

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

Mailed: March 31, 2015

In re San Diego Private Bank

Serial No. 85973494

Filed: 6/28/2013

MARIA JOHNSON
DE NOVO LEGAL PC
2244 FARADAY AVE, SUITE 103
CARLSBAD, CA 92008-7208

Denise M. DelGizzi,
Technical Program Manager:

On March 24, 2015, the 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 to allow her to issue a new nonfinal Office action.

Specifically, the examining attorney contends that, in its appeal brief, applicant raised two new specific and articulated new issues that may render the mark unregistrable.

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 not valid basis for the request.....”

In view thereof, the examining attorney’s request for remand is granted, proceedings in the appeal are suspended and the application is remanded to her for further appropriate examination.

In the event that a new final Office action ultimately is issued, the final Office action should also re-state the final refusal. The new final Office action should omit the six-month response clause and the application 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 60 days from the date of the order in which to file a supplemental brief.