

Re: Trademark Application of :
 STD Electronic International, Ltd. :
 Serial No. 75/976085 :
 Filing Date: April 11, 1994 : On Petition
 For: INTERACT :
 Petition Filed: January 23, 1998 :

STD Electronic International, Ltd. has petitioned the Commissioner to revive the above identified application. Trademark Rule 2.146(a)(3) provides authority for the requested review. The Petition is denied.

FACTS

On July 2, 1996, Petitioner filed a Request to Divide along with a Statement of Use covering those goods for which use had commenced. The goods that were in use in commerce as indicated by the Statement of Use were placed in a newly created child application. The newly created application was forwarded to the Examining Attorney for consideration of the Statement of Use.

On May 8, 1997, the Examining Attorney issued a non-final Office action with respect to the Statement of Use. Specifically, the Office action requested Petitioner to submit a copy of those specimens sent with the Statement of Use for the goods in Class 28, as the specimens had been misplaced, and advised Petitioner that Petitioner must file a change of name if Petitioner wishes the Certificate of Registration to issue in the name of the successor in interest.

Petitioner did not file a response to the outstanding Office action within the six (6) month response period following the Office action. The application abandoned. This Petition followed.

ANALYSIS

Petitioner admits that it did not respond to the outstanding Office action. Rather, Petitioner alleges that it did not need to respond to the May Office action because the requirements were unnecessary, and the mark should have been approved for registration without the information that was the subject of the May Office action. Petitioner requests that the Commissioner invoke his supervisory authority and revive the above-identified application.

Pursuant to 35 U.S.C. §6 and 37 C.F.R. §2.146(a)(3), the Commissioner may invoke supervisory authority in appropriate circumstances. However, the Commissioner will reverse the action of an

Examining Attorney only where there has been a clear error or abuse of discretion. *In re GTE Education Services*, 34 USPQ2d 1478 (Comm'r Pats. 1994); *In re Direct Access Communications (M.C.G) Inc.* 30 USPQ2D 1393 (Comm'r Pats. 1993). In this case, Petitioner has not established that the Examining Attorney clearly erred or abused her discretion in sending out the May Office action. Once the Office action was mailed, Petitioner was under an obligation to respond to the Office action.

Trademark Act Section 12, 15 U.S.C. §1062(b), provides in pertinent part:

If the applicant is found not entitled to registration, the examiner shall advise the applicant thereof and of the reason therefor. The applicant shall have a period of **six months** in which to reply or amend his application, which shall then be reexamined. This procedure may be repeated until (1) the examiner finally refuses registration of the mark or (2) the applicant fails for a period of six months to reply or amend or appeal, whereupon the application shall be deemed to have been abandoned, unless it can be shown to the satisfaction of the Commissioner that the delay in responding was unavoidable, whereupon such time may be extended (emphasis added).

Specimens Required to Approve Mark

Section 1 of the Trademark Act, 15 U.S.C. §1051, requires that along with a Statement of Use, the applicant must include “such number of specimens or facsimiles of the mark as used in commerce as may be required by the Commissioner” and other specified requirements. *See* 15 U.S.C. §1051(d)(1). Specimens provide part of the basis for examination because they show the manner in which the mark is seen by the public, including matter that appears in association with the mark in trade; specimens also provide supporting evidence of facts recited in the application. They are necessary for an Examining Attorney to be able to approve a mark for registration. *See generally* 15 U.S.C. §1051(d)(1).

Thus, while the application may have originally contained the specimens for Class 28, an Examining Attorney is unable to approve the mark for registration without a copy of the specimens in the application file. The Examining Attorney must be able to examine the specimens to determine whether the specimens show use of the mark on or in connection with the goods in commerce.

The Office appreciates that the loss of the specimens may pose an inconvenience for the Petitioner. However, the Office cannot merely approve the mark for registration without reviewing the specimens. The requirement that specimens be part of the application file for an application based on use in commerce is a statutory requirement. 15 U.S.C. §1051. Thus, the Examining Attorney did not err in requesting Petitioner to submit a copy of the specimens originally submitted with the Statement of Use.

Change of Name

With respect to the information regarding the name change of Petitioner, the statement made by the Examining Attorney is accurate. The Examining Attorney did not err in providing this advice to Petitioner. An Examining Attorney is responsible for being complete in her actions and apprising the applicant of all relevant matters. TMEP Section 1106.01. However, the statement was advisory and Petitioner did not need to file a change of name with the Office before the application could be approved for registration.

However, in view of the outstanding requirement that Petitioner submit copies of the specimens originally filed with respect to the Class 28 goods in order to enable the Examining Attorney to examine the application file, Petitioner was under an obligation to respond to the May Office action within the six month response period. 15 U.S.C. §1062(b). As this requirement to file a response to an outstanding Office action is statutory, the Commissioner has no authority to waive this requirement of the statute. Trademark Rules 2.146(a)(5) and 2.148.

DECISION

The Petition is denied. The application will remain abandoned.

Philip G. Hampton, II
Assistant Commissioner
for Trademarks

PGH:NLO:DDS

Date:

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