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

RE: TRADEMARK APPLICATION OF LEGENDARY, INC.
92-203
September, 30, 1992
***1** Petition Filed: July 16, 1992

For: $UCCESS
Serial No. 74/179614
Filing Date: June 25, 1991

Attorney for Petitioner

William D. Breneman

Breneman & Georges

Jeffrey M. Samuels

Assistant Commissioner for Trademarks

On Petition

Legendary, Inc., through its attorney, William D. Breneman, 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. Counsel further requests reconsideration of the Managing Attorney's refusal of his request to withdraw as attorney of record. Trademark Rule 2.146(a)(3) provides authority for the requested review.

Facts

Applicant filed this application on June 25, 1991, with a power of attorney appointing Mr. Breneman to prosecute the application. An Office action was mailed November 7, 1991. Pursuant to Section 12(b) of the Trademark Act, a response was due on or before May 7, 1992.

On May 7, 1992, counsel filed a "Response to November 7, 1991 Office Action," in which he stated that he was concurrently filing a request to withdraw as counsel; that he had tried numerous times to contact applicant to receive instructions regarding a response to the Office action; that applicant had not contacted him since December of 1991; and that consequently he had not been able to obtain the authorization and instructions necessary to respond to the Office action. Counsel requested that a further Office action be issued and sent directly to applicant.

Concurrently, on May 7, 1992, counsel filed a Request to Withdraw as Counsel, in which he stated that due to a breakdown in communications

with applicant it was necessary to withdraw as counsel; that he had attempted to contact applicant by telephone and by mail since January 21, 1992; that his telephone calls were not returned; that no response to written correspondence was received; and that he had received no instructions for responding to the Office action.

In an Office action mailed June 17, 1992, the Examining Attorney notified applicant that the response filed May 7, 1992 was deemed incomplete, because it did not respond to the issues raised in the Office action, and that the application was abandoned, pursuant to 37 C.F.R. § 2.65.

In another letter dated June 17, 1992, the Managing Attorney denied counsel's request to withdraw as attorney of record, because (1) the request to withdraw did not include a statement that the applicant had been given due notice of the withdrawal from employment; (2) the request did not include a statement that all papers and property in the attorney's file concerning the prosecution of the application had been delivered to the applicant; and (3) there was insufficient time before the expiration date of the response period for the applicant to obtain other representation.

***2** This petition was filed July 16, 1992. Petitioner contends that the response filed May 7, 1992 is complete because it provides counsel's reason for withdrawing and responds to the Office action to the best of counsel's ability. Counsel asserts that applicant would not return his phone calls due to a complete breakdown in communications; that applicant would not indicate which amendments should be made to the application; and that counsel had no alternative but to file a response which was "as complete as possible under the circumstances," and to request withdrawal as attorney of record.

Counsel further requests reconsideration of his request to withdraw as attorney of record. In a document entitled "Supplement to Withdraw as Counsel," he asserts that copies of all papers were supplied to the applicant soon after they were filed or received from the Office, and that copies of all papers and property concerning the prosecution of the application were again made and delivered to applicant by Federal Express on June 24, 1992.

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.

Pursuant to Section 12 of the Trademark Act, 15 U.S.C. § 1062, an applicant must respond to an Office action within six months of the mailing date in order to avoid abandonment. Under Rule 2.65(a), 37 C.F.R. § 2.65(a), an application is deemed abandoned when an applicant's response, although received within the six months' response

period, is incomplete or insufficient, and thus not responsive to the Office action. Trademark Manual of Examining Procedure (TMEP) § 1112.02(a).

In its response filed May 7, 1992, petitioner addressed none of the issues raised in the Office action. It merely detailed a "breakdown in communications" between applicant and its attorney, and requested issuance of a new Office action. This is not a proper response to an Office action. The Examining Attorney correctly concluded that the response was incomplete, pursuant to Trademark Rule 2.65(a).

The denial of counsel's request to withdraw as attorney of record was also proper. Pursuant to Trademark Rule 2.19(b), 37 C.F.R. § 2.19(b), an individual authorized to represent an applicant in a trademark case may withdraw upon application to and approval by the Commissioner. However, Rule 10.40(a), 37 C.F.R. § 10.40(a), provides that a practitioner shall not withdraw from employment until the practitioner has taken reasonable steps to avoid forseeable prejudice to the rights of the applicant. Therefore, any request to withdraw as counsel must be accompanied by (1) a statement of the reasons for the request for withdrawal; (2) a statement that the attorney has given the applicant due notice of the withdrawal from employment; and (3) a statement that the attorney has delivered to the applicant all papers and property in the attorney's file concerning the prosecution of the application. To avoid prejudice to the applicant, the Office normally denies any request for withdrawal if there is less than 30 days remaining in the period for response to an outstanding Office action, so the applicant will have sufficient time to obtain new counsel. TMEP § 602.03(a).

***3** In this case, the request to withdraw was not filed until the last day of the period for response to the Office action, and counsel stated neither that the applicant was given due notice of counsel's withdrawal from employment, nor that he had delivered to the applicant all papers and property in his file concerning the prosecution of the application. The request for withdrawal was properly denied. It would be patently unfair to applicant to permit counsel to cure the defects in his request for withdrawal after the abandonment of the application.

The petition is denied. The application was properly abandoned.

26 U.S.P.Q.2d 1478

END OF DOCUMENT