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

RE: TRADEMARK APPLICATION OF BPJ ENTERPRISES LIMITED
Serial No. 73/598,488
February 5, 1988
***1** Petition Filed: July 31, 1987

For: SANTIAGO
Filed: May 6, 1986

Attorney for Petitioner

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Assistant Commissioner for Trademarks

On Petition

Culbro Corporation has petitioned the Commissioner pursuant to Trademark Rule 2.146 to reverse a decision of the Office of the Director of the Trademark Examining Operation denying its Letter of Protest filed against the above- identified application. The relevant provision of Trademark Rule 2.146 is subsection (a)(3) which permits the Commissioner to invoke his supervisory authority where an action by the Office constitutes an abuse of discretion.

FACTS

BPJ Enterprises Limited (applicant), an Illinois corporation, filed an application for registration of the mark, 'SANTIAGO' in a typed form, for goods identified as 'cigars.' The Examining Attorney entered the following translation of the mark in the record:

> The English language translation of the word in the mark is 'St. James' or 'war cry of the Spanish.'

The Examiner approved the mark for publication, and it published in the Official Gazette on October 14, 1986. [FN1]

On December 8, 1986, the petitioner filed a Letter of Protest in relation to the above-identified trademark application, requesting that the Commissioner restore jurisdiction of the application to the Examining Attorney.

As a basis for the Letter of Protest, the petitioner alleged that approving the mark for publication without considering whether the mark is primarily geographically descriptive pursuant to Section 2(e)(2) of

the Trademark Act constituted clear error. In support of the argument that the mark is primarily geographically descriptive, petitioner submitted evidence consisting of the following:

1. An excerpt from The Columbia Lippincott Gazetteer of the World 1694 (L. Seltzer ed. 1952) showing that one of the major crops of Santiago, a fertile province in the Dominican Republic, is tobacco, and that Santiago, or Santiago de los Caballeros, is a center for cigar and cigarette making industries and is the most important trading, distributing and processing center for tobacco in the Dominican Republic;

2. An excerpt from Webster's New Geographical Dictionary 1076 (1984) showing that Santiago is both a province in the Dominican Republic and a city in that province which produces tobacco products;

3. Six statistical bulletins published by the Cigar Association of America, compiled from data reported by the U.S. Census and Customs Bureau establishing that the Dominican Republic exports cigars to the United States, and that, as of June of 1986, it had become the leading importer of these goods to the United States;

4. An excerpt from the Tobacco International Directory listing a tobacco association in Santiago, fourteen separate tobacco dealers and processors in Santiago, five manufacturers of cigars and cigarettes in Santiago, and an advertisement for cigars by a Santiagan manufacturer and exporter;

***2** 5. A tobacco map of the Dominican Republic;

6. Two advertisements concerning an individual who makes cigars in the 'Dominican tobacco center of Santiago.'

On June 1, 1987, the Petitions and Classification Attorney denied the Letter of Protest. He advised the petitioner that a Letter of Protest received after publication of a mark will be granted only where the Examining Attorney has committed clear error. He stated that if the file indicated the Examining Attorney had considered the issue, resolved it, and published the mark, there can be no clear error; rather, there is a question of judgment which should be resolved through the inter partes process. The Petitions and Classification Attorney concluded from the entry of a translation in the record that the Examining Attorney had considered the issue of the significance of the mark. Therefore, he denied the Letter of Protest. On June 24, 1987, petitioner filed a request for reconsideration of the denial of the Letter of Protest, with additional evidence. Petitioner stressed that the Office of the Director should not presume that the Examining Attorney had considered the issue of geographic descriptiveness merely because he had inserted an English translation of the mark in the file. In support of this argument, petitioner noted that the file was devoid of any reference to the possible geographic significance of the mark. On August 10, 1987, petitioner submitted a supplementary request for reconsideration of the denial of the Letter of Protest in light of the recent decision, In re Pohn, 3 U.S.P.Q.2d 1700 (Comm'r Pats. 1987).

On September 11, 1987, the Director repeated the denial of the Letter of Protest. He concluded that there was no clear error in the examination because the record indicated the Examining Attorney had considered the issue of geographic descriptiveness and concluded the mark was not primarily geographically descriptive.

This petition followed. [FN2] Petitioner is requesting the Commissioner to determine that the Examining Attorney clearly erred by

failing to refuse registration of the mark as primarily geographically descriptive and to restore jurisdiction of the application to the Examining Attorney for this purpose.

