United States Patent and Trademark Office
Trademark Trial and Appeal Board
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Mailed: March 13, 2007

In re Expo Communications, Inc.

Serial No. 78654480 (parent)
Serial No. 78978112 (child)
Serial No. 78978113 (child)

Filed: 6/20/05

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On February 20, 2007 applicant filed a notice of appeal and, on February 23, 2007, applicant filed what it styled as a request for reconsideration.[1] In the request for reconsideration, applicant asked the Examining Attorney to, inter alia, reconsider the decision making the August 17, 2006 Office action a final action, asserting that the final

[1] In point of fact, because the final Office action issued on October 17, 2006, the request for reconsideration should have been filed by no later than February 20, 2007 to be treated as a request for reconsideration. Such documents that are filed more than six months after the mailing of a final Office action are treated as requests for remand, and must be supported by a showing of good cause. However, because, on February 20, 2007, the Board, noting applicant's statement that it was simultaneously filing a request for reconsideration, remanded the application to the Examining Attorney to consider that request, we will not disturb that decision.

refusal was premature. This has now been brought to the Board's attention, and we will consider whether the final refusal was premature, since the Examining Attorney has no authority to rescind the institution of an appeal.

It is applicant's position that the final refusal was premature because the refusal of registration based on Section 2(e)(1) of the Trademark Act was never repeated with respect to the services in Class 41, and therefore applicant never had an opportunity to respond to the refusal in that class. Applicant bases this statement on the fact that, at the time the first Office action issued, Class 41 was not part of the application. Applicant is partially correct, in that the application as filed classified the services in only Classes 35 and 38, and the Examining Attorney required applicant to submit a more definite identification of services, pointing out that some of the services fell in Class 41.

However, although the application was not formally amended to add Class 41 until applicant responded to the first Office action, the first Office action still refused registration with respect to the services identified in the application, and those services included the services later included in Class 41. In fact, if those services that were later placed in Class 41 had not been in the application as originally filed, the application could not have been

amended to add them because that would have been an impermissible expansion of the scope of the original identification of services.

Accordingly, we find that the final refusal that issued on August 17, 2007 was not a premature refusal, and the appeal was properly instituted. It is noted that, on February 23, 2003, applicant requested a division of its application into the three separate classes, and that this division has now been completed. The services in International Class 35 remain in the original parent application Serial No. 7865448, the services in International Class 38 have been placed in child application, Serial No. 78978112, and the services in International Class 41 have been placed in child application Serial No. 78978113. The three files are hereby forwarded to the Examining Attorney to consider the request for reconsideration filed on February 23, 2007, which document now applies to the three divisional applications. If the refusal of registration is maintained with respect to any of the applications, the Examining Attorney should issue Office actions to that effect for those applications, and return the applications to the Board. Proceedings in the appeals with respect to those applications will be resumed, and the Board will consider whether or not to consolidate any such appeals.

By the Trademark
Trial and Appeal Board