

ESTTA Tracking number: **ESTTA1358568**Filing date: **05/14/2024**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding no.	91271770
Party	Defendant Trico Products Corporation
Correspondence address	JILL J. CHALMERS BRYAN CAVE LEIGHTON PAISNER LLP 90 SOUTH CASCADE AVENUE SUITE 1300 COLORADO SPRINGS, CO 80903 UNITED STATES Primary email: jill.chalmers@bclplaw.com Secondary email(s): katherine.keating@bclplaw.com 719-473-3800
Submission	Other Motions/Submissions
Filer's name	Katherine A. Keating
Filer's email	katherine.keating@bclplaw.com, jill.chalmers@bclplaw.com, bcipdocketing@bclplaw.com
Signature	/Katherine A. Keating/
Date	05/14/2024
Attachments	TTAB - VALEO - SIGNED Stipulation Consent Motion.pdf(918546 bytes )

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

VALEO SERVICE,

Opposer,

v.

TRICO PRODUCTS CORPORATION,

Applicant.

Opposition No.: 91,275,010

Serial No.: 88/804745

Mark: FIRST BRANDS

Class: 7

Opposition No.: 91,271,770

Serial No.: 88/804,753

Mark: FIRST BRANDS

Class: 12

Opposition No.: 91,270,401

Serial No.: 88/804,761

Mark: FIRST BRANDS

Class: 35

**MOTION TO SUBSTITUTE OR JOIN APPLICANT AND TO AMEND  
APPLICATIONS, BOTH WITH CONSENT OF OPPOSER;  
JOINT STIPULATION TO WITHDRAW OPPOSITIONS**

Opposer and Applicant have resolved their dispute based on Applicant's amendment of the goods and services in Application Serial Nos. 88/804,753 and 88/804,761 and hereby stipulate to withdrawal of the above-referenced opposition proceedings (the "**Opposition Proceedings**") with prejudice upon the entry of the amendments requested below. The three opposed applications (Serial Nos. 88/804,745, 88/804,753, and 88/804,761) (the "**Applications**") have been assigned by Trico Products Corporation ("**Trico**") to First Brands Group, LLC ("**FBG**"), the successor to the portion of the ongoing and existing business of Trico to which the marks in the Applications pertain. To the extent necessary for entry of the requested amendments, Trico and FBG request that FBG be substituted for Trico or joined as a party to the above-referenced opposition proceedings.

**A. Requested Amendment**

Pursuant to 37 C.F.R. § 2.133 and TBMP § 514.02, Applicant hereby moves to amend the identification of goods in Application Serial No. 88/804,753 to delete the words “*windshield wipers, wiper blades and spray washer pumps, windshield, windshield wiper blades, windshield washer pumps*” from the identification of goods, as set forth below:

*automobile and vehicle parts and accessories, namely, ~~windshield wipers, wiper blades and spray washer pumps, windshield, windshield wiper blades, windshield washer pumps~~; automobile and vehicle parts and accessories, namely, gas powered springs, lift supports, lift struts, and gas struts, gas operated springs for use on hatch, trunk and hood doors for motor vehicles*

so that the resulting identification of goods reads, in its entirety, as follows:

*automobile and vehicle parts and accessories, namely, automobile and vehicle parts and accessories, namely, gas powered springs, lift supports, lift struts, and gas struts, gas operated springs for use on hatch, trunk and hood doors for motor vehicles.*

Applicant further moves to amend the identification of services in Application Serial No 88/804,761 to add the words “excluding windshield wipers,” as set forth below:

*providing an online computer database featuring information about pricing and specifications for vehicle parts, excluding windshield wipers; arranging and conducting incentive reward programs to promote the sale of automotive parts, excluding windshield wipers; providing an online computer database in the field of customer service; arranging and conducting incentive reward programs to promote the sale of automotive goods, excluding windshield wipers*

so that the resulting identification of goods reads, in its entirety, as follows:

*providing an online computer database featuring information about pricing and specifications for vehicle parts, excluding windshield wipers; arranging and conducting incentive reward programs to promote the sale of automotive parts, excluding windshield wipers; providing an online computer database in the field of customer service; arranging and conducting incentive reward programs to promote the sale of automotive goods, excluding windshield wipers.*

Opposer consents to the requested amendments to Application Serial No. 88/804,753 and Application Serial No 88/804,761.

**B. Substitution or Joinder of First Brands Group, LLC**

As reflected on the trademark assignment agreement recorded with the U.S. Patent and Trademark Office at Reel/Frame 8291/0626, a copy of which is attached hereto as **Addendum A**, Trico has assigned all right, title, and interest in and to the mark FIRST BRANDS, including the Applications, to FBG. If necessary for the requested amendments to the Applications to be entered, Trico and FBG hereby ask that FBG be substituted for Trico or joined as a party to the Opposition Proceedings. Opposer consents to such substitution or joinder.

**C. Withdrawal of Oppositions**

The parties jointly stipulate that the Oppositions be withdrawn with prejudice upon entry of the requested amendments.

