

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

dmd

Mailed: January 13, 2014

In re SFS intec Holding AG

Serial No. 79109409

Filed: 11/28/2011

JOHN J O'MALLEY
VOLPE AND KOENIG PC
30 S 17TH STREET,
PHILADELPHIA, PA 19103-4009

Denise M. DelGizzi,
Technical Program Manager:

On January 13, 2014, the Trademark Examining Attorney requested, pursuant to Trademark Rule 2.142(f)(6), 37 C.F.R. §2.142(f)(6), that the application be remanded to her for further examination.

Specifically, the Trademark Examining Attorney contends that the proposed amendments to the identification of goods submitted by applicant on September 14, 2012 and April 8, 2013, are outside the scope of the original identification. Trademark Rule 2.142(f)(6) provides, in pertinent part:

If, during an appeal from a refusal of registration, it appears to the examiner that an issue not involved in the appeal may render the mark of the appellant unregistrable, the examiner may, by written request, ask the Board to suspend the appeal and to remand the application to the examiner for further examination.

TBMP §1209.02 provides, in pertinent part: "Because

the mandate of the USPTO is to register only eligible marks, an examining attorney's request for remand will generally be granted unless there is no valid basis for the request..."

In view thereof, we grant the Trademark Examining Attorney's request for remand for further examination.

Accordingly, proceedings in the appeal are suspended and the application is remanded to the Trademark Examining Attorney for further appropriate examination.

In the event that a new final Office action based on the proposed amendments ultimately is issued, the final Office action should also re-state the final refusal. The new final Office action should omit the usual six-month response clause. The application then should be returned to the Board for resumption of the appeal. See Trademark Rule 2.142(f)(3).

At that point, the Board will issue an order allowing applicant time to file a supplemental brief.

To summarize, this appeal is suspended, and the application is remanded to the Trademark Examining Attorney for further examination.