

TTAB

76471175

Attorney
Docket No. TM1939

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

Concurrent Use No. 94002078
In the matter of Trademark Registration No. 2,348,945
For the Mark: CAMPO DE FIORI
Date Registered: May 9, 2000

I MATTI RISTORANTE, INC., Petitioner
v.
CAMPO DE FIORI L.L.C., Registrant

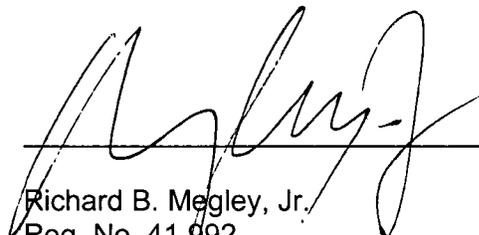
Petitioner: I MATTI RISTORANTE, INC.
205 South Mill Street, #109
Aspen, CO 81611

Box: TTAB
Honorable Commissioner of Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Sir:

Enclosed herewith via **Express Mail No. EV 712573226 US** is Applicant's Motion On Consent To Amend Applicant's Concurrent Use Application. No fee is required for this transmittal. However, authorization is given to charge any insufficiency to Deposit Account No. 14-1131.

Respectfully submitted,



Richard B. Megley, Jr.
Reg. No. 41,992
NIRO, SCAVONE, HALLER & NIRO, LTD.
181 West Madison Street, Suite 4600
Chicago, Illinois 60602
(312) 236-0733

I certify that this document and enclosed fee is being deposited on January 25, 2006 with the U.S. Postal Express Mail Service under 37 C.F.R. 1.10 and is addressed to box TTAB: Honorable Commissioner of Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451



Signature of Person Mailing Correspondence

Liz Wells

Printed Name of Person Mailing Correspondence

EV 712573226 US

"Express Mail" Label Number



01-25-2006

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**APPLICANT'S MOTION ON CONSENT TO AMEND
APPLICANT'S CONCURRENT USE APPLICATION**

Pursuant to 37 C.F.R. § 2.133(a), Applicant I Matti Ristorante, Inc. ("Applicant"), with the consent of Registrant Campo de Fiori L.L.C. ("Registrant"), hereby moves the Trademark Trial and Appeal Board ("Board") to amend Applicant's Concurrent Use Application. With respect to concurrent use proceedings before the Board, 37 C.F.R. § 2.133(a) states that an application involved in a proceeding may not be amended in substance except with the consent of the other party and the approval of the Board.

Pursuant to a Settlement Agreement executed by Applicant and Registrant, attached hereto as Exhibit A, the parties have agreed to terms for concurrent registration of the mark, CAMPO DE FIORI. Through the execution of the attached agreement, Registrant has consented to Applicant's motion to amend the Concurrent Use Application.

The parties previously submitted a settlement agreement to the Board on May 14, 2004, however, the Board objected to a "sub-licensing" provision contained in that agreement allowing the parties to sub-license the Mark to each other in the States of Illinois and Florida. The Board also requested that language be added to the agreement regarding the prevention of any likelihood of confusion. Pursuant to the Board's request, the revised Settlement Agreement attached as Exhibit

A has the sub-licensing provision removed and added language regarding the prevention of any likelihood of confusion in Paragraph 12 of the Settlement Agreement.

Therefore, in accordance with the terms of the attached Settlement Agreement, Applicant, with the consent of Registrant, moves the Board to amend Applicant's Concurrent Use Application. Applicant's amendment to the Concurrent Use Application consists solely of the incorporation of the attached Settlement Agreement. In view of the Settlement Agreement, Applicant respectfully requests that Applicant's concurrent use application be registered consistent with this Amendment.

Dated: 1/25/2006

Niro, Scavone, Haller & Niro
181 West Madison Street - Suite 4600
Chicago, Illinois 60602
(312) 236-0733

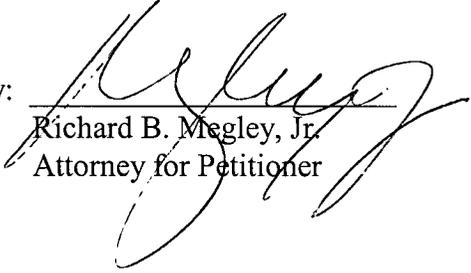
By: 
Richard B. Megley, Jr.
Attorney for Petitioner

EXHIBIT A

CONCURRENT USE AGREEMENT

This Concurrent Use Agreement ("Agreement") made this 29 day of December , 2005, between I MATTI RISTORANTE, INC. ("Matti"), a corporation incorporated under the laws of the State of Colorado and CAMPO DE FIORI L.L.C. ("Fiori"), a limited liability company under the laws of the State of New York.

