

09-27-2002

TRADEMARK

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

In re: Application of Xscape Properties, Limited)	Trademark Law Office 113
Mark: XSCAPE & design)	Examining Attorney:
Serial No.: 76/114,694)	Kelly A. Choe
Filed: August 22, 2000)	
-----)	

**PETITION FOR SUSPENSION OF APPEAL AND REMAND
FOR FURTHER EXAMINATION PURSUANT TO RULE 2.142(d)**

KANE KESSLER, P.C.
Attorneys for Applicant
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New York, NY 10019
(212) 541-6222

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SIR:

Applicant-appellant respectfully requests that the Board suspend action on this appeal and restore jurisdiction to the Examining Attorney pursuant to Rule 2.142(d) for consideration of new evidence which arose after the filing of the instant appeal.

Applicant-appellant has recently entered into an agreement (the "Agreement", attached hereto as Exhibit "A") with Calvin Klein Cosmetic Corporation ("CK"), the Delaware corporation that is the owner of the marks cited by the Examining Attorney in her refusal to pass Application Ser. No. 76/114,694 (the "Application") forward to registration. Pursuant to the Agreement, CK has agreed "to refrain from asserting any rights deriving from the use and registration of its Escape Marks or any other identical or similar mark, application or registration anywhere in the world against the trade marks the subject of the Xscape Applications and Registrations." CK has also agreed that "in the event that either party wishes to make future registered trade mark applications for trade marks that are the subject of this Agreement, the

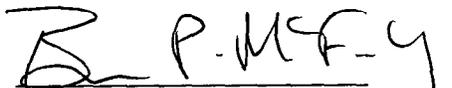
other party agrees not to oppose such application and, if called upon to do so, will provide consent to such application, providing that the specification of such application is not contrary to the terms and spirit of this Agreement.” Accordingly, CK has consented to the Application, subject to the limitations contained in Paragraphs 2.2 and 2.3 of the Agreement. We believe this consent should overcome the Examining Attorney’s unwillingness to pass the Application on to registration.

Applicant-appellant respectfully submits that this new evidence is worthwhile and extremely relevant to the eventual registration of the Application, and therefore justifies the requested remand for further consideration.

Applicant-appellant further respectfully requests that, because this petition is being filed before the reply-brief deadline, its right to submit a reply brief be preserved.

Respectfully submitted,

KANE KESSLER P.C.

By: 
Adam M. Cohen
Brendan P. McFeely
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New York, New York 10019
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AFFIDAVIT OF SERVICE BY EXPRESS MAIL

I, **BRENDAN P. MCFEELY**, declare:

I am not a party to the within action, am over 18 years of age, and reside at New York, New York.

On Thursday, September 26, 2002, I served the within:

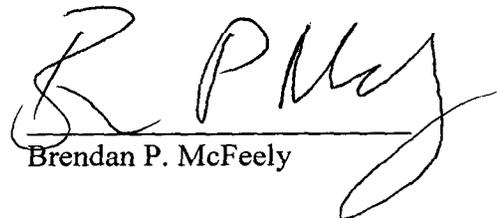
**PETITION FOR SUSPENSION OF APPEAL AND REMAND
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by delivering a true copy thereof, enclosed in a post-paid wrapper, in an official depository under the exclusive care and custody of the U.S. Postal Service within New York State, addressed to the following:

Kelly A. Choe
Trademark Attorney
Law Office 113
United States Patent and Trademark Office
2900 Crystal Drive
Arlington, Virginia 22202-3515

and

Odette Bonnet
Managing Attorney
Law Office 113
United States Patent and Trademark Office
2900 Crystal Drive
Arlington, Virginia 22202-3515


Brendan P. McFeely

PRIOR RIGHTS AND CO-EXISTENCE AGREEMENT

THIS AGREEMENT IS DATED THE 30th DAY OF JULY 2002

PARTIES

1. Calvin Klein Cosmetic Corporation, a company registered in Delaware of 501 Silverside Road, Wilmington, Delaware 19890, USA ("Calvin Klein"); and
2. Xscape Properties Limited, a company registered in England & Wales (Company Registration No. 3830319) of 10 Lower Grosvenor Place, London SW1W 0EN ("Xscape Properties").

