UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: November 24, 2008

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Opposition No. 91184018

Crown Automotive Management, Inc.

v.

Asbury Automotive Group, Inc.

Concurrent Use No. 94002373

Asbury Automotive Group, Inc.

v.

Crown Automotive Management, Inc.

and

Crown Automobile Co.

Before Walters, Zervas and Mermelstein, Administrative Trademark Judges

By the Board:

Applicant Asbury Automotive Group, Inc. seeks to register the mark CROWN AUTOMOTIVE (with crown design) for

"automobile dealerships" in International Class 35.[1] As grounds for the opposition, opposer Crown Automotive Management, Inc., alleges, *inter alia*, that the purchasing public is likely "to be confused and to believe that there is some relationship between Applicant and Opposer," because both parties are using the same or confusingly similar marks for identical services.[2] In support of its claims, opposer essentially alleges priority based on common law rights accruing from continuous use of the trade name Crown Automotive and the service mark CROWN for automobile dealerships since at least 1970. An answer has not been filed in this proceeding.

This case now comes up for consideration of applicant's motion (filed June 23, 2008) to amend the involved application to one for concurrent use registration and to terminate this opposition in favor of a concurrent use proceeding. The motion is fully briefed.[3]

Conversion to Concurrent Use Proceeding

[1] Application Serial No. 77194297, filed May 31, 2007, claiming dates of first use anywhere and in commerce of December 1998. The word "automotive" is disclaimed.

[2] The Board notes that opposer also asserts in the ESTTA cover sheet the ground of false suggestion of a connection under Trademark Act Section 2(a).

[3] Proceedings are considered to have been suspended with the filing of applicant's motion.

By its motion to amend to a concurrent use proceeding, applicant consents to entry of judgment against itself with respect to its right to an unrestricted registration based on the application involved in this proceeding (motion, page 1) and to amend its application to one seeking a concurrent use registration. Specifically, applicant seeks to geographically restrict its application to "the States of North Carolina, South Carolina, Virginia and New Jersey" (motion, page 2). Further, applicant names opposer, Crown Automotive Management, Inc., as an excepted user, with common law rights limited to the States of Florida and Ohio for the mark CROWN CARS & Design for automobile dealerships; and names Crown Automobile Co., as an excepted user, with common law rights limited to the State of Alabama.

In support of its motion, applicant states that it has no knowledge concerning opposer's claim of prior use, or indeed any use, of the identical mark. In its reply, applicant argues that, based on its compliance with the Board's procedures set forth in TMBP § 1113.01, the proposed amendment should be entered, judgment should be entered against applicant as to its right to an unrestricted registration, and the opposition should be dismissed in favor of a concurrent use proceeding naming opposer and Crown Automobile Co. as exceptions to applicant's exclusive right to use its mark.

> In response, opposer argues that the motion should be denied because applicant fails to meet the requirements of a concurrent use proceeding, namely, that applicant adopted its mark in good faith, and without knowledge of a prior party's use in another geographic area. Specifically, opposer alleges that applicant, as a subsequent purchaser of Crown Pontiac in North Carolina, had knowledge of opposer's prior use of the CROWN mark in Florida and in Alabama (response, page 4).
>
> If a party to an opposition proceeding before the Board is willing to accept entry of judgment against itself as to its right to an unrestricted registration, the party may file a statement with the Board indicating that it consents to entry of such judgment, and judgment will be entered against the requesting party. *See* TBMP § 604 (2d ed. rev. 2004). Further, where that party also moves to amend its application to one seeking geographical restrictions, the Board may institute a concurrent use proceeding. *See, e.g., Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1225 (TTAB 1993); and *Faces, Inc. v. Face's, Inc.*, 222 USPQ 918, 920 (TTAB 1983) (noting that the opposer will be afforded an opportunity to show that applicant is not entitled to a concurrent use registration, the Board granted applicant's motion to amend its geographically unrestricted application to one for a concurrent use registration).

Accordingly, applicant's motion to amend its application to one seeking concurrent registration is granted, and applicant's motion consenting to entry of judgment against itself in the opposition for a geographically unrestricted application is granted. Such judgment is hereby entered in Opposition No. 91184018. *See* TBMP § 1113.01(4) (2d ed. rev. 2004).

A concurrent use proceeding, namely Concurrent Use No. 94002373, is hereby instituted under the provisions of Section 2(d) of the Trademark Act with Asbury Automotive

Group, Inc. as the concurrent use applicant (in the position of "plaintiff"), and Crown Automotive Management, Inc. and Crown Automobile Co. as the named excepted users (in the position of "defendants").

Burden of Proof

Most concurrent use proceedings amicably settle. The Board is liberal in granting periods of suspension to accommodate settlement talks. Settlement agreements in concurrent use proceedings typically incorporate provisions addressing efforts the parties agree to undertake to avoid confusion among consumers and memorializing agreement to cooperate in resolving any confusion which may arise. The parties are referred to TBMP § 1110 (2d ed. rev. 2004) and cases referenced therein for a discussion of operative provisions in concurrent use agreements. If the parties do not enter into a concurrent use agreement establishing no likelihood of confusion and that Asbury Automotive is entitled to the concurrent use registration it seeks, then Asbury Automotive, as plaintiff, will bear the burden of proving at trial that it is entitled to the concurrent use registrations that it seeks.

Answer

The parties specified by the concurrent use plaintiff as concurrent (excepted) users in the application must file

an answer within **FORTY DAYS** from the mailing date of this order, which institutes the concurrent use proceeding.[4] Accordingly, the concurrent (excepted) users named herein are allowed until **January 3, 2009** to file an answer in accordance with Trademark Rule 2.99.[5] (See Patent and Trademark Rule 1.7 for expiration of this or any deadline falling on a Saturday, Sunday or federal holiday.) Defendants' answers and any other filing made by any party must include proof of service. *See* Trademark Rule 2.119.

If filed, the answer should be directed to the allegations relating to concurrent use recited in the plaintiff's application identified herein (*i.e.* the application of Asbury Automotive).

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[4] Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, of the Code of Federal Regulations ("Trademark Rules"). The Trademark Rules may be viewed at the USPTO's trademarks webpage: http://www.uspto.gov/main/trademarks.htm. The Board's main webpage (http://www.uspto.gov/web/offices/dcom/ttab/) includes information on amendments to the Trademark Rules applicable to Board proceedings, on Alternative Dispute Resolution (ADR), Frequently Asked Questions about Board proceedings, and a web link to the Board's manual of procedure (the TBMP).

[5] *For faster handling of all papers the parties need to file with the Board, the Board strongly encourages use of electronic filing through the Electronic System for Trademark Trials and Appeals (ESTTA). Various electronic filing forms, some of which may be used as is, and others which may require attachments, are available at http://estta.uspto.gov.*

If an answer is not filed, then the proceeding may be handled as in a case of default, and any concurrent (excepted) user(s) that does not file an answer will be precluded from claiming any right in its mark greater than that acknowledged by plaintiff in its concurrent use application. *See* Trademark Rule 2.99(d)(3).

If one or both of the defending mark users file an answer, then a schedule for this concurrent use proceeding will be set, including time for conferencing, disclosures, discovery, trial and briefing.

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