Mailed:
March 11, 2005

This Opinion is Not Citable as Precedent of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re BrainLAB AG

Serial Nos. 78102333 and 781023364

On Request for Reconsideration

Don W. Bulson of Renner, Otto, Boisselle & Sklar, LLP for BrainLAB AG.

Marc J. Leipzig, Trademark Examining Attorney, Law Office 115 (Tomas V. Vlcek, Managing Attorney).

Before Seeherman, Bottorff and Rogers, Administrative Trademark Judges.

Rogers, Administrative Trademark Judge:

The Board's decision in this appeal focused solely on whether the examining attorney properly refused to allow applicant's marks to be registered when applicant had refused to amend a particular phrase in the identification of goods, in one class, in each of the applications. We held that the refusal was proper and that, in the absence

of an appeal of our decision, the Board would delete the vague and overbroad phrase and allow the marks to be otherwise registered.

Applicant now seeks reconsideration on the ground that after it filed its reply brief, it had agreed with the examining attorney on an appropriate amendment to the phrase in dispute and submitted the amendment by e-mail to the examining attorney. Neither the applicant nor the examining attorney requested suspension of the appeal and remand to allow the amendment to be entered, which would have rendered the appeal moot.

Notwithstanding the absence of a timely request for remand, it is clear that there was no need for the Board to issue the final decision. We set aside the decision and remand the application for the examining attorney to enter the various amendments that were agreed upon at various times during the pendency of these appeals. After the examining attorney has entered all such amendments, so as to render the final refusal moot, he should inform the Board, so that we may dismiss these appeals.