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

RE: TRADEMARK REGISTRATION OF WEIDER HEALTH AND FITNESS
96-47
April 1, 1996
***1** Petition Filed: January 3, 1996

For: PERFORMANCE FAT BURNERS
Registration No. 1,909,129
Issued: August 1, 1995

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Philip G. Hampton, II

Assistant Commissioner for Trademarks

On Petition

Weider Health and Fitness has petitioned the Commissioner to cancel the above identified registration as inadvertently issued, and to restore jurisdiction to the Examining Attorney to consider an amendment deleting the disclaimer of the term FAT BURNERS. Trademark Rule 2.146(a)(3) provides authority for the requested review.

FACTS

Petitioner filed the application on September 13, 1993. On December 15, 1993, the Examining Attorney issued an Office Action requiring a disclaimer of the term FAT BURNERS. Petitioner filed a response traversing the disclaimer requirement on June 14, 1994. On July 25, 1994, the Examining Attorney made the requirement final. Petitioner submitted the required disclaimer on August 1, 1994, and the mark was published for opposition on November 15, 1994. On June 1, 1995, Petitioner filed an amendment appointing a new attorney, and requesting withdrawal of the disclaimer. The mark registered on August 1, 1995, before the proposed amendment was associated with the file. This petition followed.

DECISION

Under Section 12 of the Trademark Act, 15 U.S.C. § 1062, and Trademark Rule 2.65(a), 37 C.F.R. § 2.65(a), an applicant must respond to an Office Action within six months of the mailing date in order to avoid abandonment. After a final Office Action, the only response which an applicant may make as a matter of right is an appeal, a petition if permitted by Rule 2.63(b), or compliance with any outstanding requirement. Trademark Rule 2.64(a), 37 C.F.R. § 2.64(a).

Under Trademark Rule 2.64(b), 37 C.F.R. § 2.64(b), an applicant may request an Examining Attorney to reconsider a final Office Action within 6 months from the date of mailing. However, reconsideration is not a matter of right, and the filing of a request for reconsideration does not extend the time for appeal. TMEP § § 1105.04(f) and 1110.

In this case, the disclaimer requirement was made final on July 25, 1994. Petitioner then had 6 months in which to either (1) comply with the requirement, or (2) appeal the requirement to the Trademark Trial and Appeal Board. Petitioner also had the option of requesting reconsideration within 6 months of the mailing date of the final action; however, if such a request had been filed and denied by the Examining Attorney, and no notice of appeal had been filed, the application would have been abandoned.

***2** Pursuant to 35 U.S.C. § 6 and 37 C.F.R. § 2.146(a)(3), the Commissioner may invoke supervisory authority in appropriate circumstances. However, since the deadline for contesting the disclaimer requirement expired on January 25, 1995, the Commissioner will not cancel the registration and restore jurisdiction to the Examining Attorney to consider the amendment filed June 1, 1995.

The petition is denied.

39 U.S.P.Q.2d 1479

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