

ESTTA Tracking number: **ESTTA306212**

Filing date: **09/15/2009**

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

| | |
|------------------------|---|
| Proceeding | 92051107 |
| Party | Plaintiff Haywood Holdings, Inc. |
| Correspondence Address | Howard P. Walthall, Jr. Burr & Forman LLP 420 North 20th Street Suite 3400 Birmingham, AL 35203 UNITED STATES hpwaltha@burr.com, ivincent@burr.com, pkustos@burr.com |
| Submission | Motion to Extend |
| Filer's Name | India E. Vincent, Esq. |
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| Signature | /india e vincent/ |
| Date | 09/15/2009 |
| Attachments | PERMACLEAN PLAS - Motion to Extend Suspension.PDF (9 pages)(418955 bytes) |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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| | | |
|--|---|---------------------------|
| Haywood Holdings, Inc., |) | |
| |) | |
| Petitioner, |) | |
| |) | |
| v. |) | Cancellation No. 92051107 |
| |) | |
| Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V., |) | Mark: PERMACLEAN PLAS |
| |) | |
| Registrant. |) | Reg. No. 3,213,620 |
| | | |

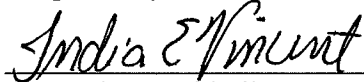
MOTION TO EXTEND SUSPENSION OF PROCEEDING

Petitioner, Haywood Holdings, Inc., hereby moves to extend the suspension of the above-captioned proceeding for an additional 6 months.

As of September 14, 2009, the Petitioner and Registrant entered into a Trademark Coexistence Agreement for PERMA-CLEAN II (U.S. Serial No. 77/567,975) (the "Petitioner's Mark") and PERMACLEAN PLAS (U.S. Registration No. 3,213,620) (the "Registrant's Mark") (the "Agreement"), a copy of which is attached hereto for reference. A copy of the Agreement was filed today in a Response to a Letter of Suspension in the application for registration of the Petitioner's Mark. Upon withdrawal of the Examining Attorney's refusal of registration and approval of the Petitioner's Mark for publication, the Petitioner will file a withdrawal of its petition to cancel the Registrant's Mark. As a result, Petitioner requests that this proceeding be suspended for the requested period to allow the Examining Attorney the opportunity to review and act upon the Response to Letter of Suspension.

Dated this 15th day of September 2009.

Respectfully Submitted,



Howard P. Walthall, Jr., Esq.

India E. Vincent, Esq.

Justin H. Kelly, Esq.

Burr & Forman, LLP

420 20th Street South, Suite 3400

Birmingham, Alabama 35203

Phone: (205) 251-3000

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*Attorneys for Petitioner,
Haywood Holdings, Inc.*

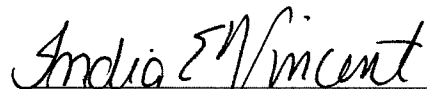
CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Motion to Extend Suspension of Proceeding was mailed to Registrant on September 15, 2009 by first class mail, postage prepaid, to the address listed by Registrant on his registration as follows:

Dr. Dirk Ostermann
Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V.
Hansastraße 27c
80686 München
Germany

A copy of the Motion was also sent on the above mentioned date to Registrant via email at dirk.ostermann@zv.fraunhofer.de.

Respectfully Submitted,


India E. Vincent, Esq.

TRADEMARK COEXISTENCE AGREEMENT

This Trademark Coexistence Agreement (the "Agreement") is entered into and effective as of the ____ day of _____, 2009 (the "Effective Date"), by and between Haywood Holdings, Inc., an Alabama corporation, located and doing business at 274 Wehapa Lakes Circle, Leeds, Alabama 35094 ("Haywood") and Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V., a Germany incorporated association, located and doing business at Patente und Lizenzen, Hansastrasse 27c, 80686 München, Fed Rep Germany ("Fraunhofer"). Haywood and Fraunhofer are sometimes referred to herein collectively as the "Parties" and individually as a "Party."

