

ESTTA Tracking number: **ESTTA444289**

Filing date: **12/02/2011**

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

| | |
|------------------------|---|
| Proceeding | 91197851 |
| Party | Plaintiff American Council on Exercise |
| Correspondence Address | MARK I REICHENTHAL BRANFMAN & ASSOCIATES 708 CIVIC CENTER DRIVE OCEANSIDE, CA 92054 UNITED STATES markr@branfman.com |
| Submission | Other Motions/Papers |
| Filer's Name | Mark I. Reichenthal |
| Filer's e-mail | markr@branfman.com |
| Signature | /Mark I. Reichenthal/ |
| Date | 12/02/2011 |
| Attachments | 20111202110010145.pdf (6 pages)(400975 bytes) |

CONSENT TO REGISTER AND USE AGREEMENT


The parties to this Agreement are the American Council on Exercise ("A.C.E."), a California Corporation with an address at 4851 Paramount Drive, San Diego, CA 92123 and Asics Corporation, ("ASICS"), a Japanese Corporation with an address at 1-1, Minatojima-Nakamachi 7-Chome Chuo-ku, Kobe, Japan 650-8555.


WHEREAS, A.C.E. is a non-profit organization committed to promoting active, healthy lifestyles and their positive effects on the mind, body and spirit and A.C.E. accomplishes its mission through ongoing public education about the importance of health and exercise and by setting educational and other standards for fitness instructors;

WHEREAS, A.C.E. is the owner of U.S. Trademark and/or Service Mark Registration Nos. 1,898,868, 3,190,832, 3,244,688 and 3,358,311 for ACE®, U.S. Trademark and/or Service Mark Registration Nos. 2,216,241, 3,688,831 and 2,852,966 for AMERICAN COUNCIL ON EXERCISE® and U.S. Trademark and/or Service Mark Registration Nos. 1,884,858 and 3,089,060 for ACE AMERICAN COUNCIL ON EXERCISE®; U.S. Trademark and/or Service Mark and Registration No. 3,905,516 for ACE IFT, and A.C.E. is also the owner of the following U.S. Trademark and/or Service Mark Applications, namely, Ser. Nos. 77/226,048 for ACE FITNESS; 77/873,336 for ACE INTEGRATED FITNESS TRAINING; 85/024,482 for ACE GET FIT; 85/044,912 for ACE FIT; 85/105,155 for ACE WELLNESS; 85/086,755 for WORKOUT WATCHDOG AMERICAN COUNCIL ON EXERCISE; and 85/110,702 for OPERATION FITKIDS AMERICAN COUNCIL ON EXERCISE (all of the foregoing marks shall be referred to collectively herein as the "A.C.E. Trademarks"); in addition to said registrations and applications, A.C.E. has used the ACE® and AMERICAN COUNCIL ON EXERCISE® marks since at least on or about April 15, 1991 on certain goods and services including, but not limited to, pre-recorded audio cassettes and video cassettes featuring physical fitness training, physical fitness training manuals, printed certification materials, fitness and health related books, loose leaf magazines devoted to health and fitness, apparel and sporting goods, physical fitness testing and training services, and research services in the field of health and physical fitness;

WHEREAS, ASICS offers a full line of performance driven athletic shoes, technical active sports apparel and accessories. ASICS shoe line includes footwear for running, racing, track and field, walking, training, basketball, wrestling, volleyball, SportStyle and Onitsuka Tiger. ASICS apparel line includes styles for running, walking, training, team and fashion. ASICS also offers a wide variety of sport accessories, including athletic bags, hats, socks and kneepads.

WHEREAS, ASICS has filed Trademark Applications, Ser. Nos. 85/035,659 for "GEL-ACE"; 85/037,191 for "GEL-ACE TOUR"; 85/037,360 for "LADY GEL-ACE"; 85/044,120 for "GELACE"; 85/044,129 for "GELACE TOUR"; and 85/044,141 for "LADY GELACE" all in Class 025 for footwear; and Ser. No. 85/041,406 for "ACE" in Class 028 for kneepads for athletic use (all of the foregoing marks shall be referred to collectively herein as the "ASICS Trademarks");

 (initials)

 (initials)

WHEREAS, A.C.E. has filed Oppositions against Ser. Nos. 85/035,659 for "GEL-ACE"; 85/037,191 for "GEL-ACE TOUR"; 85/037,360 for "LADY GEL-ACE"; and 85/041,406 for "ACE";

WHEREAS, A.C.E. has filed and has obtained acceptance for Requests for Extensions of Time to file Oppositions against Ser. No. 85/044,120 for "GELACE", Ser. No. 85/044,129 for "GELACE TOUR", and Ser. No. 85/044,141 for "LADY GELACE" all with deadlines of April 16, 2011;

WHEREAS, the parties now wish to amicably resolve and confirm their respective concurrent rights to use their respective marks so as to avoid any likelihood of confusion in the future.

