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

RE: TRADEMARK REGISTRATION OF UMAX DATA SYSTEM, INC.
95-514
September 9, 1996
***1** Petition Filed: August 31, 1995

For: UMAX (Stylized)
Registration No. 1,614,692
Issued: September 25, 1990

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Assistant Commissioner for Trademarks

On Petition

Umax Data System, Inc. has petitioned the Commissioner to reverse the decision of the Post Registration Examiner refusing to accept an amendment, pursuant to Section 7(e) of the Trademark Act, 15 U.S.C. § 1057(e), of the mark in the above-identified registration. Trademark Rules 2.146(a)(2) and 2.176 provide appropriate authority for the requested review.

Facts

In a letter mailed August 9, 1995, the Post Registration Examiner refused to accept the proposed amendment on the ground that it constituted a material alteration of the mark as registered. The original mark and the proposed amended mark are shown below:



Mark as Registered



Proposed Amended Mark

Analysis and Decision

Trademark Act § 7(e), 15 U.S.C. § 7(e), provides, in part, "the Commissioner for good cause may permit any registration to be amended ... Provided, That the amendment ... does not alter materially the character of the mark." The Act does not state any other standard related to the amendment of marks; "material alteration" is the standard for evaluating amendments to marks at all relevant stages of processing, during examination of the application and after registration. See 37 C.F.R. § § 2.72 and 2.173, TMEP § § 807.14(a), 1603.10 and 1605.08.

When an Examining Attorney refuses to allow an amendment to a mark in an application, the Applicant may appeal to the Trademark Trial and Appeal Board. See Sections 12(b) and 20 of the Act of 1946, 15 U.S.C. § § 1062(b), and 1070; 37 CFR § § 2.141, and 2.142; and TBMP chapter 1200. In determining an ex parte appeal, the Board reviews the appealed decision of an Examining Attorney to determine if it was correctly made. TBMP § 1217.

By contrast, under Trademark Rules 2.146(a)(2) and 2.176, a Registrant may petition the Commissioner for review of an adverse action on a request for amendment of a registration pursuant to Section 7. However, in the past, the Commissioner has reversed the action of a Post Registration 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** Consequently, the adverse action of a Post Registration Examiner on a request for amendment of a registration pursuant to Section 7 has been subject to a different standard of review than an Examining Attorney's final refusal to allow an amendment to a mark in an application. However, since the standards for determining the propriety of amendments to marks are the same for registrations and applications, the Commissioner believes that a Registrant whose amendment has been refused is entitled to the same standard of review that is available to an Applicant who seeks to amend a mark in an application. Henceforth, in deciding a petition to review the adverse decision of an Examiner on a proposed amendment to a registered mark under Section 7 of the Trademark Act, the Commissioner will review the decision to determine whether it was a correct one. To the extent that they state that the Commissioner will reverse an Examiner's decision on a Section 7 amendment only for clear error or abuse of discretion, In re Richards-Wilcox Manufacturing Co., 181 USPQ 735 (Comm'r Pats. 1974) and Ex parte Peerless Confection Co., 142 USPQ 278 (Comm'r Pats. 1964) are overruled.

The general test of whether an alteration is material is whether the mark would have to be republished after the alteration in order to fairly present the mark for purposes of opposition. If one mark is sufficiently different from another mark as to require republication, it is tantamount to a new mark appropriate for a new application. In re Wine Society of America Inc., 12 USPQ2d 1139 (TTAB 1989); In re Nationwide Industries Inc., 6 USPQ2d 1882 (TTAB 1988) In re Pierce Foods Corp., 230 USPQ 307 (TTAB 1986); Visa International Service

Association v. Life-Code Systems, Inc., 220 USPQ 740 (TTAB 1983); In re E.M. Townsend & Co., 143 USPQ 318 (Comm'r Pats. 1964).

In this case, the Petitioner seeks to amend the mark by minimally changing the stylization of the term UMAX. The nature of the proposed change is such that the commercial impression of the modified mark is essentially the same as that of the original mark.

The petition is granted. The registration file will be returned to the Post Registration Section for further processing.

40 U.S.P.Q.2d 1539

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