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

Proceeding	85086615
Applicant	TOKYO BROADCASTING SYSTEM TELEVISION, IN
Applied for Mark	AMERICAN NINJA WARRIOR
Correspondence Address	CHET DEVASKAR LINER GRODE STEIN LLP 1100 GLENDON AVE FL 14 LOS ANGELES, CA 90024-3518 UNITED STATES trademark@linerlaw.com
Submission	Applicants Request for Remand and Amendment
Attachments	Request for Remand--AMERICAN NINJA WARRIOR.pdf ( 7 pages )(353528 bytes )
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Signature	/cdevaskar/
Date	02/03/2012

**In the United States Patent and Trademark Office**  
**Before the Trademark Trial and Appeal Board**

Applicant: Tokyo Broadcasting System Television, Inc.                      Law Office: 113  
Mark: AMERICAN NINJA WARRIOR                      Examining Attorney: Ameen Imam  
Serial No.: 85086615  
Filed: July 16, 2010

**REQUEST FOR REMAND TO EXAMINING ATTORNEY**  
**IN CONNECTION WITH INSTITUED EX PARTE APPEAL**

Applicant, Tokyo Broadcasting System Television, Inc., by its attorneys Liner Grode Stein LLP, hereby moves that the above referenced Application be remanded to the Examining Attorney for further consideration based on the following new information and evidence.

The Examining Attorney previously issued a Final Office Action refusing registration of the above referenced Application due to a likelihood of confusion with the mark NINJA WARRIORS, U.S. Registration No. 2,185,012 (the "Cited Mark"), owned by Rubie's Costume Company, Inc. Applicant filed its Notice of Appeal of the Examining Attorney's refusal to register the Application in this case on December 9, 2011.

Since the time Applicant filed its Notice of Appeal in this case, Applicant and Rubie's Costume Company, Inc., have entered into a Consent and Co-Existence Agreement, a fully executed copy of which is attached hereto. This Consent and Co-Existence Agreement evidences the belief of both Applicant and the owner of the Cited Mark that no likelihood of confusion exists between Applicant's intended use of its AMERICAN NINJA WARRIOR mark and the use of the Cited Mark by Rubie's Costume Company, Inc.

Applicant was unable to provide this evidence to the Examining Attorney previously, as the Consent and Co-Existence Agreement between the parties was not reached until February 2, 2012. As such, it is Applicant's position that good cause has been shown for granting this Request to Remand, as the additional evidence in the form of the attached Consent and Co-Existence Agreement was not available for submission to the Examining Attorney or the Board

until yesterday. Accordingly, Applicant respectfully requests that this matter be remanded to the Examining Attorney in order for the Examining Attorney to review this new evidence pursuant to TBMP §1209 and TMEP §1504 and that the Ex Parte Appeal be suspended until such time as the Examining Attorney has rendered a decision with respect to this new evidence.

Dated: Los Angeles, California  
February 3, 2012

Respectfully submitted,  
LINER GRODE STEIN LLP

A handwritten signature in black ink, appearing to be the initials 'LGS', is written above a horizontal line.

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## CONSENT AND CO-EXISTENCE AGREEMENT

THIS CONSENT AND CO-EXISTENCE AGREEMENT (the "Consent Agreement") effective as of the 2nd day of February 2012, is between Tokyo Broadcasting System Television, Inc., a Japan corporation having a place of business at 5-3-6 Akasaka, Minato-Ku, Tokyo, Japan 107-8006, (hereinafter "TBS"), and Rubie's Costume Co. Inc., a New York Corporation, having an address at One Rubie Plaza, Richmond Hill, NY 11418 (hereinafter referred to as "Rubie's"). The parties to this Agreement are also entering into the separate Settlement Agreement effective as of the date hereof and to be executed contemporaneously herewith (the "Settlement Agreement").

### RECITALS

A. TBS is a producer and broadcaster of scripted and unscripted television programs, including Ninja Warrior and American Ninja Warrior, which are broadcast in the United States on G4 and NBC.

