

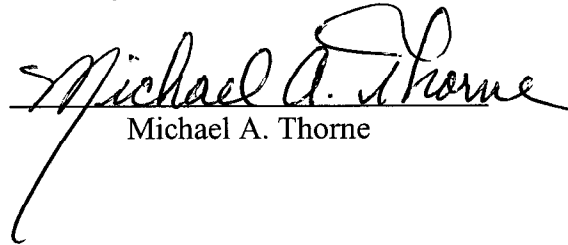


09/09/2003TTAB

CERTIFICATE OF MAILING

I hereby certify that the foregoing OPPOSER'S MOTION TO DISMISS WITH PREJUDICE, in connection with Opposition No. 91152076, and postcard receipt was mailed to the following address on August 20, 2003.

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

  
Michael A. Thorne

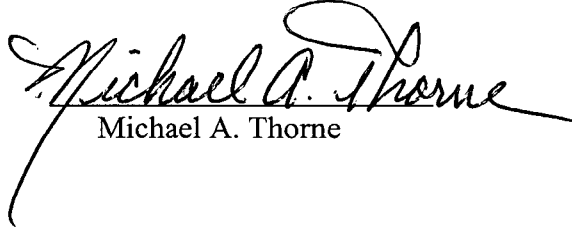
09/09/2003TTAB

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing OPPOSER'S MOTION TO DISMISS WITH PREJUDICE in connection with Opposition No. 91152076 was served on:

Caldwell A. Camero, Esq.  
Menard, Inc.  
4777 Menard Drive  
Eau Claire, WI 54703  
Phone: 715-876-2646  
FAX: 715-876-2871

Attorney for Applicant, via First-Class Mail, postage prepaid, on August 20, 2003.

  
Michael A. Thorne

09/09/2003TTAB

SETTLEMENT AGREEMENT AND MUTUAL CONSENT TO REGISTRATION

This Settlement Agreement and Mutual Consent to Registration ("Agreement") is entered into this 15<sup>th</sup> day of August, 2003 by and between ULTRADEC, INC., a Missouri corporation with its principal office at #12 Tenbrook Industrial Park, Arnold, Missouri 63010 ("Ultradec"), and MENARD, INC., a Wisconsin corporation with its principal office at 4777 Menard Drive, Eau Claire, Wisconsin 54703 ("Menard"). Ultradec and Menard are sometimes referred to herein as a "Party" and collectively as the "Parties."

WHEREAS, Menard is the owner of Trademark Application Serial No. 76/001506, filed March 15, 2000, seeking registration of the mark ULTRADECK ("ULTRADECK"), for "Non-metallic boards and planks used in connection with residential deck and dock construction," in International Class 19 ("Menard Application"), the Menard Application having been published for opposition in the October 23, 2001 issue of the Official Gazette;

WHEREAS, Ultradec is the owner of Trademark Application, Serial No. 76/224801, filed March 14, 2001, for the mark ULTRADEC ("ULTRADEC") for "Specialty chemical coatings, namely custom seamless interior floor systems comprised of moisture-cured urethane, urethane elastomers, epoxy, acrylic and polyester coatings," in International Class 2 ("Ultradec Application"), with a date of first use of such goods in commerce which Congress may regulate on May 31, 1987 as shown in the records of the USPTO. Action on said Ultradec Application was formally suspended by the Trademark Attorney on January 17, 2002, pending the disposition of the Menard Application;

WHEREAS, Ultradec and Menard are parties to a trademark opposition proceeding before the Trademark Trial and Appeal Board of the U.S. Patent and Trademark Office ("USPTO"), styled Ultradec, Inc. v. Menard, Inc., Opposition No. 91152076 (the "Opposition");

09/09/2003TTAB

WHEREAS, neither Menard nor Ultradec believes there is any likelihood of confusion between the Ultradec Mark ULTRADEC and the Menard Mark ULTRADECK, given the covenants and agreements of the Parties as set forth herein and given the differences in the goods, channels of trade, and manner in which the goods under the respective marks are and will be used in commerce in the United States; and

WHEREAS, the Parties desire to settle the Opposition as set forth in this Agreement.

