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

Proceeding	94002611
Party	Applicant Universal Chemical Products Corp.
Correspondence Address	MARÍA D TRELLES PIETRANTONI MENDOZ & ALVAREZ, LLC 208 PONCE DE LEÓN AVE, POPULAR CENTER 19TH FL SAN JUAN, PR 00918 UNITED STATES mtrelles@pmalaw.com, pcampos@pmalaw.com, docketclerk@pmalaw.com, jpeirats@pmalaw.com, vmartinez@pmalaw.com
Submission	Other Motions/Papers
Filer's Name	Maria D. Trelles-Hernandez
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Signature	/Maria D. Trelles-Hernandez/
Date	09/03/2015
Attachments	Joint Motion Dismissal.pdf(66315 bytes) Redacted - Concurrent Use No. 94002611 Executed Agreement.pdf(265167 bytes)

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

UNIVERSAL CHEMICAL PRODUCTS
CORP.

Applicant,

v.

HUERTA CHEMICAL CORP.

Registrant

CONCURRENT USE NO. 94002611

**JOINT MOTION INFORMING OF SETTLEMENT AND REQUESTING ISSUANCE OF
CONCURRENT USE REGISTRATION AND DISMISSAL OF PROCEEDINGS**

COME NOW the parties, Universal Chemical Products Corp., as Applicant, and Huerta Chemical Corp., as Registrant, and respectfully aver and pray:

1. The parties have reached an agreement for the concurrent use and registration of Applicant's and Registrant's marks. Enclosed is a redacted copy of the Agreement. A copy without redactions shall be submitted for the Board's consideration under seal.
2. As per the Agreement, the parties agree that Applicant may use and exercise all rights over the trademark H-7 in Puerto Rico and the U.S. Virgin Islands. Applicant may not use, promote, offer for sale, distribute, or sell goods bearing the H-7 trademark in any other part of the United States of America.
3. By the same token, Registrant may not use, promote, offer for sale, distribute, or sell goods bearing the H-7 trademark in the geographic territory in which Applicant will exercise its trademark rights in the United States of America (*i.e.*, in Puerto Rico and the U.S. Virgin Islands).

4. In accordance with the foregoing, the parties request that the Board issue the concurrent registration sought by the Applicant, subject to the referenced geographic limitation of use of the trademark H-7 only in Puerto Rico and the U.S. Virgin Islands and, thereafter, conclude the captioned proceedings.

WHEREFORE, the parties jointly request that the Board take notice of the foregoing and the attached Agreement, issue the concurrent registration sought by the Applicant subject to the relevant geographic limitation, and conclude these proceedings.

Dated: September 3, 2015

Respectfully submitted,

Attorneys for Registrant:	Attorneys for Applicant:
<p>MALLOY & MALLOY, P.L. 2800 S.W. 3rd Ave. Miami, Fl 33129 Tel. (305) 858-8000 Fax (305) 858-0008 Email: oruiz@malloylaw.com</p> <p>s/OLIVER ALAN RUIZ Oliver Alan Ruiz Florida Bar No. 524,786</p>	<p>PIETRANTONI MÉNDEZ & ALVAREZ LLC Popular Center, 19th Floor 208 Ponce de León Ave. San Juan, P.R. 00918 Tel. (787)274-1212 Fax (787) 274-1470</p> <p>s/MARÍA D. TRELLES-HERNÁNDEZ/ María D. Trelles-Hernández mtrelles@pmaalaw.com USDC-PR Bar No. 225106</p>

AGREEMENT

THIS AGREEMENT is made by and between Huerta Chemical Corp. (hereinafter "Huerta") a corporation of Florida, having an address of 2360 W. 78 Street, Hialeah FL 33016 US, and Universal Chemicals Products, Corp. (hereinafter "Universal"), a corporation of Puerto Rico, having an address of Amelia Industrial Park, Calle Frances #40, Guaynabo, Puerto Rico. Hereinafter Huerta and Universal are also referred to individually as a "Party" and collectively as "Parties".

