

ESTTA Tracking number: **ESTTA827632**

Filing date: **06/16/2017**

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

Proceeding	92065635
Party	Plaintiff Black Horse Racing, LLC
Correspondence Address	JAMES ROBERT (JIM) JOHNSON RESOLUTION LEGAL GROUP 100 EAST CALIFORNIA AVE , SUITE 200 OKLAHOMA CITY, OK 73104 UNITED STATES jim@resolutionlegal.com
Submission	Withdrawal of Petition to Cancel
Filer's Name	James Robert (Jim) Johnson
Filer's e-mail	jim@resolutionlegal.com
Signature	/James Robert (Jim) Johnson/
Date	06/16/2017
Attachments	Notice of Settlement and Withdrawal of Petition for Cancellation.pdf(80465 bytes) Consent Agreement - Black Horse and CPP Holding.pdf(602384 bytes)

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

In the matter of trademark Registration Number 2176547

**Mark: FIREBALL
Filing Date: May 12, 1997
Registration Date: July 28, 1998**

Black Horse Racing, LLC,)	
)	
Petitioner,)	
)	
vs.)	Cancellation Proceeding No.
)	92065635
CPP Holding Company, LLC,)	
)	
Respondent.)	

**To the Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451**

Submitted Electronically

**COMBINED NOTICE OF SETTLEMENT AGREEMENT AND WITHDRAWAL
OF OPPOSITION**

Petitioner, Black Horse Racing, LLC, hereby submits its Combined Notice of Settlement Agreement and Withdrawal of Cancellation (the "Withdrawal") in the matter of the trademark cancellation against CPP Holding Company, LLC, for the registered mark FIREBALL, U.S. Registration No. 2176547, for the reasons stated below.

It is hereby stipulated that the parties have reached a settlement and that Petitioner's Petition for Cancellation is withdrawn. It is further stipulated that the terms of the settlement are set forth in the Consent Agreement attached hereto.

Wherefore, premises considered, Petitioner respectfully requests that its Petition for Cancellation be withdrawn with prejudice.

Submitted this 16th day of June, 2017.

James Robert (Jim) Johnson
Resolution Legal Group
100 East California Ave., Suite 200
Oklahoma City, OK 73104
Telephone: 405-345-6500
Facsimile: 405-758-4775

/James Robert (Jim) Johnson/

James Robert (Jim) Johnson
Attorney for Petitioner
Black Horse Racing, LLC

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of Black Horse Racing, LLC's, Combined Notice of Settlement Agreement and Withdrawal of Cancellation was served electronically (by agreement) on June 16, 2017, on Karl Sawyer, counsel for Respondent CPP Holding Company, LLC.

By: /James Robert (Jim) Johnson/

James Robert (Jim) Johnson

CONSENT AGREEMENT

This Consent Agreement (hereinafter this "AGREEMENT") is made and effective as of the 9th day of June, 2017 (the "EFFECTIVE DATE"), between CPP Holding Company, LLC, a limited liability company organized and existing under the laws of Florida and having its principal offices at 3408 Democrat Road, Memphis, Tennessee 38118 (hereinafter "CPP") and Black Horse Racing, LLC, a limited liability company organized and existing under the laws of the state of Oklahoma, having its principal offices at 5600 N. May Ave., Suite 120, Oklahoma City, Oklahoma 73112 (hereinafter "BLACK HORSE"). CPP and BLACK HORSE may each herein be referred to as a "PARTY" and collectively as the "PARTIES."

WHEREAS, CPP is the owner of United States Trademark Registration No. 2,176,547, for the mark FIREBALL for "camshafts for producing mechanical motion in internal combustion engines for land vehicles, water craft and aircraft; valvetrain components for internal combustion engines in land vehicles, water craft and aircraft, namely, pushrods, cams; ignition systems for internal combustion engines in land vehicles, water craft, and aircraft, namely, ignition modules, ignition amplifiers, ignition coils, spark plug wires and points; points conversion kits comprised of brackets, optical triggers, and shutter wheels" in International Class 7 (hereinafter the "CPP '547 REGISTRATION"); and United States Trademark Registration No. 2,357,981 for "engine management computers, namely, engine controllers, rev-limiters, programmable input/output devices, namely, electronic engine controllers, and voltage regulators; battery chargers; surge protectors; testing and tuning apparatus for land vehicles, water craft, and aircraft, namely, degree wheels, degreing bushing, electronic precision dial indicators and top dead center locators, electronic pointer and checking springs, and tuneable computers for adjusting timing or adjusting fuel mixture" in International Class 9 (hereinafter the "CPP '981 REGISTRATION")