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

1. The Parties acknowledge and agree that Menard's goods, as identified in the Menard Application in International Class 19 (non-metallic building materials), are substantially different from Ultradec's goods, as identified in the Ultradec Application in International Class 2 (paints).
2. Menard agrees that the goods to be sold under ULTRADECK are sold at retail to the general public through Menard's chain of home improvement centers and are used exclusively for exterior residential deck and dock construction. Menard further agrees that it will not extend or seek to extend use of ULTRADECK to specialty chemical coatings and will not distribute or sell its non-metallic boards and planks under ULTRADECK for use in construction of interior floors in commercial buildings.
3. Ultradec agrees that the goods sold under ULTRADEC are sold directly, or through distributors, only to professional floor coating contractors and are not and will not be sold at retail to the general public and are used exclusively for floor coating applications on interior floors in commercial buildings. Ultradec further agrees that it will not extend or seek to extend use of ULTRADEC to residential deck and dock construction goods and services and will

09/09/2003TTAB

not distribute or sell specialty chemical coatings under ULTRADEC for use on residential decks and docks.

4. Pursuant to and in connection with the negotiation of this Agreement, the Parties have agreed to request suspension of proceedings of the Opposition by filing the Stipulated Request for Suspension of Proceedings and Resetting of Discovery and Testimony Periods, attached hereto as EXHIBIT A.

5. In view of the substantial differences in the goods, channels of trade, and manner in which the goods under the respective marks are and will be used in commerce, the Parties believe that they can co-exist with no likelihood of confusion between ULTRADECK and ULTRADEC. Menard agrees to take no action to interfere with the use and registration of ULTRADEC, as described in the Ultradec Application. Ultradec agrees to take no action to interfere with the use and registration of ULTRADECK, as described in the Menard Application. The Parties further agree to execute a Mutual Consent to Registration, in the form attached hereto as EXHIBIT B ("Consent").

6. Subject to Menard's execution of this Agreement and the Consent, Ultradec agrees that it will take no action to interfere with the use and registration of ULTRADECK, as reflected in the Menard Application, and will not seek, directly or indirectly, to oppose, cancel, or otherwise invalidate any other application of Menard for registration of ULTRADECK or any registration issuing therefrom.

7. Ultradec will dismiss, with prejudice, the Opposition by filing with the USPTO a Motion to Dismiss With Prejudice in the form attached hereto as EXHIBIT C within one (1) week after a fully executed original of this Agreement is available to Ultradec's counsel. In the

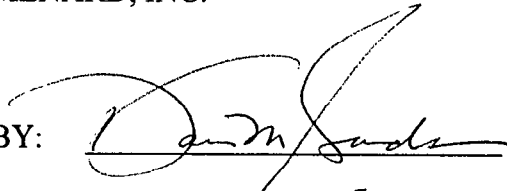
09/09/2003TTAB

event the USPTO refuses to accept the Consent and rejects the Ultradec Application on the basis of the Menard Application, this Agreement shall be null and void, and Ultradec shall retain its right to file a Notice of Cancellation.

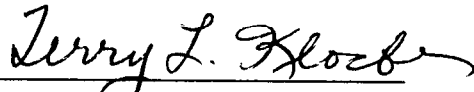
8. This Agreement contains the entire understanding and agreement of the Parties in connection with the matters referred to herein and shall be binding on, and inure to the benefit of, the Parties and their respective successors and assigns. This Agreement may be modified only by a written instrument executed by a duly authorized officer of each Party, specifically referring to this Agreement and setting forth such modification in detail.

AGREED TO by the Parties, by their duly authorized undersigned officers, as of the date first written above.

MENARD, INC.

BY:   
Name: DAWN M SANDS  
Title: Exec Gen. Counsel

ULTRADEC, INC.

BY:   
Name: TERRY L. KLOCKE  
Title: President  
8/15/2003





09/09/2003TTAB

This request is made in good faith, and with the express consent of Caldwell A. Camero, Esq., counsel for Applicant, Menard, Inc. Approval of this request is thus respectfully requested for the reasons set forth above.

Respectfully submitted,

By: \_\_\_\_\_  
Michael A. Thorne  
Spencer Fane Britt & Browne LLP  
120 S. Central Avenue, Fifth Floor  
St. Louis, Missouri 63105  
Phone: 314-863-7733  
FAX: 314-862-4656  
*mthorne@spencerfane.com*

Attorney for Opposer

Date: December \_\_\_, 2002

CERTIFICATE OF MAILING

I hereby certify that the foregoing STIPULATED REQUEST FOR SUSPENSION OF PROCEEDINGS AND RESETTING OF DISCOVERY AND TESTIMONY PERIODS, in connection with Opposition No. 91152076, and postcard receipt was mailed to the following address, this \_\_\_ day of December, 2002.

