

Re: Trademark Application of :  
 S Industries, Inc. :  
 Serial No. 75/143090 :  
 Filing Date: July 29, 1996 : On Petition  
 For: SENTRA :  
 Petition Filed: April 13, 1998 :

S Industries, Inc. has petitioned the Commissioner to reinstate the registration that was inadvertently issued from its application. Trademark Rule 2.146(a)(3) provides authority for the requested review. The petition is denied under Trademark Act Section 13, 15 U.S.C. § 1063.

## FACTS

The subject application was filed July 29, 1996, based upon use of the mark in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a). The mark was published for opposition on July 8, 1997. On August 6, 1997, Centra 2000, Inc., (“Opposer”) filed the Notice of Opposition together with a Motion to Suspend Opposition pending final determination of a civil action between Opposer and Petitioner in the U.S. District Court of the Northern District of Illinois, under Case No. 96 C 3524 (the “civil action”). The Trademark Trial and Appeal Board (the “Board”) instituted the opposition proceeding on September 22, 1997 (the “opposition proceeding”). The Board suspended the opposition proceeding on October 30, 1997. However, on February 17, 1998, the subject application issued inadvertently as Registration No. 2,136,716 (the “Registration”). On March 19, 1998, the Board notified the parties that the Registration would be cancelled because it issued as a result of a clerical error. On April 7, 1998, the Commissioner cancelled the Registration as inadvertently issued after institution of the opposition proceeding. This petition followed on April 13, 1998.

In its petition, Petitioner requested that the Commissioner “not cancel” the Registration in light of the civil action. Petitioner asserted that cancellation of the inadvertently issued registration is not warranted because of an “inconsistency” in the positions taken by Opposer in the civil action and the opposition proceeding.<sup>1</sup> Petitioner also requested that the Commissioner dismiss the opposition proceeding.

## ANALYSIS

*Registrations issued inadvertently during the pendency  
of an opposition proceeding must be cancelled.*

<sup>1</sup> It is noted that Petitioner attached an uncertified Memorandum Opinion and Order dated March 31, 1998 for the civil action by which summary judgment was entered in favor of the Opposer, who is the defendant in the civil action.

The Commissioner has the inherent authority to cancel an inadvertently issued registration. This authority will be exercised with caution. *In re McLachlan Touch, Inc.*, 6 USPQ2d 1395 (Comm'r Pats. 1988). A mark that issues while the application for registration is subject to a timely opposition, is not issued in compliance with Section 13 of the Trademark Act, 15 U.S.C. §1063.

The above-referenced application issued inadvertently while the application was subject to a timely opposition. The Registration appropriately was cancelled on April 7, 1998 as not issuing in compliance with Section 13 of the Trademark Act.<sup>2</sup>

*Substantive questions are not appropriate for consideration on petition to the Commissioner.*

Petitioner's assertions that Opposer takes "inconsistent positions" in the civil action and the opposition proceeding amount to a question of substance that is inappropriate for consideration on petition to the Commissioner. Questions of substance arising during the *ex parte* prosecution of applications, including, but not limited to, questions arising under §§2, 3, 4, 5, 6 and 23 of the Act of 1946, are not considered appropriate subject matter for petitions to the Commissioner. Trademark Rule 2.146(b), 37 C.F.R. 2.146(b). While not a question of substance arising out of the *ex parte* prosecution of the application, the question of whether there is a likelihood of confusion between respective marks in an opposition proceeding is also not appropriate subject matter for petition to the Commissioner. *Cf. In re Direct Access Communications (M.C.G.) Inc.*, 30 USPQ2d 1393 (Comm'r Pats. 1993).

## **DECISION**

The petition is denied. The file will be returned to the Board.

Philip G. Hampton, II  
Assistant Commissioner for  
Trademarks

Date:

PGH:SLC

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<sup>2</sup> Section 13(b)(1) of the Trademark Act, 15 U.S.C. 1063(b)(1), states, in pertinent part:

Unless registration is successfully opposed – (1) a mark entitled to registration on the principal register based on an application filed under §1(a) or pursuant to §44 shall be registered in the Patent and Trademark Office...

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