

TTAB

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

In the matter of trademark application Serial No. 85-596810
For the mark SASSY MITCHELL
Published in the Official Gazette on May 28, 2013

JOHN PAUL MITCHELL SYSTEMS, a)	
California corporation,)	
)	Opposition No. 91211313
Opposer,)	
)	NOTICE OF WITHDRAWAL OF
v.)	OPPOSITION
)	
BIANCA T. RUSH,)	
)	
Applicant.)	

TTAB Fee: \$300/class, International Class 03 (Hair and Skin Care Preparations), U.S. classes 051 and 052, International Class 025 (Clothing), U.S. classes 022 and 039. Total Fee \$600.00.

Trademark Trial and Appeals Board
United States Patent and Trademark Office
P. O. Box 1451
Arlington, Virginia 22313-1451

NOTICE OF WITHDRAWAL OF OPPOSITION

John Paul Mitchell Systems, a California corporation with its principal office of business located at 20705 Centre Pointe Parkway, Saugus, California 91350.

The name and address of the current applicant is Bianca T. Rush, located at 300 Shadow Glen, McDonough, Georgia, US 30253.

The parties have entered into a settlement agreement, a copy of which is attached hereto as Exhibit "A."

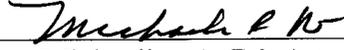
As attorney for the opposer, John Paul Mitchell Systems, I am hereby authorized to file and request the withdrawal of their opposition.



08-05-2013

A duplicate copy of this Notice of Withdrawal of Opposition are enclosed.

Respectfully submitted,

By:  Date: July 31, 2013
Michaeline A. Ré, Attorney of record, admitted in
California State Bar, State Bar Number 77853

Michaeline A. Ré
100 E. Corson Street, 3rd Floor
Pasadena, CA 91103
Tel. 626 396-9230

EXHIBIT "A"

SETTLEMENT AND COEXISTENCE AGREEMENT

This Settlement and Coexistence Agreement (“Agreement”), entered into and effective as of July 23, 2013 (the “Effective Date”), is between John Paul Mitchell Systems (“JPMS”), a California corporation, having a principal place of business at 1888 Century Park East, Suite 1600, Los Angeles, CA 90025 and Bianca T. Rush (“RUSH”), an individual, having a principal place of business at 300 Shadow Glen, McDonough, Georgia 30253, (each a “Party” and collectively, the “Parties”).

RECITALS

WHEREAS, JPMS is the owner of the federally registered marks PAUL MITCHELL® (U.S. Registration Nos. 1680913, 1745839, 2969643, 3009952, 4256635) and MITCH® (U.S. Registration No. 4036167) registered with the United States Patent and Trademark Office (“USPTO”) and covering goods and services described as hair and skin care products and services in International Class 003, 025, 041 and 044, (collectively the “JPMS Marks”). A copy of the Certificate of Registration is available on the USPTO web site.

WHEREAS, RUSH is the owner of pending U.S. Trademark Application Serial No. 85/596810 for the mark SASSY MITCHELL covering goods described as hair extensions, hair dressings for women, hair care preparations, hair oils, hair pomades, hair rinses, hair shampoos and conditioners, and hair styling preparations in International Class 003 and T-shirts in International Class 025, (collectively the “RUSH” marks). A copy of pending application is available on the USPTO web site.

WHEREAS, on June 17, 2013, JPMS filed an opposition to RUSH’s pending application with the USPTO alleging that RUSH’s intended use, promotion and advertisement of the hair care and t-shirt Goods under the SASSY MITCHELL unfairly competed with and infringed JPMS’s rights in its PAUL MITCHELL and MITCH Registrations.

WHEREAS, the costs to the Parties in prosecuting and defending against the claims asserted in the above described opposition are anticipated to be significant both in terms of legal fees and diversion from other business pursuits; and

WHEREAS, the Parties desire to put an end to any controversy, terminate the opposition, on the terms and conditions set forth below, and to settle and resolve all disputes between them and terminate, extinguish, and release all claims or causes of action against each other relating to the subject matter of the Trademark Appeals Board.

