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Filing date: **06/18/2007**

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

Proceeding	92046646
Party	Plaintiff Southern Title Holding Company LLC Southern Title Holding Company LLC ,
Correspondence Address	Edward M. Livingston The Livingston Firm 963 Trail Terrace Drive Naples, FL 34103 UNITED STATES
Submission	Other Motions/Papers
Filer's Name	Edward M. Livingston
Filer's e-mail	emlpa@comcast.net
Signature	/Edward M. Livingston/
Date	06/18/2007
Attachments	Signed Consent Concurrent Use Agreement.pdf (10 pages)(3923814 bytes)

CONSENT/CONCURRENT USE AGREEMENT

THIS AGREEMENT is made and entered into this 15th day of April, 2007 (the "Effective Date"), by and between SOUTHERN TITLE HOLDING COMPANY, L.L.C. a Florida limited liability company, its parents, subsidiaries, officers, directors, shareholders, insurers, sureties, employees, agents, general agents, general partners, limited partners, affiliates, predecessors, successors and assigns (hereinafter referred to as "STHC"), maintaining its principal place of business at 2335 Beville Road, Daytona Beach, Florida 32119; and SOUTHERN ESCROW & TITLE, L.L.C., a Florida limited liability company, its parents, subsidiaries, officers, directors, shareholders, insurers, sureties, employees, agents, general agents, general partners, limited partners, affiliates, predecessors, successors and assigns (hereinafter referred to as "SET"), maintaining its principal place of business at 12815 Emerald Coast Parkway, Suite 124, Destin, Florida 32550.

RECITALS:

WHEREAS, a dispute has arisen between STHC and SET regarding the use of their respective marks "SOUTHERN TITLE" and "SOUTHERN ESCROW & TITLE," respectively in connection with title insurance, real estate escrow services, real estate closings, title searches and settlement services ("SOUTHERN TITLE") and real estate closing services ("SOUTHERN ESCROW & TITLE");

WHEREAS, SET has adopted and used (1) the design mark "SOUTHERN ESCROW AND TITLE, L.L.C.", U.S. Registration No. 2857959, (2) the mark "SOUTHERN ESCROW" and (3) the mark "SOUTHERN ESCROW & TITLE," since October 1, 1999 in connection with real estate closing services, insurance services, lien and title search services and mortgage services (collectively referred to hereinafter as "SET MARKS").



WHEREAS, STHC has filed a U.S. Trademark Application Serial No. 78/579,373 covering the mark "SOUTHERN TITLE" filed on March 3, 2005 for use in connection with "title insurance and real estate escrow services" in International Class 36 and "real estate closings, title searches and settlement services" in International Class 42, having a date of first use of February 28, 1995 and a date of first use in commerce of March 1, 2005, the application of which was suspended from prosecution within the United States Patent and Trademark Office ("USPTO") on November 21, 2006 pending disposition of Cancellation No. 92046646 ("Cancellation Proceeding").

WHEREAS, STHC filed the Cancellation Proceeding based upon SET's registered design mark "SOUTHERN ESCROW AND TITLE, L.L.C.":

WHEREAS, the Parties desire to settle their dispute regarding the "SOUTHERN TITLE" mark and name pursuant to this Agreement in an amicable fashion to their mutual satisfaction and without resort to further litigation:

NOW, THEREFORE, in consideration of the mutual covenants contained herein and other good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged, the Parties agree as follows:

TERMS:

1. INCORPORATION OF RECITALS. The recitals to this Agreement are hereby incorporated into and made a part of this Agreement as if fully stated herein.

2. NO ADMISSIONS. Nothing in this Agreement shall operate as or be construed as an indication, inference, presumption, admission or as evidence relative to any fact, issue of law, issue of liability or any other matter on the part of any party. Each party expressly denies any and all liability to any other party raised in any proceeding.

Handwritten initials "STH" and "SET" are written in ink and enclosed in circles. The "STH" is in the top circle and the "SET" is in the bottom circle.

