FOR PUBLICATION IN FULL

Commissioner of Patents and Trademarks

Patent and Trademark Office (P.T.O.)
MATT GROENING
vs.
MISSOURI BOTANICAL GARDEN
Opposition No. 114,370
December 29, 2000
Filed: July 20, 1999

Attorney for Petitioner:

Daniel A. Crowe, Esq.

Bryan Cave LLP

One Metropolitan Square

211 N. Broadway, Suite 3600

St. Louis, Missouri 63102-2750

Attorney for Opposer:

Nicole Nehama Auerbach, Esq.

Katten Muchin & Zavis

525 West Monroe Street

Chicago, Illinois 60661-3693

Decision

***1** Missouri Botanical Garden, the applicant in the above referenced opposition proceeding, has petitioned the Commissioner, now the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (hereinafter, "the Director") to (1) dismiss the opposition proceeding, (2) withdraw an amendment to the record of the application that had been made by the Examining Attorney and (3) issue a Notice of Allowance with respect to the application. The petition is denied pursuant to 37 C.F.R. § 2.146(a).

FACTS

The application that is the subject of the above referenced opposition proceeding was initially published for opposition in the

Official Gazette on November 24, 1998. The various goods and services recited in the application were classified in International Classes 9, 35, 37, and 42. However, the Office subsequently determined that the services that had been classified in International Class 37 should have been classified in International Class 42. The Notice of Allowance was cancelled, and the Examining Attorney was directed to amend the application to reclassify the services.

Thereafter, the Examining Attorney issued an Examiner's Amendment that classified the service previously believed to have been a class 37 service in International Class 42.

Petitioner contends that the Examining Attorney entered this amendment without Petitioner's approval, and the record appears to support that contention: although the body of the Examiner's Amendment includes a statement that the amendment was made "[i]n accordance with the authorization granted by the above Applicant or attorney," no name appears in the space designated for identifying that applicant or attorney. Instead, that space bears a reference to TMEP § 1111.02, the section of the TMEP that provides that under certain circumstances, an Examining Attorney may amend the classification of goods or services without first obtaining the applicant's approval.

A mark that is reclassified after it has been published must be republished. See TMEP § 1505.01(b). The Office accordingly republished the mark in the Official Gazette on April 27, 1999. The various goods and services were now classified in International Classes 9, 35 and 42. The second publication was followed by the filing of a Request for Extension of Time to Oppose at the Trademark Trial and Appeal Board (hereinafter, "the Board") on December 23, 1999, and eventually, by the filing of the above referenced opposition proceeding, on July 3, 1999.

The present petition followed.

ANALYSIS

Failure to Issue a Notice of Allowance

Petitioner urges that the Office erred by declining to issue a Notice of Allowance after the mark was first published. Petitioner notes that 15 U.S.C. § 1063(b)(2) provides that "a notice of allowance shall be issued to the applicant" if a registration is not successfully opposed. Petitioner reasons that since no opposition was filed after the mark was published on November 24, 1998, the Office was required to issue a Notice of Allowance.

***2** Yet the requirement that the Office issue a Notice of Allowance after publication presupposes that the publication was proper. Where the mark was published with errors, the publication may be void, and a Notice of Allowance cannot be issued. Instead, the errors must be corrected, and the mark republished.

Here, regretfully, the classification of services set forth when the mark was published for opposition on November 24, 1998 was erroneous.

The service of "technical advisory and consulting services related to the adaptation and use of computer software and hardware, namely, software and hardware for reading magnetic cards, encoded cards and cards with embedded computer chips" was classified in International Class 37, but should have been classified in International Class 42. Although the adoption and use of computer hardware and software may be considered an installation or maintenance service that would be classified in International Class 37, consultation services that pertain to installation services are classified in International Class 42. The publication of November 24, 1998 was thus improper, and should not have been followed by the issuance of a Notice of Allowance.

Petitioner suggests that republication was unnecessary, since any party monitoring applications published in the Official Gazette that recited services classified in International Classes 9, 35 and 42 -- the classifications assigned to the mark when it was republished -- would have encountered Petitioner's mark, and would therefore have reviewed all the services associated with Petitioner's mark when the mark was originally published.

