

1963

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### Recommended Citation

Richard C. Browne, *Some Problems in Trademark Law: Post-Prosecution Amendments to Applications*, 12 Cath. U. L. Rev. 128 (1963).

Available at: <https://scholarship.law.edu/lawreview/vol12/iss2/4>

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## Comment / Some Problems in Trademark Law:

### Post-Prosecution Amendments to Applications

SEVERAL RECENT UNPUBLISHED DECISIONS in trademark application proceedings<sup>1</sup> point up the need for a reconsideration and clarification of Patent Office policy regarding entry of amendments to applications after initial jurisdiction has passed from the Trademark Examiner.

While the decisions referred to are principally "Patent Office Communications" and hence unpublished, they bring together a group of prior reported decisions by the Commissioner of Patents, the Trademark Trial and Appeal Board, the Court of Customs and Patent Appeals and the District Courts in which the role of "review proceedings" in trademark cases has been fashioned.

Drawn into focus by this problem of Patent Office policy are three rules set down in the Rules of Practice in Trademark Cases.<sup>2</sup> The first concerns discovery by the Trademark Trial and Appeal Board of unresolved *ex parte* issues in *inter partes* cases, presumably after *ex parte* prosecution has been concluded;<sup>3</sup> the second concerns the entry of amendments to an application involved in a proceeding;<sup>4</sup> and the third concerns "reopening" of the prosecu-

<sup>1</sup> The Durox Company, Serial No. 695,082 filed September 11, 1955; Esso Standard Oil Company, Serial No. 19,010 filed November 9, 1956; Helene Curtis Industries, Inc., Serial No. 20,381 filed December 4, 1956.

<sup>2</sup> 37 C.F.R. Part 2 (1955).

<sup>3</sup> Rule 2.131, Rules of Practice in Trademark Cases, 37 C.F.R. § 2.131 (1955); If, in considering an *inter partes* case involving an application, facts appear which, in the opinion of the Trademark Trial and Appeal Board render the mark of the applicant unregistrable on one or more *ex parte* grounds, the Board shall in its decision on the *inter partes* issues in the case recommend that if the applicant finally prevails in the case, registration be withheld pending a reexamination by the Examiner of Trademarks on the application in the light of such facts.

<sup>4</sup> Rule 2.84 (a), Rules of Practice in Trademark Cases, 37 C.F.R. § 2.84 (a) (1955); After publication or allowance the Examiner may exercise jurisdiction over an application by special authority from the Commissioner; and Rule 2.131, *supra* note 2.

tion of applications which have been involved in decided appeals.<sup>5</sup>

The *Durox* case was an opposition proceeding in which the Trademark Trial and Appeal Board rendered a decision refusing registration of the mark DUROX for a "liquid primer-sealer surface coating which may also be used as an additive for paints, enamels and lacquers," in view of a prior registration of the mark DURON for "ready mixed paint, varnishes, wood stains, rubber base paint, and paint enamels."<sup>6</sup> The decision of the Board<sup>7</sup> was, in effect, modified on appeal to the United States District Court for the District of Maryland. The District Court dismissed plaintiff's complaint "without prejudice" to plaintiff's right to apply for a registration of DUROX for goods described as "liquid chemical composition for use as an additive for automotive paints, enamels, and lacquers."<sup>8</sup>

Immediately following the decision of the District Court, the applicant filed an amendment to his application before the Patent Office, cancelling the original description of goods and substituting therefore the description of goods as approved by the District Court. It is the brief history of the treatment of this amendment by the Patent Office with which the present article is concerned.

Upon receiving the tendered amendment, the Examiner of Trademarks requested that the Commissioner grant jurisdiction over the application to him for the purpose of entering and considering the proposed amendment. While this request for jurisdiction appeared to be premature, in view of the fact that the limit of appeal to the Court of Appeals had not yet expired, the Assistant Commissioner of Patents granted jurisdiction over the application to the Examiner. While a narrative of subsequent events appears to be unnecessary, we might point out that proceedings in the application were later suspended pending termination of the appeal before the Court of Appeals for the Fourth Circuit.

