

ESTTA Tracking number: **ESTTA414181**

Filing date: **06/13/2011**

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

Proceeding	79050342
Applicant	Novation Motorbike S.P.A.
Applied for Mark	TCX
Correspondence Address	DOUGLAS R WOLF WOLF GREENFIELD & SACKS PC 600 ATLANTIC AVENUE, FEDERAL RESERVE PLAZA BOSTON, MA 02210 UNITED STATES drwtrademarks@wolfgreenfield.com
Submission	Applicant's Motion to Suspend
Attachments	N0503.20000US00.req.suspension. (3).pdf (2 pages)(69444 bytes) N0503.20000US00.TCX US Brand Agreement.pdf (7 pages)(490699 bytes)
Filer's Name	Christina M. Licursi
Filer's e-mail	cxltrademarks@wolfgreenfield.com, drwtrademarks@wolfgreenfield.com
Signature	/cml/
Date	06/13/2011

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Novation Motorbike S.P.A.
Serial No. : 79/050342
Date Filed : August 28, 2007
Mark : TCX (Stylized)
Class No. : 9, 18, 25, 28

REQUEST FOR SUSPENSION

Applicant in the above-captioned application, by its undersigned counsel, hereby requests this matter be suspended pending the review of the Consent Agreement between Applicant and the owner of the cited registration filed herewith.

A Consent Agreement was executed on June 9, 2011 and is attached herewith.

As agreed to in the Consent Agreement, Applicant is amending the goods recited in International Class 25 to read as follows: "Motorcyclist gloves and motorcyclist boots, all the aforementioned for motorcyclists and sold exclusively in motorcycling shops and in motorcycling accessories' shops."

Further, Applicant has agreed to all restrictions required by the August 16, 2009 Office Action. As a result thereof, the goods in Classes 9 and 28 are modified to read as follows:

International Class 9: protection devices for personal use against accidents, namely, back padding and guards, neck padding and guards, chest padding and guards, knee pads and guards, elbow pads and guards, life belts, life jackets; spectacles, sunglasses, spectacle cases, lenses for spectacles, spectacle frames, spectacles chains; protective helmets for sports; protective helmets; protective helmets for motorcyclists, cyclists and motorists; protective glasses for sports; goggles for sports; protective spectacles and goggles for motorcyclists, all the aforementioned for motorcyclists and sold exclusively, in motorcycling shops and in motorcycling accessories' shops; and

International Class 28: shin pads and guards, being sports articles for motorcycling use; knee pads and guards, being sports articles for motorcycling use; protective supports for shoulders and elbows, being sports articles for motorcycling use, all the aforementioned for motorcyclists and sold exclusively, in motorcycling shops and in motorcycling accessories' shops.

The goods in International Class 18 are not amended.

Due to the above facts, Applicant requests this matter be suspended pending the Board's review of the Consent Agreement and the modifications to the identification of goods.

If there are any questions or the status needs further explanation, the undersigned counsel encourages a telephone call.

Respectfully submitted,

Dated: June 13, 2011

By: 

Douglas R. Wolf
WOLF, GREENFIELD & SACKS, P.C.
Federal Reserve Plaza
600 Atlantic Avenue
Boston, MA 02210
(617) 646-8000

SETTLEMENT AGREEMENT

This agreement ("Agreement") is entered into on **June 9, 2011** by and between **TCX, LLC** (TCX, LLC), a North Carolina limited liability company, having a place of business at 115 E. 3rd Street, Wendell, North Carolina 27591-9791; and **Novation S.p.a.** ("Novation"), an Italian corporation having a principal place of business at Via G. Ferraris, 56, 31044, Montebelluna (TV), Italy, who will at times hereinafter be referred to collectively as "parties," and individually as "party."

TCX, LLC owns the United States registered, standard character trademark **TCX APPAREL** (Registration No. 3,164,387) in International Class 25 for "clothing, namely, shirts, t-shirts, sweatshirts, pants and sweatpants."

TCX, LLC owns the pending United States application to register, standard character trademark **TCX** (Serial No. 85/069979) in International. Class 25 for "clothing, namely, shirts, t-shirts, sweatshirts, pants and sweatpants."

Novation owns an application filed in the United States Patent and Trademark Office (USPTO) based upon the Madrid Protocol [Section 66A] which seeks to extend protection into United States commerce based upon International Reg. 0954515, for the design trademark



(hereafter "**TCX and Design**") (Serial No. 79/050342) for various goods classified into International Classes 009, 018, 025 and 028.