RECITALS:

WHEREAS, Fiori is the owner of registered trademark number 2,348,945 for the trademark CAMPO DE FIORI (the "Mark");

WHEREAS, Matti has been continuously using the trademark CAMPO DE FIORI since October 14, 1994 to identify its restaurants and food preparation services; and

WHEREAS, Matti and Fiori have reached an agreement which would allow use of the Mark by Matti and Fiori in limited geographic areas pursuant to this agreement.

NOW, THEREFORE, it is mutually agreed as follows:

1. Matti hereby agrees that Fiori shall have the exclusive right to use the Mark in association with its restaurant business or businesses located or to be located in:

- a. the Atlantic standard time zone,
- b. the Eastern standard time zone, and
- c. the Central standard time zone, except; (i). the State of Texas; and (ii). the State of Illinois.

in accordance with, and provided Fiori is not in breach of, the terms and conditions of this Agreement.

2. Fiori hereby agrees that Matti shall have the exclusive right to use the Mark in association with its restaurant business or businesses located in or to be located in:

- a. the Mountain standard time zone,
- b. the Pacific standard time zone,
- c. the Alaska standard time zone,
- d. the Hawaii-Aleutian standard time zone,
- c. the Samoa standard time zone,
- f. the State of Illinois, and
- g. the State of Texas,

in accordance with, and provided Matti is not in breach of, the terms and conditions of this Agreement.

3. Matti acknowledges that Fiori has an interest in assuring that its goodwill and reputation associated with its name and trademark are maintained. Therefore, Matti agrees that at all times during the term of this Agreement, Matti shall ensure that the products produced and services rendered by all of Matti's restaurants, businesses, and other operations bearing the Mark shall be consistent with the quality of its products produced and services rendered bearing the Mark as of the date of this Agreement. Fiori acknowledges that the quality of the products produced and services rendered by Matti bearing the Mark as of the date of this Agreement is satisfactory.

4. Fiori acknowledges that Matti has an interest in assuring that its goodwill and reputation associated with its name are maintained. Therefore, Fiori agrees that at all times during the term of this Agreement, Fiori shall ensure that the products produced and services rendered by all of its restaurants, businesses, and other operations bearing the Mark shall be

consistent with the quality of Fiori's products produced and services rendered bearing the Mark as of the date of this Agreement. Matti acknowledges that the quality of the products produced and services rendered by Fiori bearing the Mark as of the date of this Agreement is satisfactory.

5. Upon the request of Fiori, Matti shall allow Fiori, or its duly authorized representatives, to sample the products produced and services rendered by Matti's businesses bearing the Mark for the purpose of ascertaining or determining compliance with the quality standards set forth in Paragraph 3, provided that such sampling occurs at the location of one of Matti's businesses bearing the Mark or another agreed upon location.

6. Upon the request of Fiori, Matti shall submit to Fiori, or its duly authorized representatives, samples of any advertising and promotional materials bearing the Mark for the purpose of ascertaining or determining compliance with the quality standards set forth in Paragraph 3.

7. Upon the request of Matti, Fiori shall allow Matti, or its duly authorized representatives, to sample the products produced and services rendered by Fiori's businesses bearing the Mark for the purpose of ascertaining or determining compliance with the quality standards set forth in Paragraph 4, provided that such sampling occurs at the location of one of Fiori's businesses bearing the Mark or another agreed upon location.

8. Upon the request of Matti, Fiori shall submit to Matti, or its duly authorized representatives, samples of any advertising and promotional materials bearing the Mark for the purpose of ascertaining or determining compliance with the quality standards set forth in Paragraph 4.

9. Fiori assumes no liability with respect to the products produced or services rendered by Matti in association with the Mark and Matti shall indemnify and save Fiori for all claims of third persons arising out of Matti's products or services associated with the Mark.

10. Matti assumes no liability with respect to the products produced or services rendered by Fiori in association with the Mark and Fiori shall indemnify and save Fiori for all claims of third persons arising out of Fiori's products or services associated with the Mark.