While the Commissioner's action in restoring jurisdiction over the application to the Examiner in the case is justifiable in principle (disregarding for the moment the fact that jurisdiction was granted before the limit of appeal had expired), it is curious to note that no authority was cited either in the

<sup>5</sup> Rule 2.142 (d), Rules of Practice in Trademark Cases, 37 C.F.R. § 2.142 (d) (1955); Applications which have been considered and decided on appeal will not be reopened except by order of the Commissioner and then only for consideration of matters not already adjudicated, sufficient cause being shown.

<sup>6</sup> Registration No. 581,794 issued November 3, 1953.

<sup>7</sup> *Duron Paint Mfg. Co., Inc. v. The Durox Co.*, 125 U.S.P.Q. 534 (Patent Office Trademark Trial and Appeal Board 1960), hereinafter referred to as P.O.T.T. & A. Bd.

<sup>8</sup> *The Durox Co. v. Duron Paint Mfg. Co., Inc.*, 193 F. Supp. 829, 129 U.S.P.Q. 180 (D.Md. 1962), affirming 125 U.S.P.Q. 534 (P.O.T.T. & A. Bd. 1960). An appeal in this case is pending before the Court of Appeals for the Fourth Circuit.

Commissioner's action granting jurisdiction or in any of the later actions. This would appear to be a case in which the Commissioner saw his duty (as regards expeditious disposition of the application) and performed it promptly. Laying aside the unfortunate circumstance that the amendment was presented at an inopportune time, the *Durox* case clearly points up one instance in which the Patent Office was most willing to dispose of a long pending application simply by consideration of a single amendment after appeal.

The second case of interest also points up the willingness of the Patent Office to dispose of an application promptly after appeal, by entry of a single amendment. In this case, the Trademark Trial and Appeal Board affirmed the Examiner's refusal to register the familiar background design used on labels affixed to containers for the products of Esso Standard Oil Company.<sup>9</sup> A divided Court of Customs and Patent Appeals reversed the decision of the Trademark Trial and Appeal Board, two judges expressing the opinion that there was an inherent distinctiveness in applicant's mark, one judge concurring in the result, one judge concurring as to the registrability but disagreeing as to inherent distinctiveness, and one judge dissenting.<sup>10</sup>

After the decision of the Court, jurisdiction over the application was conferred upon the Examiner by the Commissioner, purportedly for the purpose of obtaining an affidavit of distinctiveness under Rule 2.41 of the Trademark Rules of Practice. The Examiner picked apart the decision of the Court of Customs and Patent Appeals, stating that "only two of the judges held that the design was inherently distinctive and it follows that the mark may be registered on the Principal Register only on the basis of secondary meaning."<sup>11</sup> On this basis the Examiner required an affidavit of distinctiveness under Rule 2.41 (a).<sup>12</sup> After an objection by applicant to this requirement, the notice of publication under Section 12 (a) of the Trademark Act was issued.<sup>13</sup>

The *Esso* case establishes an even more aggressive attitude by the Patent Office than did the *Durox* case, in that the Commissioner apparently acted *sua sponte* in granting jurisdiction to the Examiner of Trademarks. In the *Esso* case, not only was there no request by the applicant for amendment, but also the Court of Customs and Patent Appeals did not remand the case to the

<sup>9</sup> *In re Esso Standard Oil Co.*, 124 U.S.P.Q. 77 (P.O. T.T. & A. Bd. 1960).

<sup>10</sup> *In re Esso Standard Oil Co.*, 134 U.S.P.Q. 402 (C.C.P.A. 1962), *rev'ng* 124 U.S.P.Q. 77 (P.O. T.T. & A. Bd. 1960).

<sup>11</sup> Paper No. 32, *Esso Standard Oil Co.*, Serial No. 19,010 filed November 9, 1956.

<sup>12</sup> 37 C.F.R. §2.41 (a) (1955).

<sup>13</sup> While the Examiner expressed the view that an affidavit of distinctiveness was called for in application Serial No. 19,010, the Board, upon receiving the decision of the Court of Customs and Patent Appeals, reversed the Examiner's refusal to register the applicant's mark in two companion cases (applications Serial Nos. 19,011 and 19,012 filed November 9, 1956). The Board made no requirement of submitting an affidavit of distinctiveness.

