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

Proceeding	92050207
Party	Plaintiff Michael J. Peter
Correspondence Address	DANIEL S POLLEY DANIEL S POLLEY PA 7251 WEST PALMETTO PARK ROAD , SUITE 202 BOCA RATON, FL 33433 UNITED STATES dan@danpolley.com
Submission	Other Motions/Papers
Filer's Name	Daniel S. Polley
Filer's e-mail	dan@danpolley.com
Signature	/Daniel S. Polley/
Date	04/04/2016
Attachments	Motion for Suspension to consider Consent Agreement 4-4-2016.pdf(86689 bytes) Scanned Signed Co-Existence Agreemetn.pdf(472680 bytes)

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

In the Matter of Registration No. 2,783,766
For the Mark: SG and Design
Registration Date: November 18, 2003

MICHAEL J. PETER,)	
)	Cancellation No. 92050207
Petitioner,)	
v.)	
)	
SUICIDE GIRLS, INC.)	
)	
Registrant.)	
_____)	

PETITIONER’S MOTION FOR SUSPENSION OF CANCELLATION
PROCEEDING WITH CONSENT

Petitioner, Michael J. Peter, (“Petitioner”), by and through the undersigned counsel, hereby files this Motion for Suspension of Cancellation Proceeding with Consent of Registrant and in support thereof:

1. The parties of entered into a Coexistence Agreement dated March 25, 2016, which is attached as an Exhibit to this Motion.
2. The Coexistence Agreement also contains Registrant’s consent to registration of Petitioner’s currently suspended pending application Serial No. 77498645 (“the ‘645 application), which was refused registration by the Examining Attorney in view of Registrant’s U.S. Registration No. 2,783,766 (“the ‘766 Registration”).
3. With this proceeding suspended Petitioner will forward a copy of the parties’ Coexistence Agreement as part of its request to remove the ‘645 application

from suspension and withdrawing the citation of the '766 Registration against registration of the SG mark in the '645 application.

4. As per the terms of the Coexistence Agreement with the publication of the '645 application, Petitioner will file a Motion to Withdraw/Dismiss the Cancellation Proceeding, with prejudice.
5. TBMP §510.03(a) recognizes that the “parties may also agree to suspend proceeding for consideration of a matter by an examining attorney, including the disposition of a party’s application before the examining attorney. *See, e.g., The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1592 (TTAB 1995) (suspended pending consideration of consent agreement by examining attorney).

WHEREFORE, Petitioner respectfully requests that the Board grant this Motion for Suspension of Cancellation Proceeding with Consent to allow the examining attorney assigned to Petitioner’s pending service mark application to consider the Coexistence Agreement entered into between the parties.

Respectfully submitted,
Attorneys for Petitioner

/Daniel S. Polley/
Daniel S. Polley, Reg. No. 34,902
DANIEL S. POLLEY, P.A.
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CERTIFICATE OF SERVICE

I hereby certify that on the 4th day of April, 2016, a true copy of the foregoing
MOTION FOR SUSPENSION OF CANCELLATION PROCEEDING WITH
CONSENT
was served via email, per agreement of the parties as follows:

Paul Loving, Esq.
paulloving@gmail.com

Executed on April 4, 2016

/Daniel S. Polley/
Daniel S. Polley, Reg. No. 34,902

COEXISTENCE AGREEMENT

THIS COEXISTENCE AGREEMENT (the "Agreement") is made and entered into as of March 25, 2016 (the "Effective Date"), by and between SG Services, Inc. (formerly known as Suicide Girls, Inc.) ("SG"), and Michael J. Peter ("Peter").

WHEREAS, among other trademarks in use in commerce and/or registered or applied for with the United States Patent and Trademark Office ("USPTO"), SG owns US Registration No. 2783766 and US Application No. 86157099 as set forth on Exhibit 1 (collectively the "SG Mark");

WHEREAS, among other trademarks applied for with the USPTO, Peter owns US Application No. 77498645 as set forth on Exhibit 2 (the "Peter Mark");

WHEREAS, Peter has filed Cancellation Proceeding No. 92050207 against the SG Mark alleging priority and likelihood of confusion (the "Cancellation Proceeding");

WHEREAS, the parties agree that their marks are not identical and that they offer distinguishable products and services under their respective marks and therefore, the respective marks are not likely to be a source or subject of confusion and that neither party has ever experienced any actual confusion between the respective marks even with their co-existence in commerce for many years;

WHEREAS, both SG and Peter believe it is in their respective best interests to enter into an agreement and consequently, have negotiated this settlement, the terms, provisions, and conditions of which are fully set forth in this Agreement;

