

Re: Trademark Application of

Paul H. Wilcox

Serial No. 74/671895

On Petition

Filing Date: May 8, 1995

For: TERRALINK

Petition Filed: August 28, 1996

Paul H. Wilcox has petitioned the Commissioner to withdraw his communication expressly abandoning the above-identified application. The petition is denied under Trademark Rules 2.146(a)(3) and 2.148.

### FACTS

On June 13, 1996, Applicant filed a "Notification of Express Abandonment." The notification read, in relevant part: "Please be advised that Applicant hereby expressly abandons the above-referenced Intent To Use application to register the service mark TERRALINK."

The application was abandoned by the Examining Attorney, effective June 13, 1996. This petition followed.

### DECISION

In a verified statement, Petitioner's counsel details the negotiations between Petitioner and a California corporation, Cyberports, Inc., which led to Petitioner's express abandonment of the application. Evidently, Cyberports, Inc. was interested in changing its name to "TERALINX" and was concerned about the potential obstacle presented by Petitioner's outstanding trademark application for the mark "TERRALINK." After several weeks of negotiations, Petitioner agreed to receive 10,500 shares of Teralinx, Inc. (formerly Cyberports, Inc.) stock, in exchange for expressly abandoning the "TERRALINK" trademark application. On June 6, 1996, Petitioner's counsel received a certificate for 10,500 shares of stocks in Teralinx Corp. On June 13, 1996, as agreed, Petitioner filed a "Notification of Express Abandonment."

On July 8, 1996, Petitioner's counsel received a letter dated June 25, 1996, from counsel to Teralinx, Inc. The letter stated that Teralinx had declared itself insolvent and would cease all business operations no later than June 28, 1996.

Petitioner requests relief from the consequences of an unfortunate business decision. In petitioning the Commissioner to exercise his authority under Rule 2.146, counsel for Petitioner emphasizes that Petitioner had no basis for doubting the representations made to him in apparent good faith by counsel to Teralinx, and had no reason to suspect that Teralinx was near insolvency at the time the shares of stock were offered to him as adequate consideration for his abandonment of the TERRALINK application.

Counsel seeks to distinguish the facts of this Petition from those presented in *In re Glaxco*, 33

USPQ2d 1535 (Comm'r Pats. 1993). In *Glaxo*, Petitioner notified counsel that it wished to withdraw the application. Petitioner subsequently reevaluated the importance of the mark and decided to maintain the application. By that time, however, Petitioner's counsel had already executed and filed the communication expressly abandoning the application. The petition was denied, because neither the Applicant's reevaluation of the importance of the mark, nor the fact that the petition was filed before the Office had formally processed the express abandonment was deemed to be an extraordinary situation.

Petitioner's counsel argues that the request to withdraw the express abandonment does not involve a purely arbitrary afterthought as in *Glaxo*.

While, on a superficial level, the facts in this case are easily distinguishable from those of *Glaxo*, their essence is identical. Both cases involve the interests of third parties and the administrative requirements of the Office. The Office records in fact indicate that the present application is abandoned. Thus, third parties may already have searched Office records and relied, to their detriment, on the express abandonment of the application. In addition, Examining Attorneys may have conducted searches and taken actions that would be rendered inappropriate by the revival of this application.

While it is not the place of the U. S. Patent and Trademark Office to pass judgment on the wisdom of business transactions, it is the responsibility of the Commissioner to ensure that the exceptions provided for in Rules 2.146 and 2.148 are used appropriately. In this instance, there exists no extraordinary situation to justify exercise of the Commissioner's powers under Rules 2.136(a)(5) and 2.148. Additionally, the Petitioner is not without a remedy. He can simply re-apply for registration of the proposed mark.

The petition is denied. The application will remain abandoned. The \$100 filing fee for the extension request will be refunded in due course.

Philip G. Hampton, II  
Assistant Commissioner  
for Trademarks

PGH:NLO:EKM

Date:

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