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Filing date: **01/16/2019**

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

Proceeding	91233404
Party	Defendant Cops & Robbers, LLC
Correspondence Address	JAMES A TRIGG KILPATRICK TOWNSEND & STOCKTON LLP 1100 PEACHTREE STREET, SUITE 2800 ATLANTA, GA 30309 UNITED STATES jtrigg@ktslaw.com, jwelsh@ktslaw.com, kteilhaber@ktslaw.com, tmad- min@ktslaw.com 404-815-6500
Submission	Other Motions/Papers
Filer's Name	James A. Trigg
Filer's email	jtrigg@ktslaw.com, kcook@ktslaw.com, kteilhaber@ktslaw.com, tmad- min@ktslaw.com
Signature	/James A. Trigg/
Date	01/16/2019
Attachments	2019.01.16 Joint Motion for Leave to File Amendment to Allege Use_Exh. 1 and 2.pdf(3154412 bytes)

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

EASTERN STATE PENITENTIARY)	
HISTORIC SITE, INC.,)	
)	In re Serial No. 86/884,950
Opposer,)	
)	Mark: ALCATRAZ EAST
v.)	
)	Opposition No. 91233404
COPS & ROBBERS, LLC.)	
)	
Applicant.)	

**JOINT MOTION FOR LEAVE TO FILE
AMENDMENT TO ALLEGE USE**

Opposer Eastern State Penitentiary Historic Site, Inc. (“Opposer”) and Applicant Cops & Robbers, LLC (“Applicant”) (collectively referred to as the “Parties”) have resolved the current dispute related to the above-referenced Opposition No. 91233404, conditioned upon the amendment of Applicant’s Application Serial No. 86/884,950 (the “Application”) to allege use so that Applicant may amend its Application to seek a concurrent use registration. Applicant wishes to cite first use dating to December 16, 2016.

In accordance with 37 C.F.R. § 2.133 and the Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) §§ 219 and 514.04, and pursuant to a Concurrent Use Agreement (the “Agreement”), attached hereto as **Exhibit 1**, the Parties respectfully request that the Trademark Trial and Appeal Board (the “Board”) grant the Applicant leave to amend its Application to allege use so that Applicant may amend its Application to seek a concurrent use registration. A proposed Amendment to Allege Use is attached as **Exhibit 2**.

An amendment to allege use is not generally considered timely when filed after approval for publication. Nevertheless, the rules precluding filing an amendment to allege use following approval for publication may be waived when: (1) an extraordinary situation exists; (2) justice

requires; and (3) no other party is injured. *Hanscomb Ltd v. Hanscomb Consulting, Inc.*, 2015 WL 12766228, at *3 (T.T.A.B. Sept. 14, 2015). In *Hanscomb Limited v. Hanscomb Consulting, Inc.*, the Board determined that the petitioner did not satisfy the three factors required for waiver of the rule. However, unlike the *Hanscomb* case, in this case: (1) an extraordinary situation exists; (2) justice requires waiver of the rules; and (3) no other party will be injured.

(1) An Extraordinary Situation Exists.

Here, an extraordinary situation exists that warrants a waiver of the rule precluding an amendment to allege use following the approval for publication. Here, the Parties have consented to the peaceful coexistence and have the Agreement in place. Both Parties claim to have been using their marks in commerce without confusion. Further, unlike the *Hanscomb* case, there is a dispute between the parties in the instant matter as to whether the Opposer clearly has prior use. (The parties respectfully disagree on that issue, but have entered into the Concurrent Use Agreement in an effort to compromise.)

(2) Justice Requires Waiver of the Rules.

Justice requires waiver of the rules to allow Applicant to file an amendment to allege use because a finding otherwise would mean that Applicant loses its priority date based on the application filing date.

(3) No Other Party Is Injured.

Here, the Parties have entered into the Agreement and the Opposer consents to Applicant's amendment to allege use. Thus, no party would suffer an injury as a result of the Board allowing Applicant to proceed with amending its application.

Pursuant to 37 C.F.R. § 2.133(a), Applicant obtained consent of Opposer to amend its Application to Allege Use and convert the Application to one for a concurrent use registration, as outlined in Paragraph 9 of the Concurrent Use Agreement, (Exhibit 1, § 9).

The proposed amendment does not require republication of the application because the amendment does not broaden the scope of rights claimed by the Applicant under the Application.

Accordingly, for the reasons set forth above, the parties respectfully request that the Board allow Applicant to amend its application to allege use so that it may convert its application to a Concurrent Use Application.

