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Subject: U.S. TRADEMARK APPLICATION NO. 85973494 - PRIVATE BUSINESS CAPITAL - N/A - REMAND
REQUEST TO TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85973494

MARK: PRIVATE BUSINESS CAPITAL



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MOTION TO REMAND

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD ON APPEAL

TRADEMARK EXAMINING ATTORNEY'S REQUEST FOR REMAND

The trademark examining attorney requests that the Trademark Trial and Appeal Board remand this case to the trademark examining attorney under 37 C.F.R. §2.142(d) for the reason(s) that follow.

For the first time en brief, the applicant introduces two new statutory issues that may render the mark unregistrable. As such, the Examining Attorney requests suspension of this appeal, and remand of the case to prosecute these issues. *See* TBMP §§1209.02 and 1217.

New Issue 1: Request for Registration on the Supplemental Register

During prosecution, the applicant's mark was refused as primarily merely descriptive under Trademark Act Section 2(e)(1). Applicant has argued during prosecution that the mark is distinctive. However, on appeal, applicant requests registration on the Supplemental Register in the alternative. *See* Applicant's Appeal Brief, p. 2. If this issue can be considered in full, it is possible that the mark may be found to be Generic, and therefore unregistrable on the Supplemental Register. *See* Trademark Act Section 23(c), 15 U.S.C. §1091(c); *see* TMEP §§1209.01(c) *et seq.* Thus, this would also be a new issue that could render the mark unregistrable.

New Issue 2: Whether the mark is Misdescriptive under Trademark Act Section

The applicant's Appeal Brief indicates that the wording "private business capital" has a multiplicity of meaning. *See* Applicant's Appeal Brief, p. 2. Applicant further states for the first time that the common meaning of "private business capital" is not in fact what the applicant does. *See* Applicant's Appeal Brief, p. 2. This raises the issue that the applicant's mark may be Misdescriptive of the services under Trademark Act Section 2(e)(1). Further, if the mark would be found to be deceptively misdescriptive, the mark would be unregistrable under any circumstances. *See* 15 U.S.C. §§1052(f), 1091; TMEP §1209.04.

Further factual inquiry and information would be necessary to make this determination.

Because there are two specific and articulated new issues that may render the mark unregistrable, the Examining Attorney respectfully requests that the Trademark Trial and Appeal Board remand this case and allow the two specified statutory issues to be resolved or otherwise be placed in condition for appeal.

Respectfully submitted,

/Joanna M. Shanoski/

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