

## MUTUAL TRADEMARK CONSENT AGREEMENT

This Mutual Trademark Consent Agreement (the “Agreement”) is made and entered into as of December 29, 2017, by and between W.R. Grace & Co.-Conn., a Connecticut corporation (“W.R. Grace”), and STM Management Pty Ltd (ACN 113 600 481), an Australian limited liability company (“STM”).

WHEREAS, W.R. Grace is the owner of U.S. Trademark Registration No. 1995539 issued on August 20, 1996, with a 1976 date of first use (the “W.R. Grace Registration”) for the mark GRACE in International Class 18 for “tote bags, all-purpose sports bags, umbrellas, leather briefcase-type portfolios, credit and business card cases”; and

WHEREAS, STM is the owner of U.S. Trademark Application Serial No. 79178816 (the “STM Application”), filed on July 8, 2015, with a priority date of May 14, 2015, being a request for extension of protection of International Registration No. 1279485 under Section 66(a) of the Trademark Act, 15 U.S.C. §1141(a), based in turn on Australian Trade Mark No. 1693822, for the mark GRACE in International Class 9 for “Computer bags, computer carry cases, battery packs and protective covers, cases and sleeves all specially adapted for computers, namely, laptop computers, notebook computers, notepad computers, tablet and electronic personal organisers and accessories used with all of the foregoing, and other portable or handheld personal electronic devices, namely cameras, digital video recorders, digital audio players and mobile telephones and accessories used with all the foregoing; bags cases, packs and covers designed to provide protection against rain and other inclement weather and specially adapted for computers and other portable or handheld personal electronic devices, namely cameras, digital recorders, digital audio players and mobile telephones; stands specially adapted for holding portable and handheld personal devices, namely, computers, tablets, mobile phones, cameras, digital video recorders, digital audio players; computer stylus,” and International Class 18 for “Sports bags; shoulder bags; carry-all and carry-on bags; waist packs; backpacks; overnight bags; travel bags; rucksacks; luggage; attache cases; beach bags; garment bags for travel; school bags; hand bags; suitcases; luggage tags; plastic luggage labels; shoulder straps; shoulder strap protectors; leather shoulder belts,” pending before the United States Patent and Trademark Office (the “USPTO”); and

WHEREAS, STM filed against the W.R. Grace Registration, on November 22, 2016, Cancellation No. 92064890 (the “Cancellation”), currently pending before the United States Trademark Trial and Appeal Board (the “USTTAB”); and

WHEREAS, W.R. Grace and STM mutually believe that, provided the terms and conditions set forth in this Agreement are complied with, the mark in the STM Application for STM’s goods, on the one hand, and the mark GRACE under the W.R. Grace Registration for W.R. Grace’s goods, on the other, are sufficiently distinctive so that their respective uses and intended uses, as well as the distinctive channels of trade and targeted customers as herein described do not and will not create a likelihood of confusion or otherwise conflict with one another, and both parties desire to provide and are able to provide for the continued use and registration of their respective marks, upon the terms and conditions set forth in this Agreement.

NOW, THEREFORE, the parties hereto hereby agree as follows:

1. Trademark Ownership, Use and Registration.

(a) Subject to and conditional on Section 1(b) below, W.R. Grace consents to:

(i) the registration of the mark comprised in the STM Application and its use in any color other than the color green, for:

*“Computer bags, computer carry cases, battery packs and protective covers, cases and sleeves all specially adapted for computers, namely, laptop computers, notebook computers, notepad computers, tablet and electronic personal organisers and accessories used with all of the foregoing, and other portable or handheld personal electronic devices, namely cameras, digital video recorders, digital audio players and mobile telephones and accessories used with all the foregoing; bags cases, packs and covers designed to provide protection against rain and other inclement weather and specially adapted for computers and other portable or handheld personal electronic devices, namely cameras, digital recorders, digital audio players and mobile telephones; stands specially adapted for holding portable and handheld personal devices, namely, computers, tablets, mobile phones, cameras, digital video recorders, digital audio players; computer stylus,” in International Class 9 and “Sports bags; shoulder bags; carry-all and carry-on bags; waist packs; backpacks; overnight bags; travel bags; rucksacks; luggage; attache cases; beach bags; garment bags for travel; school bags; hand bags; suitcases; luggage tags; plastic luggage labels; shoulder straps; shoulder strap protectors; leather shoulder belts,” in International Class 18 (provided that such identification of goods in Class 9 and/or Class 18 may be amended pursuant to requirements of the USPTO examiner examining the STM Application); and*

(ii) the use and/or registration by STM of the following exact mark:



in any color (including black and white, other than green) in relation to:

