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

Proceeding	92051558
Party	Defendant Manhattan Skyline Construction Corp.
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Attachments	Manhattan Constr v Manhattan Skyline -motion to amend registration.pdf ( 8 pages )(1755254 bytes )

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

MANHATTAN CONSTRUCTION COMPANY	)	
	)	
Petitioner,	)	
	)	
v.	)	Cancellation No.
	)	92051558
	)	
MANHATTAN SKYLINE CONSTRUCTION CORP.	)	
	)	
Registrant	)	

**REGISTRANT'S MOTION TO AMEND CERTIFICATE OF REGISTRATION AS  
PROVIDED FOR IN PARTIES' CONSENT TO USE AND REGISTRATION  
AGREEMENT REACHED IN SETTLEMENT OF THIS PROCEEDING**

Registrant, Manhattan Skyline Construction Corp., with the consent of counsel for Manhattan Construction Company, submits this motion pursuant to Section 7(e) of the Trademark Act, as well as 37 C.F.R. 2.133 and Section 1609.01(b) of the Trademark Manual of Examining Procedure, to amend the services in Registration No. 2,948,795.

The amendment of the registration is sought because the parties reached a settlement of this proceeding by their Consent to Use and Registration Agreement dated September 23, 2010. A copy is attached as Exhibit A hereto. Paragraph 3 of the Agreement provides: "Within fourteen (14) days of its receipt of a fully executed duplicate original of this Agreement, [Registrant] shall amend the services of its United States Registration No. 2,948,795 to read "general contracting services for, and renovation and rehabilitation, of apartment buildings". Registrant notes that the services

in its registration presently are “general contracting services, renovation and rehabilitation of buildings”. As the proposed amendment limits the services, Registrant respectfully submits the amendment is appropriate.

Section 7(e) of the Trademark Act provides in pertinent part, “Upon application of the owner and payment of the prescribed fee, the Director for good cause may permit any registration to be amended or to be disclaimed in part: *Provided*, That the amendment or disclaimer does not alter materially the character of the mark”. Here, the proposed amendment is just a limitation on the services in the registration and does not materially alter the mark. Registrant submits that the “good cause” requirement of Section 7(e) is met as the amendment is intended to narrow the scope of the services in the registration to enable Applicant to register the marks in its pending applications (which have been blocked by Registrant’s registration). Moreover, Registrant provides for the fee payment of \$100 as below. The requirements of Section 7(e) thus are met.

37 C.F.R. Section 2.133(a) provides in pertinent part that a registration that is the subject of a cancellation proceeding may not be amended “except with the consent of the other party...and the approval of the Trademark Trial and Appeal Board, or upon motion granted by the Board”. Since counsel for the other party has given her consent, Applicant submits that the requirements of this rule have been met.

Section 1609.01(b) of the Trademark Manual of Examining Procedure provides that original certificates of registration are not required for request for amendment under Section 7 of the Trademark Act. Consequently, Registrant is not submitting the original certificate of registration with this motion.

Jenna B. Perry, Esq., counsel for Petitioner Manhattan Construction Company has given her written consent to this motion to amend Registrant's registration.

Registrant requests that the \$100 fee for the requested amendment be charged to the undersigned's Deposit Account No. 504581.

In view of the above requirements being met, Registrant submits that its motion to amend its certificate of registration is well-placed and should be granted.

The undersigned, being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this documents, declares that he is properly authorized to execute this document on behalf of the Registrant; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

BAKER & HOSTETLER LLP

Dated: November 4, 2011

By:

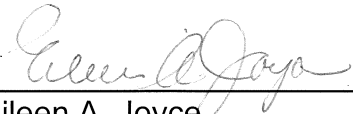


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(212) 589-4200  
Attorneys for Registrant  
Manhattan Skyline Construction Corp.

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing REGISTRANT'S MOTION TO AMEND CERTIFICATE OF REGISTRATION AS PROVIDED FOR IN PARTIES' CONSENT TO USE AND REGISTRATION AGREEMENT REACHED IN SETTLEMENT OF THIS PROCEEDING was served upon counsel for Petitioner this 4th day of November, 2010, by first class mail, postage prepaid, in an envelope addressed as follows:

Jennifer B. Perry  
McAfee & Taft  
1717 S. Boulder, Suite 900  
Oklahoma City, Oklahoma 74119

  
\_\_\_\_\_  
Eileen A. Joyce

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**EXHIBIT A**

## **CONSENT TO USE AND REGISTRATION AGREEMENT**

This is a Consent Agreement ("Agreement") effective September 23, 2010 by and between Manhattan Construction Company, an Oklahoma corporation located and doing business at 5601 South 122<sup>nd</sup> East Avenue, Tulsa, Oklahoma 74114 ("MCC") and Manhattan Skyline Construction Corp., a New York corporation located and doing business as c/o The Zucker Organization, 101 West 55<sup>th</sup> Street, New York, New York 10019 ("MSCC").

### **INTRODUCTION**

MCC has been using the service marks MANHATTAN and MANHATTAN CONSTRUCTION COMPANY in connection with building construction services since at least as early as December 12, 1907 and wishes to federally register its marks.

