

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Butler

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Concurrent Use No. 94002389

LIVE BAIT, LLC
(Serial No. 77558214)

v.

THEME FOOD, INC.
(Serial No. 78568256 and 78568268)¹

Opposition No. 91189035
Opposition No. 91189036

LIVE BAIT, LLC

v.

THEME FOOD, INC.
(Serial Nos. 78568256 and 78568268)

**Before Hairston, Rogers and Taylor, Administrative Trademark
Judges.**

By the Board:

On February 27, 2009, Live Bait, LLC (hereinafter Live Bait) filed oppositions to the registration of Theme Food, Inc.'s (hereinafter Theme Food) application Serial No. 78568256 for the mark LIVE BAIT for "restaurant services"² and application Serial

¹ As instituted, the concurrent use proceeding involved only the first of the two listed applications by Theme Food, Inc. By this order, both applications are now involved in the proceeding.

² The application was filed on February 16, 2005, claiming a date of first use anywhere and a date of first use in commerce of August, 1988. The application is the subject matter of Opposition No. 91189035.

No. 78568268 for the mark LIVE BAIT for "t-shirts and hats."³
Such applications published without territorial restrictions.

Earlier, Live Bait had filed an application seeking a concurrent use registration for its mark LIVE BAIT for "restaurant and bar services, namely, restaurant and bar services limited to a casual beach dining atmosphere with music."⁴ After being published for opposition that application resulted in institution of the captioned concurrent use proceeding. The concurrent use proceeding commenced on March 19, 2009. Live Bait claims exclusive rights to use its mark in the territory consisting of

"the entire State of Alabama and the following counties in the State of Florida: Escambia, Santa Rosa, Okaloosa, Walton, Holmes, Washington, Jackson, Calhoun, Bay, Gulf, Gadsden, Liberty, Leon, Wakulla, Franklin, Jefferson, Taylor, Dixie, Levy, Citrus, Hernando, Pasco, Pinellas, Hillsborough, and Manatee."

In its concurrent use application, Live Bait names Theme Food as an exception to its otherwise exclusive right to use its mark, specifically referencing, however, only Theme Food's Serial No. 78568256. Live Bait identifies Theme Food's territory of use as

"the entire United States except the State of Alabama and the following counties in the State of Florida: Escambia, Santa Rosa, Okaloosa, Walton, Holmes, Washington, Jackson, Calhoun, Bay, Gulf, Gadsden, Liberty, Leon, Wakulla, Franklin, Jefferson, Taylor, Dixie, Levy, Citrus, Hernando, Pasco, Pinellas, Hillsborough, and Manatee."

³ The application was filed on February 16, 2005, claiming a date of first use anywhere and a date of first use in commerce of August, 1988. The application is the subject matter of Opposition No. 91189036.

⁴ Application Serial No. 77558215, filed on August 28, 2008, claiming a date of first use anywhere and a date of first use in commerce of February 1, 1993.

The concurrent use and opposition proceedings were consolidated by order of the Board dated April 11, 2009. This case now comes up on the following:

- 1) Theme Food's motion, filed May 12, 2009, to amend its applications to ones seeking concurrent use registrations;⁵
- 2) Live Bait's request, filed June 16, and pursuant to the parties' settlement agreement, to dismiss the opposition proceedings in favor of a concurrent use proceeding;
- 3) Consideration of the parties' concurrent use agreement, submitted June 16, 2009; and
- 4) Theme Food's consented motion, filed June 25, 2009, to suspend proceedings pending consideration of the parties' concurrent use agreement.

Theme Food's May 12, 2009 proposed amendments

In accordance with a concurrent use agreement entered into between the parties, Theme Food seeks to amend its application Serial Nos. 78568256 and 78568268 to ones seeking concurrent use registrations. Theme Food proposes to amend its applications to add the following concurrent use statement:

Registration is [sought] limited to the area comprising "the entire United States except the State of Alabama and the following counties in the State of Florida: Escambia, Santa Rosa, Okaloosa, Walton, Holmes, Washington, Jackson, Calhoun, Bay, Gulf, Gadsden, Liberty, Leon, Wakulla, Franklin, Jefferson, Taylor, Dixie, Levy, Citrus, Hernando, Pasco, Pinellas, Hillsborough, and Manatee," subject to Concurrent Use Proceeding No. 94002389 with Serial No. 77558214.

⁵ Live Bait's motion to amend its concurrent use statement with respect to its territory and further to specify Theme Food's territory of use was filed on May 11, 2009 and accepted by the Board in an order mailed on May 13, 2009. Theme Food's motion was filed on May 12, 2009. It was not previously acted upon because it crossed in electronic processing with the order preparation and mailing concerning Live Bait's motion. The Board considers Theme Food's motion now.