Dated: January 16, 2019

Respectfully submitted,

/Leslie H. Smith/
Leslie H. Smith
Gregory L. Liacouras
LIACOURAS & SMITH, LLP
1515 Market Street, Suite 808
Philadelphia, PA 19102
(215) 241-5303
lsmith@liacouraslaw.com

*Counsel for Opposer Eastern State
Penitentiary Historic Site, Inc.*

/James A. Trigg/
James A. Trigg
Kenesia Cook
KILPATRICK TOWNSEND & STOCKTON
LLP
Suite 2800
1100 Peachtree Street NE
Atlanta, Georgia 30309-4528
Telephone: (404) 815-6500
jtrigg@kilpatricktownsend.com
kcook@kilpatricktownsend.com

Counsel for Applicant Cops & Robbers, LLC

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **JOINT MOTION FOR LEAVE TO FILE AMENDMENT TO ALLEGE USE** has been served on Opposer by forwarding said copy on January 16,2019 via email to:

Leslie H. Smith
Gregory L. Liacouras
lsmith@liacouraslaw.com
gll@liacouraslaw.com

/Kris Teilhaber/
Kris Teilhaber

EXHIBIT 1

Concurrent Use Agreement

This Concurrent Use Agreement (“Agreement”) is entered into between Eastern State Penitentiary Historic Site, Inc. a Pennsylvania non-profit corporation, with an address at 2027 Fairmount Avenue, Philadelphia, Pennsylvania 19130 (“ESP”), and Cops & Robbers, LLC, a Tennessee limited liability company, with an address at 20 North Orange Avenue, Suite 1600, Orlando, Florida 32801 (“C&R”), and is effective as of the date fully executed below by the Parties (“Effective Date”). ESP and C&R are hereinafter referred to collectively as the “Parties” and each individually as a “Party.”

WHEREAS, ESP represents that it has been using its ALCATRAZ OF THE EAST service mark in connection with its EASTERN STATE PENITENTIARY museum, located in Philadelphia, Pennsylvania, in the historic penitentiary that once housed notorious criminals, including Al Capone;

WHEREAS, ESP represents that it has been using its ALCATRAZ OF THE EAST service mark throughout the 75-mile radius area of Philadelphia, Pennsylvania (collectively, “ESP’s Area of Use”), since at least as early as 2013;

WHEREAS, C&R represents that it has been using its ALCATRAZ EAST service mark as the name of its museum dedicated to law enforcement, forensic science, and the history of crime, located in Pigeon Forge, Tennessee, a museum designed as a combination of Tennessee’s first state prison and the guard towers inspired by the Alcatraz lighthouse;

WHEREAS, C&R represents that it has been using its ALCATRAZ EAST service mark throughout the 75-mile radius area of Pigeon Forge, Tennessee (collectively, “C&R’s Area of Use”), since at least as early as December 16, 2016, with a constructive nationwide priority date of January 25, 2016, upon registration of its federal application for registration of ALCATRAZ EAST, Serial No. 86/884,950, for use in connection with museum services (the “Application”), and C&R further has advertised its ALCATRAZ EAST mark on a nationwide basis;

WHEREAS, on March 10, 2017, ESP filed with the Trademark Trial and Appeal Board a Notice of Opposition to registration of the Application, instituting opposition proceeding No. 91233404 (the “Opposition”), and on April 24, 2017, C&R filed its Answer and Affirmative Defenses to ESP’s Notice of Opposition;

WHEREAS, based on the distinct, non-overlapping current areas of use, the fact that the parties operate substantially different museums (both physically, in content, and in name), in substantially distinct geographic areas, with substantially different trade dress, at different price points, and the Parties’

willingness to cooperate to prevent confusion arising between their respective ALCATRAZ marks, the Parties believe they can continue to coexist without any likelihood of confusion between their respective ALCATRAZ marks; and

WHEREAS each Party wishes to enter into this Agreement, to prevent any likelihood of confusion between their respective service marks, and to amicably resolve the Opposition.

NOW THEREFORE, in consideration for the mutual promises and undertakings set forth herein, the receipt and sufficiency of which are hereby acknowledged, the Parties agree as follows:

1. Territorial Restrictions.

- a. ESP agrees to use its ALCATRAZ OF THE EAST mark only within ESP's Area of Use or any Unclaimed Area, and to always display the Eastern State Penitentiary name and/or service mark in close proximity to each use of its ALCATRAZ OF THE EAST mark. The use by ESP of its ALCATRAZ OF THE EAST mark on its web site located at www.easternstate.org shall be considered, for purposes of this Agreement, to be use within ESP's Area of Use.
- b. C&R agrees to use its ALCATRAZ EAST mark only within C&R's Area of Use or any Unclaimed Area. The use by C&R of its ALCATRAZ EAST mark on its web site located at www.alcatrazeast.com shall be considered, for purposes of this Agreement, to be use within C&R's Area of Use.
- c. With respect to any geographic area outside of either Party's Area of Use (each such geographic area an "Unclaimed Area"), the Party that first uses its ALCATRAZ mark by commencing operation of a physical facility providing museum services under such mark in any Unclaimed Area and that uses such mark continuously in connection with such physical facility for at least a one-year period in that Unclaimed Area shall, with written notification to the other Party that contains proof of such continuous use of the Party's ALCATRAZ mark in that Unclaimed Area, incorporate such Unclaimed Area into its Area of Use.

