

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**Applicant:** Metabowerke GmbH

**Mark:** METABO

**Serial No.:** 88/156,783

**Filing Date:** October 16, 2018

**ATTACHMENT TO RESPONSE TO OFFICE ACTION**

This paper forms part of Applicant's Response to the Office Action Mailed January 25, 2019.

**Cited Prior-Filed Applications.**

U.S. Application Serial No. 88062002 and U.S. Application Serial No. 87734140 have been cited as prior-filed applications. As noted below, USPTO records reflect that U.S. Application Serial No. 87734140 issued as Reg. No. 5801303 on July 9, 2019. Registration of Applicant's Mark would not engender a likelihood of confusion with either that registration nor any registration which may ultimately issue based on U.S. Application Serial No. 88062002 because those applications and the present Application are under a unity of control as will now be explained.

Attached Exhibit 1 is a true and correct copy of an image of the USPTO "TESS" database for U.S. Application Serial No. 87734140 as of July 17, 2009 which reflects that same issued as Reg. No. 5801303 on July 9, 2019. Attached Exhibit 2 is a true and correct copy of an image of the USPTO database record for U.S. Application Serial No. 877341410 as of July 17, 2019. Together, Exhibits 1 and 2 show that the owner of U.S. Application Serial No. 87734140 is Koki Holdings Co., Ltd. As reflected by the change of name which Exhibit 2 shows was recorded at Reel/Frame 6466/0305 Koki Holdings Co., Ltd. was formerly named Hitachi Koki Co., Ltd.

Attached Exhibit 3 is a true and correct copy of an image of the USPTO "TESS" database for U.S. Application Serial No. 88062002 as of July 17, 2019. Attached Exhibit 4 is a true and correct copy of an image of the USPTO database record for U.S. Application Serial No. 88062002 as of July 17, 2019. Together, Exhibits 3 and 4 show that the owner of U.S. Application Serial No. 88062002 is Koki Holdings Co., Ltd.

Attached as Exhibit 5 is a true and correct copy of the Declaration of Takuya Konnai as executed on June 27, 2019 together with the Exhibits A, B and C referred to therein (collectively, the “Konnai Declaration”). The Konnai Declaration is expressly incorporated herein by reference to form part of this Response, accordingly, there is no need to restate verbatim any its averments here.

The owner of the present Application is Metabowerke GmbH. The Konnai Declaration was made on behalf of Koki Holdings, Co., Ltd. and, together with its Exhibits, establishes that Metabowerke GmbH is a wholly-owned subsidiary of Koki Holdings Co., Ltd.. The Konnai Declaration further establishes that there is a unity of control over the marks of the cited prior-filed applications and other owned in the name of Koki Holdings, Co., Ltd. on the one hand, and the marks owned in the name of Metabowerke GmbH on the other hand, including without limitation Applicant’s Mark of the present Application. Paragraph 13 of the Konnai Declaration even goes beyond the averments demonstrating unity of control. Paragraph 13 of the Konnai Declaration makes of record the express written consent of Koki Holdings, Co. Ltd. to the registration of Applicant’s Mark in the name of Metabowerke GmbH.

In view of the foregoing, the Konnai Declaration and its Exhibits A, B, and C, Applicant respectfully submits that registration of Applicant’s Mark would not engender a likelihood of confusion with any registration owned by Koki Holdings, Co. Ltd., including without limitation the registration which issued on U.S. Application Serial No. 8773410 or any registration which may issue based on U.S. Application Serial No. 88062002. However in the event any refusal is made under Section 2(d) alleging the contrary, Applicant reserves the right to submit arguments and further evidence in response to such refusal.

### **Identification of Goods.**

The Identification of Goods has amended to delete “Hand tools and implements (hand-operated)” and; “cutting apparatus and saws, namely, hand operated saws” from the Application and the remaining goods, which were originally listed in the Application as “grinding discs”, “emery grinding wheels” and “cutting discs” have been amended for clarification such that they now read: “grinding discs, namely, grinding discs for power-operated grinders; emery grinding wheels, namely, emery grinding wheels for power-operated grinders; cutting discs, namely, cutting discs for power tools.” In view of those amendments, all goods remaining in the application have been re-classified to class 007.

Since the filing fee for a single class has been paid and since the Application continues to list goods in only a single class after the present amendments, no additional filing fee is due.

### **Specimen.**

A Substitute Specimen is submitted herewith together with a supporting Declaration.