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12-09-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #73

TRADEMARK

D9147-00011


**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re: Application of Saint-Gobain Abrasives, Inc.
Serial No.: 78/070568
Filing Date: June 22, 2001
Mark: NORTON/Class: 9
Trademark Attorney: Aretha Masterson/Law Office 112
Attorney Docket No. D9147-00011

CERTIFICATE OF MAILING

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL, POSTAGE PREPAID, IN AN ENVELOPE ADDRESSED TO : COMMISSIONER FOR TRADEMARKS, 2900 CRYSTAL DRIVE, BOX TTAB - FEE, ARLINGTON, VA 22202-3513, ON THE DATE INDICATED BELOW.

02 DEC 20 AM 10 30

BY: 
Allison Z. Gifford

DATE: December 5, 2002

**EX PARTE APPEAL FROM EXAMINER OF TRADEMARKS
TO TRADEMARK TRIAL AND APPEAL BOARD
AND REQUEST FOR RECONSIDERATION -
RESTORATION OF JURISDICTION TO EXAMINING ATTORNEY**

TO THE TRADEMARK TRIAL AND APPEAL BOARD:

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Examiner dated June 5, 2002, finally refusing registration of the above-identified trademark, in International Class 9, based on the mark being primarily merely a surname.

Applicant also encloses a Request for Reconsideration, for review and consideration by the Examining Attorney. Applicant requests that jurisdiction be restored to the Examining Attorney for consideration of the Request.

Please charge the \$100.00 filing fee for an appeal in one class, to our Deposit Account No. 04-1679; a duplicate copy is enclosed for charging purposes.

12/17/2002 CMAY11 00000152 041679 78070568

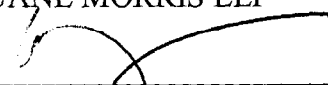
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Date: December 5, 2002

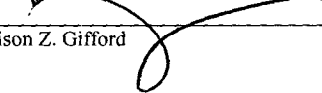
DUANE MORRIS LLP
One Liberty Place, Philadelphia, PA 19103-7396
(215) 979-1000

Respectfully submitted,

DUANE MORRIS LLP


Allison Z. Gifford
Attorney for Applicant

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO: COMMISSIONER FOR TRADEMARKS, BOX RESPONSE - NO FEE, 2900 CRYSTAL DRIVE, ARLINGTON, VA 22202-3513, ON THE DATE INDICATED BELOW.

By: 
Allison Z. Gifford

Date: December 5, 2002

In re Application:
Saint-Gobain Abrasives, Inc.

Mark: NORTON

Examining Attorney:
Aretha Masterson

Serial No.: 78/070568

Date of Filing: June 22, 2001

Trademark Law Office: 112

REQUEST FOR RECONSIDERATION AND AMENDMENT

Commissioner for Trademarks
BOX RESPONSE - NO FEE
2900 Crystal Drive
Arlington, Virginia 22202-3513

Sir:

In response to the Official Action mailed June 5, 2002, please amend the above-identified application as follows:

1. Add the following statement to the application: --The mark has become distinctive of Applicant's goods through the Applicant's substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement.--
2. Amend the identification of goods as follows: --protective apparel, particularly jackets, pants, overalls, and aprons, for protection against hazards and accidents occurring in industry--.

REMARKS

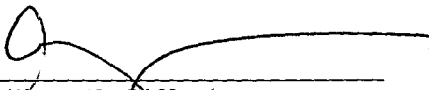
The Examining Attorney refuses registration of this application under Sec. 2(e)(4) of the Lanham Act on the ground that the mark sought to be registered is primarily merely a surname. Accordingly, Applicant respectfully amends the application to seek registration under Sec. 2(f) of the Lanham Act. Applicant has enjoyed continuous and substantially exclusive use of the NORTON mark for the five-year period preceding this claim of distinctiveness. Applicant encloses a Declaration Under 37 C.F.R. § 2.41 declaring that the mark has become distinctive as used with its goods.

CONCLUSION

Since a search of the Office records found no similar registered or pending marks which would bar registration of the mark NORTON and, in view of the foregoing, it is believed that this application is in condition for publication. Favorable action is requested.

Respectfully submitted,

Date: December 5, 2002



Allison Z. Gifford
Attorney for Applicant

DUANE MORRIS LLP
One Liberty Place
Philadelphia, PA 19103-7396
Phone: 215-979-1000

TRADEMARK**Attorney Docket No. D9147-00011****DECLARATION UNDER 37 C.F.R. § 2.41**

Mark: NORTON
Serial No.: 78/070568
Filed: June 22, 2001
Applicant: Saint-Gobain Abrasives, Inc.

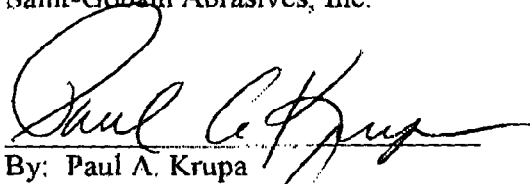
The undersigned, Paul A. Krupa, declares:

1. That I am the Senior Market Manager at Saint-Gobain Abrasives, Inc., owner of the mark NORTON and the corresponding application for Federal registration, as noted above; that I am authorized to execute this Declaration on behalf of Saint-Gobain Abrasives, Inc.; and that I am making this Declaration in the belief that the mark NORTON has become distinctive of the associated goods;

2. That the mark has become distinctive as used on and in connection with the goods by reason of substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement in commerce which may be lawfully regulated by Congress;

3. That the facts set forth in this Declaration are true; that all statements made herein of our own knowledge are true; and that all statements made herein on information and belief are believed to be true; that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or document or any registration resulting therefrom.

Saint-Gobain Abrasives, Inc.



By: Paul A. Krupa
Title: Senior Market Manager

Dated: December 5, 2002