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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77789151
Applicant	BRG Intellectual Property, LLC
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Submission	Request to Suspend and Remand for Additional Evidence
Attachments	Request to Suspend and Remand re BILL'S BAR & BURGER.pdf ( 8 pages ) (2914551 bytes )
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Date	12/13/2010

# **REQUEST TO SUSPEND AND REMAND FOR ADDITIONAL EVIDENCE**

## **FILED ELECTRONICALLY**

### **I. Introduction**

Pursuant to T.B.M.P. § 1207:02, Applicant respectfully requests that the instant Appeal be suspended and the file be remanded to the Examining Attorney to allow Applicant to submit additional evidence - specifically, an Agreement and Consent to Register which has been signed by the owner of the mark which has been cited against Applicant's Mark and which is the subject of the instant Appeal.

### **II. Background**

#### **A. Procedural History**

On April 16, 2010, the Examining Attorney issued a final refusal to register Applicant's Mark BILL'S BAR & BURGER for restaurant and bar services in Class 43 based on a likelihood of confusion with Registration No. 3,651,118 for the mark BILL'S as applied to restaurant and bar services (the "Cited Mark").

On October 14, 2010, Applicant filed a timely Notice of Appeal, and simultaneously filed a Request For Reconsideration. On that same day, the Board suspended the Appeal pending the Examining Attorney's decision with respect to the Request For Reconsideration.

The Request For Reconsideration was denied as to this Application on November 1, 2010, and on November 3, 2010, the Board issued an Order resuming the Appeal, and giving Applicant sixty days from the Order to submit its Appeal Brief.

**B. Subsequent Consent Agreement**

On December 9, 2010, the owner of the Cited Mark signed an Agreement and Consent to Register in which it expressly consents to registration of Applicant's Mark (the "Consent Agreement"), attached hereto as Exhibit A. The Consent Agreement was countersigned by Applicant on December 10, 2010.

**III. The Suspension and Remand Should Be Granted**

Section 1207:02 of the TTAB Manual of Procedure provides, in relevant part, that the Board may suspend an appeal and remand the file to the Examining Attorney to allow the Applicant to submit additional evidence if: (1) the request is made before the Board issues its final decision on the Appeal; and (2) Applicant shows good cause for not having filed the evidence before the Appeal.

In the instant case, Applicant has satisfied both criteria. With respect to No. 1, the Board has not yet issued its final decision on the Appeal. With respect to No. 2, good cause exists because the owner of the Cited Mark only recently (i.e., after the resumption of the Appeal) signed the Consent Agreement consenting to Applicant's use and registration of Applicant's Mark and expressly consenting to registration of the instant Application.

Indeed, the T.B.M.P. expressly provides for suspension and remand to allow Applicant to submit a Consent agreement. *Id.* ("because a consent agreement offered in response to a refusal to register under Section 2(d) of the Act, 15 U.S.C. § 1052(d) is inherently difficult and time-consuming to obtain, and may be highly persuasive of registrability, the Board will grant a request to suspend and remand for consideration of

a consent agreement if the request, accompanied by the consent agreement, is filed at any time prior to the rendering of the Board's final decision on the appeal.”).

This is consistent with the Board's position that “consent agreements should be given great weight” in determining the likelihood of confusion. T.M.E.P. § 1207.01(d)(viii) (citations omitted); *see also, Id.* (the Patent and Trademark Office “should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason.”); *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1363 (C.C.P.A. 1973) (“It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't.”).

In Paragraph 1 of the Consent Agreement, the owner of the Cited Mark and Applicant agreed to restriction on use which they believe will prevent any likelihood of confusion. Further in Paragraph 4 of the Consent Agreement, the parties agreed that “the parties will cooperate with each other... in advising the USPTO as necessary that the parties do not believe that their respective marks will cause confusion in the marketplace due to the different specialized markets where the parties use their respective marks”. The owner of the Cited Mark and Applicant, as the parties concerned, stated that the confusion will not occur and these Paragraphs, together with the Consent Agreement as a whole, should be given great weight in determining the likelihood of confusion.

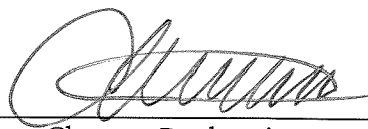
**IV. Conclusion**

Based on the foregoing, it is respectfully submitted that the Board should grant the request to suspend the Appeal and remand to the Examining Attorney to consider the Consent Agreement.

Respectfully submitted,

AMSTER, ROTHSTEIN & EBENSTEIN LLP  
Attorneys for Opposer  
90 Park Avenue  
New York, New York 10016  
(212) 336-8000

Dated: New York, New York  
December 13, 2010

By:   
Chester Rothstein

# **EXHIBIT A**

## AGREEMENT AND CONSENT TO REGISTER

THIS AGREEMENT AND CONSENT TO REGISTER (the "Agreement") is made and entered into by and between BRG Intellectual Property, LLC ("BRG"), a Delaware limited liability company having a principal place of business at 206 Spring Street, New York, NY 10012; and Caesars License Company, LLC ("CLC"), a Nevada limited liability company (formerly Harrah's License Company, LLC) having a principal place of business at One Caesars Palace Drive, Las Vegas, NV 89109. BRG and CLC shall be referred to collectively as "the Parties."

