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Filing date: **07/31/2015**

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

Proceeding	79141331
Applicant	Kim's Chocolates, naamloze vennootschap
Applied for Mark	KC CHOCOLATIER
Correspondence Address	MARTIN W SCHIFFMILLER KIRSCHSTEIN ISRAEL SCHIFFMILLER & PIERON 425 FIFTH AVE, 5TH FL NEW YORK, NY 10016-2223 UNITED STATES mws@kirschsteinlaw.com
Submission	Applicants Request for Remand and Amendment
Attachments	KC CHOCOLATIER Request for Remand.pdf(347750 bytes)
Filer's Name	Martin W. Schiffmiller
Filer's e-mail	mws@kirschsteinlaw.com
Signature	/Martin W. Schiffmiller/
Date	07/31/2015

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In Re: Trademark Application of
Kim's Chocolates, naamloze vennootschap
Ser. No.: 79-141,331
Filing Dt.: November 14, 2013
Trademark: KC CHOCOLATIER

REQUEST FOR REMAND UNDER SECTION 1209.04

The Notice of Appeal in the above-entitled application was filed on April 1, 2015. Applicant obtained one extension of time for the filing of its brief on appeal because applicant and the owner of the cited prior registrations were negotiating an agreement whereby the prior registrant would consent to the registration of applicant's mark for the goods identified in the application.

Applicant and the prior registrant have now concluded and signed a Worldwide Trademark Co-existence Agreement, a copy of which is submitted herewith. This agreement, which states the prior registrant's consent to the use and registration of the subject trademark by applicant, explains in detail why the parties believe there is no likelihood of confusion between their respective marks and provides a mechanism for resolving any confusion that might arise in the marketplace, should overcome the refusal of registration set forth by the Examining Attorney.

It is respectfully requested that the application be remanded to the Examining Attorney together with the attached Worldwide Trademark Co-existence Agreement.

Respectfully submitted,

KIRSCHSTEIN, ISRAEL,
SCHIFFMILLER & PIERONI, P.C.
Attorneys for Applicant
425 Fifth Avenue, 5th Floor
New York, NY 10016-2223
(212) 697-3750

By /Martin W. Schiffmiller/
Martin W. Schiffmiller

Dated: July 31, 2015

WORLDWIDE TRADEMARK CO-EXISTENCE AGREEMENT

K.C. Confectionery Ltd. - Kim's Chocolates N.V.
"KC CANDY" - "KC CHOCOLATIER"

THIS AGREEMENT is made this 10th day of June, 2015, between K.C. Confectionery Ltd ("KC") a Trinidad & Tobago corporation having its principal place of business at 95-97 Southern Main Road, Couva, Republic of Trinidad & Tobago, West Indies, and Kim's Chocolates N.V. ("KIM"), a Belgian company having its principal place of business at 3300 Tienen (Belgium), Grijpenlaan 11.

RECITALS

WHEREAS, KC is the owner of the trademark "KC CANDY", including *inter alia*, U.S. App. No. 86/249,824 for "KC CANDY" in connection with "confectionery, namely candies; chewing gum" in International Class 30; "KC CANDY & Design" U.S. Reg. No. 3,510,888 for "KC CANDY & Design" in connection with "confectionery, namely, candy" in International Class 30; U.S. Reg. No. 1,744,715 for "KC CANDY & Design" in connection with "candies" in International Class 30; U.S. Reg. No. 2,993,666 for "GINGER MINT KC CANDY & Design" in connection with "candy" in International Class 30; U.S. Reg. No. 1,963,022 for "DINNER MINT KC CANDY & Design" in connection with "candy, namely dinner mints" in International Class 30; U.S. Reg. No. 1,918,218 for "KC SOCCER GUM" in connection with "confectionery, namely chewing gum" in International Class 30; U.S. Reg. No. 2,221,414 for "KC TRANSFER TATTOO" in connection with "bubble gum" in International Class 30; U.S. Reg. No. 2,300,899 for "KC SOUR FACE" in connection with "sugar confectionery, namely candy" in International Class 30; United Kingdom Reg. No. 2021546 for "KC CANDY & Design" in connection with "chocolate, chocolates, non-medicated confectionery, chewing gum" in International Class 30; and United Kingdom Reg. No. 2411968 for "KC CANDY GINGER MINT & Design" in connection with "non-medicated confectionery; chocolate, ices" in International Class 30.

