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

RE: TRADEMARK APPLICATION OF KAREN POHN
87-8
June 8, 1987
***1** Petition Filed: March 6, 1987

For: POP BEADS and Design
Serial No. 586,596
Filed: March 6, 1986

Attorney for Petitioner

Simor L. Moskowitz

Fleit, Jacobson, Cohn & Price

Attorney for Applicant

Larry L. Saret

Laff, Whitsel, Conte & Saret

Margaret M. Laurence

Assistant Commissioner for Trademarks

On Petition

J. Shin Company Inc., d/b/a Village Toys, has petitioned the Commissioner pursuant to 37 C.F.R. § 2.146 to reverse a decision denying a letter of protest filed by petitioner against the above-identified application.

A review of the record reveals that applicant Karen Pohn filed the subject application on March 6, 1986 for the trademark POP BEADS and Design for 'jewelry beads'. On April 30, 1986, by Examiner's Amendment, the identification of goods was changed to 'costume jewelry beads made of plastic'. The notation was made that the mark was 'not used anywhere by the foreign manufacturer as owner of the mark'. The mark was thereupon approved for publication, and was published on July 15, 1986.

On September 15, 1986, petitioner filed a request for an extension of time to oppose. [FN1] The reason given was that additional time was required to investigate the matter to determine if an opposition were warranted, to allow for communication between petitioner and its counsel, and to prepare the necessary opposition papers. Applicant opposed this request, stating 'it is believed that petitioner is deliberately delaying issuance of the registration in hopes of avoiding infringement litigation, since it is presently believed that petitioner

is an infringer'.

The Board granted petitioner's request, and the time for filing a notice of opposition was extended to October 14, 1986. On October 14, 1986 petitioner filed a third request for an extension of time to November 12, 1986, stating that applicant had recently filed a civil action against petitioner and petitioner needed the additional time to assess the pleadings as they might affect its position in the potential opposition. The Board granted this request, and extended the time to file a notice of opposition to November 12, 1986.

On November 19, 1986 petitioner again filed a request for an extension of time. This request was filed one week after its extension of time to oppose expired on November 12, 1986. In the further request, petitioner stated that it had called the Trademark Trial and Appeal Board on November 13, 1986 to explain that the extension to the November 12, 1986 it had requested was in error, and that in computing two additional 30-day time periods from the September 15 date granted by the Board its actual extension should have been to November 14, 1986. The Board member stated that the 120-day period expired on November 12. [FN2] Accordingly, petitioner accompanied its late filed request for an extension with a notice of opposition and requested that the 120-day period be extended in view of an extraordinary situation. On December 4, 1986 the Board confirmed that it had granted the extension to November 12 and not beyond the 120-day period provided by Rule 2.102(c). Further, because the request for a further extension filed on November 19 was not filed within any extension of time previously granted, there was no statutory authority for granting that request or for acceptingthe notice of opposition filed on the same date.

***2** Contemporaneously with the late filed request for a further extension filed on November 19, petitioner filed a Letter of Protest directed to the attention of the Office of the Director of the Trademark Examining Operation. In this letter, petitioner argued that the Examining Attorney had commited clear error in approving the mark for publication. Petitioner took issue with the thoroughness of the Attorney's examination of the application. Petitioner also pointed out that it had a pending application for a similar mark which had been refused by another Examining Attorney 'because the matter presented appears to be the name of the goods,' and that Office action had included several excerpts from a Lexis/Nexis search which supported this refusal. Petitioner stated in its letter that the Examining Attorneys for both the petitioner's and applicant's applications were aware of the close connection and inter-relationship of the applications. Petitioner also took issue with the Examining Attorney's decision not to require a disclaimer of any terms in the applicant's mark.

On December 18, 1986 petitioner filed another Letter of Protest, directed to the Deputy Assistant Commissioner for Trademarks. This Letter contained material from a fashion dictionary and from the Lexis/Nexis data base, which was for the purpose of showing the descriptive nature of POP BEADS, and copies of a transcript of a deposition of the applicant taken pursuant to a civil action between petitioner and applicant. The transcript dealt with applicant's adoption and use of the mark.

