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

RE: TRADEMARK APPLICATION OF AMERICAN PSYCHOLOGICAL ASSOCIATION
95-511
May 15, 1996
***1** Petition Filed: July 10, 1995

For: PSYCHOLOGICAL METHODS
Serial No. 74/464,795
Filing Date: December 2, 1993

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On Petition

American Psychological Association has petitioned the Commissioner to suspend the above identified application pending the submission of an Amendment to Allege Use, or, in the alternative, to "postpone" the Examining Attorney's final refusal to register the subject mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), until specimens have been submitted. Trademark Rules 2.146(a)(3) and 2.146(a)(4), 37 C.F.R. § § 2.146(a)(3) and 2.1 46(a)(4), provide authority for consideration of the petition. [FN1] The petition is denied.

FACTS

Petitioner filed this application on December 2, 1993, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon the Applicant's bona fide intention to use the mark in commerce. The application seeks registration of the mark PSYCHOLOGICAL METHODS for a "printed journal pertaining to the psychological and social sciences." On May 10, 1994, the Examining Attorney issued an Office Action refusing registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that the proposed mark was merely descriptive of the subject matter of the Applicant's publication. The refusal was supported with evidence obtained from the Lexis/Nexis database. On November 10, 1994, Petitioner filed a response traversing

the refusal. On January 9, 1995, the Examining Attorney issued a second Office Action in which the refusal of registration was made final, and additional Lexis/Nexis evidence was made of record.

On January 24, 1995, Petitioner filed a request for reconsideration, [FN2] arguing that the final refusal had been made "without facts of record pertaining to the contents of the publication in question;" and that the refusal "should be made or adhered to only in view of the publication itself-- such issues being proper for 'second examination' following the submission of the Statement of Use." Alternatively, Petitioner requested that the case be suspended "pending the ability of the applicant to make the publication in question of record by way of Amendment to Allege Use prior to Publication--thus enabling the Examining Attorney to consider the propriety of the refusal in view of the Publication itself." In an Office Action dated March 24, 1995, the Examining Attorney adhered to the final refusal of registration, and denied the request for suspension of the application.

***2** This petition followed. Petitioner asserts that the descriptiveness of a publication title that does not name a target industry or group must be reviewed in connection with the contents of the publication; thus, the issue of descriptiveness should be "postponed" until second examination. Alternatively, Petitioner asserts that it has shown good cause for suspension of the application under Trademark Rule 2.67, 37 C.F.R. § 2.67.

STANDARD OF REVIEW

The Commissioner will reverse the action of an Examining Attorney only where there has been a clear error or abuse of discretion. In re GTE Education Services, 34 USPQ2d 1478 (Comm'r Pats.1994); In re Direct Access Communications (M.C.G.) Inc., 30 USPQ2d 1393 (Comm'r Pats.1993); In re Stenographic Machines, Inc., 199 USPQ 313 (Comm'r Pats.1978). In this case, Petitioner has not established that the Examining Attorney clearly erred or abused his discretion.

SECTION 2(e)(1) REFUSAL

The Trademark Manual of Examining Procedure (TMEP) clearly and explicitly requires that "to the fullest extent possible," an Examining Attorney examine an "intent-to-use" application for registrability under § 2(e)(1) "according to the same procedures and standards which apply to any other application." TMEP § § 1105.01(a)(iv) and 1209.02. Furthermore, the Examining Attorney must develop evidence of descriptiveness during initial examination. TMEP § 1105.01(a)(iv). In fact, Office policy precludes the issuance of a Section 2(e)(1) refusal during second examination if the refusal could or should have been treated in initial examination, unless the failure to issue the refusal constitutes a clear error. TMEP § § 1 105.01(a)(iv) and 11 05.05(f)(ii).

Petitioner relies upon Eastman Kodak Co. v. Bell & Howell Document Management Products Co., 23 USPQ2d 1878 (TTAB 1992), aff'd 994 F.2d

1569, 26 USPQ2d 1912 (Fed.Cir.1993). In that case, an opposition to an intent-to-use application was brought on the grounds that the Applicant intended to use the proposed mark as a model designation, and that model designations were, per se, descriptive and unregistrable. The Board found that numerical model designations were not, per se, merely descriptive; that a numerical designation might function as both a model designation and a trademark; that the determination of descriptiveness depended on how the designation was used on the goods in commerce; that, because Applicant had not yet begun to use its mark in commerce, Opposer could not prove that the mark had been used and was perceived by purchasers merely as a model designation; and that, therefore, Applicant was entitled to judgment on the issue of descriptiveness in the opposition proceeding. The opposition was dismissed, without prejudice.

***3** Cases like Eastman Kodak, in which it is the manner in which a designation is used that renders it descriptive, are relatively rare. The Board has stated that "Eastman Kodak does not, and was not intended to, place any limits on the Board's jurisdiction to decide, in the context of an ex parse appeal or opposition, issues of descriptiveness or misdescriptiveness where an intent-to-use application is involved." In re Berman Bros. Harlem Furniture Inc., 26 USPQ2d 1514, 1516 (TTAB 1993). As the Court of Appeals noted in affirming Eastman Kodak, the legislative history of the Trademark Law Revision Act of 1988 (TLRA), Pub.L. 100-667, 102 Stat. 3935, amending 15 U.S.C. § 1051 et seq. (1988), demonstrates that Congress intended most intent-to-use applications to be reviewed for descriptiveness in the initial examination/pre- use stage of the application process. Senate Report No. 100-515 states:

Patent and Trademark Office procedures for examining applications based on intent-to-use must parallel, to the greatest extent possible, existing procedures and practice for examining applications based on use. This will reduce the likelihood of inconsistency and should result in greater economy and efficiency. Although the absence of specimens will prevent the Office from determining whether an intent-to-use application covers subject matter not constituting a trademark, whether the mark is being used as a mark and whether the mark, as used, differs materially from the drawing of the mark, the absence of specimens at the time the application is filed will not affect examination on numerous fundamental issues of registrability (that is, descriptiveness, geographic or surname significance, or confusing similarity). If it appears from this examination that the mark is entitled to registration subject to its being used in commerce, the mark will be published for opposition. Subjecting an intent-to-use application to the opposition process before the applicant makes use of its mark is essential if the system is to achieve its goal of reducing uncertainty before the applicant invests in commercial use of the mark....

