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Filing date: **03/04/2020**

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

Proceeding	91251210
Party	Defendant Rhino USA, Inc.
Correspondence Address	DARIUSH G ADLI ADLI LAW GROUP PC 444 SOUTH FLOWER STREET, SUITE 3100 LOS ANGELES, CA 90071 UNITED STATES adli@adlilaw.com, docketing@adlilaw.com 213-623-6546
Submission	Other Motions/Papers
Filer's Name	William Ceravone
Filer's email	william.ceravone@adlilaw.com, docketing@adlilaw.com
Signature	/William Ceravone/
Date	03/04/2020
Attachments	2020-03-03 - Fully Executed Agreement.pdf(332127 bytes)

SETTLEMENT AGREEMENT

This Settlement Agreement (the "Settlement Agreement") is entered into by and between Mdm Products LLC, a Connecticut Limited Liability Company with a principal place of business at 105 Woodmont Road, Milford, CT 06460 (hereinafter "MDM"); and Rhino Usa, Inc., a California corporation with a principal place of business at #1001 38365 Innovation Court, Murrieta, California 92563 (hereinafter "RHINO USA").

MDM and RHINO USA are hereinafter collectively referred to as "the Parties" and either MDM or RHINO USA may be referred to separately herein as a "Party". This Agreement is effective when it has been executed by both parties.

RECITALS

This Settlement Agreement is made by and between the Parties for the full settlement and resolution of a certain dispute between the Parties regarding the RHINO SHELTER® and RHINO USA™ trademarks, as hereinafter described.

WHEREAS, MDM is a leading manufacturer and distributor of instant garages and protective fabric canopies and tents for storage of vehicles, industrial equipment and machinery, recreational use and vehicle covers.

WHEREAS, MDM is the owner of the trademark RHINO SHELTER and RHINOSHELTER.COM (hereinafter "MDM's Marks") for use in connection with "instant garages, tents, tarpaulins, protective fabric canopies and tents for storage of vehicles, industrial equipment and machinery; protective fabric canopies and tents for recreational use; unfitted vehicle covers" in international class 22 (hereinafter "MDM's Goods").

WHEREAS, MDM's trademark rights its RHINO SHELTER trademark commenced in 2006.

WHEREAS, MDM is the owner of U.S. Trademark Registration No. 3518363 for the trademark RHINO SHELTER registered on October 14, 2008.

WHEREAS, on August 31, 2017, RHINO USA filed a Trademark Application with the U.S. Patent and Trademark Office for the trademark RHINO USA under U.S. Application Nos. 87-592517 for cargo and carrier equipment for vehicles comprised of synthetic textile materials, excluding artificial leather, namely, tow ropes, tow straps, ratchet tie-down straps, quick release tie down straps, lashing straps, and tarp straps in international class 22.

WHEREAS, MDM has objected to RHINO USA's use and registration of the name RHINO USA.

WHEREAS, on September 25, 2019, MDM instituted opposition proceedings against RHINO USA's U.S. Trademark Application Serial No. 87-592517 which was assigned Opposition No. 91251210 (the "Opposition").

WHEREAS, the Parties wish to resolve their dispute amicably and without incurring further legal fees associated with Opposition Proceedings or litigation.

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

A. COVENANTS OF RHINO USA

1. RHINO USA agrees not to use the names "RHINO USA" or "RHINO" alone, or in combination with any other words or designs, for "instant garages, tents, tarpaulins, protective fabric canopies and tents for storage of vehicles; instant garages, tents, tarpaulins, protective fabric canopies and tents for storage of industrial equipment and machinery; protective fabric canopies and tents for recreational use; unfitted vehicle covers".
2. RHINO USA agrees not to file any trademark applications for the names "RHINO USA" or "RHINO" alone, or in combination with any other words or designs for "instant garages, tents, tarpaulins, protective fabric canopies and tents for storage of vehicles; instant garages, tents, tarpaulins, protective fabric canopies and tents for storage of industrial equipment and machinery; protective fabric canopies and tents for recreational use; unfitted vehicle covers".

3. RHINO USA shall amend the identification of goods in U.S. Trademark Application Serial No. 87-592517 by filing Post Publication Amendments with either (1) the Trademark Trial and Appeal Board using the form attached hereto as Exhibit A or (2) the U.S. Patent and Trademark Office within ten (10) days upon execution of this Agreement as follows (hereinafter "RHINO USA's Proposed Amended Goods"):

Proposed Amended Goods in RHINO USA Serial No. 87-592517:

(Int'l Class: 22) cargo and carrier equipment for vehicles comprised of synthetic textile materials, **excluding instant garages, tents, tarpaulins, protective fabric canopies and vehicle covers; and** excluding artificial leather, namely, tow ropes, tow straps, ratchet tie-down straps, quick release tie down straps, lashing straps, and tarp straps.