On February 24, 1987 the Petitions and Classification Attorney, to whom authority had been delegated by the Deputy Assistant Commissioner for Trademarks, declined on the basis of the Letter of Protest to request that the Assistant Commissioner for Trademarks restore jurisdiction of the application to the Examining Attorney. Two reasons were given for the decision not to forward the Letter of Protest to the Examining Attorney: The Letter did not set forth facts which might otherwise not come to the attention of the Examining Attorney, and the Letter of Protest was not timely filed. On the first point the Petitions and Classification Attorney added that Letters of Protest are not given to Examining Attorneys when they are merely adversary arguments to the effect that registration should be refused, or when they contain assertions that have to be supported by evidence best offered during an inter partes proceeding. On the timeliness issue, he noted that the Letter was filed after petitioner had failed to institute an opposition proceeding within the time allowed by Statute, and pointed out that the Letter of Protest procedure was not established to be a substitute for an opposition proceeding, or to rectify situations where a potential opposer had initiated a proceeding by filing requests for extensions of time to oppose and then missed the date to file an opposition.

The subject petition was then filed. The Director of the Examining Operation, and through him the Petitions and Classification Attorney, has broad discretion in determining whether the information contained in the Letter of Protest would be useful in the examination of an application or, after publication of the mark, whether the information presented shows that the publication constituted clear error. The standard for review of the decisions on Letters of Protest is whether the Petitions and Classification Attorney clearly abused this broad discretion.

***3** Petitioner takes the position that the Letter contained facts which otherwise would not have come to the Examining Attorney's attention, arguing that the Examining Attorney did not develop the various references submitted by petitioner 'although such references were available [to the Examiner] simply by conducting her own Lexis/Nexis search' and that these same references were found by another Examining Attorney and used to support a refusal of petitioner's applications.

Petitioner appears to have a basic misconception about the purpose of the Letter of Protest. The procedure was adopted by the Patent and Trademark Office because it was recognized that the Examining Operation did not have the same resources and expertise as those who worked in or were involved with the particular business in connection with which a trademark or service mark application might be filed. Accordingly, the Office created a procedure by which those in the trade could bring to the attention of the Office information which might be unavailable to the Examining Attorney but which would be useful in the examination of a particular application.

By the statements petitioner has made in its Letter of Protest and its Petition, it is clear that the information sought to be conveyed with the Letter of Protest was available to the Examining Attorney. The material was in the LEXIS/NEXIS data base, which is accessible in the

library of the Trademark Examining Operation. The fact that this material was cited by another Examining Attorney in connection with petitioner's applications demonstrates it was readily available, and did not require the aid of the Letter of Protest procedure for it to be made known to the Examining Attorney.

It is clear that one of the primary purposes of petitioner's Letter of Protest was to show its disagreement with the Examining Attorney's examination of the subject application, rather than to bring information to her attention. This is made manifest in such statements from the Letter of Protest as:

'Apparently, no Lexis/Nexis search was conducted, and no consideration of the requirement of a disclaimer even of the word 'beads'--was made by the Examining Attorney. Instead, the application was allowed and passed to publication virtually without substantive review';

'Clearly, then, the Examining Division, as well as the respective Examining Attorneys in both the Shin [petitioner] application and the Pohn [applicant] application were aware of the close connection and inter-relationship of these two applications';

'. . . the Examining Attorney in the above-identified application obviously did not adequately examine or review that application before allowing it'; and

'At minimum, a requirement for disclaimer of 'pop beads' apart from the mark as shown is in order . . .'

In response to the objection that the Letter of Protest was not timely filed, petitioner argues only that if the Examining Attorney had conducted a Lexis/Nexis search the application would not have been allowed and an opposition would not have been necessary. Again, petitioner's argument goes to its disagreement with the examination conducted by the Examining Attorney, and does not respond to the Office's position about when a Letter of Protest is considered untimely.

