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TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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mbm

March 11, 2022

Concurrent Use No. 94002983

Constructive Resource, Inc.

v.

Jarrold Osborne

Before Wellington, Kuczma, and English,
Administrative Trademark Judges.

By the Board:

This proceeding now comes before the Board for consideration of the motion of Jarrod Osborne (“Registrant”) for summary judgment. The motion is fully briefed.¹

I. Background

Constructive Resource, Inc. (“Applicant”), plaintiff in this proceeding, seeks concurrent use registration for the mark shown below for “Offering business management assistance in the establishment and/or operation of heating, cooling and environmental control systems using solar energy, renewable energy resources,

¹ We have considered the parties’ briefs on the motion, but do not repeat or discuss all of their arguments, except as necessary to explain the Board’s order. *Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

rainwater, and photovoltaic/solar thermal hybrid systems” in Class 35² and “Installation, maintenance and repair of heating, cooling and environmental control systems using solar energy, renewable energy resources, rainwater, and photovoltaic/solar thermal hybrid systems” in Class 37:³



In its applications, Applicant identifies its claimed territory of use as the geographic area comprising the entire United States except for the Long Beach, California area.

As an exception to its exclusive right to use its mark, Applicant names use by Registrant, who owns Registration No. 3864876 for the mark shown below for “Technical planning of photovoltaic/solar thermal hybrid installations” in Class 42:⁴

SOLAR SOURCE

² Application Serial No. 88320445, filed February 28, 2019. “SOLAR” and “THE SOLAR EXPERTS” are disclaimed. The description of the mark is as follows: “The mark consists of the words ‘SOLAR SOURCE’ in blue upper case letters with a partial world/globe design around the lettering ‘SOLA’ in ‘SOLAR’. The world/globe design is a blue incomplete circular design surrounding a blue land mass design. A ring of stylized red-orange flame triangles, which represent the sun, surround the incomplete circular design. The red-orange wording ‘THE SOLAR EXPERTS’ appears below the word ‘SOURCE.’”

³ Application Serial No. 88320453, filed February 28, 2019. This application includes the same disclaimers and description of the mark as the application in footnote 2 above.

⁴ Filed February 15, 2008 and issued October 19, 2010. “SOLAR” is disclaimed.

The Board instituted this concurrent use proceeding on December 16, 2020. Registrant filed an amended answer to the notice of institution on August 18, 2021.⁵

II. Registrant's Motion for Summary Judgment

A. Summary Judgment Standard

Summary judgment is appropriate where the movant shows that there is no genuine dispute as to any material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). In reviewing a motion for summary judgment, the evidentiary record and all justifiable inferences to be drawn from the undisputed facts must be viewed in the light most favorable to the nonmoving party. *See Lloyd's Food Prods. Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029-30 (Fed. Cir. 1993); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1546 (Fed. Cir. 1992). The Board may not resolve disputes of material fact; it may only ascertain whether a genuine dispute regarding a material fact exists. *See Lloyds' Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1544.

B. Decision

To establish its entitlement to a concurrent use registration, Applicant must demonstrate (1) that it has use of its mark in commerce prior to the filing date of the application underlying Registrant's registration and (2) that concurrent use of the parties' marks in their respective geographic territories will not result in a likelihood of confusion. 15 U.S.C. § 1052(d); *see Bad Boys Bail Bonds, Inc. v. Yowell*, 115

⁵ On July 14, 2021, the Board granted Registrant's May 21, 2021 motion to amend its answer. The May 21, 2021 proposed answer contained the proposed revisions in redline. Registrant filed a clean copy of its amended answer on August 18, 2021.

USPQ2d 1925, 1928 (TTAB 2015). The requirement set forth in Section 2(d) of the Trademark Act that a concurrent use applicant have prior use of its mark is jurisdictional in nature. *Stawski v. Lawson*, 129 USPQ2d 1036, 1039 (TTAB 2018).

In support of his summary judgment motion, Registrant argues that judgment should be entered in his favor because Applicant has admitted that it did not have use of its applied for mark prior to the February 15, 2008 filing date of the application underlying Registrant's registration.⁶ Registrant attaches Applicant's responses to Registrant's interrogatories and requests for admission, which state that Applicant did not commence use of its applied for mark until November 2009.⁷

In its response brief, Applicant admits that it did not use its applied for mark until after the filing date of the application underlying Registrant's registration.⁸ Applicant states, however, that it has filed a new application for concurrent use registration of the standard character mark SOLAR SOURCE, Application Serial No. 97143213, for which Applicant claims prior use as early as 1991.⁹ Applicant asks the Board to dissolve this concurrent use proceeding and institute a new concurrent use proceeding for its recently-filed application.¹⁰

⁶ 16 TTABVUE 4, 35-41.

⁷ *Id.* at 14-15 ("Applicant first used the Proposed Mark in or around November of 2009, but used the mark in another form as well as the Word mark (SOLAR SOURCE) dating back to 1991."), 31 ("Admitted [that Applicant did not use the Proposed Mark in commerce in 1991]. Applicant used a prior version of the Proposed Mark in commerce in 1991.").

⁸ 18 TTABVUE 2.

⁹ *Id.*

¹⁰ *Id.* at 3.

Applicant's Application Serial No. 97143213 was filed November 25, 2021 and has not yet been examined. A concurrent use proceeding may only be instituted after an application is accepted for publication, is published for opposition, and either no oppositions are filed or all oppositions filed are dismissed or withdrawn. Trademark Rule 2.99(b)-(c), 37 C.F.R. § 2.99(b)-(c). *See also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1103.01(b) (2021). Accordingly, Applicant's request to institute a new concurrent use proceeding with respect to its Application Serial No. 97143213 is **denied**.

Based on Applicant's own discovery responses and admissions, there is no dispute that Applicant did not have use of its applied for mark prior to the filing date of the application underlying Registrant's registration and that Applicant therefore cannot meet the jurisdictional requirement of Section 2(d) of the Trademark Act.

In view of the foregoing, Registrant's motion for summary judgment is **granted**, concurrent use registration to Applicant is refused, and this concurrent use proceeding is dissolved.