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

RE: TRADEMARK APPLICATION OF VESPER CORPORATION
Serial No. 193,628
August 23, 1988
***1** Petition Filed: January 4, 1988

For: Miscellaneous Design
Filed: November 17, 1978

Attorney for Petitioner:

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Assistant Commissioner for Trademarks

On Petition

Vesper Corporation [FN1] has petitioned the Commissioner to reopen prosecution of the above-identified application in order to amend the description of the mark and enter a disclaimer. Petitioner cites Trademark Rule 2.142(g), 37 C.F.R. 2.142(g), as authority for this request.

FACTS

Petitioner filed the subject application to register a design configuration for steel plate, on November 17, 1978. The Examining Attorney refused registration on the ground that the design for which registration was sought was a configuration which is functional and that registration was barred under the doctrine of res judicata, since the United States District Court for the District of Columbia held in Alan Wood Steel Company v. Watson, Comr. Pats., 113 USPQ 311 (D.D.C. 1957), that the Patent and Trademark Office had properly denied registration of the same mark to petitioner in Ex parte Alan Wood Steel Co., 101 USPQ 209 (Comm'r Pats. 1954).

Upon appeal by the petitioner to the Trademark Trial and Appeal Board, the refusal was withdrawn by an Examining Attorney to whom jurisdiction of the case was returned to consider whether the mark had acquired distinctiveness as applied to the goods. Pursuant to petitioner's claim of acquired distinctiveness under Section 2(f) of the Trademark Act, the mark was published in the Trademark Official Gazette on February 14, 1984. The application contained a statement that the mark consists of 'projections in the form of diamonds set normally to one another in alternating patterns' and a disclaimer of the representation of a steel plate apart from the mark as shown. Registration was opposed by Eastmet Corporation and Lukens, Inc. [FN2]

In its opposition proceeding, Lukens, Inc. moved for summary judgment on the ground that petitioner was collaterally estopped by the prior decisions of the Patent and Trademark Office and the District Court for the District of Columbia from denying that the configuration is functional as a matter of law. The motion for summary judgment was granted, the opposition sustained and registration refused. Lukens Inc. v. Vesper Corporation, 1 U.S.P.Q.2d 1299 (TTAB 1986). The refusal was affirmed by the Court of Appeals for the Federal Circuit in an unpublished decision on September 18, 1987. Petitioner's petition for rehearing was denied on October 19, 1987 and its suggestion for rehearing en banc was declined on November 3, 1987. Petitioner filed this petition on January 4, 1988.

A Supplement to the Petition, filed January 11, 1988, requests that the description of the mark be changed and a disclaimer entered as follows:

***2** --The mark consists of a fanciful diamond silhouette in a repeating pattern on the surface of a metal plate. No claim is made to the exclusive right to use of the repeating pattern with a different silhouette.--

DECISION

The basis for petitioner's request is inapproriate. Rule 2.142 concerns matters in an ex parte appeal to the Trademark Trial and Appeal Board. Rule 2.142(g) provides:

An application which has been considered and decided on appeal will not be reopened except for the entry of a disclaimer under Section 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.

This application was involved in an inter partes proceeding rather than an ex parte proceeding in which the Trademark Trial and Appeal Board affirmed a refusal to register. The refusal to register herein is based on a successful opposition. Petitioner appealed the decision of the Board to the Federal Circuit, which affirmed the Board's decision and denied petitioner's request for rehearing. Petitioner has cited no authority that would permit the Commissioner to reopen an application after a final decision of the Federal Circuit. [FN3]

Regarding appeal to the U.S. Court of Appeals for the Federal Circuit, Section 21 of the Trademark Act, 15 U.S.C. § 1071(a)(4) provides as follows:

The court shall decide such appeal on the evidence produced before the Patent and Trademark Office. The court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent and Trademark Office and govern further proceedings in the case.

In this case, the granting by the Trademark Trial and Appeal Board of the opposer's motion for summary judgment was affirmed by the Court of Appeals for the Federal Circuit in a judgment which was issued as a

mandate on November 3, 1987. Receipt of the mandate by the Patent and Trademark Office terminated proceedings in the case. See In re Jones, Laskin, and Sokol, 191 USPQ 249 (CCPA 1976).

The petition is denied.

FN1. Petitioner's change of name from Alan Wood Steel Company to Vesper Corporation was recorded in the Assignment Division of the Patent and Trademark Office on May 14, 1982 at Reel 415, Frame 606.

FN2. Eastmet Corporation filed Opposition No. 69,115 on April 11, 1984. Lukens, Inc. filed Opposition No. 69,116 on April 16, 1984. Action on Opposition No. 69,115 was suspended on March 27, 1986 pending the disposition of Lukens, Inc.'s motion for summary judgment.

FN3. Even if petitioner's request was properly before the Commissioner pursuant to Trademark Rule 2.142(g), it would be denied because the proposed amendment presenting a new description of the mark would require consideration by the Examining Attorney. See Ex parte Helene Curtis Industries, Inc., 134 USPQ 73 (Comm'r Pats. 1962); Ex parte Simoniz Company, 161 USPQ 365 (Comm'r Pats. 1969); In re Mack Trucks, Inc., 189 USPQ 642 (Comm'r Pats. 1976). Petitions to reopen prosecution are only granted when the 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).

8 U.S.P.Q.2d 1788

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