RECITALS

WHEREAS, Huerta adopted, used, and is using the trademark "H-7" (hereinafter "the Mark") in connection with "Waterless Hand Soap; Cleaning and Degreasing Preparation," for which registrations have been obtained in the United States Patent and Trademark Office, namely, U.S. Trademark Reg. No. 1,316,465; and, in Puerto Rico, namely, Registration No. 48463;

WHEREAS, Universal is desirous of acquiring all rights in and to the Mark for the territory of Puerto Rico, as well as, the Lesser Antilles, the Dominican Republic, and Panama (hereinafter collectively referred to as "the Territory"), together with, to the extent applicable, any appurtenant common law rights therefor, the good will associated with the mark, and the right to sue for past infringement, in the Territory;

WHEREAS, sales of goods bearing the Mark have been made in the Lesser Antilles, which may or not amount to common law use of the Mark;

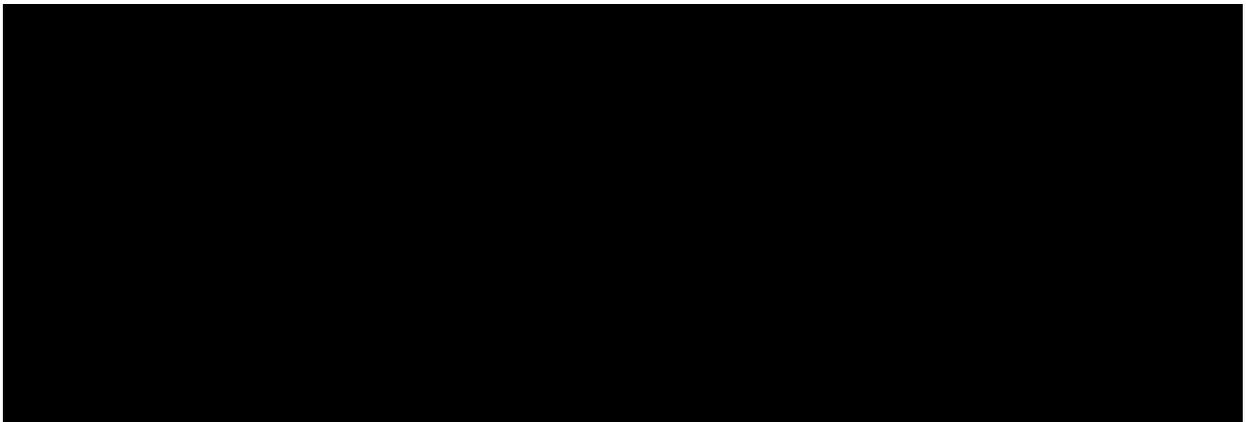
WHEREAS, Huerta MAKES NO WARRANTIES OR REPRESENTATIONS OF ANY KIND WHATSOEVER, EXPRESSED OR IMPLIED, REGARDING THE EXISTENCE OR THE EXTENT OF ANY RIGHTS TO, OR OWNERSHIP OF, THE MARK IN THE LESSER ANTILLES, THE DOMINICAN REPUBLIC, AND/OR PANAMA;

WHEREAS, Huerta reserves all rights to the Mark in the United States and in foreign countries not included in the definition of the Territory, above;

NOW THEREFORE, for good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged, the parties agree as follows:

TERMS

1.



