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

RE: TRADEMARK APPLICATION OF DIRECT ACCESS COMMUNICATIONS (M.C.G.) INC.
93-218
November 16, 1993
***1** Petition Filed: July 7, 1993

For: PHYSICIANS' HOTLINE
Serial No. 74/234,484
Filing Date: December 27, 1991

Robert M. Anderson

Acting Assistant Commissioner for Trademarks

On Petition

Direct Access Communications (M.C.G.) Inc. has petitioned the Commissioner to lift the suspension of the above identified application. Trademark Rule 2.146(a)(3) provides authority for the petition.

Facts

Petitioner filed the subject application on December 27, 1991. On April 7, 1992, the Examining Attorney issued an Office action notifying petitioner that an application with an earlier filing date, Serial No. 74/054,647, was pending before the Office; that there may be a likelihood of confusion between applicant's mark and the referenced mark; and that, if the referenced application matures into registration, the Examining Attorney may refuse registration pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

On October 7, 1992, petitioner filed a response to the Office action, arguing that there is no likelihood of confusion between its mark and the mark that is the subject of Application Serial No. 74/054,647. On November 13, 1992, the Examining Attorney suspended petitioner's application pending the disposition of Application Serial No. 74/054,647. On March 30, 1993, petitioner submitted a request for withdrawal of the application from suspension, with additional arguments as to the likelihood of confusion between the marks. On May 11, 1993, the Examining attorney notified petitioner that its arguments had been considered but not deemed persuasive, and that the application would remain suspended. This petition was filed July 7, 1993.

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 mark shown in Application Serial No. 74/054,647. 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. [FN1]

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 suspended the application. 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).

***2** The suspension of applications for conflicting marks is governed by Trademark Rule 2.83, 37 C.F.R. § 2.83, which provides, in pertinent part:

(a) Whenever an application is made for registration of a mark which so resembles another mark or marks pending registration as to be likely to cause confusion or mistake or to deceive, the mark with the earliest effective filing date will be published in the Official Gazette for opposition if eligible for the Principal Register, or issued a certificate of registration if eligible for the Supplemental Register....

(c) Action on the conflicting application which is not published in the Official Gazette for opposition or not issued on the Supplemental Register will be suspended by the Examiner of Trademarks until the published or issued application is registered or abandoned.

In this case, since the filing date of Application Serial No. 74/054,647 preceded the filing date of petitioner's application, the application was properly suspended, pursuant to Trademark Rule 2.83(c) and TMEP § 1108.01. See In re Hamilton Bank, 222 USPQ 174 (TTAB 1984); In re Mercedes Slacks, Ltd., 213 USPQ 397 (TTAB 1982). Petitioner filed a request to remove the application from suspension on March 30, 1993. The record indicates that the Examining Attorney considered petitioner's arguments, but did not find them to be persuasive. Under these circumstances, the appropriate course of action was the issuance of a new suspension notice. TMEP § 1108.02.

The petition is denied. The application remains suspended.

FN1. If a refusal of registration under Section 2(d) is issued and then made final, applicant's remedy is the filing of an appeal to the Trademark Trial and Appeal Board.

30 U.S.P.Q.2d 1393

END OF DOCUMENT