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Filing date: **06/25/2013**

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

Proceeding	94002566
Party	Applicant John W. Hill, III
Correspondence Address	KARL S SAWYER JR K & L GATES LLP 214 NORTH TYRON ST HEARST TOWER 47TH FLOOR CHARLOTTE, NC 28233-3144 UNITED STATES karl.sawyer@klgates.com, donna.millard@klgates.com, ttablitigationdocket@klgates.com
Submission	Other Motions/Papers
Filer's Name	Karl S. Sawyer, Jr.
Filer's e-mail	karl.sawyer@klgates.com, donna.millard@klgates.com, cooley@capessokol.com, ttablitigationdocket@klgates.com
Signature	/ Karl S. Sawyer, Jr. /
Date	06/25/2013
Attachments	ResponseConcurrentUse 94002566.pdf(23970 bytes) Settlement and Release Agreement.PDF(2133499 bytes)

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

In re:

John W. Hill, III	)	
	)	
v.	)	**Concurrent Use No. 94002566**
	)	
Jamat, LLC d/b/a/ Mattress Source	)	
	)	

RESPONSE

In response to the Board's communication mailed June 12, 2013, the applicant, John W. Hill III, submits herewith a copy of the settlement agreement between applicant and opposer, as required in the Board's communication. Favorable consideration is respectfully requested.

Respectfully submitted,

Karl S. Sawyer, Jr.
K&L Gates LLP
Post Office Box 33144
Charlotte, North Carolina 28233
Telephone: (704) 331 5792
Fax: (704) 353 3692
Email: karl.sawyer@klgates.com

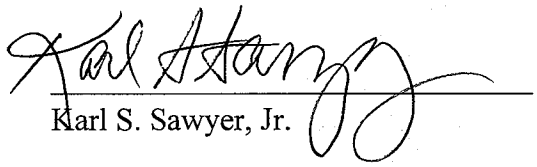
- Attorney for Applicant

CERTIFICATE OF SERVICE

I hereby certify that on this date I served a copy of the foregoing **Response and Copy of Settlement and Release Agreement** by placing said copy in the U.S. mail, first class, postage prepaid, addressed as follows:

Drey A. Cooley, Esq.
Capes, Sokol, Goodman & Surachan, P.C.
7701 Forsyth Boulevard, 12th Floor
St. Louis, MO 63105

This the 25th day of June, 2013.



Karl S. Sawyer, Jr.

SETTLEMENT AND RELEASE AGREEMENT

This Settlement and Release Agreement (hereinafter, the "Agreement") is entered into as of this 30 day of November 2012, by and between Jamat, LLC d/b/a/ Mattress Source ("Mattress Source Missouri/Illinois"), The Mattress Source, Inc. ("Mattress Source Michigan"), John W. Hill III ("Mattress Source North Carolina/South Carolina") and Mattress Source, Inc. ("Mattress Source, Inc./NCSC") all of whom shall hereinafter collectively be referred to as the "Parties" and, where necessary, individually, "Party."

WHEREAS, Mattress Source North Carolina/South Carolina holds a geographically unrestricted trademark for the mark "Mattress Source of America," filed on February 1, 2001, Serial No. 76204103, which was registered on June 3, 2003 as U.S. Registration No. 2,722,773 ("Mattress Source of America Trademark"); and

WHEREAS, Mattress Source North Carolina/South Carolina filed an application for a geographically unrestricted trademark for the mark "Mattress Source" on June 22, 2011, Serial No. 85352473 ("North Carolina/South Carolina Application"), which was published for opposition on December 13, 2011; and

WHEREAS, Mattress Source North Carolina/South Carolina warrants and represents that he is the present owner of the "Mattress Source of America Trademark;" and that said trademark and Mattress Source North Carolina/South Carolina's rights to the use of the name and mark Mattress Source are exclusively licensed to and used by Mattress Source, Inc./NCSC, a North Carolina corporation, solely owned and controlled by Mattress Source North Carolina/South Carolina.