Patent Office "for further proceedings." The mandate of the court read simply: "The decision of the board is reversed."<sup>14</sup>

The third case which commends itself to our consideration involved an application to register the trademark SHAMPOO PLUS EGG for "hair conditioning shampoo." The Trademark Trial and Appeal Board affirmed the Examiner's refusal to register applicant's mark on the Principal Register.<sup>15</sup> In a civil action filed in the United States District Court for the District of Columbia under Section 21 of the Trademark Act, on motion of plaintiff, an order of voluntary dismissal was entered with prejudice to applicant's right to obtain a registration on the Principal Register under Section 2 (f), on the record and the application then before the Court. But the dismissal was entered without prejudice to applicant's right to seek registration of its mark on the Supplemental Register on that application, or by appropriate proceedings in the Patent Office on a new application in accordance with the provisions of Section 2 (f). Prior to entry of the voluntary dismissal judgment, applicant had submitted an amendment in its application in the Patent Office, converting it to an application for registration of its mark on the Supplemental Register. As in the *Durox* case, the Examiner requested jurisdiction over the application upon receipt of the amendment, but jurisdiction was denied by the Commissioner. Applicant objected, but the Commissioner repeated the denial in successive actions. The position of the Patent Office as to why the *Helene Curtis* case stands on a different footing from the *Durox* and *Esso* cases is not clear. In contrast with the *Durox* and *Esso* cases in which jurisdiction over the applications was granted to the Examiner, the denial in the *Helene Curtis* case was replete with both statutory and decisional citations.<sup>16</sup>

At this point we wish to call into question the rationale of the cases cited in *Helene Curtis*. We question their reliability as authorities, both in terms of the apparent distaste for the cases as shown by disregard of them in certain Patent Office determinations, and in terms of the dilatory effect which invocation of these cases has upon much of the procedure in trademark cases.

The Patent Office's reluctance to enter amendments after an application has left the jurisdiction of the Trademark Examiner appears to have had its beginning on the very day the 1946 Act<sup>17</sup> became effective. In *Ex parte W. A. Sheaffer Pen Company*,<sup>18</sup> the Examiner refused to accept an amendment under

<sup>14</sup> *In re Esso Standard Oil Co.*, 134 U.S.P.Q. at 405.

<sup>15</sup> *In re Helene Curtis Industries, Inc.*, 125 U.S.P.Q. 352 (P.O. T.T. & A. Bd. 1960).

<sup>16</sup> The cases cited included *Ex parte W. A. Sheaffer Pen Co.*, 75 U.S.P.Q. 326 (Com'r. Pats. 1947); *Ex parte The Wayne Pump Co.*, 91 U.S.P.Q. 246 (Com'r. Pats. 1951); *Ex parte Monsanto Chemical Co.*, 91 U.S.P.Q. 269 (Com'r. Pats. 1951) and *Ex parte Sightmaster Corp.*, 95 U.S.P.Q. 43 (Com'r. Pats. 1951).

<sup>17</sup> 60 Stat. 427 (1946), 15 U.S.C. § 1051-1127 (1958).

<sup>18</sup> 75 U.S.P.Q. 326 (Com'r. Pats. 1947).

Section 47 (a) <sup>19</sup> of the new Act, by which the applicant sought to convert his application under the 1905 Act to one under Section 2 (f) of the 1946 Act. The Court of Customs and Patent Appeals had found the applicant's mark unregistrable under the 1905 Act on the ground of descriptiveness.<sup>20</sup> Applicant sought to avail himself of the "secondary meaning" provision of Section 2 (f) of the new Act by filing an amendment to the application already filed under the 1905 Act, rather than by filing a new application. The amendment was filed on July 5, 1947, the effective date of the 1946 Act. After the Examiner refused to enter the proposed amendment, on the ground that to do so would be "impracticable," the applicant petitioned the Commissioner to exercise his supervisory authority over the Examiner by directing entry of the amendment and by publishing applicant's mark.

In a carefully considered opinion, Assistant Commissioner Daniels directed acceptance of the amendment under Section 47 (a). Apparently finding some difficulty in justifying entry of the Sheaffer amendment on the ground of practicability, the Assistant Commissioner indulged in a bit of circumspect reasoning, touching the desire for an end to Patent Office litigation, the need for some discretion in these administrative procedures, and even the purpose of the 1946 Act.<sup>21</sup>

The Assistant Commissioner's opinion can be briefly summarized in his own words:

In view of the substantial showing of probable loss of rights to applicant [*i.e.* loss of foreign applications based upon the U.S. application] it is considered that this presents a case for exercise of any discretion available to the Patent Office, and it is believed that it is "practicable" to enter the amendment to bring the application under the provisions of the Trademark Act of 1946.<sup>22</sup>

Upon careful consideration of the reasoning contained in this opinion, and of its later consequences, it is submitted that the rule of amendment now followed by the Patent Office which apparently flows from the decision and dicta

<sup>19</sup> Section 47 (a), 60 Stat. 427 (1946), 15 U.S.C. § 1051 note (1958), reads in pertinent part: "All applications for registration pending in the Patent Office at the effective date of this Act may be amended, *if practicable*, to bring them under the provisions of this Act."