2. ESP's Consent to C&R's Use and Registration of ALCATRAZ EAST.

Subject to C&R's compliance with Paragraph 1(b) above, ESP hereby: (a) agrees not to object to, oppose, or otherwise seek to limit C&R's use of the ALCATRAZ EAST mark, in connection with museum-related goods

and services; (b) consents to registration of the Application, provided that the Application is amended, under 37 C.F.R. § 2.73, to recite concurrent use as set forth in this Agreement, and (c) consents to registration of any other trademark/service mark application filed by C&R for registration of ALCATRAZ EAST, for use in connection with museum-related goods and services, provided that any such other application recites concurrent use, as set forth in this Agreement.

3. C&R's Consent to ESP's Use and Registration of ALCATRAZ OF THE EAST.

Subject to ESP's compliance with Paragraph 1(a) above, C&R hereby: (a) agrees not to object to, oppose, or otherwise seek to limit ESP's use of the ALCATRAZ OF THE EAST mark, in connection with museum-related goods and services; and (b) consents to registration of any trademark/service mark application filed by ESP for registration of ALCATRAZ OF THE EAST, for use in connection with museum-related goods and services, provided that any such application recites concurrent use as set forth in this Agreement.

4. No Likelihood of Confusion.

The Parties recognize and agree that compliance with Paragraphs 1, 2 and 3, together with each Party's representation and assurance that it will not use its respective ALCATRAZ mark to suggest an affiliation or connection with the other Party hereto, and with each Party's representation and assurance that it will take reasonable measures under the circumstances to market and promote its respective services in such a manner as to mitigate any likelihood of confusion between the respective services, is expected to prevent conflict between the Parties' respective marks and to preclude a likelihood of confusion between the marks.

5. Agreement to Cooperate.

- (a) Should the Parties become aware of any confusion or likelihood of confusion between their respective ALCATRAZ marks, the Parties agree to cooperate promptly in good faith to attempt to eliminate such confusion or likelihood of confusion.
- (b) The Parties agree to take any further actions and execute any further agreements, including consent to register agreements, needed to carry out the spirit and intent of this Agreement.

6. Term.

This Agreement shall begin as of the Effective Date and shall remain in effect indefinitely, unless (a) earlier terminated by either Party, in accordance with Paragraph 7 herein, or (b) a Party abandons its respective ALCATRAZ mark, in accordance with the below-described "Abandonment Procedure." For purposes of this Agreement, "Abandonment Procedure" shall mean either: (i) a Party voluntarily notifying the other Party, in writing, that it has abandoned use of its respective ALCATRAZ mark; or (ii) a Party sending written notice to the other Party, inquiring whether such other Party has abandoned its respective ALCATRAZ mark ("Abandonment Inquiry"). The Party receiving the Abandonment Inquiry, within thirty (30) days of receipt of the Abandonment Inquiry, shall provide evidence that it is still using its ALCATRAZ mark in commerce. If the Party receiving the Abandonment Inquiry does not provide evidence of use of its ALCATRAZ mark in commerce, or if the Party receiving the Abandonment Inquiry does not respond to the Abandonment Inquiry, then the mark will be deemed abandoned for purposes of this Agreement, and the Party that sent the Abandonment Inquiry shall, after the expiration of such 30-day period, have no obligation to abide by any conditions or restrictions set forth in this Agreement.

7. Termination.

Either Party may terminate this Agreement upon written notice to the other Party, if that other Party breaches, in any material respect, any term of this Agreement and fails to cure that breach within thirty (30) days after receipt of written notice of the breach from the non-breaching Party.

8. Notices.

(a) All notices and other communications under this Agreement must be made in writing and addressed to the other Party at the address below:

To C&R: Janine Vaccarello
 Chief Operating Officer
 Cops & Robbers, LLC
 20 N. Orange Avenue, Suite 1600
 Orlando, FL 32801
 janine@attractionssupportservices.com

With a copy to: James Trigg, Esq.

