

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

*In re* Trademark Application of:

Docket No.: 184.0115TMUS

Casa Flora, Inc.

Serial No.: 88/267,598

Filed: 01/18/2019

Trademark Examining Attorney:  
Stoides, Katherine  
Law Office Assigned: 101

For: **“BRILLIANCE”**

Commissioner for Trademarks  
P.O. BOX 1451  
Alexandria, VA 22313-1451

**RESPONSE TO OFFICE ACTION**

Applicant has received and carefully considered the Office Action issued on December 3, 2019 (“Office Action”). Applicant hereby responds and respectfully requests reconsideration and that the application be advanced to publication.

Applicant filed for registration of the mark “BRILLIANCE” in International Class 031 for “Live plants, namely, ferns.” The application was filed as an intent-to-use application under Section 1(b), but has now been amended to be a used-based application under Section 1(a).

The Office Action refused registration based an allegation that the mark raises a likelihood of confusion under Section 2(d) with U.S. Registration No. 5829675 (hereafter “‘675 Registration”), “ROOTED BRILLIANCE”.

Applicant submits that the focus on the ‘675 Registration is on the first word and is taken as a combination that is not likely to be confused with BRILLIANCE alone. More importantly,

the owner of the '675 Registration has entered into a Coexistence Agreement with the Applicant. A redacted copy of the Coexistence Agreement is submitted herewith (Exhibit A).

In the Agreement, the owner of the allegedly conflicting registration has agreed that there is no likelihood of confusion (paragraph 4) and, further, has agreed not to sell ferns under that mark (paragraph 2). In addition to agreeing there is no likelihood of confusion, the owner of that trademark registration has agreed that the marks may coexist without issue. Accordingly, Applicant respectfully requests that the agreement of the Applicant and owner of the '675 Registration be honored and that the pending application to register BRILLIANCE move to publication.

Dated: 01/16/2020

Respectfully submitted,

By: /Robert H. Johnston III/

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Attorney for Applicant

EXHIBIT A – COEXISTENCE AGREEMENT

**COEXISTENCE AGREEMENT**

This Coexistence Agreement ("Agreement") is entered into this \_\_\_\_ day of October, 2019, by and between Casa Flora, Inc., a Texas corporation having an address of 5543 McCommas Bluff Road, Dallas, Texas 75241 (hereafter "Casa Flora"), and Dewar Nurseries, Inc., a Florida corporation, having an address at 625 W. Keene Road, Apopka, Florida 32703 (hereafter "Dewar Nurseries"). Casa Flora and Dewar Nurseries may be referred to herein individually as a "Party" and collectively as the "Parties."

**Recitals**

WHEREAS, Casa Flora alleges that it is using and is the owner of the mark "BRILLIANCE" (hereafter "BRILLIANCE Mark"); that it has used the BRILLIANCE mark in U.S. commerce since at least as early as 2003 in connection with ferns; and that the BRILLIANCE mark is the subject of U.S. Trademark Application 88/267598 (hereafter the "BRILLIANCE Application").

WHEREAS, Dewar Nurseries alleges that it is using and is the owner of the mark "ROOTED BRILLIANCE" (hereafter the "ROOTED BRILLIANCE Mark"), which has been registered as U.S. Trademark Registration 5829675 (the "ROOTED BRILLIANCE" Registration) for "Live plants; live flowers; dried plants; dried flowers; live and dried plants, namely, indoor and outdoor flowering and non-flowering plants, bushes, flowers, shrubs and trees" and alleges use of the ROOTED BRILLIANCE Mark since at least April 30, 2019.


WHEREAS, Casa Flora is the senior user, and yet Casa Flora's BRILLIANCE Application has recently been rejected based on the ROOTED BRILLIANCE Registration, and the Parties would like to resolve their differences regarding the perceived conflict between the marks.

NOW THEREFORE, in consideration of the foregoing premises and mutual covenants and promises made in this Agreement, and other good and valuable consideration, the receipt and sufficiency of which is hereby mutually acknowledged, the Parties, intending to be legally bound, hereby agree as follows:

**Terms**

1.

