

TRADEMARK CO-EXISTENCE AGREEMENT

THIS TRADEMARK CO-EXISTENCE AGREEMENT (this "Agreement"), made effective as of the 18th day of March 2014, by and between **ROGER N. GILBERT DDS INC.**, a California corporation having a principal place of business at 25875 Barton Road, Suite 104, Loma Linda, California 92354 ("Dr. Gilbert"), and **DR. YAN KALIKA**, an individual and resident of the State of California having a principal place of business at 4150 Truxel Road, Sacramento, California 95834 ("Dr. Kalika").

WITNESSETH:

WHEREAS, Dr. Kalika is the owner of pending United States Service Mark Application Serial No. 86002731 (and design, as shown in Exhibit A attached hereto) and United States Service Mark Application Serial No. 86002730 (word only) for the mark **IMAGE** (together, the "Kalika Mark") for "*dentist services; orthodontic services*" in Class 44 (the "Kalika Services"); and

WHEREAS, Dr. Gilbert is the owner of United States Service Mark Registration No. 3701343 (and design, as shown in Exhibit A attached hereto) for the mark **IMAGE IMAGE AESTHETIC DENTISTRY** (the "Gilbert Mark") for "*cosmetic dentistry; dentistry*" in Class 44 (the "Gilbert Services"); and

WHEREAS, Dr. Kalika first began using the Kalika Mark at least as early as 2002 and Dr. Gilbert first began using the Gilbert Mark in 2008; and

WHEREAS, on October 21, 2013, the U.S. Patent and Trademark Office (the "USPTO") issued an Office Action refusing registration of the Kalika Mark based on concerns that the Kalika Mark is likely to be confused with the Gilbert Mark; and

WHEREAS, notwithstanding the fact that Dr. Kalika is a prior user of the term "IMAGE," Dr. Kalika would prefer not to petition to cancel the registration for the Gilbert Mark and would prefer to enter into a co-existence arrangement with Dr. Gilbert; and

WHEREAS, Dr. Kalika and Dr. Gilbert desire to enter into this Agreement;

NOW, THEREFORE, in consideration of the recitations, mutual promises and conveyance set forth in this Agreement, the adequacy and sufficiency of which the parties acknowledge, the parties agree as follows:

1. Consent to Use and Register. Based upon the considered belief of the parties that no conflict or likelihood of confusion will result from the contemporaneous use and registration of the Gilbert Mark and the Kalika Mark consistent with this Agreement and that there has been no evidence of actual confusion between the Gilbert Mark and the Kalika Mark, the parties agree as follows:

- (a) Dr. Kalika hereby consents to registration by Dr. Gilbert of the Gilbert Mark for the Gilbert Services and will not oppose, seek to cancel or otherwise object to such registration.

- (b) Dr. Kalika hereby consents to use by Dr. Gilbert of the Gilbert Mark for the Gilbert Services and will not object to or interfere with Dr. Gilbert's use of the Gilbert Mark for the Gilbert Services.
- (c) Dr. Gilbert hereby consents to registration by Dr. Kalika of the Kalika Mark for the Kalika Services and will not oppose, seek to cancel or otherwise object to such registration.
- (d) Dr. Gilbert hereby consents to use by Dr. Kalika of the Kalika Mark for the Kalika Services.
- (e) Dr. Kalika agrees that he will not display the Kalika Mark in a manner that is similar to the display of the Gilbert Mark as shown in Exhibit A attached hereto. Dr. Kalika also agrees that he will not use the phrase "aesthetic dentistry" with the Kalika Mark. Dr. Gilbert agrees that he will not display the Gilbert Mark in a manner that is similar to the display of the Kalika Mark as shown in Exhibit A attached hereto.
- (f) In addition to the acts recited in this Agreement, Dr. Gilbert and Dr. Kalika agree to perform or cause to be performed, any and all such further acts as may be reasonably necessary to consummate this Agreement, including but not limited to, the execution of any further documents reasonably necessary to effectuate the terms of the Agreement, including but not limited to such additional documentation as may be required by the USPTO as a condition to withdrawing its refusal to register the Kalika Mark.

2. Future Efforts to Avoid Confusion. Dr. Gilbert and Dr. Kalika agree to take reasonable measures and endeavor to take necessary steps to avoid confusion between their respective marks that are the subject of this Agreement. The parties agree that, if either party becomes aware of any actual confusion arising out of the parties' use of their respective marks that are the subject of this Agreement, that party will promptly notify the other party and thereafter the parties will work together in good faith to resolve the issue of confusion.

3. Further Assurances. If the USPTO should request further documentation or assurances that no likelihood of confusion exists between the Gilbert Mark and the Kalika Mark, each party shall cooperate with the other to provide such additional documentation or assurances. While the parties believe that they are in the best position to determine whether consumer confusion between the marks is likely, in the event that a representative of the USPTO does not approve this Agreement to support the registration of the Kalika Mark, Dr. Kalika reserves all rights to file a petition to cancel the registration for the Gilbert Mark on grounds that Dr. Kalika is a prior user of his mark and this Agreement shall be null and void and of no evidentiary value.

4. Entire Agreement. This Agreement (including the documents referred to herein) constitutes the entire agreement between the parties and supersedes any prior understandings, agreements, or representations by or between the parties, written or oral, to the extent they relate in any way to the subject matter hereof. No modification, termination or attempted waiver of this Agreement shall be valid unless in writing and signed by both parties to this Agreement.

5. **Binding Effect.** This Agreement shall inure to the benefit of, and shall be binding upon, Dr. Gilbert and Dr. Kalika, and all their respective heirs, executors, administrators, partners, trustees, successors, assigns, and all parties in privity with or claiming by, through, or under them.

6. **Counterparts.** This Agreement may be executed in counterparts or with detachable signature pages and shall constitute one agreement, binding, upon all Parties thereto as if all Parties signed the same documents. Photocopies of fully executed copies of this Agreement may be treated as originals.

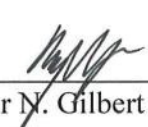
7. **Applicable Law.** This Agreement shall be governed by, construed and enforced in accordance with the laws of the State of California.

IN WITNESS WHEREOF, each of the parties has executed this Agreement as of the Effective Date.

DR. GILBERT: 

DR. KALIKA

Roger N. Gilbert DDS INC.

By:  4-03-14
Roger N. Gilbert


Dr. Yan Kalika

Title: President ROGER N. GILBERT DDS, INC.

Exhibit A

Kalika Mark

IMAGE

Gilbert Mark

image
image aesthetic dentistry