B. Rubie's is a manufacturer and distributor of Halloween costumes and other masquerade and disguise-type costumes.

C. TBS is the named applicant for U.S. Trademark Application Serial No. 85/086,621 for the mark NINJA WARRIOR for "Clothing for men, women and children, namely, shirts, t-shirts, sweatshirts, jogging suits, trousers, pants, shorts, tank tops, rainwear, sweaters, jackets, coats, raincoats, snow suits, ties, robes, hats, caps, sun visors, headbands, belts, scarves, gloves, sleepwear, pajamas, lingerie, underwear, briefs, boxer shorts, boots, shoes, sneakers, sandals, booties, slipper socks, socks, tights, stockings, hosiery and swimwear" in International Class 25. TBS is also the named applicant for U.S. Trademark Application Serial No. 85/086,615 for the mark AMERICAN NINJA WARRIOR for "Clothing for men, women and children, namely, shirts, t-shirts, sweatshirts, jogging suits, trousers, pants, shorts, tank tops, rainwear, sweaters, jackets, coats, raincoats, snow suits, ties, robes, hats, caps, sun visors, headbands, belts, scarves, gloves, sleepwear, pajamas, lingerie, underwear, briefs, boxer shorts, boots, shoes, sneakers, sandals, booties, slipper socks, socks, tights, stockings, hosiery and swimwear" in International Class 25.

D. Rubie's is the owner of U.S. Trademark Registration No. 2,185,012 for the mark NINJA WARRIORS for "Halloween costumes" in International Class 25.

E. The Examining Attorney in the U.S. Patent and Trademark Office assigned to TBS's Application Serial Nos. 85/086,621 and 85/086,615 has refused registration of the NINJA WARRIOR and AMERICAN NINJA WARRIOR marks based on a likelihood of confusion with the mark NINJA WARRIORS in Rubie's U.S. Trademark Registration No. 2,185,012.

F. The parties hereto have reviewed their respective marks and usages and following such review are in agreement that there will be no confusion in the trade or the marketplace by the concurrent use of their respective marks on their respective goods.

G. TBS and Rubie's wish to confirm their respective concurrent rights to use their respective marks so as to avoid any likelihood of confusion in the future.

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**NOW, THEREFORE**, in consideration of the foregoing recitals and the mutual promises contained herein, the parties each agree as follows:

1. The parties each agree that, subject to the terms and conditions of this Agreement and the Settlement Agreement, there will be no likelihood of confusion between TBS's NINJA WARRIOR and AMERICAN NINJA WARRIOR marks and Rubie's NINJA WARRIORS mark because of the distinctions between the marks themselves, their respective goods and classes of customers, and because their respective marks are used in substantially different channels of trade under such circumstances that any likelihood of confusion as to the source of the goods is remote. The parties agree that TBS's class of customers are individuals familiar with TBS's television programs that desire to purchase clothing items depicting the TBS brand that are intended for everyday use (as such term is regularly understood in the apparel industry) and that Rubie's class of customers are end users seeking to purchase ninja-type Halloween, masquerade or disguise-type costumes intended for novelty use. TBS's goods are intended to be sold online, in stores and by various forms of direct response in connection with TBS's television programs and at production and promotional events and location events for TBS's television programs. Rubie's goods are sold in costume and novelty stores and online where Halloween, masquerade and other disguise-type costumes are generally sold. The parties agree that given the differences in each party's respective goods and their different channels of trade, it is not likely that consumers will be confused by the concurrent use by the parties of their respective marks.

2. TBS agrees to the use and continued registration by Rubie's of the NINJA WARRIORS mark for the goods identified in Trademark Registration No. 2,185,012. TBS also agrees that it will not use the marks NINJA WARRIOR or AMERICAN NINJA WARRIOR in connection with goods covered by Trademark Registration No. 2,185,012, namely, "Halloween costumes" or any other masquerade or disguise-type costumes.

3. Rubie's agrees to the use and registration by TBS of the NINJA WARRIOR and AMERICAN NINJA WARRIOR mark for the goods identified in Application Serial Nos. 85/086,621 and 85/086,615. Rubie's also agrees that it will not use the mark NINJA WARRIORS in connection with goods covered by Application Serial Nos. 85/086,621 and 85/086,615, namely, "Clothing for men, women and children, namely, shirts, t-shirts, sweatshirts, jogging suits, trousers, pants, shorts, tank tops, rainwear, sweaters, jackets, coats, raincoats, snow suits, ties, robes, hats, caps, sun visors, headbands, belts, scarves, gloves, sleepwear, pajamas, lingerie, underwear, briefs, boxer shorts, boots, shoes, sneakers, sandals, booties, slipper socks, socks, tights, stockings, hosiery and swimwear" which are intended for everyday use and not a part of Rubie's NINJA WARRIORS Halloween masquerade and other disguise-type costumes.

