

UNITED STATES PATENT AND TRADEMARK OFFICE  
**Trademark Trial and Appeal Board**  
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EJS/TJQ/AKL/kk

Mailed: August 9, 2016

In re *Breitling SA*

Serial No. 79152818

Filed: 7/7/2014

**By the Trademark Trial and Appeal Board:**

On July 6, 2016, Applicant filed a “motion to amend application,” one day after filing its reply brief. Because a motion to amend an application must be considered by the Examining Attorney, we treat this motion as part of a request for remand.

A request for remand must be supported by a showing of good cause. Whether good cause will be found will depend, in part, on the stage of the appeal at the time the amendment is filed, including the reason given for the delay. *See* TBMP Section 1205.01. In this case, because Applicant’s request for remand was filed after briefing was completed, the reason for the delay must be strong indeed. However, although Applicant has explained that its mark will be used to identify a watch model, it has not explained why it waited until this point in the appeal to delete “jewelry” from the identification, rather than during examination or even before the Examining Attorney submitted his brief, which occurred not even a month before Applicant filed its motion

to amend the identification. Accordingly, Applicant has not demonstrated good cause that would support our granting the request for remand.

However, the Examining Attorney has indicated to the Board his consent to the remand, and due solely to that consent, we hereby suspend proceedings in the appeal and remand the application to the Examining Attorney to consider Applicant's proposed amendment to its application.

In addition, we take note that, as part of its motion to amend, Applicant has stated that it will use the mark to identify a watch model. In fact, Applicant has stated that it wishes to remove "jewelry" from the identification of goods in order for the Board to properly determine whether Applicant's use of its mark would lead to consumer confusion. These statements have raised a question as to whether Applicant has a bona fide intention to use its mark for the other goods that are listed in its identification, namely, precious metals and alloys thereof, precious stones and chronometric instruments. Accordingly, the application is also remanded to the Examining Attorney to consider whether registration should be refused for these goods on the basis that Applicant does not have a bona fide intention to use the mark in commerce in connection with them. *See* TMEP Section 1904.01(c) (April 2016).

If the Examining Attorney believes that this question merits refusing registration with respect to these goods, he should, within 30 days, issue a non-final Office action to this effect. The Office action should also determine the acceptability of Applicant's proposed identification of goods. The Examining Attorney may include evidence as well as argument going to either or both of these grounds in the Office

action. If a final refusal on the “intent-to-use” issue ultimately issues, the Examining Attorney should omit the six-month-response clause from that Office action, and should omit any mention of an option for the Applicant to file a notice of appeal in response. Since an appeal has already been filed, the application should be returned to the Board, which will then take appropriate action.

However, if after considering Applicant’s statements regarding its intention to use the mark on watches, the Examining Attorney determines that no refusal is warranted, rather than issuing an Office action, the Examining Attorney should act on the motion to amend in the context of a supplemental appeal brief, in which the Examining Attorney may simply indicate that he has determined not to refuse registration on the no intent-to-use ground. With respect to the amendment to the identification of goods to delete jewelry, the Examining Attorney may use that supplemental brief to submit additional argument and evidence, if he wishes, to support the refusal of registration under Section 2(d) even with the amended identification.<sup>1</sup> The Examining Attorney is allowed 30 days to file such a brief, and Applicant is allowed 20 days from the mailing of that supplemental brief to file a supplemental reply brief responding to any argument or evidence in that brief. Applicant may not submit any additional evidence.

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<sup>1</sup> If registrability is found on the basis of the amendment, the appeal will be moot.