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

Proceeding	94002610
Party	Applicant PM Pediatrics Management Group LLC
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Submission	Other Motions/Papers
Filer's Name	Martin W. Schiffmiller
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Signature	/Martin W. Schiffmiller/
Date	11/19/2014
Attachments	PM PEDIATRICS Joint Stipulation.pdf(925067 bytes )

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

-----X	:	
PM Pediatrics Management Group LLC,	:	
	:	
Applicant,	:	
v.	:	Concurrent Use No. 94002610
	:	
PM Pediatric Holdings, LLC,	:	
	:	
Registrant.	:	
-----X		

**STIPULATION AND AGREEMENT TO (1) AMEND REGISTRATION  
TO INCLUDE CONCURRENT USE GEOGRAPHIC RESTRICTIONS AND  
(2) ISSUE CONCURRENT USE REGISTRATION ON PENDING APPLICATION**

WHEREAS, PM Pediatric Holdings, LLC (hereinafter, “Registrant”) is the owner of U.S. Trademark Registration No. 3193477 of the mark PM PEDIATRICS & Design for “pediatric medical care” in Class 44; and

WHEREAS, PM Pediatrics Management Group LLC (hereinafter, “Concurrent Use Applicant”) is the owner of U.S. Trademark Application No. 85344372 for the mark PM PEDIATRICS & Design for “medical services” in Class 44; and

WHEREAS, on September 27, 2012 Registrant and Concurrent Use Applicant entered into a Concurrent Use Agreement (a copy of which is attached hereto as Exhibit 1), said agreement providing that (a) the Registrant is entitled to use and register the mark PM PEDIATRICS or any confusingly similar mark in the territory consisting of states of Tennessee, Kentucky, Arkansas, Louisiana, Mississippi, Alabama and the following counties in the State of Georgia: Catoosa, Chattooga, Dade, Dawson, Fannin, Floyd, Gilmer, Gordon, Habersham,

Lumpkin, Murray, Pickens, Rabun, Stephens, Towns, Union, Walker, White and Whitfield (“Registrant’s Territory”), and (b) that Concurrent Use Applicant is entitled to use and register the mark PM PEDIATRICS or any confusingly similar mark in all parts of the United States other than Registrant’s Territory; and

WHEREAS, on February 14, 2014 Concurrent Use Applicant converted its application Serial No. 85344372 to a concurrent use application, restricting the geographic scope of the application to all parts of the United States other than Registrant’s Territory; and

WHEREAS, concurrent use application Serial No. 85344372 was published for opposition on June 3, 2014 and no oppositions were filed thereto; and

WHEREAS on August 21, 2014 the Trademark Trial and Appeal Board instituted a concurrent use proceeding between concurrent use application Serial No. 85344372 and Registrant’s Registration No. 3193477;

IT IS HEREBY STIPULATED AND AGREED by and between the parties hereto through their undersigned counsel that:

1. Registration No. 3193477 shall be geographically restricted to Registrant’s Territory, i.e., the states of Tennessee, Kentucky, Arkansas, Louisiana, Mississippi, Alabama and the following counties in the State of Georgia: Catoosa, Chattooga, Dade, Dawson, Fannin, Floyd, Gilmer, Gordon, Habersham, Lumpkin, Murray, Pickens, Rabun, Stephens, Towns, Union, Walker, White and Whitfield.

2. Concurrent use application Serial No. 85344372 shall be permitted to proceed to registration, said registration being geographically restricted to all parts of the United States except for Registrant’s Territory, as set forth in said application.

3. Upon the approval of this Stipulation and Agreement, this concurrent use proceeding shall be dissolved.

Dated: November 19, 2014

Respectfully submitted,

/Samuel L. Miller/  
Samuel L. Miller  
BAKER DONELSON BEARMAN  
CALDWELL & BERKOWITZ  
Suite 800  
211 Commerce Street  
Nashville, TN 37201  
Smiller@bakerdonalson.com  
*Attorneys for Registrant*  
*PM Pediatric Holdings, LLC*

/Martin W. Schiffmiller/  
Martin W. Schiffmiller  
KIRSCHSTEIN, ISRAEL,  
SCHIFFMILLER & PIERONI, P.C.  
425 Fifth Avenue - Fifth Floor  
New York, NY 10016-2223  
mws@kirschsteinlaw.com  
*Attorneys for Applicant*  
*PM Pediatrics Management Group LLC*

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Stipulation and Agreement to (1) Amend Registration to Include Concurrent Use Geographic Restrictions and (2) Issue Concurrent Use Registration on Pending Application was served on Registrant's counsel, by first class mail, postage prepaid, in an envelope addressed to:

