

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85226865
LAW OFFICE ASSIGNED	LAW OFFICE 103
MARK SECTION (no change)	
ARGUMENT(S)	
<p>For the reasons set forth in Applicant's response filed September 26, 2011 as well as due to the amendment of the identification of goods, the Section 2(d) refusal as to U.S. Registration Nos. 0698071, 2514977, 3886843, 2010643 and 3111002 should be withdrawn.</p> <p>With respect to Registration Nos. 2010643 and 3886843, Applicant submits herewith the relevant portion of the Trademark Assignment and License Agreement between Mat Industries LLC, the owner of those registrations, and Applicant. That Agreement allows for and consents to Applicant's registration of the POWERMATE mark for the goods, as amended, in the subject application.</p>	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_1214420254-132828303_.TM_ASSIGNMENT_AND_LICENSE_AGREEMENT.pdf
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT11\IMAGEOUT11\852\268\85226865\xml7\RFR0002.JPG
	\\TICRS\EXPORT11\IMAGEOUT11\852\268\85226865\xml7\RFR0003.JPG
DESCRIPTION OF EVIDENCE FILE	First two pages of December 30, 2009 Trademark Assignment and License Agreement between Applicant Pramac America LC and MAT Industries LLC.
GOODS AND/OR SERVICES SECTION (007)(current)	
INTERNATIONAL CLASS	007
DESCRIPTION	

Corded and cordless power tools, namely, drills, sanders, circular saws, portable 12V and 12V rechargeable air compressors and components for inflating tires, toys, rafts, and sports equipment; vacuum pumps

FILING BASIS Section 1(b)

GOODS AND/OR SERVICES SECTION (007)(proposed)

INTERNATIONAL CLASS 007

TRACKED TEXT DESCRIPTION

~~Corded and cordless power tools, namely, drills, sanders, circular saws, portable 12V and 12V rechargeable air compressors and components for inflating tires, toys, rafts, and sports equipment;~~
Corded and cordless power tools, namely, drills, sanders, circular saws; ~~vacuum pumps~~

FINAL DESCRIPTION

Corded and cordless power tools, namely, drills, sanders, circular saws

FILING BASIS Section 1(b)

GOODS AND/OR SERVICES SECTION (009)(no change)

GOODS AND/OR SERVICES SECTION (011)(no change)

ADDITIONAL STATEMENTS SECTION

PRIOR REGISTRATION(S) The applicant claims ownership of U.S. Registration Number(s) 1229284.

SIGNATURE SECTION

RESPONSE SIGNATURE /Mark A. Steiner/

SIGNATORY'S NAME Mark A. Steiner

SIGNATORY'S POSITION Attorney of record

SIGNATORY'S PHONE NUMBER 415-957-3036

DATE SIGNED 05/11/2012

AUTHORIZED SIGNATORY YES

CONCURRENT APPEAL NOTICE FILED NO

FILING INFORMATION SECTION

SUBMIT DATE Fri May 11 14:09:23 EDT 2012

TEAS STAMP
USPTO/RFR-12.144.20.254-2
0120511140923200567-85226
865-4903adf9484c3cf6770ab
ef771d7b846d1a-N/A-N/A-20

Request for Reconsideration after Final Action
To the Commissioner for Trademarks:

Application serial no. **85226865** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

For the reasons set forth in Applicant's response filed September 26, 2011 as well as due to the amendment of the identification of goods, the Section 2(d) refusal as to U.S. Registration Nos. 0698071, 2514977, 3886843, 2010643 and 3111002 should be withdrawn.

With respect to Registration Nos. 2010643 and 3886843, Applicant submits herewith the relevant portion of the Trademark Assignment and License Agreement between Mat Industries LLC, the owner of those registrations, and Applicant. That Agreement allows for and consents to Applicant's registration of the POWERMATE mark for the goods, as amended, in the subject application.

EVIDENCE

Evidence in the nature of First two pages of December 30, 2009 Trademark Assignment and License Agreement between Applicant Pramac America LC and MAT Industries LLC. has been attached.

Original PDF file:

[evi_1214420254-132828303_.TM_ASSIGNMENT_AND_LICENSE_AGREEMENT.pdf](#)

Converted PDF file(s) (2 pages)

[Evidence-1](#)

[Evidence-2](#)

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 007 for Corded and cordless power tools, namely, drills, sanders, circular saws, portable 12V and 12V rechargeable air compressors and components for inflating tires, toys, rafts, and sports equipment; vacuum pumps

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has had a bona fide intention to use or use

through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Proposed:

Tracked Text Description: ~~Corded and cordless power tools, namely, drills, sanders, circular saws, portable 12V and 12V rechargeable air compressors and components for inflating tires, toys, rafts, and sports equipment;~~ Corded and cordless power tools, namely, drills, sanders, circular saws; ~~vacuum pumps~~

Class 007 for Corded and cordless power tools, namely, drills, sanders, circular saws

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

ADDITIONAL STATEMENTS

Claim of Prior Registration(s)

The applicant claims ownership of U.S. Registration Number(s) 1229284.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Mark A. Steiner/ Date: 05/11/2012

Signatory's Name: Mark A. Steiner

Signatory's Position: Attorney of record

Signatory's Phone Number: 415-957-3036

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85226865

Internet Transmission Date: Fri May 11 14:09:23 EDT 2012

TEAS Stamp: USPTO/RFR-12.144.20.254-2012051114092320

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TRADEMARK ASSIGNMENT AND LICENSE AGREEMENT

This Trademark Assignment and License Agreement ("Agreement") is entered into and effective as of December 30, 2009 (the "Effective Date"), by and between Pramac America LLC, a Delaware limited liability company ("Pramac"), and MAT Industries LLC, an Illinois limited liability company ("MAT").