Box TTAB - No Fee  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

\_\_\_\_\_  
Michael A. Thorne

09/09/2003TTAB

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing STIPULATED REQUEST FOR  
SUSPENSION OF PROCEEDINGS AND RESETTING OF DISCOVERY AND TESTIMONY  
PERIODS in connection with Opposition No. 91152076 was served on:

Caldwell A. Camero, Esq.  
Menard, Inc.  
4777 Menard Drive  
Eau Claire, WI 54703  
Phone: 715-876-2646  
FAX: 715-876-2871

Attorney for Applicant, via First-Class Mail, postage prepaid, this \_\_\_\_ day of December, 2002.

---

Michael A. Thorne

09/09/2003TTAB

EXHIBIT B

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

_____	)	
In Re Trademark Application of:	)	
	)	
ULTRADEC, INC.	)	
	)	Examining Attorney:
Serial No.: 76/224801	)	
	)	Karen K. Bush
Filed: March 14, 2001	)	
	)	Law Office 105
Mark: ULTRADEC	)	
	)	

BOX TTAB – NO FEE  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

MUTUAL CONSENT TO REGISTRATION

1. MENARD, INC. (“Menard”) is the owner of Trademark Application Serial No. 76/001506, filed March 15, 2000, seeking registration of the mark ULTRADECK, for “Non-metallic boards and planks used in connection with residential deck and dock construction,” in International Class 19, as evidenced by the publication of such mark in the October 23, 2001 issue of the Official Gazette.

2. ULTRADEC, INC. (“Ultradec”) is the owner of Trademark Application, Serial No. 76/224801, filed March 14, 2001, for the mark ULTRADEC for “Specialty chemical coatings, namely custom seamless interior floor systems comprised of moisture-cured urethane, urethane elastomers, epoxy, acrylic and polyester coatings,” in International Class 2, with a date

09/09/2003TTAB

of first use of such goods in commerce which Congress may regulate on May 31, 1987 as shown in the records of the U.S. Patent & Trademark Office. Action on said application was formally suspended by the Trademark Attorney on January 17, 2002 pending the disposition of Menard's Application Serial No. 76/001506.

3. For the reasons set forth herein, the Parties believe there is no likelihood of confusion between the respective marks of the Parties in view of the differences in the goods, channels of trade, and manner in which the goods under the respective marks are and will be used in commerce in the United States.

4. Menard's goods under its ULTRADECK mark, classified in International Class 19 (non-metallic building materials), are substantially different from Ultradec's goods under its ULTRADEC mark, classified in International Class 2 (paints).

5. Menard's goods under its ULTRADECK mark are sold at retail to the general public through Menard's chain of home improvement centers. Ultradec's goods under its ULTRADEC mark are sold directly, or through distributors, only to professional floor coating contractors.

6. Menard's goods under its ULTRADECK mark are used exclusively for exterior residential deck and dock construction. Ultradec's goods under its ULTRADEC mark are used exclusively for floor coating applications on interior floors in commercial buildings.

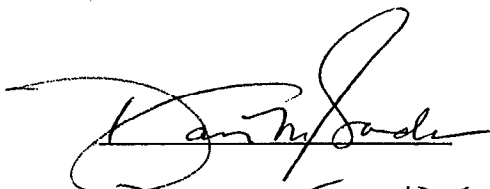
7. Pursuant to the Agreement between Ultradec and Menard in settlement of Opposition No. 91152076 (the "Settlement Agreement"), the Parties have agreed that their use of their respective marks will not cross over to the other Party's classes of goods and channels of trade set forth above in order to avoid confusion of the public.

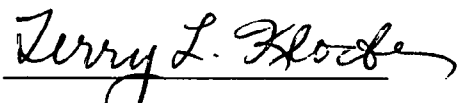
8. In view of the foregoing substantial differences in the goods, channels of trade, and manner in which the goods under the respective marks are and will be used in commerce, the Parties believe that they can co-exist; therefore, pursuant to the Settlement Agreement, Menard will take no action to interfere with the use and registration of the ULTRADEC mark, as described in Ultradec's Application Serial No. 76/224801; and Ultradec will take no action to interfere with the use and registration of the ULTRADECK mark, as described in Menard's Application Serial No.76/001506.

