IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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|---|---|
| In the Matter of Ser. No. 74673508, Reg. No. 1929015, and Reg. No. 1854765<br><br>The Harris Soup Company,<br><br>Applicant,<br><br>v.<br><br>Whole Foods Market IP, L.P.,<br><br>Registrant. | Concurrent Use Proceeding No. 94001242 |

**STIPULATED MOTION FOR DISMISSAL OF PROCEEDING AND REMAND OR OTHER DISPOSITION**

Pursuant to TBMP 605.03(c), the parties respectfully request that this proceeding be dismissed as moot in light of the fact that they have reached an agreement acknowledging that the marks at issue in this proceeding, as used, are not likely to cause confusion and in which they have agreed to continued use by each party of that particular party's marks subject to certain non-geographic conditions. A copy of the parties' Consent Agreement is attached hereto and made a part hereof by this reference.

The Agreement is an outgrowth of the parties' experience over the last five years (since Applicant initially filed its concurrent use amendment) with the actual use by the other of the marks at issue in this proceeding. It sets out the basis for the parties' belief and stipulation that there is no likelihood of confusion as a result of the historical and expected future use of their respective marks and the steps they will take to avoid any possible confusion in the future.

As a consequence, there is no need for this matter to proceed at this time. Harris withdraws its amendment for a concurrent use application subject to approval of the Trademark Trial & Appeal Board pursuant to 37 C.F.R. § 2.133(a), and both parties respectfully request that this proceeding be dismissed and that Harris' Application Ser. No. 74673508 for its uniquely styled "Harry's" mark,

07-17-2006

U.S. Patent & TMOfc/TM Mail Rcpt Dt #2

which was otherwise found acceptable for registration and which was published for opposition on March 12, 2002, be remanded for further proceedings consistent with the parties' Consent Agreement or allowed by the Board.

Respectfully submitted,

ESLER STEPHENS & BUCKLEY

By: Michael J Esler
Michael J. Esler
Of Attorneys for Applicant
Date: 7/12/06

TROP PRUNER & HU, PC

By: _____
Christopher L. Graff
Of Attorneys for Registrant
Date: 7/6/2006

**CERTIFICATE OF MAILING**

I hereby certify that this Stipulated Motion for Dismissal of Proceeding and Remand or Other Disposition and Consent Agreement are being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

U.S. Patent and Trademark Office
Trademark Trial & Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

on July 12, 2006. Note: Also filed electronically on July 12, 2006.

Gary Hardiman
Signature

GARY HARDIMAN
Printed Name

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## TRADEMARK CONSENT AGREEMENT

This Trademark Consent Agreement (hereinafter the "**Agreement**") is made and entered into by and among the following parties (hereinafter referred to as the "**Parties**"):

(i) The Harris Soup Company, an Oregon corporation having a business address of 17711 NE Riverside Parkway, Portland, Oregon 97230 (hereinafter referred to as "**Harris**"); and

(ii) Whole Foods Market IP, LP, a Delaware limited partnership having a business address of 550 Bowie Street, 6th Floor, Austin, Texas 78703, (hereinafter referred to as "**Whole Foods**").

**WHEREAS**, Whole Foods is the owner of several marks that feature the term "HARRY'S," including the marks that are the subject of the following applications and registrations (hereinafter collectively the "**Whole Foods HARRY'S Marks**"). For purposes of this Agreement, the goods and services listed in the following applications and registrations for the Whole Foods HARRY'S Marks shall be referred to collectively as the "**Whole Foods Goods and Services**":

(i) U.S. Reg. No. 1,929,015 for the mark HARRY'S (stylized), a copy of which is attached as **Exhibit A**, that covers the following goods and services:

International Class 29: meats and cheese.

International Class 30: staple foods, namely breads, pastries, pizza, pasta.

International Class 31: Ready-to-eat salads consisting of fresh fruits and vegetables.

International Class 42: retail specialty grocery, meat and produce store services.

(ii) U.S. Reg. No. 1,854,765 for the mark HARRY'S FARMERS MARKET and Design, a copy of which is attached as **Exhibit B**, that covers the following goods and services:

International Class 29: ready-to-heat, ready-to-cook, and ready-to-eat entrees consisting of fish, seafood, poultry, meats and cheese.

International Class 30: staple foods, namely breads, pastries, pizza, pasta.

International Class 31: ready-to-eat salads consisting of fresh fruits and vegetables.

International Class 42: retail specialty grocery, meat and produce services.