*“Computer bags, computer carry cases, battery packs and protective covers, cases and sleeves all specially adapted for computers, namely, laptop computers, notebook computers, notepad computers, tablet and electronic personal organisers and accessories used with all of the foregoing, and other portable or handheld personal electronic devices, namely cameras, digital video recorders, digital audio players and mobile telephones and accessories used with all the foregoing; bags cases, packs and covers designed to provide protection against rain and other inclement weather and specially adapted for computers and other portable or handheld personal electronic devices, namely cameras, digital recorders, digital audio players and mobile telephones; stands specially adapted*

*for holding portable and handheld personal devices, namely, computers, tablets, mobile phones, cameras, digital video recorders, digital audio players; computer stylus,” in International Class 9, and “Sports bags; shoulder bags; carry-all and carry-on bags; waist packs; backpacks; overnight bags; travel bags; rucksacks; luggage; attache cases; beach bags; garment bags for travel; school bags; hand bags; suitcases; luggage tags; plastic luggage labels; shoulder straps; shoulder strap protectors; leather shoulder belts,” in International Class 18 (provided that such identification of goods in Class 9 and/or Class 18 may be amended pursuant to requirements of the USPTO examiner examining any such application for the above mark);*

(b) STM shall advise and confirm with the USPTO that its mark in the STM Application was indeed filed in plain, type letters from the outset (based on and consistent with the priority application Australian Trade Mark No. 1693822 and as reflected in International Registration No. 1279485) and that the USPTO should accordingly as such amend the STM Application to reflect this mark drawing type;

(c) STM shall not at any time use the following identical mark belonging to W.R. Grace (i.e., the identical word in identical typeset) in any color, including black and white:

The image shows the word "GRACE" in a bold, green, sans-serif font. The letters are evenly spaced and have a slight shadow or drop effect, giving it a three-dimensional appearance. The background is plain white.

(d) Subject to and conditioned upon the foregoing terms, W.R. Grace shall not at any time oppose or object to the STM Application (including any renewal of any registration granted by the USPTO in respect of the STM Application), or file cancellation, revocation, infringement or like proceedings against the registration or use of the mark in the STM Application at any time by STM in connection with any of the goods in the STM Application (as said goods may be amended pursuant to requirements of the USPTO examiner examining the STM Application). For the avoidance of doubt, if the USPTO examiner rejects this Agreement as a valid consent agreement as it pertains either to the Class 9 or Class 18 goods in the STM Application (as per Section 1(e) below), W.R. Grace acknowledges and agrees that this Section (d) shall continue to apply to the use of the mark in the STM Application by STM in connection with any of the goods in the class for which the USPTO examiner has not accepted this Agreement as a valid consent agreement.

(e) Subject to W.R. Grace complying with Section 1(a), and Section 1(f) in respect of the further agreements, instruments and documents, STM shall not hereafter file cancellation, revocation, infringement or like proceedings against the W.R. Grace Registration.

(f) Within 10 calendar days after the USPTO examiner examining the STM Application accepts this Agreement as a valid consent agreement with respect to both Classes 9 and 18 and withdraws the refusal citing the W.R. Grace Registration, STM shall file with the Board a voluntary withdrawal of the Cancellation with prejudice. W.R. Grace agrees that in the event the USPTO examiner rejects this Agreement as a valid

consent agreement as it pertains either to the Class 9 or Class 18 goods in the STM Application, and if STM requests within sixty (60) days after the USPTO's notification of such refusal, W.R. Grace shall execute such further agreements, instruments or documents that are appropriate and reasonably acceptable to W.R. Grace and as STM may reasonably request, at STM's sole expense including payment of W.R. Grace's reasonable attorney expenses and costs, in order to persuade the USPTO examiner, by way of further response to office action or request for reconsideration, to accept the consent agreement. Should STM be unsuccessful in responses and arguments to the USPTO examiner or on appeal to the USTTAB and no further responses or arguments are procedurally available, W.R. Grace shall have no further obligation and STM shall promptly file a voluntary withdrawal of the Cancellation with prejudice.

(g) As consistent with Section 1(a)(ii), W.R. Grace shall not at any time use the following exact mark belonging to STM (i.e., the same composite typeset, containing the "A" feature and displayed linking of the letters) in any color (including black and white) for STM's goods in Classes 9 and 18 as set forth in the STM Application:



Consistent with the provisions in Section 1(j), this Section 1(g) does not serve as an express consent to W.R. Grace to use the above exact mark for any other goods and/or services not comprised in the STM Application.

(h) Provided the terms and conditions of this Agreement are complied with, W.R. Grace and STM mutually acknowledge and agree that W.R. Grace's mark for its goods is not likely to be confused with STM's mark for its goods. W.R. Grace acknowledges and agrees that its mark should not bar STM from obtaining registration of the STM Application. STM acknowledges and agrees that the mark in the STM Application should not bar W.R. Grace from maintaining the W.R. Grace Registration.

