

Re: Trademark Application of :
 Surgidvne, Inc. :
 Registration No. 1,577,588 : On Petition
 Issued: January 16, 1990 :
 For: SURGIDYNE and Design :
 Petition Filed: December 9, 1996 :

Surgidyne, Inc. has petitioned the Commissioner to reinstate the above-identified registration, which was cancelled for failure to file a properly executed affidavit or declaration pursuant to Section 8 of the Trademark Act, and to accord a filing date of December 28, 1995 to the previously submitted declaration under Sections 8 & 15. Trademark Rule Sections 2.146(a)(2) and 2.165(a)(2), 37 C.F.R. Sections 2.146(a)(2) and 2.165(a)(2) provide authority for review. The petition is denied under Section 8 of the Trademark Act.

FACTS

Registration No. 1,577,588 issued on January 16, 1990. Pursuant to Section 8 of the Trademark Act, 15 U.S. C. § 1058, Registrant was required to file an affidavit or declaration of continued use or excusable nonuse between the fifth and sixth year after the registration date, that is, between January 16, 1995 and January 16, 1996.

On December 28, 1995, Petitioner filed a combined Section 8 & 15 declaration. In an Office Action dated June 24, 1996, the Affidavit/Renewal Examiner withheld acceptance, *inter alia*, because the paper was not notarized or in the form of a declaration pursuant to Trademark Rule Section 2.20, 37 C.F.R. Section 2.20. Petitioner was advised that since the time for filing a properly executed affidavit or declaration had expired, the registration would be cancelled. This petition followed.¹

DECISION

Section 8 of the Trademark Act, 15 U.S.C. § 1058, provides, in part:

[T]he registration of any mark under the provisions of this Act shall be cancelled by the Commissioner at the end of six years following its date, unless within one year next

¹ Trademark Rule 2.165(a)(2), 37 C.F.R. Section 2.165(a)(2) states that a request for reconsideration shall be a condition precedent to a petition to the Commissioner to review a refusal of an affidavit, unless the first action refusing the affidavit directs the registrant to petition the Commissioner for relief. Although not directed to petition, it was reasonable for Petitioner to conclude that a request for reconsideration would be ineffective. Thus the petition is deemed properly filed.

Petitioner submitted a revised declaration under Sections 8&15 with the petition. However, since this document was filed after the statutory period, it will not be considered.

preceding the expiration of such six years the registrant shall file in the Patent and Trademark Office an affidavit setting forth those goods or services recited in the registration on or in connection with which the mark is in use in commerce and attaching to the affidavit a specimen or facsimile showing current use of the mark, or showing that any nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark....

Petitioner states that the omission of the declaration statement was a typographical error; that the declaration, stating the substance of what was required, was filed in good faith; and that the papers should be provisionally accepted under 35 U.S.C. Section 26.

35 Section 26 provides that a document required to be executed in a specified manner may be provisionally accepted by the Commissioner despite a defective execution, provided a properly executed document is submitted within such time as may be prescribed. The application of the statute is discretionary, not mandatory. *Schenley Industries, Inc. v. E. Martinoni Co.*, 161 USPQ 279 (C.C.P.A. 1969). Whether such papers will be accepted depends upon the nature of the defect and the surrounding circumstances. *Er parse Louisville & Nashville RR. Co.*, 171 USPQ 49 (Comm'r Pats. 1971).

Failure to file an affidavit in accordance with the requirements of the statute within the statutory time period is not considered a defect in execution that warrants relief under 35 U.S.C. Section 26. *In re Precious Diamonds, Inc.*, 208 USPQ 410 (C.C.P.A. 1980); *In re Laboratories Goupil, S.A.*, 197 USPQ689 (Comm'r Pats. 1977). *See also In re Weider*, 212 USPQ 947 (Comm'r Pats. 1981)(The absence of a statement attesting to awareness of penalty of perjury is not considered a minor defect in execution under 35 U.S.C. Section 26).

The circumstances in this case do not merit application of 35 U.S.C. Section 26 because Petitioner's Sections 8 & 15 submission did not contain an affidavit as required by Section 8 of the Trademark Act, nor did it contain a declaration in conformance with Trademark Rule 2.20, 37 C.F.R. Section 2.20. Accordingly, the petition is denied. The registration remains cancelled.

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.

Philip G. Hampton, II
Assistant Commissioner
for Trademarks

PGH:NLO:CLB

Date:

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