

Re: Trademark Registration of  
 Nutrition Express Corporation  
 Registration No. 1,582,191  
 Issued: February 13, 1990  
 For: NUTRITION EXPRESS  
 Petition Filed: May 28, 1996

On Petition

Nutrition Express<sup>1</sup> has petitioned the Commissioner to accept a Section 8 Affidavit filed in connection with the above identified registration.<sup>2</sup> The Petition is denied under Trademark Rules 2.146(a)(3), 2.146(a)(5) and 2.148.

## FACTS

The above registration issued on February 13, 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, i.e., between February 13, 1995 and February 13, 1996.

On May 8, 1995, a Declaration of Use under Section 8 was filed by the "McLind Corporation," and signed by its corporate president, Mr. Don McFarland. Although no explanation regarding this new entity's relationship with the Registrant was submitted with the Declaration, a Withdrawal of Attorney was filed several years prior on July 27, 1992, which identified the "registration owner at the following last known address: Mr. Don McFarland, McLind Corporation ...." No specimens accompanied the Section 8 Declaration.

In a letter dated December 28, 1995, the Affidavit Renewal Examiner in the Post Registration Division refused acceptance of the Section 8 Declaration because of the omission of specimens and the discrepancy involving ownership of the subject registered mark. Petitioner was advised that "one specimen or facsimile per class showing current use of the mark [must] be submitted prior to the expiration of the sixth year which ends on **February 6, 1996**<sup>3</sup> ... to avoid cancellation." In addition, Petitioner was required to establish ownership of the mark in McLind Corporation as of May 3, 1995, the date of execution of the Declaration of Use.

On February 26, 1996, Petitioner responded to the refusal by submitting the following: three specimens with an accompanying declaration that asserts they were in use "prior to the end of the sixth year of the registration;" a copy of the originally-filed Section 8 Declaration with the registrant's name and address of "McLind Corporation" crossed-out and replaced with "Nutrition

<sup>1</sup> Although the original registrant is identified as "Nutrition Express Corporation" in the registration, Petitioner has identified itself as "Nutrition Express."

<sup>2</sup> A Section 15 Declaration was filed concurrently with the Section 8 Declaration. Petitioner does not raise any issues in its Petition with respect to the Office's refusal to accept the Section 15 Declaration, and thus it will not be addressed in this decision.

<sup>3</sup> The expiration of the sixth year occurred on February 13, 1996 and not February 6, 1996.

Express" and a different address; a copy of the change of correspondence address from 1992; and an explanation regarding ownership, as follows:

I apologize for [the misinformation] shown on the documentation sent to you; I was merely duplicating name and company address provided [to] you in 1992 for [sic] correspondence address by my attorney.

The correct MARK name is NUTRITION EXPRESS. The new correspondence mailing address ... is: Mr. Don McFarland, Nutrition Express, 2570 West 237th Street, Torrance, CA 90505.

The declaration accompanying the specimens and the cover letter were signed by Mr. Don McFarland as "President" of "Nutrition Express."

In a letter dated May 17, 1996, the Affidavit/Renewal Examiner notified Petitioner that the specimens were received after expiration of the sixth year following registration and that the registration would be cancelled in due course. No further mention was made of the ownership discrepancy.

This Petition followed. Petitioner argues that the specimens were timely because they were submitted within six months from the mailing date of the December 28, 1995 letter of refusal, referring to the statement contained in that letter that, "in the absence of a proper response filed within six months of the mailing date of this letter, a cancellation order will be issued in due course."

## **DECISION**

Trademark Rules 2.146(a)(5) and 2.148 permit the Commissioner to waive any provision of the Rules which is not a provision of the statute, where an extraordinary situation exists, justice requires and no other party is injured thereby. However, the Commissioner has no authority to waive a requirement of the statute.

Because Section 8 of the Act specifically requires that a declaration of continued use, with a specimen attached, be filed between the fifth and sixth year after the registration date, the Commissioner has no authority to accept a specimen filed after the expiration of this period.

Accordingly, the Petition is denied and the registration will remain cancelled. The overpayment of \$100 for the Petition filing fee and the \$100 filing fee for the Section 15 Declaration will be refunded in due course. 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:

Petitioner:

Don McFarland, President  
Nutrition Express  
2570 West 237th Street  
Torrance, CA 90505