Kilpatrick Townsend & Stockton LLP
Suite 2800
1100 Peachtree Street NE
Atlanta, GA 30309-4528
jtrigg@kilpatricktownsend.com

To ESP: Brett Bertolino, Vice President, Director of Operations
Eastern State Penitentiary Historic Site
2027 Fairmount Avenue
Philadelphia, PA 19130
bb@easternstate.org

With a copy to: Leslie H. Smith, Esq.
Liacouras & Smith, LLP
1515 Market Street, Suite 808
Philadelphia, PA 19102
lsmith@liacouraslaw.com

Either Party may change its address for receiving notices under this Agreement by giving notice in writing thereof to the other Party.

- (b) All notices required under this Agreement must be sent by: (1) certified or registered mail, with return receipt requested, postage prepaid; (2) nationally recognized overnight courier (e.g., Federal Express; UPS), with written confirmation of receipt; or (3) e-mail, with written confirmation of receipt from the recipient and with simultaneous first class mailing of the notice. Notices shall be deemed to be received on the "received" date indicated on the written confirmation of receipt.

9. Dismissal of Opposition

Within 3 business days of the execution of this Agreement by both parties, C&R will circulate to ESP a joint Motion for Leave to File Amendment to Allege Use (the "Motion for Leave") requesting that the Board allow C&R to amend the Application to allege use and then convert the Application to a concurrent use application reciting ESP's claimed prior use as set forth in this Agreement, and C&R shall file such fully-signed Motion for Leave with the Trademark Trial and Appeal Board within 3 business days of its receipt of the Motion for Leave signed by, or on behalf of, ESP. ESP shall cooperate with C&R as reasonably requested to assist C&R's efforts to amend the current Application to a concurrent use application. Within 3 business days of the Trademark Trial and Appeal Board's approval of C&R's amended Application (i.e., approval of the Application amended to a concurrent use application), ESP shall circulate to C&R a Motion to

Withdraw the Opposition with the Consent of C&R (the "Motion to Withdraw") in substantially the form set forth at Exhibit A, and ESP shall file such fully-signed Motion to Withdraw with the Trademark Trial and Appeal Board within 3 business days of its receipt of the Motion to Withdraw signed by, or on behalf of, C&R. If the foregoing procedure is not successful, ESP shall consent to the registration of any other application for concurrent use filed by C&R in compliance with Paragraph 2 above.

10. Entire Agreement/Subsequent Amendments.

This Agreement is intended by the Parties as a final and complete expression of their agreement, and supersedes any and all prior and contemporaneous agreements and understandings relating to the subject matter of this Agreement.

11. Waiver.

The waiver by either Party of any breach of any provision of this Agreement by the other Party shall not be deemed to be either a waiver of any subsequent or prior breach of any such provision or any other provision or a waiver of the provision itself.

12. Severable Provisions.

If any provision of this Agreement is held to be illegal, invalid or unenforceable under present or future law, such provision shall be fully severable, without effect on the remaining provisions, except to the extent necessary to make the remaining provisions legal, valid and enforceable, and unless such severance would cause this Agreement to fail of its essential purpose. In lieu of the illegal, invalid or unenforceable provision, there shall be added or substituted a provision as similar in terms and effect as may be possible that is legal, valid and enforceable.

13. Headings/No Adverse Inference.

The headings used in this Agreement are only for purpose of reference. Such headings shall not be deemed to govern, limit, modify or in any other manner affect the scope, meaning or intent of the provisions of this Agreement or any part thereof, nor shall such captions otherwise be given any legal effect. No adverse inference shall be drawn based upon which party drafted or negotiated any provision of this Agreement.

14. Representation.

Each Party to this Agreement represents and warrants that it has consulted with legal counsel of its own choosing with respect to the execution of this Agreement.

15. Assignment/Transfer.

This Agreement is freely assignable or transferable by either of the Parties, without the written consent of the other, provided such assignment is made in conjunction with the assignment of that Party's respective trademark as recited herein.

16. Binding Effect/Successors and Assigns.

This Agreement shall be binding on and inure to the benefit of ESP and C&R, and their respective successors and permitted assigns.

17. Confidentiality.

This Agreement may be submitted to the U.S. Patent and Trademark Office in connection with overcoming a refusal to register any application filed pursuant to, respectively, Paragraph 2(b)(for applications filed by C&R) and Paragraph 3(b)(for applications filed by ESP) above, but otherwise the terms of this Agreement shall be considered confidential, and the Parties agree that disclosure to any other third party is allowable only with written consent of the non-disclosing Party or as may be required by a court or tribunal with appropriate jurisdiction over a Party.