THEREFORE, A.C.E. hereby consents to the use and registration of the ASICS Trademarks by ASICS on the terms and conditions set forth hereafter.


1. ASICS and A.C.E. agree that the ASICS Trademarks as applied for by ASICS and directed towards consumers of footwear and athletic apparel are not likely to cause confusion, or to cause mistake, or to deceive in regards to the A.C.E. Trademarks so long as ASICS complies with the terms and conditions of this Agreement:

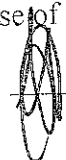
(a) There are differences between the goods and their intended class of consumers to which the marks are applied, as ASICS desires to use all of the ASICS Trademarks in conjunction with footwear for golf with the exception of Ser. No. 85/041,406 for the mark "ACE" as ASICS desires to use this particular mark for "kneepads for playing volleyball".

(b) By comparison, A.C.E. uses the A.C.E. Trademarks on goods and services including, but not limited to, pre-recorded audio cassettes and video cassettes featuring physical fitness training, physical fitness training manuals, printed certification materials, fitness and health related books, loose leaf magazines devoted to health and fitness, apparel and sporting goods, physical fitness testing and training services, and research services in the field of health and physical fitness all of which are directed towards health and fitness consumers and professionals and certain athletes.

2. In order to avoid any possibility of a likelihood of confusion, it is hereby agreed as follows:

(a) ASICS agrees to amend the description of goods for Application Ser. Nos. 85/035,659 for "GEL-ACE"; 85/037,191 for "GEL-ACE TOUR"; 85/037,360 for "LADY GEL-ACE"; 85/044,120 for "GELACE"; 85/044,129 for "GELACE TOUR"; and 85/044,141 for "LADY GELACE" from "footwear" to "golf shoes". ASICS also agrees to amend the description of goods for Application Ser. No. 85/041,406 for "ACE" from "kneepads for athletic use" to "knee pads for use in playing volleyball". These Voluntary Amendments will be filed by ASICS within five (5) business days of the execution of this Agreement. ASICS also agrees to limit its use of the ASICS

 (initials)

 (initials)

Trademarks to the goods described in its Applications as amended in accordance with this provision of this Agreement.

(b) ASICS agrees to not use a red, white and blue color scheme (or any other similar color scheme) for the ASICS Trademarks that is confusingly similar to the color scheme in the A.C.E. logo [See Exhibit A attached hereto and incorporated by this reference].

(c) ASICS agrees to not use a font for the ASICS Trademarks that is confusingly similar to the font used in Registration No. 3,244,688 for the A.C.E logo [See Exhibit A attached hereto and incorporated by this reference].

(d) ASICS and A.C.E. agree to take such further action and execute such further agreements as may be necessary to carry out the spirit of this Agreement. Further, upon the execution of this Agreement by both parties, the parties shall cooperate to the end that the aforementioned Opposition proceeding be promptly dismissed.


(e) The parties agree to cooperate and consult with one another, in good faith, should future conditions or developments not contemplated herein by this Agreement suggest to either the possibility that the parties respective marks might be likely to be confused with one another, all with the view to insuring that no substantial likelihood of confusion between the parties' respective marks, as they are used in commerce, shall occur. In the event the parties herein are unable to resolve their differences, each party hereby agrees to submit the matter to non-binding mediation which shall be held in a location to be mutually determined by the parties. Participation in the mediation shall not adversely affect any right or legal remedy the parties hereto may otherwise have.

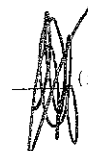
(f) The parties to this Agreement may each apply for state or federal registration of their respective rights, so long as such applications do not seek registration of marks or rights in conflict with the provisions of this Agreement, and so long as such registrations do not grant rights in conflict with the provisions of this Agreement. Should any party to this Agreement believe that such application or registration violates the terms or provisions of this Agreement, registration of the applied for mark may be opposed, or its cancellation sought, without violating the present Agreement.

(g) Should either party abandon its mark, any rights conferred to that party by this Agreement shall be lost and the other party may thereafter use its mark in all proper ways, unrestrained by the terms of this Agreement, and may thereafter apply for and obtain a federal registration of its mark unrestricted by the Agreement.

3. Miscellaneous Terms and Conditions:

(a) Both parties to this Agreement may license or assign their respective rights hereunder, in whole or in part, provided that such license or assignment does not extend beyond the provisions of this Agreement.