WHEREAS, Haywood has adopted and used through its affiliate Induron Coatings, Inc. ("Induron") the marks "PERMA-CLEAN" and "PERMA-CLEAN II" (the "Haywood Marks") in connection with protective coatings for use in protecting steel, iron and concrete from water, waterborne chemicals and other corrosive environments since at least as early as 1974;

WHEREAS, Fraunhofer has adopted and used the mark PERMACLEAN PLAS (the "Fraunhofer Mark") in connection with, among other things, material treating, namely application of protective coating and lacquering of surfaces. Fraunhofer has registered the mark in the United States by U.S. Registration No. 3,213,620 claiming a priority date of February 19, 2005 (the "Fraunhofer Registration");

WHEREAS, the Parties have considered each other's use and projected use of the respective marks, and are informed, and do not believe that concurrent use of their respective marks as outlined in this Agreement will cause confusion, deception, or mistake among consumers or the trade; and

WHEREAS, Haywood and Fraunhofer wish to peacefully co-exist in their respective markets and work together to avoid possible confusion in the marketplace.

NOW, THEREFORE, in consideration of the mutual covenants, representations and agreements hereinafter stated and for other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged by the Parties, Haywood and Fraunhofer, agree as follows:

1. **Whereas Clauses.** The foregoing recitals are incorporated herein in their entirety as if restated here in full and made a part of this Agreement.
2. **Absence of Likelihood of Confusion.**

2.1 The Parties agree that no likelihood of confusion exists between Haywood's use of the Haywood Marks for protective coatings for use in protecting steel, iron and concrete from water, waterborne chemicals and other corrosive environments where such coatings are intended for use in industrial environments and Fraunhofer's use of the Fraunhofer Mark for the application of protective coating and lacquering of surfaces for the purpose of allowing paint deposits to be easily cleaned from the surface. In determining that there is no likelihood of confusion, the Parties have considered that

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the products bearing the Haywood Marks are intended for use on interior surfaces to protect the surface from corrosive agents whereas Fraunhofer's application of protective coatings is intended to coat surfaces to make it easier to remove paint from such surfaces. The Parties acknowledge and agree that the coatings sold under the Haywood Marks and the coating services sold under the Fraunhofer Marks are marketed to different target customers and through different market channels because of their different applications. Because of the differing nature of the products sold under the Haywood Marks and the services provided under the Fraunhofer Mark, because the respective products are marketed to different customers and through different market channels, and because the appearance of the marks vary (the Haywood Marks appear in all caps, PERMA-CLEAN and PERMA-CLEAN II and the Fraunhofer Mark appears in print as either PermaCLEAN PLAS or PermaCLEAN^{PLAS}), the Parties have concluded that there is no likelihood of confusion.

2.2 Haywood agrees that it will use the Haywood Marks, or any confusingly similar form of the Haywood Marks, only in conjunction with the "Induron" mark (U.S. Registration No. 1,674,723), and that both the Induron Mark and one of the Haywood Marks will be prominently displayed on all printed materials bearing the Haywood Marks. Haywood further agrees that it does not and will not seek to market the products sold under the Haywood Marks for products or services designed to make paint easily removable from a surface.

2.3 Fraunhofer further agrees that it does not and will not seek to market its products sold under the Fraunhofer Mark in the area of sealants used to protect concrete, iron and steel from corrosive wastewater.

3. Registration of Haywood Marks.

3.1 Haywood is currently pursuing federal registration of PERMA-CLEAN II (U.S. Serial No. 77/567,975) and that application has been initially rejected based on a likelihood of confusion with the Fraunhofer Mark. Fraunhofer agrees that Haywood may file this Agreement with the USPTO as evidence of Fraunhofer's consent to Haywood's registration of the Haywood Marks, and Fraunhofer further agrees to provide whatever additional assistance Haywood requests for purposes of obtaining a federal registration of the Haywood Marks, including, without limitation, agreeing to concurrent use limitations on Fraunhofer's existing or new registrations, consistent with this Agreement.