(iii) U.S. Trademark Application Serial No. 75/299,282 (hereinafter, the "**Whole Foods Application**") for the mark HARRY'S FARMERS MARKET, that covers the following goods and services:

International Class 29: fresh fish, seafood, poultry and meats; ready-to-heat, ready-to-cook and ready-to-eat entrees consisting of fish, seafood, poultry, meats and cheese, and ready-to-eat salads consisting of fresh fruits and vegetables.

International Class 30: staple foods, namely, breads, pastries, pizza, pasta, dried spices and coffee.

International Class 31: fresh fruits and vegetables.

International Class 35: retail specialty grocery, meat and produce services.

(iv) The following Georgia State Trademark Registrations:

| Mark | No. | Goods/Services |
|---|---|---|
| HARRY'S FARMERS MARKET | T-9603 | Foods and ingredients of foods. |
| HARRY'S FARMERS MARKET | T-9602 | Foods and ingredients of foods. |
| HARRY'S FARMERS MARKET | S-9819 | Retail business services. |

**WHEREAS**, Harris has adopted and uses the mark "HARRY'S and Design (hereinafter, the "**Harris Mark**"), a copy of which is attached as **Exhibit C**, in connection with chili; chowder; packaged entrees consisting primarily of prepared meat, poultry, and vegetables; soup mixes; sauces, namely barbecue, cheese, spaghetti, teriyaki, sweet-and-sour, alfredo, and enchilada; salsa; packaged entrees consisting primarily of prepared pasta or rice; gravy; macaroni and cheese; puddings; ravioli; spaghetti and meatballs; tapioca; and tomato sauce (hereinafter collectively the "**Harris Goods**");

**WHEREAS**, Harris is the owner of U.S. Trademark Application Serial No. 74/673,508 (hereinafter, the "**Harris Application**") for the Harris Mark, which currently recites the foregoing Harris Goods.

**WHEREAS**, the U.S. Patent & Trademark Office has refused registration of the mark shown in the Harris Application on the basis of likelihood of confusion with the marks shown in U.S. Reg. Nos. 1,854,765 and 1,929,015 under 15 U.S.C. § 1052(d);

**WHEREAS**, the U.S. Patent & Trademark Office has suspended action on the Whole Foods Application pending disposition of the Harris Application;

**WHEREAS**, the Parties recognize the validity of each other's use and registration of their respective marks in connection with their respective goods and services and wish to avoid any conflict with the other's use or registration of its marks;

**WHEREAS**, the Parties are not aware of any actual confusion between the respective uses of the respective marks in the marketplace;

**WHEREAS**, the Parties have concluded that confusion is not likely to arise from their use and registration of their respective marks in connection with their respective goods and services as set forth herein due to the significant differences in the stylized presentations of the Parties' respective marks, the differences in the Parties' respective goods and services and the different channels of trade in which those goods and services travel, the fact that there are a number of third-party marks which are similar to the Parties' respective marks such that the public has become sophisticated in distinguishing them, and the fact that to the best of the Parties' knowledge, their marks have coexisted for several years without any instance of consumer confusion;

**WHEREAS**, the Parties wish to work together to avoid any such confusion in the future and to dispel any such confusion should it arise; and

**WHEREAS**, the Parties desire to resolve their concerns amicably without the need for further litigation or proceedings before the Trademark Trial and Appeal Board.

**NOW, THEREFORE**, in consideration of the mutual promises set forth herein and for other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the Parties agree as follows:

1. Whole Foods represents and warrants that it has all necessary power and authority to execute this Agreement, to consummate the transactions contemplated hereby, and to carry out all obligations under this Agreement. Whole Foods further represents and warrants that it is the owner of U.S. Reg. Nos. 1,854,765 and 1,929,015, and the Whole Foods Application.

2. Harris represents and warrants that it has all necessary power and authority to execute this Agreement, to consummate the transactions contemplated hereby, and to carry out all obligations under this Agreement. Harris further represents and warrants that it is the owner of the Harris Application.

3. In order to preclude or minimize any possibility of confusion between the Parties' respective marks, the Parties agree to the following:

   3.1. Harris agrees that it will not use or register (or assist, encourage, or induce others to do so) the Harris Mark except in connection with the Harris Goods. Harris further agrees that it will always use and depict the Harris Mark in the particular stylization and design as set forth in the drawing page of the Harris Application,

and in no event shall Harris use any design or design elements confusingly similar to those of any of the Whole Foods HARRY'S Marks.

