

REQUEST TO AMEND

This brief is submitted to request an amendment to the mark that is the subject of U.S. Application Serial No. 88/644,109 (the “Application”) submitted by Diamond Supply Company (the “Applicant”) seeking registration on the Principal Register for the mark “DIAMOND CANNABIS COLLECTION” in standard character form in connection with “[B]ackpacks not made of hemp; wallets not made of hemp” in International Class 18 (the “Applied-for Mark”).

Applicant hereby respectfully requests that it be permitted to amend the Applied-for Mark from “DIAMOND CANNABIS COLLECTION” to “DIAMOND CANNABIS COLLECTIVE” (the “Amended Mark”) in view of the following Remarks (the “Remarks”).

REMARKS

Based on the reason set forth below, Applicant respectfully submits that the Amended Mark creates essentially the same commercial impression as the Applied-for Mark, thus, no material alteration will occur.

I. THE APPLIED-FOR MARK AND THE AMENDED MARK CREATE ESSENTIALLY THE SAME COMMERCIAL IMPRESSION.

Pursuant to TMEP §807.14, “[T]he test for determining whether an amendment is a material alteration is as follows:

The modified mark must contain what is the essence of the original mark, and the new form must create the impression of being essentially the same mark.”

The words “COLLECTION” and “COLLECTIVE” have essentially the same meaning. The current online version of the Merriam-Webster dictionary defines “COLLECTION” as “1: the act or process of collecting” and “2b: GROUP, AGGREGATE.” See a screenshot of the webpage

from Merriam-webster.com containing the foregoing definitions for “COLLECTION” as **Exhibit A**.

The same dictionary defines “COLLECTIVE” as “1: denoting a number of persons or things considered as one group or whole” and “2a: formed by collecting: AGGREGATED.” See a screenshot of the webpage from Merriam-webster.com containing the foregoing definitions for “COLLECTIVE” as **Exhibit B**.

II. THE WORD “COLLECTION” WOULD LIKELY REQUIRE A DISCLAIMER.

The word “COLLECTION” is a commonly used term within the clothing and accessories industries; accordingly, based on a review of marks recently included on the Principal Register containing this term, it seems inevitable that the Examining Attorney will require Applicant to disclaim exclusive rights to this term. Accordingly, the amendment of this generic term in the manner requested would not alter the commercial impression of the Applied-for since the dominant elements “DIAMOND CANNABIS” would remain intact.

III. EACH CASE MUST BE DECIDED ON ITS OWN FACTS, AND THESE GENERAL RULES ARE SUBJECT TO EXCEPTIONS.

Pursuant to TMEP §807.14, “*Each case must be decided on its own facts, and these general rules are subject to exceptions.*” In this case, the inclusion of the word “COLLECTION” as part of the Applied-for Mark was inadvertent. Applicant respectfully request that the Examining Attorney take that into consideration particularly if a search of the USPTO’s registry has yet to occur. Applicant is not concerned with paying an additional fee to file a new application; rather, it is the time lost that is of most concern to Applicant due its imminent business plans.

CONCLUSION

Applicant filed the Application in good faith and does not believe that amending the Applied-for Mark in the manner requested will constitute a material alteration of the Applied-for Mark since “COLLECTION” and “COLLECTIVE” are synonymous and thus the Amended Mark would retain the same commercial impression as the Applied-for Mark. Moreover, the term “COLLECTION” is essentially a generic term that the Examining Attorney will undoubtedly require Applicant to disclaim. The dominant elements of the Applied-for Mark “DIAMOND CANNABIS” would remain intact post amendment thereby retaining the commercial impression. In light of the foregoing remarks, Applicant hereby respectfully requests that it be permitted to amend the Application accordingly.

Dated: January 16, 2020
New York, New York

Respectfully submitted,

By: /s/ Gregory N. Weisman
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