NOW, THEREFORE, in consideration of the mutual promises, warranties and covenants contained in this Agreement, the receipt and sufficiency of which is hereby acknowledged, and the above recitals, which are incorporated in the operative terms of this Agreement by reference the parties agree as follows:

TERMS AND CONDITIONS

1. Recitals. The Parties agree that the above Recitals are true and correct and are

hereby incorporated into this Agreement.

2. Acknowledgment of Rights. RUSH acknowledges JPMS's ownership of and exclusive right to use and register its PAUL MITCHELL and MITCH Trademarks, and to use the mark PAUL MITCHELL® in connection with the sale of a full line of hair care products, including shampoos, conditioners, hair spray, styling products, hair colors and permanent waves and to use the mark "MITCH" in connection with the sale of a men's hair and skin care product line. The company sells and markets its products through the professional salon market having done so from 1980. However, JPMS has no control over the products once they are sold and the products may be found in mass-retailers and on the Internet.

JPMS acknowledges RUSH's ownership and exclusive right to use and register its SASSY MITCHELL Trademark for the goods and services set forth in U.S. trademark application No. 85/596810 as an intent to use application and is already using the mark on hair extension products not covered by this application. However, JPMS is aware that another company currently sells and markets hair care products under the trade name "SASSY" and therefore makes no acknowledgment or representation that RUSH is the sole and exclusive owner of the mark as compared to any other person or entity in the market place. JPMS agrees not to oppose, petition to cancel, or otherwise challenge or object to the use or any current application and/or subsequent application for registration by RUSH of Marks consisting of or comprising the terms "SASSY MITCHELL," as long as such use and/or registration is in accordance with the terms of this Agreement.

3. Limitations on Rights. RUSH agrees that it will not in the future use or apply for registration of any trademark or service mark and/or trade name consisting of or incorporating the term MITCHELL or MITCH, or any term that may be confusingly similar to PAUL MITCHELL or MITCH covering such services as hair and skin care products, cosmetology schools, clothing, business and marketing materials.

Rush hereby represents that the products are marketed primarily to ethnic markets and are sold in her salon or over the Internet. Further that the mark consists of the word "SASSY" in pink cursive font above the black stylized word "MITCHELL."

John Paul Mitchell System ("JPMS") is using the PAUL MITCHELL® and MITCH® are both registered marks of the company, both in the United States and elsewhere. Copies of their product screens are posted on the PAUL MITCHELL web site.

JPMS currently sells its hair care products only through professional salons, barber shops and cosmetology schools and distributes both consumer products and products for professional application in a salon.

RUSH states that her use of this mark is subject to the following limitations:

Goods for which RUSH uses its Mark: RUSH will only use the mark in connection with the sale of hair extensions, hair dressings for women; hair oils, pomades, rinses, shampoos and conditioners and hair styling products under the SASSY MITCHELL brand and will only sell its

products over the Internet or in RUSH's own salon and will not sell products in or to the professional salon market. Copies of RUSH's product are posted on her web site.

Should RUSH change its packaging RUSH shall submit samples of any new packaging to JPMS for its approval. Said approval will not be unreasonably withheld. JPMS and RUSH want to make sure that no consumer is confused as to the source of the goods.

JPMS is entitled to use the PAUL MITCHELL® and MITCH® marks on any product and in any market without the prior approval of RUSH. JPMS states that its use of their mark is subject to the following limitations:

JPMS will not use the mark "SASSY" in connection with the sale of any of its goods or services.

4. **Dismissal of Trademark Opposition.** Within ten (10) business days of receipt of a copy of the fully executed Settlement Agreement, JPMS will file a Notice of Withdrawal of Opposition with the Trademark Appeals Board and file a copy of this coexistence agreement with the appeal board so that the trademark can proceed to registration.

