

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	87377245
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 124
<b>MARK SECTION</b>	
<b>MARK</b>	<a href="https://tmng-al.uspto.gov/resting2/api/img/87377245/large">https://tmng-al.uspto.gov/resting2/api/img/87377245/large</a>
<b>LITERAL ELEMENT</b>	SWISSMATIC
<b>STANDARD CHARACTERS</b>	YES
<b>USPTO-GENERATED IMAGE</b>	YES
<b>MARK STATEMENT</b>	The mark consists of standard characters, without claim to any particular font style, size or color.
<b>ARGUMENT(S)</b>	
<b><u>RESPONSE TO OFFICE ACTION</u></b>	
<p>In an Office Action dated December 8, 2018, the Examining Attorney maintained and made final the refusal to register Applicant's mark SWISSMATIC pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).</p> <p>In response, and pursuant to T.M.E.P. § 1207.01(d)(viii) (Oct. 2018), Applicant respectfully submits herewith a Consent Agreement negotiated in good faith and at arm's length between Applicant and the Federation of the Swiss Watch Industry, owner of Certification Mark Registration No. 3,047,277 cited by the Examining Attorney, and duly signed by officers of each party. Applicant respectfully submits that whereas the Consent Agreement establishes, among other factors (as discussed in detail in Applicant's Response to Office Action dated November 8, 2018, and incorporated herein by reference), that the certification mark is used exclusively by manufacturers of Swiss watches (provided their watches meet the certification standards), that Applicant is a member of the Federation of the Swiss Watch Industry, that Applicant's watches comply with the standards regulating the certification mark SWISS, that the parties know of no instances of actual confusion among consumers resulting from the use of their respective marks, that the parties desire to continue to coexist without causing confusion, that the parties have agreed to cooperate in the unlikely event of actual confusion in order to alleviate any such confusion, and that no likelihood of confusion exists between the marks, and whereas the Federation of the Swiss Watch Industry expressly consents to Applicant's continued use and registration of the subject mark in the Consent Agreement, the</p>	

refusal to register should be withdrawn.

Whereas Applicant has satisfied the concerns and complied with the requirements of the Examining Attorney, Applicant respectfully reiterates its request that the subject refusal be withdrawn and that Applicant's mark be approved for publication.

#### EVIDENCE SECTION

EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	<a href="#">evi_389822016-20190610153154552176_.SWISSMATIC_Executed_Consent.pdf</a>
CONVERTED PDF FILE(S) (2 pages)	<a href="#">\\TICRS\EXPORT17\IMAGEOUT17\873\772\87377245\xml21\RFR0002.JPG</a>
	<a href="#">\\TICRS\EXPORT17\IMAGEOUT17\873\772\87377245\xml21\RFR0003.JPG</a>
DESCRIPTION OF EVIDENCE FILE	consent agreement

#### SIGNATURE SECTION

RESPONSE SIGNATURE	/Timothy D. Pecsénye/
SIGNATORY'S NAME	Timothy D. Pecsénye
SIGNATORY'S POSITION	Attorney of Record, PA Bar Member
SIGNATORY'S PHONE NUMBER	215-569-5619
DATE SIGNED	06/10/2019
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

#### FILING INFORMATION SECTION

SUBMIT DATE	Mon Jun 10 15:38:40 EDT 2019
TEAS STAMP	USPTO/RFR-XX.XX.XXX.XX-20 190610153840258784-873772 45-62097262634818fd4783cb 4b9ce9dccb135b61064f3a556 53bd838bdd8ff12fc3-N/A-N/ A-20190610153154552176

Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PTO Form 1960 (Rev 10/2011)

OMB No. 0651-0050 (Exp 09/20/2020)

### Request for Reconsideration after Final Action

#### To the Commissioner for Trademarks:

Application serial no. **87377245** SWISSMATIC(Standard Characters, see <https://tmng-al.uspto.gov/resting2/api/img/87377245/large>) has been amended as follows:

#### ARGUMENT(S)

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

#### RESPONSE TO OFFICE ACTION

In an Office Action dated December 8, 2018, the Examining Attorney maintained and made final

the refusal to register Applicant's mark SWISSMATIC pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

