United States Patent and Trademark Office

Office of the General Counsel
Office of the Solicitor

March 11, 2016

Via E-mail: rcoleman@archerlaw.com; jmacmull@archerlaw.com

Joel G. MacMull, Esq.
Ronald D. Coleman, Esq.
Archer & Greiner P.C.
44 Wall Street – Suite 1285
New York, NY 10005

Re: Applicant's Request Filed March 8, 2016 in *In re Tam*, Application No. 85472044

Dear Mr. MacMull and Mr. Coleman:

I write in response to your submission filed with the Trademark Trial and Appeal Board on March 8, 2016, requesting the Director of the United States Patent and Trademark Office (USPTO) to "comply with the Opinion and Judgment of the United States Court of Appeals for the Federal Circuit dated December 22, 2015 in *In re Simon Shiao Tam,* Case No. 2014-1203 ('*In re Tam*'), in which the Court wrote, '[w]e vacate the Board's holding that Mr. Tam's mark is unregistrable, and remand this case to the Board for further proceedings.'"

You have inquired why there have been no "further proceedings" since the Mandate issued on February 12, 2016. The Federal Circuit's decision in *In re Tam* remains subject to potential Supreme Court review. 28 U.SC. § 1254. As you know, on March 9, 2016, the Solicitor General of the United States filed on behalf of the USPTO Director an Application to Extend the Time to File a Petition for a Writ of Certiorari (Supreme Court No.15A925). Consistent with USPTO practice following a Federal Circuit decision in an appeal of a Board decision, there will be no "further proceedings" at the Board regarding this trademark application until the last of the following occurs: 1) the period to petition for a writ of certiorari (including any extensions) in *In re Tam* expires without a petition being filed; (2) a petition for certiorari is denied; or (3) certiorari is granted and the U.S. Supreme Court issues a decision.

Please contact me if you have any questions.

Very truly yours,

Thomas W. Krause
Acting Solicitor

cc: Trademark Trial and Appeal Board