This reasoning assumes that parties who come across marks published in the Official Gazette that recite goods and services classified in multiple International Classes will necessarily scrutinize the recitations associated with each of the classes. Yet some parties may choose to limit their search to include only particular classes. Here, some parties who reviewed the Official Gazette of November 24, 1998 may have chosen not to read any of the recitations of services in International Class 37. Had Petitioner's mark not been republished, such parties would have had no notice that Petitioner's services include "technical advisory and consulting services related to the adaptation and use of computer software and hardware, namely, software and hardware for reading magnetic cards, encoded cards and cards with embedded computer chips."

In further support of its contention that republication was unnecessary, Petitioner notes that the Office allowed the services in question to be classified in International Class 37 in a companion application filed by Petitioner (Application Serial No. 75/340688). Petitioner suggests that this classification was therefore proper here as well. However, if the Office erred in allowing the other application to be published, it would be illogical and inappropriate to repeat that error. Consistency must be secondary to correctness of Office practice. See In re Stenogrraphic Machines, Inc. 199 USPQ 313, 317 (Comm'r Pats. 1978).

Petitioner's Request that the Commissioner Withdraw the Amendment Made by the Examining Attorney

***3** Petitioner argues that the Examining Attorney lacked jurisdiction to reclassify the services.

An Examining Attorney may amend the international classification of services recited in an application without the applicant's approval. TMEP § 1111.02(1). However, current practice provides that permission must nevertheless be obtained "where the change is made after

publication and thus would require republication of the mark." Id. If a mark must be reclassified after it has been published, an Examining Attorney must either (1) amend the classification with the applicant's consent, or (2) if such consent cannot be obtained, request that the Commissioner for Trademarks restore jurisdiction and issue an Office Action requiring the applicant to authorize the reclassification.

The Director hereby announces a change to that policy. Henceforth, an Examining Attorney may reclassify the goods or services recited in an application without either (1) the applicant's approval or (2) a restoration of jurisdiction [FN1], even if the application has already been published for opposition. In all such cases, the Examining Attorney must advise the applicant that the goods or services have been reclassified by issuing an Examiner's Amendment [FN2]. Following this notification, the mark will be published for opposition in the Official Gazette.

The Trademark Manual of Examining Procedure will be amended to reflect this change in policy.

This change will not prejudice an applicant's rights. Classification is within the sole discretion of the Office. In re Tee-Pak, Inc., 164 USPQ 88 (TTAB 1969). Hence, under current practice, any amendment to classification sought by an Examining Attorney will ultimately be made, even if the applicant's approval is solicited but not obtained. An objection to an amendment to classification may postpone -- but will never prevent -- the republication of a mark.

In view of the change in policy regarding the requirement that an applicant's approval must be sought before republication, the Director declines to grant Petitioner's request to withdraw the amendment made by the Examining Attorney.

Dismissal of the Opposition

Petitioner asks the Director dismiss the opposition proceeding. This request is based on the claim that the amendment to the classification and the second publication of the mark were invalid, and that a Notice of Allowance should have issued after the first publication. However, for the reasons discussed above, the second publication was valid, and the amendment to the application was proper. Hence, no grounds exist for dismissing the opposition.

DECISION

The petition is denied. The file will be returned to the Board for continuation of the opposition proceedings.

Lynne G. Beresford

Deputy Commissioner for Trademark Policy

FN1. Under 37 C.F.R. § 2.84(a), an examining attorney may exercise jurisdiction over an application after publication with the permission of the Commissioner. In this case, the examining attorney did not request that the Commissioner restore jurisdiction before entering the examiner's amendment. However, as a result of the policy change just described, 37 C.F.R. § 2.84 does not bar the examining attorney from amending the classification of goods and services after publication.

FN2. An applicant who believes that the amendment to the classification was erroneous may petition the Commissioner to review the amendment.

59 U.S.P.Q.2d 1601

END OF DOCUMENT