3.2. Whole Foods agrees that it will not use or register (or assist, encourage, or induce others to do so), any of the Whole Foods HARRY'S Marks except in connection with the Whole Foods Goods and Services. Whole Foods further agrees that it will not use any design or design elements confusingly similar to those of the Harris Mark in connection with its use of the Whole Foods HARRY'S Marks.

3.3. Subject to Harris' compliance with this Agreement, Whole Foods consents to the use and registration of the Harris Mark by Harris on or in connection with the Harris Goods consistent with this Agreement, and Whole Foods will refrain from taking any action or proceedings, legal or otherwise, which will hinder Harris in the free and unfettered use of the Harris Mark consistent with this Agreement, and will not contend that such use conflicts with any rights possessed by Whole Foods.

3.4. Subject to Whole Foods' compliance with this Agreement, Harris consents to the use and registration of the Whole Foods HARRY'S Marks by Whole Foods on or in connection with the Whole Foods Goods and Services consistent with this Agreement, and Harris will refrain from taking any action or proceedings, legal or otherwise, which will hinder Whole Foods in the free and unfettered use of the Whole Foods HARRY'S Marks consistent with this Agreement, and will not contend that such use conflicts with any rights possessed by Harris.

4. Neither party will in any way represent itself nor its goods or services as being connected with, sponsored by, or approved by, the other party. In the unlikely event that a party receives a misplaced consumer or customer inquiry regarding the other party's goods and/or services, such party will properly direct the consumer or customer to the correct party.

5. If any of Whole Foods' applications or registrations for the Whole Foods HARRY'S Marks are cited by an examiner or registrar as a bar to the registration of an application by Harris (or its subsidiaries or affiliates) for the Harris Mark in connection with the Harris Goods consistent with this Agreement, then Whole Foods will use reasonable efforts to assist Harris (or its subsidiaries or affiliates) to obtain such registration, including, without limitation, by providing Whole Foods' written consent to use and registration.

6. If any of Harris applications or registrations for the Harris Mark are cited by an examiner or registrar as a bar to the registration of an application by Whole Foods (or its subsidiaries or affiliates) for any of the Whole Foods HARRY'S Marks in connection with the Whole Foods Goods and Services consistent with this Agreement, then Harris will use reasonable efforts to assist Whole Foods (or its subsidiaries or affiliates) to obtain such registration, including, without limitation, by providing Harris' written consent to use and registration.

7. The trademark rights referred to herein may be licensed by either party without the other's consent, provided that such license is in compliance with the terms of this Agreement. With the exception of an assignment of substantially the entire business and goodwill of Harris, this Agreement shall not be assignable by Harris without the written consent of Whole Foods, which consent shall not be unreasonably withheld. This Agreement shall be binding upon the licensees, successors, heirs and assigns, as permitted herein, of the Parties.

8. The failure of either party to enforce at any time any of the provisions of this Agreement shall in no way be construed to be a waiver of such provision, or in any way affect the validity of this Agreement or any part thereof, or the right of such party thereafter to enforce each and every provision.

9. The Parties intend to be bound by the terms of this Agreement, and the Parties agree that it is in their respective commercial interests to be so bound. Each of the Parties represents to the other that this Agreement has been duly authorized by all necessary corporate action.

10. This Agreement may not be amended or modified, nor may any of its provisions be waived, except by a formal written instrument expressly referencing this Agreement and the modification thereto, signed by an authorized officer or agent of each of the Parties.

11. This Agreement will bind and inure to the benefit of the successors and assigns (as permitted herein) of each party, and contains the entire agreement of the Parties with respect to the subject matter hereof.

**IN WITNESS WHEREOF**, the Parties have caused this agreement to be executed in duplicate originals, each of which is deemed an original for all purposes, as of the day and year indicated.

**THE HARRIS SOUP COMPANY**

By: Lori Hendren
Name: LORI HENDREN
Title: V.P. Administration
Date: 7/6/06

**WHOLE FOODS MARKET IP, L.P.**

By: [signature]
Name: Roberta Lang
Title: President
Date: 7-5-06

# Exhibit A

Int. Cls.: 29, 30, 31 and 42

Prior U.S. Cls.: 46, 100 and 101

Reg. No. 1,929,015

# United States Patent and Trademark Office

Registered Oct. 24, 1995

## TRADEMARK
## SERVICE MARK
## PRINCIPAL REGISTER

Harry's

HARRY'S FARMERS MARKET, INC. (GEORGIA CORPORATION)
1180 UPPER HEMBREE ROAD
ROSWELL, GA 30076

FOR: FRESH FISH, SEAFOOD, POULTRY, MEATS AND CHEESE, IN CLASS 29 (U.S. CL. 46).

