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

Proceeding	92056958
Party	Defendant Felix Dennis
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Date	05/13/2014
Attachments	PROSPER - Request to Amend Registration and Suspension 92056958.pdf(154387 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Prosper, Inc.,)	
)	Cancellation No. 92056958
Petitioner,)	
)	Mark: PROSPER
v.)	
)	Registration No.: 4,123,910
Felix Dennis,)	
)	Registration Date: April 10, 2012
Registrant.)	
_____)	

REQUEST TO AMEND REGISTRATION AND SUSPENSION

Registrant, Felix Dennis, requests that the Board enter the following amendment to Registration No. 4,123,910. Petitioner, Prosper, Inc., consents to this amendment, pursuant to the attached Consent and Coexistence Agreement by and between Petitioner and Registrant (the “Agreement”):

“Downloadable electronic publications, namely, magazines, newspapers, newsletters, and periodicals, all in the field of financial information; all excluding teaching and course material for use in relation to business and investing training” in cl. 9;

“Magazines, newspapers, newsletters, and periodicals, all in the field of financial information; all excluding publications in the field of education and training regarding business and investing” in cl. 16;

“Publication of magazines, newspapers, newsletters, periodicals, and electronic magazines; all excluding educational, personal coaching and teaching services in the fields of business and investing” in cl. 41.

As the Petitioner and Registrant have executed the Agreement, Registrant requests that this proceeding be suspended for 60 days to allow the Board to effect the foregoing amendment

and Petitioner to withdraw the Cancellation Action. The parties request that the new dates be reset as follows:

Defendant's Pretrial Disclosures :	07/15/2014
Defendant's 30-day Trial Period Ends :	08/29/2014
Plaintiff's Rebuttal Disclosures :	09/13/2014
Plaintiff's 15-day Rebuttal Period Ends :	10/13/2014

In lieu of the foregoing suspension, Registrant welcomes the Board's guidance regarding other ways to dismiss the Cancellation Action prior to the expiration of the current suspension on May 15, 2014.

Felix Dennis

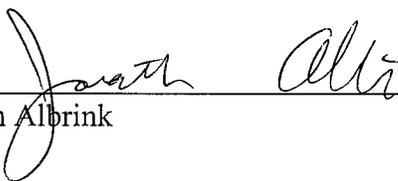
By its Attorneys,

/mhuq/ Date: May 13, 2014
Muzamil Huq
PRYOR CASHMAN LLP
7 Times Square
New York, NY 10036-6569
(212) 421-4100

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing REQUEST TO AMEND REGISTRATION AND SUSPENSION was served upon Petitioner by First Class Mail, postage pre-paid, this 13th day of May 2014:

RICHARD L HILL
HILL JOHNSON & SCHMUTZ
4844 NORTH 300 WEST , SUITE 300
PROVO, UT 84604



Jonathan Albrink

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CONSENT AND COEXISTENCE AGREEMENT

Honorable Commissioner of Trademarks
P.O. Box 1541
Alexandria, Virginia 22313

Re: Trademark Registration No. 4,123,910 and Cancellation Proceeding 92056958

The following is a Consent and Coexistence Agreement (“Consent Agreement”) by and between FELIX DENNIS (“Dennis”) an individual having a business address at 2nd Floor, 9-11, Kingly Street, London, United Kingdom W1B5PN; and PROSPER, INC. (“Prosper”), a Utah corporation, having offices at 5252 N. Edgewood Drive, Suite 150, Provo, UT 84604.

1. Background.

1.1 Dennis owns Trademark Registration No. 4,123,910 for the mark PROSPER in classes 9, 16 and 41 (the “Dennis Registration”). The descriptions of the goods and services for the Dennis Registration are given in Exhibit A, attached hereto and incorporated herein.

1.2 Prosper owns ten trademark registrations for the mark PROSPER, and variations thereof in classes 9, 16 and 41 (the “Prosper Registrations”) and three Trademark Applications for PROSPERING, Application Ser. Nos. 85/481719, 85/481784 and 85/481895, filed November 28, 2011 (the “Prosper Applications”). The descriptions of the goods and services for the Prosper Registrations and Prosper Applications are given in Exhibit B, attached hereto and incorporated herein.

1.3 The Patent and Trademark Office (“PTO”) has cited the Dennis Registration against the Prosper Applications. In response, Prosper has filed a cancellation proceeding under No. 92056958 to cancel the Dennis Registration (“Cancellation”).

1.4 Pursuant to discussions between Prosper and Dennis (“the Parties”), each of the Parties hereby consents to the other Party’s concurrent use and registration of its respective marks with respect to their respective goods and services, stated in their respective registrations and applications, pursuant to the conditions set forth herein.

