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

RE: TRADEMARK APPLICATIONS OF LUTRON ELECTRONICS CO., INC.
Serial No. 627,181; 632,258; 632,262; 632,273
August 30, 1988
***1** Petition Filed: February 22, 1988

For: LUTRON and design
Filed: November 24, 1986

For: Miscellaneous design
Filed: October 27, 1986

Attorneys for Petitioner

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Assistant Commissioner for Trademarks

On Petition

Lutron Electronics Co., Inc. has petitioned the Commissioner to review an action of an Examining Attorney taken in each of the four above-identified trademark applications. Petitioner asks the Commissioner to grant the following relief: that the Examining Attorney withdraw from examining the applications and that a new Examining Attorney be assigned to the applications; that the third party opinion letters be expunged from the application; and that the final rejections be withdrawn; or, in the alternative, that the Examining Attorney withdraw the finality of the final refusals and allow petitioner an additional six months to present evidence and argument in support of the registrability of the marks. This petition will be considered pursuant to Trademark Rule 2.146(a)(3).

FACTS

In March, 1987, the Examining Attorney issued first Office actions in all four of the above-identified applications refusing registration pursuant to Sections 1 and 2(e)(1) of the Trademark Act on the ground that the matter presented constituted a configuration of the goods and, as such, was merely descriptive and primarily functional. Petitioner responded that the mark was registrable and submitted evidence that the mark had acquired distinctiveness pursuant to Section 2(f) of the Trademark Act.

The Examining Attorney issued final refusals in each application.

[FN1] In support of such refusals, the Examining Attorney relied on evidence she obtained and on several exhibits submitted by the petitioner in support of the Section 2(f) claim. [FN2] The evidence obtained by the Examining Attorney includes a letter addressed to the Examining Attorney from W.W. Coyle, Engineering Manager for Carlon Thyrocon (with photographs of Carlon Thyrocon prototype electric light dimmers), which states, in part:

Thank you for giving us the opportunity to respond to the situation that Lutron is causing by their application . . . [T]his will seriously impact our product development . . . We agree with you that the slide actuator is not a unique nor 'Trademarkable' feature of their product . . . [W]e are extremely interestedand concerned about your decision and the outcome of any subsequent appeals.

The final refusals include the following language:

In a letter dated November 4, 1987, W.W. Coyle, the Engineering Manager at Carlon Thyrocon, stated that their product development would be negatively impacted if Lutron were granted an effective monopoly on the design . . .

As further evidence of the undistinctive nature of applicant's mark, attached . . . is a letter from W.W. Coyle . . . (written in response to my inquiries), which states that Thyrocon has developed and will be marketing a slide dimmer which looks like Lutron's. Four photographs of Thyrocon's switch are annexed to this letter as evidence that Lutron's switch design is not distinctive. The Thyrocon switch is virtually identical to Lutron's.

***2** This petition followed on February 22, 1988. [FN3]

ANALYSIS

Trademark Rule 2.146(a)(3) provides that a petition may be taken to the Commissioner requesting him to invoke his supervisory authority in appropriate circumstances. The proper response to a final action on a substantive ground, as herein, is an appeal to the Trademark Trial and Appeal Board. See Trademark Rules 2.63 and 2.64. However, this petition does not request relief in relation to the substantive refusal; it questions the manner in which the evidence in support of that refusal was obtained. This matter is deemed proper for petition because this aspect of the Examining Attorney's action concerns an issue of administrative practice and procedure.

The Commissioner will exercise his supervisory authority and reverse an action of an Examining Attorney only where there has been clear error or abuse of discretion. In re Richards-Wilcox Mfg. Co., 181 USPQ 735 (Comm'r Pats. 1974); Ex parte Peerless Confection Co., 142 USPQ 278 (Comm'r Pats. 1964). The present circumstances constitute a serious abuse of discretion by the Examining Attorney.

There are two issues concerning the Examining Attorney's action that will be addressed. First, in relation to gathering evidence during the examination of an application, what should be the nature and extent of an Examining Attorney's contact with third parties and, second, what kind of evidence from third parties is appropriate for an Examining Attorney to rely upon in support of a refusal to register. [FN4]

Contact with third parties during ex parte examination

The evidence in an application file is limited by the ex parte nature of the proceeding to that provided by the applicant and the Examining Attorney. It is only logical that a thorough examination of an application by the Examining Attorney would include a review of any available information pertaining to the registrability of a mark. However, in seeking information from sources outside the Office, the Examining Attorney must remember the ex parte nature of the proceeding and request only factual evidence concerning registrability rather than ask opinions. [FN5]

Thus, an Examining Attorney may contact those in the relevant trade for information concerning the product, channels of trade, marketing, etc., but the inquiry should be limited to eliciting factual information. It is inappropriate to discuss or request opinions about the registrability of the applicant's mark or about the reliability of any statements or information submitted by the applicant. To do so lends an appearance of bias to the Examining Attorney's examination. Such evidence should be introduced only in an inter partes proceeding brought on behalf of an interested party, where the proceedings are governed by and subject to the safeguards of the Federal Rules of Evidence and Civil Procedure.

