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Filing date: **05/12/2008**

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

Proceeding	92046613
Party	Plaintiff THE BRONSKILL GROUP, INC
Correspondence Address	SUSAN NEUBERGER WELLER MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND 701 PENNSYLVANIA AVENUE N.W. WASHINGTON, DC 20004 UNITED STATES snweller@mintz.com
Submission	Motion to Suspend for Settlement Discussions
Filer's Name	Susan Neuberger Weller, Esq.
Filer's e-mail	snweller@mintz.com, sckalamaras@mintz.com
Signature	/susan neuberger weller/
Date	05/12/2008
Attachments	BaAM Productions Stipulated Suspension.pdf ( 16 pages )(509596 bytes )

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

In the matter of Registration No. 2,805,213 for BAMB!

Date of Issuance: January 13, 2004

_____	)	
THE BRONSKILL GROUP, INC.,	)	
	)	
Petitioner,	)	Cancellation No. 92,046,613
	)	
	)	
BAMB! WORLDWIDE, INC.,	)	
	)	
Registrant.	)	
_____	)	

**STIPULATED REQUEST FOR SUSPENSION OF PROCEEDINGS**

The Bronskill Group, Inc. and BAMB! Worldwide, Inc., Parties to the above-captioned proceeding, hereby request that the present cancellation proceedings be suspended for a period of 180 days pending a decision by the Trademark Examiner on Petitioner's Request to Remove Application from Suspension, Response, Amendment, and Submission of Foreign Registration that was submitted to the U.S. Trademark Office on May 9, 2008 (*see* Exhibit 1). It is requested that proceedings resume as follows:

Proceedings resume:	November 6, 2008
Discovery period to close:	March 6, 2009
Testimony period for party in position of plaintiff to close: (opening thirty days prior thereto)	June 4, 2009
Testimony period for party in position of defendant to close: (opening thirty days prior thereto)	August 3, 2009

Rebuttal testimony period to close:  
(opening fifteen days prior thereto)

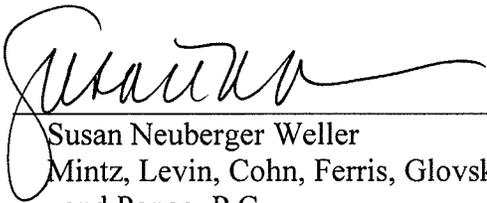
September 17, 2009

The time period for filing briefs shall also be extended in accordance with Rule 2.128(a).

This request is made for good cause and in good faith, and is made with the express consent of Registrant via the attached Settlement and Consent Agreement that was executed by the Parties on April 3, 2008 (*see* Exhibit A of Exhibit 1 at para. 10).

Respectfully submitted,

Dated: May 12, 2008

By:   
Susan Neuberger Weller  
Mintz, Levin, Cohn, Ferris, Glovsky,  
and Popeo, P.C.  
701 Pennsylvania Avenue, N.W.  
Washington, D.C. 20004  
Telephone: (202) 585-3510  
Facsimile: (202) 434-7400

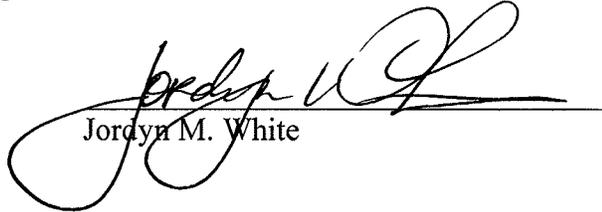
Attorneys for Petitioner  
The Bronskill Group, Inc.

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing **STIPULATED REQUEST FOR  
SUSPENSION OF PROCEEDINGS** was served by U.S. mail, first class, postage prepaid, on  
this 12th day of May, 2008 on the following:

Michele D. Miller, Esq.  
2420 W. Lunt Avenue  
Suite 200-F  
Chicago, IL 60645

Attorney for Registrant

  
Jordyn M. White

## **EXHIBIT 1**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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In re Application of

The Bronskill Group, Inc.

Serial No. 76/341,337

Filing Date: November 26, 2001

Mark: B.a.A.M. PRODUCTIONS  
(Stylized)

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Trademark Law Office: 107

Examining Attorney: Nelson B. Snyder III

**REQUEST TO REMOVE APPLICATION FROM SUSPENSION, RESPONSE,  
AMENDMENT, AND SUBMISSION OF FOREIGN REGISTRATION**

Trademark Assistance Center  
Madison East, Concourse Level Room C 55  
600 Dulany Street  
Alexandria, VA 22314

This is submitted in response to the Notices of Suspension dated November 9, 2006 and March 13, 2005.

