

ESTTA Tracking number: **ESTTA29563**

Filing date: **03/31/2005**

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

Proceeding	92041018
Party	Defendant REFAELY AND SONS INC. 7964 ARJONS SUITE F (IN THE REAR) SAN DIEGO, CA 92126
Correspondence Address	ANDREW LACHMAN EISNER & ASSOCIATES 9777 WILSHIRE BOULEVARD, SUITE 718 BEVERLY HILLS, CA 90212
Submission	Stipulated Withdrawal from Cancellation and Voluntary Surrender of Registration with Consent
Filer's Name	Andrew Lachman
Filer's e-mail	lachmanlaw@hotmail.com
Signature	/Andrew Lachman/
Date	03/31/2005
Attachments	Scan0007.tif (1 page) Scan0008.tif (1 page) Scan0009.tif (1 page) Scan0010.tif (1 page) Scan00011.tif (1 page) Scan00012.tif (1 page) Scan00013.tif (1 page) Scan00014.tif (1 page)

CERTIFICATE OF MAILING

I hereby certify that on March 31 2005, correspondence was filed with the Trademark Trials and Appeals Board via electronic filing on March 31 2005

Andrew Lachman
Andrew Lachman, Esq.

3/31/05
Date

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

In the matter of Trademark

Serial No.: **75773754**
Mark" BENEFEET

LANGER INC.

v.

REFAELY & SONS, INC.

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MAR 15 2005
MAR 15 2005
Epstein Drangel
Bazerman & James LLP

Cancellation Proceeding No. **92041018**

**STIPULATED WITHDRAWAL FROM CANCELLATION AND VOLUNTARY
SURRENDER OF REGISTRATION WITH CONSENT**

Respondent, Refaely & Sons, Inc. and Petitioner, Langer, Inc., by their attorneys hereby stipulate and agree as follows:

1. Respondent, Refaely & Sons, Inc. with the consent of Petitioner, Langer, Inc. hereby applies to the Patent and Trademark Office to voluntarily surrender the above referenced Registration for cancellation and requests that the Director cancel this Registration for reasons stated and pursuant to the terms of the attached Settlement Agreement between Petitioner and Respondent.
2. Petitioner Langer, Inc. with the consent of Respondent, Refaely and Sons, Inc., hereby withdraws the present cancellation proceeding no. 92041018 without prejudice.

SO STIPULATED AND AGREED.

Dated: March 15, 2005

By Andrew Lachman
Andrew Lachman, attorney for
Refaely & Sons, Inc.
9952 Santa Monica Blvd. 1st Floor
Beverly Hills, CA 90212
(310) 282-0507

By Harold James
Harold James, Attorney for Langer, Inc
Epstein Drangel Bazerman & James,
60 East 42nd Street, Suite 820
New York, NY 10165
(212) 292-5391

SETTLEMENT AGREEMENT

This agreement is between LANGER, INC., a New York corporation with its principal place of business at 450 Commack Road, Deer Park, New York 11729 (herein "Langer") and REFAELY & SONS INC., a California corporation with its principal place of business at 4130 La Jolla Village drive, PMB 10743, La Jolla, California 92037 and RAPHAEL REFAELY, president of Refaely & Sons Inc. (herein collectively and individually "Refaely").

WHEREAS, Langer is the owner of the trademark and service mark Registration No. 1,909,895 of August 8, 1995 and service mark Registration No. 1,936,282 of November 21, 1995 to the mark "BENEFOOT" and has been using that mark on the goods and services specified in those registrations; and

WHEREAS, Refaely is the owner of trademark Registration No. 2,352,015 of May 23, 2000 to the mark "BENEFEET" and has been using that mark on men's, women's and children's socks; and

WHEREAS, Langer has initiated a cancellation proceeding in the United States Patent and Trademark Office (Cancellation No. 92041018) to cancel the aforementioned Refaely registration, which cancellation proceeding is presently pending (the "Action"); and

WHEREAS, Refaely's use of "BENEFEET" has been in connection with socks for the general public while Langer's use of "BENEFOOT" has been in connection with goods and services involved in orthotics; and

WHEREAS, the parties are desirous of settling the dispute between them,

NOW, THEREFORE, IT IS HEREBY AGREED by and between the parties as follows:

