



THIS DECISION IS CITABLE AS PRECEDENT

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
www.uspto.gov

Re: Trademark Applications of	:	
P.T. Polymindo Permata	:	
	:	
U.S. Application Serial No. 85062213	:	
Filing Date: June 14, 2010	:	On Petition
Mark: VIROREED	:	
	:	
U.S. Application Serial No. 85062255	:	
Filing Date: June 14, 2010	:	
Mark: VIROTHATCH	:	
	:	
Petition Filed: August 6, 2013	:	

P.T. Polymindo Permata (petitioner) has separately petitioned the Director of the United States Patent and Trademark Office (Director) in each of the applications identified above to: (1) reverse the trademark examining attorney’s abandonment of the above-identified applications for failure to file a complete response to final Office actions; and (2) accept substitute specimens and supporting declarations. The Director has the authority to review petitioner’s request. *See* 37 C.F.R. §2.146(a)(3). Because the same issue is presented in both petitions, the Director is issuing a single decision. The petitions are granted.

FACTS¹

Petitioner submitted statements of use on January 25, 2012, pursuant to Trademark Act Section 1(d). 15 U.S.C. §1051(d). On April 11, 2012, the examining attorney issued Office actions refusing the specimens submitted with the statements of use because they consisted of advertising material for the goods. Petitioner filed responses on October 11, 2012, including different specimens. The examining attorney issued final Office actions on November 19, 2012, refusing all of the specimens of record because they consisted of advertising material for the goods.

The issuance of the final refusals triggered a six-month response period during which, to avoid abandonment of the application, petitioner was required either to file appeals to the Trademark Trial and Appeal Board (TTAB) or petitions, if permitted under Trademark Rule 2.63(b)(2), or to comply with the outstanding requirements. 37 C.F.R. §§2.63(b)(2), 2.64(a); TMEP §715.01. The final Office actions set forth each of these options. Petitioner did not file appeals. Instead, on May 16, 2013, petitioner filed requests for reconsideration including substitute specimens consisting of packaging for the goods. The substitute specimens were not accompanied by supporting declarations under Rule 2.20. 37 C.F.R. §2.20.

¹ This decision recites only the facts relevant to the issue on petition.

The examining attorney did not grant the requests for reconsideration because the requests did not include the required declarations in support of the substitute specimens. On July 5, 2013, the examining attorney held the applications abandoned because petitioner failed to file a complete response to the November 19, 2012 final Office actions. On August 6, 2013, petitioner filed these petitions requesting reversal of the holdings of abandonment and included substitute specimens consisting of packaging for the goods and signed declarations under Rule 2.20 in support of the specimens.

DISCUSSION

As noted in the *Trademark Manual of Examining Procedure* (TMEP) §1706 (Oct. 2013), the Director may review the actions of an examining attorney or paralegal under Rule 2.146(a)(3) for clear error or abuse of discretion. 37 C.F.R. §2.146(a)(3). The Director may exercise supervisory authority on petition in appropriate circumstances. *See* 35 U.S.C. §2; 37 C.F.R. §2.146(a)(3). In some cases, the Director will exercise supervisory authority even where there has been no clear error or abuse of discretion, if a petitioner can show that it has substantially complied with the requirements of the statute or rules. *See In re Carnicon Dev. Co.*, 34 USPQ2d 1541, 1543 (Comm'r Pats. 1992) (assertion of verified date of first use, coupled with statement of current method of use, interpreted as substantially in compliance with minimum filing requirement of Rule 2.88(e)(3), 37 C.F.R. §2.88(e)(3), for an allegation in a statement of use that the “mark is in use in commerce.”).

The Director finds no clear error in the abandonment of the applications for failure to file complete responses because the lack of supporting declarations for the substitute specimens rendered the requests for reconsideration incomplete responses. *See* 37 C.F.R. §2.65(a). However, the submission of requests for reconsideration that included acceptable substitute specimens that would obviate the specimen refusals, which were missing only supporting declarations, demonstrated substantial compliance and a bona fide attempt to advance these examinations on the part of petitioner. The preferred action in this case would have been for the examining attorney to provide an additional 30-day period for petitioner to perfect its responses by submitting the supporting declarations. *See* 37 C.F.R. §2.65(b); TMEP §715.03(a)(2)(C) (“If the applicant has made a good-faith but incomplete attempt to comply and there is no time remaining or fewer than 30 days remaining in the six-month response period, the examining attorney has discretion under [Rule 2.65(b),] 37 C.F.R. §2.65(b)[,] to issue an ‘Examiner’s Action Continuing a Final Refusal – 30 day Letter’ that gives the applicant additional time to resolve the matters that remain outstanding.”); *see also* TMEP §718.03(b) (“Under [Rule 2.65(b)] . . . , the examining attorney has discretion to give an applicant additional time to perfect the response if: (1) the response was filed within the six-month period; (2) the response was a bona fide attempt to advance the examination; (3) the response was a substantially complete response to the examining attorney’s action; and (4) consideration of some matter or compliance with some requirement was inadvertently omitted. Generally, this discretion should be exercised in connection with a response to a final action.”).

In this case, the Director finds that petitioner substantially complied with the examining attorney’s requirements by submitting, as part of its requests for reconsideration, unverified but otherwise acceptable specimens that would have obviated the specimen refusals. In addition, on

petition, petitioner has completed its responses by providing accompanying declarations under Rule 2.20. Therefore, the Director agrees to exercise supervisory authority to revive the applications because petitioner has now perfected proper responses to the examining attorney's specimen refusals. *See* 37 C.F.R. §2.146(a)(3).

DECISION

The petitions are granted. The applications will be revived and forwarded to the examining attorney for examination of the substitute specimens and supporting declarations submitted with the petitions.

Sharon R. Marsh

Sharon R. Marsh
Deputy Commissioner
for Trademark Examination Policy

SRM:CAG

Date: December 17, 2013

Attorney for Petitioner:

William W. Haefliger, Esq.
201 South Lake Avenue, Suite 512
Pasadena, CA 91101-3087