WHEREAS, Mattress Source Missouri/Illinois timely filed an Opposition to the North Carolina/South Carolina Application on May 10, 2012, Trademark Trial and Appeal Board Proceeding No. 91205101 ("Mattress Source Missouri/Illinois Opposition"); and

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WHEREAS, Mattress Source Michigan timely filed an Opposition to the North Carolina/South Carolina Application on May 10, 2012, Trademark Trial and Appeal Board Proceeding No. 91205104 ("Mattress Source Michigan Opposition"); and

WHEREAS, Mattress Source Missouri/Illinois filed an Application for Concurrent Use for use of the mark "Mattress Source" in Missouri and Illinois on May 9, 2012, Serial No. 85620807 ("Missouri/Illinois Concurrent Use Application"); and

WHEREAS, Mattress Source Michigan filed an Application for Concurrent Use for use of the design with the words "Mattress Source" in Michigan on May 10, 2012, Serial No. 85622222 ("Michigan Concurrent Use Application"); and

WHEREAS, each Party to this Agreement denies any liability arising out of any claims, transactions and matters relating to the Parties and denies any and all claims asserted by each of the Parties in all of the foregoing matters; and

WHEREAS, the Parties have arrived at mutually agreeable terms and settlement of all claims arising out of any transactions and matters, including, but not limited to, those that might or could be asserted in the future by any of the Parties with respect to ownership and the use of the name or mark "Mattress Source"; and

WHEREAS, in order to avoid the costs, hazards and risks of litigation, the Parties have agreed to fully compromise and settle said claims as between and among the Parties as set forth below; and

NOW, THEREFORE, in consideration of the mutual promises and covenants contained herein, the Parties agree as follows:

1. Conversion of North Carolina/South Carolina Application into Concurrent Use Application and Withdrawal of Oppositions. Mattress Source North Carolina/South Carolina

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shall amend the North Carolina/South Carolina Application to seek a Concurrent Use Registration citing Missouri, Illinois and Michigan as exceptions to Mattress Source North Carolina/South Carolina's use of the mark "Mattress Source" (hereinafter, the proceeding shall be referred to as the "Settlement Concurrent Use Proceeding"). Mattress Source Missouri/Illinois and Mattress Source Michigan shall subsequently withdraw their respective Opposition filings (the Mattress Source Missouri/Illinois Opposition and Mattress Source Michigan Opposition, respectively) without prejudice in favor of Mattress Source North Carolina/South Carolina's Settlement Concurrent Use Proceeding. Each Party shall bear its/his own costs in the Settlement Concurrent Use Proceeding.

2. Missouri/Illinois Concurrent Use Application. Should Mattress Source Missouri/Illinois desire to proceed with its Missouri/Illinois Concurrent Use Application, the Parties shall execute a joint request to consolidate the Missouri/Illinois Concurrent Use Application into the Settlement Concurrent Use Proceeding. Mattress Source North Carolina/South Carolina and Mattress Source Michigan shall consent to the Missouri/Illinois Concurrent Use Application and to Mattress Source Missouri/Illinois's ownership of and right to use the name or mark "Mattress Source" in Missouri and Illinois.

3. Michigan Concurrent Use Application. Should Mattress Source Michigan desire to proceed with its Michigan Concurrent Use Application, the Parties shall execute a joint request to consolidate the Michigan Concurrent Use Application into the Settlement Concurrent Use Proceeding. Mattress Source North Carolina/South Carolina and Mattress Source Missouri/Illinois shall consent to the Michigan Concurrent Use Application and to Mattress Source Michigan's ownership of and right to use the name or mark "Mattress Source" in Michigan.

