

TTAB



Holme Roberts & Owen LLP
Attorneys at Law

DENVER

November 29, 2004

BOULDER

BOX TTAB
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

COLORADO SPRINGS

Re: Joint Motion to Dismiss Proceedings
In Matter of Application No.: 75/682,226
Opposition No.: 124,556
Our Reference: 47249-00020

Dear Sir:

LONDON

Enclosed for filing is a Joint Motion to Dismiss Proceedings in the Matter of above-referenced Application before the Trademark Trial and Appeal Board.

MUNICH

Please confirm receipt of this Joint Motion to Dismiss Proceedings by applying your date stamp to the enclosed postcard and returning it to us.

SALT LAKE CITY

In addition, the Commissioner is hereby authorized to charge any fees to our Deposit Account No. 08-2665.

SAN FRANCISCO

Thank you.

Very truly yours,

Karla Carnes Allen
Practice Support

Enclosures



12-02-2004

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #74

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

In the Matter of: Application Serial No. 75/682,226

Published in the *Official Gazette* on July 11, 2000

HSS HIRE SERVICE GROUP PLC,)
)
Opposer,)
)
v.)
)
THE HOME SERVICE STORE, INC.)
)
Applicant.)
_____)

CERTIFICATE OF MAILING (37 C.F.R. 1.8A)
I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.
Katheryn Jarvis Coggon 11/29/04
Katheryn Jarvis Coggon Date

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Opposition No.: 124,556

Date: November 29, 2004

JOINT MOTION TO DISMISS PROCEEDINGS

HSS Hire Service Group, PLC along with The Home Service Store, Inc., by and through their respective attorneys, hereby move to dismiss with prejudice (1) the opposition proceeding commenced by Opposer, with respect to Application Serial No. 75/682,226; and (2) the cancellation proceedings commenced by Applicant, with respect to Registration No. 2,072,559 and 2,368,208 (collectively, the "Proceedings").

Opposer and Applicant submit that their motion should be granted by the TTAB because the parties have reached a settlement on October 6, 2004, attached hereto as **Exhibit A**, which resolves the parties disputes.

Respectfully submitted 11/29, 2004.

Lawrence H. Meier
Lawrence H. Meier
Downs Rachlin Martin PLLC
199 Main Street
P.O. Box 190
Burlington, VA 05402-1090
Attorney for Applicant

Katheryn Jarvis Coggon
Katheryn Jarvis Coggon
Holme Roberts & Owen LLP
1700 Lincoln, Suite 4100
Denver, Colorado 80203
Telephone: 303-861-7000
Attorney for Opposer

SETTLEMENT AGREEMENT

THIS SETTLEMENT AGREEMENT is entered into the 6th day of October 2004, (the "Effective Date") by and between **THE HOME SERVICE STORE, INC.**, a Delaware corporation with a principal place of business located at 80 West Street, Suite 104, Rutland, Vermont 05701 (hereafter "Home Service Store"), and **HSS HIRE SERVICE GROUP, PLC**, a United Kingdom public limited company with a principal place of business located at 25 Willow Lane, Mitcham, Surrey, United Kingdom CR4 4TS (hereafter "Hire Service Group") (Home Service Store and Hire Service Group are collectively referred to as the "Parties").

WHEREAS, Home Service Store owns the mark HSS, alone and with any design, including without limitation any and all common law rights and Home Service Store's U.S. Trademark Registration No. 2,445,973 for HSS and its U.S. Trademark Application Serial No. 75/682,226 for HSS and design (these marks are collectively referred to as the "Home Service Store Marks");

WHEREAS, Hire Service Group owns the marks HSS, HSS HIRE SHOP, HSS RENTAL STORES, and HSS RENTX, all alone and with any design, including without limitation any and all common law rights and Hire Service Group's U.S. Trademark Registration No. 2,072,559 for HSS HIRE SHOP, Reg. No. 2,368,208 for HSS RENTAL STORES, Reg. No. 2,749,523 for HSS RENTAL STORES, Reg. No. 2,749,524 for HSS RENTX, Reg. No. 2,746,297 for HSS, Reg. No. 2,782,541 for HSS RENTX, Reg. No. 2,835,855 for HSS RENTX and design, and Reg. No. 2,835,856 for HSS RENTX and design (these marks are collectively referred to as the "Hire Service Group Marks");