<sup>20</sup> Trademark Act of 1905 § 5, 33 Stat. 725 (1905).

<sup>21</sup> "2. To carry out by statute our international commitments to the end that American traders in foreign countries may secure the protection to their marks to which they are entitled." 75 U.S.P.Q. at 329. Note: Sheaffer had filed a number of foreign applications based upon the United States application. If the present application were to be abandoned, Sheaffer stood to lose substantial rights in foreign countries. It was this situation perhaps, more than any other factor in the case, which influenced the Commissioner's decision. The case is still cited today for the dictum that there must be substantial rights of an applicant involved before the Commissioner will depart from Rule 2.142 (d). See *Ex parte Helene Curtis Industries*, 134 U.S.P.Q. 73 (Com'r. Pats. 1962).

<sup>22</sup> 75 U.S.P.Q. at 329.

in the *Sheaffer* case is in need of reconsideration and clarification. The rule requiring a showing of "good cause" does not rest upon a sound basis, and indeed, can have no sound basis if all the objects and purposes of the 1946 Act are to be met.

There are several reasons why the "good cause" doctrine of the *Sheaffer* case should not be extended to present day practice regarding amendments to trademark applications pending in the Patent Office. The Examiner of Trademarks who reviewed the amendment tendered by Sheaffer, found that it was "not practicable" to enter the amendment nearly six months after termination of proceedings before the Court of Customs and Patent Appeals. On petition, the Assistant Commissioner found that, "in an ordinary case, it is believed that this would be correct,"<sup>23</sup> because indiscriminate transfer of applications from the 1905 Act to the 1946 Act after final disposition of issues under the 1905 Act would be ". . . undesirable and contrary to the principles that 'there must be an end to litigation, even in the Patent Office.'"<sup>24</sup> With the general propositions stated, there can be no quarrel, but the significance of these propositions is greatly lessened when they are broadly applied in those cases in which a single amendment will place an application in condition for publication of the mark sought to be registered. Assistant Commissioner Daniels treated the *Sheaffer* case as an extreme exception to the rule which he thought should obtain, whereas there appears to be no sound reason why all cases should not be treated as the *Sheaffer* case was, when the result is a substantial saving of time and effort by both applicant and the Patent Office. The Trademark Rules of Practice have brought about a distinction between cases in which an applicant seeks entry of an amendment and cases in which the Patent Office sees need for an amendment after the application has left the Examiner. In most cases, the amendments requested by applicants are substantially the same as those which the Patent Office has often ordered in other cases and the distinction in treatment of the cases appears to be unwarranted.

While there must indeed be an end to Patent Office litigation, the expedience contemplated by the rule against "reopening" is lost when a new case must be begun and a new record built after so much time has already been spent in building a record, most of which effort will be repeated in the new application.

Practicability was the touchstone built into Section 47 (a) of the new Act, and the Assistant Commissioner expressed the view that "'practicable' however, implies compliance with established courses of administrative procedure, and necessarily involves some measure of discretion."<sup>25</sup> At this point we seem

<sup>23</sup> *Id.* at 328.

<sup>24</sup> *Ibid.*

<sup>25</sup> *Ibid.*

to enter the gray area which has shrouded much of the practice before the Patent Office in the full spectrum of cases, not only under Section 47 (a), but in all cases raising the question of entry of an amendment after the application has left the hands of the Examiner. One must ask himself whether "practicable" should mean "at the convenience of the Patent Office," or "in the best interests of the parties," or should it mean "at the discretion of the Patent Office." If discretion is to be the test, as it apparently was in *Durox*, *Esso* and *Helene Curtis*, it may be asked whose discretion shall control, and what constitutes abuse of such discretion. In the *Sheaffer* case, the Assistant Commissioner stated that in exercising his discretion, he found it practicable to order entry of the amendment, yet he did not find that the Examiner abused any discretion by refusing to enter the amendment. Does this discretion lie only with the Commissioner, and is it exercisable only upon petition? If discretion lies only with the Commissioner, how is the Examiner to decide whether or not to accept an amendment? Even if there is no abuse of discretion in each individual case does the exercise of that discretion in different ways in different cases result in "arbitrary and capricious action?"

