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November 21, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hale

REQUEST FOR RECONSIDERATION

Serial No. 78963970

B. Craig Killough of Barnwell Whaley Patterson & Helms LLC for Nathan S. Hale.

Cimmerian Coleman, Trademark Examining Attorney, Law Office 102 (Karen M. Strzyz, Managing Attorney).

Before Hairston, Zervas and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Nathan S. Hale ("applicant") filed an intent-to-use application to register the mark WHISKEY CREEK RANCH, in standard character format, for services ultimately identified as follows:

> Recreational services, namely, providing hunting preserves; summer camps and not including golf courses or golf tournaments; environmental education services, namely, providing classes about the environment; recreational camp services, namely, providing wildlife and nature studies for others, in Class 41; and,
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> Dude ranches, in Class 43.

Applicant disclaimed the exclusive right to use the word "ranch."

The Trademark Examining Attorney refused to register applicant's mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that applicant's mark is likely to cause confusion with the mark WHISKEY CREEK, in typed drawing format, for "golf courses, golf tournaments, and providing facilities for recreational activities," in Class 41.[1]

In a decision mailed on October 24, 2008, the Board affirmed the refusal to register the application on the ground that applicant's mark is likely to cause confusion with the registered mark.

On November 17, 2008, applicant filed a request for reconsideration of the October 24, 2008 decision. Applicant requests that the Board consider a consent agreement between applicant and the registrant. Applicant makes the following arguments in support of its request for reconsideration:

> 8. During the pendency of the Appeal, and over a period of months, Applicant and Registrant of the Registration negotiated a Consent Agreement.

[1] Registration No. 2492786, issued September 25, 2001; affidavits under Sections 8 and 15 accepted and acknowledged.

> 9. While the Applicant regrets that the Consent Agreement was not consummated in time to submit prior to the issuance of the Decision, consent agreements are "inherently difficult and time-consuming to obtain, and may be highly persuasive of registrability."
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> 11. On or about October 23, 2008, the day before the Board issued its Decision, Applicant and Registrant entered into a Consent Agreement relating to Applicant's use of its mark.
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> 12. Applicant consummated the Consent Agreement in a reasonably prompt fashion, but was unable to do so prior to the Board's Decision.
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> 31. Although Applicant was unable to move for remand prior to the Decision, the interests of justice and the purposes of the trademark laws would best be served by vacating or rescinding the decision and remanding this case to the Examiner for consideration of the Agreement.

Applicant is actually requesting that the Board reopen prosecution to consider the consent agreement. *See* Applicant's Request for Reconsideration ¶29 *quoting* Trademark Rule 2.142(d), 37 CFR §2.142(d) ("After an appeal is filed, if the appellant or the examiner desires to introduce additional evidence, the appellant or the

examiner may request the Board to suspend the appeal and to remand the application for further examination"). In this situation, however, Trademark Rule 2.143(g), 37 CFR §2.143(g) is applicable.[2] That rule reads as follows:

> An application which has been considered and decided on appeal will not be reopened except for the entry of a disclaimer under §6 of the Act of 1946 or upon order of the Director, but a petition to the Director to reopen will be considered only upon a showing of sufficient cause for consideration of any matter not already adjudicated.

Accordingly, the Board may only reopen prosecution to enter a disclaimer, not to consider a consent agreement.

The general premise of a request for consideration is that based on the evidence or record and the prevailing authorities, the Board erred in reaching the decision on the merits. The request for reconsideration may not be used to introduce additional evidence (*i.e.*, a consent agreement obtained after the decision has issued), or to merely reargue points that have been previously made. The request for reconsideration should be limited to a demonstration of an error that the Board made in

[2] As a practical matter, after the Board renders a decision in an appeal, there is no longer any pending appeal to be suspended.

interpreting the law or the facts. TBMP §§ 543 and 1219.01 (2nd ed. rev. 2004). As indicated above, applicant does not contend that the Board made an error in interpreting the facts or law, rather applicant is asking the Board to reopen the prosecution of the application to consider a recently obtained consent agreement.

While we acknowledge that it can be difficult and time consuming to obtain a consent agreement, applicant's only alternative, in this case, would have been to submit the consent agreement and requested a suspension of the appeal at any time prior to the issuance of the decision. See Trademark Rule 2.142(d).

Applicant also argues that if the Board reopens prosecution and remands the application for consideration of the consent agreement, applicant will not have to cancel the cited registration, thus avoiding the cost and burden of that proceeding to the parties and the Board.[3] While applicant is free to pursue that course, the better alternative may be to refile the application and submit the consent agreement if, and when, the examining attorney cites the registrant's registration as a bar to applicant's registration.

[3] Applicant's Request for Reconsideration ¶33.

Because applicant is requesting the Board to reopen the prosecution of the application after it has issued a decision on appeal, and because the Board may only reopen prosecution to enter a disclaimer, applicant's request for reconsideration is denied.