

Re: Trademark Applications of :  
Pepi Gramshammer :  
  
Serial No. 74-638317 :  
Filing Date: February 24, 1995 : On Petition  
For: TWIN ELK and Design :  
  
Serial No. 74-678950 :  
Filing Date: May 18, 1995 :  
For: MISCELLANEOUS DESIGN :  
  
Petitions Filed: March 24, 1997<sup>1</sup> :

Pepi Gramshammer, an individual, has petitioned the Commissioner to permit amendment of the Statements of Use filed in the above-identified applications. The petitions are denied under Trademark Rule 2.146.

## **FACTS**

Both of the above-identified trademark applications were filed under Section 1(b) of the Trademark Act, 15 U.S.C. §1051 (b). A Notice of Allowance issued in each case. on December 3, 1996, Petitioner filed a Statement of Use (SOU) for each of the applications.

The applications were handled by two Examining Attorneys. However, in office actions dated February 9, 1997, and February 26, 1997, respectively, each Examining Attorney noted that Petitioner had expressly deleted goods from the application. The Examining Attorneys further noted that the specimens of use provided with the SOUs did not match the goods remaining in the application. Therefore, each Examining Attorney issued a non-FINAL action requiring Petitioner to provide substitute specimens of use supporting use for the remaining goods. This petition followed.

## **ANALYSIS**

### ***Waiver of Trademark Rule 2.63(b)***

Pursuant to Trademark Rules 2.63(b) and 2.146(a)(1), 37 C.F.R. §§2.63(b) and 2.146(a)(1), an Applicant may petition the Commissioner for relief from a formal requirement of an Examining Attorney, if the Examining Attorney's action is: (1) repeated or made final, and (2) such action is limited to subject matter appropriate for petition to the Commissioner. In this case, the Examining

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<sup>1</sup> Since the issue on petition is identical for each of the above-identified applications, the petitions have been consolidated for review.

Attorney, if the Examining Attorney's action is: (1) repeated or made final, and (2) such action is limited to subject matter appropriate for petition to the Commissioner. In this case, the Examining Attorneys' requirements for substitute specimens have neither been repeated nor made final.<sup>2</sup> Therefore, under both Rules 2.63(b) and 2.146(a)(1), the petitions could be considered to be premature.

In the cases on petition, Petitioner argues that permission to amend the identifications would obviate the need for substitute specimens. Further, Petitioner states that the Examining Attorneys erred as a matter of procedure by not inquiring about the discrepancy between the goods and services in the Statements of Use and those contained in the Notices of Allowance, as required under TNIEP §1105.05 (f)(iv). Thus, the real issue is an issue of administrative procedure, which is ripe for consideration on petition and which is appropriate subject matter for review by the Commissioner. *In re Tetrafluor Inc.*, 17 USPQ2d 1160 (Comm'r Pats. 1990). Therefore, the requirement of Rule 2.63(b) that the Examining Attorney's action be repeated or made final is waived so that the true issue of alleged procedural error may be considered.

### ***Amendment Not Permissible***

The identifications in each case cannot be amended to restore the goods and services which were deleted.

Section 1(d)(1) of the Trademark Act requires that the Statement of Use include a verified statement specifying those goods or services in the Notice of Allowance on or in connection with which the mark is used in commerce. The form used by Petitioner to file the Statement of Use is explicit. Petitioner typed the goods and services to be deleted directly after a phrase stating:

“Those goods/services identified in the Notice of Allowance in this application except: (Identify goods/services to be deleted from application).” Even if the form was completed in error, Petitioner deleted the goods and services for which restoration is requested, because the goods and services identified in the SOU are those expressly designated for deletion and are contained within the four corners of the Statement of Use form signed by the Petitioner.

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2 Under Trademark Rule 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. “ A requirement for substitute specimens is considered substantive, pursuant to Sections 1, 2 and 45 of the Trademark Act. Therefore, a requirement for substitute specimens is properly reviewed by the Trademark Trial and Appeal Board, and is not appropriate subject matter for petition. *In re Direct Access Communications (M. C. G) inc.*, 30USPQ2d 1393 (Comm'r Pats. 1993); *InreHart*, 199USPQ 585 (Comm'r Pats. 1978).

In the cases on petition, the subject matter is considered appropriate for review because Petitioner is really requesting permission to amend the identification of goods and services, claiming that the Examining Attorneys erred procedurally in not providing Petitioner the opportunity to clarify his intention with respect to the goods and services for which he was filing his Statements of Use.

## DECISION

The petitions are denied. The application files will be returned to the respective Examining Attorneys for review of Petitioner's correspondence of August 6, 1997, filed via facsimile transmission, and August 11, 1997<sup>3</sup>.

Philip G. Hampton, II  
Assistant Commissioner  
for Trademarks

PGH:EKM  
Date:

Attorney for Petitioner:

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<sup>3</sup> As of the date of this decision, the August 11, 1997 correspondence appears to have been filed only with respect to application Serial No. 74-638317.