

TTAB



09-04-2001

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

U.S. Patent & TMO/TM Mail Rcpt Dt #7C

RANDOM HOUSE, INC.

Opposer,

v.

STICHTING GEESTELIJK

WETENSCHAPPELIJK GENOOTSCHAP

Applicant.

)
)
)
) Opposition No.: 113,223
) Serial Number: 75/346540
) Mark: MISCELLANEOUS DESIGN
) Published on: October 20, 1998, TM-124
) Filing Date: August 25, 1997
)
)
)

SEP 10 1997

COMMISSIONER FOR TRADEMARKS
Box TTAB NO FEE
2900 Crystal Drive
Arlington, VA 22202-3513

ANSWER TO NOTICE OF OPPOSITION

Applicant, Stichting Geestelijk Wetenschappelijk Genootschap ("SGWG"), hereby responds to the Notice of Opposition filed by Random House in the above-identified application. The following numbered paragraphs correspond to the paragraphs in the Notice of Opposition.

1. SGWG is without knowledge or information sufficient to form a belief as to the truth or accuracy of this averment.
2. SGWG is without knowledge or information sufficient to form a belief as to the truth or accuracy of this averment. SGWG admits that a copy of U.S. Reg. No. 870,126 is attached to the Notice of Opposition as Exhibit A.

3. SGWG is without knowledge or information sufficient to form a belief as to the truth or accuracy of this averment.
4. SGWG is without knowledge or information sufficient to form a belief as to the truth or accuracy of this averment.
5. SGWG is without knowledge or information sufficient to form a belief as to the truth or accuracy of this averment.
6. SGWG is without knowledge or information sufficient to form a belief as to the truth or accuracy of this averment.
7. SGWG is without knowledge or information sufficient to form a belief as to the truth or accuracy of this averment.
8. SGWG admits that its application includes the goods of books, magazines, leaflets and brochures of a philosophical, theological and ideological nature and denies the remaining averments of this paragraph.
9. Denied.
10. Denied.

Affirmative Defense

1. This Notice of Opposition is moot and/or Opposer is estopped from bringing this action because Applicant and Opposer settled this matter; the settlement agreement and Notice of Withdrawal of Opposition with Consent are attached as collective Exhibit 1.

Wherefore, SWGW requests that this Opposition be dismissed and that the mark shown in Application Ser. No. 75/346,540 be registered on the Principal Register.

Pursuant to Rule 2.119, a copy of this Answer has been served upon Jeffrey C. Katz, Counsel for Opposer, and a certificate of service is attached.

Respectfully submitted,

STICHTING GEESTELIJK
WETENSCHAPPELIJK GENOOTSCHAP

Date: 9-4-01

By: David E. Rogers
Michael A. Lechter
David E. Rogers
William R. Bachand
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Two Renaissance Square
40 N. Central Avenue
Phoenix, AZ 85004-4440
(602) 528-4122

CERTIFICATE OF MAILING BY EXPRESS MAIL EXPRESS MAIL NO. EL847354303US

I, Lois Wilkinson, hereby certify that the above identified Answer and Exhibit, pursuant to 37 C.F.R. §1.10, is being deposited as "Express Mail" this date with the United States Postal service in an envelope addressed to Commissioner for Trademarks, Box TTAB NO FEE, 2900 Crystal Drive, Arlington, VA 22202-3513, on

Date: September 4, 2001

By: Lois Wilkinson
Signature of person depositing Express Mail

#163940v1

CERTIFICATE OF SERVICE

I, Lois Wilkinson, hereby certify that a true copy of the foregoing ANSWER TO NOTICE OF OPPOSITION was served on September 4, 2001, by facsimile and first class mail, postage prepaid, on the following attorney for Opposer:

Jeffrey C. Katz
Davis & Gilbert LLP
1740 Broadway
New York, New York 10019
(212) 468-4800

Facsimile: (212) 468-4888



SETTLEMENT AGREEMENT

This Settlement Agreement and Assignment ("Agreement") is entered into on this _____ day of January, 200~~0~~¹ by and between Stichting Geestelijk Wetenschappelijk Genootschap "De Eeuw van Christus", a Netherlands foundation, and Random House, Inc., a New York corporation.

The purpose of this agreement is to (1) settle a dispute between the Parties over the use and registration of the Church Logo, and (2) avoid future disputes between the Parties over the use and/or registration of other marks.

Therefore, in view of the promises set forth herein and other good and valuable consideration, the sufficiency of which is hereby acknowledged, the Parties agree as follows:

1.0 Definitions.

1.1 "Stichting" means Stichting Geestelijk Wetenschappelijk Genootschap "De Eeuw van Christus" and its agents, officers, servants, attorneys, employees, principals, successors, assignees, licensees and all persons or entities associated with them or acting in concert with them, and all persons holding for or through them.

1.2 "Random House" means Random House, Inc., and its agents, officers, servants, attorneys, employees, principals, successors, assignees, licensees and all persons or entities associated with them or acting in concert with them, and all persons holding for or through them.

1.3 "Parties" means Stichting and Random House.

1.4 "Use" means any reproduction or utilization of a mark, whether it be in an oral, written or electronic communication, in such a manner that it suggests a connection, association or affiliation between the mark and the party or the party's products or services, or suggests that

one party to this Agreement has sponsored the other party or the other party's products and services.

1.5 "Pantheon Design" means the design that is a part of U.S. Trademark Registration No. 870,126, owned by Random House.

1.6 "Church Logo" means the design mark shown in U.S. Trademark Registration No. 2,217,113, owned by Stichting.

