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**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**  
OFFICE OF ASSISTANT COMMISSIONER FOR TRADEMARKS  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

98-422 (R)

Re: Trademark Application of :  
Aura Systems, Inc. :  
Serial No. 74/343881 :  
Filing Date: December 28, 1992 : On Request for Reconsideration  
For: AURA :  
Request Filed: September 25, 1998<sup>1</sup> :

Aura Systems, Inc., has requested reconsideration of the Commissioner's decision regarding the above referenced petition. The request upon reconsideration is denied.

## **FACTS**

The above identified application was filed pursuant to Trademark Act Section 44(d), 15 U.S.C. Section 1126(d), on December 28, 1992.

Throughout the prosecution of this application, the Office alternately issued one of two types of Office Actions: notices that further action on the application was suspended pending the issuance of the foreign registration that would serve as the basis for the application, and requests that Petitioner advise the Office of the status of the application for that foreign registration.

The last of the requests for information on the status of the foreign application was issued on July 11, 1997. The response to this request was not received within the time allowed, and the application abandoned on January 13, 1998.

A petition to revive the application was filed on June 8, 1998. Petitioner asserted that the application had been filed pursuant to both 15 U.S.C. §1051(b) and 15 U.S.C. §1126(d). Petitioner's argument for revival was that the Commissioner should deem the application to be pending with respect to §1051(b), since the Office Action to which Petitioner had not responded

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<sup>1</sup> Petitioner has demonstrated that the Request for Reconsideration was filed on September 25, 1998 by presenting (1) a copy of the request that bears the serial number of an Express Mail receipt, and (2) a copy of the corresponding receipt. This receipt bears a U.S. Postal Service stamp showing receipt of the papers on September 25, 1998. See 37 C.F.R. §1.10. However, the request was apparently misplaced, and Petitioner provided a copy of the request by facsimile.

would not have been issued but for the assertion of §1126(d) as a filing basis.<sup>2</sup> See *In re Paperboard Industries Corp.* 41 USPQ 2d. 1159 (Comm'r. Pat. 1996).

However, in a decision dated July 30, 1998, the Commissioner determined that Petitioner had not asserted 15 U.S.C. §1051(b) as a filing basis. The present request for a reconsideration of that determination followed.

## ANALYSIS

An applicant will not be found to have based an application for registration on an intent to use the mark in commerce, 15 U.S.C. §1051(b) if the body of the application does not include a verified statement of the applicant's *bona fide* intention to use the mark in commerce. This requirement is statutory (See 15 U.S.C. §1051(b)(1)(A)) and cannot be waived. The statute likewise requires a statement of the applicant's *bona fide* intention to use the mark in commerce where the application is based on 15 U.S.C. §1126(d). See 15 U.S.C. §1126(d)(2).

Where a statement of a bona fide intention to use the mark in commerce is made in the context of a reference to §1126(d), this statement will not be understood to refer to §1051(b) as well. Thus, the statement "applicant has a bona fide intention to use the mark in commerce in connection with the above identified goods and asserts a claim of priority based upon [a non United States application] (15 U.S.C. §1126(d))" cannot be construed as an assertion of §1051(b) as a filing basis.

Here, Petitioner's application included the following averment:

Applicant has a bona fide intention to use the mark in commerce on or in connection with the above-identified goods/services, and asserts a claim of priority based upon German application Serial No. B 95 957/9 Wz, filed June 30, 1992 (15 U.S.C. 1126(d) as amended). (Application at p.1).

Under the standard just described, this averment cannot be construed as an assertion of §1051(b) as a filing basis. However, Petitioner identifies various elements in the record that in its view, allow a conclusion that §1051(b) was asserted as a filing basis. These elements are considered in turn.

First, Petitioner notes that the transmittal letter enclosing the application described the application as an "application [that was] being filed upon a bona fide intention to use the mark, 15 U.S.C. 1051(b) as amended." However, the transmittal letter is not a component of the application. Indeed, Petitioner itself notes that this letter "*accompanied* the subject application" (Request for reconsideration at p.2, emphasis supplied). Hence, any statements made in this letter cannot be deemed to be a part of the application.

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<sup>2</sup> Petitioner also argued, alternatively, that the application should be revived because the failure to respond to the Office Action was unavoidable. 37 C.F.R. §2.66. The Commissioner found that the failure was not unavoidable. Petitioner has not requested reconsideration of that finding.

Next, Petitioner notes that the application was accompanied by a return postcard that identified 15 U.S.C. §1051(b) as the asserted basis. However, this postcard, like the transmittal letter, is not a part of the application.

Petitioner also argues that an assertion of §1051(b) is present in the drawing submitted with the application, since this drawing includes the statement “[a]pplication based on bona fide intention to use the mark, and a claim of priority based upon a foreign application (15 U.S.C. 1126(d) as amended.)” However, an assertion of a filing basis must be made in the body of an application.

Petitioner further notes that the first paragraph of the application referred to “15 U.S.C. 1051 et seq.,” and that this paragraph was followed by the paragraph in which 15 U.S.C. §1126(d) was asserted as a filing basis. Petitioner’s argument is that because the wording “et seq.” encompasses §1051(b), and because the paragraph that follows this wording includes the statement of a bona fide intention to use the mark that is required where §1051(b) is asserted, a claim of §1051(b) as a basis is clearly present. Petitioner finds further support for this reading of the application by the presence of a description of the intended manner of use of the mark, a description that is only appropriate where §1051(b) is claimed.

This argument is not persuasive. As noted above, a statement of a bona fide intention to use the mark in commerce that is made in the context of an assertion of §1126(d) as a basis cannot be understood to refer to §1051(b) as well. Here, the application included an unambiguous assertion of §1126(d) as a filing basis. This assertion cannot be read as a simultaneous assertion of an additional basis. The reference to an intended manner of use of the mark was made in a separate paragraph, and is in any case, not an assertion of a §1051(b) filing basis: it is merely an element that is necessary if that assertion is made.

The reference to “15 U.S.C. 1051 et. seq.” likewise cannot convert the assertion of §1126(d) into an assertion of another basis. Even if “et seq.” were to be interpreted as a reference to §1051(b), nothing in the wording of the application would allow this reference to be incorporated into the section of the application where a basis is asserted. That section of the application refers explicitly and exclusively to §1126(d).

Petitioner also notes that the official filing receipt issued by the Office in connection with this application identified §1051(b) as the filing basis, and argues that it should be “entitled to the benefit of and to rely on the explicit acknowledgment . . . that there was a Section 1(b) basis for this application.” (Request for Reconsideration at p.3) The reference to §1051(b) on the official filing receipt is the result of an unfortunate clerical error. An erroneous reference to a filing basis by the Office cannot be construed as an assertion of that basis by an applicant.

**DECISION**

The request on reconsideration is DENIED, and the application will remain abandoned.

Robert M. Anderson  
Acting Assistant Commissioner  
for Trademarks

RMA:AL

Date:

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