NOW, THEREFORE, for the mutual promises set forth in this Agreement and other good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged, the parties state and agree as follows:

1. **Whereas Clauses.** All of the preceding WHEREAS clauses are true and correct and are incorporated by reference in and made a part of this Agreement.
2. **Co-Existence.**
 - 2.1 SG and Peter agree to the co-existence of the SG Mark and Peter Mark, whereby:
(i) SG shall have the right to own registrations and make use of the SG Mark for (a) clothing, namely, jackets, t-shirts, tank tops, sweatshirts [and collared shirts] sold in connection with online adult entertainment services via a global computer network, in International Class 25; (b) entertainment services in the nature of providing adult material over a global computer network, in International Class 41 and (c) Entertainment services, namely, television and film production services and an on going television series about the lives of a group of models; (ii) SG shall have the right to register the SG Mark in Class 043 and make use of the SG Mark for nightclub services, nightclub entertainment services and adult entertainment services, provided that the SG Mark is not used separate and apart from the mark SUICIDEGIRLS; except that SG shall also have the right to use the SG Mark



separate and apart from the mark SUICIDEGIRLS, on promotional items promoting the SUICIDE GIRLS nightclubs and merchandise sold or distributed in or in a reasonable proximity to, or otherwise in connection with a SUICIDE GIRLS nightclub; and (iii) Peter shall have the right to own registrations and make use of the Peter Mark for nightclub services; nightclub entertainment services; adult entertainment services, in International Class 043, provided that the Peter Mark is not used separate and apart from the mark SOLID GOLD: except that Peter shall also have the right to use the Peter Mark separate and apart from the mark SOLID GOLD, on promotional items promoting SOLID GOLD nightclubs and merchandise for SOLID GOLD nightclubs sold or distributed in or in a reasonable proximity to, or otherwise in connection with a SOLID GOLD nightclub. This co-existence is conditional upon the parties' compliance with the terms of this Agreement.

3. Avoidance of Confusion.

3.1 Undertakings by Peter.

- 3.1.1 Peter does not and will not object and hereby consents to the registrations of the SG Mark in International Classes 25 or 41 (whether standalone or as a composite with anything else (e.g. the word SuicideGirls)) which are already registered or applied for anywhere in the world as of the Effective Date, including but not limited to US Registration No. 2783766 and US Application No. 86157099, nor interfere with SG's applications with the United States Patent and Trademark Office ("USPTO") for Sections 8, 9 & 15 renewals and incontestability therefore, respectively. Furthermore, Peter will not attempt to register the Peter Mark (whether standalone or as a composite mark with anything else (e.g. the word(s) Solid Gold)) for the services listed in US Registration No. 2783766 or in regard to film and television production services unless the same is solely registered and used as a composite with the mark "Solid Gold".
- 3.1.2 Within ten (10) days of the publication of the Peter Mark by the USPTO, Peter will withdraw the Cancellation Proceeding with prejudice, and each Party shall bear its own costs of the Cancellation Proceeding, and of their withdrawal.
- 3.1.3 Peter will not file opposition or cancellation proceedings (nor interfere with SG's applications with the USPTO for subsequent Sections 8, 9 & 15 renewals and incontestability, respectively) against existing registrations or pending or new applications by SG to register the SG Mark (whether standalone or as a composite mark with anything else (e.g. the word SuicideGirls)) covering goods and/or services similar to those in US Registration No. 2783766 or Application No. 86157099, provided the exploitation of such marks comport with the terms and limitations as set forth in this Agreement. Peter reserves the right to oppose any such pending or new application, however, if the SG Mark is filed as a composite with

A handwritten signature in black ink, appearing to be 'MGP', located in the bottom right corner of the page.

another word or device (other than SuicideGirls) which Peter considers to be confusingly similar to any of its trademarks other than the Peter Mark.

3.2 Undertakings by Suicide Girls.

3.2.1 SG does not and will not object and hereby consents to the registration of the Peter Mark (i.e., US Application No. 77498645, nor interfere with Peter's applications with the USPTO for Section 8, 9 & 15 renewals and incontestability therefore, respectively)). ..

3.2.2 SG will not file opposition or cancellation proceedings nor interfere with Peter's applications with the USPTO for Section 8, 9 & 15 renewals and incontestability therefore, respectively) against pending or new applications by Peter to register the Peter Mark (whether standalone or as a composite mark with anything else (e.g. the words Solid Gold)) covering goods and/or services in International class 43 or with respect to film or television show(s), documentary or series based on or centered around an adult night club or gentleman's club provided the exploitation of such marks comport with the terms and limitations as set forth in this settlement agreement, in particular, but without limitation, those restrictions set forth in Paragraph 3.1.1 herein. SG reserves the right to oppose any such pending or new application, however, if the Peter Mark is filed as a composite with another word or device which SG considers to be confusingly similar to any of its trademarks other than the SG Mark.

