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

Proceeding	91216671
Party	Defendant Nanjing Fire Protection Technology Co., Ltd.
Correspondence Address	NANJING FIRE PROTECTION TECHNOLOGY CO LTD 599 ZHUSHAN RD, JIANGNING DISTRICT NANJING, 211100 CHINA tim@headleyiplaw.com
Submission	Other Motions/Papers
Filer's Name	Tim Headley
Filer's e-mail	tim@headleyiplaw.com
Signature	/Tim Headley/
Date	08/20/2014
Attachments	2014 08 20 Maxtek v. Naxtek Co-Existence Agreement (Inficon_s signature).PDF(1506398 bytes)

CO-EXISTENCE AGREEMENT

This Co-existence Agreement (hereinafter “the Agreement” or “this Agreement”) is entered into as of the 3rd day of July, 2014 (hereinafter “the Effective Date”), by and between INFICON GMBH, a corporation having a place of business at Hintergasse 15B, CH-7310 Bad Ragaz, Switzerland (hereinafter “INFICON”) and NANJING FIRE PROTECTION TECHNOLOGY CO., LTD., a corporation having a place of business at 599 Zhushan Rd., Jiangning District, Nanjing 211100, China (hereinafter “NANJING”).

WHEREAS, INFICON has applied to register the mark “Maxtek” (hereinafter “the INFICON Mark”) in the United States Patent and Trademark Office (hereinafter “the USPTO”) as a trademark for “[s]cientific and measuring apparatus and instruments, particularly for measuring thin layers during the application of thin-layer coatings and quartz crystal microbalances; accessories for the above-mentioned goods” in International Class 9, Application Serial No. 79/139,120, filed October 7, 2013; and

WHEREAS, NANJING has applied to register the mark “NaXtek (stylized)” (hereinafter “the NANJING Mark”) in the USPTO as a trademark for “[a]ccess control and alarm monitoring systems; Acoustic sound alarms; Alarm central units; Alarm installations and alarms; Alarm monitoring systems; Alarm that utilizes pressure sensitive pads to monitor patients or resident movement; Alarms for the detection of inflammable gases; Anti-intrusion alarms; Building security systems comprising software and hardware for providing picture, video, alarm status, building plans, and other information to a remote station; Carbon dioxide discharge valves for use in fire suppression systems; Carbon dioxide refrigeration apparatus for use in fire suppression systems; Electrical controls for irrigation sprinkler systems; Electronic alarm for

providing notice of bed-wetting; Electronic door alarms; Electronic exit alarms; Environmental monitoring system comprised of meters and sensors that measure pressure, humidity, temperature and includes alarm and reporting functions; Fire alarm and emergency evacuation devices, namely, fire alarm control panels, smoke detectors, heat detectors, alarm pull stations, audible and visible notification appliances, strobes, sirens, bells, horns, and speakers; Fire alarms; Fire alarms in the shape of Christmas tree ornaments; Fire and smoke detectors; Fire boats; Fire engines; Fire extinguishers; Fire extinguishing apparatus; Fire extinguishing apparatus for automobiles; Fire fighting equipment, namely, fire fighting monitors that spray foam or liquids on fires; Fire hose nozzles; Fire pumps; Fire sprinklers; Fire-extinguishers; Fire-extinguishing systems; Fire-fighting equipment, namely, water cannons; Gas alarms; Leak detecting device for water supplied home appliances consisting of water sensor, control unit with audible alarm and water valves; Manual control panels for use in carbon dioxide fire suppression systems; Release valves and switches for use in carbon dioxide fire suppression systems; Security alarm controllers; Security and fire alarms; Smoke alarm tester in the nature of a cool burning smoke generator; Smoke alarms; Sound alarms; Sprinkler heads for fire sprinklers; Sprinkler systems for fire protection; Sprinkler valve wiring hubs, including both computerized and non-computerized units; Telecommunications equipment, namely, fiber-optic transceivers, fiber optic repeaters, converters and optimizers, wave division multiplexers, free-space optics transmission systems, switches including Ethernet switches and routers, fiber-to-the-home and ethernet-over-VDSL access aggregators, terminators and repeaters, and remote presence management products, namely, switches, and console, alarm, sensor and power management devices; Thermally activated manually resettable fire safety valves; Wireless digital electronic apparatus to secure and protect data and images on all forms of wireless equipment including

mobile telecommunications equipment using an automatic synchronization process and alarm notification of the loss or theft of the wireless equipment including mobile telecommunications equipment” in International Class 9, Application Serial No. 86/049,708, filed August 28, 2013; and

WHEREAS, INFICON asserts that the INFICON Mark will be damaged by registration of the NANJING Mark due the broad description of goods in the NANJING application; and

WHEREAS, INFICON has filed Opposition Proceeding No. 91216671 against the NANJING Mark; and

WHEREAS, the parties, having carried out negotiations through their counsel, believe that their respective marks can co-exist without confusion, mistake, or deception pursuant to the terms and conditions of this Agreement.