TIMELINESS

While the issue of timeliness was not raised by the Office of the Director as a basis for refusing to grant the Letter of Protest, due to the recent decision of In re Pohn, 3 U.S.P.Q.2d 1700 (Comm'r Pats 1987), it is appropriate to consider whether the Office of the Director properly considered the Letter of Protest as timely filed. In the Pohn decision, supra., p. 1703, the Assistant Commissioner concluded that 'Letters of Protest will generally not be considered timely if they are filed more than 30 days after the mark is published for opposition.' The Assistant Commissioner noted, however, that this issue must be determined in light of all the circumstances of the particular case.

***3** The Letter of Protest in this case was filed 44 days after the effective date of publication of the mark. However, in light of the fact that this Letter of Protest was filed before the timeliness standard was enunciated in the Pohn decision, the petitioner appears to have proceeded in a timely manner, justifying the date of filing the Protest. [FN3] This situation is decidedly different than that in the Pohn case, where the petitioner did not file a Letter of Protest until more than 4 months after publication of the mark and after he had missed the time period for filing an opposition. Therefore, the Office of the Director did not abuse its discretion in this case by accepting the Letter of Protest as timely filed.

REQUEST FOR RECONSIDERATION

After the denial of the Letter of Protest by the Office of the Director, the petitioner submitted both a request for reconsideration and a supplementary request for reconsideration of the denial.

The Letter of Protest is an examination procedure which was created and exists at the discretion of the Office to assist the examination process. While this procedure may lengthen the examination process, the potential of the information received to improve the quality of examination in a particular case justifies the Letter of Protest procedure. However, there is no provision for reconsideration requests in relation to a denial of a letter of protest, and such a procedure would be inappropriate. A protester should carefully present all relevant arguments and evidence in the initial Letter, as a request for reconsideration serves to unnecessarily extend the examination process. Trademark Rule 2.146 provides recourse to a denial of a Letter of Protest by means of a petition to the Commissioner.

Therefore, the Office of the Director improperly considered the petitioner's requests for reconsideration and evidence contained therein. Those papers will not be considered in deciding the issue presented in this petition. The only evidence that will be considered is that submitted with the original Letter of Protest filed December 8,

1986.

PROCEDURES FOR CONSIDERING LETTER OF PROTEST

Before addressing the substantive issue presented in this case, the Assistant Commissioner will consider whether the Office of the Director followed appropriate procedures in making its determination.

The record indicates that the Petitions and Classification Attorney originally considered granting the Letter of Protest and sent a memorandum to the Examining Attorney advising him to request that the Commissioner restore jurisdiction of the application to him. The record also indicates that, in response, the Examining Attorney sent a memorandum attempting to refute the evidence in the Letter of Protest and arguing why he should not be required to take jurisdiction of the application. Apparently after receipt of this memorandum, the Petitions and Classification Attorney decided that the Letter should not be granted. This procedure was improper. The Examining Attorney should have no involvement in the decision regarding a Letter of Protest. The Office of the Director has been given broad discretion to make this determination objectively and then forward to the Examining Attorney only the evidence that the Office of the Director has determined is appropriate. This avoids any appearance of impropriety in relation to third party intervention in the ex parte prosecution of an application, promotes consistency in Letter of Protest determinations, and avoids prejudicing the Examining Attorney.

***4** In the denial of the request for reconsideration of the Letter of Protest, the Office of the Director referred to, and based its decision on, information contained only in the Examining Attorney's above-described memorandum to the Petitions and Classification Attorney. This is clearly inappropriate. The only evidence that the Office of the Director should consider in decisions involving Letters of Protest is the evidence of record in the application file and the evidence submitted with the Letter.

Therefore, the Office of the Director did abuse its discretion by involving the Examining Attorney in the decision-makingprocess and by considering information which was not properly a part of the record. The information contained in the Examining Attorney's memorandum will not be considered herein to determine whether the Office of the Director abused its discretion by denying the Letter of Protest.

DENIAL OF LETTER OF PROTEST

The issue in this petition is whether the Office of the Director abused its discretion in denying the petitioner's Letter of Protest. In this case the Letter of Protest was filed after publication of the mark for opposition. As stated in the Pohn decision, supra., p. 1702, the Office of the Director has broad discretion in determining whether to accept a Letter of Protest. The standard for that determination after publication of the mark is very specific: the information presented must show that the publication of the mark constituted a clear error.

The Assistant Commissioner will decide the issue by considering the following factors:

1. Whether prior consideration by the Examining Attorney of the issue raised in the Letter of Protest is the appropriate standard for determining whether there has been a clear error in the examination of an application.

In the denial of the Letter of Protest, the Petitions and Classification Attorney advised the petitioner that, while a Letter of Protest received after publication of the mark will only be granted where the Examining Attorney has committed clear error, once the Examining Attorney had considered the nature of the mark, the issue became a question of judgment which should be resolved through an inter partes proceeding. This standard is inappropriate. The question is not whether the Examining Attorney considered the issue, but whether publication of the mark constituted clear error. This analysis will vary in each case and should take into consideration all appropriate information in the application record and in the Letter.