(hereinafter collectively the “CPP REGISTRATIONS”);

WHEREAS, BLACK HORSE is the owner of United States Trademark Registration No. 5,049,054, for the mark FIREBALL for “automobile customization services; automotive upgrade services, namely, supercharging, turbocharging and performance upgrades of automobiles” in International Class 37 (hereinafter the “BLACK HORSE REGISTRATION”); and United States Trademark Application Serial No. 86/909,267 for “automobiles; motor vehicles, namely, automobiles, trucks, vans, sport utility vehicles and structural parts therefor” in International Class 12) (hereinafter the “BLACK HORSE APPLICATION”) (hereinafter collectively the “BLACK HORSE REGISTRATION AND APPLICATION”);

WHEREAS, the BLACK HORSE APPLICATION is currently under rejection by the U.S. Patent and Trademark Office on the grounds of an asserted likelihood of confusion with the mark of the CPP ‘547 REGISTRATION;

WHEREAS, BLACK HORSE has filed a Petition to Cancel the CPP ‘547 REGISTRATION on the grounds of asserted abandonment, which has been assigned Cancellation Proceeding No. 92065635 by the Trademark Trial and Appeal Board of U.S. Patent and Trademark Office (the “CANCELLATION PROCEEDING”);

WHEREAS, after consulting with each other and based upon terms and conditions stated herein, the PARTIES agree and acknowledge that confusion is unlikely to arise from the use of the MARK, as hereinafter defined, for their respective CPP GOODS, as hereinafter defined, and BLACK HORSE GOODS AND SERVICES, as hereinafter defined, and the PARTIES desire to memorialize their understanding in this AGREEMENT;

NOW THEREFORE, in consideration of the foregoing premises and the mutual promises contained herein, the PARTIES agree as follows:

1. This Agreement shall govern the PARTIES' uses of the mark FIREBALL, alone or in combination with other terms or elements, and any and all iterations, variations, and derivations that would be confusing similar thereto (collectively the "MARK").
2. As used herein, "CPP GOODS" shall mean and include any and all mechanical and electrical components for internal combustion engines, including camshafts, camshaft components including cams and cam followers, valvetrain components including valves, hydraulic and mechanical lifters, locks, valve springs, spring retainers, stem seals, guides, locks, lash caps, pushrods, cylinder heads, pistons, timing chains and gear sets, steel, aluminum, and cast iron rocker arms, studs, nuts, valvetrain stabilizers, pushrod guideplates, distributor gears, balance shafts, and vacuum canisters and hardware therefor, ignition systems including ignition modules, ignition amplifiers, ignition coils, spark plug wires and points, points conversion kits including brackets, optical triggers, and shutter wheels, tools for use in engine testing, maintenance, and repair including valve seat machining tools and oil pump priming tools, engine management computers, engine controllers, rev-limiters, programmable input/output devices, electronic engine controllers, voltage regulators, battery chargers, surge protectors, engine testing and tuning apparatus including degree wheels, degreasing bushings, electronic precision dial indicators, top dead center locators, electronic pointer and checking springs, and tuneable computers for adjusting timing or adjusting fuel mixture.
3. As used herein, "BLACK HORSE GOODS AND SERVICES" shall mean and include fully assembled and roadworthy automobiles, trucks, vans, and sport utility vehicles, services for customizing and upgrading stock automobiles, trucks, vans, and sport utility vehicles produced by other manufacturers, including supercharging, turbocharging and

like performance upgrades thereof, customized body panels applied to automobiles as part of such customization and upgrade services, superchargers, turbochargers, ground effects kits, and spring lowering kits.

