

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed:  
August 1, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Eximius Coffee, LLC*

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Remand

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Serial No. 86262060

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John S. Egbert of Egbert Law Offices PLLC for Eximius Coffee, LLC.

Charles H. Hiser IV, Trademark Examining Attorney, Law Office 112 (Angela Bishop Wilson, Managing Attorney).

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By Kuhlke, Administrative Trademark Judge.

Applicant, Eximius Coffee, LLC, filed an intent-to-use application to register on the Principal Register the standard character mark ALDECOA for goods identified as “coffee, caffeine-free coffee, instant coffee, single serve coffee,” in International Class 30. Registration has been refused under Section 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(e)(4), on the ground that ALDECOA is primarily merely a surname.

During prosecution of the application, the Examining Attorney advised Applicant in the Office Actions, under the heading Supplemental Register, that a mark in a Section 1(b) application is not eligible for registration until an acceptable

amendment to allege use (AAU) is filed, and provided instructions on how to file an AAU. When the refusal was made final, Applicant filed an AAU to comply with the requirement to make the application eligible for registration on the Supplemental Register. After the AAU was accepted, no further Office Action issued.

Applicant filed this appeal and in its brief requested in the alternative that the application be remanded after final decision for amendment to the Supplemental Register. However, when the Board has issued its final decision in an ex parte appeal, the examining attorney is without jurisdiction to take any further action, and the Board has no authority to remand the case to the examining attorney for further examination. A case that has been considered and decided on appeal to the Board may be reopened only as provided in Trademark Rule 2.142(g), 37 C.F.R. § 2.142(g). *See In re Johanna Farms, Inc.*, 223 USPQ 459, 460 (TTAB 1984).

While it seems clear Applicant's intent in filing the AAU was to request an amendment in the alternative to the Supplemental Register and the Office Actions could be read to imply that is sufficient, in fact, an applicant must also file an amendment to the application to seek registration on the Supplemental Register. *See* TMEP §§ 816.04 (April 2016) ("When the applicant files an allegation of use that complies with the minimum requirements of 37 C.F.R. § 2.76(c) ... *and* an amendment to the Supplemental Register in response to a refusal, the examining attorney must follow the procedures outlined in TMEP § 714.05(a). ... If the examining attorney is not persuaded to withdraw the refusal, but would accept the

amendment the applicant must be given the option of registration on the Supplemental Register or going forward with the appeal on the underlying refusal” (emphasis added)); and 1102.03. It is noted in particular that when an application is amended from the Principal Register to the Supplemental Register after the filing of an AAU, the effective filing date of the application is amended to the date of the AAU and the examining attorney must conduct a new search of USPTO records for conflicting marks. *See, e.g.*, TMEP § 1102.03.

In view thereof, the Board hereby suspends action on this appeal, and the application is remanded to the Examining Attorney for consideration of the amendment in the alternative to the Supplemental Register. Examination must be completed within thirty (30) days from the date of remand, or within an extension of time sought and obtained for that purpose. In the event the amendment in the alternative to the Supplemental Register is accepted, the Examining Attorney should return the application to the Board for consideration of the issue on appeal, *i.e.*, the refusal of registration on the Principal Register under Section 2(e)(4). The remand is solely for consideration of the amendment, in the alternative, to the Supplemental Register.

In view of the above, the appeal is suspended.