If the U.S. Patent and Trademark Office does not accept RHINO USA's Proposed Amended Goods and Services, the parties will assist each other and negotiate in good faith to provide an amendment acceptable to the U.S. Patent and Trademark Office.

4. RHINO USA shall not use or seek to register any name that is confusingly similar with RHINO or RHINO SHELTER for MDM's Goods defined above.
5. RHINO USA agrees not to object to, oppose or cancel MDM'S Trademark Applications and/or registrations for RHINO SHELTER, RHINO, and RHINOSHELTER.COM for MDM's Goods defined. RHINO USA shall promptly execute any requested consents in support of registration of MDM's Trademark Applications for MDM's Mark for MDM's Goods and Services defined herein, as well as any other documents required by the U.S. Trademark Office to effectuate the terms of this Agreement. If a Letter of Consent is not sufficient to overcome a citation raised during trademark prosecution, the parties will assist each other and negotiate in good faith to seek to overcome the citation.

B. COVENANTS OF MDM

1. MDM agrees not to use or register the name RHINO USA, or a confusingly similar name to RHINO USA, for any goods or services that are identical or substantially identical to RHINO USA's Proposed Amended Goods defined above.
2. MDM agrees not to use or register the name RHINO USA.
3. Concurrently with the execution of this Agreement, MDM shall execute the form attached hereto as Exhibit A, which reflects MDM's consent to RHINO USA's registration of RHINO USA for RHINO USA's Proposed Amended Goods, and conditionally withdraws the Oppositions with prejudice upon entry of such amendments.
4. MDM hereby waives, releases, discharges RHINO USA, and all of its entities, subsidiaries, affiliates and its respective shareholder members, directors, managers, officers, employees, attorneys, agents and representatives from any and all claims of past infringement.
5. MDM agrees not to object to, oppose or cancel RHINO USA's trademark applications and/or registrations for RHINO USA for RHINO USA's Proposed Amended Goods, so long as RHINO USA complies with the terms of this Agreement.
6. MDM shall promptly execute any requested consents in support of registration of RHINO USA's trademark applications and/or registrations for RHINO USA for RHINO USA's Proposed Amended Goods, as well as any other documents required by the U.S. Trademark Office to effectuate the terms of this Agreement. If a Letter of Consent is not sufficient to overcome a citation raised during trademark prosecution, the parties will assist each other and negotiate in good faith to seek to overcome the citation.

C. GENERAL TERMS AND CONDITIONS

1. Each Party hereto shall be solely responsible for its own legal expenses and costs in connection with this Settlement Agreement, including the negotiation, execution, and performance of this Settlement Agreement.
2. This Settlement Agreement constitutes the entire agreement between the Parties pertaining to the subject matter hereof. Accordingly, this Settlement Agreement supersedes and replaces all prior negotiations, agreements, understandings and/or contracts between the Parties, whether written or oral, on that subject.
3. Unless stated otherwise herein, the Parties acknowledge and agree that the matters set forth in this Agreement constitute the settlement and compromise of disputed claims, and that this Agreement and the terms contained herein are not, and shall not be construed to be an admission or evidence of any liability or fault by any party regarding any claims asserted or which could have been asserted by any party.
4. If any provision of this Settlement Agreement or the application thereof is held invalid, the invalidity shall not affect other provisions or applications of this Settlement Agreement which can be given effect without the invalid provisions or applications. To this end, the provisions of this Settlement Agreement are declared to be severable.
5. There will be no publicity as to the terms, conditions or existence of this Agreement, except to the extent agreed upon in writing between the Parties.
6. The scope of this Agreement shall be the United States.
7. Any dispute arising out of this Agreement shall be brought in the federal and state courts located where either party maintains its principal place of business, which shall have exclusive jurisdiction to adjudicate all matters involving the Parties and this Agreement. The Parties irrevocably submit to the exclusive jurisdiction of those courts.
8. Both Parties have participated in the negotiation and preparation of the Settlement Agreement. Therefore this Settlement Agreement shall be construed in a fair and objective manner, and not strictly for or against either Party.

9. This Settlement Agreement may be executed in counterparts, and each counterpart, when executed, shall have the efficacy of a signed original. True and correct copies of such signed counterparts may be used in lieu of the originals for any purpose.

