

From: Gustason, Anne

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CC:

Subject: U.S. TRADEMARK APPLICATION NO. 77505597 - DRHORSEPOWER  
YOUR PRESCRIPTION FOR - 37455-403 - Request for Reconsideration Denied -  
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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**APPLICATION SERIAL NO.** 77505597

**MARK:** DRHORSEPOWER YOUR PRESCRIPTION FOR



**CORRESPONDENT ADDRESS:**

ANDREW D SKALE  
MINTZ LEVIN  
3580 CARMEL MOUNTAIN RD STE 300  
SAN DIEGO, CA 92130-6766

**GENERAL TRADEMARK INFORMATION:**  
<http://www.uspto.gov/main/trademarks.htm>

**APPLICANT:** DRHORSEPOWER, INC.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

37455-403

**CORRESPONDENT E-MAIL ADDRESS:**

**REQUEST FOR RECONSIDERATION DENIED**

**ISSUE/MAILING DATE:**

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.64(b); TMEP §§715.03(a), 715.04(a). The requirement(s) and/or refusal(s) made final in the Office action dated May 6, 2011, are maintained and continue to be final. *See* TMEP §§715.03(a), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. *See* 37 C.F.R. §2.64(b); TMEP §§715.03, 715.03(a), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP

§715.03(a), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal when the time for responding to the final Office action has expired. *See* TMEP §715.04(a).

Further, applicant's request for suspension pending the outcome of proceeding number 91199348, is denied as applicant is not a party to this proceeding.

Please see TMEP §716.02 and §716.02(a) below:

### **716.02 Circumstances Under Which Action May Be Suspended**

Under 37 C.F.R. §2.67, an examining attorney has the discretion to suspend an application "for good and sufficient cause." The most common reasons for suspension of an application are discussed below.

As a general rule, the USPTO will not suspend an application to give an applicant time to secure a consent agreement.

Any request to stay a deadline for responding to an Office action pending disposition of a petition to the Director should be directed to the Deputy Commissioner for Trademark Examination Policy. If such a request is sent to the examining attorney, the examining attorney should forward it to the Office of the Deputy Commissioner for Trademark Examination Policy. The examining attorney should not suspend action on an application pending a decision on petition to the Director. *See* 37 C.F.R. §2.146(g); TMEP §1705.06.

#### **716.02(a) Applicant's Petition to Cancel Cited Registration**

If the examining attorney refuses registration under §2(d) of the Trademark Act in view of the mark in a prior registration, the applicant may file a petition to cancel the registration under 15 U.S.C. §1064 and, within a proper response period, inform the examining attorney that the petition to cancel has been filed. This will constitute a proper response to the §2(d) refusal, and may be done by telephone, if there are no other outstanding issues that require a written response. The examining attorney will then suspend further action until the termination of the cancellation proceeding, if the application is otherwise in condition for approval or final refusal. The applicant should provide the number of the cancellation proceeding, if available; however, if the applicant does not provide the cancellation number, the examining attorney may ascertain it from USPTO records.

The examining attorney should suspend further action only if the applicant states that the cancellation proceeding has already been filed or is being filed concurrently with the response to the Office action.

Although the examining attorney will determine the status of the cancellation proceeding through a routine status check (*see* TMEP §716.04), the applicant may call or e-mail to advise the examining attorney when the registration has been cancelled, in order to avoid any possible delay in removing the application from suspension. The examining attorney

must not remove the application from suspension and withdraw the §2(d) refusal until the TRAM system shows that the registration has actually been cancelled or expired.

When an application is suspended pending resolution of a cancellation proceeding, it is possible that a settlement agreement filed in the proceeding may be contingent upon the approval of an amendment or acceptance of a consent agreement filed in the suspended application, and the consequent approval of the application for publication. The Board has no jurisdiction over the application that is pending before the examining attorney. Thus, the applicant must file the amendment or consent agreement with the examining attorney, not with the Board. The examining attorney must consider the amendment or agreement and take appropriate action, including approving the application for publication, if appropriate. See TBMP §605.03(c).

In rare circumstances, the examining attorney may issue an Office action advising an applicant of a conflicting mark in an earlier-filed application and, during the response period, the mark registers and the applicant files a petition to cancel the registration. Although the applicant may respond to the Office action by informing the examining attorney that the petition to cancel has been filed, the examining attorney may not suspend under these circumstances because the application would not be in condition for final refusal if the registration is not cancelled. The examining attorney must first issue a non-final Office action refusing registration. The applicant may then respond by requesting suspension pending the outcome of the cancellation proceeding.

See TMEP §716.02(e) regarding suspension pending cancellation of a cited registration under §8 or §71 of the Act or expiration of a cited registration for failure to renew under §9 of the Act.

**Only parties to a cancellation proceeding may request suspension of their application pending the outcome of the proceeding. Therefore, the request to suspend the applicant's application pending the outcome of proceeding number 91199348 is denied.**

/Anne Gustason/  
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