Many of these questions have now been answered by the Rules of Practice in Trademark Cases which generally require that jurisdiction over applications no longer before the Examiner, can be granted to the Examiner only by the Commissioner's order.<sup>26</sup> But while the Trademark Rules of Practice have apparently settled the procedure in most cases where amendment is sought, the rationale of the *Sheaffer* case still influences the decisions made by the Commissioner upon such petitions<sup>27</sup> as is shown by later cases.

Several years after the *Sheaffer* case, three more "amendment" cases came to the attention of Assistant Commissioners. We shall not delve into the facts of these cases here, it being sufficient for our purpose to point out that in each of the three cases, the application had passed from the Examiner so that it would have been necessary to restore jurisdiction to him if the amendment were entered.

In two of the cases, the applicants sought entry of amendments under Section 2 (f) of the 1946 Act,<sup>28</sup> and the third applicant sought entry of an amendment from the Principal to the Supplemental Register.<sup>29</sup> All three

<sup>26</sup> Cases contemplated by the Rules of Practice include: a) applications considered and decided on appeal, Rule 2.142 (d); b) applications allowed or published, Rule 2.84; c) cases not specifically covered elsewhere in the rules. Rules 2.146 and 2.147.

<sup>27</sup> Witness the *Helene Curtis* case in which the *Sheaffer* case is cited by the Commissioner for the proposition that, "no showing appears in this case to indicate extenuating circumstances justifying a departure from Rule 2.142 (d)." (134 U.S.P.Q. at 73). It was a later decision on a request for reconsideration in which the Commissioner tied in the *Sheaffer* case with the *Wayne Pump* and *Monsanto* cases, *supra* note 16.

<sup>28</sup> *Ex parte* The Wayne Pump Co. and *Ex parte* Monsanto Chemical Co., *supra* note 16.

<sup>29</sup> *Ex parte* Sightmaster Corp., *supra* note 16.

petitions for entry of amendment were denied by the Commissioner on the ground that the applicants had prosecuted their applications to the point of appeal, had had full review by the Examiner on the original applications and that no circumstances had been shown to justify "reopening" the applications. It should be pointed out that the Rule at that time<sup>30</sup> was substantially the same as the present Rule<sup>31</sup> governing entry of amendments to applications after appeal. The former Rule however, did not carry the requirement that applicant show "good cause" for reopening the application. The revised Rule added that cases could be reopened, only for consideration of matters not already adjudicated, "sufficient cause being shown."<sup>32</sup> It is submitted that the addition of the requirement for a showing of good cause was unnecessary, has led to needless protraction of relatively simple cases and that this requirement should be abolished in favor of a rule that amendments will be permitted unless to do so would be impracticable.<sup>33</sup>

We can best see the influence of the *Sheaffer* case today by inspecting the microcosm represented by the *Durox*, *Esso* and *Helene Curtis* cases. On the one hand, it would seem it need only be found "practicable" to "reopen" a case if the Patent Office is seeking the "reopening," while on the other, there must be both "practicability" and "good cause" to reopen a case if the applicant makes the request.<sup>34</sup> A seemingly irreconcilable case however is the *Durox* case, in which jurisdiction for consideration of an amendment was granted, not on applicant's petition to the Commissioner "for good cause shown," but by virtue of an Examiner's request for jurisdiction. This case appears to clearly demonstrate that in at least some cases, it is completely practicable to enter the amendment, and that perhaps the "good cause shown" rule stated in Rule 2.142 (d) is unnecessary.

We submit that the time has come for a review and reconsideration either of what should constitute "good cause shown" as required by the present rule, or whether the requirement should be deleted altogether in the interest of the fundamental purposes of the Act:

To remedy constructions of the present acts which have in several instances obscured and prevented their original purpose.

Generally to simplify trade-mark practice, to secure trademark owners in the

<sup>30</sup> 12 F.R. 3956 (1947) (abolished July 7, 1955).

