

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: September 15, 2006

Concurrent Use No. 94002078

I Matti Ristorante, Inc.

v.

Campo De Fiori, L.L.C.

Cindy B. Greenbaum, Attorney:

The Board's December 2, 2004 order rejected the terms of the parties' proposed concurrent use agreement (filed May 14, 2004) because, among other things, the agreement allowed each party to use and advertise its mark in the other party's territory (i.e., the "sub-licensing provisions"), and the agreement did not include language regarding the prevention of likelihood of confusion among consumers. On January 31, 2006, applicant submitted a revised concurrent use agreement that purportedly overcomes the Board's earlier objections.¹ However, the revised concurrent use agreement remains unacceptable.

¹ Applicant's motion (filed January 25, 2006) to withdraw its motion (filed January 23, 2006) to deem admitted applicant's requests for admissions is granted. The Board will take no action on the underlying motion to deem admitted the requests for admissions.

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Specifically, new paragraph 12 of the revised agreement contemplates each party advertising in the other party's territory, if they should so choose, so long as such advertisements contain certain disclaimers. The Board generally will approve a concurrent use agreement only if said agreement clearly states that the parties will not advertise in each other's territory, but if spillover advertising should occur, then the parties will take appropriate action to avoid any likelihood of confusion, such as by use of disclaimers or other means.

In this case, despite the recitation that the parties desire "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," they appear willing to advertise in each other's territory so long as certain information is included, namely, the location of the party's restaurants, businesses and other operations and/or identification and/or statements sufficient to indicate that it is a separate entity from the other party. Such cross-advertising is simply not acceptable in a concurrent use case.

The parties are allowed until THIRTY DAYS from the mailing date of this order to file a settlement agreement that addresses the above-noted deficiencies.

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This proceeding remains otherwise suspended.