WHEREAS, KIM is the owner of the trademark "KC CHOCOLATIER", including *inter alia*, U.S. App. No. 79/141,331 for "KC CHOCOLATIER" in connection with "coffee, tea, cocoa; pastry and confectionery, confectionery ices; chocolate, chocolate bars, chocolate candies and truffles, chocolates, chocolates spreads" in International Class 30; and

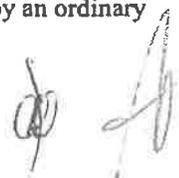
WHEREAS, the parties wish to consent to co-existence of their marks "KC CANDY" and "KC CHOCOLATIER" and avoid future controversies to the extent possible.

TERMS

NOW, THEREFORE, for good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged, the parties agree as follows:

USE AND REGISTRATION OF "KC CHOCOLATIER"

1. KIM shall limit and restrict its use, licensing, application for registration, registration, and renewal of any mark incorporating "KC" to the composite mark "KC CHOCOLATIER", each element being present in close proximity and sufficient emphasis to be understood by an ordinary



consumer to be a composite presentation, and any permissible variation thereof or confusingly similar mark shall be further limited to the products "fine chocolates, namely, chocolate, chocolate bars, chocolate truffles, chocolates and chocolate spreads", which may include as a sub-set products where chocolate is the sole or substantially the sole ingredient, including but not limited to chocolate bars and tablets, filled or not filled, with or without inclusions. The parties expressly agree that the logo shown under Schedule 1 complies with this condition.

2. KC consents to KIM's use, licensing, application for registration, registration, and renewal of the "KC CHOCOLATIER" mark in compliance with the terms of Paragraph 1.

3. KC agrees to refrain from any filing of future oppositions, cancellations, and infringement actions against "KC CHOCOLATIER" based on its "KC CANDY" marks, or otherwise objecting to KIM's use of "KC CHOCOLATIER" provided that the same is in compliance with the terms of Paragraph 1.

4. KC agrees not to claim any rights based on the registration and/or use of "KC" against renewal of, an application for, or use by KIM of "KC CHOCOLATIER", as long as the same is in compliance with the terms of Paragraph 1. In the event consent by KC is necessary or desirable for any of KIM's applications for and/or renewals of "KC CHOCOLATIER" in compliance with the terms of Paragraph 1, KC undertakes to provide its consent in the form reasonably requested and prepared by KIM, including cooperation to obtain registrations where registrars are unpersuaded by this Agreement and consents (e.g., application in KC's name to obtain registration on behalf of KIM) and wherein the reasonable cost will be borne by KIM.

5. KC agrees to refrain from ever using, applying to register, registering, or renewing the "KC CHOCOLATIER" mark for any goods or services unless authorized and consented to by KIM.

USE AND REGISTRATION OF "KC CANDY"

6. KC shall not use, license, apply for registration of, register, or renew the "KC CANDY" mark, or any other composite mark including "KC," for "chocolates" defined as products where chocolate is the sole or substantially the sole ingredient, including but not limited to chocolate bars and tablets, filled or not filled, with or without inclusions. Without limitation, KC may use, apply for registration of, register, or renew any composite mark including "KC" for confectionery products and goods that include chocolate as an additional ingredient as long as chocolate is not the sole or substantially the sole ingredient.

7. KIM consents to KC's use, licensing, application for registration of, registration, and renewal of the "KC CANDY" mark in compliance with the restrictive terms of Paragraph 6.

8. KIM agrees to refrain from any filing of future oppositions, cancellations, and infringement actions against "KC CANDY" based on its "KC CHOCOLATIER" mark, or otherwise objecting to KC's use of "KC CANDY" provided that the same is in compliance with the restrictive terms of Paragraph 6.

9. KIM agrees not to claim any rights based on the registration and/or use of "KC CHOCOLATIER" against renewal of, an application for, or use by KC of "KC CANDY", as long as the same is in compliance with the terms of Paragraph 6. In the event consent by KIM is necessary

or desirable for any of KC's applications for and/or renewals of "KC CANDY", KIM undertakes to provide its consent in the form reasonably requested and prepared by KC, including cooperation to obtain registrations where registrars are unpersuaded by this Agreement and consents (e.g., application in KIM's name to obtain registration on behalf of KC) and wherein the reasonable cost will be borne by KC.