10. No waiver of any breach of this Settlement Agreement shall be binding unless in writing and signed by the Party waiving the breach. No waiver of any breach of this Settlement Agreement shall be, or construed to be, a waiver of any other breach of this Settlement Agreement.

11. In entering into this Settlement Agreement, the Parties represent that they have each read this Settlement Agreement in full, and that the terms of this Settlement Agreement and their consequences are fully understood and voluntarily accepted and agreed to by them.

12. Each person executing this Settlement Agreement on behalf of any Party represents and warrants that he or she is fully authorized and empowered to execute this Settlement Agreement, and that all necessary action for the execution of this Settlement Agreement has been taken.

13. This Agreement is not assignable by either Party, except upon written permission from the other Party, with the exception of related companies under common control and ownership.

14. Each of the covenants and undertakings of this Agreement shall be binding upon and shall inure to the benefit of the Parties' affiliates, subsidiaries, officers, directors, shareholders, predecessors, successors and employees.

15. As to the matters specified above, this instrument contains the entire Agreement between the Parties, and no modifications or termination hereof shall be binding on the Parties unless it is in writing and signed by a duly authorized officer of the Party to be bound. This Agreement and all its provisions are intended to be severable. Should a term or provision hereof be unenforceable, the remaining terms and provisions shall continue to be binding.

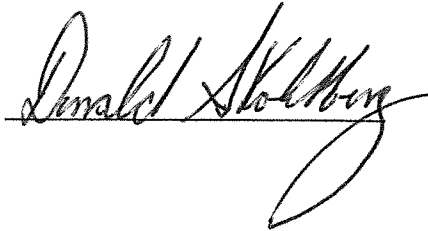
16. The Parties shall promptly execute any and all documents reasonably necessary to carry out and perform their obligations hereunder.

17. This Settlement Agreement is deemed to be effective as of the first date on which it has been duly executed by all of the signatories identified below.

IN WITNESS WHEREOF, the parties hereto have executed this Agreement by their executive officers thereunto duly authorized, on the day and year written below.

Mdm Products LLC

Date: 3.3.2020

By: 
Name:
Title:

Rhino USA, Inc.

Date: 2/3/20



By: _____
Name:
Title:

EXHIBIT A

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

In the matter of Application Serial No.

Mdm Products LLC,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91251210
)	
Rhino Usa, Inc.,)	
)	
Applicant.)	
)	

**MOTION ON CONSENT TO PERMIT POST-PUBLICATION AMENDMENT OF
APPLICATION; SUSPEND OPPOSITION;
AND CONDITIONALLY WITHDRAW OPPOSITION**

Opposer Mdm Products LLC (“Opposer”) and Applicant Rhino Usa, Inc. (“Applicant”) hereby move to (a) allow Applicant to amend the identification of goods for the mark RHINO USA in Application Serial No. 87-592517 (the “Application”) that is the subject of the above-captioned opposition proceeding; (b) suspend the opposition pending the Board’s review of the proposed amendment; and (c) withdraw the opposition with prejudice conditioned upon acceptance of the amendments.

Applicant proposes, with Opposer’s consent, to revise the goods and services in the Applications as follows:

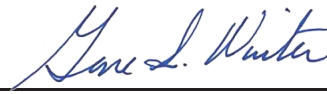
(Int’l Class: 22) cargo and carrier equipment for vehicles comprised of synthetic textile materials, **excluding instant garages, tents, tarpaulins, protective fabric canopies and vehicle covers; and** excluding artificial leather, namely, tow ropes, tow straps, ratchet tie-down straps, quick release tie down straps, lashing straps, and tarp straps.

The parties believe the amendment to be appropriate in that it limits the identification of goods without broadening them pursuant to TMEP § 1402.06 and 37 C.F.R. § 2.71(a), and, thus, no re-publication would be required.

The parties also jointly move to suspend the above-referenced opposition pending review of the proposed amendment. The parties further consent to the withdrawal of the opposition with prejudice upon the approval and entry of the proposed amendment.

Dated: March 3, 2020

Mdm Products LLC

By: 
Gene S. Winter
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REENS LLC
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Counsel for Opposer

Rhino Usa, Inc.

By: 
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Counsel for Applicant

CERTIFICATE OF SERVICE

I hereby certify that on this 5th day of February 2020, a copy of the foregoing MOTION ON CONSENT TO PERMIT POST-PUBLICATION AMENDMENT OF APPLICATION; SUSPEND OPPOSITION, AND CONDITIONALLY WITHDRAW OPPOSITION was sent by email to Opposer's counsel at the following email addresses of record:

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By: 

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