3. REGISTRATION OF THE "SOUTHERN TITLE" MARK. STHC agrees that within fifteen (15) days of the execution of this Agreement, it will file with the Trademark Trial and Appeal Board ("TTAB") this Agreement.

4. LIMITATION ON USE OF THE "SOUTHERN TITLE" MARK AND NAME. STHC agrees to the following limitations in connection with its use of the "SOUTHERN TITLE" mark and name:

A. STHC agrees to always use the mark and name "SOUTHERN TITLE" and it will never add the term ESCROW to its mark and name.

B. STHC agrees that the term SOUTHERN will always be of equal prominence to the term TITLE and will be given equal emphasis as far as color, size, font and the like.

C. STHC agrees that the mark and name "SOUTHERN TITLE" will be used for title insurance and real estate escrow services in International Class 36 and real estate closings, title searches and settlement services in International Class 42.

D. STHC agrees that the mark and name "SOUTHERN TITLE" will be used in interstate commerce in the United States of America.

E. STHC agrees that the mark and name "SOUTHERN TITLE" will be used in advertisements, letterhead, brochures, on the Internet and in other ways customary to business.

5. LIMITATION ON USE OF THE SET MARKS. SET agrees to the following limitations in connection with its use of the SET MARKS:

A. SET agrees to never drop the term ESCROW from its mark and name.

B. SET agrees that the term ESCROW will always be of equal prominence to the term SOUTHERN and will be given equal emphasis as far as color, size, font and the like.

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6. WITHDRAWAL OF CANCELLATION PROCEEDING. Within thirty (30) days of notification of approval of the Agreement by the TTAB and approval by the Examining Attorney and issuance of the registration for STHC's pending service mark application for "SOUTHERN TITLE." STHC shall withdraw the Cancellation Proceeding, with prejudice.

7. CONSENT TO ALL FUTURE "SOUTHERN TITLE" APPLICATIONS. In the event any one of SET's registrations or applications for any SET MARK is ever cited by the USPTO against any application filed by STHC to register the mark "SOUTHERN TITLE," SET shall agree to provide its express written consent to the registration of "SOUTHERN TITLE."

8. CONSENT TO ALL FUTURE "SOUTHERN ESCROW" APPLICATIONS. In the event any one of STHC's registrations or applications for SOUTHERN TITLE is ever cited by the USPTO against any application filed by SET to register any of its marks, STHC shall agree to provide its express written consent to the use and registration of said marks.

9. NO OTHER "SOUTHERN ESCROW & TITLE, L.L.C." APPLICATIONS. SET agrees that any additional federal or state service mark applications for SET's Marks will be registered in accordance with the limitations set forth in paragraph 5 of this Agreement. Any changes or alterations to the present logo utilized by SET (see Exhibit 1) will be made in accordance with the limitations set forth in paragraph 5 of this Agreement.

10. NO OTHER "SOUTHERN TITLE" APPLICATIONS. STHC agrees that any additional federal or state service mark applications for STHC's Marks will be used and registered in accordance with the limitations set forth in paragraph 4 of this Agreement.



Any changes or alterations to the present logo utilized by **STHC** (see Exhibit 2) will be made in accordance with the limitations set forth in paragraph 4 of this Agreement.

11. NO ADMISSION OF LIABILITY. Each Party acknowledges and agrees that this Agreement is a compromise of disputed claims and neither this Agreement, nor any consideration provided pursuant to this Agreement, shall be taken or construed to be an admission or concession by either **STHC** or **SET** of any kind with respect to any fact, liability or fault.

12. EFFORTS TO AVOID CONFUSION: In the event the parties identify a likelihood of confusion or actual confusion between the marks the parties shall cooperate fully and in good faith to take reasonable steps to ameliorate such confusion or likelihood of confusion.