***4** A decision as to the timeliness of a Letter of Protest must be made in the context of the purpose of such a Letter. As indicated above, the primary purpose of the Letter is to aid the Examining Attorney in the examination of an application. Therefore, it is expected that most such Letters will be filed while applications are still in the examination stage, and before they are approved for publication. However, the Office recognizes that some parties who may have information bearing on the registrability of a mark will not be aware of an application until it is published for opposition. This is particularly true with the current pendency goals for examination, with applications being approved for publication in as little as three months. Because of this, Letters of Protest may be filed under certain conditions after publication. See TMEP § 1503.02.

The timeliness of the Letter of Protest is determined in light of all the circumstances of the particular case. It is recognized that the Letter of Protest procedure has a potential for abuse, and that a party could try to use the Letter of Protest as a means of delaying the issuance of a registration. This can work a particular hardship on the applicant, who has no knowledge that the Letter has been filed, and has no method to respond to the Letter until jurisdiction over the application is restored to the Examining Attorney, and registration is

refused. Accordingly, Letters of Protest will generally not be considered timely if they are filed more than 30 days after the mark is published for opposition. While, in special circumstances, there may be exceptions to this general policy, such exceptions would normally be limited to situations where the protestor could not earlier have obtained the information provided in the Letter, or has required additional time to gather relevant information for inclusion in the Letter, such as evidence of descriptiveness.

However, Letters of Protest are not appropriate when the protestor's purpose is merely to delay the issuance of a registration, or to use it as a substitute for opposition. Thus, a Letter of Protest will be denied as untimely if the protestor has already embarked on an opposition by filing requests for extensions of time to oppose [FN3], or if he is using the Letter of Protest because he has failed to file an opposition. In the present situation, the Petitions and Classification Attorney could reasonably conclude that the Letter of Protest was untimely for both these reasons. As he stated in his February 24, 1987 letter, 'the Letter of Protest procedure has not been established to rectify situations where a potential opposer had initiated a proceeding in terms of filing requests for extensions of time to oppose and missed the date to file an opposition.'

Petitioner also asks that, even if the Petitions and Classification Attorney's decision is found to be correct, the Letter of Protest policy as followed by the Office be suspended so that petitioner's Letter of Protest will be accepted. Petitioner has couched this request in terms of a waiving a rule pursuant to Rule 2.148, although he is asking for the waiver of a policy set forth in the TMEP. Petitioner argues that it will be harmed if the registration issues because the registration can then be deposited with the U.S. Customs Service, as a result of which petitioner's goods may be seized and their importation delayed while administrative proceedings take place. While the Commissioner is not unmindful of petitioner's concerns, petitioner has not provided adequate reasons, or indeed any reasons, as to why it delayed so long in filing the Letter of Protest. If petitioner had wanted to prevent applicant's mark from issuing to registration, and had adequate grounds for doing so, it had an adequate remedy in the form of an opposition proceeding. The fact that petitioner failed to file a timely notice of opposition, and may suffer harm from this failure, is not a sufficient reason for distorting the Letter of Protest procedure to suit petitioner's needs.

***5** The petition is denied.

Petitioner asks that, if the petition is denied, it be granted a brief period of time before the registration issues in order to pursue any administrative remedies it may have. Petitioner is advised that the registration will not issue before July 14, 1987.

FN1. Although the paper is not in the file, it appears from applicant's statements that petitioner timely filed a first request for an extension of time to oppose on August 14, 1986, and that the September 15 request was a timely and appropriate second request.

FN2. Trademark Rule 2.102(c) provides, in part: '. . . extensions of time to file an opposition aggregating more than 120 days from the date of publication of the application will not be granted except upon (1) a written consent or stipulation signed by the applicant or its authorized representative, or (2) a written request by the potential opposer or its authorized representative stating that the applicant or its authorized representative has consented to the request, and including proof of service on the applicant or its authorized representative, or (3) a showing of extraordinary circumstances, it being considered that a potential opposer has an adequate alternative remedy by a petition for cancellation.'

FN3. Such a situation obviously differs from one where the party files a Letter of Protest within the 30 day publication period, and also requests an extension of time to file an opposition so that it can preserve its ability to proceed with an opposition should the Letter of Protest be denied.

3 U.S.P.Q.2d 1700

END OF DOCUMENT