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4. Ownership of and Right to Use "Mattress Source" trademark outside of Missouri, Illinois, and Michigan. Mattress Source Missouri/Illinois and Mattress Source Michigan warrant and represent that Mattress Source North Carolina/South Carolina owns and may use the "Mattress Source" trademark or name throughout the remainder of the United States outside of Michigan, Illinois and Missouri. Such warranty and representation shall not be affected by and shall exist notwithstanding any outcome (including, but not limited to, whether or not the "Mattress Source" mark is eventually registered by any Party) of the North Carolina/South Carolina Application, Mattress Source Missouri/Illinois Opposition, Mattress Source Michigan Opposition, Missouri/Illinois Concurrent Use Application, Michigan Concurrent Use Application, Settlement Concurrent Use Proceeding or the ability to consolidate the Missouri/Illinois Concurrent Use Application or Michigan Concurrent Use Application with the Settlement Concurrent Use Proceeding.

5. Ownership of and Right to Use "Mattress Source" trademark in Missouri and Illinois. Mattress Source North Carolina/South Carolina and Mattress Source Michigan warrant and represent that Mattress Source Missouri/Illinois owns and may use the "Mattress Source" trademark or name in Missouri and Illinois. Such warranty and representation shall not be affected by and shall exist notwithstanding any outcome (including, but not limited to, whether or not the "Mattress Source" mark is eventually registered by any Party) of the North Carolina/South Carolina Application, Mattress Source Missouri/Illinois Opposition, Mattress Source Michigan Opposition, Missouri/Illinois Concurrent Use Application, Michigan Concurrent Use Application, Settlement Concurrent Use Proceeding or the ability to consolidate the Missouri/Illinois Concurrent Use Application or Michigan Concurrent Use Application with the Settlement Concurrent Use Proceeding.

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6. Ownership of and Right to Use "Mattress Source" trademark in Michigan. Mattress Source North Carolina/South Carolina and Mattress Source Missouri/Illinois warrant and represent that Mattress Source Michigan owns and may use the "Mattress Source" trademark or name in Michigan. Such warranty and representation shall not be affected by and shall exist notwithstanding any outcome (including, but not limited to, whether or not the "Mattress Source" mark is eventually registered by any Party) of the North Carolina/South Carolina Application, Mattress Source Missouri/Illinois Opposition, Mattress Source Michigan Opposition, Missouri/Illinois Concurrent Use Application, Michigan Concurrent Use Application, Settlement Concurrent Use Proceeding or the ability to consolidate the Missouri/Illinois Concurrent Use Application or Michigan Concurrent Use Application with the Settlement Concurrent Use Proceeding.

7. Marketing and Advertising.

a. Representations

i. Mattress Source Missouri/Illinois shall not make any express or implied representation, in which the mark "Mattress Source" is used, that it operates outside of Illinois or Missouri.

ii. Mattress Source Michigan shall not make any express or implied representation, in which the mark "Mattress Source" is used, that it operates outside of Michigan.

iii. Mattress Source North Carolina/South Carolina shall not make any express or implied representation, in which the mark "Mattress Source" is used, that it operates in Missouri, Illinois or Michigan.

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b. Advertising.

i. Mattress Source Missouri/Illinois shall not conduct any advertising, in which the mark "Mattress Source" is used, that makes any express or implied representation that Mattress Source Missouri/Illinois operates outside of Missouri or Illinois. Nothing in this Agreement shall prevent Mattress Source Missouri/Illinois from processing orders from individuals or entities located outside of Missouri or Illinois or shipping goods outside of Missouri or Illinois under the name or mark "Mattress Source," provided Mattress Source Missouri/Illinois complies with the terms of this Agreement.

ii. Mattress Source Michigan shall not conduct any advertising, in which the mark "Mattress Source" is used, that makes any express or implied representation that Mattress Source Michigan operates outside of Michigan. Nothing in this Agreement shall prevent Mattress Source Michigan from processing orders from individuals or entities located outside of Michigan or shipping goods outside of Michigan under the name or mark "Mattress Source," provided Mattress Source Michigan complies with the terms of this Agreement.

iii. Mattress Source North Carolina/South Carolina shall not conduct any advertising, in which the mark "Mattress Source" is used, that makes any express or implied representation that Mattress Source North Carolina/South Carolina operates inside Missouri, Illinois or Michigan. Nothing in this Agreement shall prevent Mattress Source North Carolina/South Carolina from processing orders from individuals or entities located inside of Missouri, Illinois or Michigan or shipping goods inside of Missouri, Illinois, or Michigan under the name or mark "Mattress Source," provided Mattress Source North Carolina/South Carolina complies with the terms of this Agreement.

