# SAMPLE SETTLEMENT AND COEXISTENCE AGREEMENT

**Submitted by M. Kelly Tillery, Pepper Hamilton LLP**

This Settlement and Coexistence Agreement ("Agreement"), entered into and effective as of the day of , 2010 (the "Effective Date"), is between (i) Corporation (“ ”), a corporation organized and existing under the laws of the State of , having a principal place of business at ,

 ; and

Corporation (“

Corp.”), a corporation

organized and existing under the laws of the State of having a principal place of business at , , (each, a “Party” and collectively, the “Parties”).

# RECITALS

WHEREAS, Corp. is the owner of the federally registered Mark

 (U.S. Registration No. ), Registered with the United States Patent and Trademark Office (“USPTO”) on , covering services described as “ ” in International Class , “ ” in International Class , and “ ” in International Class

 (collectively the “ Corp. Services”). A copy of the

Certificate of Registration is identified on **Schedule “A”**, attached hereto and made a part hereof;

WHEREAS, is the owner of pending U.S. Trademark Application Serial

No.

for the Trademark

covering goods described as

“ ” in International Class

(the “

Goods”). A copy of the

Application as filed is identified on **Schedule “B”**, attached hereto and made a part hereof;

WHEREAS, on , 2010, Corp. sent a “Cease and Desist”

Letter to alleging ’s intended use, promotion and

advertisement of the

Goods under the

Mark unfairly

competed with and infringed Servicemark Registration;

Corp.’s rights in its

WHEREAS, there is currently pending in the United States District Court for the

 District of ("Court"), a Civil Action entitled

Corporation v. Corporation, designated as Civil Action No.

(hereinafter the "Civil Action"), filed on , 2010;

WHEREAS, in the Civil Action, seeks a Declaratory Judgment and

Declaration of Trademark Non-Infringement and no Unfair Competition, by its use of, and

application for registration, of its Goods;

Trademark covering ’s

WHEREAS, the costs to the Parties in prosecuting and defending against the claims asserted in the above described Civil Action is anticipated to be significant both in terms of legal fees and diversion from other business pursuits; and

WHEREAS, the Parties desire to put an end to any controversy, terminate the Civil Action on the terms and conditions set forth below, and to settle and resolve all disputes between them and terminate, extinguish, and release all claims or causes of action against each other relating to the subject matter of the Civil Action.

**NOW, THEREFORE**, in consideration of the mutual promises, warranties and covenants contained in this Agreement, the receipt and sufficiency of which is hereby acknowledged, and the above recitals, which are incorporated in the operative terms of this Agreement by reference, the parties agree as follows:

# TERMS AND CONDITIONS

1. **Recitals.** The Parties agree that the above Recitals are true and correct and are hereby incorporated into this Agreement.
2. **Acknowledgement of Rights.** acknowledges Corp.’s ownership of and exclusive right to use and register its Servicemark in connection with ; ; and , and related services and agrees not to oppose, petition to cancel, or otherwise challenge or object to the use or any current registration and/or subsequent application for registration by

 Corp. of Marks consisting of or comprising the terms , as long as such use and/or registration is in accordance with the terms of this Agreement.

 Corp. acknowledges ’s ownership of and exclusive

right to use and register its Trademark in connection with

 , and other , and agrees not to oppose, petition to cancel, or otherwise challenge or object to the use or any current application and/or subsequent application for registration by of Marks consisting of or comprising the terms

 , as long as such use and/or registration is in accordance with the terms of this Agreement.

1. **Limitations on Rights.** agrees that it will not in the future use or apply for registration of any service mark, trademark and/or trade name consisting of or incorporating the term , or any term that may be confusingly similar to “ ” covering such services as ;

 ; and and/or related services.

 Corp. agrees that it will not in the future use or apply for registration of any trademark, servicemark and/or trade name consisting of or incorporating the term

 , or any term that may be confusingly similar to “ ” covering

such goods as and/or other .