**RESPONSE**

The Examiner initially refused to register Applicant's mark under Section 2(d) on grounds of likely confusion with Registration No. 2,805,213 for the mark BAMM! ("Cited Mark") for "business marketing consulting services in the music industry and not related to nonentertainment music trade associations" in Class 35. On October 17, 2006, Applicant filed a

Petition to Cancel the Cited Mark on grounds of abandonment. The Applicant and Registrant executed a Settlement and Consent Agreement on April 3, 2008, a copy of which is attached in Exhibit A. Consent agreements are to be given great weight by the Examiner in a likely confusion analysis. *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 6 USPQ2d 1305 (Fed. Cir. 1988); *Bongrain International (American) Corp. v. Delice de France Inc.*, 1 USPQ2d 1775 (Fed. Cir. 1987); *In re N.A.D. Inc.*, 224 USPQ 969 (Fed. Cir. 1985). Thus, the terms of this Settlement and Consent Agreement justify a withdrawal of the Section 2(d) refusal of registration, and Applicant respectfully requests the refusal of registration based on the Cited Mark be withdrawn.<sup>1</sup>

#### AMENDMENTS

Applicant requests that its application be amended to delete reliance on Section 1(b) and requests that its application proceed to registration under Section 44(e). A copy of its underlying Canadian Registration No. TMA597,019 is attached in Exhibit B.

Moreover, pursuant to the Examiner's requirements in his March 14, 2005 Notice of Suspension, Applicant requests that its description of services be amended as follows:

**Class 35:** Consulting and business services in the fields of event design, technical production, production management and operations, namely providing design, planning, management, staging, installation, coordination, and technical production for live events, productions and trade shows; transportation logistics services, namely arranging the transportation of goods for others; all of the above services performed for others in the entertainment and trade show industries.

**Class 37:** Electrical and carpentry contractor services, namely, installation and subsequent dismantling of trade show exhibits and

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<sup>1</sup> Applicant will request that the cancellation proceeding be suspended pending the Examiner's consideration of this filing, and the cancellation proceeding will be dismissed upon withdrawal of the Section 2(d) refusal of registration.

production sets for others in the entertainment and trade show industries.

**Class 39:** Storage of production and trade show rentals and equipment, namely stage scenery, stage systems, lighting and sound systems, exhibit booths and displays, production sets, signage, and furniture for the entertainment and trade show industries; warehousing and freight transportation by truck for the entertainment and trade show industries.

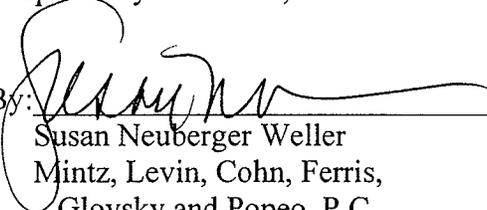
**Class 41:** Rental of stage scenery; rental of trade show exhibit booths and displays.

Applicant authorizes the U.S. Trademark Office to add Class 41 to its application for an additional cost of \$325 and authorizes the U.S. Trademark Office to debit Deposit Account No. 500311 for the appropriate fees.

### **CONCLUSION**

With these submissions, Applicant believes its application is now in proper condition to be approved for publication and such action is respectfully solicited.

Respectfully submitted,

By: 

Susan Neuberger Weller  
Mintz, Levin, Cohn, Ferris,  
Glovsky and Popeo, P.C.  
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Washington, DC 20004  
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Fax: 202-434-7400  
E-mail: [snweller@mintz.com](mailto:snweller@mintz.com)

Attorneys for Applicant  
The Bronskill Group, Inc.

Date: May 9, 2008

**EXHIBIT A**

## **SETTLEMENT AND CONSENT AGREEMENT**

This Settlement and Consent Agreement (“Agreement”) is entered into between The Bronskill Group, Inc., a Canadian corporation with an address at 662 King Street West, Suite 101, Toronto, Ontario, CANADA M5V 1M7 (“Bronskill”) and BAMM! Worldwide, Inc., an Illinois corporation with an address at 2420 W. Lunt Avenue, Suite 2-00, Chicago, Illinois 60645 (“BWI”) (collectively “the Parties”).

