

TRADEMARK COEXISTENCE AND SETTLEMENT AGREEMENT

THIS TRADEMARK COEXISTENCE AND SETTLEMENT AGREEMENT (“Agreement”), which is effective on the date upon which it is fully executed (“Effective Date”), is made by and between Fortitude Health, LLC, a New Jersey limited liability company with a mailing address of 101 US Highway 46, Suite 122, Pine Brook, New Jersey 07058 (“Fortitude Health”), and Justin Samra, a United States citizen with a mailing address of 3555 29th St., Apt. 4F, Long Island City, New York 11106 (“Samra”) (collectively referred to as the “Parties”).

RECITALS

WHEREAS, since at least as early as September 2011, Fortitude Health has been using the trademark HEALFAST in connection with the advertising and sale of a variety of skin and hair care products; and

WHEREAS, Fortitude Health is the owner of Application Serial No. 88438062 for the mark HEALFAST for “non-medicated skin care preparations, namely, creams, lotions, gels, shampoos, oils,” in International Class 3; and

WHEREAS, since at least as early as January 2017, Samra has been using the trademark HEALFAST in connection with the advertising and sale of various dietary and nutritional supplements and anti-inflammatories; and

WHEREAS, Samra is the owner of U.S. Registration No. 5,400,628 for the mark HEALFAST & design for “products needed to optimize a patient's recovery and reduce complications, namely, vitamin and mineral supplements, antioxidant food supplements, amino acids for nutritional purposes, probiotic supplements, and anti-inflammatories,” in International Class 5; and

WHEREAS, Samra is the owner of U.S. Registration No. 5,570,232 for the mark HEALFAST for “amino acids for nutritional purposes; anti-inflammatories; mineral supplements; probiotic supplements; vitamins; food supplements, namely, anti-oxidants” in International Class 5; and

WHEREAS, the United States Patent and Trademark Office (“USPTO”) has cited Samra’s trademark registrations as bases for refusing registration of Fortitude Health’s HEALFAST mark under Trademark Act §2(d); and

WHEREAS, on August 29, 2019, Fortitude Health filed a Petition for Cancellation against Samra’s trademark registration for HEALFAST on the basis of priority and likelihood of confusion (Cancellation No. 92072152) (the “Dispute”); and

WHEREAS, the Parties entered into good faith negotiations to attempt to resolve the Dispute and did, in fact, resolve the Dispute by entering into this Agreement.

AGREEMENT

NOW, THEREFORE, in consideration of the mutual promises and agreements set forth herein, and other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the Parties, each intending to be legally bound hereby, do promise and agree as follows:

1. The above Recitals are true and accurate and form a part of this Agreement.
2. The Parties acknowledge and agree that this Agreement is the result of a compromise and its execution is not in any way to be construed or deemed an admission of wrongdoing or liability on the part of either party. It is not an admission or acknowledgment of the merit or lack of merit of either party's claims or defenses with respect to the Dispute.
3. Within thirty (30) days of the Effective Date, Fortitude Health shall submit this Agreement to the USPTO for the purpose of overcoming the USPTO's refusal to register Fortitude Health's HEALFAST mark (Serial No. 88438062).
4. In the event the USPTO maintains its refusal to register Fortitude Health's HEALFAST mark after Fortitude Health has submitted this Agreement to the USPTO, the Parties shall exercise their best efforts to meet any ongoing concerns of the USPTO and shall submit a revised agreement within thirty (30) days for the USPTO's consideration. In the event the USPTO maintains its refusal to register Fortitude Health's HEALFAST mark after the revised agreement is submitted, this Agreement shall immediately terminate and it shall be as if this Agreement never existed.
5. Within ten (10) days of the USPTO publishing Fortitude Health's HEALFAST mark in the Official Gazette, Fortitude Health shall withdraw its Petition for Cancellation with prejudice with the written consent of Samra.
6. Fortitude Health agrees never to adopt, use, or attempt to register the word "heal" with the word "fast" in connection with any ingestible supplements or anti-inflammatories.
7. Samra agrees never to adopt, use, or attempt to register the word "heal" with the word "fast" in connection with any non-ingestible skin care preparations, hair care preparations, or cosmetics.
8. Fortitude Health agrees never to adopt, use, or attempt to register its HEALFAST mark in a logo or stylized format that is confusingly similar to the logo and stylized format in which Samra uses his HEALFAST & design mark, as depicted below:



9. So long as Samra remains in compliance with all of the terms and conditions of this Agreement, Fortitude Health shall not take any adverse action to interfere with or challenge Samra's ownership, use, or registration of HEALFAST or the HEALFAST & design marks in connection with the products recited in Registration Nos. 5,400,628 and 5,570,232.