The Novation application for **TCX and Design** was finally rejected in the USPTO in an Office Action dated August 16, 2009 based on the prior registration owned by TCX, LLC of **TCX APPAREL** for apparel goods classified in International Class 025, said final rejection being based and effective solely against those specific goods claimed by Novation within International Classes 009, 025, and 028 which are bolded, as follows:

IC 009 PROTECTION DEVICES FOR PERSONAL USE AGAINST ACCIDENTS, NAMELY, BACK PADDING AND GUARDS, NECK PADDING AND GUARDS, CHEST PADDING AND GUARDS, KNEE PADS AND GUARDS, ELBOW PADS AND GUARDS, **PROTECTIVE BELTS FOR MOTORCYCLING USE, PROTECTIVE JACKET PADDING FOR MOTORCYCLING USE; GARMENTS IN THE NATURE OF CLOTHING FOR PROTECTION AGAINST ACCIDENTS, IRRADIATION AND FIRE; GLOVES FOR PROTECTION AGAINST ACCIDENTS; LIFE BELTS, LIFE JACKETS; SPECTACLES, SUNGLASSES, SPECTACLE CASES, LENSES FOR SPECTACLES, SPECTACLE FRAMES, SPECTACLES CHAINS; PROTECTIVE HELMETS FOR SPORTS; PROTECTIVE HELMETS; PROTECTIVE HELMETS FOR MOTORCYCLISTS, CYCLISTS AND MOTORISTS; PROTECTIVE GLASSES FOR SPORTS; GOGGLES FOR SPORTS; PROTECTIVE SPECTACLES AND GOGGLES FOR MOTORCYCLISTS; PROTECTIVE CLOTHING FOR MOTORCYCLISTS; PROTECTIVE CLOTHING AGAINST**

ACCIDENTS; FOOTWEAR FOR PROTECTION AGAINST ACCIDENTS, IRRADIATION AND FIRE, PROTECTIVE SUITS FOR MOTORCYCLISTS AGAINST ACCIDENTS, VESTS FOR PROTECTION AGAINST ACCIDENTS, PROTECTIVE BIBS FOR MOTORCYCLISTS, ALL THE AFOREMENTIONED FOR MOTORCYCLISTS AND SOLD EXCLUSIVELY, IN MOTORCYCLING SHOPS AND IN MOTORCYCLING ACCESSORIES' SHOPS

IC 018 RUCKSACKS FOR MOTORCYCLISTS; SPORTS BAGS FOR MOTORCYCLISTS, TOTE BAGS FOR MOTORCYCLISTS, KNAPSACKS FOR MOTORCYCLISTS

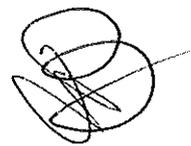
IC 025 MOTORCYCLES GLOVES, BICYCLE GLOVES, CROSS-COUNTRY GLOVES, RIDING GLOVES; MOTORCYCLIST BOOTS, CYCLING SHOES; LEGGINGS, JACKETS, JERKINS, SHIRTS, WAISTCOATS, PANTS, T-SHIRTS, BODY SUITS, UNDERWEAR, ALL THE AFOREMENTIONED ITEMS FOR MOTORCYCLISTS; SOLES FOR FOOTWEAR, INNER SOLES FOR FOOTWEAR, TIPS FOR FOOTWEAR, HEEL PIECES FOR BOOTS AND SHOES, FOOTWEAR UPPERS, HEELS, FITTINGS OF METAL FOR BOOTS AND SHOES WITH PROTECTIVE PURPOSES, ALL THE AFOREMENTIONED FOR MOTORCYCLISTS AND SOLD EXCLUSIVELY, IN MOTORCYCLING SHOPS AND IN MOTORCYCLING ACCESSORIES' SHOPS.

IC 028 PROTECTIVE PADDING FOR SHOULDERS, ELBOWS, KNEES AND SHINS, BEING PARTS OF SPORTS SUITS FOR MOTORCYCLING USE; SHIN PADS AND GUARDS, BEING SPORTS ARTICLES FOR MOTORCYCLING USE; KNEE PADS AND GUARDS, BEING SPORTS ARTICLES FOR MOTORCYCLING USE; PROTECTIVE SUPPORTS FOR SHOULDERS AND ELBOWS, BEING SPORTS ARTICLES FOR MOTORCYCLING USE, ALL THE AFOREMENTIONED FOR MOTORCYCLISTS [sic] SOLD EXCLUSIVELY, IN MOTORCYCLING SHOPS AND IN MOTORCYCLING ACCESSORIES' SHOPS

Despite a claim to ownership of the prior registration of **TCX APPAREL**, the TCX, LLC application for TCX in turn was suspended on September 29, 2010 by the USPTO pending a final resolution of possibly conflicting goods recited within the prior, pending application of **TCX and Design**, owned by Novation.