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iv. Nothing in this Agreement shall prohibit any Party from advertising on the Internet, in which the name or mark "Mattress Source" is used, provided such advertising complies with the terms of this Agreement. Nothing in this Agreement shall prohibit any Party from listing its website in any internet search engine or directory, provided such advertising complies with the terms of this Agreement.

v. Nothing in this Agreement shall create or place liability upon any Party as a result any advertising or publicity generated by a non-party.

c. Internet Website.

i. Mattress Source Missouri/Illinois shall have the right to maintain an Internet Website, provided that such Party's website does not state or suggest that the Party conducts business using or under the name or mark "Mattress Source" outside of Missouri or Illinois.

ii. Mattress Source Michigan shall have the right to maintain an Internet Website, provided that such Party's website does not state or suggest that the Party conducts business using or under the name or mark "Mattress Source" outside of Michigan.

iii. Mattress Source North Carolina/South Carolina shall have the right to maintain an Internet Website, provided that such Party's website does not state or suggest that the Party conducts business using or under the name or mark "Mattress Source" inside Missouri, Illinois or Michigan.

iv. Each Party warrants and represents that MattressSource.com, MattressSourceStl.com and MyMattressSource.com, the websites for Mattress Source North Carolina/South Carolina, Mattress Source Missouri/Illinois and Mattress Source Michigan, respectively, as of the date of this Agreement, are in compliance with the terms herein.

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d. Nothing in this Agreement shall prohibit any Party from marketing, advertising or selling any goods or services or operating any business in which the name or mark "Mattress Source" is not used.

8. No Past Assignments. Other than previously mentioned herein, the Parties warrant and represent that they have not, prior to the execution of this Agreement, assigned any claim or potential claim against another Party or licensed or assigned their right to use the mark or name "Mattress Source" to any other person or entity.

9. Mutual Releases.

a. In consideration of entering into this Agreement, and the mutual promises and obligations contained herein, Mattress Source North Carolina/South Carolina, and its heirs, assigns, predecessors, successors, agents, employees, attorneys, past, present and future officers, directors, stockholders, insurers and assigns, hereby release, remise, quit and forever discharge the other Parties, and their heirs, predecessors, successors, agents, employees, attorneys, and all past, present and future officers, directors, stockholders, insurers and assigns of and from any and all past, present or future claims, demands, obligations, actions, causes of action, rights, damages, costs, losses of services, and all expenses and compensation of any nature whatsoever, whether based on tort, contract, indemnity, contribution or other theory of recovery, and whether for compensation or punitive damages, whether known or unknown, ascertained or unascertained, that Mattress Source North Carolina/South Carolina and its/his heirs, predecessors, successors, agents, employees, attorneys, past, present and future officers, directors, stockholders, insurers and assigns, had, or may now have or may have in the future, against Mattress Source Missouri/Illinois or Mattress Source Michigan arising out of or with respect to (1) any and all claims raised or which could have been raised with respect to the North

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Carolina/South Carolina Application, Mattress Source Missouri/Illinois Opposition, Mattress Source Michigan Opposition, Missouri/Illinois Concurrent Use Application, Michigan Concurrent Use Application, and/or Settlement Concurrent Use Proceeding, and/or (2) any and all past, present and future claims related to the ownership or use of the mark or name "Mattress Source" in Missouri, Illinois and Michigan, with the exception of any claims arising out of the breach of this Agreement.

