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Trademark Trial and Appeal Board  
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DelGizzi/Butler

Mailed: January 10, 2018

Concurrent Use No. 94002643

*Subway IP, Inc., substituted for Doctor's  
Associates Inc.<sup>1</sup>*

*v.*

*Janco, LLC*

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

Applicant, Subway IP, Inc. ("SIP), seek a concurrent use registration for the mark FLATIZZA for "sandwiches, namely, open-faced flatbread sandwiches with a variety of toppings."<sup>2</sup> Applicant's claimed territory of use is "the area comprising each state of the United States, with the exception of Snohomish County and King County in the state of Washington." TSDR July 30, 2014 at ¶¶17, 22.

Applicant names use by common law user Janco, LLC as the sole exception to its exclusive right to use its mark. Applicant identifies Janco, LLC's territory of use as the area comprising "Snohomish County and King County, Washington." *Id.*

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<sup>1</sup> In an order dated May 18, 2016, the Board joined Subway IP, Inc. as a party in view of the assignment that was recorded after the commencement of the proceeding. Reel/Frame 5735/0460. A review of recorded document indicates that the assignment occurred prior to the commencement of the proceeding. Moreover, in view of the default judgment entered against Janco, LLC, discovery and testimony will not be necessary. Accordingly, Subway IP, Inc. is hereby substituted for Doctor's Associates Inc.

<sup>2</sup> Application Serial No. 86250900, filed April 14, 2014, claiming a date of first use anywhere and a date of first use in commerce of February 15, 2013.

On May 18, 2016, the Board entered default judgment against Janco, LLC because of its failure to file an answer, or otherwise respond to the concurrent use allegations. The Board indicated that the excepted user against whom default judgment has been entered is precluded from claiming any right more extensive than that acknowledged in the involved application. The Board advised Applicant that it still had the burden of proving its entitlement to the registration sought as against the defaulting party. Trademark Rule 2.99(d)(2), 37 CFR § 2.99(d)(2). *See also* TBMP §§ 1107 and 1108 (June 2017). That is, Applicant still must prove that there will be no likelihood of confusion by reason of the concurrent use by the parties of their respective marks, and, where necessary, that the parties have become entitled to use their marks as a result of their concurrent lawful use in commerce prior to the application filing date. *See* Trademark Act § 2(d), 15 U.S.C. § 1052(d). The Board indicated that Applicant may prove its entitlement by making an *ex parte* showing, and allowed Applicant time to do so.<sup>3</sup>

This case now comes up on Applicant's response, filed July 18, 2016. By way of its response, Applicant, introduced the declaration of Jessica Johnson, Trademark Attorney of Franchise World Headquarters, LLC, a service organization associated with SIP. 6 TTABVUE 10. As an exhibit to her declaration, Ms. Johnson introduced

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<sup>3</sup> When an *ex parte* showing is allowed, a concurrent use applicant may prove its entitlement to registration by less formal procedures than those normally required for the introduction of evidence in an *inter partes* proceeding. For example, the concurrent use applicant is to establish that confusion is not likely to occur by addressing the factors the Board looks at in settlement agreements. *See* TBMP §§ 1108, 1110.

her declaration submitted in Opposition No. 91217243, *Doctor's Associates, Inc. v. Janco, LLC*.<sup>4</sup>

Ms. Johnson states her understanding that Janco, LLC use of the mark FLATIZILLA is limited to two Ready-Spaghetti restaurants located in King County and Snohomish County, Washington. Ms. Johnson further states that SIP is unaware of any actual confusion during the past two and a half years during which SIP used the FLATIZZA trademark on a national basis; that SIP will cease all sales of products and all regional marketing under the FLATZILLA mark in King County and Snohomish County, Washington to ensure there is no potential for likelihood of confusion in the geographically restricted area; and that, to the extent SIP does encounter any actual confusion, SIP will take additional steps to avoid such confusion.

Upon consideration of Applicant's *ex parte showing*, the Board finds that the evidence is sufficient to establish, *prima facie*, that confusion is unlikely, and that Applicant is entitled to a concurrent use registration with the appropriate geographical restrictions as detailed in its concurrent use statement.

**Decision:**

Applicant is entitled to a concurrent use registration for the mark FLATIZZA for "Sandwiches, namely, open-faced flatbread sandwiches with a variety of toppings" in Class 30, for the area comprising each state of the United States, with the exception of Snohomish County and King County in the state of Washington. Application. Serial No. 86250900.

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<sup>4</sup> Such opposition was sustained on January 7, 2016. The Board indicated that a concurrent use proceeding involving application Serial No. 86250900 would be instituted. This concurrent use proceeding was instituted the next day.

Concurrent Use No. 94002643

The following concurrent use statement in involved application Serial No. 86250900 will be added.

Registration limited to the area comprising each state of the United States, with the exception of Snohomish County and King County in the state of Washington pursuant to Concurrent Use No. 94002643. Concurrent registration with Janco, LLC 21225 Bothell Everett Highway, Suite 101, Bothell, WA 98021.