

This is in response to a suspension notice issued November 26, 2016, suspending Trademark Application Serial No. 79178816 pending the outcome of USTTAB Cancellation No. 92064890 re U.S. Trademark Registration No. 1995539.

Pursuant to a mutual trademark consent agreement entered into between Applicant and the registrant under Registration No. 1995539, a true and complete copy of which is submitted herewith, Applicant is to submit the consent agreement in response to the aforementioned suspension notice regarding Application Serial No. 79178816, and within 10 calendar days after the USPTO's approval for publication of Application Serial No. 79178816 in Classes 9 and 18, Applicant shall file a voluntary withdrawal of Cancellation No. 92064890, with prejudice.

In an office action issued September 20, 2016, the Examining Attorney had previously refused registration of Application Serial No. 79178816 under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), with respect to Registration No. 1995539.

Under the aforementioned mutual trademark consent agreement, the cited registrant consents to Applicant's registration and use of its mark in the United States, and the parties mutually agree upon certain restrictions, limitations and provisions in order to avoid any likelihood of confusion. Moreover, under the agreement, the cited registrant and Applicant 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 with the agreement, and that provided the terms and conditions of the agreement are complied with, confusion between such marks is not likely given the restrictions on the stylizations and forms of use of their respective marks, differences in the respective goods on which their marks are used and

intended to be used, and the distinctness of their respective distribution channels and customer bases. The parties further agree in the agreement that if, contrary to their expectations, incidents of actual confusion between the parties or their goods marketed under their respective marks occur, the parties shall confer and use commercially reasonable efforts in good faith to attempt to ensure that such incidents do not recur.

In view of the parties' agreement and given the aforementioned limitations and restrictions on use of the respective marks for the parties' respective goods, Applicant respectfully submits that the consent agreement obviates any likelihood of confusion.

On a separate note, Applicant wishes to observe that Application Serial No. 79178816 is 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), said international registration being based on Australian Trade Mark No. 1693822. Applicant respectfully submits that when the aforementioned extension of protection of International registration no. 1279485 was received and entered at the USPTO on December 17, 2015, the Office incorrectly coded the mark as being in stylized letters. Applicant hereby declares that:

(1) Under the laws of the country of the basic application and/or registration, the basic application and/or registration includes, and thus the international registration includes, the legal equivalent of a standard character claim.

and

(2) The mark consists of standard characters without claim to any particular font style, size, or color.

Accordingly, Applicant respectfully requests that Application Serial No. 79178816 be amended to reflect that the mark therein is in standard character format.

Finally, in her office action issued September 20, 2016, the Examining Attorney observed that the wording in Applicant's Class 9 identification of goods "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" is missing a comma between "bags" and "cases." Applicant accepts the Examining Attorney's suggested change in this regard.

In conclusion, Applicant respectfully requests that the Examining Attorney withdraw the Section 2(d) refusal, amend the application as aforementioned and allow Application Serial No. 79178816 to proceed to publication.