

Re: Specialty Products Company :
 Registration No. 626,079 :
 Registration Date: May 1, 1956 : On Petition
 For: GLASSFLOW :
 Petition Filed: November 27, 1996 :

Specialty Products Company has petitioned the Commissioner to permit amendment of the identification of goods in the above-identified registration. The petition is denied under Section 7(e) of the Trademark Act and Trademark Rules 2.146 and 2.173.

FACTS

The above-identified registration issued on May 1, 1956 for “emulsifiable oil intended as a lubricant for glass working machinery.”

On December 12, 1995, Petitioner filed an application for amendment of trademark registration, requesting amendment to the goods identified in U.S. Registration No. 626,079. Specifically, Petitioner requested that the term “emulsifiable” be deleted from the identification of goods.

On March 28, 1996, Petitioner filed its second renewal, under Section 9 of the Trademark Act. In a letter dated May 13, 1996, the Applications Examiner in the Post Registration Division refused to accept the proposed amendment to the identification of goods. Petitioner filed a response to the refusal on May 24, 1996. On August 1, 1996, the Applications Examiner continued the refusal to accept the proposed amendment to the identification of goods. This petition followed.

ANALYSIS

Section 7(e) of the Trademark Act provides for amendments to registrations. Petitioner argues that Section 7 of the Trademark Act contains no prohibition against amending a registration to broaden the scope of identification of the goods. Further, Petitioner argues that Trademark Rule 2.173(b) contains no prohibition against amending a registration to broaden the scope of identification of the goods. Finally, Petitioner notes that the Trademark Manual of Examining Procedure, at section 1607.03, makes clear that the post-registration standard for accepting amendments to identifications of goods is whether republication of the mark would be required. Petitioner states that “the mere deletion of the word ‘emulsifiable’ certainly would not require republication of the mark.”

The “republication” standard to which Petitioner refers is used to analyze proposed changes to the mark itself. More serious, however, is the fact that Petitioner has very much mischaracterized the relevant provision of Trademark Rule 2.173(b) with respect to post-registration amendments to the identification of goods. Trademark Rule 2.173(b), 37 C.F.R. §2.173(b), reads, in its entirety, as follows:

(b) No amendment in the identification of goods or services in a registration will be permitted except to restrict the identification or otherwise to change it in ways that **would not** require republication of the mark. No amendment seeking the elimination of a disclaimer will be permitted. [Emphasis added].

Trademark Rule 2.1 73(b) thus expressly prohibits acceptance of amendments to an identification that would do other than restrict the identification.

Amendments under Section 7 are always published in the Trademark *Official Gazette*. However, parties that might be affected by changes in a registration usually derive minimal benefit from such notice. This is because Section 14 of the Trademark Act restricts the bases for filing a petition to cancel a registration, and especially limits the bases for cancellation after five years from the date of registration of a mark. The registration for Petitioner's mark was issued in 1956. Therefore, while publication of the amendment to the identification of goods in the *Official Gazette* would provide notice of the change, any party facing possible harm would be without effective recourse to protest the change. To avoid irremediable harm to third parties, the Commissioner strictly enforces the requirement of Rule 2.713(b), with respect to amendments to the identification of goods. Petitioner itself is not without a remedy. If it believes that the underlying goods identified by its mark have so changed as to require a new identification, Petitioner may file a new application.

DECISION

The petition is denied. The registration file will be returned to the Post Registration Division for consideration of the renewal application.

Should Petitioner wish to file a new application for registration of the mark GLASSFLOW for "oil intended as a lubricant for glass-working machinery," the office will, upon request, expedite handling of the application. TMEP §1102.03. The application filing fee is currently \$245.00 per class.

Philip G. Hampton, II
Assistant Commissioner
for Trademarks

PGH:EKM

Date:

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