97-254

Re: Trademark Application of	:	
Winner International Royalty Corporation	:	
Application No. 75-082025	:	
Filing Date: April 1, 1996	:	On Petition
For: AMERICA'S FAVORITE	:	
Petition Filed: March 24, 1997	:	

Winner International Royalty Corporation has petitioned the Commissioner to accept its claim of acquired distinctiveness under Section 2(f) filed in connection with the above-identified application. The petition is denied under Trademark Rule 2.146(b) as inappropriate subject matter for a petition to the Commissioner.

FACTS

Petitioner is the owner of U.S. Registration No. 1,791,096, on the Supplemental Register, for the mark "AMERICA'S FAVORITE" for "anti-theft steering wheel lock for motor vehicles made primarily of metal." On April 1, 1996, Petitioner filed the above-identified application, for the same goods, this time seeking registration on the Principal Register. In the application, Petitioner included a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f).

The Examining Attorney refused registration under Section 2(e)(1), 15 U.S.C. §1052(e)(1), arguing that the proposed mark was "merely lauditorily descriptive." Petitioner responded on October 3, 1996, indicating that the Examining Attorney improperly rejected Petitioner's 2(f) claim based on five years of substantially continuous and exclusive use of the mark in commerce. The Examining Attorney issued a FINAL refusal on November 13, 1996. Petitioner filed a request for reconsideration on December 12, 1996. The Examining Attorney maintained the finality of the FINAL refusal in an Office Action dated February 13, 1997. This petition followed.

ANALYSIS

Pursuant to Trademark Rule 2.63(b), 37 C.F.R. §2.63(b), an Applicant may file a timely petition to the Commissioner for relief from a formal requirement if the Examiner's action is made FINAL and such action is limited to subject matter appropriate for petition to the Commissioner.

However, 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 refusal to register under Section 2(e)(1) is a substantive refusal. The Examining Attorney's rejection of Petitioner's claim of acquired distinctiveness under Section 2(f) is also a substantive issue because it goes directly to the refusal under Section 2(e)(1). The appropriate course of action for the Petitioner was to file an appeal with the Trademark Trial and Appeal Board. 37 C.F.R. §2.64(a).

DECISION

Although the Office Action of November 13, 1996 was a FINAL refusal, the Office Action of February 13, 1997 also contains a six-month response clause. Therefore, Petitioner has the remainder of the six-month period from issuance of the February 13, 1997 Office Action in which to either: (1) file an appeal to the Trademark Trial and Appeal Board or (2) comply, if feasible, with any outstanding requirements.

The application file will be returned to the Law Office 104 Awaiting Response docket.

Philip G. Hampton, II
Assistant Commissioner
for Trademarks

PGH:EKM

Date:

Attorney for Petitioner:

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