4. If the USPTO refuses to allow publication of the Peter Mark based on this Agreement, or if the USPTO refuses to allow publication of the SG Mark in association with Application No. 86157099, the parties will agree to negotiate in good faith to address the examining attorneys' respective concerns and attempt to overcome the refusal to register.
5. Promptly upon full execution hereof: (i) SG will submit this Agreement to the USPTO examining attorney assigned to Application No. 86157099 for the purpose of securing the right to publish the mark for opposition; and (ii) Peter will submit this Agreement (a) to the USPTO examining attorney assigned to the Peter Mark application for the purpose of securing the right to publish the Peter Mark for opposition; and (b) to the Trademark Trial and Appeal Board ("TTAB") by consent motion to suspend the Cancellation Proceeding until such time, if any, that the Peter Mark is published for opposition, at which time, per Peter's motion for the same as set forth in Paragraph 3.1.2 herein, the TTAB will dismiss the Cancellation Proceeding with prejudice. In such event as the TTAB requires additional motions or clarification to effectuate the intent of this Paragraph, the parties will agree to negotiate in good faith to address the concerns of the TTAB and attempt to overcome the same.
6. The parties note that neither is aware of any instance of actual confusion despite their concurrent use of their respective marks for many years and agree that no confusion as to source is likely from the continued use of the parties' respective marks in connection with their respective products and services identified in the SG Mark and Peter Mark. The



parties agree that they shall continue to cooperate to ensure that there is no likelihood of confusion between their above-identified respective marks. In the unlikely event that confusion among consumers occurs, the parties agree to take commercially reasonable steps to address and remedy such confusion.

7. The parties agree to take any further actions and execute any further agreements needed to carry out the spirit and intent of this Agreement, specifically taking any steps necessary to help avoid confusion.
8. Confidentiality. Neither the parties nor their counsel shall seek to publicize, or comment to the press concerning, this Agreement.
9. Warranties and Representations. The parties acknowledge that no person or any other entity has made any promise, representation, or warranty whatsoever, expressed, implied or statutory, not contained herein, concerning the subject matter hereof, to induce the execution of this instrument, and the parties acknowledge that they have executed this instrument without reliance on any promise, representation, or warranty not contained herein. The parties have read and understand all terms and conditions of this Agreement.
10. Force and Effect of Agreement. This Agreement shall be binding upon and inure to the benefit of the parties and each of their respective directors, officers, agents, employees, stockholders, representatives, attorneys, heirs, successors and assigns.
11. Severability. The invalidity or unenforceability of any paragraph or provision of this Agreement shall not affect the validity or enforceability of the remainder of this Agreement, or the remainder of any paragraph or provision. This Agreement shall be construed in all respects as if any invalid or unenforceable paragraph or provision were omitted. Without limiting the generality of the foregoing, if any court, agency, tribunal, or other authority in one country declares this Agreement or any part of it to be invalid or unenforceable, that act shall have no effect on the validity and enforceability of this Agreement in any other country.
12. Governing Law & Dispute Resolution. This Agreement shall be governed by and construed in accordance with the laws of the District of Columbia. The parties hereby agree and consent to the exclusive jurisdiction and venue of any state or federal court located in Los Angeles, California or any state or federal court located within the Southern District of Florida. In any litigation, the parties agree to go to early mediation after the filing of all pleadings and they each hereby waive all defenses of lack of personal jurisdiction and forum non-conveniens if the litigation is brought in one of the courts identified in this Paragraph.
13. Waiver. The waiver of any breach of any term of this Agreement by any Party shall not be deemed a waiver of any subsequent or prior breach. No Party shall be deemed to have waived any breach of any term of this Agreement, except as set forth in writing.
14. Execution of Agreement. The undersigned individuals hereby warrant and represent that they have full authority to execute and perform this Agreement on behalf of the party for



which they have signed. This Agreement may be executed in counterparts, all of which, when taken together, shall constitute one agreement with the same force and effect as if all signatures had been entered on one document.