WHEREAS, CLC is the owner of three U.S. Trademark Registrations, including (1) Reg. No. 1,530,198 for the mark Bill's (word mark) for entertainment services in the nature of casino gaming in Int. Class 41 and for night club services in Int. Class 43; (2) Reg. No. 3,316,023 for the Bill's Gamblin' Hall & Saloon (design), for casino and gaming services; entertainment services, namely, arranging for ticket reservations for shows and other entertainment events; entertainment services in the nature of musical, variety and comedy shows; conducting and providing facilities for special events featuring casino and gaming contest and tournaments in Int. Class 41 and hotel services; bar and restaurant services; provision of conference, exhibition and meeting facilities in Int. Class 43; and (3) Reg. No. 3,651,118 for Bill's (word mark) for hotel, bar and restaurant services; provision of conference, exhibition and meeting facilities in Int. Class 43 (collectively referred to as the "CLC Registrations"); and these registrations are registered in the U. S. Patent and Trademark Office ("USPTO");

WHEREAS, BRG has adopted and is using the name and mark BILL'S BAR & BURGER to identify its burger themed restaurants and bars, and BRG has filed U. S. Trademark Application Serial No. 77/789,151 for the mark BILL'S BAR & BURGER for restaurant and bar services in Int. 43 (collectively the "BRG Application");

WHEREAS, the USPTO has rejected the BRG Application based on CLC's Registration No. 3,651,118; and

WHEREAS, the Parties believe that their services which are provided under their respective marks are distinguishable in appearance, advertising channels and commercial impression and are not likely to be confused by the public if marketed and used by the Parties in accordance with the terms of this Agreement.

WHEREAS, the Parties each have determined that, subject to the compliance with their respective obligations hereunder, no confusion between the Parties trademarks is likely to exist.

NOW, THEREFORE, in consideration of the mutual promises herein contained and for good and valuable consideration, the sufficiency and receipt of which are hereby acknowledged;

IT IS AGREED THAT:

1. BRG agrees that it will not use, or license or permit third parties to use the BRG Marks in connection with any casino in Atlantic City, NJ or Las Vegas, NV, except that due to the independent distinctions which would prevent any likelihood of confusion, BRG may use the BRG mark "BILL'S BAR & BURGER" in connection with casinos in Starwood Capital Group properties owned or controlled by Barry Sternlicht.
2. Except for the restrictions in Paragraph 1, CLC will not object to BRG's use of the mark "BILL'S BAR & BURGER" nor will CLC oppose or petition to cancel BRG's Application or any other mark that BRG may file for the same mark to use to identify its restaurant services and bar services, in Int. Class 43.
3. BRG will not challenge or petition to cancel CLC's rights or registrations in the Bill's marks anywhere in the world, including the CLC's Registrations, nor will BRG challenge any applications CLC files to register its BILL'S marks anywhere in the world.
4. The parties will cooperate with each other, at BRG's sole expense, in advising the USPTO as necessary that the parties do not believe that their respective marks will cause confusion in the marketplace due to the different specialized markets where the parties use their respective marks, provided that the Parties adhere to the terms and conditions of this Agreement.
5. Although the Parties do not believe that confusion is likely, if confusion occurs, the Parties agree to report such confusion to each other, and the parties agree to take such steps as are reasonably necessary to prevent such confusion from occurring again in the future.
6. No waiver of the breach of any terms or provisions of this Agreement shall be construed to be a waiver of any preceding or succeeding breach of the same or any other term or provision. The various rights and remedies hereunder are cumulative, and the exercise or enforcement of any one or more of them shall not preclude the parties hereto from exercising or enforcing any of the others, or any right or remedy allowed by law.
7. This Agreement shall be construed in accordance with the laws of the State of Nevada. Any action arising out of or related in any way to this Agreement shall be brought only in the state or federal courts of Clark County, Nevada, and the Parties expressly consent to the jurisdiction of such courts over them for purposes of such actions.
8. The effective date of this Agreement shall be the date on which the Agreement has been fully executed by both parties.
9. This agreement shall be binding upon the parties, their successors and/or assigns, and all others acting by, through, with or under their direction or otherwise in privity therewith.
10. This instrument contains the entire and only Agreement between the parties and shall not be varied, amended or supplemented except by a subsequent writing executed by authorized representatives of both parties.



11. If part of this Agreement is held unenforceable or invalid, it shall not affect the enforceability of the other parts of the Agreement or the total Agreement.

12. The Parties mutually understand, acknowledge, and agree that the USPTO is not obligated to accept this Consent, and we mutually agree that if the USPTO does not withdraw its objection to BRG's Application, the Parties shall thereafter maintain whatever rights each would have had if this letter agreement had not been executed.

IN WITNESS THEREOF, each of the parties has caused this Agreement to be executed by its duly authorized representative. A photocopy of this agreement shall be considered binding upon the parties.

BRG INTELLECTUAL PROPERTY, LLC

Date: December 10, 2010

By Stephen Hanson

Name Stephen Hanson

Title President

CAESARS LICENSE COMPANY, LLC,  
by its sole member,  
CAESARS ENTERTAINMENT OPERATING  
COMPANY, INC.

Date: December 9, 2010

By Jane E. Tyler

Name Jane E. Tyler

Title Assistant Secretary