RECITALS

- A. Calvin Klein sells and distributes on a worldwide basis a range of toiletries, perfumery, cosmetics, fashion accessories and other luxury goods under the trade mark ESCAPE and is the registered proprietor of various marks that include the element ESCAPE (stylised or word mark) in numerous jurisdictions and territories worldwide (together the "Escape Marks"). This includes the trade mark registrations set out in Schedule 1 to this Agreement.
- B. Xscape Properties has applied to register, and has registered, various marks that include the element XSCAPE (stylised or word marks) in a number of territories and jurisdictions and territories worldwide (together the "Xscape Applications and Registrations"). This includes the trade mark applications set out in Schedule 2 to this Agreement.
- C. Calvin Klein has filed oppositions against certain CTM and UK trade mark applications, details of which are set out in Schedule 3 (the "Oppositions").
- D. The parties agree to settle the Oppositions and agree to co-exist on the terms set out below.

AGREEMENT

1. Xscape Properties recognises and acknowledges Calvin Klein's prior rights in the Escape Marks and undertakes to refrain from asserting rights deriving from the use and registration of its Xscape Applications and Registrations, any other identical or similar mark the subject of the Xscape Applications and Registrations or any identical or similar application or registration anywhere in the world against Calvin Klein's prior rights in the Escape Marks.
2. Xscape Properties undertakes:

2.1 to delete Class 3 from all of the Xscape Applications and Registrations including, but not limited to, those set out in Schedule 2, and send copies of all letters to the local Registries requesting such deletion to Calvin Klein within 10 working days of entering into this Agreement, and undertakes not to use, nor register in the future, the mark XSCAPE in any form whatsoever in relation to any goods in Class 3 of the International Classification of Goods and Services (Nice Agreement) (the "International Classification");

2.2 to apply to record the following limitation in the local trade mark registers against all of the Xscape Applications or Registrations including, but not limited to, those set out in Schedule 2 and send copies of all letters to the local Registries requesting such limitation to Calvin Klein within 10 working days of entering into this Agreement:

"Goods covered in Class 25 shall only be sold through: (i) XSCAPE branded entertainment leisure and sports centres and concessions therein; (ii) XSCAPE branded mail order brochures; (iii) the website www.xscape.co.uk; (iv) retail parks belonging to Xscape Properties Limited or its parent company, Capital and Regional plc; and (v) the premises of commercial sponsors of XSCAPE branded entertainment, leisure and sports centres, PROVIDED that none of (i), (ii), (iii), (iv) or (v) compete with Calvin Klein Cosmetic Corporation, its licensees, related companies or authorised retailers of Calvin Klein products AND PROVIDED that (i), (ii), (iii), (iv) and (v) and the goods sold through the same, are being used to promote XSCAPE branded entertainment leisure and sport centres.

2.3 not to sell any goods falling within Class 25 of the International Classification, other than through: (i) XSCAPE branded entertainment leisure and sports centres and concessions therein; (ii) XSCAPE branded mail order brochures; (iii) the website www.xscape.co.uk; (iv) retail parks belonging to Xscape Properties Limited or its parent company, Capital and Regional plc; and (v) the premises of commercial sponsors of XSCAPE branded entertainment, leisure and sports centres, PROVIDED that none of (i), (ii), (iii), (iv) or (v) compete with Calvin Klein Cosmetic Corporation, its licensees, related companies or authorised retailers of Calvin Klein products AND PROVIDED that (i), (ii), (iii), (iv) and (v) and the goods sold through the same, are being used to promote XSCAPE branded entertainment leisure and sport centres.

3. Calvin Klein undertakes to:

3.1 withdraw the Oppositions and send copies of all letters to the local Registries requesting such withdrawal to Xscape Properties within 10 working days of entering into this Agreement; and

3.2 refrain from asserting rights deriving from the use and registration of its Escape Marks or any other identical or similar mark, application or registration anywhere in the world against the trade marks the subject of the Xscape Applications and Registrations.

4. Each party shall bear its own costs in the Oppositions.

5. This Agreement shall apply worldwide.
6. In the event that either party wishes to make future registered trade mark applications for trade marks that are the subject of this Agreement, the other party agrees not to oppose such application and, if called upon to do so, will provide consent to such application, providing that the specification of such application is not contrary to the terms and spirit of this Agreement.
7. The rights of this Agreement shall enure to the benefit of any legal successors and licensees, as well as to any affiliated companies. The parties agree to impose the obligations under this Agreement on their legal successors and assigns.
8. Should one or more of the provisions of this Agreement be or become void or invalid, the remaining provisions shall remain unaffected. The parties agree, in good faith, to take every effort to negotiate an addition to the Agreement in order to restore the initial legal commercial aim of the offending provisions. The same shall apply in the event this Agreement is incomplete.
9. This Agreement shall be governed by English law and the parties agree to submit the exclusive jurisdiction of the English courts.

We hereby agree to the terms of the above Agreement.

For and on behalf of Calvin Klein
Cosmetic Corporation

Name..... *David Loy Hamilton*
 Title..... *David Loy Hamilton*
 Date..... *President July 30, 2002*

Name.....
 Title.....
 Date.....