WHEREAS, Hire Service Group filed an opposition proceeding with the Trademark Trial and Appeal Board ("TTAB") with respect to Home Service Store's U.S. Trademark Application Serial No. 75/682,226 (the "Opposition Proceeding"); and

WHEREAS, Home Service Store filed a cancellation proceeding with the TTAB with respect to Hire Service Group's U.S. Trademark Registrations Nos. 2,072,559 and 2,368,208 (the "Cancellation Proceeding"; the Opposition Proceeding and the Cancellation Proceeding are hereinafter sometimes collectively referred to as the "Proceedings");

WHEREAS, the Proceedings are currently pending before TTAB as Opposition No. 124,556;

WHEREAS, the Parties desire to clearly delineate their respective uses of their respective marks to avoid any likelihood of confusion in the marketplace in which they sell their goods and services and wish to resolve their differences and settle their dispute with respect to the Proceedings.

NOW, THEREFORE, in consideration of the mutual covenants contained herein and for other good and valuable consideration, the receipt and sufficiency of which is mutually acknowledged, the Parties agree as follows:

1. Whenever the Home Service Store uses "HSS" on a stand-alone basis (i.e., other than in text) in its print advertising, marketing materials and other documents used in connection with its business (e.g., catalogs, newspapers, signs, yellow pages, letterhead, forms and agreements), it will prominently display "HSS" (with the S's being smaller than the H) with a design logo (currently a house) and the words "THE HOME SERVICE STORE" immediately adjacent (above, beneath or on either side of) the "HSS" and logo on the first page of all such documents. In addition, in each such use, Home Service Store will make each letter of "THE HOME SERVICE STORE" at least one-third the height of the "H" in "HSS", provided that the entire mark "THE HOME SERVICE STORE" shall be at least 1.0" wide; provided, however, that for small collateral materials (i.e., materials not large enough to accommodate an "HSS" logo at least 1.0" wide), Home Service Store will have the right to depict the "HSS" mark so that it is at least 0.75" wide. In its sole discretion, Home Service Store may change its design logo, except that Home Service Store will not use an arrow as its design logo. For the avoidance of doubt, no portion of the house design currently used in the HSS design mark shall be considered an arrow.

2. Home Service Store will use "HSS - The Home Service Store" or "HSS - Home Service Store" in the first use of "HSS" in a text format (as opposed to a logo or trademark format) on each page of form documents, which specifically excludes individually addressed business letters, in which such text appears, whether in hardcopy or electronic form. Home Service Store is not required to use "The Home Service Store" in connection with subsequent text uses of "HSS" on pages of documents in which "HSS" first appears as described in the previous sentence.

3. Whenever the Home Service Store uses the "HSS" mark on a stand-alone basis (i.e., other than in text) in its website (currently, www.trusthss.com), it will display "HSS" (with the S's being smaller than the H) with a design logo (currently a house) and the words "THE HOME SERVICE STORE" immediately adjacent (above, beneath or on either side of) the "HSS" and logo on the top half of each page of its website. In addition, in each such use, Home Service Store will make each letter of "THE HOME SERVICE STORE" at least one-third the height of the "H" in "HSS", provided that the entire mark "THE HOME SERVICE STORE" shall be at least 66 pixels wide when viewed at 100% screen size on a 14-inch monitor having a resolution of 800 x 600. In its sole discretion, Home Service Store may change its design logo, except that Home Service Store will not use an arrow as its design logo. For the avoidance of doubt, no portion of the house design currently used in the HSS design mark shall be considered an arrow.

4. Nothing in the agreement will affect in any way either party's ability to use and protect any mark or design logo that does not include the "HSS" mark, except as provided in Section 5 hereof.

5. Hire Service Group will agree not to use, or interfere in any way with Home Service Store's use of, the marks HOME SERVICE STORE, HOME ALLIANCE, HA, TRUSTED HOME SERVICES and THS, whether in block letter or logo form, with or without a design element. Home Service Store will agree not to use, or interfere in any

way with Hire Service Group's use of, the marks RENTX, PODZ, and CABINZ, whether in block letter or logo form, with or without a design element.

