

REQUEST TO AMENDMENTS AND REMARKS IN SUPPORT OF REQUEST TO AMEND BASIS OF REGISTRATION FROM SECTION 1(b) TO SECTION 44(e), REQUEST TO AMEND THE GOODS, REQUEST TO AMEND THE MARK AND AMENDMENTS AND REMARKS IN SUPPORT THEREOF

Pursuant to the Petition to Withdraw Application From Publication and Restore Jurisdiction to the Examining Attorney for Consideration of Proposed Amendment of the Statutory Basis for Registration From Section 1(b) to Section 44(e), Request to Amend the Goods, Request to Amend the Mark, and Amendments and remarks in Support Thereof (the “Petition”) being filed concurrently herewith, Applicant, Kering, respectfully requests that the Examining Attorney amend the application in the manner outlined below.

AMENDMENTS

Please amend the basis for registration by deleting Section 1(b) of the Trademark Act, 15 U.S.C. § 1051 from the application and substituting Section 44(e) of the Trademark Act, 15 U.S.C. § 1126 as the basis for registration, as follows:

Applicant is the owner of French Trademark Registration No. 164312874 for the



mark in Class 9. Said Registration is now in force and effect and a copy of the Certificate of Registration issued from the French Trademark Office is submitted herewith.

Please amend the goods to:


Spectacle frames, spectacles, sunglasses, tinted or anti-glare spectacles, protective goggles, pince-nez, opera glasses, magnifying glasses, cases for spectacles and cases for contact lenses; optical apparatus/instruments, namely, cases for eyeglasses and sunglasses; optical correcting lenses, spectacle glasses, contact lenses, tinted or filter lenses for spectacles, protective lenses for eyewear, magnifying lenses, optical lenses; portable telephones and smartphones accessories, namely, batteries, covers, cases; accessories for electronic devices for the wireless transmission of data and/or voice signals, namely batteries; cases and covers for portable computers.

Please amend the mark from  to , as shown in the new drawing attached hereto.

REMARKS


Pursuant to T.M.E.P. §§ 806.03(a) and 1505.01(f), Applicant seeks to amend the basis for its application from Section 1(b) of the Trademark Act, 15 U.S.C. § 1051, to Section 44(e) of the Trademark Act, 15 U.S.C. § 1126.

Moreover, pursuant to T.M.E.P. §§ 807.13, 807.14 and 1505.02(c), Applicant request that the goods be amended/limited to the goods that are in the foreign registration or covered by the foreign

registration. Applicant also requests that the mark be amended from 

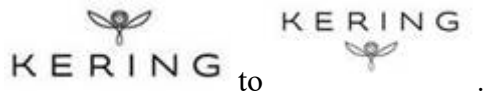
to .

As set forth above, Applicant also submits that it is the owner of French Trade Mark

Registration No. 164312874 for the mark  in Class 9 (the “Registration”). The Registration is now in force and effect and a copy of the Registration issued from the French Trademark Office is attached hereto. Also attached is a signed English translation thereof.


Applicant has petitioned the Commissioner to withdraw its application from publication and restore jurisdiction of the application to the Examining Attorney for consideration of this Request to Amend the Basis of the above-referenced application from Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b) to Section 44(e) of the Trademark Act, 15 U.S.C. 1126(e). Applicant has also requests that the goods in the application be limited/amended to the goods included/covered by the


goods in the foreign registration. Moreover, Applicant has requested that the mark be amended from



Applicant notes that a verified statement of Applicant's bona fide intention to use the mark in commerce with respect to all the goods covered by the new Section 44(e) basis was provided during the prosecution process.

Finally, as indicated above, pursuant to T.M.E.P. §§ 1505.02(c), and 807.13 and 807.14,

Applicant requests that the mark shown in the application be amended from 

to , as shown in the new drawing attached hereto and Applicant's foreign registration. Applicant submits this amendment does not materially alter the mark, nor does this amendment change the commercial impression of the mark. In addition, this amendment will not require any additional searching be conducted. Accordingly, such an amendment is proper. In support of this amendment, Applicant directs the Examining Attorney's attention to In support of the amendment, Applicant directs the Examining Attorney's attention to Visa International Service Association v. Life-Code Systems, Inc., 220 U.S.P.Q. 740 (T.T.A.B. 1983), where the Trademark Trial and Appeal Board set forth the standard to be used in determining whether an amendment is a material alteration of a trademark:

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 general test of whether an alteration is material is whether the mark would have to be republished after the alteration in order to fairly present the mark for purposes of opposition. If one mark is sufficiently different from another mark as to require republication, it would be tantamount to a new mark appropriate for a new application.

Id. at pp. 743-44.

Applicant respectfully submits that as the old and new form of the marks create essentially the same commercial impression, and as the amended mark contains what is the essence of the original mark, this amendment does not result in a material alteration. A new drawing attached here to showing the amended mark.

In light of the foregoing, Applicant respectfully submits that it has satisfied all requirements to register the mark under Section 44(e) of the Trademark Act, 15 U.S.C. §§ 1126(b) and (c). Accordingly, Applicant respectfully requests that the Examining Attorney grant Applicant's request for amendment, cancel the Notice of Allowance, delete the Section 1(b) basis, amend the goods, amend the mark and allow the application to proceed based solely on the foreign registration under Section 44(e) of the Trademark Act.

It is respectfully requested that the Examining Attorney contact the undersigned attorney if the Examining Attorney has any questions or requires any additional information regarding this matter.

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