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

RE: TRADEMARK APPLICATION OF GLAXO GROUP LIMITED
93-224
November 26, 1993
***1** Petition Filed: August 6, 1993

For: ARCODEX
Serial No. 74/132,345
Filing Date: January 22, 1991

Robert M. Anderson

Acting Assistant Commissioner for Trademarks

On Petition

Glaxo Group Limited has petitioned the Commissioner to withdraw its communication expressly abandoning the above identified application. Trademark Rule 2.146(a)(3) provides authority for the requested review.

Petitioner filed the subject application on January 22, 1991. On July 28, 1993, petitioner filed a communication stating that it "hereby withdraws the above referenced application pursuant to 37 C.F.R. § 2.68." This petition was filed August 6, 1993. The petition is supported by the declaration, pursuant to 37 C.F.R. § 2.20, of petitioner's attorney, who asserts that by letter dated June 28, 1993, petitioner notified counsel that it wished to withdraw the application; that by letter dated July 21, 1993 petitioner notified counsel that it had reevaluated the importance of the mark and decided to maintain the application; but that petitioner's letter of July 21, 1993 did not come to counsel's attention until after he had executed and filed the communication expressly abandoning the application on July 23, 1993.

Trademark Rule 2.68, 37 C.F.R. § 2.68, permits the abandonment of an application by the filing of a written statement of abandonment or withdrawal of the application signed by the applicant or the applicant's attorney. While the rules do not provide for the filing of a request to withdraw an express abandonment of an application, the Commissioner has the discretion to grant such a request pursuant to 37 C.F.R. § 2.146(a)(3).

In deciding whether to grant an applicant's request to withdraw an express abandonment, the interests of third parties and the administrative requirements of the Office must be considered. Third parties may have searched Office records and relied to their detriment on the express abandonment of the application, and Examining Attorneys may have conducted searches and taken actions that would be rendered inappropriate by the revival of the application. In this case, petitioner points out that the petition to withdraw the abandonment was filed before the Office had processed the communication expressly abandoning the application. However, said communication was on file, available for inspection by the public and by Office personnel.

To avoid prejudicing the rights of third parties, the Commissioner will exercise his authority to allow an applicant to withdraw an express abandonment in an ex parte case only in an extraordinary situation. [FN1] Neither the applicant's reevaluation of the importance of the mark, nor the fact that the petition was filed before the Office had formally processed the express abandonment is deemed to be an extraordinary situation.

***2** The petition is denied. The application is abandoned.

FN1. After the commencement of an inter partes proceeding, an applicant's request to expressly abandon its application, or to withdraw a request to expressly abandon an application, is handled by the Trademark Trial and Appeal Board, because such abandonment can affect the applicant's rights in the mark. 37 C.F.R. § 2.135.

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