

ESTTA Tracking number: **ESTTA290075**

Filing date: **06/16/2009**

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

Proceeding	94002389
Party	Applicant Live Bait, LLC
Correspondence Address	David R. Burkholder Balch & Bingham LLP 1901 6th Ave N Birmingham, AL 35203-2618 UNITED STATES dburkholder@balch.com
Submission	Other Motions/Papers
Filer's Name	David R. Burkholder
Filer's e-mail	dburkholder@balch.com
Signature	/davidburkholder/
Date	06/16/2009
Attachments	Live Bait Concurrent Use Agreement.pdf (8 pages)(250025 bytes)



BALCH & BINGHAM LLP

Alabama • Georgia • Mississippi • Washington, DC

David Burkholder
(205) 226-3403

Attorneys and Counselors
1901 Sixth Avenue North, Suite 1500
P.O. Box 306 (35201-0306)
Birmingham, Alabama 35203-4642
(205) 251-8100
(205) 226-8799 Fax
www.balch.com

(205) 488-5719 (direct fax)
dburkholder@balch.com

June 16, 2009

BY ELECTRONIC FILING

Ms. Cheryl Butler
Trademark Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1451
Alexandria, Virginia 22313-1451

**Re: Concurrent Use Proceeding 94002389
Live Bait, LLC v. Theme Food Inc.
(Consolidated with Opposition Nos. 91189035 and 91189036)**

Dear Ms. Butler:

Per our discussion by telephone today, I am hereby filing the attached Concurrent Use Agreement (“Agreement”) between the parties to this proceeding. This Agreement should conclude Concurrent Use Proceeding No. 94002389. As we discussed, two oppositions have been consolidated with this concurrent use proceeding. They are Opposition No. 91189035 and Opposition No. 91189036. The applications that are the subject of those oppositions have been amended to reflect the terms of the attached Agreement and it is therefore Opposer Live Bait, LLC’s intention that both of those oppositions be dismissed with prejudice in favor of the attached Agreement, with concurrent use registrations issuing to all parties. If this raises any questions or you need further action from me to effectuate the requests in this letter and resolve all matters between these parties, please let me know. Thank you.

Very truly yours,

David Burkholder

DB:do
Attachment

CONCURRENT USE AGREEMENT

THE PARTIES to this Agreement are Live Bait, LLC ("Live Bait"), a limited liability company organized under the laws of Alabama and having a place of business at 2901 Second Avenue South, Birmingham, AL 35233, and Theme Food Inc. ("Theme Food") a corporation organized under the laws of New York and having a place of business at 29 Union Square W., New York, NY 10003 (collectively "the Parties").

WHEREAS Theme Food has continuously used the mark "LIVE BAIT" in connection with restaurant services since 1987 and has provided its restaurant services in New York;

WHEREAS Live Bait's predecessor-in-interest began using the mark "LIVE BAIT" in connection with restaurant services in 1993 without knowledge of Theme Food's earlier use of the mark and Live Bait through its predecessor-in-interest has continuously provided its restaurant services under the mark LIVE BAIT in Alabama since 1993.

WHEREAS Theme Food filed a petition to cancel Live Bait's Reg. No. 2,336,220 for the mark LIVE BAIT in connection with restaurant services (Cancellation Proceeding No. 92044254) which petition was granted by the TTAB on July 23, 2008 leading to the cancellation of Reg. No. 2,336,220;

WHEREAS Theme Food filed application Serial No. 78568256 to register the mark LIVE BAIT in connection with restaurant services in Class 42 and application Serial No. 78568268 to register the mark LIVE BAIT in connection with hats and t-shirts in Class 25 (collectively, the "Theme Food Applications");

WHEREAS Live Bait has opposed the Theme Food Applications in Opposition Proceedings Nos. 91189036 and 91189035;

WHEREAS Live Bait has filed concurrent use Application Serial No. 77558214 which seeks registration of the mark LIVE BAIT in connection with restaurant and bar services in Class 043 with Live Bait claiming exclusive right to use the mark in the area comprising Florida and Alabama and recites Theme Food Inc. as an exception to Live Bait, LLC's exclusive use;

WHEREAS, Application Serial No. 77558214 is subject to Concurrent Use Proceeding No. 94002389; and

WHEREAS, the Board granted the Parties' consented motion to consolidate Concurrent Use Proceeding No. 94002389 and Opposition Nos. 91189036 and 91189035 on April 11, 2009.

NOW THEREFORE, to resolve all issues the Parties agree upon the following:

- A. Theme Food hereby consents to Live Bait's exclusive use and registration of the mark LIVE BAIT in connection with restaurant services in the geographical area comprising the entire State of Alabama and the following Florida counties: Escambia, Santa Rosa, Okaloosa, Walton, Holmes, Washington, Jackson, Calhoun, Bay, Gulf, Gadsen, Liberty, Leon, Wakulla, Franklin, Jefferson, Taylor, Dixie, Levy, Citrus, Hernando, Pasco, Pinellas, Hillsborough, Manatee (collectively, the "Live Bait Territory"). Theme Food also consents to Live Bait's continued sales of merchandise bearing the Live Bait name in the above-listed geographic areas.

