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

RE: TRADEMARK APPLICATION OF MISSION PHARMACAL COMPANY, INC.
93-251
December 27, 1993
***1** Petition Filed: August 11, 1993

For: CRAMP GUARD
Serial No. 74/296,618
Filing Date: July 22, 1992

Robert M. Anderson

Acting Assistant Commissioner for Trademarks

On Petition

Mission Pharmacal Company, Inc. has petitioned the Commissioner to withdraw a final refusal issued August 2, 1993 in connection with the above identified application. Trademark Rules 2.63(b) and 2.146(a)(3) provide authority for the requested review.

Facts

Petitioner filed the above identified application on July 22, 1992. On October 28, 1992, the Examining Attorney issued an Office action refusing registration pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). On November 12, 1992, petitioner filed a response traversing the refusal of registration. The Examining Attorney made the refusal final in an Office action dated January 5, 1993. On April 14, 1993, petitioner filed a response in which it (1) proposed an amendment to the identification of goods, and (2) further traversed the refusal of registration under Section 2(d). On June 4, 1993, the Examining Attorney issued a non-final Office action requiring further amendment of the identification of goods, and continuing the Section 2(d) refusal. On June 18, 1993, petitioner responded by complying with the requirement to amend the identification of goods. In an Office action dated August 2, 1993, the Examining Attorney notified petitioner that the amendment to the identification of goods was acceptable, and again made final the refusal of registration under Section 2(d).

On August 13, 1993, petitioner filed a notice of appeal to the Trademark Trial and Appeal Board, together with a Brief on Appeal. Concurrently, petitioner filed the instant petition. Petitioner contends that the final action dated August 2, 1993 fails to comply with Trademark Rule 2.61(a), 37 C.F.R. § 2.61(a), which provides that if an application is not entitled to registration, the applicant will be so notified and advised of the reasons therefor. Specifically, petitioner contends that the Examining Attorney failed to address its arguments that the amendment of the identification of goods obviated the refusal of registration. Petitioner requests that the Commissioner "withdraw the Final Refusal and order responsive comments, or in the

absence thereof to [sic] send the case to publication."

Decision

Pursuant to Trademark Rule 2.146(b), 37 C.F.R. § 2.146(b), "[q]uestions of substance arising during the ex parte prosecution of applications, including, but not limited to, questions arising under sections 2, 3, 4, 5, 6 and 23 of the Act of 1946, are not considered to be appropriate subject matter for petitions to the Commissioner."

This petition is inappropriate to the extent that it seeks review of the Examining Attorney's determination that there is a likelihood of confusion between petitioner's mark and the cited mark. Accordingly, petitioner's arguments as to the merits of the potential refusal of registration under 15 U.S.C. § 1052(d) shall not be addressed in this decision.

***2** The only question that can be reviewed on petition is whether the Examining Attorney acted in accordance with the Trademark Rules of Practice when he issued the final Office action dated August 2, 1993. The Commissioner will reverse the action of an Examiner 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).

In the first Office action, dated October 28, 1992, the Examining Attorney refused registration, and stated his reasons for refusal. In the Office action dated January 5, 1993, the Examining Attorney made the refusal final, further elaborating on the reasons for refusal. In its response filed April 14, 1993, petitioner raised a new issue by proposing an amendment to the identification of goods. Therefore, in accordance with established Office practice, the Examining Attorney withdrew the finality of the Section 2(d) refusal, and issued a non-final action dated June 4, 1993 addressing the proposed amendment, and continuing the Section 2(d) refusal, setting forth his reasons for continued refusal and introducing evidence in support of the refusal. [FN1] In the final action dated August 2, 1993, the Examining Attorney notified petitioner that the refusal of registration was again made final, "[f]or the reasons outlined in the office actions of June 4, 1993, January 5, 1993, and October 28, 1992."

Accordingly, the Office action dated August 2, 1993 fully complies with Trademark Rule 2.61(a), in that it notifies petitioner that registration has been finally refused and advises petitioner of the reasons for refusal.

The petition is denied. The application file will be forwarded to the Trademark Trial and Appeal Board for further action in connection with the ex parte appeal.

FN1. No refusal or requirement can be made final, even if it is a repeated refusal or requirement, unless the entire action can be made final. TMEP § 1105.04(c). See In re Abolio y Rubio S.A.C.I. y G., 24 U.S.P.Q.2d 1153 (TTAB 1992).

1993 WL 761294 (Com'r Pat. & Trademarks), 33 U.S.P.Q.2d 1060

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