2.0 Agreement.

2.1 Stichting agrees to use the Church Logo only in combination with one or more of the phrases "The Age of Christ," "The University of Christ," or "Stichting Geestelijk Wetenschappelijk Genootschap 'De Eeuw van Christus.'"

2.2 Stichting agrees not to file additional applications with the U.S. Patent and Trademark Office in International Class 9 or 16 for the Church Logo, unless the applications are for a composite mark including (1) the Church Logo, and (2) the words "The foundation society for spiritual consciousness 'The Age of Christ,'" "The University of Christ," or "Stichting Geestelijk Wetenschappelijk Genootschap 'De Eeuw van Christus.'"

2.3 Random House agrees not to challenge Stichting's use of the Church Logo as long as Stichting uses it in accordance with this agreement. Random House agrees not to challenge Stichting's registration of the Church Logo as long as Stichting's applications for registration and registrations are for composite marks in accordance with this agreement. Stichting agrees not to challenge Random House's use or registration of the Pantheon Design in connection with the goods listed in U.S. Trademark Registration No. 870,126.

2.4 Random House agrees to dismiss Opposition No. 113,223. Each party agrees to execute and/or file, at no cost to the other party, any documents necessary to dismiss any pending actions anywhere in the world between the parties.

2.5 Each party shall bear its respective attorney's fees and costs.

3.0 Integration.

3.1 This Agreement, including any schedules, attachments, exhibits or documents incorporated by reference constitutes the entire agreement between the Parties and supersedes all prior proposals, representation, negotiations and communications, oral or written, between the Parties with respect to its subject matter. No variation from these provisions shall be binding unless in writing and signed by both Parties.

4.0 Nonwaiver.

4.1 All rights and remedies conferred under this Agreement or by any other instrument or law shall be cumulative, and may be exercised singularly or concurrently. Either party's failure or forbearance to enforce any right or claim against the other arising under this Agreement shall not be deemed a waiver of that or any other provision unless such waiver is signed in writing by the party to be charged.

5.0 Severability.

5.1 In the event any provision of this Agreement or the application of any provision shall be held by a tribunal of competent jurisdiction to be contrary to law, then the remaining provisions of this Agreement shall be unimpaired, and the illegal, invalid or unenforceable provision shall be replaced by a provision, which, being legal, valid and enforceable, comes closest to the intent of the Parties underlying the illegal, invalid or unenforceable provision.

6.0 General.

6.1 All terms and conditions of this Agreement shall be binding upon and shall inure to the benefit of the Parties to this Agreement and their respective permitted successors, permitted assigns, and legal representatives.

IN WITNESS WHEREOF, the Parties have caused this Agreement to be executed by their duly authorized representatives.

**STICHTING GEESTELIJK
WETENSCHAPPELIJK GENOOTSCHAP
"DE EEUW VAN CHRISTUS"**

By _____

Name N.A. VALKENBURGH

Title PRESIDENT

Date December 8 2000

RANDOM HOUSE, INC.

By _____

Name Harriette K. Dorsen

Title Senior Vice President

Date 1/31/01

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

In the matter of Application Serial No.
75/346,540 (OG October 20, 1998, TM 124)

Opposition No. 113,223

Random House, Inc.,

Opposer,

-v-

Stichting Geestelijk Wetenschappelijk
Genootschap,

Applicant.

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

WITHDRAWAL OF OPPOSITION WITH CONSENT

Pursuant to Rule 2.106 (c), Opposer hereby withdraws the subject Opposition (No. 113,223), with the consent of Applicant, Stichting Geestelijk Wetenschappelijk Genootschap, through its attorneys, noted below.

DAVIS & GILBERT LLP

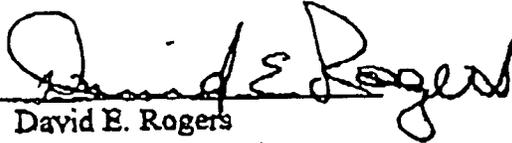
February 2, 2001

By:


Jeffrey C. Katz
1740 Broadway
New York, New York 10019
212-468-4800
Attorneys for Opposer

Agreed: SQUIRE, SANDERS & DEMPSEY L.L.P.

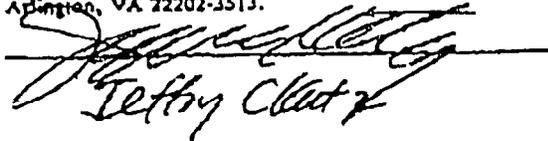
February 9, 2001

By: 

David E. Rogers
Two Renaissance Square
40 North Central Avenue
Suite 2700
Phoenix, Arizona 85004-4498
602-528-4000
Attorneys for Applicant

CERTIFICATE OF EXPRESS MAIL

Date of Deposit: February 13, 2001
"Express Mail" Mailing Label No.: EL761807639US
I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.


Jeffrey Clutz

THE PATENT AND TRADEMARK OFFICE ACKNOWLEDGES RECEIPT OF THE FOLLOWING: DATE: February 13, 2001

REF. NO.: 7120-0014

APPLICANT/REGISTRANT: Random House, Inc

SER. NO. / REG. NO. 75/346540

MARK: Miscellaneous Design

DUE DATE _____ Check # _____ Amt. \$ _____

(x) ~~Announcement of~~ reply to official communication

() ~~Announcement of~~ (Withdrawal of Opposition with

() ~~F~~ consent - Opp. No. 113,223)

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02-13-2001

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U.S. Patent & TM Office Mail Report PL 972 r Cancellation

(x) Express Mail Certificate No.: EL761807639US