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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Roof Deck Entertainment LLC

v.

Live! Holdings, LLC

Concurrent Use No. 94002650

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

Opinion by Masiello, Administrative Trademark Judge:

In an order dated April 20, 2016, the Board considered whether this concurrent use proceeding could be disposed of on the basis of a written consent made of record during the examination of the application. We determined that it could not, and we allowed the parties time in which to make a more detailed presentation of their proposed terms of concurrent use. Applicant Roof Deck Entertainment LLC ("Applicant") has now submitted a confidential filing[1] consisting of Applicant's arguments, a declaration of Applicant's principal, and a complete copy of a 2010

[1] 6 TTABVUE. The attempted filings docketed as 5 and 7 TTABVUE were incomplete.

"Confidential Settlement and Trademark Agreement" (the "Agreement") between Applicant's predecessor in interest[2] and Registrant Live! Holdings, LLC ("Registrant"). We will discuss the terms of the parties' confidential settlement in general terms only.

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.[3]

The application identified Registrant as the sole exception to Applicant's exclusive right to use its mark in commerce. Registrant is the owner of 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;

[2] Tepperburg declaration ¶ 7, 6 TTABVUE 10.

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

> Restaurant, cocktail lounge, and bar services, in International Class 43.[4]

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. During the examination of the application Applicant filed, on September 17, 2014, a "Statement of Consent to Registration" signed by Registrant.

The parties' Agreement assigns to Applicant the states of New York and Nevada as areas in which Applicant would enjoy the exclusive use of marks consisting of or including the term MARQUEE. The Agreement assigns to Registrant another state (geographically distant from both New York and Nevada) as an area in which Registrant would enjoy the exclusive use of certain specific marks, including the marks MARQUEE and THE MARQUEE. Although Applicant is prohibited from operating under the mark MARQUEE in Registrant's designated state, the Agreement allows Applicant's advertising under the mark to be disseminated in Registrant's state.

The Agreement also identifies three substantial geographic regions, far distant from each other, which either party may attempt to claim as an exclusive region of use, provided that certain notice and payment provisions are observed. The Agreement provides that in the remainder of the United States the parties will

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

coexist. In this region of coexistence, Applicant would be free to use MARQUEE alone as well as many MARQUEE-formative marks; however, Registrant would be limited to using three specific MARQUEE-formative marks, different from those allowed in Registrant's state of exclusivity and not including MARQUEE alone or THE MARQUEE alone. The three specific MARQUEE-formative marks of Registrant are prohibited to Applicant nationwide; and Registrant has agreed not to use a list of specific MARQUEE-formative marks that Applicant is likely to use.

Applicant's principal has stated that he is unaware of any instances of actual confusion "between the services" offered under the parties' respective marks during the "more than seven years that both parties' marks have been used."[5] He contends that he would be likely to know of any such confusion because, under the Agreement, "Registrant is required to notify Applicant of any instances of actual confusion that come to its attention."[6]

The Board has been enjoined to give "substantial" and even "great" weight to agreements entered into between parties in good faith, and to defer to the parties' assessment of the likelihood of confusion. *See Amalgamated Bank v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305, 1307 (Fed. Cir. 1988) (citing *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973) ("It is at least difficult to maintain a subjective view that confusion will occur when

[5] Tepperburg declaration ¶ 6, 6 TTABVUE 10.

[6] *Id.* at ¶ 9, 6 TTABVUE 10. Section 19 of the Agreement provides that "The parties hereto agree that they will make reasonable efforts to prevent, eliminate and minimize any present or future confusion or likelihood of confusion … by redirecting the inquirer or any misdirected mail, telephone inquiries or communications" to the appropriate party. 6 TTABVUE 25.

those directly concerned say it won't.")). *See also In re Beatrice Foods Co.*, 166 USPQ 431, 437 (CCPA 1970); *Bongrain Int'l (American) Corp. v. Delice de France, Inc.*, 811 F.2d 1479, 1485-85, 1 USPQ2d 1775, 1778 (Fed. Cir. 1987); *Houlihan v. Parliament Import Co.*, 921 F.2d 1258, 17 USPQ2d 1208, 1212 (Fed. Cir. 1990). We assume that the parties are familiar with trade and market practices for their industry as well as the realities of the marketplace and channels of trade for their services. Based upon Registrant's consent and the parties' Agreement, we find that concurrent use of the involved marks is not likely to cause confusion, mistake or deception under 15 U.S.C. § 1052(d).

Decision: Applicant has demonstrated that it is entitled to a registration of its mark that is geographically restricted to the states of New York and Nevada pursuant to Concurrent Use Proceeding No. 94002650. Concurrent registration with Live! Holdings, LLC.

Registration No. 3857629 will be restricted to the geographic area comprising the United States except the states of New York and Nevada, pursuant to Concurrent Use Proceeding No. 94002650. Concurrent registration with Roof Deck Entertainment LLC.