WHEREAS, the parties desire to resolve all controversies which have arisen between them, and believe the following terms of agreement manifestly and objectively will maintain a clear line of demarcation as to their respective activities within United States commerce, without any possibility of public confusion, mistake or deception as to the source or sponsorship of their respective services sold in connection with their respective marks, and to do so without either party making any admission as to any liability in this matter.

NOW, THEREFORE, each party having thought out its commercial interests with care, and as reputable business persons and users of valuable marks, each having no interest in causing public confusion and having considered the factors laid out within *In re E.I. DuPont de Nemours*



& Co., 177 USPQ 563 (C.C.P.A. 1973), the parties hereby covenant to undertake certain undertakings, as follows:

1. Novation covenants to file a Motion with the Board seeking to amend the goods within the pending application for **TCX and Design** so as to obviate the final rejection in further view of the present agreement reached with the owner of the cited prior registration, to include solely those items and those channels of trade within the pending application for TCX and Design which are classified into International Classes 009, 018, 025, and 028, as follows:

IC 009 PROTECTION DEVICES FOR PERSONAL USE AGAINST ACCIDENTS, NAMELY, BACK PADDING AND GUARDS, NECK PADDING AND GUARDS, CHEST PADDING AND GUARDS, KNEE PADS AND GUARDS, ELBOW PADS AND GUARDS, LIFE BELTS, LIFE JACKETS; SPECTACLES, SUNGLASSES, SPECTACLE CASES, LENSES FOR SPECTACLES, SPECTACLE FRAMES, SPECTACLES CHAINS; PROTECTIVE HELMETS FOR SPORTS; PROTECTIVE HELMETS; PROTECTIVE HELMETS FOR MOTORCYCLISTS, CYCLISTS AND MOTORISTS; PROTECTIVE GLASSES FOR SPORTS; GOGGLES FOR SPORTS; PROTECTIVE SPECTACLES AND GOGGLES FOR MOTORCYCLISTS, ALL THE AFOREMENTIONED FOR MOTORCYCLISTS AND SOLD EXCLUSIVELY, IN MOTORCYCLING SHOPS AND IN MOTORCYCLING ACCESSORIES' SHOPS.

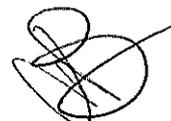
IC 018 RUCKSACKS FOR MOTORCYCLISTS; SPORTS BAGS FOR MOTORCYCLISTS, TOTE BAGS FOR MOTORCYCLISTS, KNAPSACKS FOR MOTORCYCLISTS

IC 025 MOTORCYCLIST GLOVES AND MOTORCYCLIST BOOTS, ALL THE AFOREMENTIONED FOR MOTORCYCLISTS AND SOLD EXCLUSIVELY, IN MOTORCYCLING SHOPS AND IN MOTORCYCLING ACCESSORIES' SHOPS.

IC 028 SHIN PADS AND GUARDS, BEING SPORTS ARTICLES FOR MOTORCYCLING USE; KNEE PADS AND GUARDS, BEING SPORTS ARTICLES FOR MOTORCYCLING USE; PROTECTIVE SUPPORTS FOR SHOULDERS AND ELBOWS, BEING SPORTS ARTICLES FOR MOTORCYCLING USE, ALL THE AFOREMENTIONED FOR MOTORCYCLISTS AND SOLD EXCLUSIVELY, IN MOTORCYCLING SHOPS AND IN MOTORCYCLING ACCESSORIES' SHOPS

2. For goods that fall into Class 025, Novation covenants to hereafter strictly limit its use of any trademark comprising any "TCX" formative in United States commerce to substantially the **TCX and Design** format, and to strictly limit that use in United States commerce to the items and channels of trade of International Class 025 recited above, in paragraph 1. It is understood that Novation may continue to offer promotional clothing items bearing the **TCX and Design** format only, and TCX, LLC reserves the right to object to such usage in the event of confusion.

