Commissioner of Patents and Trademarks
Patent and Trademark Office (P.T.O.)

RE: TRADEMARK APPLICATION OF M.V ET ASSOCIES
Serial No. 73-813,814
August 8, 1991
***1** Petition Filed: June 19, 1990

For: FORMES ET COULEURS and design
Filed: July 21, 1989

Attorney for Petitioner

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On Petition

M.V Et Associes has petitioned the Commissioner for review of the Examining Attorney's refusal to accept certain proffered amendments to the identification of goods for the above referenced application. Review of the petition is undertaken pursuant to Trademark Rules 2.146 and 2.148, 37 C.F.R. § § 2.146 and 2.148.

FACTS

When petitioner's application was first filed, the identification of goods read: "Clothing and underclothing for men, women and children; belts, shawls, scarves, ties, foulards, gloves, footwear, headgear."

Upon review of the application, the Examining Attorney found the identification to be indefinite. Changes to the identification were suggested in the initial Office action which issued October 4, 1989. Petitioner responded to the action on April 4, 1990 and requested amendment of the identification to read: "Clothing, namely pants, shirts, sweaters, jackets, underwear, belts, shawls, scarves, ties, foulards, gloves, footwear, headgear." The application file reveals the requested amendment to the identification was entered into the Office's Trademark Reporting and Monitoring (TRAM) system on April 13, 1990.

Further procedural facts established by the application file or through reference to TRAM records reveal: that the Review and Amendment Clerk reviewed the file for publication on April 23, 1990; a telephone interview was held between the Examining Attorney and counsel for petitioner on April 24, 1990; allowance of the application was withdrawn on May 4, 1990. The Examiner's Amendment resulting from the

telephone interview of April 24 was mailed on May 5, 1990. [FN1] This amendment was entered in the TRAM system on May 7, 1990 and resulted in the identification being amended to read: "Clothing, namely pants, shirts, T-Shirts, tunics, sweaters, pullovers, sweater vests, jackets, underwear, belts, shawls, scarves, ties, foulards, gloves, footwear and headwear." [Underscoring indicates changes effected by Examiner's Amendment as compared to operative identification following entry of the express amendment of April 4.]

The mark was approved for publication on May 9, 1990 and was eventually scheduled for publication in the Official Gazette of August 7, 1990. The instant petition was filed on June 19, 1990, but was not immediately identified as a petition to the Commissioner. Thus, the application file was retrieved from the Publication and Issue Section, and the petition was mistakenly processed as a request for amendment of the identification. As a result the TRAM system was changed on July 24, 1990 so that the identification reverted to its form following the entry of petitioner's express amendment of April 4, 1990. [FN2]

DECISION

***2** The only issue raised by the instant petition involves petitioner's latitude to effect further amendments to the identification of goods. There is no dispute that the express amendment of April 4, 1990 acted to clarify and limit the identification of goods. Subsequent to the filing of that amendment, however, counsel for petitioner attempted, by phone, to further amend the identification to list eight specific items of clothing. It is the Examining Attorney's refusal to accept all of the requested amendments which petitioner seeks to have reviewed.

The provision of the Trademark Rules which applies in this case is subsection (b) of Rule 2.71, 37 C.F.R. § 2.71, which states: "The identification of goods or services [in an application] may be amended to clarify or limit the identification, but additions will not be permitted."

The effect of this rule was discussed in "Examination Guide 3-89: Implementation of the Trademark Law Revision Act of 1988 and the Amended Rules of Practice in Trademark Cases," which was published as a supplement to the TMEP and reprinted in the Official Gazette on November 21, 1989, 1108 TMOG 30. Exam Guide 3-89 explained the rationale behind Rule 2.71(b) by noting the "constructive use" and "nationwide priority" provisions of Trademark Act Section 7(c), 15 U.S.C. § 1057(c), and noting that the identification of goods or services in an application "defines the scope of those rights." Thus, Rule 2.71(b) precludes all amendments to an identification of goods which would impermissibly enlarge the scope of those rights after filing of the application.

Exam Guide 3-89, at pages 48-50, sets forth the following principles for handling amendments, which apply to the case at hand. First, amendments which substitute more specific language in place of more general language so as to limit the goods as to certain types within a more general category are clearly acceptable. Second, if a proffered

amendment seeks to insert an item which is "logically encompassed by an item already included in the identification," then the amendment can be accepted. However, the guide cautions: "The scope of the goods and services, as originally identified or as amended by an express amendment, establishes the outer limit for any later amendments." (emphasis added)

In the case at hand, petitioner filed an express amendment which clarified its original identification to remove indefiniteness and which acted to limit more general language by substituting specific types of goods. Once this amendment was filed, it established the outer limit for later amendments. Thus, when petitioner's counsel attempted, by phone, to further amend the identification of goods by specifically listing "T-shirts, tunics, pullovers, vests, coats, bermuda shorts, skirts, and dresses," the Examining Attorney was required to assess the propriety of the requested amendments in light of Rule 2.71(b) and through comparison with the identification as it stood following entry of the express amendment of April 4.

