

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed:
June 30, 2009
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re O'Rourke-Nicaud Ventures, L.L.C.

Serial No. 77035443

Request for Reconsideration

Gregory C. Smith of Garvey Smith Nehrbass & North, L.L.C. for
O'Rourke-Nicaud Ventures, L.L.C.

David C. Reihner, Trademark Examining Attorney, Law Office
111 (Craig D. Taylor, Managing Attorney).

Before Bucher, Grendel and Mermelstein, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Applicant has requested reconsideration of our June 3,
2009 decision in which we affirmed the refusal of the
Trademark Examining Attorney to register the following mark:



on the Principal Register on the ground that the mark is
merely descriptive or deceptively misdescriptive of the
recited services. The basis for applicant's request is that
on May 26, 2009, prior to the issuance of our decision,
applicant had filed a request for remand of the application

in order to amend the application to the Supplemental Register. Because the Board was unaware of the request for remand at the time it issued its decision, we hereby vacate our decision and will now consider the request.

A request for remand must include a showing of good cause. In determining whether good cause has been shown, the Board will consider both the reason given and the point in the appeal at which the request for remand is made. See TBMP Section 1209.04. Here, the request for remand was filed very late in the appeal process, after briefing had been completed. However, applicant has explained that it could not file the amendment to the Supplemental Register until it had commenced using the mark, and it did not make such use until approximately the time that briefing had begun. Furthermore, we note that on December 4, 2008, applicant had explained to the Trademark Examining Attorney that it was attempting to begin making use of its mark in order to amend its application to the Supplemental Register, but had not been able to do so because of the downturn in the economy, and requested that the Trademark Examining Attorney suspend action on the application until it could file an Amendment to Allege Use. The Trademark Examining Attorney never commented on this request for suspension in denying the request for reconsideration; he merely addressed

the substantive arguments that applicant had made in previous communications.

In view of the totality of the circumstances, including the fact that the amendment to the Supplemental Register is intended to obviate the refusal of registration, we find that applicant has shown the necessary good cause. Accordingly, proceedings in the appeal are suspended, and the application is remanded to the Trademark Examining Attorney to consider applicant's amendment to the Supplemental Register and its Amendment to Allege Use, both of which were filed on May 26, 2009. If registration on the Supplemental Register is found appropriate, the appeal will be moot, and the Board should be so informed. On the other hand, if a final refusal of registration ultimately issues, the file should be returned to the Board.¹ Proceedings in the appeal will then be resumed, and a briefing schedule on any issues that are the subject of the new final refusal will be set.

Decision: This application is hereby remanded to the Trademark Examining Attorney.

¹ We take no position at this juncture as to whether registration on the Supplemental Register is appropriate. The Trademark Examining Attorney is reminded that the applicant must be given an opportunity to respond to any refusal of registration on the Supplemental Register or any refusals or requirements raised as a result of the filing of the Amendment to Allege Use.