On July 18, 2008, MCC filed United States Application Serial No. 77/478,127 for registration of the mark MANHATTAN for "building construction services" and United States Application Serial No. 77/526,349 for registration of the mark MANHATTAN CONSTRUCTION COMPANY for "building construction services."

MSCC has been using the service mark MANHATTAN SKYLINE CONSTRUCTION CORP. for general contracting services, renovation and rehabilitation of buildings since at least as early as January 3, 2005.

MSCC is the owner of United States Registration No. 2,948,795 for MANHATTAN SKYLINE CONSTRUCTION CORP. (exclusive rights to "MANHATTAN" and "CONSTRUCTION CORP." disclaimed) for "general contracting services, renovation and rehabilitation of buildings." MSCC's United States Registration No. 2,948,795 has been cited against MCC's Application Serial Nos. 77/478,127 and 77/526,349 to register MANHATTAN CONSTRUCTION COMPANY and MANHATTAN based on confusing similarity.

The parties have not experienced any instances of actual confusion during the time that their use of their respective marks have coexisted.

MCC and MSCC believe that the provisions below in which they delineate their respective service mark applications and registrations will result in an avoidance of any likelihood of confusion, mistake or deception.

### **MCC'S AND MSCC'S RIGHTS AND OBLIGATIONS**

In consideration of the terms below and for good and valuable consideration, MCC and MSCC agree as follows:

1. The parties accept the factual recitations above as true.
2. MSCC consents to the concurrent use and registration by MCC of the service marks MANHATTAN and MANHATTAN CONSTRUCTION COMPANY in both standard character and stylized form and without any limitation. Specifically, MSCC


consents to the concurrent registration by MCC of United States Application Serial No. 77/478,127 for registration of the mark MANHATTAN and United States Application Serial No. 77/526,349 for registration of the mark MANHATTAN CONSTRUCTION COMPANY.

3. Within fourteen (14) days of its receipt of a fully executed duplicate original of this Agreement, MSCC shall amend the services of its United States Registration No. 2,948,795 to read “general contracting services for, and renovation and rehabilitation, of apartment buildings.”
4. MSCC and MCC agree that use and registration of their respective marks stated herein for their respective services stated herein is not likely to cause confusion, mistake or deception. The parties’ mutual consents and limitations expressed in the paragraphs herein are supported by the differences in the parties’ marks, the differences in the nature of the parties’ respective services and their discriminating target purchasers.
5. If any instance of actual confusion, mistake or deception is brought to the attention of either party hereto, that party shall promptly notify the other party and the parties shall cooperate in good faith to take steps to eliminate such confusion in the future.
6. MSCC specifically agrees to limit its use of the mark MANHATTAN SKYLINE CONSTRUCTION CORP. to general contracting services for, and renovation and rehabilitation, of apartment buildings. MSCC also specifically agrees to limit its use of the mark MANHATTAN SKYLINE CONSTRUCTION CORP. to the states of New York, New Jersey and Connecticut.
7. MCC and MSCC agree to suspend Cancellation No. 92051558 to carry out the terms of this Agreement. Provided that MSCC has complied with all terms of this Agreement, MCC will dismiss Cancellation No. 92051558 within thirty (30) days of receipt of the final of all of the following documents: (1) a certificate of registration for United States Application Serial No. 77/478,127; (2) a certificate of registration for United States Application Serial No. 77/526,349; and (3) a copy of the amended certificate of registration for United States Registration No. 2,948,795 to read “general contracting services for, and renovation and rehabilitation, of apartment buildings.”
8. MCC and MSCC agree to take such further action and execute such further agreements which may be necessary to carry out the spirit of this Agreement.
9. The benefits of this Agreement shall inure to the parties and their respective licensees, successors and assigns, and companies which are affiliates of, or are related to, the parties.
10. This Agreement constitutes the entire agreement between the parties. Any prior or concurrent representations made by the parties or their representatives, to the contrary notwithstanding, are fully merged herein.

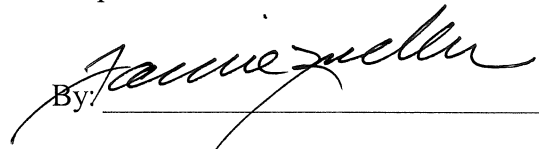


11. If any term of this Agreement is found to be invalid then such term shall be severed or adapted to be in accordance with such law and the rest of this Agreement shall remain in full force and effect.
12. This Agreement may be modified only by a writing which is signed by both parties.
13. Each party hereto shall bear its own attorneys' fees and costs.
14. Each party represents to the other that the person signing this Agreement on its behalf is authorized to do so and to bind its respective party hereto.

Agreed to by Manhattan Construction Corp.

By:   
\_\_\_\_\_  
Kevin P. Moore  
Executive Vice President

Agreed to by Manhattan Skyline Construction Corp.

By:   
\_\_\_\_\_  
Name and Title: LAURIE ZUCKER  
CEO