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Filing date: **11/18/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77147075
Applicant	The Chamber of Commerce of the United States of America
Applied for Mark	NATIONAL CHAMBER
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Submission	Applicants Request for Remand and Amendment
Attachments	Request for Remand -- NATIONAL CHAMBER.pdf (7 pages)(103280 bytes)
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Date	11/18/2009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Matter of Service Mark Application

Serial No.:	77147075	:	International Class 35
		:	
Applicant:	The Chamber of Commerce of the United States of America	:	
		:	
Filed:	April 3, 2007	:	Examining Attorney: C. Buongiorno Law Office 102
		:	
Mark:	NATIONAL CHAMBER	:	

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

BOX TTAB
NO FEE

**MOTION TO REMAND APPLICATION TO THE
EXAMINING ATTORNEY FOR CONSIDERATION
OF RECENT ACTION BY THE TRADEMARK OFFICE**

Pursuant to Trademark Rule 2.142(d) and TBMP Sections 1207.02 and 1209.04,
Applicant, The Chamber of Commerce of the United States of America (the “U.S. Chamber”),
respectfully requests that jurisdiction over this *ex parte* appeal be remanded to the Examining
Attorney for consideration of certain recent actions taken by the Trademark Office.

BACKGROUND

Applicant has appealed the Examining Attorney’s final refusal of Serial No. 77147075,
through which Applicant seeks to register the mark NATIONAL CHAMBER for “*Providing
online directory information services featuring information regarding local and state Chambers*”

of Commerce; providing information and news in the field of business, namely information and news on current events and on economic, legislative, and regulatory developments that can impact businesses; administration of a discount program enabling participants to obtain discounts on goods and services” in International Class 35. The Examining Attorney has refused registration, asserting that (1) the NATIONAL CHAMBER mark is merely descriptive for each of the recited services; (2) the identification language “*providing information and news in the field of business, namely information and news on current events and on economic, legislative, and regulatory developments that can impact businesses*” is indefinite; and (3) Applicant supposedly failed to comply with the Examining Attorney’s request for information.

Applicant respectfully submits that each of the asserted grounds for refusal is improper and is prepared to argue its position before the Board. Subsequent to the Examining Attorney’s issuance of the Final Office Action, however, the Office revised the *Acceptable Identification of Goods and Services Manual*. Specifically, the *ID Manual* now provides that the services of “*Providing information and news in the field of business*” and, more specifically, “*Providing information and news in the field of business, namely, information and news on current events and on economic, legislative, and regulatory developments as it relates to and can impact businesses*” are acceptable identifications within Class 35. *See* Ex. A (results of an online search of the *ID Manual*) (second and third entries) (both adopted Oct. 15, 2009).

Applicant submits that this action by the Office is potentially material to the examination of the pending application as it could render moot at least one of the basis on which registration was refused. Because the *ID Manual* was only recently updated to reflect the acceptance of this identification, however, the Examining Attorney has not yet had an opportunity to consider its impact. Thus, pursuant to Trademark Rule 2.142(d) and TBMP Sections 1207.02 and 1209.04,

Applicant requests that jurisdiction over this appeal be remanded to the Examining Attorney for consideration of the recent actions taken by the Office in updating the *ID Manual*.

ARGUMENT

The Board has explained that a request for remand for further examination based on newly-discovered evidence will be considered upon a showing of “good cause” for why the information sought to be made of record was not introduced earlier. *TBMP*, §1207.02. The Board has also noted that it may be proper for an Applicant to request remand so an examining attorney may consider a refusal in light of a recently decided case. *Id.*, §1209.04. One of the factors the Board considers in this process is the timeliness of the request. *Id.*, §1207.02.

Here, Applicant is promptly moving to request remand following the Office’s adoption last month of “acceptable identifications” that closely parallel the ID at issue here. Further, on remand Applicant would propose to amend the relevant portion of its identification to conform it with the identification language adopted by the Office.¹ *See TBMP*, §1205.01 (“Good cause will be found ... when [an] amendment is an attempt to comply with a requirement, such as an amendment to the identification of goods in response to a requirement for an acceptable identification, or when the amendment will obviate a ground for refusal”)

As neither party has yet filed briefs in this case (Applicant’s opening brief is not due until later this month), and given the relevance of the new information on which Applicant proposes to rely, Applicant submits that “good cause” exists under Trademark Rule 2.142(d) for the Board to remand jurisdiction over this appeal to the Examining Attorney so that the recent actions of the Office in changing the *ID Manual* may be considered through further examination.

¹ Specifically, Applicant proposes to amend the relevant portion of its identification of services as follows so as to bring the current identification language in line with what the Office has deemed acceptable: “*Providing information and news in the field of business, namely, information and news on current events and on economic, legislative, and regulatory developments as it relates to and [that] can impact businesses*”.

A copy of the relevant portion of the *ID Manual*, which constitutes the additional evidence on which Applicant relies, is attached as Ex. A. *Accord TBMP*, §1207.02.

Respectfully submitted,

KENYON & KENYON LLP

Dated: November 18, 2009

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Exhibit A

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