3. Novation acknowledges that TCX, LLC has priority of use with respect to use of



the formative TCX in United States commerce in connection with apparel and related International Class 025 goods, and specifically with respect to the items, as follows:

CLOTHING, NAMELY, SHIRTS, T-SHIRTS, SWEATSHIRTS, PANTS AND SWEATPANTS

4. Novation reserves a right to modify the **TCX and Design** format in Class 025 in the future, but covenants not to use in United States commerce, or seek any United States federal or state registration of, a materially different new design trademark comprising the formative "TCX" until 15 days prior notice of the new design and the items are given to TCX, LLC. TCX, LLC shall approve or object to the new design within 15 days. Approval shall not be unreasonably withheld, provided the goods associated with the new design or existing **TCX and Design** relate to motorsports, including motorcycle and motocross. TCX, LLC shall have no obligation to provide consent to any use or application to register a Novation formative "TCX" mark except as provided herein for **TCX and Design** for the recitation in Class 025 in paragraph 1.

5. TCX, LLC covenants that hereafter it will neither adopt and use within United States commerce, nor attempt to seek any United States federal or state registration of, any new design trademark comprising the formative "TCX" that is imitative of **TCX and Design**, with respect to any goods substantially the same as the items and channels of trade of International Classes 009, 018, 025 and 028 recited above, in paragraph 1, or any apparel goods including but not limited to:

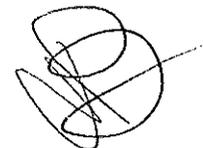
CLOTHING, NAMELY, SHIRTS, T-SHIRTS, SWEATSHIRTS, PANTS AND SWEATPANTS.

6. In consideration of the facts and covenants recited herein, for clothing, namely, shirts, t-shirts, sweatshirts, pants and sweatpants, Novation acknowledges that TCX, LLC has priority of use in United States commerce and the right to seek or maintain any United States federal or state registration for any new trademark comprising the formative "TCX", including but not limited to TCX APPAREL and TCX, that is presented other than as a design which is imitative of **TCX and Design** or any right that Novation may have established such as provided in paragraph 4 prior to the adoption by TCX, LLC of its new trademark.

Novation further specifically consents to use and registration by TCX, LLC of the TCX mark of Serial No. 85/069979 with respect to those International Class 025 goods currently recited within Serial No. 85/069979.

7. In consideration of the acts and covenants recited herein TCX, LLC specifically acknowledges that Novation has priority of use and the right to seek or maintain a United States federal registration upon an amendment of the claimed goods within Serial No. 79/050342 for the formative **TCX and Design** in International Classes 009, 018, 025 and 028 recited above, in paragraph 1.

8. The parties mutually covenant to use best efforts to distinguish its trade dress



and overall commercial presentations from that previously adopted by the other. However, nothing in this paragraph shall be construed to require either party to consult with the other party regarding any future presentation of its trade designations, except as provided above, in paragraph 4.

9. The parties mutually covenant to undertake the promises made herein in essential and strict reliance upon a good faith and timely performance of all promises made herein by the other party; and in that circumstance to forego opposing, seeking to cancel or otherwise taking any steps intended to inhibit use or registration of any trademark, trade name, or domain name that is permitted by terms of this agreement; to take all reasonable steps required to ensure that all future uses in commerce of any permitted trademark, trade name, or domain name will be in strict compliance with all terms of this agreement, and to presently release a party in compliance from any and all claims (asserted or unasserted, now or in the future) arising out of its compliance with all terms of this agreement.

10. The parties mutually agree that in view of the limitations and amendments stated herein, no likelihood of confusion, mistake or deception should exist and each party may represent to the USPTO that it has reached agreements as to the consents to use and registration, as defined herein. In the unlikely event that an objection to a registration permitted herein is made by the USPTO, or an instance of actual confusion arises, written notice shall immediately be provided to the other party, and both parties shall cooperate to ascertain the cause of said objection or confusion and to take reasonable steps to attempt to overcome the objection or to prevent any possibility of confusion in the future.

11. In the event that a party discovers a violation of a material term of agreement by the other party, it has the right, but not the obligation, to provide a Notice of Breach. The noticed party then shall have thirty (30) days to cure the stated violation, if that violation is of the type, which is capable of being cured. Furthermore, if a curable violation is not cured at the end of the thirty day notice period, but the violating party did promptly and in good faith commence reasonable steps to cure within that period, and is continuing diligently and continuously towards completion of a cure when that period ends, then the noticing party shall not unreasonably refuse to extend the notice period, upon the request of, and for good cause shown by, the violating party. The violating party shall not be in breach of this agreement if it in fact does cure a curable violation within the notice period.