Respectfully submitted,

VALEO SERVICE

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TRICO PRODUCTS CORPORATION



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FIRST BRANDS GROUP, LLC



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**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing MOTION TO SUBSTITUTE OR JOIN APPLICANT AND TO AMEND APPLICATIONS, BOTH WITH CONSENT OF OPPOSER; JOINT STIPULATION TO WITHDRAW OPPOSITIONS has been served on Opposer on **May 14, 2024** by sending a copy via e-mail to Opposer's counsel of record:

Bryce J. Maynard  
Buchanan Ingersoll & Rooney, PC  
1737 King Street, Suite 500  
Alexandria, VA 22314  
bryce.maynard@bipc.com

May 14, 2024



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Katherine Keating

**Addendum A**

**900822093 12/18/2023**

**TRADEMARK ASSIGNMENT COVER SHEET**

Electronic Version v1.1  
Stylesheet Version v1.2

ETAS ID: TM861898

<b>SUBMISSION TYPE:</b>	NEW ASSIGNMENT												
<b>NATURE OF CONVEYANCE:</b>	NUNC PRO TUNC ASSIGNMENT												
<b>EFFECTIVE DATE:</b>	06/10/2020												
<b>CONVEYING PARTY DATA</b>													
<table border="1"><thead><tr><th>Name</th><th>Formerly</th><th>Execution Date</th><th>Entity Type</th></tr></thead><tbody><tr><td>Trico Products Corporation</td><td></td><td>11/10/2023</td><td>Corporation: NEW YORK</td></tr></tbody></table>	Name	Formerly	Execution Date	Entity Type	Trico Products Corporation		11/10/2023	Corporation: NEW YORK					
Name	Formerly	Execution Date	Entity Type										
Trico Products Corporation		11/10/2023	Corporation: NEW YORK										
<b>RECEIVING PARTY DATA</b>													
<b>Name:</b>	First Brands Group, LLC												
<b>Street Address:</b>	Suite 5300												
<b>City:</b>	Cleveland												
<b>State/Country:</b>	OHIO												
<b>Postal Code:</b>	44114												
<b>Entity Type:</b>	Limited Liability Company: DELAWARE												
<b>PROPERTY NUMBERS Total: 3</b>													
<table border="1"><thead><tr><th>Property Type</th><th>Number</th><th>Word Mark</th></tr></thead><tbody><tr><td>Serial Number:</td><td>88804745</td><td>FIRST BRANDS</td></tr><tr><td>Serial Number:</td><td>88804753</td><td>FIRST BRANDS</td></tr><tr><td>Serial Number:</td><td>88804761</td><td>FIRST BRANDS</td></tr></tbody></table>	Property Type	Number	Word Mark	Serial Number:	88804745	FIRST BRANDS	Serial Number:	88804753	FIRST BRANDS	Serial Number:	88804761	FIRST BRANDS	
Property Type	Number	Word Mark											
Serial Number:	88804745	FIRST BRANDS											
Serial Number:	88804753	FIRST BRANDS											
Serial Number:	88804761	FIRST BRANDS											
<b>CORRESPONDENCE DATA</b>													
<b>Fax Number:</b>													
<i>Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.</i>													
<b>Phone:</b>	4156753400												
<b>Email:</b>	bcipdocketing@bclplaw.com												
<b>Correspondent Name:</b>	Katherine A. Keating												
<b>Address Line 1:</b>	Three Embarcadero Ctr												
<b>Address Line 4:</b>	San Francisco, CALIFORNIA 94111												
<b>ATTORNEY DOCKET NUMBER:</b>	FIRST BRANDS - TM ASSIGNM												
<b>NAME OF SUBMITTER:</b>	Katherine A. Keating												
<b>SIGNATURE:</b>	/Katherine A. Keating/												
<b>DATE SIGNED:</b>	12/18/2023												
<b>Total Attachments: 1</b> source=Trademark Assignment - FIRST BRANDS(609138759.1)-Executed#page1.tif													

CH \$90.00 88804745

900822093

TRADEMARK  
REEL: 008291 FRAME: 0626

**Addendum A**

**TRADEMARK ASSIGNMENT**

This Nunc Pro Tunc Trademark Assignment Agreement is made and entered into as of June 10, 2020 (the "Effective Date"), by and between Trico Products Corporation, a New York corporation with an address of 3255 West Hamlin Road, Rochester Hills, Michigan 48309 ("Assignor"), and First Brands Group, LLC, a Delaware limited liability company with an address of 127 Public Square, Suite 5300, Cleveland, Ohio 44114 ("First Brands").

Assignor is the owner and beneficiary of all rights, title, and interest in and to the following trademarks (the "Marks"), including the U.S. Trademark Applications listed below for the Marks (the "Applications"):

FIRST BRANDS	App. Ser. No. 88/804,745
FIRST BRANDS	App. Ser. No. 88/804,753
FIRST BRANDS	App. Ser. No. 88/804,761

First Brands is the successor to the portion of the ongoing and existing business of Assignor to which the Marks pertain.

Assignor desires to convey, transfer, assign, and deliver to First Brands all of its rights, title, and interest in and to the Marks and the goodwill of the business associated therewith and symbolized thereby, including the Applications; and First Brands desires to acquire the Marks and the goodwill of the business associated therewith and symbolized thereby, including the Applications.

NOW THEREFORE, for good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the parties agree as follows:


Assignor hereby conveys, transfers, assigns, and delivers to First Brands, *nunc pro tunc* as of June 10, 2020, all of Assignor's rights, title, and interest in, to, and under the Marks, including all common law rights connected therein; together with the goodwill of the business symbolized thereby and associated therewith, and any registrations of and applications to register the Marks, including the Applications; and together with all claims for damages by reason of past, present, or future infringement or other unauthorized use of the Marks, and with the right to sue for and collect damages.

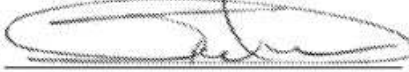
Assignor further covenants that it will execute all documents, papers, forms, and authorizations and take all other actions that may be necessary for securing, completing, or vesting in First Brands full rights, title, and interest in and to the Marks.

IN WITNESS WHEREOF, Assignor and Assignee have duly executed this Assignment, effective as of the Effective Date.

TRICO PRODUCTS CORPORATION

FIRST BRANDS GROUP, LLC

By: 

By: 

Name: Stephen Graham  
Title: CFO  
Date: 11-10-2023

Name: Stephen Graham  
Title: CFO  
Date: 11-10-2023