

From: Hughitt, Beth

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Subject: U.S. TRADEMARK APPLICATION NO. 85801419 - BLACKCARDSTATUS - N/A - REMAND REQUEST TO TTAB

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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)**

**U.S. APPLICATION SERIAL NO.** 85801419

**MARK:** BLACKCARDSTATUS



**CORRESPONDENT ADDRESS:**

BLACKCARDSTATUS LLC

BLACKCARDSTATUS LLC

311 WEST THIRD STREET, STE 3955

CARSON CITY, NV 89703

**APPLICANT:** BLACKCARDSTATUS LLC

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

legal@blackcardstatus.com

**MOTION TO REMAND**

This application is before the Board in connection with Opposition Number 91211919.

The examining attorney initially examined this application and issued an Office action on February 14, 2013, solely in connection with a premature use refusal. Applicant submitted its response on the very

same day, and provided additional specimens that persuaded the examining attorney to withdraw the refusal. However, as part of the Response to Office Action form, applicant also included a voluntary disclaimer of the wording "BLACKCARDSTATUS" – i.e., a disclaimer of the entire mark. The examining attorney did not notice the disclaimer statement in her review of applicant's response, and thus approved the application for publication after determining that the premature use refusal had been resolved. The mark was published on April 9, 2013, and the above-noted opposition was filed on August 7, 2013.

In reviewing the trademark register concerning various BLACK CARD marks, the examining attorney noticed the disclaimer statement of record in connection with this application. Because a disclaimer of an entire mark is inappropriate (TMEP §1213.06) and because the examining attorney does not consider the mark to be descriptive, she requests suspension of the opposition proceeding and remand of the application to allow her to issue a new non-final Office action requiring that applicant withdraw the improper disclaimer.

37 C.F.R. §2.130 states, in relevant part: "If, while an *inter partes* proceeding involving an application under section 1 or 44 of the Act is pending, facts appear which, in the opinion of the trademark examining attorney, render the mark in the application unregistrable, the facts should be called to the attention of the Trademark Trial and Appeal Board"; *see also* TBMP §515. Similarly, TMEP §1504.02 provides that the Board has jurisdiction over any application in which a notice of opposition has been filed; and that if an examining attorney determines that a new refusal or requirement should be issued during an *inter partes* proceeding, the examining attorney must request that the Board suspend the proceedings and remand the application for further examination.

Accordingly, because a disclaimer of an entire mark is clearly inappropriate and affects the question of registrability, the examining attorney hereby expresses her regret for having failed to notice the voluntary disclaimer during initial examination, and requests that the Board suspend the opposition and remand the application to her for purposes of issuing a new non-final Office action.

Respectfully submitted,

/Elizabeth A. Hughitt/

Examining Attorney

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