Mailed: October 7, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Healthy Dogma, Inc.

Serial No. 87627598

Remand

Geoffrey D. Aurini of Harness Dickey & Pierce PLC,
for Healthy Dogma, Inc.

J. Ian Dible, Trademark Examining Attorney, Law Office 111,
Chris Doninger, Managing Attorney.

Before Wolfson, Lykos, and Heasley,
Administrative Trademark Judges.

By Lykos, Administrative Trademark Judge:

Applicant has appealed the Trademark Examining Attorney's final refusal to register the mark PETMIX for "pet food" in International Class 31 on the Principal Register pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that it is merely descriptive of the identified goods, or alternatively, that Applicant's mark is merely descriptive but that Applicant has failed to present sufficient evidence to show acquired distinctiveness under Section 2(f) of the

Trademark Act, 15 U.S.C. § 1052(f). During prosecution, the Examining Attorney advised Applicant that it could seek registration on the Supplemental Register, but Applicant declined to do so.

Applicant timely filed a notice of appeal, and in its main brief requested that,

> If the Merely Descriptive refusal is upheld, Applicant relies on its Section 2(f) claim of Acquired Distinctiveness. If the Section 2(f) evidence is deemed insufficient, Applicant chooses to amend its application to the Supplemental Register which the Examiner indicates is available.

Applicant's Brief, p. 1; 8 TTABVUE 2. In his appeal brief, the Examining Attorney provided his consent. Examining Attorney's Brief, 10 TTABVUE 13 ("Applicant is advised that, though the proposed mark was refused registration on the Principal Register, Applicant may amend the application to seek registration on the Supplemental Register").[1] However, it would be procedurally improper to permit

[1] An appeal brief is not the best vehicle for proposing an amendment in the alternative to the Supplemental Register. As recently explained in *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, 2020 BL 293152 (TTAB 2020):

> As a best practice, an applicant seeking to obviate a refusal by proposing an amendment to an application should propose the amendment as early as possible during prosecution. If that does not occur, then the Board strongly prefers that an applicant make such an amendment in a request for reconsideration filed soon after the issuance of a final Office action but prior to the applicant's deadline for filing a notice of appeal. Doing so provides an opportunity for the issue to be addressed before the appeal stage. If an applicant has missed that opportunity, then the next preferred alternative is to file a separately captioned request for remand and suspension of proceedings with the Board, ideally prior to the deadline for filing an appeal brief, so that the Board can make a prompt ruling on the request and the examining attorney does not have to draft a potentially unnecessary appeal brief. If the Board decides to remand the application to the examining attorney, it will suspend the appeal for consideration by the

Applicant to amend the application to the Supplemental Register after the Board issues a final decision affirming the Examining Attorney's refusal to register the mark as being merely descriptive without acquired distinctiveness. *See In re Integrated Embedded*, 120 USPQ2d 1504, 1512 (TTAB 2016) (once final decision rendered, request to amend to Supplemental Register not possible). Once the application has been considered and decided by the Board on appeal, Applicant's course of action would be limited to a request for reconsideration of the Board's decision, and/or the filing of an appeal therefrom, either by way of an appeal to the U.S. Court of Appeals for the Federal Circuit, or by way of a civil action seeking review of the Board's decision. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 1219 (2020). The Examining Attorney lacks jurisdiction to take any further action once a final decision has been rendered, 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 by 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).[2]

> examining attorney of an amendment which might obviate the refusal (and thus the appeal). Embedded amendments in an appeal brief are not prohibited but they are discouraged because they may be inadvertently overlooked by the Board before the Examining Attorney files his or her brief; if noticed, they may needlessly delay the proceeding.

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

In order to effectuate the mutual intent of Applicant and the Examining Attorney, the Board hereby suspends action on this appeal, and **the application is remanded to the Examining Attorney for the sole purpose of considering the amendment in the alternative to the Supplemental Register.** *See, e.g., In re Eximius Coffee, LLC*, 120 USPQ2d 1276, 1277 (TTAB 2016) (prior to issuing a final decision, the Board remanded the application for consideration of the amendment in the alternative to seek registration on the Supplemental Register). Examination must be completed within **thirty (30) days** from the date of remand. In the event the amendment in the alternative to the Supplemental Register is accepted, the Examining Attorney shall return the application to the Board for consideration of the issues on appeal. Upon resumption of the appeal, the Board will issue a final decision.