2. Revision of Goods and Services in Dennis Registration.

2.1 Dennis agrees to revise the description of its goods and services for the Dennis Registration to the following descriptions (the “Amended Descriptions of Goods and Services of the Dennis Registration”):

2.2 Class 9 – “Downloadable electronic publications, namely, magazines, newspapers, newsletters, and periodicals, all in the field of financial information; all excluding teaching and course material for use in relation to business and investing training.”

2.3 Class 16 - “Magazines, newspapers, newsletters, and periodicals, all in the field of financial information; all excluding publications in the field of education and training regarding business and investing.”

2.4 Class 41 - “Publication of magazines, newspapers, newsletters, periodicals, and electronic magazines; all excluding educational, personal coaching and teaching services in the fields of business and investing.”

3. Mutual Consents to Respective Trademark Uses.

3.1 Prosper consents to Dennis’s continued use of the trademark PROSPER in connection with the Amended Descriptions of Goods and Services of the Dennis Registration stated above and agrees not to seek cancellation of the Dennis Registration with the Amended Descriptions of Goods and Services.

3.2 Dennis consents to Prosper's continued use of the trademark PROSPER in connection with the goods and services described in the Prosper Registrations and Prosper Applications, as shown in Exhibit B herein. Dennis agrees to not oppose any of the Prosper Applications, to not seek cancellation of the registrations resulting from the Prosper Applications, and to not seek cancellation of any of the Prosper Registrations.

4. **No Confusion or Likelihood of Confusion.**

4.1 Dennis represents and warrants that he is unaware of any confusion as a result of the Parties' concurrent use of their respective trademarks with their respective goods and services for over three years in commerce in the United States.

4.2 Prosper represents and warrants that it is unaware of any confusion as a result of the Parties' concurrent use of their respective trademarks with their respective goods and services for over three years in commerce in the United States.

4.3 The basis for this consent and agreement to coexist is Dennis's and Prosper's mutual determination that there is no likelihood that consumers have been or will be confused by the concurrent use of the two marks as used and detailed under the terms set forth above. This is supported by the fact that the Parties' goods are totally different, are not competitive, do not overlap, and have no relationship whatsoever and that the Parties have coexisted within the marketplace without any instances of confusion among the purchasing public for a number of years.

5. **Mutual Cooperation to Avoid Confusion.**

5.1 The Parties agree to continue taking reasonable action to prevent any confusion due to the coexistence and registration of their respective trademarks, to notify each other of any incidences of actual confusion of which they became aware, and to take reasonable action to correct such confusion.

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5.2 In the event that either Party becomes aware of any actual confusion or mistake occurring as a result of the Parties' concurrent use of their respective trademarks, each Party agrees to communicate all details of each such instance to the other Party within a reasonable time of discovery thereof, and to cooperate reasonably to take steps to abate the cause of confusion or mistake by making such changes necessary so as to prevent any such confusion or mistake from arising again.

5.3 The Parties agree to cooperate with one another so as to effectuate the terms of this Agreement, including the registration and/or continued registration of each of the Parties' respective trademarks.

6. Conclusion.

6.1 In view of the differences in the respective goods, the absence of any confusion among the purchasing public, and the other factors noted above, both Parties agree to the terms of this Consent Agreement by signing, dating, and returning it to Prosper for filing with the Commissioner of Trademarks.

6.2 This Agreement is subject to Rule 408 of the Federal Rules of Evidence and is not admissible in this Cancellation Action except for settlement purposes, and is also not admissible in any litigation between the parties. This Agreement is contingent on a preliminary condition that the Examining Attorney (a) withdraws the objections to the registration of the Prosper Applications, and (b) the Prosper Applications are published in the Official Gazette. In such case, Prosper agrees to file a dismissal with prejudice of this Cancellation proceeding within ten (10) days after such publication.

6.3 This Consent Agreement may be executed in any number of counterparts (including, without limitation, by facsimile), each of which shall be deemed an original and which together shall constitute one agreement.

6.4 The Parties agree that this Consent Agreement and the terms embodied therein shall be kept confidential by the Parties and shall not be disclosed except as may be required by law.

6.5 This Consent Agreement shall remain in effect for as long as both Parties have registered rights in PROSPER-formative marks

6.6 This Consent Agreement shall be governed by the laws of the State of New York, without giving effect to its laws concerning conflicts of law.

IN WITNESS WHEREOF, the Parties have signed this Agreement, individually or by their duly authorized officers or representatives, effective as of the following Effective Date:

Effective Date: Feb 13, 2014

FELIX DENNIS

Signature: 

Date: 22nd April 2014

PROSPER, INC.

Signature: 

Title: CEO

Date: 2/13/14