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Mailed:
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re BROOME MERCER CORP.

Reconsideration

Serial No. 76625510

Myron Amer of Myron Amer, P.C. for BROOME MERCER CORP.

Lourdes D. Ayala, Trademark Examining Attorney, Law Office
106 (Mary I. Sparrow, Managing Attorney).

Before Walters, Kuhlke and Walsh, Administrative Trademark
Judges.

Opinion by Walsh, Administrative Trademark Judge:

In a paper filed on November 13, 2006, BROOME MERCER
CORP. (applicant) has requested reconsideration of our
decision which was mailed on October 24, 2006.¹ In that
decision we affirmed the Examining Attorney's refusal to
register applicant's mark under Trademark Act Section 2(d)
15 U.S.C. § 1052(d). The application seeks to register the

¹ We apologize for the delay in acting on this request. There was a delay in transmission of Applicant's paper from the USPTO mailroom.

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mark SOHO RUNWAY in standard-character form on the Principal Register for goods identified as, "ladies clothing, namely, dresses, blouses, slacks and fur coats" in International Class 25. The mark in the cited registration is RUNWAY and the goods are "scarfs" in International Class 25.

Applicant states the following in its request:

In an initial Office Action, the Examining Attorney noted a prior pending, potentially conflicting application, serial Number 78/503,733 for the below goods:

"Athletic shoes; bandanas; baseball caps; beach cover-ups; beachwear; belts; cloth bibs for babies; bikinis, blazers, boots; bow ties; bras; caps; chaps; cloth bibs; coats; dresses; ear muffs; footwear; gloves; golf shirts; Halloween costumes; hats; head bands; headwear; hosiery; infantwear; jackets; jeans; jerseys; kerchiefs; leotards; leg warmers; mittens; neckties; night shirts; night gowns; pajamas; pants; panty hose; polo shirts; ponchos; rainwear; robes; sandals; scarves; shirts; shoes; skirts; shorts; slacks; slippers; sleepwear; socks; stockings; sweaters; sweat pants; sweat shirts; swimsuits; tank tops; tights; t-shirts; underwear; vests; wrist bands" (underlining added).

The Examining Attorney later withdrew consideration of application Serial No. 78/503,733, and chose not to base a Sect. 2(d) refusal on a registration granted on said application.

A Sect. 2(d) refusal based on goods of the registration granted on application Serial No. 78/503,733 is thus waived, particularly as to "dresses, slacks and coats," and the Board is respectfully requested to so hold in the decision rendered."

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For completeness, we noted that the mark in Application Serial No. 78503733 is PROJECT RUNWAY in standard-character form. Applicant appears to argue that the Examining Attorney "waived" the authority to refuse registration in applicant's case because the Office had withdrawn as a potential basis for refusal another application which included some of the same goods identified in applicant's application. Or perhaps applicant bases its waiver theory on the fact that the PROJECT RUNWAY application was ultimately approved and published for opposition.

Applicant had made arguments with regard to the PROJECT RUNWAY application in its brief in this appeal. We considered those arguments and concluded as follows in our October 24, 2006 opinion: "The Examining Attorney never issued a refusal with regard to PROJECT RUNWAY. Accordingly, whether or not such a refusal would have been appropriate is not before us." We then proceeded to decide the appeal based on the Section 2(d) refusal which the Examining Attorney had made.

In this request, applicant once again asks us to consider the Examining Attorney's actions with regard to the PROJECT RUNWAY application. Though applicant's arguments on their face appear to vary from those it

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presented in its appeal, there is no difference in substance. We reject applicant's unsupported argument that the Examining Attorney's action with regard to the PROJECT RUNWAY application somehow represented a waiver of the authority to refuse registration with regard to the registration which the Examining Attorney did cite. We must consider each application (and refusal) on its merits without regard to actions which may have been taken with respect to other applications. In re Nett Designs, Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). We once again reject applicant's argument that actions with respect to the PROJECT RUNWAY application in any way precluded the refusal which was made in this case, a refusal which we affirmed in our decision of October 24, 2006.

In conclusion, we have considered all of applicant's arguments, and we find no error in our decision. Applicant's request for reconsideration is denied. The decision, dated October 24, 2006, stands.