**NOW THEREFORE**, Menard, by its duly authorized undersigned officer, hereby consents to the use and registration of the ULTRADEC mark, as described in Ultradec's Application Serial No. 76/224801 for "Specialty chemical coatings, namely custom seamless interior floor systems comprised of moisture-cured urethane, urethane elastomers, epoxy, acrylic and polyester coatings," in International Class 2. Likewise, Ultradec, by its duly authorized undersigned officer, hereby consents to the use and registration of the ULTRADECK mark, as described in Menard's Application Serial No. 76/001506 for "Non-metallic boards and planks used in connection with residential deck and dock construction," in International Class 19.

MENARD, INC.

ULTRADEC, INC.

By:   
Print Name: DAWN M SANDS  
Title: Exec. Gen Counsel  
Date: Aug 5, 2003

By:   
Print Name: TERRY L. KLOCKE  
Title: President  
Date: 8/15/2003

09/09/2003TTAB

EXHIBIT C

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

_____	)	
ULTRADEC, INC.	)	
	)	Opposition No.: 91152076
Opposer,	)	
	)	Mark: ULTRADECK
	)	
v.	)	Serial No.: 76/001506
	)	
MENARD, INC.	)	Published: October 23, 2001
	)	
Applicant.	)	
	)	

BOX TTAB – NO FEE  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

OPPOSER’S MOTION TO DISMISS OPPOSITION WITH PREJUDICE

The parties to the above-captioned proceeding have reached a settlement agreement, a true copy of which is attached hereto and incorporated herein by reference, pursuant to which, Opposer, Ultradec, Inc., by its undersigned attorney, respectfully requests that the Board dismiss said proceeding, with prejudice. This request is made in good faith, and with the express consent of Caldwell A. Camero, Esq., counsel for Applicant, Menard, Inc. Approval of this request is thus respectfully requested for the reasons set forth above.

Respectfully submitted,

By: \_\_\_\_\_  
Michael A. Thorne  
Spencer Fane Britt & Browne LLP  
120 S. Central Avenue, Fifth Floor

09/09/2003 TTAB

St. Louis, Missouri 63105  
Phone: 314-863-7733  
FAX: 314-862-4656  
*mthorne@spencerfane.com*  
Attorney for Opposer

Date: \_\_\_\_\_, 200\_

CERTIFICATE OF MAILING

I hereby certify that the foregoing OPPOSER'S MOTION TO DISMISS WITH PREJUDICE, in connection with Opposition No. 91152076, and postcard receipt was mailed to the following address, this \_\_\_ day of \_\_\_\_\_, 200\_.

Box TTAB - No Fee  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

\_\_\_\_\_  
Michael A. Thorne

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing OPPOSER'S MOTION TO DISMISS WITH PREJUDICE in connection with Opposition No. 91152076 was served on:

Caldwell A. Camero, Esq.  
Menard, Inc.  
4777 Menard Drive  
Eau Claire, WI 54703  
Phone: 715-876-2646  
FAX: 715-876-2871

Attorney for Applicant, via First-Class Mail, postage prepaid, this \_\_\_ day of \_\_\_\_\_, 200\_.

\_\_\_\_\_  
Michael A. Thorne

09/09/2003TTAB

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

_____	)	
In Re Trademark Application of:	)	
	)	
ULTRADEC, INC.	)	
	)	Examining Attorney:
Serial No.: 76/224801	)	
	)	Karen K. Bush
Filed: March 14, 2001	)	
	)	Law Office 105
Mark: ULTRADEC	)	
	)	

BOX TTAB – NO FEE  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

MUTUAL CONSENT TO REGISTRATION

1. MENARD, INC. (“Menard”) is the owner of Trademark Application Serial No. 76/001506, filed March 15, 2000, seeking registration of the mark ULTRADECK, for “Non-metallic boards and planks used in connection with residential deck and dock construction,” in International Class 19, as evidenced by the publication of such mark in the October 23, 2001 issue of the Official Gazette.

2. ULTRADEC, INC. (“Ultradec”) is the owner of Trademark Application, Serial No. 76/224801, filed March 14, 2001, for the mark ULTRADEC for “Specialty chemical coatings, namely custom seamless interior floor systems comprised of moisture-cured urethane, urethane elastomers, epoxy, acrylic and polyester coatings,” in International Class 2, with a date of first use of such goods in commerce which Congress may regulate on May 31, 1987 as shown



09/09/2003 TAB

in the records of the U.S. Patent & Trademark Office. Action on said application was formally suspended by the Trademark Attorney on January 17, 2002 pending the disposition of Menard's Application Serial No. 76/001506.