1. Refaely agrees that it will expressly abandon its Registration No. 2,352,015 of May 23, 2000 and will, within thirty (30) days of the execution of this agreement, file in the aforementioned cancellation proceeding a formal document to that effect and a consent to the mutual termination of said cancellation proceeding.
2. Refaely further agrees in the future that it will use the mark "BENEFEET" only on men's, women's and children's socks which are:
 - (a) not health, medically or orthotically related;
 - (b) sold at retail in the United States, Mexico, Canada or anywhere else worldwide; and
 - (c) have the name and/or d/b/a of the manufacturer" appearing prominently on the labels and packages of the socks, and Langer agrees to such use by Refaely, provided, however, that Refaely may transfer this agreement, the rights to the use "BENEFEET," and any common law or other marks to another entity only if that entity does not offer health, medical or orthotic goods or services and if that entity agrees in writing communicated to Langer that it adopts all of the terms of this agreement.

3. This Agreement is binding on Langer, Inc., Refaely & Sons, Inc., Raphael Refaely, and their subsidiaries, successors and assigns.
4. Langer agrees that Refaely shall have and shall continue to have the right to use in commerce, and that Refaely shall be accorded other such rights related thereto in the mark "BENEFEEET" or any term similar thereto in accordance with the provisions set forth above.
5. In consideration of the Agreement and the releases contained herein, and except for any outstanding obligations owed under this Agreement Refaely and Langer generally relieves, releases and forever discharges to the full extent permitted by law each other and their successors and assigns of any such persons or entities, and each of them, of and from any and all claims based on, arising out of, relating to or in connection with anything whatsoever done, omitted or suffered to be done at any time prior to the date of this Agreement, including but not limited to any and all claims, based on, arising out of, relating to or in connection with the Action.
6. Each Party acknowledges that they have been advised by legal counsel and are familiar with the provisions of Section 1542 of the Civil Code of the State of California, which provides as follows:

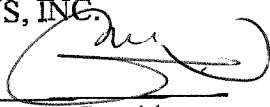
"A general release does not extend to claims which the creditor does not know or suspect to exist in his favor at the time of executing the release, which if known by him must have materially affected his settlement with the debtor."

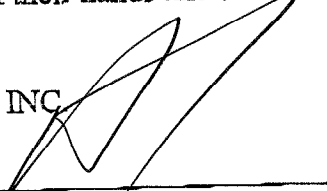
7. The Parties, and each of them, represent and warrant to each other and agree with each other, as follows:
 - a. Each Party has carefully read and reviewed this Agreement and understands it fully, and each Party has reviewed the terms of this Agreement with an attorney of the Party's choice prior to executing this Agreement;
 - b. This Agreement is the result of arm's length negotiation between the Parties;
 - c. Each Party agrees that it will not, either directly or indirectly, take any action which would interfere with the performance of this Agreement by any other Party, or which would adversely affect any of the rights provided for herein and shall not act in any manner inconsistent with this Agreement;
 - d. Each natural person executing this Agreement warrants that he or she has the authority to execute this Agreement on behalf of the Party on whose behalf said person is executing it. Each corporate Party or business entity Party represents and warrants that it is duly organized and in good standing in the jurisdiction or jurisdictions wherein it is incorporated, and that the execution and delivery of this Agreement has been duly authorized and approved by the required vote of its Board of Directors or members, if necessary;
8. **Joint Negotiation.** This Agreement has been jointly negotiated and drafted. The language of this Agreement shall be construed as a whole according to its fair meaning and not strictly for or against any Party, and it is agreed that no provision hereof shall be construed against any Party by virtue of the activities of that Party or such Party's


attorneys.

