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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

99-156

Re: Trademark Application of :
White Bros. Cycle Specialists, Inc. :
Application Serial No. 75/977495 : On Petition
For: WHITE BROTHERS :
Petition Filed: October 19, 1998 :

White Bros. Cycle Specialists, Inc. (“Petitioner”) has petitioned the Commissioner to review the decision of the Examining Attorney to abandon the above-referenced application and to revive the application. The petition is granted in part and denied in part under 37 C.F.R. §2.146(a)(3).

FACTS

The above-referenced multiple-class application was filed on August 21, 1996. The Examining Attorney issued the first Office Action on February 8, 1998. In this Office Action, the Examining Attorney refused registration under 15 U.S.C. §1052(d) on the basis that the mark when used in connection with the goods identified in the application, was likely to be confused with the mark in Registration No. 1,086,696. It was also indicated in the Office Action that “the [s]tated refusal refers to Class 12 only and does not bar registration in the other classes.” The Examining Attorney also made requirements for proper clarification and classification of the identified goods and for a disclaimer. Petitioner filed a response to the Office Action on August 12, 1997.

The Examining Attorney issued a second Office Action on October 30, 1997 wherein the statutory refusal under 15 U.S.C. §1052(d) and requirement to clarify and classify properly the identified goods were made final.¹ On April 30, 1998, Petitioner filed a request for reconsideration of the final refusal (“Request for Reconsideration”) and a request to divide the application (“Request to Divide”).

In the Request to Divide, Petitioner requested that particular goods listed in International Class 12 be divided out of the application, while the remainder of the goods be permitted to proceed in a separate application. The Request to Divide stated: “[t]he goods to be divided out are as

¹ The identification of goods was deemed acceptable for the goods identified in International Classes 16 and 25. The remaining goods were classified in International Classes 7 and 12 or considered indefinite. The disclaimer requirement was withdrawn.

follows: --Watercraft parts and accessories, namely, hull rubber molding, handlebars, handlebar ends and handlebar grips; motorcycle ATV parts and accessories, namely, inverted forks, handlebars, fenders, mud flap extensions, brake savers, wheels, hubcaps, spokes and rims in Class 12.” The application containing these goods in International Class 12 remained under the original application serial number 75/153969 while all other goods proceeded with the above-referenced application serial number (“the above-referenced child application”).

It is also noted that on April 30, 1998, Petitioner also filed a Notice of Appeal in connection with the original application serial number 75/153969. In the Notice of Appeal, Petitioner stated that “Applicant...hereby appeals to the Trademark Trial and Appeal Board for the Class 12 goods identified in the above-identified application from the continuing final refusal dated October 30, 1997.”

On August 17, 1998, the Examining Attorney issued an Office Action continuing the final refusal under 15 U.S.C. §1052(d) and final requirement to clarify the identification of goods. The above-referenced child application was abandoned in turn because a Notice of Appeal had not been filed in connection with this application. This petition followed.

It is noted that when the Examining Attorney abandoned the above-referenced application, the Office records indicated that a renewal application under 15 U.S.C. §1059 had been filed in connection with the cited registration.

Petitioner’s Arguments

Petitioner asserts that the above-referenced application was abandoned in error because Petitioner did not believe that the refusal under 15 U.S.C. §1052(d) applied to the above-referenced child application. Specifically, Petitioner noted that the Examining Attorney articulated in the first Office Action that “[t]he stated refusal refers to Class 12 only and does not bar registration in the other classes.”

Petitioner also asserts that the letter dated June 12, 1998 from the ITU/Divisional Unit stated that “[t]he goods in International Class 12, for which there is a 2(d) refusal, remain in the original (parent serial number 75/153969) application.” Petitioner believes that this letter is further evidence that the 2(d) refusal was limited to the parent application, and not the above-referenced child application.

ANALYSIS

The Examining Attorney did not err in determining in her discretion that the above-referenced application was in condition for abandonment.

