

Re: Trademark Registration of :
 Mare-Bare, Inc. :
 Registration No. 1,580,234 :
 Issued: January 30, 1990 : On Petition
 For: STARDUST :
 Petition Filed: December 30, 1996 :

Mare-Bare, Inc. has petitioned the Commissioner to accept a Section 8 Affidavit for Class 28 goods, filed in connection with the above identified registration. The petition is denied pursuant to Trademark Rules 2.146(a)(3), 2.146(a)(5) and 2.148.

FACTS

The above registration issued on January 30, 1990 for the following four international classes: 28 (“dice”), 39 (“recreational vehicle and motorhome parking services”), 41 (“casino services”) and 42 (“hotel, restaurant, bar, night club, beauty salon and barbershop, and retail gift store services”). 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, i.e., between January 30, 1995 and January 30, 1996.

On June 26, 1995, Petitioner submitted a combined Section 8 and 15 Affidavit, a check for \$200, and three copies of a brochure identifying the “Stardust Resort & Casino, Las Vegas, Boyd Gaming Corporation.”¹ The brochure advertises the hotel and casino and makes no reference in the text or in any photographs to the class 28 goods identified in the registration. In addition, the combined Affidavit expressly excluded class 39. No other specimens were included with the Affidavit other than the three brochures.

On April 3, 1996, the Affidavit-Renewal Examiner issued an office Action notifying Petitioner that the Affidavit could not be accepted for Class 28 because a specimen showing current use of the mark had not been submitted. In addition, Petitioner was informed that the current filing fee for a combined Affidavit was \$200 per class, and thus Petitioner had submitted fees sufficient for only one class. At the end of the letter, Petitioner was advised that, “[i]n the absence of a proper response filed within six months of the mailing date of this letter, classes 41 and 42 [would] be accepted for [the] Section 8 only.”

¹ There is no indication of an assignment of the registration to the named entity on the specimens. nor was an explanation submitted by Petitioner as to the nature of its relationship with this entity.

² Petitioner submitted dice for the class 28 goods. The declaration in support of these specimens is signed by a corporate officer who declared that “[t]he substitute specimens submitted herewith for the goods recited in Class 28, which goods were in use in both intrastate and interstate commerce at least as early as March 1, 1985, the date of first use recited in the Registration.”

On September 18, 1996, Petitioner submitted verified specimens for the class 28 goods² as well as \$400 to cover the two remaining classes. In a letter dated November 21, 1996, the Affidavit Renewal Examiner canceled class 28 from the registration, noting that “[t]he specimen submitted for class 28 cannot be considered since the time in which to file timely specimens within the sixth year has passed “.³

This petition followed.⁴ Counsel for Petitioner argues that the Section 8 Affidavit properly complied with all statutory requirements for the three international classes 28, 41 and 42. Specifically, Counsel notes that there is no statutory requirement that specimens be submitted for each class prior to the sixth year. In addition, Counsel argues that the first refusal letter was mailed over nine months after the filing of the affidavit and substantially after the sixth year due date, and thus the lack of timely notice precluded a timely submission of the class 28 specimen.

DECISION

Section 8 requires that an affidavit or declaration under Section 8 of the Act be accompanied by a specimen showing current use of the mark. 15 U.S.C. § 1058. While the Act does not contain a “per class” specimen requirement, Trademark Rule 2.162(e), 37 C.F.R. §2.162(e), specifies that the affidavit or declaration must “be accompanied by a specimen or facsimile, for each class of goods or services, showing current use of the mark.”

Pursuant to Trademark Rule 2.162(e), a registrant who has submitted a “deficient” specimen for a class of goods or services may cure the deficiency after the sixth year has expired. For example, a registrant who submits an advertisement as a specimen of trademark usage of a mark for goods may cure the deficiency after the sixth year has expired, as long as the advertisement pertained to those same goods recited in the registration. *In re Brittain's Tullis Russell, Inc.*, 23 USPQ2d 1457 (Comrn’r Pats. 1992). However, a specimen showing use of the mark on or in connection with different goods or services cannot be cured after expiration of the sixth year. *In re City Holdings, Inc.*, 33 USPQ2d I047 (Comm’r Pats. 1993); *In re Metrotech*, 33 USPQ2d I049 (Comrn’r Pats. 1993).

In the instant case, the originally submitted specimens consist of three copies of an advertising brochure for Petitioner’s hotel and casino which do not reference the class 28 goods anywhere thereon. The specimens submitted on September 18, 1996, in response to the Affidavit-Renewal Examiner’s refusal letter, cannot be accepted inasmuch as the Commissioner is without the authority to accept a specimen filed after the expiration of the statutory period.

While the office regrets that Petitioner was not notified earlier of the class 28 specimen omission, please note that it is Petitioner who is ultimately responsible for filing proper documents.

³ A refund of the \$200 filing fee for class 28 was also authorized.

⁴ Petitioner has requested review of the Section 8 Affidavit only.

Although the office attempts to notify parties as to defective papers to permit timely refiling, it has no obligation to do so. *In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984); *In re Fuller-Jeffrey Broadcasting Corp. of Santa Rosa*, 16 USPQ2d 1456 (Comrn'r Pats. 1990).

Accordingly, the Petition is denied. 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:LBK

Date:

Attorney for Petitioner:

Edward J. Quirk, Esq.
Quirk & Tratos
3773 Howard Hughes Parkway
Suite 500
North Las Vegas, Nevada 89109