2. After receipt of the initial payment described in Paragraph 1, Huerta will assign to Universal all of its right, title, and interest to the Mark in Puerto Rico (including Reg. No. 48463), along with all goodwill associated therewith. Huerta agrees to sign such additional documents as reasonably may be needed to effect the assignment of the Trademark Registration in Puerto Rico, the cost of which will be borne by Universal.
3. In the event consent by Huerta is necessary or desirable for Universal's registration of the Mark in the United States on a concurrent use basis, and provided that the geographical area of such concurrent use application is limited to Puerto Rico and the United States Virgin Islands, Huerta undertakes to provide its consent in the form reasonably requested and prepared by Universal, the cost of which will be borne by Universal.
4. Each party hereby consents to the other party's use and corresponding registration of the Mark in their respective territories as set forth in this Agreement, and agrees not to oppose, cancel, or otherwise attack the other party's use, provided that such use is in compliance with this Agreement. Huerta expressly recognizes that pursuant to this Agreement, it may not assert rights over the Mark in Puerto Rico and the United States Virgin Islands, despite its federal registration and Huerta agrees that it will not file any action in federal or state court asserting rights over the Mark in Puerto Rico and the United States Virgin Islands as a result of its federal registration.
5. Universal may not use the Mark in any countries other than those that comprise the Territory as defined herein, and agrees not to promote, offer for sale, distribute, or sell goods bearing the Mark in any other country, whether directly or indirectly. With regard to the United States, Universal may only use the Mark in Puerto Rico and the United States Virgin Islands, and agrees not to promote, offer for sale, distribute, or sell goods bearing the Mark elsewhere in the United States or its territories, whether directly or indirectly. Universal will take reasonable efforts to ensure that no distributor or re-seller of goods bearing the Mark will engage in further re-distribution or re-sale outside of the Territory, and will discontinue supplying any such distributor or re-seller engaged in or facilitating such activity. Goods bearing the Mark outside of the Territory shall be deemed by the Parties as "not genuine" and subject to seizure by Huerta, in addition to other legal and/or equitable remedies.
6. Huerta may not use the Mark in any of the countries that comprise the Territory as defined herein, and agrees not to promote, offer for sale, distribute, or sell goods bearing the Mark in the Territory, whether directly or indirectly. With regard to the United States, Huerta acknowledges that it may not use the Mark in Puerto Rico and the United States Virgin Islands, and agrees not to promote, offer for sale, distribute, or sell goods bearing the Mark in Puerto Rico and the United States Virgin Islands, whether directly or indirectly. Huerta will take reasonable efforts to ensure that no distributor or re-seller of goods bearing the Mark will engage in further re-distribution or re-sale in the Territory, and will discontinue supplying any such distributor or re-seller engaged in or facilitating such activity. Goods bearing the Mark in the Territory which have not been sold, promoted, offered for sale or distributed by Universal shall be deemed by the Parties as "not genuine" and subject to seizure by Universal, in addition to other legal and/or equitable remedies.

MISCELLANEOUS

7. Nothing herein shall be construed to place the parties in a relationship of partners, joint venturers, or licensor-licensee, and neither party shall have the power to bind or obligate the other party in any manner whatsoever except as specifically provided herein.

8. Entire Agreement. This Agreement contains the entire agreement of the Parties with respect to the subject matter hereof. There are no agreements, understandings, assurances, promises, warranties, covenants, or undertakings with respect to the subject matter of this Agreement that are not set forth in this Agreement. This Agreement supersedes all prior or contemporaneous agreements, discussions or representations, whether oral or written, with respect to the subject matter hereof.
9. Amendments/Modifications and Waiver. This Agreement may be amended only by agreement in writing signed by each of the Parties hereto. No waiver of any provision nor consent to any exception to the terms of this Agreement or any other agreement contemplated hereby will be effective unless in writing and signed by the Party to be bound, and then only for the specific purpose, extent and instance so provided. Failure by any Party to enforce any rights under this Agreement will not be construed as a waiver of such rights, and a waiver by either Party of a default hereunder in any instance will not be construed as constituting a continuing waiver or as a waiver in other instances.
10. Severability. If any provision of this Agreement is determined to be invalid, illegal or unenforceable, the remaining provisions of this Agreement will remain in full force and effect provided that the economic and legal substance of the transaction contemplated is not affected in any manner materially adverse to any Party.
11. Successors and Assigns. This Agreement will inure to the benefit of and is binding on the Parties hereto and their respective parents, subsidiaries, divisions, affiliates, directors, officers, employees, agents and all those acting in concert or participation with them or under their direction or control, and upon the Parties' respective successors and permitted assigns.
12. Joint Drafting. The Parties agree that in any construction to be made of this Agreement, this Agreement will not be construed as having been drafted solely by or on behalf of any one or more of the Parties hereto.
13. Enforcement of Agreement. If either Party commences a lawsuit to enforce its rights hereunder, the prevailing Party shall be entitled to recover its reasonable costs and expenses, including attorney's fees and costs reasonably incurred in connection with such lawsuit.
14. Advice of Counsel. The Parties hereby represent that they have had the opportunity to obtain independent legal advice in connection with this Agreement, and that they each have read, understand and agree with all the terms and conditions contained herein, and that each executes this Agreement voluntarily without any duress or undue influence on the part of, or on behalf of, any Party hereto or representative thereof.
15. Agreement May Be Executed in Counterparts. This Agreement may be executed and delivered in counterparts and by electronic means capable of producing a printed copy, and by each Party in a separate counterpart, each of which when so executed and delivered will constitute an original and all of which taken together will constitute one and the same instrument.
16. Authorizations. Each Party hereto warrants and represents that he/it is fully authorized to enter into this Agreement and to carry out the obligations provided herein.
17. **This Agreement shall be governed by and construed in accordance with Florida law. In the event of any claim arising under or relating to the subject matter of this Agreement: a) such action shall be brought and exclusive venue shall lie in the applicable State or Federal courts in Miami-Dade County, Florida; b) the parties submit to the jurisdiction of the State and Federal**

