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

RE: TRADEMARK APPLICATION OF GTE EDUCATION SERVICES
93-284
November 4, 1994
***1** Petition Filed: June 16, 1993

For: CA.SCHOOLCOM
Serial No. 74/118,792
Filing Date: November 28, 1990

Philip G. Hampton, II

Assistant Commissioner for Trademarks

On Petition

GTE Education Services has petitioned the Commissioner to reverse the Examining Attorney's action holding the above application to be abandoned for failure to file a proper response to an Office Action. Trademark Rule 2.146(a)(3) provides authority for the requested review.

FACTS

The subject application was filed on November 28, 1990, for "educational services, namely electronic bulletin boards, databases, conferencing systems and network services." In an Office Action dated March 25, 1991, the Examining Attorney indicated that, among other things, the application identified services that spanned three International Classes and that the specimens did not support "educational services" in International Class 41.

Petitioner timely responded to the Office Action by, among other things, submitting fees for two additional classes. No substitute specimens were submitted for the Class 41 services, although Petitioner stated that "[a] diligent search is in progress to locate suitable specimens which will be provided to the Trademarks [sic] Office upon locating. Concurrently, Applicant is endeavoring to ascertain the dates of first use for the additional classes and will provide this information with its further submission."

In a letter dated January 13, 1992, the Examining Attorney held the specimen refusal final, and also made the requirement for clarification of the recitation of services in Class 41 final. [FN1] On July 13, 1992, Petitioner submitted substitute verified specimens for Class 41, and also clarified the wording of the services in this class.

On August 26, 1992, the Examining Attorney, construing the July 13, 1992, response as a request for reconsideration of the final refusal issued in January of 1992, accepted the amendment to the recitation of services, and indicated the following:

In a reference to the substitute specimens, the request for

reconsideration is DENIED. The FINAL requirement for substitute specimens ... is continued for the reasons stated previously as well as those set forth below.

Applicant's recitation is for educational services. Educational services are considered activities involving the provision of courses, workshops, and the like in specified fields.... Applicant's specimens of record clearly indicate the services are on line computer services.... There is no indication that applicant conducts training workshops, classes or advises. Therefore, the specimens of record do not show use of the mark in reference to the specified services.

The application was declared abandoned on June 2, 1993, with an effective abandonment date of July 14, 1992, for failure to respond to the final Office Action dated January 13, 1993, within six months of the mailing date. This petition followed.

***2** Petitioner argues that it responded to the final Office Action by submitting a response within the six-month period on July 13, 1993, and thus the abandonment was in error in should be withdrawn. [FN2]

DECISION

Trademark Rule 2.146(a)(3) permits the Commissioner to invoke his supervisory authority in appropriate circumstances. However, the Commissioner will reverse the action of an Examining Attorney only where there has been a clear error or abuse of discretion. In re Richards-Wilcox Manufacturing Co., 181 USPQ 735 (Comm'r Pats.1974); Ex parte Peerless Confection Co., 142 USPQ 278 (Comm'r Pats.1964). No clear error or abuse of discretion has occurred in the instant case.

Trademark Rule 2.64(a) states that an applicant's response to a final Office Action is limited to either (1) an appeal to the Trademark Trial and Appeal Board (Board), (2) compliance with any requirement, or (3) a petition to the Commissioner, if permitted by Trademark Rule 2.63(b). According to Trademark Rule 2.64(b), an applicant may request reconsideration after final action within the time period for response, however, this will not stay the time for filing an appeal to the Board. [FN3] If the request for reconsideration is not persuasive, and the time for appeal has passed, the application is abandoned. TMEP § 1105.04(f)

Any paper filed after final action containing new amendments, new evidence or new arguments is construed as a request for reconsideration. TMEP § 1110. Sections 11105.04(f) and 1110 of the Trademark Manual of Examining Procedure (TMEP) explain the procedure to be followed by an Examining Attorney when a request for reconsideration is filed after a final refusal has issued. Generally, where an Applicant presents amendments, evidence or arguments which fail to raise any new issue or which are not significantly different from previously submitted material, an Examining Attorney should deny the request, maintain any final refusals and requirements, and advise the Applicant of the status of the case, e.g., whether the application is abandoned, or being sent to the Board for institution of an ex parte appeal. If no new issue or evidence is presented in the request, no notice of appeal has been timely filed, and the six month period to

respond to the final action has expired, then the application will be deemed abandoned. [FN4]

In the present case, the Examining Attorney properly determined that no new issue had been raised, "denied" the request and "continued" the final refusal due to inadequate specimens for Class 41, because the substitute specimens submitted with the request were deficient for the same reason as the original specimens. [FN5] No six month response clause appeared in the Office Action. Although anupdate of the status of the application was omitted from the denial of the request, the Applicant was on notice that the application would abandon inasmuch as no appeal was filed during the specified time period after issuance of the final action. See Trademark Rules 2.64(b) and 2.142(a).

***3** Thus the Examining Attorney substantially complied with the established examining procedure outlined in the TMEP for requests for reconsideration in this instance, and no clear error or abuse of discretion can be said to have occurred.

Accordingly, the petition is denied. The application will remain abandoned.

FN1. There was no mention in the final refusal of the requirement that applicant submit verified dates of use for the three classes.

FN2. It is unclear from the petition whether Petitioner received the August 26, 1992 Office Action which maintained the final requirement for substitute specimens.

FN3. An appeal to the Trademark Trial and Appeal Board from an Examining Attorney's final action must be filed within six months from the date of the final action. 37 C.F.R. § 2.142(a).

FN4. The procedure set forth in the TMEP for requests for reconsideration above is somewhat inconsistent with actual trademark examining practice. Although both TMEP sections insist that a request for reconsideration is a filing that is either "granted" or "denied" by an Examining Attorney. In all cases it appears that a request is "granted," i.e., the evidence contained therein is always reviewed by the Examining Attorney so long as the request is timely filed. The only issue in question is whether or not, after reviewing the evidence or arguments submitted in the request, the Examining Attorney will restate the final refusal with the same six month response period in place, or withdraw the finality and issue a new action, with a new response period (because a new issue has been raised). These two TMEP sections are currently under review for the next revision of the TMEP.

FN5. Although the Examining Attorney used the rather ambiguous term "continued" to refer to the maintaining of the final specimen refusal, there is no doubt that this wording was intended to inform the Petitioner that the final refusal was being adhered to and that the substitute specimens were still unacceptable.

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