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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
OFFICE OF ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 Crystal Drive
Arlington, Virginia 22202-3513

99-420

Re: Trademark Application of :
The Standard Register Company :
Serial No. 75/157,384 :
Filing Date: August 22, 1996 : On Petition
For: INNOVATIVE DOCUMENTS :
& SYSTEMS :
Petition Filed: June 1, 1999 :

The Standard Register Company has petitioned the Commissioner to revive the above referenced application, or alternatively, to extend the time within which Petitioner may appeal to the Trademark Trial and Appeal Board. The petition is denied pursuant to 37 C.F.R §2.146(a)(3).

FACTS

The above referenced application was filed on August 28, 1996. In an Office Action issued on March 27, 1997, the Examining Attorney requested that Petitioner clarify the recitation of the services associated with the mark. Petitioner accordingly provided a revised recitation on October 2, 1997. However, the examining attorney determined that this recitation was unacceptable, and issued an Office Action finalizing the requirement for a new recitation on November 24, 1997. The issuance of this Office Action triggered a six month response period within which Petitioner was required to either meet the outstanding requirement for an acceptable recitation, or to appeal this requirement to the Trademark Trial and Appeal Board.

On December 12, 1997, Petitioner submitted a revised recitation. The Examining Attorney found this recitation to be unacceptable, and issued an Office Action on January 12, 1998 in which he continued the outstanding final requirement for an acceptable recitation.

On May 26, 1998, Petitioner requested reconsideration of this decision. The examining attorney issued an Office Action on August 11, 1998 continuing the final requirement for an acceptable recitation of services.

Petitioner submitted yet another revised recitation on February 11, 1999. However, on March 25, 1999, the Examining Attorney issued an Office Action that advised Petitioner that the application had abandoned, because more than six months had passed since the issuance of the final refusal on November 24, 1997.

The present petition followed.

ANALYSIS

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 Mfg. Co.*, 181 USPQ 735 (Comm'r Pats. 1974); *Ex parte Peerless Confection Co.* 142 USPQ 278 (Comm'r Pats. 1964).¹

Here, the Examining Attorney's determination that the application had been abandoned was neither erroneous nor an abuse of discretion. "Abandonment may result when the applicant's response, although received within the period for response, is incomplete or insufficient and thus not responsive to the Office action." TMEP Section 1112.02(a). At different times during the prosecution of the application, the Examining Attorney required that Petitioner revise particular wording in the recitation. The various proposed recitations submitted by Petitioner were not consistent with this requirement. Hence, an outstanding requirement was never satisfied, and the determination that the application had abandoned was therefore proper.

Petitioner notes that the proposed recitation set forth in its communication of February 11, 1999 is "virtually identical" (Petition at p.2) to a recitation suggested - - and later repudiated - - by another Examining Attorney in connection with other applications, and argues that "the inconsistent directions [Petitioner] received during the same period of time from two different Examining Attorneys handling similar issues constitutes an 'extraordinary situation' as contemplated by 37 CFR sec. 2.146." (Petition at p.3)

This argument is not persuasive. The application had abandoned by the time the recitation in question was submitted: more than six months had passed since the issuance of the final requirement. Hence, the submission of this recitation cannot provide a grounds for reviving this application, even if Petitioner's mistaken belief that the recitation was acceptable was the result of extraordinary circumstances.

Petitioner has also requested that the Commissioner extend the time within which Petitioner may appeal the Examining Attorney's decision to the Trademark Trial and Appeal Board. The Commissioner lacks the authority to grant this relief.

¹ It is also noted that the Commissioner will not review substantive decisions rendered by Examining Attorneys. See 37 C.F.R. §2.63(b).

DECISION

The Petition is DENIED, and the application will remain abandoned.

Robert M. Anderson
Acting Assistant Commissioner
for Trademarks

RMA:AL

Date:

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