3.2 Fraunhofer further agrees that it will not directly or indirectly oppose, contest, object, petition to cancel, or otherwise seek to challenge the Haywood Marks or Haywood's ability to register the Haywood Marks or Haywood's ability to maintain or renew any such registration for the Haywood Marks, or take any other action that would adversely affect the validity, registration and/or use of the Haywood Marks.

4. Registration of the Fraunhofer Mark. Haywood agrees that it will not directly or indirectly oppose, contest, object, petition to cancel, or otherwise seek to challenge the Fraunhofer Mark or the Fraunhofer Registration or Fraunhofer's ability to maintain or renew any registration for the Fraunhofer Mark, or take any other action that would adversely affect the validity, registration and/or use of the Fraunhofer Mark.

5. **Abandonment.** In the event either Party abandons its marks, as evidenced by (i) a final judgment or order by a court or administrative body of competent jurisdiction; (ii) express abandonment by the Party; (iii) cancellation of all of a Party's registration of its mark(s); and/or (iv) non-use for a period of five consecutive years, this Agreement shall terminate. The Party asserting termination of the Agreement under this paragraph shall provide notice to the other Party pursuant to Section 8 below.

6. **Termination.** In the event either the U.S. Patent and Trademark Office or a court finds this Agreement void, unenforceable, or insufficient to avoid a likelihood of confusion and allow for registration of the Haywood Marks, this Agreement shall automatically terminate and each Party reserves its rights with respect its marks and shall be entitled to enforce such rights as they existed immediately prior to the execution of this Agreement.

7. **Cooperation and Avoidance of Confusion.**

7.1 The Parties agree to execute and deliver all such additional documents, consents, instruments and certificates and shall take all such other actions as the other Party may reasonably request in connection with the consummation of this Agreement and effecting the intent and purpose hereof.

7.2 Each Party agrees not to take any steps to associate its marks, goods and/or services with the other Party's marks, goods or services. The Parties agree that if they restrict the use of their respective marks in the manner set forth above, no likelihood of public or consumer confusion should occur. Each Party agrees that in the unlikely event that any instances of confusion, mistake or deception occurs, the Parties will work together in good faith to take reasonable steps necessary to eliminate mistake or deception, and to use commercially reasonable efforts to avoid any future instances. Each Party agrees that in the event that either Party learns of any instance of actual confusion or mistake by a consumer or customer as to whether the Parties or their respective goods or services are associated or affiliated, the Party agrees to take reasonable steps to correct such misunderstanding.

8. **Notices.** All notices sent under any provision of this Agreement shall be sent in writing and by overnight mail or nationally recognized overnight courier, postage prepaid, said notice to be effective as of the date of receipt, as follows:

- a. Notices sent to Haywood shall be sent to:

Haywood Holdings, Inc.
Attn: David Hood, President
P.O. Box 2371
Birmingham, Alabama 35201
Phone: 205-521-9606

Oh

With a copy to:

India Vincent, Esq.
Burr Forman LLP
420 North 20th Street
Suite 3400
Birmingham, Alabama 35203
Phone: (205) 458-5284

b. Notices sent to Fraunhofer shall be sent to:

Fraunhofer-Gesellschaft zur Förderung
der angewandten Forschung e.V.
Patente und Lizenzen
Hansastraße 27c
80686 München, Fed Rep Germany
Attn: Dr. Dirk Ostermann
Phone: +49(0)89/1205-2522

Any change of address will be effective when sent in accordance with the provisions of this paragraph.

9. **Geographic Scope of Agreement.** This Agreement is effective in the United States of America and its territories and possessions.

10. **Construction.** The Parties agree that it is the intention of neither Party to violate any public policy, statutory or common law, or governmental regulation; that if any sentence, paragraph, clause or combination of the same is, or becomes, in violation of any applicable law or regulation, or is unenforceable or void for any reason, such sentence, paragraph, clause or combination thereof shall be inoperative, and the balance of this Agreement shall remain binding upon the Parties.