6. Home Service Store will have sixty (60) days from the Effective Date of this Agreement to conform its website to the terms of this Agreement and will have nine (9) months from the Effective Date of this Agreement to conform its other uses of "HSS" to the terms of this Agreement.

7. Home Service Store will not use the Home Service Store Marks in connection with any goods or services currently described in any existing applications or registrations for the Hire Service Group Marks; provided, however, that Home Service Store shall have the right to use the Home Service Store Marks in connection with contractor and installation services, i.e., Home Service Store would be allowed to provide services directly to customers, rather than through independent contractors. Home Service Store will have the right, however, to use and protect by additional trademark and trade name registrations the term "HSS", when used in combination with another term, to identify a partner or other business affiliate of Home Service Store so long as such composite mark or name is not used in a manner that would create a likelihood of confusion relative to the mark "HSS" when used to identify the goods and services currently listed in the existing applications and registrations for the Hire Service Group Marks (e.g., "HSS Rentals" would not be acceptable).

8. Hire Service Group will not use the Hire Service Group Marks in connection with any goods or services currently described in existing applications or registrations for the Home Service Store Marks. Further, Hire Service Group will not use the Hire Service Group Marks in connection with the provision of the services identified in the Home Service Store's application for HOME ALLIANCE (Serial No. 78/197,237), nor will it use the Hire Service Group Marks in connection with the installation and maintenance of prefabricated building components such as, without limitation, sunrooms, decking and replacement windows. Notwithstanding the foregoing, Hire Service Group may use the Hire Service Group Marks in connection with temporary site trailers, containers and portable storage units.

9. Home Service Store will not use the combination of red, white and blue or the combination of red and blue in its depiction of the Home Service Store Marks. Nothing in this Agreement precludes Home Service Store from using red, white and blue alone or in combination with other colors in its depiction of the Home Service Store Marks, nor does anything in this Agreement preclude Home Service Store from using red, white and blue, alone, in any combination, or with any other colors, in any of its advertising, promotional or other materials, whether in hardcopy or electronic form. Notwithstanding the foregoing, Home Service Store shall have no obligation to require partners of Home Service Store (who typically have branding standards for co-branded marketing materials that Home Service Store has no ability to influence) to abide by the terms of this Section 9 other than with regard to the color of Home Service Store's HSS logo.

10. Home Service Store will have the right to continue using its "www.trusthss.com" domain name.

11. Home Service Store will remove the "HSS" (by itself) metatag from its website within sixty (60) days of the Effective Date of this Agreement.

12. With regard to the Home Service Store Marks and the Hire Service Group Marks, each party agrees not to interfere with the other party's use of its marks as specified in this Agreement, will not oppose or seek to cancel the other party's marks, and will assist the other party in registering its marks by entering into a consent to register agreement to be submitted to the U.S. Patent and Trademark Office. All pending opposition and cancellation actions in the U.S. Patent and Trademark Office will be dismissed with prejudice. Home Service Store hereby remises, releases, and forever discharges Hire Service Group of and from any and all manner of action and actions, cause and causes of action, suits, claims and demands whatsoever, in law or in equity, which Home Service Store ever had, now has or may have in the future against Hire Service Group, relating in any way to Hire Service Group's use of the Hire Service Group Marks prior to the date of this Agreement. Hire Service Group hereby remises, releases, and forever discharges Home Service Store of and from any and all manner of action and actions, cause and causes of action, suits, claims and demands whatsoever, in law or in equity, which Hire Service Group ever had, now has or may have in the future against Home Service Store, relating in any way to Home Service Store's use of the Home Service Store Marks prior to the date of this Agreement.