10. KIM agrees to refrain from ever using, licensing, applying to register, registering, or renewing the "KC CANDY" mark for any goods or services unless authorized and consented to by KC.

11. Each party shall cooperate to avoid the use of logo-designs, font-letters, packaging presentations, and other commercial impressions that would create a confusingly similar commercial impression to indicia previously used by the other party. Each party acknowledges that present indicia of the other party are in compliance herewith.

NO LIKELIHOOD OF CONFUSION

12. Both parties acknowledge that given the differences in the marks themselves and the dissimilarities in the nature of the goods on which their respective marks are henceforth to be used in compliance with Paragraphs 1 and 6, respectively, it is unlikely that the general public or the trade will confuse the source of the respective goods of the parties, sold under the parties' said trademarks.

13. Although both parties acknowledge that their anticipated compliance with this Agreement makes confusion unlikely to occur, both parties shall confer in good faith and shall take whatever steps they deem necessary or appropriate to avoid any likelihood of trade and/or consumer confusion involving their said trademarks, should any need arise.

MISCELLANEOUS

14. The territory encompassed by this agreement is worldwide.

15. KIM agrees to reimburse KC for Malloy & Malloy, P.L.'s fees in the amount of US\$2,000.00 for preparation of this Agreement, payable upon execution hereof to "Malloy & Malloy, P.L. Trust Account." Notwithstanding, this Agreement shall be deemed jointly drafted and construed against neither party as the drafter thereof.

16. The parties hereby release one another from any known claim, liability, or other cause of action related to use, application for registration of, registration of, or renewal of their respective marks prior to the date of this Agreement, subject only to compliance with this Agreement.

17. Nothing herein shall be construed to place the parties in a relationship of partners, joint venturers, or licensor-licensee, and neither party shall have the power to bind or obligate the other party in any manner whatsoever except as specifically provided herein.



18. This agreement constitutes the entire agreement of the parties hereto on the subject hereof and supersedes all prior and contemporaneous negotiations, understandings, and agreements whether written or oral. No part of this agreement may be varied by either party except by writing signed by each of the parties hereto.

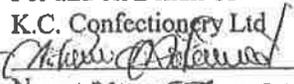
19. Should one party be of the opinion that the other party has breached this Agreement, the aggrieved party shall provide written notice to the accused party and fifteen (15) days opportunity to cure. All notices shall be delivered to the addresses listed above.

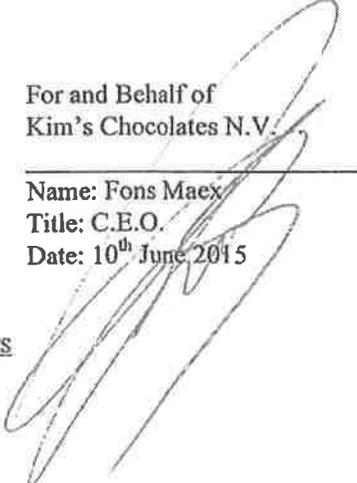
20. This Agreement shall be governed by and construed in accordance with Florida law. In the event of any claim arising under or relating to the subject matter of this Agreement: a) such action shall be brought and exclusive venue shall lie in the applicable State or Federal courts in Florida; b) the parties submit to the jurisdiction of the State and Federal courts in Florida; c) the rule of "interpretation against the draftsman" shall not apply as this Agreement resulted from an arms-length negotiation between the parties; d) EACH PARTY WAIVES ITS RIGHT TO TRIAL BY JURY; e) the prevailing party shall recover its reasonable attorney fees and costs; and f) final decisions of the Florida courts may be enforced in any court of competent jurisdiction.

21. This Agreement and all obligations contained herein shall be binding upon and inure to the benefit of the parties and their respective parents, subsidiaries, divisions, licensees, affiliates under common control, related companies, officers, directors, employees, and other representatives acting on their behalf and on their successors, transferees, and assigns.

22. Each party represents that it has the sole authority to make all decisions concerning or relating to the trademarks addressed herein, including but not limited to decisions concerning or relating to worldwide co-existence and consent agreements, and otherwise has full authority to enter into this Agreement.