<sup>31</sup> Rule 2.142 (d), *supra* note 5.

<sup>32</sup> *Ibid.*

<sup>33</sup> Many of the procedural difficulties in practice before the Patent Office arise out of application of the rules of Patent practice to trademark cases. This procedure often overlooks the fact that the fundamentals of patent cases *vis a vis* trademark cases, and the rights growing out of filing dates in each type of case, are distinctly different.

<sup>34</sup> See earlier discussion of the *Helene Curtis* case, particularly footnote 27.

goodwill which they have built up, and to protect the public from imposition by the use of counterfeit and imitated marks and false trade descriptions.<sup>35</sup>

In support of the position that liberalization of the rules regarding entry of these amendments and restoration of jurisdiction to the Examiner for the purpose of considering them, we find a number of cases in which amendments and other actions have been entered under the circumstances outlined above. These cases appear to adopt the spirit of the 1946 Act as intended by Congress, and seem to find none of the difficulty or caution which pervades the *Sheaffer*, *Wayne Pump*, *Monsanto* and *Sightmaster* cases.<sup>36</sup> An attempt to find a distinction between those cases which refuse amendment on petition to the Commissioner, and those in which amendment has been freely permitted is an unrewarding one.

To note but a few of those cases in which further action has been permitted before the Examiner, we find that jurisdiction over applications has been restored to the Examiner after *ex parte* appeal or after opposition proceedings have terminated, for consideration of amendments setting forth (1) the correct dates of first use and properly identifying the goods;<sup>37</sup> (2) the correct date of first use;<sup>38</sup> (3) evidence supporting the date of first use alleged;<sup>39</sup> (4) amendment to description of goods;<sup>40</sup> (5) evidence showing use of the mark on specified goods;<sup>41</sup> (6) evidence showing use of the mark on specified goods or deleting reference to such goods;<sup>42</sup> (7) evidence of use of the mark;<sup>43</sup> (8) augmentation of the record (appeal suspended pending augmentation before the Examiner);<sup>44</sup> (9) election as to three alternatives, namely, seek review by District Court, amend application to Supplemental Register, or delete objectionable material from drawing;<sup>45</sup> (10) showing of distinctiveness under Rule 2.41.<sup>46</sup>

Most significant in addition to the above cases, however, is a case in which

<sup>35</sup> S. Rep. No. 1333, 79th Cong., 2nd Sess. 4 (1946).

<sup>36</sup> *Supra* note 16.

<sup>37</sup> *Schenley Industries, Inc. v. Battistoni*, 112 U.S.P.Q. 485 (Com'r. Pats. 1957).

<sup>38</sup> *Sears, Roebuck and Co. v. Haymer*, 114 U.S.P.Q. 404 (Com'r. Pats. 1957); *The B. F. Goodrich Co. v. National Cooperatives, Inc.*, 114 U.S.P.Q. 406 (Com'r. Pats. 1957).

<sup>39</sup> *Metal Masters Co. v. Enco Mfg. Co.*, 114 U.S.P.Q. 448 (Com'r. Pats. 1957).

<sup>40</sup> *Ex parte Palm Beach Co.*, 114 U.S.P.Q. 463 (Com'r. Pats. 1957).

<sup>41</sup> *Rough Rider, Inc. v. Mid-American Mfg. Co.*, 115 U.S.P.Q. 229 (Com'r. Pats. 1957).

<sup>42</sup> *Hollymatic Corp. v. Hollywood Water Heater Co.*, 115 U.S.P.Q. 421 (Com'r. Pats. 1957), *affd.* 124 U.S.P.Q. 452 (C.C.P.A. 1960).

<sup>43</sup> *Otto Niederer Sons, Inc. v. Braunsberg*, 116 U.S.P.Q. 524 (Com'r. Pats. 1958); *Pioneer Hi-Bred Corn Co. v. Rucker's Poultry Farm and Hatcheries, Inc.*, 118 U.S.P.Q. 165 (Com'r. Pats. 1958); *Ex parte Clary Corp.*, 118 U.S.P.Q. 168 (Com'r. Pats. 1958).

<sup>44</sup> *Ex parte Ohio Knife Co.*, 117 U.S.P.Q. 449 (Com'r. Pats. 1958).