Letters of Protest serve to bring information to the attention of the Office. [FN4] After publication of the mark, that information must be evaluated from the standpoint of whether, when considered with the evidence already in the record, there is sufficient evidence to establish a prima facie case in support of the proposed refusal to register. If, in view of the protester's information, any consideration of the issue in the record by the Examining Attorney is inadequate or incorrect, the Office of the Director should find clear error in the examination and grant the Protest. If the Examining Attorney did not consider the issue and, in the Director's view, the protestor's evidence is sufficient to establish a prima facie case in support of the proposed refusal to register, the Office of the Director should find clear error in the examination and grant the Protest. [FN5]

***5** Therefore, the Office of the Director clearly abused its discretion by considering only whether the Examining Attorney had previously considered the issue to determine whether there was clear error in the examination process. Furthermore, the Office of the Director erred in concluding that the issue of geographic descriptiveness had been considered since the Examining Attorney had entered a translation of mark in the record. The two issues are unrelated.

2. Whether the petitioner submitted sufficient evidence to establish a prima facie case in support of a refusal to register the mark on the ground that it is primarily geographically descriptive.

A refusal to register on the basis of geographic descriptiveness is appropriate if the primary significance of the mark is geographical, the geographic location is not obscure, and the goods do, in fact, come from the geographical place named in the mark. See In re Nantucket, Inc., 213 USPQ 889, 895 (CCPA 1982) (Nies, J., Concurring), and In re Handler Fenton Westerns, Inc., 214 USPQ 848 (TTAB 1982). In In re Loew's Theatres, Inc., 226 USPQ 865 (Fed. Cir. 1985), the Court stated that the PTO's burden of proof is simply to establish that there is a reasonable predicate for its conclusion that the public would be likely to make the particular goods/place association on which it relies. The Court concluded that, given the limited resources available to

Attorneys at the PTO, the PTO had made an acceptable prima facie showing by its submission of gazateer excerpts.

The evidence submitted by the petitioner with the original Letter of Protest, and discussed above, complies with the standards enunciated by the Court and the Board to establish a prima facie case of geographic descriptiveness and, thus, sufficiently raises the issue of geographic descriptiveness to warrant serious consideration by the Examining Attorney. In reaching a contrary decision, the Office of the Director considered evidence and arguments not part of the record and drew conclusions not supported by the law. Thus, it clearly abused its discretion in denying the Letter of Protest.

Accordingly, the petition is granted. The above-identified application will be forwarded to the Office of the Director of the Trademark Examining Operation to grant the Letter of Protest and forward the file to the Examining Attorney. The Examining Attorney is granted jurisdiction in this application to take action in accordance with this decision.

FN1. Due to a late mailing of the Official Gazette, Notices of Opposition or Requests for an Extension of Time which were filed by November 19, 1986, were considered timely filed for marks published on October 14, 1986. See 1072 TMOG 3, November 18, 1986. On November 3, 1986, the petitioner filed a Request for an Extension of Time to File a Notice of Opposition with the Trademark Trial and Appeal Board. This and subsequent requests were granted pending the outcome of the Letter of Protest herein.

FN2. On October 26, 1987, the petitioner filed a supplemental statement to its petition which included evidence in support of its position that the mark in issue is primarily geographically descriptive. The standard of review in this petition is whether the Office of the Director abused its discretion in denying the Letter of Protest. The only relevent evidence is that considered by the Office of the Director in making its decision. Therefore the evidence submitted with this petition is inappropriate and will not be considered.

FN3. Petitioner stated that it was unaware of the mark until after it had published, that any delay in filing the Letter of Protest was due to the fact that it had been attempting to gather evidence as to the descriptiveness of the mark, and that the extension of time to oppose had been requested solely to preserve the right to oppose in the event the Letter of Protest was denied. These statements were not in the original Letter, but were made after petitioner became aware of the Pohn decision, and will be accepted for the sole purpose of determining timeliness.

FN4. While the primary purpose of the procedure is to permit those in the trade to provide useful information which might otherwise be unavailable to the Examining Attorney, after publication of a mark the protestor should submit sufficient evidence to support its allegation of clear error in examination, which may include information generally

available to the Examining Attorney.

FN5. Generally, if the Office of the Director has found that the evidence of record supplemented by the protester's information is sufficient to establish a prima facie case for the proposed refusal, and jurisdiction over the application is returned to the Examining Attorney, the Examining Attorney should enter such a refusal in the record. However, on rare occasions, further research by the Examining Attorney may indicate that a refusal is inappropriate. Any decision to re-publish the mark rather than to issue a refusal to register the mark should be made with the Director's approval.

7 U.S.P.Q.2d 1375

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