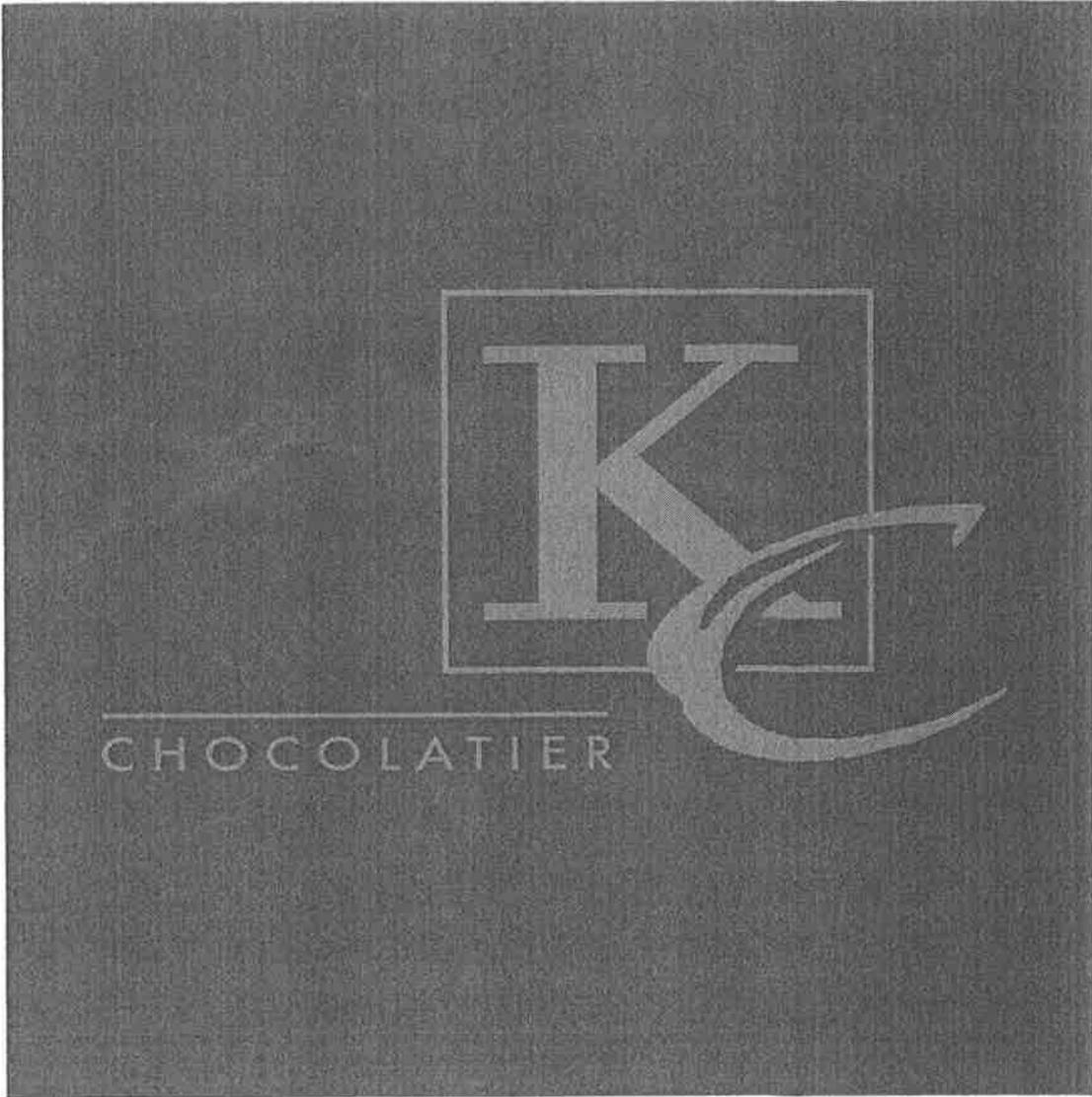
23. This agreement may be executed in any number of counterparts or duplicates each of which shall be an original, but such counterparts or duplicates shall together constitute but one and the same agreement.

For and on Behalf of
K.C. Confectionery Ltd

Name: ASHMEEK MOHAMED
Title: CORPORATE SECRETARY
Date: 27/07/2015

For and Behalf of
Kim's Chocolates N.V.

Name: Fons Maex
Title: C.E.O.
Date: 10th June 2015

ACKNOWLEDGMENTS

Schedule A



[Handwritten signature]