WHEREAS, Pramac and MAT previously entered into a Trademark License Agreement on June 30, 2008 relating to use of the POWERMATE and POWERSTATION marks in conjunction with air compressors, pneumatic tools and outdoor lawn and garden power equipment (the "2008 Agreement") and executed simultaneously herewith is an Amendment to the 2008 Agreement (the "Amendment"); and

WHEREAS, Pramac desires to assign to MAT the rights in the United States, Mexico, Canada, along with any and all territories and possessions of the foregoing, including but not limited to Puerto Rico (the "Territory"), to the POWERMATE mark for specific goods; and

WHEREAS, Pramac desires to grant to MAT a sole and exclusive license to use the Licensed Mark (hereinafter defined) in all other territories solely in connection with the procurement, promotion, marketing, sale, offer for sale and distribution of the Licensed Products (as hereinafter defined) (the "Business"); and

WHEREAS, MAT desires to accept such assignment and license to use the Licensed Mark in connection with the Business pursuant to the terms and conditions of this Agreement.

NOW THEREFORE, in consideration of the mutual covenants, agreements and warranties herein contained, and for other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the parties hereto agree as follows:

ARTICLE I ASSIGNMENT OF TRADEMARK

1.1 Assigned Mark. The "Assigned Marks" shall mean the mark POWERMATE along with any and all logos, stylization, colors, trade dress or the like previously used by Pramac or its predecessors-in-interest with the POWERMATE mark (i) in the Territory; and (ii) in conjunction with the Assigned Products (defined below).

1.2 Assigned Products. The "Assigned Products" shall mean air compressors, pneumatic tools used with air compressors, pressure washers, tools used with pressure washers, and parts, manuals and accessories for any of the foregoing.

1.3 Assignment. Pramac hereby assigns and agrees to sell, assign and transfer to MAT its entire right, title and interest in and to the Assigned Marks together with the goodwill of the business to which the Assigned Marks pertain, as well as all rights of enforcement and recovery for past infringement of the Assigned Marks. Pramac has filed an application for and secured a registration of the POWERMATE mark in which entirety of the goods fall within the scope of the Assigned Mark, specifically, US Ser. No. 77/565782 and Reg. Nos. 2687466 and 2010643. Pramac further agrees to take any and all reasonable and necessary steps to implement the provisions of this assignment to MAT

including, but not limited to, the execution of the assignment of US Ser. No. 77/565782 and Reg. Nos. 2687466 and 20106043. MAT will take all necessary steps to limit the description of the goods on such registrations to the Assigned Products. The parties agree to take procedural advantage of the status of the pending trademark application at Ser. No. 77565782 by using the application to divide the goods contained therein in accordance with the division of goods described below. The parties will take all reasonable steps to divide the pending trademark application at Ser. No. 77565782 so that each party will have the ability to secure registration for the following the goods and retain the benefit of the original filing date of the application:

Pramac Goods – Cl. 04 - Lubricating oils for use with machinery; Cl. 07 –magnetic starters; and Cl. 09 – Air tanks used in diving.

MAT Goods – Cl. 07 - Nozzles for air sanders; regulators for use with air tools; hose connectors and couplers for use with air tools; caulk guns, grinding stones for use with air tools; spray guns; sand blasters; combination filter, regulator and lubricator for use with air tools; chisels for use with air hammers; socket sets for use with air tools; portable air tanks for use with air tools; and Cl. 017 – Air hoses.

First, the application will be assigned in its entirety to MAT who will then proceed to (i) submit evidence of use for the MAT goods listed above and (ii) request division of the Pramac Goods into a second intent to use application. Then, MAT shall assign the second application containing the Pramac Goods to Pramac so that Pramac may continue prosecution of the new application as it chooses. If such division proves unreasonable, MAT has the right to prosecute the pending application and maintain ownership of the resulting registration, but, upon request by Pramac, shall promptly cancel from the application or registration any of the goods listed above as “Pramac Goods” and/or draft and execute, at MAT’s expense, any Consent Agreement or other document required by the Trademark Office to effect Pramac’s registration of the POWERMATE marks for the Pramac Goods identified above.

1.4 Overlapping Registrations of Assigned Marks. Pramac has secured various registrations of the POWERMATE mark in the Territory for which the Assigned Products comprise a portion of the entire description of goods listed in the registration (the “Overlapping Registrations”). Pramac will take any and all reasonable and necessary steps to either assign that portion of the Overlapping Registrations which relates to the Assigned Products or divide up the Overlapping Registrations to accomplish this task. The parties agree that they will abide by the following progression of actions to implement this assignment of the Overlapping Registrations: (a) file the appropriate request to divide the existing Overlapping Registration(s) to separate the Assigned Products from the remaining goods and then execute an assignment document of the divided portion relating to the Assigned Products for recordation at the appropriate national Trademark Office; or (b) voluntarily cancel the Assigned Products from the Overlapping Registration(s) and then cooperate with MAT in the successful registration in the name of MAT of the Assigned Mark for use with the Assigned Products.

1.5 Cooperation. The parties anticipate that it will require concerted effort on the part of both parties to implement the assignment and division of the Overlapping Registrations, requiring the submission of documentation by both Pramac and MAT to the respective Trademark Offices. Therefore, Pramac and MAT expressly agree to promptly and completely cooperate with one another in order to implement the necessary changes to the Overlapping Registrations. One aspect of such cooperation is the execution of Letters of Consent, including the Letters of Consent attached hereto as Exhibit B. Simultaneously with the execution of this Agreement, Pramac will execute and provide to MAT fully