12. Within five (5) days of execution of this agreement, the parties instruct and authorize their counsel of record to prepare and file those amendments and papers in the USPTO reasonably required to effectuate this agreement and to make of record the terms of the consents to use and registration, as defined herein.

13. This agreement shall commence on execution and continue in perpetuity unless and until terminated by (i) failure of a party to cure upon a Notice of Breach; or (ii) in the event either party, or its successors or assigns, abandons its aforesaid marks, as the case may be, in which event the foregoing covenants shall cease to have any purpose. Abandonment of a mark shall be determined in accordance with the trademark law in the United States, both statutory and case law.



14. Neither party shall object, anywhere in the United States to a use in commerce by the other party, its related company, or agent, of a trademark, trade name or domain name which is in accordance with the terms of this agreement. Neither party, its related company, or agent shall oppose any application, nor seek to cancel any registration, of the other party involving a trademark, trade name or domain name that is in accordance with the terms of this agreement. Neither party has any affirmative obligation to the other that is not specified as a term of agreement.

15. Upon receipt of the fully executed agreement, each party, on behalf of himself and any affiliated corporations and companies, acquits and forever discharges the other party, and their respective parents, affiliated corporations, companies and subsidiaries, and present and former officers, directors, shareholders, partners, managers, members, employees, agents, insurers, customers, successors and attorneys of each of the foregoing persons and entities, and, where applicable, their respective predecessors, heirs, executors, assigns, administrators and representatives, and each of them, of and from any and all causes of action, claims for relief, lawsuits, charges or complaints which either party now holds in connection with manufacture use or sale of any goods involving or arising out of the marks, as defined herein.

16. If any provision of this agreement as written is deemed unlawful, overly broad or otherwise unenforceable as written, the parties submit to reformation of the provision or offensive portion thereof which is reasonable and permissible under the circumstances, or if this is not possible, the offensive provision or portion thereof will be deemed severed.

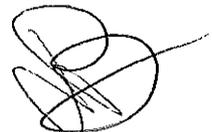
17. This is the entire agreement between the parties and no modification or amendment of this agreement will be effective unless in writing and signed by the parties hereto.

18. This agreement will be binding for any activity that affects United States commerce by either of the parties hereto, their successors, and/or assigns, and upon any and all others acting by or through them, or in privity with them, or under their direction.

19. Each party acknowledges the risk that subsequent to the execution of this agreement, a party may discover facts or may incur, suffer or discover losses, damage or injuries which are unknown and unanticipated at the time this agreement is signed, which if known on the date of this agreement, may have materially affected its decision to give the release contained in this agreement. Despite this knowledge and understanding, each party hereby assumes the risk of such unknown and unanticipated facts and claims, and hereby waives any alleged right to set aside or rescind this agreement.

20. No representations or warranties have been made by either party to the other, or by anyone else, except as expressly set forth in this agreement, and this agreement is not being executed in reliance on any representation or warranty other than those expressly set forth herein.

21. Each party will bear its own costs, expenses, and attorneys' fees that it has heretofore incurred in connection with or arising out of the matters set forth in the recitals hereinabove, the matters and claims released hereunder and the negotiation of this agreement.



22. All questions with respect to the construction of this agreement and the rights and liabilities of the parties hereto shall be governed by the substantive laws of the State of North Carolina, or where pre-empted, by the appropriate body of federal law. Any dispute concerning this agreement, its formation, interpretation or breach, that cannot be resolved by negotiation between the parties shall be adjudicated exclusively by a federal or state court with subject matter jurisdiction located in the State of North Carolina and the parties hereby irrevocably submit and consent to the personal jurisdiction of all such courts for this purpose.

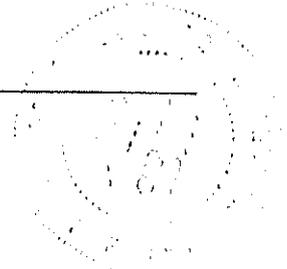
23. This Agreement may be signed in counterparts.

IN WITNESS WHEREOF, the parties have executed this Agreement in duplicate to be effective on the date first written above.

[SEAL] TCX, LLC

By Keith Bilyeu

Printed Name: KEITH BILYEU
Title: President



[SEAL] Novation S.p.a.

By Luca Businaro

Printed Name: LUCA BUSINARO
Title: C.E.O.