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

Proceeding	91161375
Party	Defendant Kimberton Enterprises, Inc. Kimberton Enterprises, Inc. 336 Cold Stream Road Kimberton, PA 19442
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Date	01/04/2007
Attachments	AMEND001.PDF ( 5 pages )(102022 bytes )

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

BFS DIVERSIFIED PRODUCTS, LLC	:	
	:	
Opposer,	:	
v.	:	<b>Opposition No. 91 161375</b>
	:	
	:	Serial No. 76/513,202
	:	
HENRY COMPANY	:	
(formerly Kimberton Enterprises, Inc.)	:	
	:	
Applicant.	:	
	:	

**APPLICANT'S RENEWED MOTION TO AMEND APPLICATION**

Applicant, Henry Company (hereinafter "Applicant"), through its attorneys Pepper Hamilton LLP, hereby submits the following Renewed Motion to Amend Application in connection with the above-captioned opposition proceeding.

1. On April 21, 2003, Applicant applied for registration of its mark RUBBERKOTE (Serial No. 76/513,202) for "elastomeric roof coating system, namely elastomeric exterior coating primer, elastomeric base coat and elastomeric top coat" in International Class 19. The trademark was published in the Official Gazette on December 2, 2003.
2. On March 30, 2004, BFS Diversified Products, LLC ("Opposer") filed a notice of opposition which was instituted by the Trademark Trial and Appeal Board on July 22, 2004.
3. Applicant and Opposer have agreed upon the terms of a Settlement Agreement (the "Agreement"), which will be executed and become effective after the present

Renewed Motion to Amend Application has been granted and the amendment has been entered by the United States Patent and Trademark Office.

4. Applicant is concurrently filing herewith a Notice of Assignment and Motion for Substitution of Party. The assignment of the RUBBERKOTE mark from Kimberton Enterprises, Inc. to Applicant, the parent company of Kimberton Enterprises, Inc., was recorded on August 3, 2006 at Reel 3361, Frame 0618.

5. Applicant hereby seeks to amend its mark from RUBBERKOTE to HENRY RUBBERKOTE. Applicant, who by assignment is the current owner of the mark RUBBERKOTE, is also the owner of numerous registrations bearing the mark HENRY for the same and similar goods as those for which Applicant currently applies:

a. Registration No. 1501782 for HENRY for “cements for (sic) roofing membranes, cements for roll roofing and cement for laps and seams in composition roofing” in International Class 1; for “roof paints, reflective paints and primer for asphalt roof coatings” in International Class 2; and for “roof sealants, fabric membranes for roofs, asphalt-based driveway coatings and asphalt-based driveway crack fillers” in International Class 19;

b. Registration No. 1064754 for HENRY for “floor covering adhesives, molding adhesives, wall panel adhesives, subfloor adhesives, wallboard adhesives, acoustical tile adhesives, insulation adhesives for use in installation of foam insulation, ceramic tile adhesives, metal tile adhesives and brick adhesives” in International Class 1; for “roof paints and reflective paints” in International Class 2; and for “plastering compound, floor patching compound, dry wall stud mastic, and tile grout” in International Class 19;

c. Registration No. 1706784 for HENRY for “mortar and grout for ceramic tile” in International Class 19;

d. Registration No. 2812328 for HENRY LO-SLOPE for “roofing membrane supplied in rolls, consisting of asphalt combined with rubber polymer, reinforced with fabric” in International Class 19; and

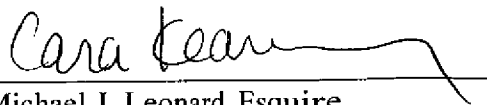
e. Registration No. 2743485 for HENRY...BECAUSE YOU ONLY WANT TO DO IT ONCE for “roof coatings in the nature of paint” in International Class 2; and for “roof cements namely, plastic roof cement and coal tar patching compositions, non-metal building flashing compound white roofing mastic, elastomeric roofing mastic, asphalt-based cold-applied roof cement; asphalt-coating gravel binder; rubberized asphalt emulsion adhesive and lap cement and roof coatings, namely, asphalt emulsion roof coatings, solvent-based asphalt roof coatings, asphalt primer for roofing, asphalt-based reflective roof coatings, containing aluminum white latex-based reflective roof coatings, acrylic-based elastomeric roof-coatings, and asphalt-based roof patching compound” in International Class 19.

6. Consistent with Trademark Manual of Examining Procedure § 807.14(b), the requested amendment adds “an element that the applicant has previously registered for the same goods.” Here, the requested amendment adds “HENRY”, a mark that Applicant has previously registered for the same and similar goods. Therefore, the amendment of the mark from RUBBERKOTE to HENRY RUBBERKOTE is not a material change which would require republication of the mark. See TMEP §807.14(b) (“the addition of applicant’s well-known registered mark to the mark sought to be registered is not a material change which would require republication of the mark”) (internal citation omitted).

7. Upon amendment to Applicant’s mark as requested herein, and pursuant to the terms of the anticipated Agreement, Opposer will withdraw its opposition to Applicant’s application.

WHEREFORE, in an effort to amicably resolve this proceeding, Applicant Henry Company respectfully requests that the Board approve this amendment and forward the approved Motion to the Examining Attorney.

Respectfully submitted,



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Dated: 1/4/07

Attorneys for Applicant  
HENRY COMPANY

CERTIFICATES OF SERVICE AND MAILING

I certify that on January 4, 2007, I caused a true and correct copy of the foregoing Renewed Motion to Amend Application on behalf of Applicant, Henry Company, to be served via United States Postal Service first-class mail, postage prepaid, upon the following:

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