

**THIS DECISION IS NOT A
PRECEDENT OF THE TTAB**

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: September 9, 2015

Concurrent Use No. **94002429**

*Richard A. Harris, a Professional
Corporation*

v.

*Ticket Busters Inc., a New York
Corporation*

**Before Kuhlke, Wolfson and Shaw,
Administrative Trademark Judges**

By the Board:

This matter comes up on concurrent use applicant Richard A. Harris, P.C.'s (hereinafter "Applicant") motion (filed January 16, 2015) seeking summary judgment on the question of its entitlement to a concurrent use registration for "legal services" throughout the United States except New York City. Excepted user Ticket Busters Inc. of New York (hereinafter "TBI") filed (on March 2, 2015) a combined response to Applicant's motion and a cross-motion for partial summary judgment seeking a determination that Applicant is not entitled to a concurrent use registration that includes the

state of New York.¹ The motion is fully briefed and the cross-motion is contested.

The Board presumes the parties' familiarity with the pleadings, the history of the proceeding and the arguments and evidence submitted with respect to the motion. Therefore, this order will not summarize the proceeding background or recount the parties' arguments except as necessary.

Decision

A motion for summary judgment is a pretrial device intended to save the time and expense of a full trial when the moving party is able to demonstrate, prior to trial, that there is no genuine dispute of material fact, and that it is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(a); *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). If the moving party is able to meet this initial burden, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely disputed facts that must be resolved at trial. The nonmoving party may not rest on mere allegations or assertions but must designate specific portions of the record or produce additional evidence showing the existence of

¹ Although TBI identifies the exclusion it seeks in its cross-motion as "any part of the city of New York," it is apparent from the cross-motion that TBI seeks to exclude the entire state of New York from any registration that may issue to Applicant herein at the conclusion of this proceeding. Applicant has acknowledged TBI's intent in its reply/opposition brief.

a genuine dispute of material fact for trial. Should the nonmoving party fail to raise a genuine dispute of material fact as to an essential element of the moving party's case, judgment as a matter of law may be entered in the moving party's favor.

A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *See Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). The evidence must be viewed in a light most favorable to the non-moving party, and all reasonable inferences are to be drawn in the non-movant's favor. *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA, supra*. The Board does not resolve disputes of material fact but rather only ascertains whether disputes of material fact exist. *See Lloyd's Food Products*, 987 F.2d at 767, 25 USPQ2d at 2029; *Olde Tyme Foods*, 961 F.2d at 200, 22 USPQ2d at 1542.

In the context of a concurrent use proceeding, in order to prevail on a motion for summary judgment, the concurrent use applicant must demonstrate that there is no genuine dispute that (1) the parties are presently entitled to concurrently use the mark in commerce, and (2) there is no likelihood of confusion, mistake or deception in the market place as to the source of the goods or services resulting from the continued concurrent use of the trademark. *See America's Best Franchising Inc. v. Abbott*, 106 USPQ2d

1540, 1547 (TTAB 2013) (quoting *In re Beatrice Foods Co.*, 429 F.2d 466, 166 USPQ 431, 435-36 (CCPA 1970)).

Upon careful consideration of the arguments and evidence presented by the parties and drawing all inferences with respect to the motion in favor of TBI as the nonmoving party, we find that Applicant has failed to demonstrate the absence of a genuine dispute of material fact for trial. At a minimum, genuine disputes of material fact exist as to the relatedness of Applicant's legal services and TBI's consulting services, and the scope of the territorial restriction in view of the affidavit of TBI's president attesting to TBI's rendering of its services throughout the state of New York. In view thereof, Applicant's motion for summary judgment is hereby **DENIED**.²

By the same token, in view of the genuine dispute of material fact as to the scope of the territorial restriction, TBI's cross-motion for partial summary judgment must also be **DENIED**.

Applicant's Motion to Amend Concurrent Use Statement

By motion made on January 12, 2015, Applicant seeks to amend its concurrent use statement, pursuant to the deletion of excepted users Ticket Busters Inc. of Florida and Parking Ticket Busters, to the following:

² The parties are reminded that evidence submitted in support of or in opposition to a motion for summary judgment is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced during the appropriate trial period. *See, for example, Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

Applicant claims the exclusive rights to use the mark in the area comprising the entire United States with the exception of within the limits of New York City.

As the territorial reach of Applicant's mark *vis-à-vis* TBI has yet to be determined, the motion to amend is premature and is hereby **DENIED**.³

Applicant's Registration No. 3668729

As part of the Board's institution order, Applicant was informed that it must advise the Board of any relevant applications or registrations which should be included in this concurrent use proceeding. 3 TTABVue 2. No response was made by Applicant. However, as part of its motion for summary judgment, Applicant identified unrestricted Registration No. 3668729 for TICKET BUSTERS and design.⁴ In view of the identity of the services and the literal elements of the marks in Applicant's registration and concurrent use application, **Applicant's Registration No. 3668729 is hereby added to this proceeding.** See TBMP § 1104 (2015).

Proceedings herein are **RESUMED** and dates are **RESET** as follows:⁵

Plaintiff's Pretrial Disclosures Due

10/8/2015

³ However, inasmuch as the statement of concurrent use in Applicant's application was published with certain territorial restrictions that no longer apply, given the deletion of all but TBI as an excepted user, Applicant's mark will require republication following resolution of this proceeding in Applicant's favor. See TMEP § 1505.03(a) (republication required after entry of any post-publication amendment that expands an applicant's rights or would otherwise require notice to third parties).

⁴ Filed October 27, 2008, under Section 1(a) of the Trademark Act and registered on August 18, 2009, with a claim of color and a disclaimer of TICKET.

⁵ Applicant's notice of reliance (filed April 15, 2015) has been given no consideration in view of the Board's suspension of this matter pending disposition of the parties' motions.

Plaintiff's 30-day Trial Period Ends	11/22/2015
Defendant's Pretrial Disclosures Due	12/7/2015
Defendant's 30-day Trial Period Ends	1/21/2016
Plaintiff's Rebuttal Disclosures Due	2/5/2016
Plaintiff's 15-day Rebuttal Period Ends	3/6/2016

IN EACH INSTANCE, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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