NOW, THEREFORE, in consideration of the mutual promises contained herein, and for other good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged by each of the parties, it is hereby mutually agreed as follows:

1. The parties are entering into this Agreement to document the steps being taken to avoid possible confusion between their marks, such that the parties’ respective marks may co-exist without confusion.

2. NANJING hereby agrees to restrict its identification of goods in Class 9 by inserting the clause “..., none of the above goods for use in the field of thin film deposition control.” The parties agree that the limitation of goods identified in this Paragraph 2 will serve to prevent possible confusion between the marks.

3. **Consent by INFICON.** INFICON hereby consents to use and registration of the NANJING Mark in the United States of America for the goods recited in aforementioned application as amended pursuant to Paragraph 2 above. INFICON will not object to, challenge or otherwise interfere with the use or registration of the NANJING Mark by NANJING, provided that NANJING limits its use and registration of the Mark as set forth herein.

4. **Consent by NANJING.** NANJING hereby consents to use and registration of the INFICON Mark in the United States of America for the goods recited in the aforementioned application. NANJING will not object to, challenge or otherwise interfere with this or any future use of the INFICON Mark for the goods and any services related thereto.

5. **Avoidance of Confusion.** Neither Party will in any way attempt to associate himself with the other party or its services or business activities. Each party will take all reasonable measures within his control to avoid confusion between the parties' respective marks. In particular, NANJING will not use or register any mark or logo that is likely to cause confusion with any "MaxTek" mark or logo now or hereafter used by INFICON. In the event that any evidence of confusion should arise in the future, the parties agree to promptly notify each other, cooperate and find mutually-acceptable ways to eliminate or minimize any future confusion.

6. **Filing; Further Steps.** To facilitate the purpose of this Agreement, within five (5) business days of date on which this Agreement has been fully executed, NANJING shall file a written request to amend the identification of goods in its application as set forth in Paragraph 2 above with the Trademark Trial and Appeal Board . INFICON hereby provides its consent to the filing of said request for amendment. If the filing of such amendment does not suffice to achieve the parties' purpose in making this Agreement, INFICON may request that NANJING execute and deliver such further documents to accomplish the purpose of this Agreement, and

both parties shall work in good faith to resolve any other issues. NANJING shall respond to such a request within five (5) business days of receipt of the request, and shall provide the requested execution or documents within ten (10) days of receipt of the request, at its own expense.

7. **Opposition Proceeding.** Provided that NANJING files the amendment pursuant to Paragraph 6 above and such amendment is accepted by the USPTO, INFICON agrees that it will withdraw the Opposition proceeding against the NANJING Mark.

8. **Release.** As material inducement to each party entering into this Agreement, each party, individually, collectively and on behalf of its representatives, successors, assigns, officers, directors, employees, predecessors, affiliates, and agents (collectively, "Releasing Parties"), irrevocably and unconditionally releases, and forever discharges all other parties to this Agreement and their present, past, and future parents, subsidiaries, and affiliated corporations, divisions, affiliates, predecessors, principals, partners, joint venturers, representatives, successors, and assigns, and their past and present owners, directors, officers, employees, stockholders, attorneys, agents, and insurers, and all persons acting by, through, under or in concert with any of them (collectively referred to as "Releasees"), individually and jointly, from all known losses, charges, complaints, promises, agreements, suits, causes of action, claims, judgments, damages, indemnity, contribution, liabilities, and expenses, including any claims for attorneys' fees and costs, of any kind and character, that exist as of the Effective Date ("Claim" or "Claims"), which the Releasing Parties have, own, or hold, or claim to have, own, or hold, against each or any of the Releasees from the beginning of the world relating in any way to their mark as identified herein.

9. **No Partnership.** Nothing contained in this Agreement shall be construed as creating a partnership, joint venture, agency or employment relationship between the parties.

10. **Entire Agreement.** This Agreement is the entire agreement between the parties with respect to the subject matter hereof and supersedes all prior agreements or understandings, whether written or oral. This Agreement may not be modified, amended or supplemented, and no provision may be waived, except by a writing signed by a duly authorized representative of each of the parties.