(i) W.R. Grace and STM further mutually acknowledge and agree that neither of them is aware of any threat of potential or likely confusion among actual or potential purchasers between their respective aforementioned marks as intended to be used in accordance herewith, and that each of them has concluded, provided the terms and conditions of this Agreement are complied with, that confusion between such marks is not likely given the differences in the respective goods and services on which their marks are used and intended to be used, and the distinctness of their respective distribution channels and targeted customer and user bases. In the event of any unforeseen incidents of actual confusion between the parties or their goods marketed under their respective marks as identified herein occur, the parties shall confer and use reasonable efforts in good faith to attempt to ensure that such incidents do not recur.

(j) The STM Application is a request for extension of protection of STM's International Registration No. 1279485 (the "IR") under Section 66(a) of the Trademark Act, 15 U.S.C. §1141(a). In the event WIPO's International Bureau hereafter cancels the IR or restricts any of the goods listed in the IR at the request of the Office of Origin due to the cancellation of the basic application and/or registration within five years of

the date of the home country registration and not where the international registration expires for failure to renew, or is cancelled, in whole or in part, at the request of the holder, then STM may transform the goods to which said cancellation or restriction applies in the STM Application to a new U.S. trademark application based on intent to use or actual use in U.S. commerce (a "Section 1 Application") for registration of the same mark for any or all of the cancelled or restricted goods that were covered by the STM Application pursuant to USPTO requirements and practice as set forth in 15 U.S.C. §1141j(c) and 37 C.F.R. §7.31. Should that occur, all provisions contained in this Agreement applicable to the STM Application shall apply *mutatis mutandis* to such Section 1 Application.

(k) Other than the consents and negative obligations set out in the foregoing Sections 1(a) through 1(j), neither party agrees to any other consents and neither party shall be prevented from objecting to any use (or applications for registration) by the other party which does not comply with, is contrary to, or is not otherwise covered or dealt with by the foregoing terms.

2. Mutual Release.

Each party hereto releases the other party from any claim to damages or for any accounting for profits for any past or current use of their respective marks, but not including for any breaches of this Agreement arising after the date hereof.

3. Successors and Assigns.

This Agreement shall be binding upon and inure to the benefit of the parties' respective successors and assigns, licensees, distributors, and any other person or entity having an interest in, to, or under the parties' aforementioned respective trademarks.

4. Notices

Until advised in writing of a different name and address, all notices and communications required to be made under this Agreement shall be sent via email, with a copy sent via first class mail, postage prepaid, as follows:

(i) If to W.R. Grace, to:

W. R. Grace & Co.-Conn.  
7500 Grace Drive  
Columbia, Maryland 21044  
United States  
Attention: Charles A. Cross, Esq., Vice President and Chief Intellectual  
Property Counsel  
Email: Charles.A.Cross@grace.com

with a copy to:

John Rynkiewicz, Esq.  
Arnold & Porter Kaye Scholer LLP  
601 Massachusetts Ave., NW  
Washington, D.C. 20001  
United States  
Email: John.Rynkiewicz@apks.com

(ii) If to STM, to:

STM Management Pty Ltd.  
21/34 Ralph Street  
Alexandria, New South Wales 2015  
Australia  
Attention: Ethan Nyholm  
Email: ethan@stmbrands.com.au

with a copy to:

William J. Seiter, Esq.  
Seiter Legal Studio  
2500 Broadway, Bldg F, Suite F-125  
Santa Monica, California 90404  
United States  
Email: williamjseiter@seiterlegalstudio.com

5. Counterparts.

This Agreement may be executed in more than one counterpart, each of which shall be deemed an original, whether transmitted physically or electronically, and which together shall constitute one instrument. Electronically reproduced signatures will have the same effect as original signatures.

6. Amendment and Waiver

Neither this Agreement nor any of the terms hereof may be amended, supplemented, waived or modified orally, but only by an instrument in writing signed by each Party hereto.


7. Governing Law

This Agreement will in all respects be governed by, and construed in accordance with, the laws (excluding conflict of laws rules and principles) of the State of New York, including all matters of construction, validity, and performance.

IN WITNESS WHEREOF, the parties have executed this Mutual Trademark Consent Agreement as of the date first above written.

W.R. Grace & Co.-Conn.

STM Management Pty Ltd.

By:   
Name: Charles A. Cross  
Title: Assistant Secretary

By: \_\_\_\_\_  
Name: \_\_\_\_\_  
Title: \_\_\_\_\_

IN WITNESS WHEREOF, the parties have executed this Mutual Trademark Consent Agreement as of the date first above written.


W.R. Grace & Co.-Conn.

STM Management Pty Ltd.

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

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

Title: \_\_\_\_\_

By: 

Name: Eruen Nyholm

Title: CEO