WHEREAS, Bronskill has pending a U.S. trademark application Serial No. 76/341,337 for the mark B.A.A.M. PRODUCTIONS (“Pending Application”) for “design, technical production, production management, graphic production, operational management, installation, dismantle supervision, labor services, and production rental services for the entertainment and trade show industries; storage, warehousing, and transportation logistics services for the entertainment and trade show industries;”

WHEREAS, BWI owns U.S. Registration No. 2,805,213 for the mark BAMM! (“Registration”) for “business marketing consulting services in the music industry and not related to non-entertainment music trade associations;”

WHEREAS, the Registration has been cited by the U.S. Trademark Office as grounds for refusing registration of the Pending Application under Section 2(d);

WHEREAS, Bronskill filed a Petition for Cancellation of the Registration with the U.S. Trademark Trial and Appeal Board, No. 92046613 (“Cancellation Proceedings”), which is pending; and

WHEREAS, the Parties believe that their respective uses of the marks B.A.A.M. PRODUCTIONS and BAMM! are not likely to be confused in the marketplace and, therefore, have resolved to settle all outstanding issues in a manner which allows all marks to coexist.

NOW, THEREFORE, for good and valuable consideration, the sufficiency of which is hereby acknowledged, the Parties agree as follows:

1. Bronskill is an entertainment and design resource company providing itself and through related companies and divisions design development and project management expertise to its clients. Its staff includes designers, project managers, construction managers, graphic specialists, architectural technologists, detailers, and site supervisors. Its clients include event and show producers, designers and planners from museums and attractions, agencies, developers, and architects who need an outside entity to oversee and manage various projects. Bronskill's role in a particular project for a client may include design development, CAD services, base building or media integration, project management services such as budget and schedule development, or production and construction services such as local venue coordination, installation management and turn key construction management. Further information concerning Bronskill and the nature of its business can be found on its website at [www.baamproductions.com](http://www.baamproductions.com).

2. BWI is a strategic marketing, promotions, and product placement company that provides customized services to members of the music community. Its services include marketing analysis and consultation, media consultation, image consultation, grassroots awareness campaigns, lifestyle marketing, retail marketing, consumer promotions, public relations, street team promotions, target marketing, special event marketing, corporate sponsorship and endorsements, club and record pool service, artist tour support, radio promotion marketing, strategic media planning and buying, product placement, product inventories, in-store play distribution, and point of purchase product services. Further information concerning BWI can be found on its web site at

-N/A-

3. The Parties agree that the services each actually provides under their respective marks at issue are different and are not likely to be confused in the marketplace.

4. Neither Party is aware of any actual confusion that has resulted in the marketplace between their respective marks used for their respective services.

5. The Parties agree that they market their products to different customers, through different channels of trade, and in different markets. BWI's exclusive market is artists in the music community who are seeking marketing and promotional assistance in promoting their musical products, compositions, and services. Bronskill's primary market is designers, producers, agencies, and architects who contract with Bronskill to work within their specific project structure to provide various consulting, construction, design and production services described previously in paragraph 1. The Parties agree that these customers, markets, and channels of trade are entirely different, and are not likely to be confused by the concurrent use of the marks at issue.

6. The Parties believe their concurrent use of their respective marks on or in connection with their respective services as described above is unlikely to cause purchaser confusion, mistake, or deception due to the differences between the services, customers, markets, channels of trade, and how each mark is actually used in the marketplace.

7. The Parties agree to take all reasonable steps to avoid confusion as to the source or origin of their respective services offered under their respective marks, as well as to sponsorship and affiliation between them. The Parties agree to cooperate and consult with one another, in good faith, should any conditions develop which suggest to either Party that the Parties' respective marks might be confused with one another, with the view of ensuring that no substantial likelihood of confusion occurs between the Parties' respective marks.

8. BWI agrees not to contest, challenge or otherwise object to Bronskill's Pending Application and any similar or related applications or registrations which issue therefrom, or to Bronskill's use of its B.A.A.M. PRODUCTIONS mark or any component trademarks in the United States in association with its provision of goods and services in its field of use as set out in Paragraph 1 above.

9. Subject to the terms of paragraph 10 below, Bronskill agrees not to contest, challenge, or otherwise object to the Registration for BAMM! or BWI's use of its BAMM! trademark in the United States in association with its services in its field of use as set forth in Paragraph 2 above.

10. The Parties will submit this Settlement and Consent Agreement to the U.S. Trademark Office in connection with the Pending Application in an effort to overcome the Section 2(d) refusal of registration. The Parties agree to request jointly that the Cancellation Proceeding be suspended pending the consideration of this filing by the Examining Attorney. If the Examining Attorney withdraws the Section 2(d) refusal of registration, Bronskill will file a request to dismiss without prejudice the Cancellation Proceeding. If the filing of the Consent Agreement does not result in the withdrawal of the refusal of registration by the Examining Attorney, Bronskill may continue to litigate the Cancellation Proceeding.