 (initials)

 (initials)

(b) This Agreement together with any Exhibit(s) attached hereto and incorporated herein by reference contain the entire agreement of the parties hereto and no prior written or oral negotiations, representations, inducements, promises, or agreements between them regarding the subject of this Agreement not embodied herein shall be of any force or effect.

(c) This Agreement may not be superseded and none of the terms of this Agreement can be waived or modified except by an express written agreement signed by all parties hereto. Any oral representations or modifications concerning this Agreement shall be of no force or effect unless contained in a subsequent written modification signed by all parties.


(d) The failure of either party to enforce any provision of this Agreement shall not be construed as a waiver of any such provision, nor prevent such party thereafter from enforcing such provision or any other provision of this Agreement. The rights and remedies granted both parties herein are cumulative and the election of one shall not constitute a waiver of such party's right to assert all other legal remedies available under the circumstances.


(e) The captions, subject, section, and paragraph headings in this Agreement are included for convenience and reference only and do not form a part hereof, and do not in any way codify, interpret, or construe the intent of the parties or affect the construction or interpretation of any provision of this Agreement.

(f) The language of all parts of this Agreement shall in all cases be construed as a whole, according to its fair meaning, and not strictly for or against any of the parties. If any provision is declared invalid or unenforceable, such provision shall be deemed modified to the extent necessary to render it valid and enforceable. Otherwise, if any provision of this Agreement is held by an arbitrator or court of competent jurisdiction to be unenforceable, void, illegal or invalid, said provision shall be deemed to be severed and deleted, and neither such provision, its severance or deletion, shall affect the validity or affect the remaining covenants and provisions of this Agreement. No covenant or provision shall be deemed dependant upon any other unless so expressly provided herein. As used in this Agreement, the masculine or neuter gender and singular or plural number shall be deemed to include the others wherever the context so indicates or requires.

(g) In the event any party to this Agreement commences any action, legal or otherwise, concerning any aspect of this Agreement, including but not limited to the interpretation or enforcement of any of its provisions or because of any alleged dispute, breach, default, or misrepresentation in connection with any aspect or provision of this Agreement, the prevailing party shall be entitled to recover reasonable attorneys' fees and all other costs and expenses incurred in connection with the action or proceeding, including without limitation expert witness fees, court reporter fees, collection expenses, and the costs of appeal, in addition to any other relief that party may be entitled. The award of attorney's fees shall not be bound by any court fee schedule, but shall, if it is in the interest of justice to do so, include the full amount of costs, expenses, and attorney fees incurred in good faith.

(h) The original of this Agreement and one or more copies hereof have been prepared

 (initials)

 (initials)

and signed as duplicate originals, and each of the parties hereto shall retain an originally signed copy hereof. Each duplicate original shall be deemed an original instrument as against any party who has signed it. All exhibits referred to herein are hereby deemed incorporated by this reference.

(i) All notices, requests, demands, and other communications required or desired to be given pursuant to this Agreement shall be in writing and shall be deemed to have been given when personally served or by mailing it, postage fully prepaid, registered or certified mail, return receipt requested, addressed to the respective party to whom notice is being given at the address set forth at the beginning of this Agreement or at such other address as the respective party may from time to time designate by written notice given pursuant to this paragraph. Such notices or other communications shall be deemed effective at the time of personal delivery or three (3) business days after mailing in the manner set forth in this numbered paragraph.

Upon receipt by A.C.E. of an executed duplicate original of this Consent to Use and Register Agreement and acceptance by the United States Patent and Trademark Office of ASICS' Voluntary Amendments as detailed herein, A.C.E. will promptly dismiss, without prejudice, its Oppositions to the ASICS Trademarks. Further, the parties herein agree to consent to and submit additional Requests for Extensions of Time as necessary pending acceptance of ASICS' Voluntary Amendments.

American Council on Exercise

By: 

Scott Goudeseune

(print/type name)

Title: Chief Executive Officer

Dated: 22 September, 2011

Asics Corporation

By: 


TOSHIYUKI SANO

(print/type name)

Its: Director & Managing Executive Officer

(Title)

Dated: October 13, 2011

 (initials)


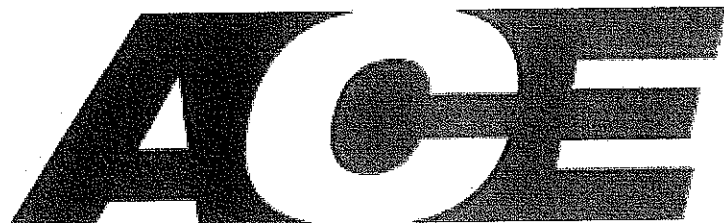
 (initials)

EXHIBIT A

Depiction of ACE Logo



AC (initials)

_____ (initials)