Samuel Miller, Esq.  
Baker Donelson Bearman Caldwell & Berkowitz  
Suite 800  
211 Commerce Street  
Nashville, TN 37201  
[Smiller@bakerdonelson.com](mailto:Smiller@bakerdonelson.com)

this 19th day of November, 2014

/Deborah A.Egan/  
Deborah A. Egan

# EXHIBIT 1

## CONCURRENT USE AGREEMENT

THIS AGREEMENT is by and between P.M. Pediatrics Management Group LLC, a limited liability company organized and existing under the laws of the State of New York, having its principal place of business at 1 Hollow Lane, Suite 301, Lake Success, New York 11042 (the "New York company") on the one hand, and, on the other hand, P.M. Pediatrics, LLC, a limited liability company organized and existing under the laws of the state of Tennessee, having its principal place of business at Hamilton Office Park, 7446 Suite 103, Chattanooga, Tennessee 37421 ("P.M. Pediatrics, LLC") and P.M. Pediatrics Holdings, LLC, a limited liability company organized and existing under the laws of the state of Delaware, having its principal place of business at 7446 Shallowford Road, Suite 103, Chattanooga, Tennessee 37421 (the "Tennessee company").

WHEREAS, the New York company owns U.S. Application No. 85344372 of the mark PM PEDIATRICS and Design for "medical services" in Class 44 (the "Application");

WHEREAS, P.M. Pediatrics, LLC obtained U.S. Registration No. 3,193,477 of the mark PM PEDIATRICS and Design for "pediatric medical care" in Class 44 (the "Registration");

WHEREAS, the Examining Attorney in the U.S. Patent and Trademark Office (the "U.S.P.T.O.") has cited the Registration as an obstacle to the Application;

WHEREAS, the New York company has petitioned to cancel the Registration in action number 92055016 (the "Action") before the Trademark Trial and Appeal Board (the "Board") based upon priority and a likelihood of confusion;

WHEREAS, P.M. Pediatrics, LLC assigned all its right, title and interest to the Registration to the Tennessee company on September 1, 2012;

WHEREAS, the New York company and the Tennessee Company, by and through its predecessor-in-interest, have used their respective marks in connection with their respective services in separate territories concurrently without any actual confusion and have reached an agreement to define and continue such concurrent use; and

WHEREAS, the New York company and the Tennessee Company (collectively the "Parties") are agreeable to resolving the Action by virtue of the terms of this Agreement, which will also prevent any future controversy between them concerning the use of their respective marks.

NOW THEREFORE, in consideration of the foregoing, and the covenants and conditions hereinafter set forth, the Parties agree as follows:

1. The Parties agree that the Tennessee company is entitled to use and register the mark PM PEDIATRICS, and any confusingly similar mark, in the territory consisting of the States of Tennessee, Kentucky, Arkansas, Louisiana, Mississippi, Alabama and parts of Georgia (as delineated in the map annexed hereto as Exhibit A) such territory being referred to as "Territory One."

2. The Parties agree that the New York company is entitled to use and register the mark PM PEDIATRICS, any confusingly similar mark, in all parts of the United States outside Territory One, such territory being referred to as "Territory Two."

3. The New York company agrees not to open or run any medical practice or otherwise provide any goods or services under the name or mark PM PEDIATRICS, or any confusingly similar name or mark, in Territory One.

4. The Tennessee company agrees not to open or run any medical practice or otherwise provide any goods or services under the name or mark PM PEDIATRICS, or any confusingly similar name or mark, in Territory Two.

5. The Tennessee company agrees not to advertise or promote any medical or related services or any products under the name or mark PM PEDIATRICS directly in Territory Two. Notwithstanding the above, the Tennessee company may generally advertise or promote medical services under the name or mark PM PEDIATRICS that, through no fault of its own, are disseminated in Territory Two (including, by way of non-limiting example, internet websites, public airwaves, and national print media distributions that spill into Territory Two).

6. The Parties both represent that they have had concurrent use of their respective PM PEDIATRICS marks since at least as early as 2005 in separate areas of the United States, namely, in the territory consisting of at least some of the states in Territory One by the Tennessee company and at least some of the states in Territory Two by the New York company, and that such concurrent use has not resulted in any actual confusion.

7. The New York company has, since at least as early as January 10, 2005, used its mark PM PEDIATRICS mainly in the form of the design mark shown in the Application. The Tennessee company has, since at least as early as October 11, 2005, used its mark PM PEDIATRICS mainly in the form of the design mark shown in the Registration. The Parties recognize and understand, however, that they have each, in the past and even presently on occasion, used their respective marks in different forms from those set forth in their respective Application and Registration, and that in the future they may use their respective marks in different forms.