courts in Florida; e) EACH PARTY WAIVES ITS RIGHT TO TRIAL BY JURY; and d) final decisions of the Florida courts may be enforced in any court of competent jurisdiction.

IN WITNESS THEREOF, each of the parties has executed and delivered this Agreement.

HUERTA CHEMICAL CORP.

Signed: [Signature]

Print Name: NEER SIVANEZ

Print Title: president

Date: 8-3-12

UNIVERSAL CHEMICAL PRODUCTS, CORP.

Signed: [Signature]

Print Name: JUAN L. VENTO

Print Title: president

Date: 8/3/12



Estado Libre Asociado de Puerto Rico
 Departamento de Estado
 San Juan, Puerto Rico

TRASPASO

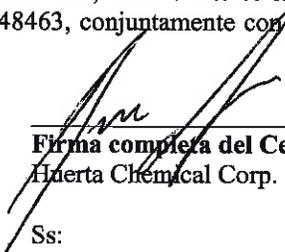
MARCA H-7

Por Cuanto, Huerta Chemical Corp, una corporación organizada bajo las leyes del Estado de la Florida, Estados Unidos, ha adoptado y usado en su negocio ---la marca H-7, la cual está registrada en el Departamento de Estado de Puerto Rico bajo el número 48463 de fecha 3 de febrero de 2000 y renovación de 13 de enero de 2010, y

Por Cuanto, Universal Chemicals Products, Corp. una corporación organizada bajo las leyes del Estado Libre Asociado de Puerto Rico haciendo negocios en Calle Frances #40, Guaynabo, Puerto Rico adquirió los derechos de dicha marca para el territorio de Puerto Rico:

Por tanto, a todo el que pueda interesar:

Sébase que por y en consideración a la suma de \$10 y otras consideraciones buenas y de valor que le han sido pagadas y que por la presente declara haber recibido, el cedente, Huerta Chemical Corp, ha vendido, cedido y traspasado, y por la presente vende, cede y traspasa al cesionario Universal Chemicals Products, Corp. todos sus derechos, título e interés en la referida marca en Puerto Rico y en el registro del mismo, número 48463, conjuntamente con la plusvalía del negocio en el cual se usa dicha marca en Puerto Rico.

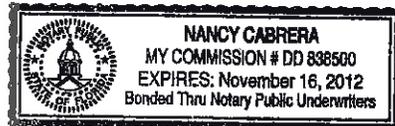

 Firma completa del Cedente
 Huerta Chemical Corp.

Ss:

Affidávit Núm. _____

Personalmente compareció ante mi (él o la) señor(a) Nancy Oliva Pérez, quien reconoció haber otorgado libremente el anterior documento, hoy día 31^{ra} de AUGUST de 2012.

Sello Notarial




 Firma del Notario Público

NOTA: Este modelo debe radicarse en original y acompañar con el mismo, un comprobante de rentas internas de \$10 por cada registro.