In this case, the Examining Attorney appears to have been extremely thorough in her search for information concerning the registrability of the mark, which is commendable. It is not clear from the record whether the Examining Attorney improperly solicited Mr. Coyle's opinions or whether these opinions were gratuitous. However, it seems that the Examining Attorney, at the very least, informed Mr. Coyle about the fact of petitioner's application for registration and of her intended refusal, requesting information in support thereof. The Examining Attorney's request for information was inappropriate to the extent that she discussed the specific mark in terms of the issue of registrability, rather than simply requesting generally available information about the product and the trade.

Appropriate evidence from third party sources

***3** Even if an Examining Attorney's request for information from third parties is proper, not all information received may be used in support of a refusal to register. The Examining Attorney should rely only on factual information.

The Examining Attorney could properly rely on evidence such as brochures, advertising material, catalogs, and any other factual information. The Examining Attorney should not rely upon third party evidence such as memoranda, letters or other documents expressing opinions, or prototype information about goods which are not in use or are otherwise unavailable to the general public.

The Examining Attorney seriously abused her discretion in this case by including in the record the letter from Mr. Coyle identified above

and the prototype information from Carlon Thyrocon. The letter is primarily third party opinion about the competitor's products and the registrability of the marks herein. The prototype is admittedly not in use and the information is unavailable to the general public or relevant trade. Clearly, this information should not be a part of the record in an ex parte proceeding. Any party who might be injured by the registration of a mark may file an opposition to the registration of a mark or a petition to cancel a registration with the Trademark Trial and Appeal Board or seek redress in an appropriate court action.

DECISION

The petition is granted to the extent that the Office Actions of November 16, 1987, and January 19, 1988, are vacated and shall be disregarded in their entireties. Furthermore, to avoid any appearance of bias in the continued examination of the applications, the Managing Attorney shall reassign the applications herein to a Senior Attorney in the Law Office for further examination consistent with this decision. Further, because of the seriousness of the abuse of discretion that occurred with respect to these applications, the petition fee will be refunded.

Petitioner has requested that certain evidence be expunged from the record of the application. However, petitioner has cited no authority in support of such action, and neither the Trademark Act nor the Trademark Rules of Practice provides for expungement of evidence from a file during ex parte examination. Thus, this request is denied.

FN1, The final refusals in three of the applications were mailed to petitioner on November 16, 1987. Petitioner's attorney stated that when the action in relation to application Serial No. 627,181 was not received, she so advised the Examining Attorney and this refusal was mailed on January 19, 1988.

FN2. Several of the pieces of evidence are missing from each of the application files. However, due to the identical nature of the final refusals, the deletion of some evidence appears to have been inadvertent and each application record will be considered to include the same evidence for the purpose of the consideration herein.

FN3. Trademark Rule 2.146(d) requires that a petition on any matter not otherwise provided for shall be filed within sixty days from the date of mailing of the action from which relief is requested. With respect to the three applications in which the final refusal was mailed on November 16, 1987, this petition is not timely. However, since the issue is the same in relation to each application and the petition is timely filed in relation to one application, the Commissioner will exercise his discretion and, in the interest of justice, consider the issue in relation to all applications.

FN4. The petitioner objected to the entry of the evidence at the time

of final refusal. Either the applicant or the Examining Attorney may submit evidence at any time prior to appeal. The Office practice, as set forth in Section 1105.04(c) of the Trademark Manual of Examining Procedure requires that 'the Examining Attorney must have placed in the record all evidence in support of . . . refusal before or at the time the final action is rendered.' Thus, the Examining Attorney acted properly in this regard. There is no prejudice to the petitioner because the petitioner may always the challenge the reliability of the evidence at any stage of the proceeding, even in its brief on appeal.

FN5. An Examining Attorney may obtain verified statements from persons outside the Office concerning facts relevant to the issue of registrability.

8 U.S.P.Q.2d 1701

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