[REDACTED]

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2. Dewar Nurseries agrees not to sell ferns under the ROOTED BRILLIANCE Mark.
  3. In exchange for the foregoing, Casa Flora agrees not to challenge the ROOTED BRILLIANCE Registration, so long as Dewar Nurseries remains in compliance with the terms of this Agreement.
  4. Dewar Nurseries and Casa Flora do not believe that any confusion is likely to arise from the respective use of the Parties' marks under the terms in this Agreement. In particular, Dewar Nurseries does not believe that use of the mark "BRILLIANCE" for ferns is likely to cause confusion with respect to the "ROOTED BRILLIANCE" Mark for the goods described in paragraph 1 with the Amendment. Accordingly, Dewar Nurseries hereby consents to the registration of the BRILLIANCE Mark in the BRILLIANCE Application by Casa Flora.
  5. Dewar Nurseries shall not use any rights that Dewar Nurseries may claim in the ROOTED BRILLIANCE Mark as the basis for objection to Casa Flora's use or registration of the BRILLIANCE Mark for ferns, or directly or indirectly institute proceedings to contest the BRILLIANCE Application or petition to cancel or oppose any registration of such marks by Casa Flora or its affiliates, so long as such marks are not for anything other than ferns.
  6. Dewar Nurseries represents and warrants that it owns the ROOTED BRILLIANCE Mark and all rights therein and the goodwill associated therewith, and Dewar Nurseries has not assigned or transferred its interest in any of the rights that are affected by this Agreement.
  7. The Parties agree that in the event they become aware of or are informed of confusion arising from the simultaneous use of their respective marks on their respective goods and services as set forth above, they will promptly inform one another of such confusion and will promptly and in good faith confer and cooperate with one another to work out appropriate steps to eliminate or minimize such confusion. The Parties further agree that neither party will attempt to associate itself with the other party in any way in the future, and that neither Party has done so in the past.

8.




9. In the event that one of the parties abandons the marks covered by this Agreement, this Agreement will terminate and neither party will thereafter be restricted in their registration or use of their marks as set forth in this Agreement.
10. This Agreement will be governed by and construed under the United States Federal Trademark Act of 1946, 15 U.S.C. § 1051 et. seq., as amended.
11. Each Party shall bear its own costs and expenses accrued in connection with the settlement of this matter.
12. This Agreement shall be binding upon and inure to the benefit of the Parties and their respective officers, agents, servants, immediate parents, subsidiaries, other affiliates, successors, assigns and any and all entities controlled by any party.
13. This Agreement sets forth the entire understanding between the Parties with respect to the subject matter hereof and may not be amended except in a writing signed by both Parties.
14. This Agreement shall be deemed to have been prepared jointly by the Parties hereto and any uncertainty or ambiguity existing hereunder shall not be interpreted against either Party, but according to the application of rules of the interpretation of contracts if such uncertainty or ambiguity exists.
15. This Agreement may be executed in counterparts, each of which shall be deemed to be an original, but which together shall be deemed to constitute a single document.
16. Failure of either Party at any time to demand strict performance by the other of any term or condition of this Agreement shall not be construed as a continuing waiver or relinquishment thereof, and either Party may at any time demand strict and complete performance by the other of said term or condition.
17. If any term or provision of this Agreement is held invalid or unenforceable by a court or other tribunal of competent jurisdiction, such ruling shall not affect the validity or operation of the remainder of this Agreement, and such term or provision shall be modified to the extent necessary to make it valid and/or enforceable, or, if such modification is not possible, severed from this Agreement.

The Parties hereto have caused this Agreement to be executed by and through their duly authorized representatives below:

Casa Flora, Inc

By: \_\_\_\_\_

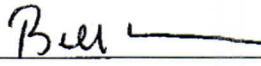
Printed  
Name: \_\_\_\_\_

  
RICHARD LIM

Dewar Nurseries, Inc.

By: \_\_\_\_\_

Printed  
Name: \_\_\_\_\_

  
BILL DEWAR

11/22/19

Title: President  
Date: 11/22/19

Title: Pres-  
Date: 11/22/19