

Re: Trademark Application of
Carver Corporation
Serial No. 74/644932
Filing Date: March 7, 1995
For: POWERLINK and Design
Petition Filed: August 28, 1996

On Petition

Carver Corporation has petitioned the Commissioner to revive the above-identified application. The petition to revive is denied under Trademark Rule 2.146(a)(3), 37 C.F.R. §2.146(a)(3).

FACTS

On August 21, 1995, the Examining Attorney issued a Priority Action requiring new specimens of use. The Petitioner filed substitute specimens with its October 31, 1995 response. On December 4, 1996, the Examining Attorney issued a second, FINAL Priority Action, continuing the requirement for acceptable specimens of use. The Petitioner filed a second set of substitute specimens with its response of June 4, 1996.

In a note to the file, dated July 12, 1996, the Examining Attorney indicated that he considered the June 4, 1996 response to be incomplete because the specimens still did not show use of the applied-for mark on the goods. Therefore, the application was deemed abandoned. This petition followed.

DECISION

Trademark Rule 2.146(b), 37 C.F.R. §2.146(b), makes clear that “[q]uestions of substance arising during the ex parte prosecution of applications, including, but not limited to, questions arising under sections 2, 3, 4, 5, 6 and 23 of the Act of 1946, are not considered to be appropriate subject matter for petitions to the Commissioner.”

Whether an Examining Attorney followed proper procedure in issuing a FINAL Office Action, and whether an application is properly declared abandoned, are clearly procedural issues, reviewable by the Commissioner on petition. However, the Commissioner will reverse the action of an Examining Attorney only in cases where there has been a clear error or an abuse of discretion. *In re Richards-Wilcox Manufacturing Co.*, 181 USPQ 735 (Comm’r Pats. 1974); *Ex parte Peerless Confection Company*, 142 USPQ 278 (Comm’r Pats. 1964).

According to TMEP §1105.04(c), a refusal or requirement is in condition for FINAL action when the Applicant has had at least one opportunity to reply to each basis for refusal, or each requirement, asserted by the Examining Attorney.

In the present case, both the first and second Office Actions contained a requirement under Trademark Rule 2.56, 37 C.F.R. §2.56, that the Petitioner submit three acceptable specimens of

use. In both Office Actions, the Examining Attorney explained that the specimens of record did not demonstrate use of the proposed mark in connection with the underlying goods. Thus, the FINAL Office Action properly issued because the specimens requirement was clearly made (and maintained) in both the first and second Office Actions.

Accordingly, the Petition is denied. The application will remain abandoned.

Philip G. Hampton, II
Assistant Commissioner
for Trademarks

PGH:NLO:EKM

Date:

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