

THIS OPINION IS NOT A  
PRECEDENT OF THE

Mailed:  
November 4, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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In re American Onion International, Inc.

\_\_\_\_\_  
Serial No. 76660662  
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Request for Reconsideration  
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Dallas G. Thomsen of Sussman Shank LLP for American Onion International, Inc.

Timothy J. Finnegan, Trademark Examining Attorney, Law Office 104 (Chris Doninger, Managing Attorney).

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Before Rogers, Taylor and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

This case comes before us on the Examining Attorney's request for reconsideration, with accompanying exhibits, filed October 24, 2008.

A. Prosecution History.

American Onion International, Inc. ("applicant") filed a use-based application on the Principal Register for the mark "Patagonia SweetReds," in standard character format, for "fresh onions," in Class 31. During the prosecution of

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the application, applicant disclaimed the exclusive right to use the term "SweetReds." The Trademark Examining Attorney refused registration under Sections 1, 2 and 45 of the Trademark Act of 1946, 15 U.S.C. §§1051, 1052 and 1127, on the ground that "Patagonia" is a varietal name for onions. Applicant argued that "Patagonia" was not a varietal name, and, in the alternative, requested that its application be registered on the Supplemental Register.<sup>1</sup> An applicant may take alternative positions with respect to a refusal to register. TBMP §1215 (2<sup>nd</sup> ed. rev. 2004); TMEP §1202(c) (5<sup>th</sup> ed. 2007).

In his response to applicant's request for reconsideration, the Examining Attorney did not acknowledge or address applicant's alternative request to register its mark on the Supplemental Register.<sup>2</sup> However, in his appeal brief, the Examining Attorney did address the issue of whether applicant's mark was registrable on the Supplemental Register. He determined that the mark was not

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<sup>1</sup> Applicant's November 21, 2007 Request for Reconsideration; Applicant's Brief; and Applicant's Reply Brief.

<sup>2</sup> During the prosecution of the application, the Examining Attorney adopted the position that the term "SweetReds" is a generic term. October 30, 2006 Office Action (the term "SweetReds" describes a feature of applicant's goods because "the onions are of the sweet red variety"); May 22, 2007 Office Action ("the addition of the generic SWEETREDS does not overcome the refusal. "Sweet red" is merely the generic designation for a sweet red onion").

registrable on the Supplemental Register because the evidence in the final office action proved that the term "SweetReds is highly descriptive, if not generic."<sup>3</sup>

In a decision dated August 8, 2008, the Board affirmed the refusal to register applicant's mark, but allowed applicant thirty days to delete the disclaimer of "SweetReds," disclaim the exclusive right to use "Patagonia," and amend the application to the Supplemental Register. The Board found that the evidence of record did not support the Examining Attorney's contention that "SweetReds" is a generic term, but only supported a finding of descriptiveness.

On September 2, 2008, applicant filed a request to delete its disclaimer of "SweetReds," enter a disclaimer of applicant's exclusive right to use the word "Patagonia" apart from the mark as shown, and amend the application to the Supplemental Register. Accordingly, in an order dated September 12, 2008, the Board set aside its August 8, 2008 final decision and approved the application for registration on the Supplemental Register.

Although the Board's order was dated September 12, 2008, it was not posted on the Office's TARR system until September 22, 2008. Subsequently, on October 24, 2008, the

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<sup>3</sup> Examining Attorney's Brief, unnumbered pages 4-6.

Examining Attorney filed his request for reconsideration with accompanying exhibits.

B. Whether the request for reconsideration was timely filed?

Trademark Rule 2.144 provides that a request for reconsideration must be filed one month from the date of the decision. See also TBMP §1219.01 (2<sup>nd</sup> ed. rev. 2004). Even if we use the date that the order was posted on the Office's TARR system (September 22, 2008), instead of the actual mailing date of the order (September 12, 2008), the Examining Attorney's request for reconsideration, filed on October 24, 2008, was late.<sup>4</sup> See *In re Ferrero S.p.A.*, 24 USPQ2d 1061, 1062 (TTAB 1992) ("we hereby give notice that in future cases, we will require that any request by the Examining Attorney for *reconsideration* of the decision of the Board, on an ex parte appeal, be filed within one month of the date of the decision to which the request is directed, unless the time is extended by the Board upon a showing of sufficient cause"). Accordingly, the request for reconsideration was not timely filed.

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<sup>4</sup> The Examining Attorney did not request an extension of time to file a request for reconsideration, nor did he provide an explanation for the late filing.

C. Whether the Examining Attorney filed a proper request for reconsideration?

As indicated above, the Examining Attorney filed exhibits purporting to show that the term "SweetReds" is generic when used in connection with onions. However, the premise of a request for reconsideration is that, based on evidence of record and the prevailing authorities, the Board erred in reaching its decision. The request for reconsideration may not be used to introduce new evidence. In other words, the request for reconsideration should be limited to a demonstration that based on the evidence of record and the applicable law, the Board's ruling is in error and must be changed. See TBMP §§543 and 1219.01 (2<sup>nd</sup> ed. rev. 2004). In this case, the Examining Attorney is seeking to reopen the prosecution of the application by submitting new evidence, rather than pointing out that the Board made a factual or legal error. Accordingly, the Examining Attorney did not file a proper request for reconsideration.

Decision: The request for reconsideration is denied.