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

RE: TRADEMARK APPLICATIONS OF MONTE DEI MASCHI DI SIENA
94-146; 94-147
February 2, 1995
***1** Petitions Filed: March 21, 1994

For: MONTEPASCHI
Serial No. 74/139,507; 74/139,508
Filing Date: February 15, 1991

Philip G. Hampton, II

Assistant Commissioner for Trademarks

On Petition

Monte Dei Maschi Di Siena has petitioned the Commissioner to restore jurisdiction of the above captioned applications to the Examining Attorney. Trademark Rule 2.146(a)(3) provides authority for the requested review.

The subject applications were filed February 15, 1991, based upon the applicant's bona fide intention to use the marks in commerce, pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). The marks were published for opposition on June 22, 1993, and Notices of Allowance issued on September 14, 1993. Petitioner filed a request for an extension of time to file a Statement of Use for each of the applications on March 9, 1994.

These petitions were filed March 21, 1994. Each petition was accompanied by a proposed amendment adding Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e), as a basis for registration. Petitioner requests that the applications be withdrawn from publication, and that jurisdiction over the applications be restored to the Examining Attorney for consideration of the amendments. [FN1]

Office policy has prohibited the amendment of an application after publication to add or substitute a new statutory basis for registration. TMEP § 1006.04. The rationale is that acceptance of such an amendment would be disruptive to the orderly examination of subsequent applications, and would be unfair to third parties, who need to know the asserted basis or bases for registration with certainty at the time of publication, so that they can weigh their own rights against those of the applicant and make informed judgments as to whether to oppose. Goodway Corp. v. International Marketing Group Inc., 15 U.S.P.Q.2d 1749 (TTAB 1990); Sherlock's Home Inc. v. Tippling House Ltd., 10 U.S.P.Q.2d 1709 (TTAB 1989); Societe Des Produits Marnier Lapostolle v. Distillerie Moccia S.R.L., 10 U.S.P.Q.2d 1241 (TTAB 1989).

However, Trademark Rule 2.146(a)(3) permits the Commissioner to invoke supervisory authority in appropriate circumstances, and this is an appropriate situation in which to invoke such authority. Henceforth,

the Office will accept post publication amendments adding or substituting new statutory bases for registration, but only with the express permission of the Commissioner, after consideration on petition. [FN2] Republication will always be required.

The petitions are granted. The Notices of Allowances will be cancelled. The applications will be withdrawn from publication, and returned to the assigned Examining Attorney for consideration of the proposed amendments. If the Examining Attorney approves the amendments, the marks will be republished for opposition.

FN1. Pursuant to Trademark Rule 2.84(a), 37 C.F.R. § 2.84(a), jurisdiction over an application filed under Section 1(b) of the Trademark Act resides with the Examining Attorney after issuance of the Notice of Allowance. TMEP § § 1105.05(c) and 1504.01.

FN2. Pursuant to Trademark Rule 2.77, 37 C.F.R. § 2.77, the only amendment permitted between the issuance of a Notice of Allowance and the submission of a Statement of Use is an amendment to delete goods or services. However, this rule does not apply to an amendment deleting the Section 1(b) basis from the application. Such an amendment can be filed at any time during the pendency of the application. TMEP § 1006.07.

34 U.S.P.Q.2d 1415

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