

**CITY OF SAN ANTONIO  
PARKS AND RECREATION DEPARTMENT  
CITY COUNCIL AGENDA MEMORANDUM**

**TO:** Mayor and City Council  
**FROM:** Malcolm Matthews, Director, Parks and Recreation Department  
**SUBJECT:** Tower of the Americas Trademark - Consent Agreement  
**DATE:** June 23, 2005

**SUMMARY AND RECOMMENDATIONS**

This ordinance approves a Consent Agreement between the City of San Antonio and the Sinclair Oil Corporation regarding the use of the trademark name "Tower of the Americas".

Staff recommends approval of this ordinance.

**BACKGROUND INFORMATION**

The City hired a consultant, Charles W. Hanor, P.C., to review and register trademarks (marks) on behalf of the City. During the process of registering the TOWER OF THE AMERICAS, the Sinclair Oil Corporation contacted the City to indicate that it would object to the City's registration unless the City agreed to certain limitations in its use of the mark.

The Sinclair Oil Corporation is the owner of certain marks that contain the word AMERICA and this includes but is not limited to marks for LITTLE AMERICA, GRAND AMERICA, and THE AMERICAS. These apply to resort hotel, restaurant and retail properties owned by the firm. In order to avoid any likelihood of confusion between the City's TOWER OF THE AMERICA'S marks and Sinclair's AMERICA marks, the City and Sinclair negotiated this Consent Agreement.

The proposed agreement provides that the City of San Antonio will not use THE AMERICAS mark without also including TOWER as part of the mark.

The proposed agreement also provides that the City will allow Sinclair Oil Corporation to use and register marks including the term THE AMERICAS and/or AMERICA and the Sinclair Oil Corporation will not provide hotel or restaurant services in association with any marks including TOWER OF THE AMERICAS or TOWER RESTAURANT as part of the mark.

**POLICY ANALYSIS**

This Consent Agreement requires passage of a City ordinance.

**FISCAL IMPACT**


There is no impact to the General Fund.

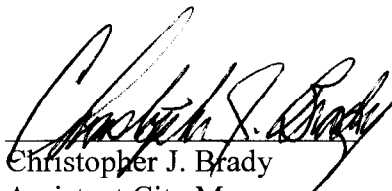
**COORDINATION**

This Consent Agreement was coordinated with the City Attorney's Office.

**SUPPLEMENTARY COMMENTS**

A Discretionary Contracts Disclosure Form is not required.

  
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Malcolm Matthews  
Director of Parks and Recreation

  
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Christopher J. Brady  
Assistant City Manager

✓   
\_\_\_\_\_  
J. Rolando Bono  
Interim City Manager

## CONSENT AGREEMENT

THIS AGREEMENT is made and entered into by and between City of San Antonio, a Texas Municipal Corporation ("San Antonio"), having a principal place of business at 100 South Flores, San Antonio, Texas, 78205, and Sinclair Oil Corporation, a Wyoming corporation ("Sinclair") with a principal place of business at 550 East South Temple, Salt Lake City, Utah 84102;

WHEREAS, Sinclair is the owner of a family of AMERICA marks for retail gift shops; retail clothing stores, resort hotel and resort lodging services; restaurant, bar and night club services; hotel and lodging services; banquet and catering services and facilities; as well as other services and goods, that include but are not limited to marks for LITTLE AMERICA, GRAND AMERICA, and THE AMERICAS; and

WHEREAS, San Antonio is the owner of a family of TOWER marks including the mark TOWER OF THE AMERICAS for restaurant services, United States Application No. 78/306,431, filed September 28, 2003 and THE TOWER RESTAURANT for restaurant services, United States Registration No. 2,906,579, registered November 30, 2004 and TOWER OF THE AMERICAS for entertainment services, namely, viewing and observation services from and observation deck of a tower building for the purpose of sightseeing and fireworks displays, United States Registration No. 2,906,578, registered November 30, 2004;

WHEREAS, in order to establish a basis for contemporary use by the parties hereto of their respective marks and to avoid any likelihood of confusion, the parties are desirous of entering into this Consent Agreement to ensure that confusion is not likely to occur;

NOW, THEREFORE, in consideration of the mutual terms, covenants and conditions set forth herein, and for good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the parties agree as follows:

1. Sinclair agrees that San Antonio may continue to use and register marks including the marks TOWER OF THE AMERICAS and/or TOWER RESTAURANT in the United States of America, its possessions and territories, and countries foreign thereto in connection with hotel and restaurant services as well as services supporting and relating to the same.
2. San Antonio agrees not to provide hotel or restaurant services in association with any marks including the AMERICAS mark without also including TOWER as part of the mark. San Antonio agrees not to provide hotel or restaurant services in association with any marks including the AMERICA mark.
3. San Antonio agrees that Sinclair may continue to use and register marks including the term AMERICA and/or THE AMERICAS in the United States of America, its possessions and territories, and countries foreign thereto in connection with hotel and restaurant services as well as services supporting and relating to the same.

4. Sinclair agrees not to provide hotel or restaurant services in association with any marks including TOWER OF THE AMERICAS or TOWER RESTAURANT as part of the mark.

5. The parties acknowledge the fact that purchasers of San Antonio's services and purchasers of Sinclair's services are such that consumers are unlikely to be confused as to the source of such services.

6. The parties further agree that, to the extent that either party becomes aware of the potential for confusion or confusion-in-fact, the party becoming aware of such issues shall take commercially reasonable steps to notify the consumer that there is no association, sponsorship or approval between the party's respective services, and will seek to remedy said potential for confusion or confusion-in-fact. The parties shall cooperate fully to the extent possible to resolve any potential issues of confusion that may arise.

7. Both parties agree that their use of their respective marks as set forth in this consent agreement will avoid a likelihood because of the limitations set forth herein and the nature of the goods and services. The parties believe that the terms of this Consent Agreement is sufficient such that no consumer would be likely to encounter both parties uses of their respective marks under such circumstances that the consumer would assume that the services of one party are those of the other, are in some manner connected or associated with those of the other.

8. Neither party will petition to cancel, oppose or otherwise interfere with the federal registrations of the other party's relative marks as set forth above so long as the goods and/or services are in accordance with the terms of this Consent Agreement.

9. In consideration of this Consent Agreement and the undertakings set forth herein and for other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, both parties do respectfully for themselves and their administrators, successors, assigns, officers, directors, shareholders, agent, employees hereby release quitclaim and forever discharge one another and one another's administrators, successors, assigns, officers, directors, shareholders, agent, employees of and from all claims, counterclaims, demands, costs, damages, losses, liabilities, actions and causes of action (hereinafter referred to as "claims") of every nature and description, whether known or unknown, suspected or unsuspected, foreseen or unforeseen, real or imaginary, actual or potential, and whether arising at law or in equity, under the common law, state law, federal law, or any law, or otherwise, but limited to those claims which have been or which might have been asserted in any action relating to either party's use of the above marks as of the date of this Consent Agreement, it being the intention of both parties to hereby effect a release of said specific claims.

10. This Consent Agreement shall remain in full force and effect so long as either party or licensee or assignee of such party continues to use its relative mark(s) or as long as any registration of either party's above marks remain in effect. This Consent Agreement shall be binding upon and inure to the benefit of the parties hereto, their respective successors and assigns.

IN WITNESS WHEREOF, the parties hereto have signed this Consent Agreement on the day and date written below.

**CITY  
OF SAN ANTONIO**

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

Its: \_\_\_\_\_

Date: \_\_\_\_\_

SINCLAIR OIL CORPORATION

By: S. Holding



Its: V.P.

Date: 5/13/05