***3** The Examiner allowed the identification to be amended through the listing of "T-shirts" and "tunics." These items were permissibly included in the identification because they constitute items "logically encompassed" within the category of "shirts," an item which was already within the operative identification. In addition, "pullovers" and "sweater vests" (rather than "vests") were permissibly listed as items "logically encompassed" within the category of "sweaters," also an item within the operative identification. "Coats, bermuda shorts, skirts and dresses" were not "logically encompassed" within the scope of any items set forth in the identification as changed by the express amendment of April 4. Therefore, the examiner acted properly when she refused to allow telephone amendment of the identification to list these items.

Petitioner's counsel asserts that the Examining Attorney had not even "acted on" the express amendment of April 4, despite its filing, when counsel sought, at petitioner's behest, to introduce the referenced eight items into the identification. The file indicates otherwise. The Review and Amendment clerk completed a pre-publication review of the application file on April 23. Such a review would not have been undertaken unless the file, with the amendment of April 4, had already been reviewed by the Examining Attorney and approved for publication. In any event, it is irrelevant whether the examiner had considered the amendment prior to the telephone interview of April 24, when the interview was conducted which led to the Examiner's Amendment of May 5.

The changes requested by petitioner's express amendment of April 4 had been entered into the Office's computer systems as of April 13 and remained there until further changes were effected in the TRAM system on May 7, in accordance with the Examiner's Amendment mailed on May 5. Thus, for more than three weeks, third parties checking the status of petitioner's application in the Office's computer systems would have been put on notice that petitioner's formerly indefinite identification had been significantly restricted.

Petitioner acknowledges the purpose underlying Rule 2.71(b) but argues that the language precluding additions "is clearly meant to preclude additions to the description of goods outside the scope of goods as first set forth in the application." Further, petitioner

asserts that the determination as to whether an amendment acts to clarify or limit an identification must be determined through a comparison with the identification as filed, rather than as it may have been amended. Office policy, as set forth in Exam Guide 3-89, rejects this approach.

Trademark Rule 2.146(a)(3), 37 C.F.R. § 2.146(a)(3), permits the Commissioner to invoke his supervisory authority in appropriate circumstances. However, the Commissioner will reverse the action of an Examining Attorney in a case such as this only where there has been a clear error or abuse of discretion. In re Richards-Wilcox Manufacturing Co., 181 USPQ 735 (Comm'r Pats.1974); Ex parte Peerless Confection Co., 142 USPQ 278 (Comm'r Pats.1964). No such error has been demonstrated in this case; the examiner has properly applied Rule 2.71(b).

***4** Trademark Rules 2.146(a)(5) and 2.148, 37 C.F.R. § § 2.146(a)(3) and 2.148, permit the Commissioner to waive any provision of the Rules which is not a provision of the statute, where an extraordinary situation exists, justice requires and no other party is injured thereby. All three conditions must be satisfied before a waiver is granted. In this case, the provision of Rule 2.71 which acts to bar the amendments petitioner seeks to enter is not statutory in nature. However, its application will not be waived. Office policy regarding the interpretation of the rule is clear and petitioner has not established that an extraordinary situation exists which warrants waiver of the rule.

CONCLUSION

The examiner's handling of petitioner's various amendment requests has been completely in keeping with the guidelines set forth in Exam Guide 3-89 and all extant Office policies governing application of Rule 2.71(b). Accordingly, the petition is denied. The application file will be returned to the Examining Attorney so that the changes effected by the Examiner's Amendment of May 5 can be re-entered into the TRAM system and the file can once again be reviewed for possible publication.

FN1. It is noted that the changes effected in the identification of goods via the Examiner's Amendment mailed on May 5, 1990 were the product of a telephone interview between the Examining Attorney and an attorney apparently acting on behalf of the petitioner but who had never been appointed as an attorney by petitioner. However, since the Examiner's Amendment has been acknowledged by appointed counsel in the instant petition, the changes effected by the amendment are deemed to have been ratified by appointed counsel.

FN2. Though the mistaken processing of the petition as a request to amend the identification of goods has "undone" the changes effected by the Examiner's Amendment, this error will be corrected.

21 U.S.P.Q.2d 1628

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