5. **Actual Confusion.** In the event that either Party becomes aware of any actual confusion or mistake occurring as a result of their use of their respective marks, the Parties agree to communicate all details of each such instance to each other, and to cooperate reasonably to take steps to abate the cause of confusion or mistake, and to prevent any such confusion or mistake from arising again.

6. **Modification of Agreement.** This Agreement may not be altered, amended, modified or otherwise changed except by a writing duly signed by all Parties hereto.

7. **Voluntary Agreement.** The Parties hereto acknowledge that they are entering into this Agreement freely and voluntarily, that they have ascertained and weighed all the facts and circumstances likely to influence their judgment herein, that they have given due consideration to the provisions contained herein, and that they thoroughly understand and consent to all provisions hereof. Each party has reviewed this Agreement and accordingly, the rule of construction to the effect that any ambiguities are to be resolved against the drafting party will not be employed in any interpretation of this Agreement.

8. **No Waiver.** No delay or omission to exercise any right, power, or remedy accruing to any Party, upon any breach or default under this Agreement, shall impair any such right, power, or remedy of such Party to be construed to be a waiver of any such breach or default, or an acquiescence therein, or of or in any similar breach or default thereafter occurring; nor shall any waiver of any single breach or default be deemed a waiver of any other breach or default theretofore or thereafter occurring. All of a Party's remedies including without limitation recovery of attorneys' fees and costs, either under this Agreement, or by law or otherwise afforded to such Party, shall be cumulative and not alternative.

9. **Notices.** All communications required or permitted to be made under this

Agreement shall be in writing and either shall be delivered personally or sent by United States Postal Services certified or registered mail, postage prepaid and return receipt requested, to the address or addresses set forth below, or such other address or addresses as either party may notify the other pursuant to this section. Any such communication shall be deemed to be properly given (i) if delivered personally, upon written acknowledgment of receipt after delivery to the address specified; or (ii) if posted, the earlier of the actual date of delivery, as set forth in the return receipt, or three (3) business days from the date posted pursuant to the foregoing. The addresses for the parties are as follows:

To: John Paul Mitchell Systems
Attn: Legal Department
20705 Centre Pointe Parkway
Santa Clarita, CA 91350

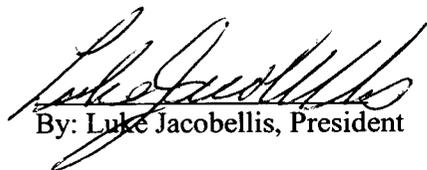
With a copy, via the same mode addressed to:

Michaeline A. Ré
100 E. Corson Street, Third Floor
Pasadena, CA 91103

To: Bianca Rush
300 Shadow Glen
McDonough, Georgia 30253

10. **Counterparts.** This Agreement may be executed in any number of counterparts, each of which when so executed and delivered shall be an original, but all of which together shall constitute one and the same instrument.

John Paul Mitchell Systems



By: Luke Jacobellis, President

Bianca T. Rush

By: Bianca T. Rush, owner

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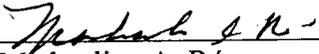
By: Luke Jacobellis, President

Bianca T. Rush
By: Bianca T. Rush, owner
7/30/13

CERTIFICATE OF SERVICE

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300 Shadow Glen
McDonough, Georgia, USA 30253

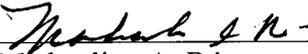


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By: Michael A. Ré Date: July 31, 2013
Michaeline A. Ré, Attorney of record, admitted in
California State Bar, State Bar Number 77853

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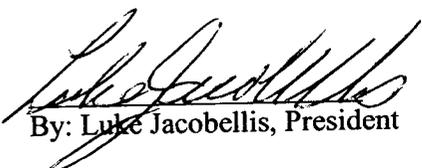
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10. **Counterparts.** This Agreement may be executed in any number of counterparts, each of which when so executed and delivered shall be an original, but all of which together shall constitute one and the same instrument.

John Paul Mitchell Systems


By: Luke Jacobellis, President

Bianca T. Rush

By: Bianca T. Rush, owner

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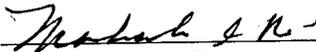
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