<sup>45</sup> *In re The Chase-Shawmut Co.*, 120 U.S.P.Q. 320 (P.O. T.T. & A. Bd. 1959).

<sup>46</sup> *In re Magnetics, Inc.*, 122 U.S.P.Q. 405 (P.O. T.T. & A. Bd. 1959); *In re Speer Filler Strip Co.*, 122 U.S.P.Q. 614 (P.O. T.T. & A. Bd. 1959).

applicant petitioned for reconsideration of an adverse decision of the Trademark Trial and Appeal Board and at the same time moved to amend the application to the Supplemental Register.<sup>47</sup> While the Board denied the petition for reconsideration and found it had no jurisdiction to entertain the motion to amend, it recommended that applicant petition the Commissioner to grant jurisdiction over the application. The editor's note following the case states: "Petition to grant jurisdiction to Examiner of Trademarks was approved June 23, 1959."<sup>48</sup> It is not seen how the circumstances of this case differ from any of the circumstances in cases denying entry of the amendment, and it is urged that the rule of the *Vari-Krom* case be recognized.

The contrast among the three groups of cases set forth herein seems to be at first glance marked by a question which might be phrased, "What course of action in a particular case will have the most convenient results for either the Patent Office or the interested parties?" The answer to this question in each case does not appear to be found in consistent, well considered rules or guide lines, but in an *ad hoc* consideration by the Patent Office of some intangible and unenunciated quantity.

The *Sheaffer* case and those following it seem to point to "discretion" as the touchstone, but the factors influencing the exercise of that discretion are unknown. Some of the cases appear to be denounceable as the result of "arbitrary and capricious action." The more recent cases in which Assistant Commissioner Leeds participated, while perhaps decided under Rule 2.131,<sup>49</sup> are also based upon the exercise of discretion and consideration of convenience to the parties. In what way these cases differ from the earlier cases, however, is left only to speculation. It is unquestionable that these later cases raised fewer problems and provided far more expedient results, saving time and money for the Patent Office and the applicants.

The *Durox*, *Esso* and *Helene Curtis* cases point up the serious lack of uniformity in treatment of these cases. The *Durox* case seems to most closely approximate the liberal cases permitting amendment, although the authority for entering the amendment in that case is highly questionable since the case came from a District Court.<sup>50</sup>

The *Esso* case seems to surpass even the most liberal of the "reopening" cases in that the Court of Customs and Patent Appeals made no statement in its opinion calling for "further proceedings" in the Patent Office.

Perhaps it can best be said that the *Durox* and *Esso* cases were instances in which the Patent Office was most anxious to see to its task as guardian of the

<sup>47</sup> *In re Vari-Krom, Inc.*, 121 U.S.P.Q. 630 (P.O. T.T. & A. Bd. 1959).

<sup>48</sup> *Id.* at 631.

<sup>49</sup> *Supra* note 3.

<sup>50</sup> The questions arising out of the 1946 Act with respect to the jurisdiction, judgments and orders of District Courts are themselves worthy of a complete comment.

public interest, and in so seeking, perhaps blinked its eye at procedural policies.

The *Helene Curtis* case, however, is a clear return to the *Sheaffer* line of cases and does not appear to square on principle either with *Durox* and *Esso*, or with the purposes of the statute as outlined in the Senate Committee Report.

In conclusion, it is submitted that the policy of permitting or restricting amendments to trademark applications, as enunciated in the Rules of Practice and as reflected in the *Durox*, *Esso* and *Helene Curtis* cases, bears such a lack of uniformity that careful review is in order. Whether revision of Rule 2.142 (d) is called for by eliminating the requirement for the showing of good cause, or whether the Rule as it now stands can be interpreted liberally, are questions of which we would urge serious consideration. It would be hoped that, at the very least, some uniform guide lines would be set out for determining the procedure in such cases as those discussed here. Substantial economies would surely result in time, effort, and money, both to applicants and the Patent Office, if the rule of amendments were liberalized. The liberalization urged here should not be considered to be either revolutionary or controversial. Indeed Congress, in its statement of purposes of the Act, sought . . .

Generally to simplify trademark practice, to secure trademark owners in the goodwill which they have built up, and to protect the public from imposition by the use of counterfeit and imitated marks and false trade descriptions.<sup>51</sup>

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<sup>51</sup> S. Rep. No. 1333, 79th Cong., 2nd Sess. 4 (1946).