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

RE: TRADEMARK APPLICATION OF TETRAFLUOR, INC.
Serial No. 73-761,898
January 3, 1990
***1** Petition Filed: June 5, 1989

For: SEALS
Filed: November 4, 1988

Attorney for Petitioner

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Assistant Commissioner for Trademarks

On Petition

Tetrafluor, Inc. has petitioned the Commissioner to request an order reversing the refusal of the Examining Attorney to accept an amendment to the drawing in the referenced application. The petition will be reviewed under Trademark Rules 2.146(a)(3), 2.146(a)(5), and 2.148.

FACTS

On November 4, 1988, petitioner filed application papers seeking registration of the mark DITHERSEAL, for "seals" in International Class 17. The specimens filed with the application papers show use of this mark. However, the mark shown on the drawing sheet filed with the application papers and specimens consists solely of the single typed word SEALS.

In the initial Office action, the Examining Attorney refused registration of the mark SEALS pursuant to Sections 1, 2, and 45 of the Trademark Act, 15 U.S.C. § § 1051, 1052, and 1127, because the mark shown on the drawing sheet was deemed not to function as a mark and to be the name of the goods. The initial action also noted that the mark shown on the drawing sheet, i.e., SEALS, did not match the mark shown on the specimens, i.e., DITHERSEAL. Petitioner was informed that it would not be permitted to amend the mark on the drawing sheet from SEALS to DITHERSEAL because the character of the mark would be materially altered.

Petitioner responded to the initial Office action by asserting that the mark which it actually seeks to register is DITHERSEAL, and by noting that this is the mark listed in the application papers,

illustrated by the specimens, and referred to by both the transmittal letter and acknowledgment card transmitted with the application. Petitioner then asserted that "[e]ven the most unititated [sic] would certainly and readily see that a typographical error was made in secretarial preparation of the drawing sheet...." Amendment of the drawing sheet to show the mark as DITHERSEAL was requested.

The Examining Attorney thereafter issued a second action, which pointed out that the proffered amendment to the drawing of the mark was unacceptable, because it sought to substitute "a completely different mark" for the mark shown on the original drawing sheet. The refusal to register the mark SEALS was also renewed in the second Office action, which was made final. The instant petition followed.

DECISION

1. The Propriety of the Instant Petition

Petitioner's response to the initial Office action was titled "Amendment or in the Alternative Petition to the Commissioner" and was processed by the Examining Attorney as an amendment and response to the Office action. The Examining Attorney informed petitioner that, at that time, the filing of a petition to the Commissioner was premature. After the final refusal was issued, the instant petition was filed on June 5, 1989. Petitioner then filed, on October 13, 1989, a document titled "Inquiry About Status of Application and Further Response to Office Action Dated 5/18/89," which is construed as a filing supplemental to the petition.

***2** This petition is inappropriate to the extent that it seeks the Commissioner's review of a substantive matter, i.e., either the Section 2 refusal to register or the Examining Attorney's determination that the proffered amendment of the drawing would constitute a material alteration. This is true regardless of whether the petition was filed after the initial or the final Office action. See 37 CFR § 2.146(b); In re Hart, 199 USPQ 585 (Comm'r Pats.1978).

However, petitioner herein is questioning substantive matters only to the extent that it asserts that neither the Act nor the Rules should be construed to preclude correction of an allegedly obvious typographical error. Petitioner alleges that the issue of material alteration is inapplicable because the application record as a whole clearly shows that applicant has been seeking registration of the mark DITHERSEAL from the start. Since the proffered amendment to the drawing, if accepted to correct a typographical error, would obviate the substantive refusals in this case, the petition is viewed as involving issues with "potentially substantive effect" that have arisen under circumstances making review by the Commissioner appropriate.

2. The Examining Attorney did not Commit Clear Error

Trademark Rule 2.146(a)(3) permits the Commissioner to invoke his supervisory authority in appropriate circumstances. However, the

Commissioner will reverse the action of an Examining Attorney in a case such as this only where there has been a clear error or abuse of discretion. In re Richards-Wilcox Manufacturing Co., 181 USPQ 735 (Comm'r Pats.1974); Ex parte Peerless Confection Co., 142 USPQ 278 (Comm'r Pats.1964).

The Examining Attorney's refusal to allow petitioner to amend the drawing of its mark is properly based upon consideration of the public, who may have relied to its detriment on the absence within the PTO record of pending applications of notice of an application to register the mark DITHERSEAL. The Examining Attorney correctly concluded that SEALS and DITHERSEAL are materially different marks and the fact that the applicant seeks only to correct a typographical error in the drawing of the mark is insufficient justification for the proposed amendment to the mark.

The applicant argues that the totality of the contents of its application file clearly indicate that it intended to seek registration of the mark DITHERSEAL and notes that it cannot comprehend why the Examining Attorney would conduct a search of the register of marks solely in relation to the mark SEALS. The applicant seems to believe that the Examining Attorney refused its request to amend the drawing from SEALS to DITHERSEAL because subsequent searches of the register would have to be undertaken. In fact, the record in the application file indicates that the Examining Attorney conducted an extensive search for references that might be cited as a bar to registration of DITHERSEAL and its root component DITHER.

***3** Petitioner also seeks a waiver of that portion of Rule 2.72 which prohibits amendments to the drawing of a mark when the amendment would materially alter the character of the mark. Petitioner argues that this rule was not intended to prevent the correction of typographical errors.

Trademark Rules 2.146(a)(5) and 2.148 permit the Commissioner to waive any provision of the Rules which is not a provision of the statute, where an extraordinary situation exists, justice requires and no other party is injured thereby. All three conditions must be satisfied before a waiver is granted.

Oversights that could have been prevented by the exercise of ordinary care or diligence are not extraordinary situations as contemplated by the Trademark Rules. In re Bird & Son, Inc., 195 USPQ 586 (Comm'r Pats.1977). The typographical error petitioner seeks to correct by amendment could have been remedied through adequate proofreading of the application papers and drawing sheet prior to their filing. Further, for the reasons set out above, waiver of Rule 2.72 and correction of the drawing would, in this case, raise the risk of harm to third parties who may have acted in reliance on the record of pending applications.

Accordingly, the petition is denied.

The application will be returned to the Trademark Examining Operation and the petitioner, pursuant to 37 C.F.R. Section 2.63(b)(2), will be given 30 days from the date of this decision to enter a response to the final refusal of registration by the Examining Attorney.

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