4. BLACK HORSE acknowledges the validity and enforceability of the CPP REGISTRATIONS in connection with the CPP GOODS, and agrees not to oppose, petition to cancel, or otherwise contest, either of the CPP REGISTRATIONS or otherwise to contest CPP's usage of the MARK for the CPP GOODS. BLACK HORSE agrees to dismiss the CANCELLATION PROCEEDING with prejudice within five (5) days of the EFFECTIVE DATE. BLACK HORSE acknowledges and agrees to the current and ongoing usage of the MARK by CPP for the CPP GOODS, and agrees not to oppose any further applications for trademark registration by CPP to the extent covering such usages of the MARK for the CPP GOODS. BLACK HORSE agrees to refrain from any use or attempt to register the MARK for any of the CPP GOODS. BLACK HORSE further agrees to amend the identification of goods in the BLACK HORSE APPLICATION to limit "structural parts therefor" to "structural body parts therefor."
5. CPP acknowledges the validity and enforceability of the BLACK HORSE REGISTRATION AND APPLICATION in connection with the BLACK HORSE GOODS AND SERVICES, and agrees not to oppose, petition to cancel, or otherwise contest, either of the BLACK HORSE REGISTRATION AND APPLICATION or otherwise to contest BLACK HORSE's usage of the MARK for the BLACK HORSE GOODS AND SERVICES. CPP acknowledges and agrees to the current and ongoing usage of the MARK by BLACK HORSE for the BLACK HORSE GOODS AND SERVICES, and agrees not to oppose any further applications for trademark registration

by BLACK HORSE to the extent covering such usages of the MARK for the BLACK HORSE GOODS AND SERVICES. CPP agrees to refrain from any use or attempt to register the MARK for any of the BLACK HORSE GOODS AND SERVICES.

6. CPP and BLACK HORSE agree that their respective CPP GOODS and BLACK HORSE GOODS AND SERVICES appeal and are targeted to primarily different groups of customers within different segments of the automotive market and travel in primarily different channels of trade. CPP and BLACK HORSE shall be entitled to advertise and promote their respective CPP GOODS and BLACK HORSE GOODS AND SERVICES under the MARK through any promotional outlet or medium, including Internet websites and other online outlets, provided that each PARTY shall use reasonable good faith efforts to target its advertising and promotions to the channels of trade and primary consumers for their respective CPP GOODS and BLACK HORSE GOODS AND SERVICES.
7. CPP and BLACK HORSE agree that, so long as they comply with the provisions of Paragraphs 1-6 above, confusion, mistake, or deception between their respective uses of the MARK is unlikely to occur. In the event either CPP or BLACK HORSE encounters any instances of actual confusion, mistake or deception as between their respective uses of the MARK, each agrees promptly to notify the other and to cooperate to agree upon and to take reasonable measures to mitigate and prevent further instances of confusion.
8. This Agreement shall be binding upon and inure to the benefit of the PARTIES and their permitted successors, assigns, licensees, and all others in privity with them.
9. The rights and obligations in this Agreement may be assigned in whole, but not in part, by either PARTY upon the consent of the respective other PARTY, provided such

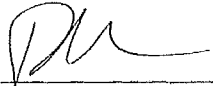
consent shall not be unreasonably withheld or delayed. Without altering or limiting the scope and generality of the foregoing, either PARTY may also assign its rights and obligations under this Agreement, including the PARTIES' rights and title to their respective CPP '547 REGISTRATION, CPP '981 REGISTRATION, BLACKHORSE REGISTRATION and BLACK HORSE APPLICATION, and any derivative registration granted therefrom, to a parent, subsidiary or affiliated entity that wholly or majority owns and controls the PARTY, is wholly or majority owned and controlled by the PARTY, or is under common ownership and control with the PARTY, provided that the recipient of any such assignment ratifies in writing and agrees to assume all contractual obligations hereunder.

10. Each PARTY agrees to take such further actions and to execute such further documents as may be necessary or reasonably desirable to carry the intent of this Agreement into full force and effect.
11. This Agreement constitutes the entire understanding between the PARTIES with respect to the subject matter hereof and may not be modified, changed or amended except in writing executed by the PARTIES or their permitted successors and assigns.
12. In the event any provision of this Agreement is found to be unenforceable, the remaining provisions shall survive unaffected.

[Remainder of this page left intentionally blank. Signature page follows.]

IN WITNESS WHEREOF, the PARTIES have duly executed the Agreement as follows:

CPP HOLDING COMPANY, LLC

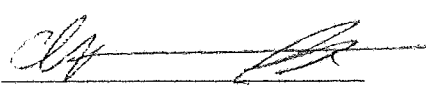
Signature: 

Name: RONALD COLEMAN

Corporate Title: Pres

Date: 6-8-17

BLACK HORSE RACING, LLC

Signature: 

Name: CHARLES W. HAINISELL, JR.

Corporate Title: Manager

Date: 6-5-17