FIRST USE 7-1-1988; IN COMMERCE 7-1-1988.

FOR: STAPLE FOODS, NAMELY BREADS, PASTRIES, PIZZA, PASTA, DRIED SPICES AND COFFEE, IN CLASS 30 (U.S. CL. 46).

FIRST USE 7-1-1988; IN COMMERCE 7-1-1988.

FOR: FRESH FRUITS AND VEGETABLES AND READY-TO-EAT SALADS CONSISTING OF FRESH FRUITS AND VEGETABLES, IN CLASS 31 (U.S. CL. 46).

FIRST USE 7-1-1988; IN COMMERCE 7-1-1988.

FOR: RETAIL SPECIALTY GROCERY, MEAT AND PRODUCE STORE SERVICES, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 7-1-1988; IN COMMERCE 7-1-1988.

SER. NO. 74-444,333, FILED 10-6-1993.

PRISCILLA MILTON, EXAMINING ATTORNEY

# Exhibit B

Int. Cls.: 29, 30, 31 and 42

Prior U.S. Cls.: 46 and 101

# United States Patent and Trademark Office

Reg. No. 1,854,765
Registered Sep. 20, 1994

## TRADEMARK
## SERVICE MARK
## PRINCIPAL REGISTER

Harry's
FARMERS MARKET

HARRY'S FARMERS MARKET, INC. (GEORGIA CORPORATION)
1180 UPPER HEMBREE ROAD
ROSWELL, GA 30076

FOR: FRESH FISH, SEAFOOD, POULTRY, AND MEATS; READY-TO-HEAT, READY-TO-COOK AND READY-TO-EAT ENTREES CONSISTING OF FISH, SEAFOOD, POULTRY, MEATS AND CHEESE, IN CLASS 29 (U.S. CL. 46).

FIRST USE 7-1-1988; IN COMMERCE 7-1-1988.

FOR: STAPLE FOODS; NAMELY, BREADS, PASTRIES, PIZZA, PASTA, DRIED SPICES, AND COFFEE, IN CLASS 30 (U.S. CL. 46).

FIRST USE 7-1-1988; IN COMMERCE 7-1-1988.

FOR: FRESH FRUITS AND VEGETABLES, AND READY-TO-EAT SALADS CONSISTING OF FRESH FRUITS AND VEGETABLES, IN CLASS 31 (U.S. CL. 46).

FIRST USE 7-1-1988; IN COMMERCE 7-1-1988.

FOR: RETAIL SPECIALTY GROCERY, MEAT AND PRODUCE SERVICES, IN CLASS 42 (U.S. CL. 101).

FIRST USE 7-1-1988; IN COMMERCE 7-1-1988.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "FARMERS MARKET", APART FROM THE MARK AS SHOWN.

SER. NO. 74-444,332, FILED 10-6-1993.

PRISCILLA MILTON, EXAMINING ATTORNEY

# Exhibit C

74673508

APPLICANT: The Harris Soup Company, Inc. an Oregon corporation
14370 S.W. Rochester
Beaverton, Oregon 97005

FIRST USE IN COMMERCE: At least 04/01/86

GOODRICH MAILROOM
TRADEMARK REC'D
MAY 15 1995
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US PATENT & TRADEMARK OFFICE

International Class 29: Chili; chowder; packaged entrees consisting primarily of prepared meat, poultry and vegetables; and soup mixes.

International Class 30: Sauces, namely barbecue, cheese, spaghetti, teriyaki, sweet-and-sour, alfredo, and enchilada; packaged entrees consisting primarily of prepared pasta or rice; gravy; macaroni and cheese; puddings; ravioli; spaghetti and meatballs; tapioca; and tomato sauce.

INT. CL. 29
PRIOR U.S. CL. 46

INT. CL. 30
PRIOR U.S. CL. 46

Harry's

PUBLISHED
03/12/02

## CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of STIPULATED MOTION FOR DISMISSAL OF PROCEEDING AND REMAND OR OTHER DISPOSITION, and CONSENT AGREEMENT has been served on the following counsel of record by depositing a copy in the United States Mail, postage prepaid, on this 12th day of July, 2006:

Christopher L. Graff, Esq.
Trop, Pruner & Hu, P.C.
7718 Wood Hollow Drive, Suite G-50
Austin, Texas 78731

Michael J. Esler