13. MUTUAL RELEASE:

A. Release by **STHC**: Contingent upon the timely performance of the terms of this Agreement by the parties, **STHC** hereby releases, acquits and forever discharges **SET**, as well as its affiliates, subsidiaries, parent companies, agents, officers, directors, employees, insurers, attorneys, heirs, successors and the agents, employees and assigns of its affiliates and parent companies (hereinafter collectively and individually referred to as the "Released Parties") of and from any and all causes of action, suits, proceedings, torts, agreements, representations, promises, judgment, damages, expenses and claims whatsoever of every name and nature, both in law and equity, which **STHC** may now have, or has ever had against the Released Parties arising out of the use of the **SET MARKS** from the beginning of time to the date of execution of this Agreement.




B. Release by SET. Contingent upon the timely performance of the terms of this Agreement by the parties and subject to the reservation of rights in Paragraph 9. SET hereby releases, acquits and forever discharges STHC, as well as its affiliates, subsidiaries, parent companies, agents, officers, directors, employees, insurers, attorneys, heirs, successors and the agents, employees and assigns of its affiliates and parent companies (hereinafter collectively and individually referred to as the "Released Parties") of and from any and all causes of action, suits, proceedings, torts, agreements, representations, promises, judgment, damages, expenses and claims whatsoever of every name and nature, both in law and equity, which SET may now have, or has ever had against the Released Parties arising out of the use of the "SOUTHERN TITLE" mark and name from the beginning of time to the date of execution of this Agreement.

14. REPRESENTATIONS AND WARRANTIES. Each of the parties, STHC and SET, represent and warrant to the other party as of the Effective Date of this Agreement that:

- A. the execution, delivery and performance by it of its obligations under this Agreement (1) are within its corporate power, (2) have been duly authorized by all necessary corporate action, (3) do not contravene any law or any contractual provision binding on it and (4) do not require any consent or approval of any person or governmental authority except such consents and approvals as have been obtained and are in full force and effect; and
- B. this Agreement constitutes its legal, valid and binding obligation and is enforceable in accordance with its terms.

15. SUCCESSORS AND ASSIGNS. This Agreement shall be binding upon, and shall inure to the benefit of the parties hereto and their respective successors, assigns, heirs,

Two handwritten signatures are present in the bottom right corner of the page. Each signature is enclosed within a hand-drawn circle. The first signature is more stylized and appears to be 'JF', while the second is more legible and appears to be 'JR'.

beneficiaries and affiliates including partners, officers, directors, managers, parents and subsidiaries.

16. PREPARATION EXPENSES. Each party hereto shall bear its own costs and expenses in connection with the preparation, negotiation and execution of this Agreement and in connection with the Cancellation Proceeding.

17. COMPLETE AGREEMENT

A. This Agreement is the only agreement of the parties hereto relating to the subject matter thereof. No statements, promises or representations have been made by any party to another, or are relied upon and no consideration has been or is offered, promised, expected or held out, other than that provided in this Agreement.

B. No conditions precedent to the effectiveness of this Agreement exist, other than as may be expressly provided herein. All prior discussions and negotiations have been and are merged and integrated into, and are superseded by, this Agreement. This Agreement may only be modified by a writing signed by the party to be bound.

18. BREACH OF AGREEMENT. In the event of a breach of this Agreement, the parties acknowledge that recovery of damages will not be sufficient legal remedy and agree that the aggrieved party shall be entitled to specific performance thereof in addition to any and all other remedies, legal or equitable, to which it may be entitled.

19. FURTHER ASSURANCES. Without limiting any of the foregoing provisions of this Agreement, following the Effective Date, the parties hereto shall cooperate with each other and execute, acknowledge and deliver to each other such further and additional documents as may reasonably be required to effect and evidence the terms of this Agreement.



~~20. CONSENT/CONCURRENT USE AGREEMENT CONSTRUED AS A WHOLE.~~ This Agreement shall be construed as a whole according to its fair meaning, and not strictly for or against any of the parties. Should any provision of this Agreement be declared or be determined by any court to be illegal, invalid or unenforceable, the validity of the remaining parts, terms or provisions shall not be affected thereby and said illegal, invalid or unenforceable part, term or provisions shall be deemed not to be a part of this Agreement.