37 C.F.R. §2.64(b) states in connection with final actions:

...The filing of a request for reconsideration will not extend the time for filing an appeal or petitioning the Commissioner, but normally the examiner will reply to a request for reconsideration before the end of the six-month period if the request is filed within three

months after the date of the final action. Amendments accompanying requests for reconsideration after final action will be entered if they comply with the rules of practice in trademark cases and the Act of 1946.

TMEP section 1005.04(f) states, in pertinent part:

If, upon the examining attorney's consideration of a request for reconsideration, all refusals and requirements are not withdrawn, and the period for proper response to the final action has passed, the application will be deemed abandoned. Thus, if time is short and the applicant is filing a request for reconsideration, or has filed a request which has not yet been acted on, the applicant may preserve its right to appeal by also filing a notice of appeal (including the fee) prior to expiration of the response period...

At issue throughout the prosecution of the referenced application was the identification of goods, particularly those goods listed *by Petitioner* in International Class 7 in the above-referenced child application. The requirement to clarify and classify the goods properly was made final and continued in connection with the above-referenced child application, not having been resolved to the satisfaction of the Examining Attorney. Therefore, goods in International Class 12 remained in the above-referenced application even after the division.

It is noted that in Petitioner's response to the first Office Action, Petitioner merely changed the classification of its goods, previously identified in International Class 12, as falling in International Class 7. Petitioner stated that these goods were parts of engines and for this reason, were appropriately identified in International Class 7. However, Petitioner had been informed in the Examining Attorney's first Office Action that *generally*, parts of vehicle engines were classified in International Class 7 and given other detailed guidelines concerning the proper identification and classification of Petitioner's goods. In the Examining Attorney's final Office Action, Petitioner was specifically informed that "[t]he present identification of goods in Class 7 contains many goods which clearly are classified in Class 12 and in other classes..."

Petitioner presumed incorrectly that by retaining particular goods in International Class 12 in the parent application that the refusal under 15 U.S.C. §1052(d) did not apply to the goods identified in the above-referenced child application. Therefore, the Examining Attorney did not err in determining in her discretion that the above-referenced child application was ripe for abandonment in the absence of a Notice of Appeal for this application.

It is noted that while the letter from the Paralegal Specialist in the ITU/Divisional Unit confirming completion of the divisional, did not indicate that the statutory refusal remained outstanding for the above-referenced child application, the records of both applications indicated that the goods in International Class 12 remained in the child application. Hence, the statutory refusal was applicable to the above-referenced child application.

Petitioner is entitled to limited relief on petition.

The Trademark Act gives applicants a right to appeal after a *final* action by an examining attorney. 15 U.S.C. §1070. Appeal must be taken within six months from the date of final

refusal or from the date of the action from which appeal is taken. 37 C.F.R. §2.146(a). In this case, where no Notice of Appeal has been filed within the statutory six month period, the Examining Attorney acted properly in abandoning the application. However, Petitioner is entitled to limited relief on petition.

Pursuant to 35 U.S.C. §6 and 37 C.F.R. §2.146(a)(3), the Commissioner may exercise supervisory authority on petition. Because the goods identified in International Classes 16 and 25 were determined to be properly identified and classified and not subject to the statutory refusal under 15 U.S.C. §1052(d), the application will be revived with respect to those classes. *See In re Worldstyle Inc.*, 49 USPQ2d 1959 (Comm'r Pats. 1998).

DECISION

The petition is granted in part to the extent that the application will be revived with respect to the goods identified in International Classes 16 and 25. The petition is denied in part to the extent that all other goods identified generally in International Classes 7 and 12, by Petitioner, will remain abandoned for the reasons stated above. The application will be revived and forwarded to the Examining Attorney for approval for publication in the *Official Gazette* with respect to the goods identified in International Classes 16 and 25 only.

Robert M. Anderson
Acting Assistant Commissioner
for Trademarks

Date:

RMA:SLC

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