

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

Mailed: July 26, 2005

In re Quad/Graphics, Inc.

Serial No. 78079036

Filed: 08/14/2001

BILLIE JEAN SMITH  
MICHAEL BEST AND FRIEDRICH  
100 E WISCONSIN AVE STE 3300  
MILWAUKEE, WI 53202-4108

***Tina Craven, Paralegal Specialist:***

Applicant's request for remand filed July 11, 2005 is noted.

Applicant seeks remand in order to amend the application to seek registration pursuant to Section 2(f). Good cause having been shown, the request for remand is granted, action on the appeal is suspended, and the file is remanded to the Trademark Examining Attorney for consideration.

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.