

Re: Trademark Registration of :
 Warner Communications Inc. :
 Registration No. 1,020,406 :
 Issued: September 16, 1975 : On Petition
 For: NONESUCH and N Design :
 Petition Filed: April 23, 1997¹ :

Warner Communications Inc. has petitioned the Commissioner to grant renewal of the above identified registration. 37 C.F.R. §§2.146(a)(2), 2.146(a)(5), 2.148 and 2.184(b) provide authority for the requested review. The petition is denied under 15 U.S.C. §1059.

FACTS

The above registration issued for the mark NONESUCH and N Design used to identify “phonograph records and pre-recorded tapes” on September 16, 1975. Pursuant to 15 U.S.C. §1059, an application for renewal of the registration was due to be filed within the six months preceding September 16, 1995, or, on payment of a late fee, within the three month grace period following that date.²

On September 13, 1995, Petitioner filed a renewal application stating that the mark is still in use in interstate commerce on the goods recited in the registration, along with a specimen showing the mark currently used on “compact discs.” By letter dated November 1, 1995, the Affidavit-Renewal Examiner notified Petitioner that renewal was withheld because the specimen showed use of the mark on goods different from those identified in the registration. Petitioner was advised that a new specimen must be submitted prior to the expiration of the period for which the

¹ On September 9, 1998 and September 30, 1998, Petitioner submitted supplemental papers in support of the petition.

² Petitioner filed a renewal application on March 9, 1995. In a letter dated May 31, 1995, the Post Registration Affidavit/Renewal Examiner rejected the renewal application as premature because the date of execution of the renewal application preceded the beginning of the sixth month prior to the expiration of the twenty-year period. Petitioner was advised that a newly-executed renewal application was due on or before September 16, 1995.

registration was issued, or within the grace period thereafter with a late fee of \$100 per class. This petition followed.³

A substitute specimen showing use of the mark on pre-recorded tapes and a declaration stating that the substitute specimen was in use in commerce prior to the expiration of the period for filing the renewal application were submitted on petition. The issue for review is whether the Office can accept the substitute specimen received after the expiration of the statutory time period for filing the renewal application.

ANALYSIS

15 U.S.C. §1059, requires that an application for renewal of a registration be filed within six months prior to the expiration of the period for which the registration was issued or renewed or, on payment of a late fee, within the three month grace period following that date. A complete renewal application must include, *inter alia*, a statement of the goods or services for which the mark is being used, **and a specimen showing how the mark is currently used.** *In re Culligan International Co.*, 915 F.2d 680, 16 USPQ2d 1234 (Fed. Cir. 1990); *In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984).

The renewal specimen must show use of the mark on the same goods or services that are identified in the registration. A specimen evidencing use of the mark on different goods or services does not meet the requirements of the statute. This is true even if the specimen evidences use of the mark on goods or services that are closely related to those recited in the registration. *In re Capp Enterprises, Inc.*, 32 USPQ2d 1855 (Comm'r Pats. 1993).

In this case, the registration covers only “phonograph records and pre-recorded tapes.” The specimen submitted with the renewal application shows use of the mark on “compact discs.” The Affidavit-Renewal Examiner properly refused to renew the registration because the renewal specimen did not show use of the mark on the goods recited in the registration.

Petitioner requests that the Commissioner accept the substitute specimen submitted after the expiration of the statutory period for filing the renewal application. However, while it is unfortunate that the Office Action affording Petitioner the opportunity to file a new specimen during the statutory period may have been lost or misdirected, the filing of a specimen or facsimile specimen showing current use of the mark is a statutory requirement that must be

³ A petition to the Commissioner requesting review of the refusal to a renewal application must be filed within six months from the date of mailing of the refusal. 37 C.F.R. §2.184(b). However, Counsel for Petitioner declares that the November 1, 1995 Office Action denying the renewal application was never received. 37 C.F.R. §2.184(b) is waived because the circumstances in this situation are extraordinary and because timeliness is not a provision of the statute and no party will be harmed thereby. 37 C.F.R. §2.146(a)(5) and 2.148. In this case, Counsel acted diligently in the filing of §9 renewal and in monitoring the status of the registration. *Trademark Manual of Examining Procedure* (TMEP) §413.

Counsel for Petitioner declares that she first became aware of the Office Action after contacting the Post Registration Section to determine the status of the registration and the renewal application. A copy of the Office Action was subsequently transmitted via fax to Counsel on October 24, 1996. The petition was filed on April 23, 1997.

satisfied prior to the expiration of the period for applying for renewal. 15 U.S.C. §1059; *see* TMEP §1605.06. The Commissioner has no authority to extend this period for any reason. *In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984); *Ex parte Firmenich & Co.*, 137 USPQ 476 (Comm'r Pats. 1963).

DECISION

The petition is denied. The registration is expired. The registration file shall be forwarded to the Post Registration Section for notation on the file and entry in the TRAM (Trademark Reporting and Monitoring) System that the registration has expired.

Should Petitioner wish to file a new application for registration of its mark, the Office will, upon request, expedite handling of the application. *See* TMEP §1102.03.

Robert M. Anderson
Acting Assistant Commissioner
for Trademarks

RMA:CLB

Date:

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