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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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ARM

Mailed: April 20, 2016

Concurrent Use No. 94002650

Roof Deck Entertainment LLC

v.

Live! Holdings, LLC

Before Quinn, Lykos, and Masiello,
Administrative Trademark Judges.

By the Board:

Roof Deck Entertainment LLC ("Applicant") seeks a concurrent use registration of the mark MARQUEE in standard characters for the following services:

> Nightclubs; beach clubs, namely, an establishment which offers live disc jockey music, dancing, and recreational facilities for water activities in the nature of swimming and recreational hot tub lounging; entertainment services, namely, arranging and conducting parties, arranging and conducting special events for social entertainment purposes, dance events, and disc jockey services featuring recorded music, in International Class 41;
>
> Restaurant, bar and cocktail lounge services; beach clubs, namely, an establishment which offers cocktail lounge

> services, food, alcoholic and non-alcoholic beverages, in International Class 43.[1]

The application identified Live! Holdings, LLC ("Registrant") as the sole exception to Applicant's exclusive right to use its mark in commerce. Registrant is the owner of U.S. Reg. No. 3857629 for the mark THE MARQUEE in standard characters for the following services:

> Night club; entertainment services, namely, providing musical venues for live and pre-recorded concerts, in International Class 41;
>
> Restaurant, cocktail lounge, and bar services, in International Class 43.[2]

The application requested registration of Applicant's mark for the geographic territory consisting of the states of New York and Nevada. Applicant acknowledged Registrant's entitlement to a registration for the geographic territory consisting of the entire United States except the states of New York and Nevada. Applicant stated in its application that it would supply a consent of Registrant and with its response of September 17, 2014 filed a "Statement of Consent to Registration" signed by Registrant. The consent document recites that Registrant and Applicant have entered into a "confidential Agreement" whereby both parties have agreed to unspecified limitations upon the use of their respective marks. The "confidential Agreement" is not of record.

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[1] Application Serial No. 86135035, filed on December 4, 2013 under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), stating December 16, 2003 as the date of first use and first use in commerce.

[2] Reg. No. 3857629 issued on October 5, 2010, based on an application filed February 3, 2009.

After examination, the application was published for opposition. The Board instituted this concurrent use proceeding on February 6, 2016 and now considers whether the proceeding may be disposed of on the basis of Registrant's consent and the parties' "confidential Agreement."

As a general matter, the Board will find an applicant entitled to concurrent registration on the basis of a settlement agreement only if the terms of the agreement are sufficient to persuade the Board that confusion, mistake, or deception is not likely to result from the continued concurrent use by the parties of their marks. 15 U.S.C. § 1052(d). The mere existence of an agreement between the parties will not always and automatically result in a finding of no likelihood of confusion. A "naked" consent to registration, *i.e.*, one that does not provide a reasoned basis for the consent given, is entitled to little probative weight in the likelihood of confusion analysis. *See e.g., In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). On the other hand, an agreement which includes information as to why the parties believe confusion is unlikely, which evidences the parties' business-driven belief and conclusion that there is no likelihood of confusion, and which includes provisions to avoid any potential confusion, is entitled to great weight in favor of a finding that confusion is not likely. *In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 USPQ2d 1071 (Fed. Cir. 1993); *Bongrain Int'l (Am.) Corp. v. Delice De France, Inc.*, 811 F.2d 1479, 1 USPQ2d 1775 (Fed. Cir. 1987). The persuasiveness of the agreement depends on the reasons the parties give as to why they have reached the conclusion

that confusion is not likely. *Holmes Oil Co. v. Myers Cruizers of Mena Inc.*, 101 USPQ2d 1148, 1150 (TTAB 2011).

In the consent document, Registrant consents to a registration of Applicant's mark that is limited to the states of New York and Nevada and agrees to the amendment of its own registration so as to limit its geographic scope by exclusion of Applicant's territories. According to the consent document, the "confidential Agreement" states:

> [T]he parties will avoid confusion by using somewhat different marks and using them in different territories or in overlapping territories, for different services.

The parties offer no explanation of how their marks are, or will be, "somewhat different"; the only difference between the marks that is known to the Board is that one of them includes the initial term THE. The quoted provision also indicates that both parties will continue to use their marks in "overlapping territories," albeit for "different services"; there is no information as to the nature of these purportedly "different services." Use of the parties' marks in an overlapping territory on services that are technically different yet commercially related could have the effect of increasing, rather than alleviating, the likelihood of confusion.

The consent document also states that the confidential Agreement sets forth the parties' agreement that confusion has not yet occurred and that use of the parties' marks in separate territories is not likely to cause confusion in the future. As the Agreement is described in the consent document, the parties have agreed to "make reasonable efforts":

> (1) to prevent, eliminate and minimize any confusion "by redirecting the inquirer or any misdirected mail,

telephone inquiries or communications" to the appropriate party;

(2) not to use the logos or tag lines of the other;

(3) not to act to create an association between the parties and their businesses.

The three measures described above do not differ greatly from what would be expected of two strangers having no contractual relationship. No business should act to falsely create the impression of an association with another business; nor should it use the "logos or tag lines" already adopted by a competitor. The agreement to redirect misdirected mail and communications is a desirable courtesy that corrects an error; but it does not indicate that anything will be done to prevent the same type of error from occurring in the future.

Bearing in mind that the parties' services are identical and their marks are essentially identical, the parties' submissions do not persuade the Board that confusion is not likely to result from the continued concurrent use by the parties of their marks. Accordingly, proceedings are SUSPENDED for SIXTY DAYS from the mailing date of this order to allow the parties time to submit a revised agreement or other evidence of their commitment to measures for the avoidance of confusion, failing which proceedings shall be resumed. Note that providing more information as to why the parties believe confusion to be unlikely, together with support for such belief in the form of demonstrated facts and undertakings of the parties, will better allow the Board to determine that the consent is based on a reasoned assessment of the marketplace. We point out that the persuasive value of any agreement will be increased if the actual agreement is submitted for the Board's review. Confidential

materials can be filed under seal through the Board's ESTTA electronic filing system, and if so filed they will not be made available for public viewing. *See* TBMP §§ 120.02 and 412.04 (2015) for information regarding proper filing of confidential materials. *See* TBMP § 1110 for examples of measures that parties may take for the prevention of confusion.

ORDERED:

This proceeding is SUSPENDED for sixty days from the mailing date of this order to allow time for the parties to submit a revised settlement agreement, failing which proceedings shall be resumed, and subject to the right of either party to request resumption of proceedings.