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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
OFFICE OF ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 Crystal Drive
Arlington, Virginia 22202-3513

98-541

Re: Trademark Application of :
Andre Romanelli, Inc. :
Serial No. 74/692688 :
Filing Date: June 23, 1995 : On Petition
For: MARIO RINALDI :
Petition Filed: June 19, 1998 :

Andre Romanelli, Inc. (“Petitioner”) has petitioned the Commissioner to restore jurisdiction to the Examining Attorney, for the purpose of reopening prosecution of the above-referenced application. The petition is denied under 37 C.F.R. §2.142(g).

FACTS

The above-identified application for registration was filed on June 23, 1995. In an Office Action dated October 13, 1995, the Examining Attorney refused registration under 15 U.S.C. §1051(d), because the mark was likely to be confused with the mark in U.S. Registration No. 678,511 (the “cited registration”).¹

Eventually, the Examining Attorney issued a final refusal, and Petitioner filed an appeal with the Trademark Trial and Appeal Board (the “Board”). On May 1, 1998, the Board issued its order, affirming the refusal to register under 15 U.S.C. §1051(d). On May 14, 1998, Petitioner filed a Request for Reconsideration with the Board. Unpersuaded by Petitioner’s additional evidence and argument, the Board reiterated its affirmance of the refusal on May 27, 1998. This petition followed.

Petitioner’s Argument

Petitioner asserts that the basis for this petition is “the probably [sic] abandonment of the cited registration and the attendant result that applicant is entitled to registration” as implied by a “self-explanatory Industrial Investigator’s Report,” which accompanied this petition.

¹ In the same Office Action, the Examining Attorney also required that, if the subject mark identified a particular living individual, a written consent of record be furnished.

Petitioner also indicated that in seeking to reopen this application, Petitioner wished to file a petition to cancel the registration within a specified period of time.

ANALYSIS

The regulatory requirements for reopening an application under 37 C.F.R. §2.142(g) are set forth as follows:

An application which has been considered and decided on appeal will not be reopened except for the entry of a disclaimer under §6 of the Act of 1946 or upon order of the Commissioner, but a petition to the Commissioner to reopen an application will be considered only upon a showing of sufficient cause for consideration of any matter not already adjudicated.

Petitions to reopen applications are denied when reopening prosecution would require additional examination in order to determine suitability for registration. *See Ex parte Helene Curtis Industries, Inc.*, 134 USPQ 73 (Comm'r Pats. 1962); *Ex parte Simoniz Co.*, 161 USPQ 365 (Comm'r Pats. 1969); and *In re Mack Trucks, Inc.*, 190 USPQ 642 (Comm'r Pats. 1976).

However, petitions to reopen prosecution of applications have been granted when an amendment would place the application in condition for publication subject only to an updating search, and no other examination would be required on the part of the Examining Attorney. *See In re Hickory Mfg. Co.*, 183 USPQ 789 (Comm'r Pats. 1974)(Reopening of application permitted for entry of a disclaimer which the Examining Attorney had previously required.)

Petitioner's information about possible nonuse of the mark in the cited registration and Petitioner's apparent intention to file a petition to cancel the cited registration do not constitute sufficient cause for consideration of a matter not already adjudicated. The filing of a petition to cancel does not place the application in condition for publication because the cancellation would have to be completed with a decision favorable to Petitioner before the refusal to register could be withdrawn. *See generally In re Vycom Electronics Ltd.*, 21 USPQ2d 1799 (Comm'r Pats. 1986).

Further, during the pendency of the application before the Examining Attorney, Petitioner could have elected to file a petition to cancel the cited registration and to request suspension of further action on its application. TMEP §1108.01. Instead, Petitioner elected to file an *ex parte* appeal and pursue it to a final decision by the Board. 37 C.F.R. §2.142(g) was not intended to permit an applicant to pursue the procedural alternative of a cancellation proceeding after the Board has finally disposed of an application by a decision adverse to the applicant on an *ex parte* appeal. *See In re Vycom Electronics Ltd.*

DECISION

The petition is denied. The application will be abandoned in due course.

Robert M. Anderson
Deputy Assistant Commissioner
for Trademarks

Date:

RMA:SLC

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