13. This Agreement covers use and registration of marks in the United States, Canada and Mexico.

14. Upon failure of either Party to perform or comply with any of the agreements, conditions, covenants, provisions or stipulations contained in this Agreement (the "Breaching Party"), the other Party (the "Non-Breaching Party") shall give written notice of such failure to the Breaching Party in accordance with the provisions of Section 16. The Breaching Party shall then have thirty (30) days to cure said failure; provided, however, that as part of its cure, if applicable, the Breaching Party shall correct collateral materials in its possession within the thirty (30) day period and send replacement collateral materials to any necessary third parties within the thirty (30) day period. The Non-Breaching Party understands that the Breaching Party cannot guarantee that replacement materials sent to third parties will be substituted for the existing materials within the thirty (30) day period and that failure of such third parties to do so will not constitute a breach of this Section 14 or a further breach of this Agreement by the Breaching Party.

15. The parties believe that in light of the undertakings in this Agreement, there is no likelihood of confusion with respect to the Home Service Store Marks and the Hire Service Group Marks. In furtherance of the objectives of this Agreement, Hire Service Group agrees that it will not intentionally use the Hire Service Group Marks, and Home Service Store agrees that it will not intentionally use the Home Service Store Marks, to promote goods and/or services in a manner that is likely to cause confusion.

The Home Service Store and HSS Hire Service Group each will notify the other of any actual or potential confusion of which they are or become aware involving the Home Service Store Marks and the Hire Service Group Marks. The parties will take reasonable steps in the event that actual confusion occurs with respect to such marks to alleviate such confusion.

16. All notices required to be delivered pursuant to this Agreement shall be in writing and shall be delivered by hand, facsimile or recognized overnight courier, postage pre-paid, and shall be addressed to the parties at the following addresses, or to such other addresses as the parties may designate in writing from time to time:

If to Home Service Store: The Home Service Store, Inc.
80 West Street, Suite 104
Rutland, Vermont 05701
Attn: Director, Business Development
(currently, Sarah Dupras)
Facsimile No.: 802-786-7432

with a copy to: Lawrence H. Meier, Esq.
Downs Rachlin Martin PLLC
199 Main Street, P.O. Box 190
Burlington, Vermont 05402
Facsimile No.: (802) 862-7512

If to Hire Service Group: HSS Hire Service Group, PLC
25 Willow Lane
Mitcham
Surrey, United Kingdom CR4 4TS
Attn: Director of Special Projects (currently,
David Kilonback)
Facsimile No.: 011 44 208 687 5022

with a copy to: Katheryn Jarvis Coggon, Esq.
Holme Roberts & Owen LLP
1700 Lincoln Street, Suite 4100
Denver, Colorado 80203
Facsimile No.: (303) 866-0200

Such notices are deemed received on the date delivered by hand or facsimile if delivered before 5:00 p.m. local time of the recipient, and the next day if delivered thereafter, and on the day after placement with recognized overnight courier for next-day delivery.

17. Each party shall pay for its own attorneys' fees and expenses relating to the Proceedings and the negotiation of this Agreement.

18. The Parties hereto agree that the terms and conditions of this Agreement or any part hereof may only be amended in a writing executed by both Parties.

19. Nothing contained in this Agreement shall be construed as creating a joint venture, partnership or agency relationship between the Parties.

20. This Agreement contains the complete understandings of the Parties in relation to the subject matter hereof.

21. If any of the terms of this Agreement are held to be unlawful by a court of competent jurisdiction, such a finding shall in no way affect the remaining obligations of the Parties hereunder.

22. This Agreement shall be binding upon the Parties and their successors and assignees.


23. The Parties represent and warrant that they have the capacity and right, and have received all approvals needed, to enter into this Agreement.

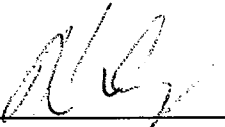
24. This Agreement shall be executed in duplicate, each of which shall be deemed an original, but both of which together shall constitute one and the same instrument.

WHEREFORE, the Parties state that they have carefully read this foregoing Agreement and consent and agree to be bound by its terms and conditions, to which they set their hand and seal below.

THE HOME SERVICE STORE, INC.

HSS HIRE SERVICE GROUP, PLC

By: 
Name: Mark Ilderton
Title: President

By: 
Name: David Kilonback
Title: Director of Special Projects

Date: 10/11/04

Date: 6/10/04

BTV/225001.2