11. The obligations of Fiori and Matti set forth in this Agreement shall exist for only so long as either Fiori or Matti continue to use the Mark in their respective businesses. Should either Fiori or Matti discontinue use of the Mark for a continuous period of 2 years, both Fiori and Matti shall be relieved of all obligations set forth in this Agreement.

12. It is in the interests of both Matti and Fiori to prevent any likelihood of confusion that may potentially arise from the concurrent use of the Mark by each of the parties in their respective geographical areas as set forth in Paragraphs 1 and 2 of this Agreement. Therefore, Matti agrees that at all times during the term of this Agreement, Matti shall expressly identify in any of its corporate literature or advertising appearing in Fiori's geographical area the following: (i) the location of its restaurants, businesses and other operations and/or (ii) identification and/or statements sufficient to indicate that it is a separate entity from Fiori. Furthermore, Fiori agrees that at all times during the term of this Agreement, Fiori shall expressly identify in any of its corporate literature or advertising appearing in Matti's geographical area the following: (i) the location of its restaurants, businesses and other operations and/or (ii) identification and/or statements sufficient to indicate that it is a separate entity from Matti.

13. Matti acknowledges Fiori's right, title, and interest in and to its name and the Mark for the locations identified in Paragraph 1, and Fiori acknowledges Matti's right, title, and

interest in and to its name and the Mark for the locations identified in Paragraph 2, and neither party will at any time do or cause any act or thing contesting or in any way impairing or tending to impair any part of the right, title, and interest of the other.

14. Any notices required or permitted to be given under this Agreement shall be deemed sufficiently given if sent by prepaid courier or sent by facsimile to the party to be notified at its address below, or to such other address as may be furnished in writing by such party to the notifying party:

a. In the case of Fiori: Anthony S. Cannatella
Pavia & Harcourt LLP
600 Madison Avenue
New York, NY 10022
Facsimile: (212)980-3135

b. In the case of Matti: Raymond P. Niro
Niro, Scavone, Haller & Niro, Ltd.
181 West Madison Street, Suite 4600
Chicago, IL 60602
Facsimile: (312)236-3137

15. Because it is a central location for the parties, this Agreement shall be interpreted in accordance with the laws of the State of Illinois, irrespective of its rules concerning conflicts of laws. The parties agree to submit themselves to the jurisdiction of the United States District Court for the Northern District of Illinois to resolve any conflict relating to the subject matter of this Agreement.

16. Any changes or alterations to this Agreement must be provided in writing and agreed upon by both Fiori and Matti in writing.

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17. This is the entire agreement between the parties concerning its subject matter and supersedes all prior negotiations and agreements, oral or written. There are no other contemporaneous agreements between the parties relating to the subject matter hereof.

18. This Agreement is not assignable by either party without the consent of the other party.

19. This Agreement may be executed by the parties in separate counterparts and exchanged by facsimile, with the same effect as if all parties had signed the same instrument.

WHEREFORE, the parties hereby acknowledge their agreement and consent to the terms and conditions set forth above through their respective signatures as contained below:

I MATTI RISTORANTE, INC.

By: [Signature]

Its: J.P.

CAMPO DE FIORI L.L.C.

By: BRUNO GALARDI-ESTE

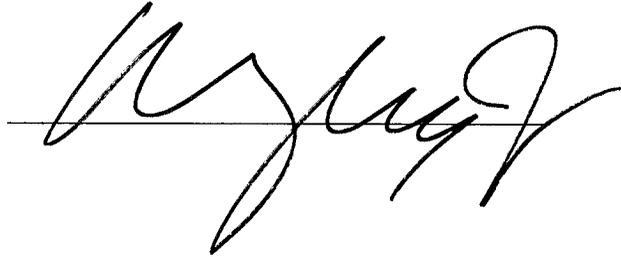
Its: MANAGING MEMBER

12/29/2005

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **APPLICANT'S MOTION ON CONSENT TO AMEND APPLICANT'S CONCURRENT USE APPLICATION** was served upon the below listed counsel by U.S. Postal Express Mail Service on this 25 day of January, 2006.

Anthony S. Cannatella, Esq.
Pavia & Harcourt
600 Madison Avenue
New York, NY 10022

A handwritten signature in black ink, appearing to read 'Anthony S. Cannatella', is written over a horizontal line.