Theme Food further states that the use by Live Bait of its mark is the only known exception to Theme Food's otherwise exclusive right to use its mark.

Inasmuch as Theme Food's proposed amendment for each application is in accordance with settlement and, thus, Live Bait consents thereto, Theme Food's amendment to geographically restrict its application Serial Nos. 78568256 and 78568268 is approved and entered. See Trademark Rules 2.99 and 2.133(a).

Opposition Nos. 91189035 and 91189036 are dismissed with prejudice

Live Bait (opposer in the opposition proceedings) requests that, in view of the amendments to the involved applications and the parties' concurrent use agreement, the oppositions be dismissed with prejudice in favor of a concurrent use proceeding.⁶ Live Bait further requests that concurrent use registrations be issued to the parties.

In view thereof, Opposition Nos. 91189035 and 91189036 are dismissed with prejudice in favor of a concurrent use proceeding. See TBMP §1113.01(4) (2d ed. rev. 2004).

Theme Food's Application Serial No. 78568268 is added to Concurrent Use No. 94002389

At the outset, the Board notes that Theme Food's application Serial No. 78568256 is already involved in Concurrent Use No. 94002389. For purposes of judicial economy, Theme Food's application Serial No. 78568268 is now added to Concurrent Use No.

⁶ See also paragraph G of the parties' executed concurrent use agreement.

94002389 and said concurrent use proceeding shall proceed under the provisions of Section 2(d) of the Trademark Act between Live Bait as the concurrent use applicant in the position as "plaintiff" and Theme Food as the named excepted user and applicant in the position as "defendant".

In view of the agreement reached by the parties with respect to the concurrent use of their marks, the Board finds it unnecessary to allow the parties time to file any additional or supplementary statements under Trademark Rule 2.99. Instead, the agreement will be reviewed by the Board as a potential means for resolving this proceeding.

Consideration of the parties' concurrent use agreement

The parties express their belief that confusion is not likely because each party's mark is used in a distinct geographic area and their respective goods and services are marketed and sold to different consumers. Each party consents to the exclusive use of the mark LIVE BAIT by the other party within such party's defined territory. Each party further consents to concurrent use registration of the mark LIVE BAIT by the other party for the defined geographic area. Each party agrees not to use its mark in the territory of the other party. The agreement also provides that each party may continue to advertise its goods and services through the marketing channels it is currently using as long as each party's marketing does not target the territory of the other party; that the parties may use and maintain websites in association with

their respective restaurants; and 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 Live Bait's territory.⁷ The parties agree to cooperate with each other if confusion arises; to take steps to eliminate any confusion that arises; to take steps to prevent further confusion; and in any way necessary to carry out the intent of the agreement.

Upon consideration of the agreement between the parties, which supports each party's right to the respective concurrent use registrations, the Board is persuaded that under the circumstances of this case, concurrent use by the parties of their involved marks will not, in fact, be likely to cause confusion.

In making this determination, the Board has taken into account not only the provisions of the agreement and the actual geographic restrictions of the areas of use, but also the voluntary entrance by the parties into an agreement which includes provisions for concurrent use when it would be clearly against their business interests to cause confusion on the part of the public. *See Amalgamated Bank of New York v. Amalgamated Trust & Savings*, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988).

DECISION:

Applicant, Live Bait, LLC is entitled to registration of its mark LIVE BAIT for "restaurant and bar services, namely, restaurant and bar services limited to a casual beach dining

⁷ Such activities allowed to Live Bait by the parties' agreement are specific.

atmosphere with music" for the area consisting of "the entire State of Alabama and the following counties in the State of Florida: Escambia, Santa Rosa, Okaloosa, Walton, Holmes, Washington, Jackson, Calhoun, Bay, Gulf, Gadsden, Liberty, Leon, Wakulla, Franklin, Jefferson, Taylor, Dixie, Levy, Citrus, Hernando, Pasco, Pinellas, Hillsborough, and Manatee." (Application Serial No. 77558214.)

Applicant, Theme Food, Inc., is entitled to registration of its mark LIVE BAIT for "restaurant services" and for "t-shirts and hats" for the area consisting of "the entire United States except the State of Alabama and the following counties in the State of Florida: Escambia, Santa Rosa, Okaloosa, Walton, Holmes, Washington, Jackson, Calhoun, Bay, Gulf, Gadsden, Liberty, Leon, Wakulla, Franklin, Jefferson, Taylor, Dixie, Levy, Citrus, Hernando, Pasco, Pinellas, Hillsborough, and Manatee." (Application Serial Nos. 78568256 and 78568268.)

In view of the decision made regarding the parties' rights to concurrent use registrations, Theme Food's request to suspend proceedings is deemed moot.