11. **No Modification.** No cancellation, modification, amendment, deletion, addition or other change in this Agreement or any provision hereof, or waiver of any right or remedy herein provided, shall be effective for any purpose unless specifically set forth in writing and signed by both Parties. No waiver of any right or remedy in regard to any occurrence or event on one occasion shall be deemed a waiver of any right or remedy in regard to such occurrence or event on any other occasion.

12. **Dispute Resolution.**

12.1 **Negotiation.** The Parties shall attempt in good faith to resolve promptly any dispute arising out of or relating to this Agreement by negotiation. If a matter cannot be resolved in the normal course of business, any interested Party shall give the other Party written notice of any such dispute not resolved. If said dispute has not been resolved by negotiation within 30 days of the disputing Party's written notice, either

Party shall be free to pursue such further efforts to resolve the dispute as each Party shall determine appropriate in its sole discretion.

12.2 Jury Waiver. EACH PARTY HEREBY EXPRESSLY WAIVES ITS RIGHT TO A TRIAL BY JURY AND AGREES THAT ANY LEGAL ACTIONS ARISING OUT OF OR RESULTING FROM THIS AGREEMENT SHALL BE RESOLVED BY A JUDGE SITTING WITHOUT A JURY.

12.3 Court Proceedings. Any legal action arising out of or related to this Agreement brought by either Party shall be brought before the District Court for the Northern District of Alabama to the exclusion of all others, and Alabama law shall apply to any relevant state law issues. The Parties hereby consent to the personal jurisdiction and venue of the state of federal courts sitting in Jefferson County, Alabama for any matter or proceeding brought by either Party relating to this Agreement.

12.4 Injunctive Relief. This Section 12 shall not be construed to limit or to preclude either Party from bringing any action at any time for injunctive or other provisional relief as necessary or appropriate.

13. Choice of law. The Parties agree that this Agreement shall be governed, construed and interpreted under and according to the laws of the State of Alabama, United States without regard to conflicts or choice of law principles.

14. Independent Contractors. The relationship between the Parties is solely that of independent contractors and not that of an agency, partnership, or joint venture. Neither Party has the authority to represent or bind the other.

15. Headings The headings in this Agreement are for convenience only and shall not define or limit any of the terms or provisions hereof.

16. Duplicate Originals. This Agreement may be executed in one or more counterparts, by manual or facsimile signature, each of which shall be deemed any original, but which together shall constitute one and the same instrument. However, the Agreement shall not be binding until all required counterparts are fully executed and delivered to the Parties to this Agreement.

17. Severability. If any provision, or portion thereof, of this Agreement shall be determined to be invalid, void, or otherwise unenforceable, and such provision, or portion thereof, does not alter the material purpose of this Agreement, such provision shall be deemed severed from this Agreement and the remainder of the Agreement shall remain in full force and effect.

18. Survival. Any provision of this Agreement which by its terms contemplates performance after the term of this Agreement shall survive any termination or expiration of this Agreement until fully performed.

19. Entire Agreement. This Agreement constitutes the entire agreement of the Parties regarding the subject matter hereof, provided that in the event the U.S. Patent and

Trademark Office determines that this Agreement is insufficient to ensure the absence of a likelihood of confusion between the Haywood Marks and the Fraunhofer Mark, Haywood reserves the right to assert the seniority of the Haywood Marks.

IN WITNESS WHEREOF, the Parties hereto have executed this Agreement in the manner appropriate for each as of the Effective Date.

**Fraunhofer-Gesellschaft zur
Förderung der angewandten Forschung e.V.**

By: *W. Knappe*

Print Name: Dr. Wolfgang Knappe

Title: Deputy Head of Patent Department

Date: September 14, 2009

Haywood Holdings, Inc.

By: *David D. Hood*

Print Name: DAVID D. HOOD

Title: PRESIDENT

Date: 14 SEP 2009