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

RE: TRADEMARK APPLICATION OF COMPUTER REFERENCE PRODUCTS-US, INC.
92-349
February 2, 1993
***1** Petition Filed: June 16, 1992 [FN1]

For: COMPUTER REFERENCE PRODUCTS
Serial No. 74/143,819
Filing Date: March 4, 1991

Robert M. Anderson

Acting Assistant Commissioner for Trademarks

On Petition

Computer Reference Products-US, Inc. has petitioned the Commissioner to reinstate the above identified application. Trademark Rule 2.146(a)(3) provides authority for the requested review.

Facts

Petitioner filed the application on March 4, 1991. An Office action was issued June 24, 1991, in which (1) registration was refused pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that the proposed mark is merely descriptive of the goods; and (2) applicant was required to amend the identification of goods.

On November 29, 1991, petitioner filed an Amendment to Allege Use, pursuant to 37 C.F.R. § 2.76. Neither the Amendment to Allege Use nor the accompanying transmittal letter made any reference to the outstanding Office action. However, in the body of the Amendment to Allege Use, petitioner requested registration on the Supplemental Register, and adopted the identification of goods that had been suggested by the Examining Attorney in the Office action. On January 15, 1992, the Examining Attorney approved the Amendment to Allege Use.

On May 9, 1992, the Examining Attorney declared the application to be abandoned, effective December 25, 1991, for failure to respond to the Office action. Section 12(b) of the Trademark Act, 15 U.S.C. § 1062(b); 37 C.F.R. § 2.65(a).

This petition was filed June 16, 1992. Petitioner asserts that a response to the outstanding Office action was incorporated into the Amendment to Allege Use, in that it responded to the Section 2(e)(1) refusal by amending to the Supplemental Register, and responded to the requirement for amendment of the identification of goods by adopting the identification suggested by the Examining Attorney.

Decision

This matter is deemed appropriate for petition because the abandonment of an application is an issue of administrative practice and procedure.

Trademark Rule 2.146(a)(3) permits the Commissioner to invoke 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 Company, 142 USPQ 278 (Comm'r Pats.1964).

Trademark Rule 2.76, 37 C.F.R. § 2.76, provides for the filing of an Amendment to Allege Use in an application based upon the applicant's bona fide intention to use a mark in commerce, pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). Trademark Rule 2.76(f) states that the filing of an Amendment to Allege Use shall not constitute a response to an outstanding Office action. However, as petitioner correctly notes, the rule does not prohibit incorporation of a response to an Office action into an Amendment to Allege Use. While the Office prefers that an Amendment to Allege Use be filed in aseparate paper, this is not required.

***2** Although not in the preferred form, petitioner's Amendment to Allege Use did in fact incorporate a complete response to the Office action dated June 24, 1991. The Examining Attorney clearly erred in declaring the application to be abandoned.

The petition is granted. The application is reinstated.

Because the petition was necessitated by an Office error, the petition fee required by Trademark Rule 2.6(a)(15) is waived and will be refunded in due course.

FN1. The petition was perfected by payment of the fee, required under Trademark Rule 2.6(a)(15), on November 10, 1992.

30 U.S.P.Q.2d 1389

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