For and on behalf of Xscape Properties Limited

Name..... *LYNDA LORAL*
 Title..... *DIRECTOR*
 Date.....

Name..... *(PY) PIERRE-YVES GERBEAU*
 Title..... *DIRECTOR*
 Date..... *30/7/02*

SCHEDULE 1

Escape Marks in UK and CTM

Country/ Jurisdiction	Registration No.	Mark	Class	Filing Date
UK	920045	ESCAPE	3	23-Jan-1968
UK	1432706	ESCAPE	3	19-Jul-1990
UK	1523353	ESCAPE (STYLISED)	3	11-Jan-1993
CTM	75887	ESCAPE	3	1-Apr-1996
CTM	75838	ESCAPE (STYLISED)	3	1-Apr-1996
CTM	144162	ESCAPE FOR MEN CALVIN KLEIN (STYLISED & DEVICE)	3	1-Apr-1996

SCHEDULE 2

Xscape Applications/Registrations

Country/ Jurisdiction	Registration/ Application No.	Mark	Class
UK	2214677	XSCAPE (STYLISED & DEVICE (Deemed withdrawn)	3, 9, 14, 16, 18, 21, 24, 25, 26, 27, 28, 29, 32, 33, 35, 36, 41 and 42
UK	2213806	GREAT XSCAPE (Deemed withdrawn)	3, 9, 14, 16, 18, 21, 24, 25, 26, 28, 29, 32 and 33
UK	2214672	XSCAPE	3, 9, 14, 16, 18, 21, 24, 25, 26, 28, 29, 32 and 33
CTM	1425701	XSCAPE	3, 9, 14, 16, 18, 21, 24, 25, 26, 28, 29, 32, 33, 35, 36, 41 and 42
CTM	1425726	XSCAPE (STYLISED & DEVICE)	3, 9, 14, 16, 18, 21, 24, 25, 26, 28, 29, 32, 33, 35, 36, 41 and 42
International*	733261	XSCAPE	3, 9, 14, 16, 18, 21, 24, 25, 26, 28, 29, 32, 33, 35, 36, 41 and 42
International*	727865	XSCAPE (STYLISED & DEVICE)	3, 9, 14, 16, 18, 21, 24, 25, 26, 28, 29, 32, 33, 35, 36, 41 and 42

*Covers Hungary, Poland & Czech Republic

SCHEDULE 3

Oppositions

Country/ Jurisdiction	Opposition No.	Subject matter of Opposition
UK	52225	UK application #2214677 XSCAPE (STYLISED & DEVICE)
UK	52285	UK application #2213806 GREAT XSCAPE
CTM	B332561	CTM application #1425701 XSCAPE
CTM	B343436	CTM application #1425727 XSCAPE & DEVICE

TTAB

09-27-2002

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N.J. AND D.C. BAR**
PA. BAR‡

September 26, 2002

VIA EXPRESS MAIL: NO. EV213425361US

BOX TTAB - NO FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Re: Petition for Suspension of Appeal and Remand for Further Examination Pursuant to Rule 2.142(d)

Dear Sir or Madam:

Enclosed please find Applicant-appellant's Petition for Suspension of Appeal and Remand for Further Examination Pursuant to Rule 2.142(d), submitted in triplicate.¹

Please telephone the undersigned if you have any questions regarding the foregoing.

Sincerely,

B.P.McFeely
Brendan P. McFeely

Enclosures

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RECEIVED
U.S. PATENT & TRADEMARK OFFICE

¹If at any time a fee is required but inadvertently is not submitted (or is submitted, but is inadequate) in connection with this application, or any registration or other application resulting therefrom, and such omission or insufficiency necessarily would result in the immediate abandonment/cancellation of all or a portion of any such application/registration, without at least a 30-day period to cure said omission/deficiency, then, and in such case only, please telephone us to confirm that the PTO should debit our deposit account, number 50-0908, in order to cover the minimum fee that would be required in order to avoid any such total or partial abandonment/cancellation. Otherwise, please notify us as to any omitted or deficient fee in the normal course. The foregoing procedure is in accordance with our discussions with Cheryl Black, Esq. of the Assistant Commissioner's Office, and Ms. Polly Kemp in the PTO Deposit Accounts office.

Certificate of Mailing by "Express Mail" (37 CFR § 1.10)

Number: EV213425361US

Date of Deposit: September 26, 2002

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service on the date indicated above and is addressed to the *Assistant Commissioner for Trademarks, 2900 Crystal Drive, Box TTAB, NO FEE, Arlington, Virginia 22202-3513.*

Name: Brendan P. McFeely

Signature: 