11. **Representation by Counsel.** Each party acknowledges that he has sought or had the opportunity to seek the representation of independent counsel with regard to the subject matter hereof. This Agreement has been drafted by both parties and shall not be interpreted against either party as the drafter.

12. **Representation as to Authority.** Each party represents and warrants that he has the sole right and exclusive authority to execute this Agreement and that he has not sold, assigned, transferred, conveyed or otherwise disposed of any claim or demand, or any portion of or interest in any claim or demand, relating to any matter covered hereby.

13. **Costs and Attorneys' Fees.** Except as expressly provided herein, each party will bear his own costs and attorneys' fees incurred as a result of this dispute and the resolution thereof by means of this Agreement.

14. **Damages in the Event of Breach.** If either party breaches any term of this Agreement, the breaching party shall be responsible for whatever damages the other party incurs as a result of said breach, plus reasonable attorney's fees and costs incurred in enforcing the

terms of this Agreement. The remedy provided in this Paragraph shall be in addition to any remedy provided elsewhere in this Agreement or any other remedies available at law or equity.

15. **Successors and Assigns.** This Agreement shall extend to, inure to the benefit of, and be binding upon the parties and their respective directors, officers, partners, proprietors, attorneys, agents, servants, employees, representatives, affiliates, subsidiaries, shareholders, predecessors, successors and assigns.

16. **Severability.** All parties believe that the provisions of this Agreement are reasonable and fair in all respects, and are necessary to protect the interests of each party. However, in case any one or more of the provisions or parts of a provision contained in this Agreement shall, for any reason, be held to be invalid, illegal or unenforceable in any respect in any jurisdiction, such invalidity, illegality or unenforceability shall not affect any other provision or part of a provision of this Agreement or any other jurisdiction, but this Agreement shall be reformed and construed in any such jurisdiction as if such invalid or illegal or unenforceable provision or part of a provision had never been contained herein and such provision or part shall be reformed so that it would be valid, legal and enforceable to the maximum extent permitted in such jurisdiction.

17. **No Oral Modification.** This Agreement may not be amended or modified in any respect whatsoever, except by a writing duly executed by an authorized representative of each party, and the parties each agree that each will make no claim at any time that this Agreement has been orally amended or modified. No oral waiver of any term shall be effective for any purpose.

18. **Integration.** This Agreement sets forth the entire agreement between the parties to this Agreement and fully supersedes all other oral and written understandings or agreements

between the parties pertaining to the subject matter of this Agreement. The terms of this Agreement are contractual and not mere recitals, and the nonenforceability of any provision of this Agreement shall not affect the enforceability of any other provision.

19. **Governing Law/Venue.** This Agreement shall be construed and governed by the substantive laws of the United States of America relating to trademarks and unfair competition, and to the procedural laws of any State of the United States of America where any alleged breach of the agreement should occur, without regard to its principles of conflicts of laws.

20. **Term and Expiration.** This Agreement shall remain in effect for so long as both Parties or their successors continue to use and have not abandoned their respective marks in the United States of America or its territories or possessions. This Agreement will expire if either party or his successor ceases all use of and abandons his mark with no intent to resume use in the United States of America, its territories and possessions.

21. **Notices.** All notices to be given pursuant to this agreement shall be sent via overnight courier to the party receiving notice at the following addresses:

If to INFICON: Hintergasse 15B
CH-7310 Bad Ragaz
SWITZERLAND

With a copy to: Jason S. Nardiello
Hiscock & Barclay, LLP
One Park Place
300 South State Street
Syracuse, New York 13202
(315) 425-2817
jnardiello@hblaw.com; ip@hblaw.com

If to NANJING: 599 ZHUSHAN RD., JIANGNING DISTRICT

NANJING, 211100

China

With a copy to:

Yale Young

4100 Legacy Dr., #404, Plano, TX 75024

yale.young@orientechcompany.com

(469) 855-0551

22. Counterparts. This Agreement may be executed in one or more counterparts, each of which shall be deemed an original, all of which together shall constitute one and the same instrument. A signature to this Agreement transmitted via facsimile shall be deemed as effective as an original signature. A copy hereof shall have the same effect as the original.

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

INFICON GMBH

NANJING FIRE PROTECTION
TECHNOLOGY CO., LTD.

By: 

By: 

(Signature)

(Signature)

Matthias Trondle

Erika Bollhalder

(CFO)

(Finance/Con-
troller)

Its: _____

Its: General Manager

Date: 9/7/2014

Date: 31st of July, 2014