The Patent and Trademark Office's examination of the statement of use will be only for the purpose of determining issues that could not have been fully considered during the initial examination of the application, that is, whether the person filing the statement of use is the applicant, whether the mark as used corresponds to the drawing submitted with the application, whether the goods or services were identified in the application and not subsequently deleted, and whether the mark, as displayed in the specimens or facsimiles, functions as a mark....

Senate Judiciary Committee Rep. on S. 1883, S.Rep. No. 515, 100th Cong., 2d Sess. (1988), reprinted in United States Trademark Association, The Trademark Law Revision Act of 1988 184, 186 (1989) (emphasis added).

***4** Petitioner's suggestion that a determination of "the descriptiveness ... of a publication title that does not name a target industry or group must necessarily be postponed until second examination" is not deemed persuasive. For purposes of determining descriptiveness, marks which comprise titles of publications are evaluated using the same standards and criteria as any other marks. An applicant who seeks registration of a mark used or intended to be used on a publication, must specify both the specific physical nature and the literary subject matter of the publication. TMEP § 804.03(c). In determining descriptiveness, the Examining Attorney considers themeaning of the mark that appears on the drawing, in relation to the goods identified in the application. The Trademark Trial and Appeal Board has held that "the question of registrability must be determined, in proceedings before the Board, on the basis of the goods or services as set forth in the application, rather than in reference to the precise nature of the goods or services on or in connection with which the mark is actually used or intended to be used (emphasis added)." In re Vehicle Information Network Inc., 32 USPQ2d 1542, 1544 (TTAB 1994).

In this case, the mark consists of the words PSYCHOLOGICAL METHODS, and the goods are identified as a "printed journal pertaining to the psychological and social sciences." The identification itself provides enough information about the goods to permit consideration of the issue of descriptiveness. The Examining Attorney has held that the proposed mark is merely descriptive of the subject matter of the publication, and has supported his refusal with evidence of use of the term PSYCHOLOGICAL METHODS in relation to the goods. The Commissioner sees no error or abuse of discretion in the Examining Attorney's actions.

REQUEST FOR SUSPENSION

TMEP § 1105.05(a)(i) explicitly states that an Examining Attorney "should not suspend action in the case or take any other similar action for the purpose of extending the time for filing an amendment to allege use." Thus, the Examining Attorney acted properly in refusing Petitioner's request for suspension.

The suspension of an intent-to-use application pending the filing of an Amendment to Allege Use would allow the intent-to-use Applicant to reserve rights in the mark indefinitely, which is clearly contrary to the legislative intention of the TLRA Sections 1(c)and 1(d)of the Trademark Act, 15 U.S.C. § § 1051 (c) and 1051(d), set forth specific time periods in which Amendments to Allege Use and Statements of Use can be filed. These provision would be rendered meaningless if the Office were to permit the suspension of an intent- to-use application pending the filing of an Amendment to Allege Use.

DECISION

The petition is denied. Petitioner is hereby granted 30 days from the mailing date of this decision to respond to the final Office Action dated January 9, 1995.

FN1. Petitioner cites, inter alia, Trademark Rules 2.63(b) and 2.1 46(a)(I) as authority for the requested review. These rules permit an Applicant to petition the Commissioner to review the propriety of an Examining Attorney's formal requirement, if the Examining Attorney's action is limited to subject matter appropriate for petition to the Commissioner. However, under Trademark Rule 2.1 46(b), "[q]uestions of substance arising during the ex parse prosecution of applications, including, but not limited to, questions arising under sections 2, 3, 4, 5, 6 and 23 of the Act of 1946, are not considered to be appropriate subject matter for petitions to the Commissioner." While the propriety of issuing the final refusal under Section (2)(e)(1) prior to the filing of specimens, and the propriety of the Examining Attorney's denial of Petitioner's request for suspension are both procedural issues that are appropriate for review by the Commissioner, the question of whether the mark is merely descriptive is clearly a matter of substance that is inappropriate for review on petition. Accordingly, because the Office Action was not limited to petitionable subject matter, and because it contained no "formal requirement," Trademark Rules 2.63(b) and 2.146(a)(1) do not apply.

Trademark Rules 2.146(a)(3) and 2.146(a)(4) do provide authority for consideration of the petition. Unlike Rule 2.63(b)), these rules do not stay the period for responding to an Office Action until 30 days after the date of the Commissioner's decision on petition. However, the Commissioner construes Petitioner's request for suspension of the application as an implied request for a stay of the period for response to the final Office Action, pursuant to Trademark Rule 2.146(g).

FN2. Any paper filed after final action containing new amendments, new evidence, or new arguments is construed as a request for reconsideration. TMEP § 1110.

39 U.S.P.Q.2d 1467

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