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

RE: TRADEMARK APPLICATION OF G. HEILEMAN BREWING COMPANY, INC.
94-155
November 10, 1994
***1** Petition Filed: May 6, 1994

For: ICE-LAGERED
Serial No. 74/2124,324
Filing Date: October 15, 1991

Philip G. Hampton, II

Assistant Commissioner for Trademarks

On Petition

Anheuser-Busch Companies, Incorporated has petitioned the Commissioner to reverse the decision of the Administrator for Trademark Classification and Practice (Administrator) denying a Letter of Protest filed in connection with the above identified application. Trademark Rule 2.146(a)(3) provides authority for the requested review.

FACTS

The above-identified intent-to-use application for the mark ICE-LAGERED, to be used in conjunction with "alcoholic malt beverages, namely, beer" in International Class 32, published for opposition on May 19, 1992. [FN1] Petitioner filed several requests for extensions of time to file an opposition with the Trademark Trial and Appeal Board, extending the time for filing an opposition through September 16, 1992. When no notice of opposition was filed within the statutory period, the Notice of Allowance proceeded to issue on April 13, 1993.

On August 3, 1993, Petitioner filed a Letter of Protest, submitting evidence and arguments against registration of the subject mark based upon its alleged descriptiveness and/or genericness. Exhibits A through H from the Letter of Protest have been incorporated by reference in the petition. A significant portion of the evidence consists of excerpts of newspaper and magazine articles from the Nexis (R) database showing common usage of the terminology "lagered" and "ice beer." Included in this evidence is an excerpt from an article in the March 23, 1992 issue of Marketing Intelligence Service Ltd., which references the following usage of "ice lagered:" "Ice lagered, cold filtered Draft and Draft Light Beers are now available from Rainier Brewing Co. of Seattle, WA, under its Rainier banner."

The Letter of Protest asserted that the evidence of descriptiveness submitted was not available at the time the application was initially examined and published, and referred to the fact that the first alleged descriptive or common descriptive reference to "ice beer" in the Nexis (R) database occurred on March 25, 1993, well after the publication

date of the application. The Administrator denied the Letter of Protest as untimely filed, citing In re Pohn, 3 U.S.P.Q.2d 1700 (Comm'r Pats.1987) and In re BPJ Enterprises, Ltd., 7 U.S.P.Q.2d 1375 (Comm'r Pats.1988). This petition followed. [FN2]

Counsel for Petitioner argues that the Letter of Protest should be accepted because it contains evidence that could not be obtained until well after the thirty day period following publication of the subject mark, and thus is consistent with In re Pohn, supra, which expressly states an exception to the time restriction on Letters of Protest filed beyond thirty days after publication where "the protester 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." Specifically, Petitioner's Counsel asserts that evidence of the subject mark's descriptiveness only first appeared in the Nexis database on March 25, 1993, well after the date when a Letter of Protest could be timely filed under the present case law, i.e., June 18, 1992. In addition, Counsel has submitted a second Letter of Protest with the petition which includes additional evidence and arguments against registration.

DECISION

***2** The Administrator for Trademark Classification and Practice has broad discretion in determining whether to grant a Letter of Protest. While Trademark Rule 2.146(a)(3) permits the Commissioner to invoke his supervisory authority in appropriate circumstances, the Commissioner will reverse the action of the Administrator on a Letter of Protest only where there has been an abuse of this broad discretion. In re Pohn, 3 U.S.P.Q.2d 1700 (Comm'r Pats.1987).

The Letter of Protest procedure was adopted, among other reasons, because it was recognized that the Trademark Examining Groups did not have the same resources and expertise as those who worked in or were involved with a particular industry or trade. A Letter of Protest filed more than 30 days after the date of publication of the subject mark is generally denied by the Administrator as untimely unless "the protester 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 protester's purpose is merely to delay the issuance of a registration, or to use it as a substitute for opposition." In re Pohn, 3 U.S.P.Q.2d 1700, 1703 (Comm'r Pats.1987).

The published decision that established a time limitation with respect to Letters of Protest filed after publication, In re Pohn, supra, was decided prior to the implementation of the Trademark Law Revision Act (TLRA) of 1988, which was implemented on November 16, 1989. The Trademark Manual of Examining Procedure (TMEP) § 1116.02(a) has extended application of this time period to intent to use applications as well, although there are no published decisions on this issue. [FN3]

In the present case, the Nexis (R) excerpts (Exhibit G) show that,

although the evidence was not available during the initial examination of the application, it was available to Petitioner at least as early as March 23, 1992, a date almost two months prior to the date of publication of the subject mark on May 19, 1992. This situation does not fit the exception enumerated in Pohn, inasmuch as the evidence of descriptiveness was available prior to the date of publication, and thus the Administrator properly denied the Letter of Protest as untimely.

Action on this petition is generally consistent with the principle that Letters of Protest, as a procedure outside formal rules, should be limited to minimize possible delay and disruption in the processing of an application. Furthermore, this action is consistent with the intended framework for processing intent to use applications. Cf. Eastman Kodak Co. v. Bell & Howell Document Management Products Co., 994 F.2d 1569, 26 U.S.P.Q.2d 1912 (Fed.Cir.1993). The Examining Attorney will have the opportunity to revisit the issue of registrability upon the examination of the Statement of Use with specimens. The Examining Attorney is responsible for undertaking appropriate research related to the mark based on knowledge of developments within the relevant industry and other factors, and will issue a refusal in appropriate circumstances. In addition, interested parties have a remedy via a cancellation proceeding.

***3** Accordingly, the petition is denied. The application file will be forwarded to the Administrator for review of the second Letter of Protest filed with the petition. The petition papers and this decision will not be a part of the application file, but will instead be forwarded to the Administrator to be filed with the first Letter of Protest papers.

FN1. A note to the file dated January 16, 1992, indicates that the Examining Attorney conducted a Nexis (R) search for variations on the words "ice lager." No Office action was issued during examination of the application prior to publication.

FN2. On August 9, 1993, a Statement of Use was filed by Applicant which will be forwarded to the Examining Attorney for examination following resolution of the instant petition and second Letter of Protest filed with the petition.

FN3. An intent-to-use application is inherently different from a use-based application. For example, an intent-to-use application is examined both after the application has received a filing date, and after the filing of a Statement of Use. Thus, contrary to an application based upon Section 1(a) of the Act which, once published, generally does not return to the Examining Attorney for further examination, an intent-to-use application is returned to the Examining Attorney for examination of the Statement of Use. During examination of the Statement of Use, an Examining Attorney generally "will not issue any requirements or refusals concerning matters which could or should have been raised during initital examination, unless the failure to do so in initial examination results in clear error. 'Clear Error' refers to an error which, if not corrected, would result in issuance of a

registration in violation of the Act." TMEP § 1105.05(f)(ii). The registration of a generic term would be an example of "clear error."

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