8. The Parties agree to use their best efforts to ensure that there is no likelihood of confusion with respect to the use of their respective marks within their territories as defined *supra*, and further agree to consult and attempt to rectify any instances of confusion which may arise in the future in connection with their concurrent use.

9. The Parties agree that each is entitled to registrations covering the respective territory in which it is entitled to use its mark, as mentioned *supra*. The Parties further agree to make such changes in this Agreement which might be required by the Board in order to obtain such registrations by each party. It is understood and expected by the Parties that the Application and Registration will both become concurrent use registrations for the respective territory as defined *supra*.

10. The Parties shall promptly petition the Board for a conversion of the Action to a Concurrent Use Proceeding and shall cooperate with each other in the amicable resolution of such proceeding.

11. This Agreement shall be effective as of the last date of signing below and shall be perpetual, unless modified or terminated with mutual written consent of both parties. This Agreement may be executed by each party by way of fax or scan signature and in counterpart copies, which when combined after delivery shall constitute a complete agreement.

12. The terms and enforcement of this Agreement shall be construed by the substantive laws of the District of Columbia, excluding choice of law provisions, as if it were negotiated, executed, delivered and performed entirely in that state. All substantive federal trademark law issues shall be construed under precedents of the United States Court of Appeals for the Federal Circuit.

13. Each party shall bear its own costs and attorneys' fees in connection with this Agreement and any subsequent matter relating thereto.

14. This Agreement shall be binding on P.M. Pediatrics, LLC, the Parties, and all owners, officers, directors, agents, servants and employees of the Parties, all parent companies, divisions, subsidiaries, successors, assigns (including successors in ownership or assigns of the marks at issue) and licensees of the Parties, and all related companies of the Parties including, but not limited to, any entities or persons owned or controlled by a Party or its owners or officers, or in which a Party or its owners or officers is a partner, and all persons or companies acting in concert or in participation with any of them, and shall survive any and all such successions and assignments. This Agreement shall be binding upon any and all renewals of either Application or Registration, *supra*.

IN WITNESS WHEREOF, the parties hereto have caused this Agreement to be made and executed by duly authorized officers as of the dates indicated below.

P.M. PEDIATRICS MANAGEMENT  
GROUP LLC

By:

David Fiehl

Name:

DAVID FIEHL

Title:

EVP + Gen'l Counsel

Date:

9-27-12

P.M. PEDIATRICS, LLC

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

Name: \_\_\_\_\_

Title: \_\_\_\_\_

Date: \_\_\_\_\_

P.M. PEDIATRICS HOLDINGS, LLC

By:

Richard Stern

Name:

Richard Stern

Title:

Manager

Date:

9-21-12

11. This Agreement shall be effective as of the last date of signing below and shall be perpetual, unless modified or terminated with mutual written consent of both parties. This Agreement may be executed by each party by way of fax or scan signature and in counterpart copies, which when combined after delivery shall constitute a complete agreement.

12. The terms and enforcement of this Agreement shall be construed by the substantive laws of the District of Columbia, excluding choice of law provisions, as if it were negotiated, executed, delivered and performed entirely in that state. All substantive federal trademark law issues shall be construed under precedents of the United States Court of Appeals for the Federal Circuit.

13. Each party shall bear its own costs and attorneys' fees in connection with this Agreement and any subsequent matter relating thereto.

14. This Agreement shall be binding on P.M. Pediatrics, LLC, the Parties, and all owners, officers, directors, agents, servants and employees of the Parties, all parent companies, divisions, subsidiaries, successors, assigns (including successors in ownership or assigns of the marks at issue) and licensees of the Parties, and all related companies of the Parties including, but not limited to, any entities or persons owned or controlled by a Party or its owners or officers, or in which a Party or its owners or officers is a partner, and all persons or companies acting in concert or in participation with any of them, and shall survive any and all such successions and assignments. This Agreement shall be binding upon any and all renewals of either Application or Registration, *supra*.

IN WITNESS WHEREOF, the parties hereto have caused this Agreement to be made and executed by duly authorized officers as of the dates indicated below.

PM PEDIATRICS MANAGEMENT  
GROUP LLC

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

Name: \_\_\_\_\_

Title: \_\_\_\_\_

Date: \_\_\_\_\_

P.M. PEDIATRICS HOLDINGS, LLC

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

Name: \_\_\_\_\_

Title: \_\_\_\_\_

Date: \_\_\_\_\_

P.M. PEDIATRICS, LLC

By: Fric Danker

Name: [Signature]

Title: Managing Member

Date: 9/24/12

# EXHIBIT A