11. This Agreement shall be binding on and inure to the benefit of the Parties and their respective related companies, including, but not limited to, their subsidiaries, divisions, licensees, successors-in-interests, officers, directors, assigns, employees, and agents.

12. This constitutes the entire Agreement between the Parties and supersedes and replaces any previous oral or written agreement between them or their attorneys or representatives.

13. The Parties shall bear their own costs and attorneys' fees in connection with this Agreement.

WHEREBY, the Parties acknowledge their agreement to these terms by their signatures below.

**THE BRONSKILL GROUP, INC.**

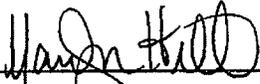
By:  \_\_\_\_\_

Name: RIK BRONSKILL

Title: PRESIDENT / CEO

Date: APRIL 3/08

**BAMM! WORLDWIDE, INC.**

By:  \_\_\_\_\_

Name: MARILYN HILL

Title: OWNER

Date: 12 MARCH 2008

**EXHIBIT B**



**Office de la propriété  
Intellectuelle  
du Canada**

Un organisme  
d'Industrie Canada

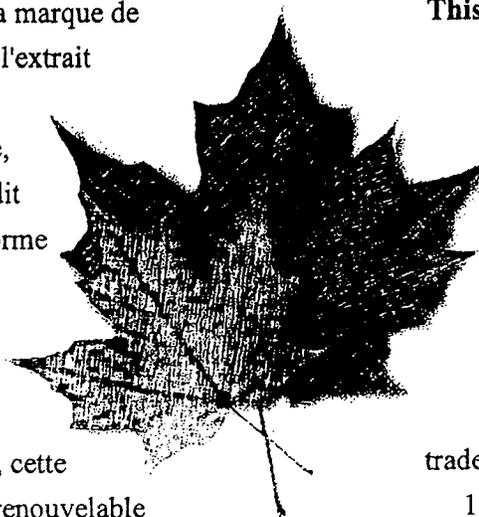
**Canadian  
Intellectual Property  
Office**

An Agency of  
Industry Canada

*Marques de commerce*  
*Certificat d'enregistrement*

La présente atteste que la marque de commerce identifiée dans l'extrait ci-joint, tiré du registre des marques de commerce, a été enregistrée et que ledit extrait est une copie conforme de l'inscription de son enregistrement.

Conformément aux dispositions de la *Loi sur les marques de commerce*, cette marque de commerce est renouvelable tous les quinze ans à compter de la date d'enregistrement.



*Trade-marks*  
*Certificate of Registration*

This is to certify that the trade-mark, identified in the attached extract from the register of trade-marks, has been registered and that the said extract is a true copy of the record of its registration.

In accordance with the provisions of the Trade-marks Act, this trade-mark is subject to renewal every 15 years from the registration date.

**B.a.A.M. PRODUCTIONS**

Número d'enregistrement  
Registration Number **TMA597,019**

Número de dossier  
File Number **1122963**

Date d'enregistrement  
Registration Date **9 déc/Dec 2003**

Registraire des marques de commerce  
Registrar of Trade-marks  
(CIPO 198)11-02

**Canada**

OPIC  CIPO

PL'N/DEM. NO 1 122 963

REGISTRATION/ENREGISTREMENT NO TMA597,019

**FILING DATE/DATE DE PRODUCTION:**

22 nov/Nov 2001

**REGISTRATION DATE/DATE D'ENREGISTREMENT:**

09 déc/Dec 2003

**REGISTRANT/PROPRIÉTAIRE ORIGINAL:**

THE BRONSKILL GROUP, INC.

662 King Street West

Suite 101

Toronto

ONTARIO

M5V 1M7

**REP FOR SERVICE/REP POUR SIGNIFICATION:**

GOWLING LAFLEUR HENDERSON LLP

SUITE 4900

COMMERCE COURT WEST

TORONTO

ONTARIO M5L 1J3

**TRADE-MARK/MARQUE DE COMMERCE:**

**B.a.A.M. PRODUCTIONS**

**DISCLAIMER/DÉSISTEMENT:**

The right to the exclusive use of the word PRODUCTIONS is disclaimed apart from the trade-mark.

**SERVICES:**

Services to the entertainment and trade show industries, namely, the design of floor plans, trade show and event layouts, the technical production of staging, lighting, sound and audio visual systems, production management, graphic production, operational management, services to install and dismantle trade shows and events, the provision of labour to effect the aforesaid services, the rental of necessary equipment and vehicles to effect these services, storage and warehousing, and transportation logistics.

**CLAIMS/REVENDEICATIONS:**

Declaration of Use filed November 03, 2003 on services.