

Re: Trademark Registration of	:	
Metaux Precieux S.A. Metalor	:	
Registration No. 1,598,131	:	On Petition
Issued: May 29, 1990	:	
For: DELTA and Design	:	
Petition Filed: October 29, 1996	:	

Metaux Precieux S.A. Metalor has petitioned the Commissioner to reverse the Affidavit-Renewal Examiner's refusal to accept a Section 8 Affidavit filed in connection with the above-referenced registration.<sup>1</sup> The petition is denied under Trademark Rule 2.146(a)(3), 37 C.F.R. §2.146(a)(3).

## **FACTS**

The above-referenced registration issued on May 29, 1990, for the mark DELTA and Design. Pursuant to Section 8 of the Trademark Act, 15 U.S.C. §1058, Petitioner 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 May 29, 1995 and May 29, 1996.

On November 15, 1995, Petitioner filed a declaration of continued use of the mark, together with a specimen of current use of the mark. The registered mark and the mark shown on the specimen are set forth below.



Mark As Registered

**V-DELTA**

Mark Shown on Specimen

In an Office Action dated June 10, 1996, the Affidavit-Renewal Examiner notified Petitioner that the affidavit could not be accepted because the specimen did not show use of the mark identified in the registration. The Affidavit-Renewal Examiner stated further that the mark shown in the specimen was materially altered from the form of the mark as registered. On July 5, 1996, the Petitioner filed a response to the June 10, 1996 Office Action requesting a six-month extension of time to provide substitute specimens. Petitioner asserted that the specimen submitted was deficient and therefore, additional time should be allowed to cure the defect. In an Office Action dated August 30, 1996, the Affidavit-Renewal Examiner advised Petitioner that substitute specimens could not be submitted because the original specimens represented a material alteration of the mark. Since the sixth year following the date of registration had expired, there was no time remaining to submit new specimens. This petition followed.

---

<sup>1</sup> The Petitioner's Section 8 Affidavit was filed in conjunction with a Section 15 Affidavit of Incontestability.

## **DECISION**

Pursuant to 35 U.S.C. §6 and 37 C.F.R. §2.146(a)(3), the Commissioner may invoke supervisory authority in appropriate circumstances. However, the Commissioner will reverse the action of an Examiner only where there has been a clear error or abuse of discretion. No clear error or abuse of discretion has been established in the instant case.

The Trademark Act requires that a specimen or facsimile showing current use of the mark be filed within the prescribed period, and an omission of the required specimen cannot be cured after expiration of the sixth year. Section 8 of the Trademark Act, 15 U.S.C. §1058; TMEP §1603.08. Pursuant to Trademark Rule 2.162(e), a registrant who has submitted a deficient specimen with a Section 8 Affidavit 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 the same goods recited in the registration. *In re Brittains Tullis Russell, Inc.*, 23 USPQ2d 1457 (Comm'r Pats. 1992).

However, a specimen that shows use of a different or materially altered mark can not be cured after expiration of the sixth year. Because Section 8 of the Trademark Act and Trademark Rule 2.162(e) require the filing, within the statutory filing period, of a specimen showing current use of "the mark" a specimen showing use of a different mark is, in effect, an omission of a specimen showing use of the registered mark. Such a specimen is not "deficient" and therefore, additional time cannot be given to submit new specimens. *In re Darnell*, 33 USPQ2D 1372 (Comm'r Pats. 1993).

In this case, Petitioner's mark shown on the specimen filed with the Section 8 Affidavit is V-DELTA in a typed format with all caps, while, the mark in the registration is for Delta with a V design that looks like a check mark. Although both marks use the word DELTA, the registered mark includes a significant design element missing from the specimen submitted with the Section 8 Affidavit. Accordingly, the Affidavit-Renewal Examiner reasonably concluded that the Petitioner had not submitted a specimen of current use of the registered mark prior to the expiration of the sixth year following the registration date.

Having determined that the specimen filed within the sixth year evidenced use of a mark that differed materially from the registered mark, the decision of the Affidavit-Renewal Examiner to refuse to consider substitute specimens filed after the sixth year had expired is affirmed.

The petition is denied. The registration will be canceled in due course.

Philip G. Hampton, II  
Assistant Commissioner for  
Trademarks

PGH:JCL

Date:

Attorney for Petitioner:

Jess M. Collen, Esq.  
McGlew and Tuttle  
Scarborough Station  
Scarborough, NY 10510-0806