18. Execution/Authority.

- a. This Agreement may be executed in counterparts, each of which will be considered an original, but both of which, when put together, will constitute one and the same instrument.
- b. Each Party represents and warrants that: (i) it has the capacity and right to enter into this Agreement; and (ii) the individual that signs this Agreement on its behalf is authorized to execute this Agreement.
- c. Signatures exchanged electronically or via facsimile shall be enforceable as originals.

[signatures on following page]

IN WITNESS HEREOF, the Parties hereto, intending to be legally bound, agree to all of the terms and conditions of this Agreement.

EASTERN STATE PENITENTIARY
HISTORIC SITE, INC.

Signed: _____

Name: Brett Bertolino

Title: V.P., Director of Operations

Date: 1/3/19

COPS & ROBBERS, LLC

Signed: _____

Name: Janine Vaccarello

Title: COO

Date: 1/11/19

EXHIBIT 2

Allegation of Use
(Statement of Use/Amendment to Allege Use)
(15 U.S.C. Section 1051(c) or (d))

To the Commissioner for Trademarks:

MARK: ALCATRAZ EAST

SERIAL NUMBER: 86/884,950

This Allegation of Use is being submitted before a Notice of Allowance issues.

The applicant, Cops & Robbers, LLC, having a place of business at 20 N. Orange Avenue, Suite 1600, Orlando, Florida, 32801, is using or is using through a related company the mark in commerce on or in connection with the services as follows:

For International Class 041: Museum services.

The mark was first used at least as early as 12/16/2016, and first used in commerce at least as early as 12/16/2016, and is now in use in such commerce. The applicant is submitting one specimen for the class showing the mark as used in commerce on or in connection with any item in the class, consisting of webpage as advertisements for the services.

The applicant hereby appoints William H. Brewster, Esq., James A. Trigg, Esq., Laura Tejada, Esq., and Kenesia L. Cook, Esq., members of the bar of the State of Georgia, of Kilpatrick Townsend & Stockton LLP, 1100 Peachtree Street, N.E., Suite 2800, Atlanta, Georgia 30309-4530 USA, to submit this Service Mark Allegation of Use on behalf of the applicant.

A fee payment in the amount of \$200 will be submitted with the form, representing payment for 1 class.

APPLICANT NAME: Cops & Robbers, LLC
MARK: ALCATRAZ EAST

Declaration

Applicant requests registration of the above-identified service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq., as amended). Applicant is the owner of the mark sought to be registered, and is using the mark in commerce on or in connection with the services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce.

The undersigned being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this document, declares that she is properly authorized to execute this document on behalf of the Owner; and all statements made of her own knowledge are true and that all statements made on information and belief are believed to be true.

Signature:  _____ Date: 1/16/19 _____

Signatory's Name: Janine Vaccarello

Signatory's Position: Chief Operating Officer


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ALCATRAZ EAST'S FAMOUS ARTIFACTS ★ ★ ★

 visit our [Crime Library](#).

Ted Bundy is considered the most notorious serial killer in history. The public's fascination with his crimes are studied to this day. Some pieces from the museum's collection include: **Bundy's VW Bug**, a typewriter used in prison, and his trial dental mold. His 30 year execution anniversary on January 24, 2019 has ignited a wave of general interest, movies, and documentaries. To learn more about Ted Bundy,



Our guests are always surprised to see the **White Ford Bronco** that carried a frantic and suicidal O.J. Simpson during the famous televised car chase! Visit our [Facebook](#) page to see our awesome reviews.


 Alcatraz East
 4.8 ★★★★★
 powered by Facebook

 Lindsey Kirk
 4 days ago
 ★★★★★ Awesome experience! AC's Bronco on display 📸

 Curt Lege
 6 days ago
 ★★★★★ enjoyed it very professional presentation took two hours to walk through

 Mel Casey
 9 days ago
 ★★★★★ Excellent well worth the money and the extra 5 dollars for the laser game after !

 Andrea Barrow Curley
 12 days ago
 ★★★★★ Very interesting and well thought out. Great flow.

ALCATRAZ EAST'S PHOTO GALLERY ★ ★ ★



Brandy R Green

13 days ago

★★★★★ It was fun and very interesting!

[Next Reviews](#)

ALCATRAZ EAST INFORMATION:

📍 2757 Parkway
Pigeon Forge, TN 37863

☎ 865-453-3278

✉ info@alcatrazeast.com

PHOTO GALLERY:



Sign-Up For Updates, Contests & More Below:

Name *

First

Last

Email *

When Do You Plan On Visiting Pigeon Forge? *

Where Are You From? *

How Did You Hear About Us? *

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