1. **Dismissal of the Civil Action**. Within five (5) business days of receipt of a copy of the fully executed Settlement Agreement, will file a Notice of Dismissal of the Complaint in the Civil Action, without prejudice and pursuant to Rule 41(a)(1) of the Federal Rules of Civil Procedure. A copy of the Notice of Dismissal is attached hereto as Exhibit “C”.
2. **Mutual Releases**. , on behalf of itself and its parents, subsidiaries, divisions, present and former officers, directors, employees, agents, attorneys and controlling persons, successors and assigns, expressly releases Corp., and any of its subsidiaries, divisions, present and former officers, directors, employees, agents, attorneys and controlling persons, from any and all claims, demands, costs, expenses, liabilities, damages, actions, and causes of action, known or unknown, which relate to the Mark which were, or could have been, brought in the Civil Action or in any counterclaims or affirmative defenses thereto.

 Corp., on behalf of itself and its parents, subsidiaries, divisions, present and former officers, directors, employees, agents, attorneys and controlling persons, successors and assigns, expressly releases , and any of its subsidiaries, divisions, present and former officers, directors, employees, agents, attorneys and controlling persons, from any and all claims, demands, costs, expenses, liabilities, damages, actions, and causes of action, known or unknown, which relate to the Mark which were, or could have been, brought in the Civil Action or in any counterclaims or affirmative defenses thereto.

1. **Injunctive Relief.** The Parties acknowledge and agree that any breach of this Agreement may result in irreparable harm to the other Party. Accordingly, the Parties agree that if either Party breaches any section of this Agreement, the other Party may be entitled, in addition to other remedies available to it, to an injunction to be issued by the United States

District Court for the

District of

restraining the other Party from

committing or continuing any breach of this Agreement, without the need for posting any bond or any other undertaking and without opposition by the other Party to such remedies or relief.

1. **Actual Confusion.** In the event that either Party becomes aware of any actual confusion or mistake occurring as a result of their uses of their respective marks, the Parties agree to communicate all details of each such instance to each other, and to cooperate reasonably to take steps to abate the cause of confusion or mistake, and to prevent any such confusion or mistake from arising again
2. **Modification of Agreement.** This Agreement (including this paragraph) may not be altered, amended, modified, or otherwise changed except by a writing duly signed by all Parties hereto.
3. **Voluntary Agreement.** The Parties hereto acknowledge that they are entering into this Agreement freely and voluntarily, that they have ascertained and weighed all the facts and circumstances likely to influence their judgment herein, that they have given due

consideration to the provisions contained herein, and that they thoroughly understand and consent to all provisions hereof. Each party has reviewed this Agreement and, accordingly, the rule of construction to the effect that any ambiguities are to be resolved against the drafting party will not be employed in any interpretation of this Agreement.

1. **No Waiver.** No delay or omission to exercise any right, power, or remedy accruing to any Party, upon any breach or default under this Agreement, shall impair any such right, power, or remedy of such Party or be construed to be a waiver of any such breach or default, or an acquiescence therein, or of or in any similar breach or default thereafter occurring; nor shall any waiver of any single breach or default be deemed a waiver of any other breach or default theretofore or thereafter occurring. All of a Party’s remedies including without limitation recovery of attorneys’ fees and costs, either under this Agreement, or by law or otherwise afforded to such Party, shall be cumulative and not alternative.
2. **Notices**. All communications required or permitted to be made under this Agreement shall be in writing and either shall be delivered personally or sent by United States Postal Service certified or registered mail, postage prepaid and return receipt requested, to the address or addresses set forth below, or to such other address or addresses as either party may notify the other pursuant to this Section. Any such communication shall be deemed to be properly given (i) if delivered personally, upon written acknowledgment of receipt after delivery to the address specified; or (ii) if posted, the earlier of the actual date of delivery, as set forth in the return receipt, or three (3) business days from the date posted pursuant to the foregoing. The addresses for the parties are as follows:

To Corporation, via a reputable overnight service, addressed to:

with a copy, via the same mode, addressed to:

M. Kelly Tillery, Esquire Pepper Hamilton LLP 3000 Two Logan Square

Eighteenth and Arch Streets Philadelphia, Pennsylvania 19103-2799

To Corporation, via a reputable overnight service, addressed to: