



07-05-2002

IN U.S. Patent & TMO/TM Mail Rcpt Dt. #22

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

TAB

TRADEMARK TRIAL AND
APPEAL BOARD
02 JUL 11 AM 12:41

Applicant: Kao Kabushiki Kaisha, a/t/a Kao Corporation

Serial No: 75/551,214

Filed: September 11, 1998

Mark: KAO SOFINA & S Design

Our Ref.: KAO 9807815

REQUEST FOR RESUMPTION OF PROCEEDINGS

NO FEE

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

The above-referenced application was the subject of extensions of time to file a Notice of Opposition. The dispute has now been resolved according to the terms of the enclosed Settlement Agreement (copy enclosed). Therefore, and in accordance with the terms of Section 6 of the Agreement, requiring that all oppositions and cancellations, and all extensions of time to oppose be withdrawn, Applicant requests that further action on the application move forward, and that the Notice of Allowance issue.

Certificate of Mailing Under 37 CFR 1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on:

July 2, 2002
(Date of Deposit)

(Signature)

Susan Upton Douglass
(Printed name of person mailing paper or fee)

July 2, 2002
(Date of Signature)

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Dated: New York, New York
July 2, 2002

Respectfully submitted,

FROSS ZELNICK LEHRMAN
& ZISSU, P.C.

By: 
Susan Upton Douglass
Attorneys for Applicant
866 United Nations Plaza
New York, New York 10017
(212) 813-5900

Enc.

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing was served by prepaid, first-class mail upon Opposer's attorney, Christina L. Martini, Esq., Piper Rudnick, 203 North LaSalle Street, Chicago, Ill, 60601 this 2nd day of July, 2002


Susan Upton Douglass

SETTLEMENT AGREEMENT

THIS SETTLEMENT AGREEMENT (hereinafter the "Agreement") is made and entered into as of the date it is signed by both parties (hereinafter the "Effective Date") and is by and between Amgen Inc. (hereinafter "Amgen"), a Delaware corporation, located at One Amgen Center Drive, Thousand Oaks, California 91320-1789 and Kao Kabushiki Kaisha, t/a Kao Corporation, a Japan corporation, located at 14-10 Nihonbashi Kayabacho, 1-Chome, Chuo-ku, Tokyo 103-8210, Japan (hereinafter "Kao").

WITNESSETH:

WHEREAS, Amgen intends to use the trademark SOFINA (hereinafter "Amgen's Mark"), in the United States and in certain countries around the world, in connection with prescription pharmaceuticals for modulating weight loss, regulating reproductive function, and promoting wound healing and for use in the treatment of obesity, diabetes, hypertension, dyslipidemia, cardiovascular diseases and infertility (hereinafter "Amgen's Products"), and has registered and/or applied to register the SOFINA mark in a number of jurisdictions for use in connection with Amgen's Products;

WHEREAS, Kao uses, intends to use, has registered and/or has applied to register the trademark SOFINA, and other marks that include SOFINA, in the United States and in certain countries around the world (hereinafter "Kao's Marks"), for use in connection with cosmetics, toiletries, hair care and skin care preparations, fragrances, cosmetic utensils and personal grooming aids and preparations (hereinafter "Kao's Products"); and

WHEREAS, Amgen and Kao wish to settle disputed issues relating to the parties' respective uses and attempts to register Amgen's Mark and Kao's Marks, respectively.

NOW, THEREFORE, for and in consideration of the promises, agreements and covenants contained herein, the adequacy, sufficiency and receipt of which are conclusively acknowledged, the parties intending to be legally bound agree as follows:

1. Definition.

The term "Specified Territory" shall mean and refer to the entire world, except for the following countries: China, Hong Kong, Japan, Macao, Indonesia, Malaysia, Philippines, Singapore, South Korea, Sri Lanka, Thailand, Taiwan and Vietnam.

2. Amgen's Use and Registration of Amgen's Mark.

- (a) Amgen may use, fully exploit and seek to register Amgen's Mark in the Specified Territory in connection with Amgen's Products (hereinafter

"Amgen's Authorized Use"). Kao shall not object to Amgen's Authorized Use of Amgen's Mark, or its registration of Amgen's Mark for Amgen's Products, provided such use and registration conform with the terms and conditions of this Agreement. Amgen agrees that it will not use or seek to register Amgen's Mark outside of the Specified Territory.

