire United States, except for the state of Oklahoma.

In an order dated September 5, 1997 (*Unclassified*, Feb. 20, 2007, TSDR pgs. 3-5), the Trademark Trial and Appeal Board, (“Board”) found that TMC had established that the concurrent use of its application with Ronald D. Donahue was not likely to lead to confusion, mistake or deception, and found TMC was entitled to a concurrent use registration for the area comprising the entire United States except for the state of Oklahoma.

Application Serial No. 74607695 matured into restricted Registration No. 2110223 on November 4, 1997. TMC now moves for leave to amend its registration to remove the concurrent use restriction.

II. Motion to Remove Restriction

A party that seeks to alter a concurrent use restriction to its registration may only do so, if at all, through an appropriate decision in a new concurrent use proceeding before the Board, or by order of a court of competent jurisdiction. However, removal of such a restriction by amendment under Trademark Act § 7(e) may be permitted where an entity that was the only exception to registrant's right to exclusive use of its registered mark assigns its rights in its mark to registrant, so that all rights in the mark are merged in registrant. *In re Alfred Dunhill Ltd.*, 4 USPQ2d 1383, 1384 (Comm'r 1987) (assignment of rights resulted in removal of limitation on concurrent user's exclusive right to use); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1114 (2020). TMC has moved the Board to remove the concurrent use restriction in this case because it believes that Ronald D. Donahue is no longer using the mark ON THE RUN in connection with retail convenience store services.

Because Ronald D. Donahue has not assigned its rights to TMC, and TMC has submitted evidence in support of its belief that Ronald C. Donahue may have abandoned its common law rights and owns no subsisting registration thereof, TMC, as the owner of the remaining concurrent use registration, may file a new application for an unrestricted registration of the mark. *See* TBMP § 1114 (June 2020).

Accordingly, TMC's motion to amend its registration to remove the concurrent use restriction is DENIED.