- B. Live Bait hereby consents to Theme Food's exclusive use and registration of the mark LIVE BAIT in connection with restaurant services and merchandise within all areas of the United States except for the Live Bait Territory (the "Theme Food Territory").

- C. Theme Food agrees not to use its mark within the Live Bait Territory. The Parties agree that Theme Food may use and maintain a website related to its Live Bait Restaurants.

- D. Live Bait agrees not to use its mark in the Theme Food Territory, other than with the exception listed in Paragraph L below regarding specific advertising outside of the Live Bait Territory. The Parties also agree that Live Bait may continue to use and maintain its website in conjunction with its Live Bait Restaurants.

- E. Theme Food agrees to convert Serial Nos. 78/568,256, 78/568,268 to concurrent use applications restricting its claim for exclusive use solely to the Theme Food Territory and listing Live Bait's use of its mark in the Live Bait Territory as an exception to Theme Food's exclusivity.

- F. Live Bait agrees to amend Serial No. 77558214 restricting its claim for exclusivity to the Live Bait Territory and to set forth Theme Food's right to use the mark within the Theme Food Territory as an exception to Live Bait's exclusivity.

- G. The Parties agree to file such amendments to their respective applications and shall file this Agreement with the TTAB within fourteen (14) days of the full execution of this Agreement. The Parties further agree that upon the registration of the Theme Food (concurrent use) Applications and Live Bait's concurrent use application, all with the above-described geographical limitations, Live Bait shall file motions to dismiss with prejudice Opposition Nos. 91189036 and 91189035.

- H. The Parties agree that there is no likelihood of actual confusion between the Parties' respective marks because each of the Parties' marks will be used in distinct geographical areas and will be marketed and sold to different consumer groups.
- I. Live Bait hereby agrees not to challenge the use or registration of the mark LIVE BAIT as used by Theme Food in connection with the services set forth in Application Serial No. 78/568,256 once it is amended to be limited to the Theme Food Territory and the goods in the 78/568,268 registration as long as it is amended as recited above and Theme Food complies with the required geographic restrictions.
- J. Theme Food agrees not to challenge the use or registration of the mark LIVE BAIT as used by Live Bait in connection with the services set forth in Serial No. 77558214 once it is amended as recited above as long as Live Bait complies with the required geographic restrictions.
- K. The Parties agree not to challenge each other's use or registration of their respective LIVE BAIT marks in connection with goods and services within their natural zones of expansion as long as Live Bait's use is restricted to the Live Bait Territory and Theme Food's use is restricted to the Theme Food Territory.
- L. The Parties agree that each Party may continue to advertise its respective goods and services through the marketing channels it is currently using as long as Theme Food's

marketing does not target the Live Bait Territory and Live Bait's marketing does not target the Theme Food Territory. Theme Food agrees that Live Bait may continue to advertise its mark during Southeastern Conference football games and in conjunction with speed boat races in areas outside of the Live Bait Territory. The Parties also agree each may use and maintain a website in association with their respective restaurants.

- M. The Parties hereby agree that if any confusion arises in the future, they will notify the other of the same and will cooperate to take steps to eliminate the confusion and to prevent any further confusion.
- N. The Parties hereby agree that they will cooperate in any way necessary to carry out the intent of this Agreement.
- O. Should any part or provision of this Agreement be held unenforceable or in conflict with the applicable laws of any jurisdiction, the validity of the remaining parts or provisions shall not be affected by such a holding.
- P. This Agreement constitutes the entire Agreement between the Parties with respect to the subject matters hereof. This Agreement may not be modified except by means of a writing signed by both Parties.
- Q. The Parties represent that they fully understand their right to discuss all aspects of this Agreement with their respective attorneys, that they have availed themselves of that right

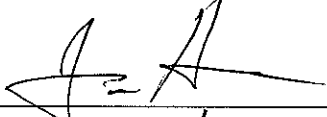
to the extent desired, and that they have read and fully understand all of the provisions of, and have voluntarily entered into, this Agreement. In addition, the Parties acknowledge that in executing this Agreement, they do not rely and have not relied on any representation or statement not set forth herein made by any other Party or by any agent, representative, or attorney of any other Party.

R. Each of the undersigned represents that he is duly and validly authorized to execute this Agreement.

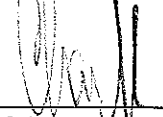
S. This Agreement may be executed in separate counterparts and shall be fully effective as of the date fully executed copies are exchanged between the Parties.

IN WITNESS WHEREOF, the Parties have executed this Concurrent Use Agreement this 8 day of June, 2009.

LIVE BAIT, LLC

By: 
Terry W. Hughes, member
(Name/Title)

THEME FOOD INC.

By: 
Charles M. White, President
(Name/Title)