- (b) As soon as reasonably practicable after the Effective Date of this Agreement, Amgen will amend any and all applications to register Amgen's Mark in any jurisdiction in the Specified Territory so that they include only Amgen's Products. Amgen need not amend its registrations for Amgen's Mark in the Specified Territory so that they include only Amgen's Products, but agrees that (i) its use will conform to the limitations set forth in this Agreement, and (ii) that upon Kao's request, and at Kao's expense, it will amend any registration for Amgen's Mark in any jurisdiction in the Specified Territory so that the registration includes only Amgen's Products if, in Kao's judgment, such amendment will aid Kao in protecting Kao's Marks for Kao's Products in that jurisdiction. As soon as reasonably practicable after the Effective Date of this Agreement, Amgen will expressly withdraw its applications and voluntarily surrender its registrations for Amgen's Mark in any jurisdiction that is not included in the Specified Territory.

3. Kao's Use and Registration of Kao's Marks.

- (a) Kao may use, fully exploit and seek to register Kao's Marks worldwide in connection with Kao's Products (hereinafter "Kao's Authorized Use"). Amgen shall not object to Kao's Authorized Use of Kao's Marks, or its registration of Kao's Marks for Kao's Products, provided such use and registration conform with the terms and conditions of this Agreement.
- (b) As soon as reasonably practicable after the Effective Date of this Agreement, Kao will amend any and all applications to register Kao's Marks in any jurisdiction in the Specified Territory so that it includes only Kao's Products. Kao need not amend its registrations for Kao's Marks in the Specified Territory so that they include only Kao's Products, but agrees that (i) its use will conform to the limitations set forth in this Agreement, and (ii) that upon Amgen's request, and at Amgen's expense, it will amend any registration for any of Kao's Marks in any jurisdiction in the Specified Territory so that the registration includes only Kao's Products if, in Amgen's judgment, such amendment will aid Amgen in protecting Amgen's Mark for Amgen's Products in that jurisdiction.



Handwritten initials or signature.

4. Nutritional Supplements.

Notwithstanding the provisions contained herein, this Agreement neither permits nor prohibits use by Kao of Kao's Marks, or use by Amgen of Amgen's Mark, for nutritional supplements, and should not be interpreted in any way to address those issues. For purposes of this Agreement, nutritional supplements are defined as (a) dietary supplements, food supplements, and nutraceuticals that are taken in the form of a pill and typically chewed and/or swallowed, and (b) nutritional supplement food and beverage products such as meal replacement drinks and energy bars.

5. Use by Related Parties

- (a) Subject to the provisions of subparagraph 5(b), and provided that such use and registration conform to the terms and conditions of this Agreement, it is understood and agreed that Amgen's Authorized Use and Kao's Authorized Use of their respective marks may be undertaken in some countries in the name of licensees, affiliates, officers, employees, agents, or other related party (hereinafter "Related Parties"), and that applications to register the parties' respective marks in various jurisdictions may likewise be filed in the name of Related Parties (hereinafter "Use or Registration by Related Parties").
- (b) Use or Registration by Related Parties shall be permitted pursuant to all of the terms and conditions of this Agreement. Either party may request written confirmation from the other party that a third party who is using the mark(s) in any particular country or attempting to register the mark(s) in any particular jurisdiction is one of the Related Parties.

6. Withdrawal of Opposition and Cancellation Proceedings.

Upon the full execution of this Agreement by both parties, Amgen and Kao will (i) cease filing extensions of time to oppose any and all applications by the other party to register its respective mark(s), and (ii) voluntarily withdraw with prejudice all oppositions and cancellation proceedings they have initiated against the applications and registrations of the other's mark(s), and both parties agree to join in such withdrawals as necessary.

7. Cooperation.

- (a) The parties agree to cooperate with and assist one another as reasonably requested to effect the terms of this Agreement and to provide letters of consent which conform with this Agreement, which letters of consent shall be promptly supplied in suitable form by the requested party to the requesting party at the expense of the requesting party.
- (b) If, despite the parties' agreement that use of their respective marks pursuant to the terms of this Agreement is unlikely to produce confusion,

either party learns of an instance of actual confusion, the parties agree that they will work together to correct the circumstance(s) that created the opportunity for confusion to occur.