b. In consideration of entering into this Agreement, and the mutual promises and obligations contained herein, Mattress Source, Inc./NCSC, and its heirs, assigns, predecessors, successors, agents, employees, attorneys, past, present and future officers, directors, stockholders, insurers and assigns, hereby release, remise, quit and forever discharge the other Parties, and their heirs, predecessors, successors, agents, employees, attorneys, and all past, present and future officers, directors, stockholders, insurers and assigns of and from any and all past, present or future claims, demands, obligations, actions, causes of action, rights, damages, costs, losses of services, and all expenses and compensation of any nature whatsoever, whether based on tort, contract, indemnity, contribution or other theory of recovery, and whether for compensation or punitive damages, whether known or unknown, ascertained or unascertained, that Mattress Source, Inc./NCSC and its heirs, predecessors, successors, agents, employees, attorneys, past, present and future officers, directors, stockholders, insurers and assigns, had, or may now have or may have in the future, against Mattress Source Missouri/Illinois or Mattress Source Michigan arising out of or with respect to (1) any and all claims raised or which could have been raised with respect to the North Carolina/South Carolina Application, Mattress Source Missouri/Illinois Opposition, Mattress Source Michigan Opposition, Missouri/Illinois Concurrent Use Application, Michigan Concurrent Use

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Application, and/or Settlement Concurrent Use Proceeding, and/or (2) any and all past, present and future claims related to the ownership or use of the mark or name "Mattress Source" in Missouri, Illinois and Michigan, with the exception of any claims arising out of the breach of this Agreement.

c. In consideration of entering into this Agreement, and the mutual promises and obligations contained herein, Mattress Source Missouri/Illinois, and its heirs, assigns, predecessors, successors, agents, employees, attorneys, past, present and future officers, directors, stockholders, insurers and assigns, hereby release, remise, quit and forever discharge the other Parties, and their heirs, predecessors, successors, agents, employees, attorneys, and all past, present and future officers, directors, stockholders, insurers and assigns of and from any and all past, present or future claims, demands, obligations, actions, causes of action, rights, damages, costs, losses of services, and all expenses and compensation of any nature whatsoever, whether based on tort, contract, indemnity, contribution or other theory of recovery, and whether for compensation or punitive damages, whether known or unknown, ascertained or unascertained, that Mattress Source Missouri/Illinois and its/his heirs, predecessors, successors, agents, employees, attorneys, past, present and future officers, directors, stockholders, insurers and assigns, had, or may now have or may have in the future, against Mattress Source North Carolina/South Carolina or Mattress Source Michigan arising out of or with respect to (1) any and all claims raised or which could have been raised with respect to the North Carolina/South Carolina Application, Mattress Source Missouri/Illinois Opposition, Mattress Source Michigan Opposition, Missouri/Illinois Concurrent Use Application, Michigan Concurrent Use Application, and/or Settlement Concurrent Use Proceeding, and/or (2) any and all past, present and future claims related to the ownership or use of the mark or name "Mattress Source" outside

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of Missouri or Illinois, with the exception of any claims arising out of the breach of this Agreement.

d. In consideration of entering into this Agreement, and the mutual promises and obligations contained herein, Mattress Source Michigan, and its heirs, assigns, predecessors, successors, agents, employees, attorneys, past, present and future officers, directors, stockholders, insurers and assigns, hereby release, remise, quit and forever discharge the other Parties, and their heirs, predecessors, successors, agents, employees, attorneys, and all past, present and future officers, directors, stockholders, insurers and assigns of and from any and all past, present or future claims, demands, obligations, actions, causes of action, rights, damages, costs, losses of services, and all expenses and compensation of any nature whatsoever, whether based on tort, contract, indemnity, contribution or other theory of recovery, and whether for compensation or punitive damages, whether known or unknown, ascertained or unascertained, that Mattress Source Michigan and its/his heirs, predecessors, successors, agents, employees, attorneys, past, present and future officers, directors, stockholders, insurers and assigns, had, or may now have or may have in the future, against Mattress Source Missouri/Illinois or Mattress Source North Carolina/South Carolina arising out of or with respect to (1) any and all claims raised or which could have been raised with respect to the North Carolina/South Carolina Application, Mattress Source Missouri/Illinois Opposition, Mattress Source Michigan Opposition, Missouri/Illinois Concurrent Use Application, Michigan Concurrent Use Application, and/or Settlement Concurrent Use Proceeding, and/or (2) any and all past, present and future claims related to the ownership or use of the mark or name "Mattress Source" outside of Michigan, with the exception of any claims arising out of the breach of this Agreement.