10. So long as Fortitude Health remains in compliance with all of the terms and conditions of this Agreement, Samra shall not take any adverse action to interfere with or challenge Fortitude Health's ownership, use, or registration of HEALFAST in connection with the products recited in Application Serial No. 88438062.

11. In the event either party abandons use of its respective mark for a period of three (3) consecutive years, all restrictions in Paragraphs 6-8 shall cease to be effective.

12. The Parties are most interested in avoiding consumer confusion and agree that the concurrent use and registration of their respective marks, for their respective products, will not result in confusion so long as the Parties abide by the terms and conditions of this Agreement.

13. The Parties agree that they will take reasonable steps to avoid any potential confusion that might arise from the concurrent use of their respective marks, and further agree not to intentionally promote, market, or advertise their products under their respective marks in a manner that is likely to cause confusion among consumers in the marketplace. Should either party become aware of any instance of actual confusion stemming from the concurrent use of their respective marks, it agrees to notify the other party within thirty (30) days. The Parties agree to cooperate and to take all reasonable and necessary steps to alleviate and eliminate such confusion and to remedy the circumstances that led to such confusion.

14. This Agreement shall extend to and be effective throughout the United States of America and the entire world.

15. This Agreement may be enforced by any court having jurisdiction over the Parties and the subject matter.

16. This Agreement represents the entire understanding of the Parties with respect to its subject matter and supersedes all previous and contemporaneous agreements, promises, representations, understandings, and negotiations, whether written or oral.

17. This Agreement may not be modified or altered in any manner except in a writing signed by the Parties.

18. In the event that any provision of this Agreement is held to be illegal, invalid, or unenforceable under any law, rule, or regulation, such provision shall be fully severable and this Agreement shall be construed and enforced as if such provision never comprised a part hereof. The remaining provisions of this Agreement shall remain in full force and effect and shall not be affected by the illegal, invalid, or unenforceable provision or by its severance therefrom.

19. This Agreement shall be binding upon and inure to the benefit of the Parties, their owners, employees, affiliates, subsidiaries, divisions, representatives, assigns, licensees, and successors.

20. The failure of a party at any time to require performance by the other party of any provision of this Agreement shall not affect in any way the right to require such performance at any time or date, nor shall such failure be deemed a waiver of such provision unless the waiver is set forth in writing and signed by the Parties.

21. This Agreement shall be deemed to have been written jointly and equally by the Parties. The Parties knowingly and voluntarily enter into this Agreement having had the opportunity to consult with independent legal counsel of their choosing.

22. In the event either party breaches any provision of this Agreement, the non-breaching party shall provide written notice to the breaching party of the alleged breach. If the breach is not cured within thirty (30) days from the date the notice is mailed, the non-breaching party may file suit against the breaching party seeking all available legal and equitable remedies.

23. In the event a party brings a lawsuit or other action against the other party in order to enforce any of the terms or conditions of this Agreement, the Parties agree that the prevailing party shall be entitled to recover from the losing party its reasonable attorneys' fees, costs, and expenses incurred in connection with any such litigation or proceedings.

24. Fortitude Health and Samra each agree to bear their own costs, expenses, and attorneys' fees incurred in connection with this Agreement and the Dispute. No monetary payment or compensation of any kind is due to be paid by Fortitude Health or Samra upon or after execution of this Agreement.

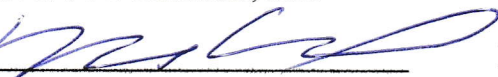
25. For the convenience of the Parties, facsimile or electronically scanned fully executed copies of this Agreement shall be treated as if they are originals.

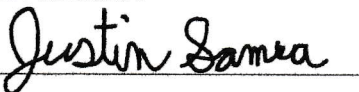
[Signature Page to Follow]

By their execution below, the Parties have agreed to all of the terms and conditions of this Agreement and represent and warrant to each other that (i) each party has the right and power to enter into this Agreement and to perform all duties contained or referenced herein; (ii) the individual signatories are empowered and authorized to sign this Agreement; (iii) this Agreement is valid, legal, and binding; and (iv) this Agreement does not contravene any other agreement to which Fortitude Health or Samra is a party.

FORTITUDE HEALTH, LLC

JUSTIN SAMRA

By: 

By: 

Name: Michael M. Newick

Name: Justin Samra

Title: OWNER

Title: Individual Owner

Dated: 6/11/2020

Dated: 6/10/2020