- (c) The parties further agree that if either party receives a direct inquiry related to the goods or services of the other, the party receiving such inquiry will use its reasonable best efforts to direct that inquiry to the appropriate party.

8. Notice and Cure.

If either party wishes to assert a claim that the other party has breached this Agreement, notice of such claim shall be sent in accordance with the procedures and to the address for notices provided below. A period of not less than thirty (30) days shall be provided during which the alleged breach may be cured or otherwise addressed before any further action to enforce this Agreement may be instituted.

9. Costs and Fees.

Each party will bear its own costs and attorneys fees with respect to all matters in connection with this Agreement except as otherwise indicated herein.

10. Representations and Warranties.

The parties hereto represent and warrant that they have full power and authority to enter into this Agreement and undertake the obligations set forth hereunder and that all signatures affixed to the Agreement and any ancillary documents are duly authorized.

11. Construction.

This Agreement constitutes the entire agreement between the parties hereto, and it supersedes any prior agreements or understandings between them relating to the subject matter hereof. There are no agreements, covenants, conditions or limitations of this Agreement that are not expressly stated herein. The parties mutually acknowledge and agree that this Agreement and the terms and provisions memorialized herein have been fully and fairly negotiated and that they have consulted with legal counsel or have had the opportunity to do so. The parties hereto agree that this Agreement may not be amended or changed in any way except by a written instrument signed by each of the parties. This Agreement resolves and settles disputed claims. Nothing herein or related hereto shall constitute, be construed as, or be deemed to be an admission of fault, confusing similarity, liability or wrongdoing of any kind. This Agreement shall only apply in the Specified Territory except as otherwise set forth herein.

12. Binding Effect.

This Agreement shall be assignable by either party and shall be fully binding upon and inure to the benefit of each of the parties hereto and each of their respective successors and assigns.

13. Recitals and Headings.

The recitals set forth above shall be deemed to be incorporated within this Agreement as if fully set forth herein, and this Agreement shall be interpreted in light of such recitals; however, the captions and headings contained herein are for convenient reference only and are not a part hereof.

14. Execution.

This Agreement may be executed by each of the parties hereto in separate counterparts and shall have the same force and effect as if it had been executed as a single document.

15. Notices.

Any notices required or permitted under the terms of this Agreement must be given in writing by overnight mail courier to the party to be notified at the address stated below or at such other address as is furnished in writing to the notifying party:

Amgen: Amgen Inc.
One Amgen Center Drive
Thousand Oaks, CA 91320-1789
Attn: General Counsel

with a copy to: Mark I. Feldman, Esq.
Piper Marbury Rudnick & Wolfe
203 North LaSalle Street
Chicago, Illinois 60601-1293

Kao: Kao Kabushiki Kaisha, t/a Kao Corporation
14-10 Nihonbashi Kayabacho
1-Chome, Chuo-ku
Tokyo 103-8210
JAPAN
Attn: Director of Trademarks Department

with a copy to: J. Allison Strickland, Esq.
Fross Zelnick Lehrman & Zissu, P.C.
866 United Nations Plaza
New York, New York 10017



16. Illegal Provisions.

Should any provision of this agreement be or become illegal or unenforceable by reason of conflict with the law of any jurisdiction to which it applies, such provision shall be deemed to be without effect with regard to such jurisdiction. Such illegality or unenforceability shall not be deemed to affect the remaining provisions hereof and, in such event, this agreement shall be construed to the full extent it may lawfully be construed so as to effect the intents and purposes of the parties.

IN WITNESS WHEREOF, the undersigned have executed the above and foregoing Agreement on the dates set forth below.

AMGEN INC., a Delaware corporation

By: Stuart L. Watt
Name: Stuart L. Watt
Title: V.P. and Associate General Counsel
Date: JUNE 13, 2002

KAO KABUSHIKI KAISHA, T/A KAO CORPORATION, a Japan corporation

By: T. Murata
Name: Tetsuo MURATA
Title: Director of Trademarks Dept.
Date: 5th June 2002