In response, and pursuant to T.M.E.P. § 1207.01(d)(viii) (Oct. 2018), Applicant respectfully submits herewith a Consent Agreement negotiated in good faith and at arm's length between Applicant and the Federation of the Swiss Watch Industry, owner of Certification Mark Registration No. 3,047,277 cited by the Examining Attorney, and duly signed by officers of each party. Applicant respectfully submits that whereas the Consent Agreement establishes, among other factors (as discussed in detail in Applicant's Response to Office Action dated November 8, 2018, and incorporated herein by reference), that the certification mark is used exclusively by manufacturers of Swiss watches (provided their watches meet the certification standards), that Applicant is a member of the Federation of the Swiss Watch Industry, that Applicant's watches comply with the standards regulating the certification mark SWISS, that the parties know of no instances of actual confusion among consumers resulting from the use of their respective marks, that the parties desire to continue to coexist without causing confusion, that the parties have agreed to cooperate in the unlikely event of actual confusion in order to alleviate any such confusion, and that no likelihood of confusion exists between the marks, and whereas the Federation of the Swiss Watch Industry expressly consents to Applicant's continued use and registration of the subject mark in the Consent Agreement, the refusal to register should be withdrawn.

Whereas Applicant has satisfied the concerns and complied with the requirements of the Examining Attorney, Applicant respectfully reiterates its request that the subject refusal be withdrawn and that Applicant's mark be approved for publication.

#### **EVIDENCE**

Evidence in the nature of consent agreement has been attached.

#### **Original PDF file:**

[evi\\_389822016-20190610153154552176\\_.SWISSMATIC\\_Executed\\_Consent.pdf](#)

**Converted PDF file(s)** ( 2 pages)

[Evidence-1](#)

[Evidence-2](#)

#### **SIGNATURE(S)**

##### **Request for Reconsideration Signature**

Signature: /Timothy D. Pecsénye/ Date: 06/10/2019

Signatory's Name: Timothy D. Pecsénye

Signatory's Position: Attorney of Record, PA Bar Member

Signatory's Phone Number: 215-569-5619

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 owner's/holder'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 owner/holder in this matter: (1) the owner/holder 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 owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder'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 filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 87377245

Internet Transmission Date: Mon Jun 10 15:38:40 EDT 2019

TEAS Stamp: USPTO/RFR-XX.XX.XXX.XX-20190610153840258

784-87377245-62097262634818fd4783cb4b9ce

9dccf135b61064f3a55653bd838bdd8ff12fc3-N

/A-N/A-20190610153154552176



Fédération de l'industrie horlogère suisse FH  
Verband der Schweizerischen Uhrenindustrie FH  
Federation of the Swiss Watch Industry FH

REQU le

11 APR 2019

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451  
United States of America

RE: Consent to Use and Registration  
United States Trademark Application  
For **SWISSMATIC**  
Serial No. 87/377,245  
In the Name of TISSOT SA

Dear Sir or Madam:

Dear Sir or Madam:

We understand that the United States Patent and Trademark Office ("USPTO") has issued a refusal to register the above-referenced trademark SWISSMATIC for "*horological and chronometric instruments as well as parts for the aforesaid goods; accessories for the aforesaid goods, namely, watch movements, watch bracelets; all aforementioned products from Switzerland*" [International Class 14] filed by TISSOT SA on the basis that the mark for such goods creates a likelihood of confusion with our registered certification mark, SWISS (U.S. Reg. No. 3,047,277).

Our certification mark is used exclusively by manufacturers of swiss watches, provided that their watches meet our certification standards.

We acknowledge that Tissot is itself a member of our organization, the Federation of the Swiss Watch Industry (the "Federation"). Furthermore, we acknowledge that Tissot watches comply with the standards regulating our certification mark SWISS.

Rue d'Argent 6  
2502 Biel/Bienne  
Switzerland

Tél. +41 (0)32 328 08 28  
Fax +41 (0)32 328 08 80  
[info@fhs.ch](mailto:info@fhs.ch)/[www.fhs.ch](http://www.fhs.ch)




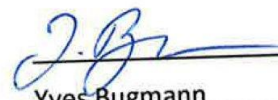
On the basis of this mutual understanding, the Federation consents to the use and registration by Tissot of the mark SWISSMATIC in connection with the above-identified goods. In the unlikely event of actual confusion arising, the Federation and Tissot will consult with each other in good faith on means of alleviating any such confusion.

Very truly yours,

ACKNOWLEDGED AND ACCEPTED:

**FEDERATION OF THE SWISS WATCH INDUSTRY**

By:   
Name: Jean-Daniel Pasche  
Title: President  
Date: April 8, 2019

By:   
Name: Yves Bugmann  
Title: Head of Legal Division  
Date: April 8, 2019

TISSOT SA

By:

Mireille Koenig

Name:

MIREILLE KOENIG

Title:

AUTHORIZED SIGNATORY

Date:

April 17, 2019

By:

Eric Schreiner

Name:

ERIC SCHREINER

Title:

AUTHORIZED SIGNATORY

Date:

April 17, 2019