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

RE: TRADEMARK APPLICATIONS OF ST. MARY'S HEALTH CARE SYSTEM, INC.
96-33; 96-43; 96-48
June 18, 1996
***1** Petitions Filed: November 27, 1995

For: ST. MARY'S HEALTH CARE SYSTEM, INC. and design
Serial No. 74/469408
Filing Date: December 14, 1993

For: ST. MARY'S HEALTH CARE SYSTEM, INC. and design
Serial No. 74/476654 [FN1]
Filing Date: January 5, 1994

For: Miscellaneous Design
Serial No. 74/476644
Filing Date: January 5, 1994

Attorney for Petitioner:

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Philip G. Hampton, II

Assistant Commissioner for Trademarks

On Petition

St. Mary's Health Care System, Inc. has petitioned the Commissioner to restore jurisdiction of the above-referenced applications to the Examining Attorney. [FN2]

FACTS

The above-referenced applications were filed under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), based on the Petitioner's bonafide intention to use the marks in commerce. On June 8, 1994, Amendments to Allege Use were filed alleging March 17, 1994, as the date of first use and first use in commerce of the marks in connection with all the services listed in the applications. On June 21, 1994, the Examining Attorney accepted the Amendments to Allege Use and approved the applications for publication. After publication in the Office Gazette, but prior to registration, the Petitioner discovered that the dates of

first use and first use in commerce alleged in its Amendments to Allege Use were partially incorrect. Consequently, as an amendment after publication. The Petitioner requests that the above-referenced applications be divided and that the Amendments to Allege Use be withdrawn in each application. [FN3]

DECISION

An Examining Attorney no longer has jurisdiction over an application filed under Section 1(a) or Section 44 of the Trademark Act after the date the mark is published for opposition in the Official Gazette. After publication, the Examining Attorney may not take further action which may constitute a refusal or a requirement without the permission of the Commissioner. Trademark Rule 2.84(a), 37 C.F.R. § 2.84(a); TMEP § 1504.01.

With respect to the services in connection with which the Petitioner has not in fact made use of the mark, the Examining Attorney cannot approve the Petitioner's amendments after publication without republishing the marks. Consequently, a petition requesting that jurisdiction be restored to the Examining Attorney is required. Trademark Rule 2.84(b), 37 C.F.R § 2.84(b).

Trademark Rule 2.84(a), 37 C.F.R. § 2.84(a) provides, in part:

> After publication of an application under Section 1(a) or 44 of the Act the examiner may, with the permission of the Commissioner, exercise jurisdiction over the application.

***2** The petitions are granted. Accordingly, jurisdiction is restored to the Examining Attorney for consideration of the amendments after publication including the requests to withdraw the Amendments to Allege Use. With respect to the services in connection with which the Petitioner has not in fact made use, the above-referenced applications, after processing the requests to divide, will be republished in due course to provide notice of the Petitioner's amendments after publication.

FN1. This Application Serial Number registered inadvertently and will be canceled as an inadvertently issued registration restored to pendency and then forwarded to the Examining Attorney.

FN2. The Petitions are styled "Petition to the Commissioner of Patents and Trademarks under Trademark Rules 2.146(a)(5) and 2.148 to Waive the Timing Provisions of Trademark Rules 2.76(h) and 2.87(c) to Permit the Filing of a Divisional Service Application." However, because the Petitioner seeks to amend the above-reference applications after publication, these Petitions are decided under Trademark Rule 2.84(a) as petitions to the Commissioner requesting that jurisdiction be restored to the Examining Attorney.

FN3. Requests to Divide application and Request to Withdraw Amendment to Allege Use together with the divisional fees, were filed subsequent

to the filing of these petitions.

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