3. For the reasons set forth herein, the Parties believe there is no likelihood of confusion between the respective marks of the Parties in view of the differences in the goods, channels of trade, and manner in which the goods under the respective marks are and will be used in commerce in the United States.

4. Menard's goods under its ULTRADECK mark, classified in International Class 19 (non-metallic building materials), are substantially different from Ultradec's goods under its ULTRADEC mark, classified in International Class 2 (paints).

5. Menard's goods under its ULTRADECK mark are sold at retail to the general public through Menard's chain of home improvement centers. Ultradec's goods under its ULTRADEC mark are sold directly, or through distributors, only to professional floor coating contractors.

6. Menard's goods under its ULTRADECK mark are used exclusively for exterior residential deck and dock construction. Ultradec's goods under its ULTRADEC mark are used exclusively for floor coating applications on interior floors in commercial buildings.

7. Pursuant to the Agreement between Ultradec and Menard in settlement of Opposition No. 91152076 (the "Settlement Agreement"), the Parties have agreed that their use of their respective marks will not cross over to the other Party's classes of goods and channels of trade set forth above in order to avoid confusion of the public.

8. In view of the foregoing substantial differences in the goods, channels of trade, and manner in which the goods under the respective marks are and will be used in commerce, the

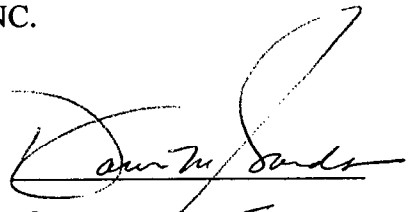
09/09/2003TTAB

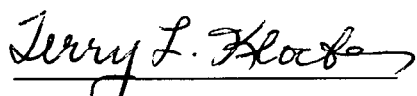
Parties believe that they can co-exist; therefore, pursuant to the Settlement Agreement, Menard will take no action to interfere with the use and registration of the ULTRADEC mark, as described in Ultradec's Application Serial No. 76/224801; and Ultradec will take no action to interfere with the use and registration of the ULTRADECK mark, as described in Menard's Application Serial No.76/001506.

**NOW THEREFORE**, Menard, by its duly authorized undersigned officer, hereby consents to the use and registration of the ULTRADEC mark, as described in Ultradec's Application Serial No. 76/224801 for "Specialty chemical coatings, namely custom seamless interior floor systems comprised of moisture-cured urethane, urethane elastomers, epoxy, acrylic and polyester coatings," in International Class 2. Likewise, Ultradec, by its duly authorized undersigned officer, hereby consents to the use and registration of the ULTRADECK mark, as described in Menard's Application Serial No. 76/001506 for "Non-metallic boards and planks used in connection with residential deck and dock construction," in International Class 19.

MENARD, INC.

ULTRADEC, INC.

By:   
Print Name: DAWN M. SANDS  
Title: Exec. General Counsel  
Date: Aug 5, 2003

By:   
Print Name: TERRY L. KLOCKE  
Title: President  
Date: 8/15/2003

TAB

09/09/2003TAB

SPENCER FANE

BRITT & BROWNE LLP

ATTORNEYS & COUNSELORS AT LAW

MICHAEL A. THORNE  
mthorne@spencerfane.com

August 20, 2003



08-25-2003

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #58

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

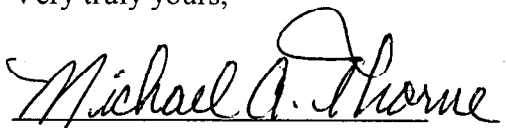
Re: Trademark Opposition No. 91152076

Dear Commissioner:

The parties to the above-referenced Opposition have reached agreement regarding a settlement. Enclosed herewith in that regard are the following documents:

1. Opposer's Motion to Dismiss Opposition with Prejudice;
2. True copy of the Settlement Agreement and Mutual Consent to Registration ("Settlement Agreement");
3. True copy of Mutual Consent to Registration ("Consent");
4. A return postcard to acknowledge receipt of the foregoing documents.

Very truly yours,

  
 Michael A. Thorne  
 Attorney for Ultradec, Inc.

MAT/  
Enclosures  
File: 5006428-0002