15. Agreement not Evidence. This Agreement shall not be used, discussed, referenced or entered into evidence or as an exhibit by either party in connection with the Cancellation Proceeding. Notwithstanding the previous sentence, the parties agree that this Agreement can be entered and filed with the USPTO and/or TTAB in connection with suspending, withdrawing or dismissing the Cancellation Proceeding.
16. Entire Agreement and Modification. This Agreement represents the entire agreement between the Parties and supersedes all prior or contemporaneous agreements. This Agreement may not be altered, amended or modified, except in a writing signed by all Parties.

Dated: March 25, 2016

SG Services, Inc.

By: 
Name:
Title:

Dated: March 25, 2016

Peter

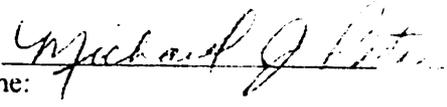
By: 
Name:
Title:



EXHIBIT 1:

US Registration No. 2783766 and US Application No. 86157099



Word Mark SG

Goods and Services IC 025. US 022 039. G & S: Clothing, namely, jackets, t-shirts, tank tops, sweatshirts [and collared shirts] sold in connection with online adult entertainment services via a global computer network. FIRST USE: 20020900. FIRST USE IN COMMERCE: 20020900

IC 041. US 100 101 107. G & S: entertainment services in the nature of providing adult material over a global computer network. FIRST USE: 20010900. FIRST USE IN COMMERCE: 20010900

Mark Drawing Code (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Search Code 02.03.01 - Busts of women facing forward; Heads of women facing forward; Portraiture of women facing forward; Women - head, portraiture or busts facing forward

02.03.17 - Pigtails; Ponytails; Women with ponytails or pigtails

02.03.19 - Bathing suits (women wearing); Lingerie (women wearing); Nude women, women wearing underclothes, bathing suits or brief attire; Underclothes (women wearing); Underwear (women wearing)

Serial Number 76408240

Filing Date May 15, 2002

Current Basis 1A

Original Filing Basis 1A

Published for Opposition August 26, 2003

Registration Number 2783766

Registration Date November 18, 2003

Owner (REGISTRANT) Suicide Girls, Inc. CORPORATION OREGON 25 NW 23rd Place Suite 6 Portland OREGON 972105599

A handwritten signature in black ink, appearing to be 'SG' with a flourish underneath.

(LAST LISTED OWNER) SG SERVICES, INC. CORPORATION OREGON
5482 WILSHIRE BLVD., #1925 LOS ANGELES CALIFORNIA 90036

Assignment Recorded ASSIGNMENT RECORDED
Attorney of Record Jonathan Pollack
Description of Mark Color is not claimed as a feature of the mark.
Type of Mark TRADEMARK. SERVICE MARK
Register PRINCIPAL
Affidavit Text SECT 8 (6-YR). SECTION 8(10-YR) 20130208.
Renewal 1ST RENEWAL 20130208
Live/Dead Indicator LIVE



Word Mark SG
Goods and Services IC 041, US 100 101 107. G & S: Entertainment services, namely, television and film production services and an on going television series about the lives and interests of various models. FIRST USE: 20060901. FIRST USE IN COMMERCE: 20060901
Mark Drawing Code (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code 02.03.01 - Busts of women facing forward; Heads of women facing forward; Portraiture of women facing forward; Women - head, portraiture or busts facing forward
02.03.17 - Pigtails; Ponytails; Women with ponytails or pigtails
02.05.01 - Busts of children; Children, heads, portraiture, busts: Heads of children
Serial Number 86157099

JP
W/MP

Filing Date January 3, 2014
Current Basis 1A
Original Filing Basis 1A
Owner (APPLICANT) SG SERVICES, INC. CORPORATION
CALIFORNIA 5482 WILSHIRE BLVD Los Angeles
CALIFORNIA 90036
Attorney of Record Jonathan Pollack, Esq.
Prior Registrations 2779128:2783766
Description of Mark Color is not claimed as a feature of the mark. The mark consists of an image of a girl above the literal elements.
Type of Mark SERVICE MARK
Register PRINCIPAL
Live/Dead Indicator LIVE



EXHIBIT 2:

US Application No. 77498645

SG

Word Mark	SG
Goods and Services	IC 043. US 100 101. G & S: Nightclub services: nightclub entertainment services; adult entertainment services. FIRST USE: 19870101. FIRST USE IN COMMERCE: 19870101
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	77498645
Filing Date	June 13, 2008
Current Basis	1A
Original Filing Basis	1A
Owner	(APPLICANT) PETER. MICHAEL J. INDIVIDUAL UNITED STATES 2301 Delmar Place Fort Lauderdale FLORIDA 33301
Attorney of Record	DANIEL S. POLLEY, ESQ.
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