21. NOTICES. Any notice required or permitted hereunder shall be considered duly given if in writing and sent by registered or certified mail, postage prepaid, to the address set forth as follows, or such address as each party may hereafter designate in writing:

TO SFHC: Southern Title Holding Company, LLC
2335 Beville Road
Daytona Beach, FL 32119

COPY TO: The Livingston Firm
963 Trail Terrace Drive
Naples, FL 34103
(239) 262-8502
(239) 261-3773 (fax)

TO SET: Southern Escrow & Title, L.L.C.
12915 Emerald Coast Parkway
Suite 124
Destin, FL 32550

COPY TO: David M. Lilenfeld, Esq.
Manning Lilenfeld LLP
3340 Peachtree Road, NE
Tower Place, Suite 2600
Atlanta, Georgia 30326
(404) 835-3333
(404) 393-9710 (fax)

22. MEDIATION AND ARBITRATION. All disputes that may arise in connection with this Agreement that are not adjusted by the parties themselves shall first be submitted



to mediation in the State of Florida under the rules and regulations related to mediation under Florida law. If such disputes are not settled by mediation, then the dispute shall be submitted to arbitration under the rules and regulations of the American Arbitration Association. The cost of arbitration shall be paid by the losing party. The award shall be binding and inclusive and any award may be sued on or enforced by the party in whose favor it runs in any court of competent jurisdiction or as specified elsewhere in this Agreement at the option of the successful party.

23. CHOICE OF LAW AND FORUM. This Agreement and any disputes arising under it shall be construed, enforced and interpreted in accordance with the laws of the State of Florida. Any action brought for the enforcement of any arbitration award or any terms, conditions or revisions contained herein shall be brought only in a court of competent jurisdiction to which all parties agree to submit themselves.

24. ATTORNEYS' FEES. Should the terms or provisions of this Agreement become the subject of dispute, arbitration or litigation, the prevailing party shall be entitled to recover reasonable attorneys' fees and costs.

25. WAIVER. Waiver by either party or any of its rights hereunder or of any defaults of the other party shall not constitute a waiver of rights in the future or future defaults.

26. LEGAL COUNSEL. This Agreement was negotiated among the parties, each of whom had the opportunity to consult with legal counsel during the negotiations, drafting, and execution of this Agreement, and the parties agree that this Agreement shall not be construed against any party as the drafter.



27. HEADINGS. The headings of the sections of this Agreement are for convenient reference only and shall not effect the construction or interpretation of any of the terms or provisions set forth herein.

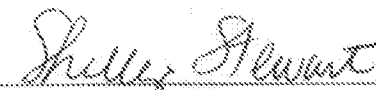
28. EFFECTIVE DATE. This Agreement shall be effective when the second of the two parties hereto executes this Agreement and inserts the dates on page one of this Agreement.

IN WITNESS WHEREOF, the parties hereto have hereinafter set their hands and seals on the dates and year written below their signatures.

Signed, sealed and delivered
in the presence of:

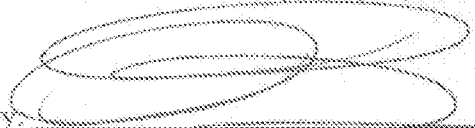
As to SOUTHERN TITLE
HOLDING COMPANY, LLC

SOUTHERN TITLE HOLDING COMPANY LLC
a Florida limited liability company, (SEAL)

By: 
Printed Name: Shelley Stewart
Title: President
Date: June 15, 2007


As to SOUTHERN ESCROW
& TITLE, LLC.

SOUTHERN ESCROW & TITLE, L.L.C.
a Florida limited liability company, (SEAL)

By: 
Printed Name: George T. Brannon, Sr.
Title: President
Date: June 5, 2007