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e. Each of the releases provided for in Paragraphs 10(a)-(d) shall not be affected by and shall remain in full force and effect notwithstanding any outcome (including, but not limited to, whether or not the "Mattress Source" mark is registered by any Party) of the North Carolina/South Carolina Application, Mattress Source Missouri/Illinois Opposition, Mattress Source Michigan Opposition, Missouri/Illinois Concurrent Use Application, Michigan Concurrent Use Application, Settlement Concurrent Use Proceeding or the ability to consolidate the Missouri/Illinois Concurrent Use Application or Michigan Concurrent Use Application with the Settlement Concurrent Use Proceeding.

10. Authority. Each Party warrants and represents that it/he has the authority to enter and execute this Agreement and to settle and release fully and completely all claims, causes of action, demands, charges and liabilities settled and released herein.

11. Signing of Future Documents. The Parties agree to execute any and all future documents necessary to effectuate and in furtherance of this Agreement.

12. Entire Agreement; Amendments. This Agreement constitutes the entire agreement between the Parties and supersedes any and all prior oral and written communications, agreements or proposals among the Parties concerning any of the subject matters which compromise this Agreement. This Agreement may not be modified, amended or waived without the express prior written consent of the other parties.

13. Successors and Assigns. This Agreement shall be binding upon, inure to the benefit of and be enforceable by the Parties and their respective permitted successors and assigns, as well as any licensees of the names or marks "Mattress Source" or "Mattress Source of America."

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14. Nonadmission. The Parties agree that this Agreement is not to be construed as an admission of any liability and that each Party has denied any liability to the others.

15. Governing Law. This Agreement shall be governed in all respects as to validity construction, performance or otherwise by the law of the state in which any action arising under this agreement originated and, as applicable, the federal trademark laws of the United States.

16. Legal Counsel. The Parties agree that they have consulted with counsel prior to entering into this Agreement and that the terms of the Agreement are fully understood and voluntarily accepted by each Party.

17. Counterparts. This Agreement may be executed in several counterparts, each of which shall be deemed an original, but all of which together shall constitute one in the same instrument.

IN WITNESS WHEREOF, intending to be legally bound hereby, the Parties have executed this Agreement as of the date first written above.

JAMAL LLC D/B/A/ MATTRESS SOURCE

By: [illegible]

Name: Barry [illegible]

Title: C E O

THE MATTRESS SOURCE, INC.

By: [illegible]

12/17/12 Name: Brian Wallace

Title: President

JOHN W. HILL III

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MATTRESS SOURCE, INC.

By: _____

Name: JOHN W. HEIN III

Title: PRES

14. Nonadmission. The Parties agree that this Agreement is not to be construed as an admission of any liability and that each Party has denied any liability to the others.

15. Governing Law. This Agreement shall be governed in all respects as to validity, construction, performance or otherwise by the law of the state in which any action arising under this agreement originated and, as applicable, the federal trademark laws of the United States.

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IN WITNESS WHEREOF, intending to be legally bound hereby, the Parties have executed this Agreement as of the date first written above.

JAMAT, LLC D/B/A/ MATTRESS SOURCE

By: [signature]

Name: BARRY SEIDEL

Title: C.E.O.

THE MATTRESS SOURCE, INC.

By: Brian Wallace

12/14/12 Name: Brian Wallace

Title: President

JOHN W. HILL III

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