

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Baez

Mailed: July 31, 2003

In re THE ORIGINAL
PHILADELPHIA CHEESESTEAK CO

Serial No. 76126277

Filed: 09/12/2000

EUGENE E RENZ JR
MONROE
PO BOX 2056
MEDIA, PA 19063-9056

Vionette Baez, Paralegal

Applicant's filed on July 15, 2003, a request for reconsideration, which includes an amendment and a declaration, an appeal brief and a request for oral hearing.

The request for reconsideration requires consideration by the Trademark Examining Attorney. Accordingly, the appeal is suspended and the file is herewith remanded to the Examining Attorney.

The basis of the final refusal is that the mark is merely descriptive. In the response applicant has traversed this refusal and has also, in the alternative, amended the application to seek registration pursuant to Section 2(f).

In the event the Examining Attorney finds the alternative claim of acquired distinctiveness persuasive, the Examining Attorney should inquire whether applicant wishes to proceed with the appeal regarding the Section 2(e)(1) ground of refusal. If not, the appeal will be moot.

If, however, applicant wishes to pursue the appeal on the Section 2(e)(1) refusal, the file should be returned to the Board, and action in the appeal will be resumed.

Finally, if the Examining Attorney is not persuaded by applicant's Section 2(f) claim, the Examining Attorney is reminded that the alternative claim of acquired distinctiveness should be treated as raising a new issue, such that any refusal to accept registration under Section 2(f) cannot be made final until applicant has been given an opportunity to respond.

If another final refusal ultimately issues, the "six-month response" clause should be omitted from the paper in which such action is taken; the file of this case should be returned to the Board; proceedings will be resumed; and applicant will be allowed time in which to file its brief on appeal.

An oral hearing will be schedule in due course.