- 10. **Severability.** The Parties covenant and agree that in the event any provision of this Agreement should be held by a court of competent jurisdiction to be void, voidable, illegal or unenforceable in any respect, the remaining portions and provisions hereof shall nevertheless remain in full force and effect as if such void, voidable or unenforceable portion or provision had never been contained herein.
- 11. **Governing Law; Jurisdiction.** This Agreement is executed and delivered in the County of Los Angeles, State of California and shall be construed in accordance with, and governed by, the laws of the State of California with respect to contracts executed in and fully performed in the State of California.
- 12. **Arbitration.** In the event of a dispute between the parties arising from this Agreement, the parties agree to binding arbitration under the rules of the American Arbitration Association, the arbitrator to be mutually agreed to by the parties.
- 13. **No Admission of Liability.** The Parties acknowledge that this Agreement is made as a compromise of potential and actual disputed claims, that REFAELY and LANGER specifically deny liability for such claims, and that no act with respect to this Agreement, including the giving of consideration for the Agreement, shall be construed as an admission of liability or responsibility to any person. Neither this Agreement nor anything contained herein shall be admissible in any proceeding as evidence of or an admission by any of LANGER or REFAELY of any violation of any law or regulation or of any liability whatsoever to LANGER or REFAELY. Notwithstanding the foregoing, between the Parties, this agreement may be introduced into a proceeding solely for the purpose of enforcing this Agreement.
- 14. **Execution in Counterparts.** This Agreement may be executed and delivered in two or more counterparts, each of which, when so executed and delivered, shall be deemed an original. Signatures transmitted by fax shall be deemed to have the force and effect as original signatures

IN WITNESS WHEREOF, the parties have hereunto set their hands and seals the day and year set forth below.

REFAELY & SONS, INC.
 By: 
 Raphael Refaely, President
 Date: 2-24-05


LANGER, INC.
 By: 
 Andrew H. Meyers, President
 Date: 2/4/05

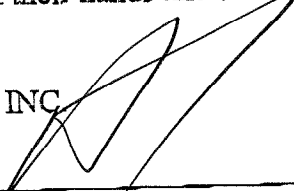
REFAEL REFAELY
 By: 
 Date: 2-24-05


attorneys.

- 10. **Severability.** The Parties covenant and agree that in the event any provision of this Agreement should be held by a court of competent jurisdiction to be void, voidable, illegal or unenforceable in any respect, the remaining portions and provisions hereof shall nevertheless remain in full force and effect as if such void, voidable or unenforceable portion or provision had never been contained herein.
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IN WITNESS WHEREOF, the parties have hereunto set their hands and seals the day and year set forth below.

REFAELY & SONS, INC.
 By: 
 Raphael Refaely, President
 Date: 2-24-05

LANGER, INC.
 By: 
 Andrew H. Meyers, President
 Date: 2/4/05

REFAEL REFAELY
 By: 
 Date: 2-24-05

The United States of America



CERTIFICATE OF REGISTRATION
PRINCIPAL REGISTER

The Mark shown in this certificate has been registered in the United States Patent and Trademark Office to the named registrant.

The records of the United States Patent and Trademark Office show that an application for registration of the Mark shown in this Certificate was filed in the Office; that the application was examined and determined to be in compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks; and that the Applicant is entitled to registration of the Mark under the Trademark Act of 1946, as Amended.

A copy of the Mark and pertinent data from the application are part of this certificate.

This registration shall remain in force for TEN (10) years, unless terminated earlier as provided by law, and subject to compliance with the provisions of Section 8 of the Trademark Act of 1946, as Amended.



A. Todd Pichini

Commissioner of Patents and Trademarks

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

Reg. No. 2,352,015

United States Patent and Trademark Office

Registered May 23, 2000

**TRADEMARK
PRINCIPAL REGISTER**

BENEFEET

REFAELY AND SONS INC. (CALIFORNIA CORPORATION), DBA THE SOCK FACTORY
7964 ARJONS SUITE F (IN THE REAR)
SAN DIEGO, CA 92126

FIRST USE 7-1-1999; IN COMMERCE 8-5-1999.

SER. NO. 75-773,754, FILED 8-12-1999.

MICHAEL MOORE, EXAMINING ATTORNEY

FOR: LINE OF MEN'S, WOMEN'S AND CHILDREN'S SOCKS, IN CLASS 25 (U.S. CLS. 22 AND 39).

CERTIFICATE OF SERVICE:

On this 31st day of March, 2005 this STIPULATED MOTION FOR WITHDRAWAL AND SURRENDER OF REGISTRATION was served via First Class Mail, postage pre-paid to:

Harold James
Epstein Drangel Bazerman & James
60 E. 42nd Street Suite 82-
New York, NY 10165

A handwritten signature in black ink, appearing to read "Andrew Lachman", with a long horizontal flourish extending to the right.

Andrew Lachman, Esq.