4. The parties agree that TBS will submit this Consent Agreement to the United States Patent and Trademark Office in connection with the prosecution of Trademark Application Serial Nos. 85/086,621 and 85/086,615 for the marks NINJA WARRIOR and AMERICAN NINJA WARRIOR.

5. TBS and Rubie's shall use their best efforts to avoid confusion between their respective marks and shall cooperate and consult with one another in good faith to resolve and prevent any future conditions or developments that suggest to either party the likelihood of confusion between the parties' use of the NINJA WARRIOR, AMERICAN NINJA WARRIOR and NINJA

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WARRIORS marks in connection with their respective goods/services. In the event either party becomes aware of any actual confusion between the goods or services of the parties, such party will notify the other party in writing of each instance of confusion and will refer any such confused consumer or potential consumer to a representative of the other party and each party shall cooperate in good faith in an effort to resolve any such consumer confusion.

6. Each of the parties warrants and represents that it has the capacity and right to enter into this Consent Agreement; that this Agreement was fully negotiated by the parties between them and that none of the provisions hereof is to be considered as having been drafted by any party; and that each party has been represented by counsel in the formation of this Consent Agreement and the Settlement Agreement and hereby consents to the terms and conditions of each such agreement.

7. Each of the parties warrants and represents that this Consent Agreement and the Settlement Agreement comprise the entire understanding of the parties with respect to the subject matter hereof, all prior oral or written communications or understandings being superseded and merged herein. Unless otherwise specifically indicated by the contrary herein, the connectives "and" and "or" shall be construed both conjunctively and disjunctively.

8. The parties agree that this Consent Agreement shall (a) be binding upon and inure to the benefit of the parties, their successors and assigns, their parent companies and subsidiaries and their licensees and agents and (b) govern their conduct worldwide.

9. If any of the provisions of this Consent Agreement are held invalid, illegal, or unenforceable in any respect, such invalidity, illegality, or unenforceability shall not affect any other provision hereof, and, if such provision cannot be restated by a court of competent jurisdiction to reflect as nearly as possible the original intentions of the parties in accordance with applicable law, this Consent Agreement shall be construed as if the invalid, illegal or unenforceable provision had never been contained herein.

10. The parties agree that neither the terms of this Consent Agreement nor any action taken in furtherance of this Agreement shall constitute an admission of fact or law by TBS or Rubie's.

11. For the convenience of the parties, this Consent Agreement may be executed in multiple counterparts. Each party shall deliver to the other party a signed original of the counterpart executed by such party. Each party's signature page to a counterpart may be appended to any other counterpart to produce a complete document with the signature of all parties. In any event, each executed counterpart shall be considered an original of one and the same agreement if each party has executed at least one counterpart.

12. The parties agree that the terms and conditions of this Consent Agreement or any part hereof may only be amended in a writing executed by both of them.

13. Nothing contained in this Consent Agreement shall be construed as creating a joint venture, partnership, agency or employment relationship between the parties.

14. Each party shall bear their own respective attorney's fees and costs.

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15. This Consent Agreement constitutes a contract made under the laws of the State of New York, and shall be interpreted and construed in accordance with such laws. The parties hereby each consent to the jurisdiction of the Courts of the State of New York, State and Federal having jurisdiction over the Borough of Queens.

IN WITNESS WHEREOF, each of the parties hereto has executed this Consent Agreement as of the day, month, and year first above written.

Tokyo Broadcasting System Television, Inc.

By: *Nakro Yoshida*  
Nakro YOSHIDA

Director of Program Sales

Title: Media Business Division

Date: *Feb 2, 2012*

Rubie's Costume Co. Inc.

By: \_\_\_\_\_

Title: \_\_\_\_\_

Date: \_\_\_\_\_

venture, partnership, agency or employment relationship between the parties.

14. Each party shall bear their own respective attorney's fees and costs.

15. This Consent Agreement constitutes a contract made under the laws of the State of New York, and shall be interpreted and construed in accordance with such laws. The parties hereby each consent to the jurisdiction of the Courts of the State of New York, State and Federal having jurisdiction over the Borough of Queens.

IN WITNESS WHEREOF, each of the parties hereto has executed this Consent Agreement as of the day, month, and year first above written.

Tokyo Broadcasting System Television, Inc.

By: \_\_\_\_\_

Title: \_\_\_\_\_

Date: \_\_\_\_\_

Rubie's Costume Co. Inc.

By: Marc P. Beige

Title: MARC P. BEIGE, PRESIDENT

Date: FEB 2, 2012