

98-562

Re: Trademark Application of :
Star Stabilimento Alimentare S.p.A :
Serial No: 75/057975 :
Filing Date: February 14, 1996 : On Petition
For: GRAND´ ITALIA AND :
DESIGN :
Petition Filed: June 26, 1998 :

Star Stabilimento Alimentare S.p.A. has petitioned the Commissioner to accept an amendment changing the basis for registration of the above identified trademark, pursuant to 37 C.F.R. §2.146(a)(3). The petition is denied under 15 U.S.C. §§1051(d) and 1126(e).

FACTS

The application was filed on February 14, 1996, based upon Applicant's bona fide intention to use the mark in commerce. 15 U.S.C. §1051(b). The mark was published for opposition on July 4, 1997, and a Notice of Allowance issued on December 23, 1997. Pursuant to 15 U.S.C. §1051(d), a Statement of Use or Extension Request therefor, was required by June 23, 1998. This petition was filed June 26, 1998.¹ Petitioner requests that the basis of the application be amended to 15 U.S.C. §1126(e).

DECISION

An applicant may request post publication amendments adding or substituting new statutory bases by petitioning the Commissioner under 37 C.F.R. §2.146. *In re Monte Dei Maschi Di Siena*, 34 USPQ2d 1415 (Comm'r Pats 1995); *Trademark Manual of Examining Procedure* 1006.04. After consideration by the Commissioner on petition, the application is returned to the Examining Attorney to accept or deny the new basis of registration. If the new basis is accepted, republication for opposition is always required. *Monte Dei Maschi Di Siena* at 1416

15 U.S.C. §1126(e), provides:

A mark duly registered in the country of origin of the foreign applicant may be registered on the principal register if eligible, otherwise on the supplemental

¹ The certificate of mailing, pursuant to 37 C.F.R. §1.8, is dated June 23, 1998.

register herein provided. The application therefor shall be accompanied by a certification or a certified copy of the registration in the country of origin of the applicant. The application must state the applicant's bona fide intention to use the mark in commerce, but use in commerce shall not be required prior to registration.

Petitioner submitted an uncertified photocopy of an Italian Registration Certificate with its request. No Statement of Use, or extension request therefor, was filed by the statutory deadline of June 23, 1998. Because applicant neither filed a Statement of Use or extension request therefor, pursuant to 15 U.S.C. §1051(d), during the statutory period, nor a certified copy of the foreign registration, pursuant to 15 U.S.C. §1126(e), the application is abandoned. Applicant has complied with neither 15 U.S.C. §1051(d) nor 15 U.S.C. §1126(e).

Accordingly, the petition is denied. The application will be forwarded to the Intent to Use Division for processing.

Robert M. Anderson
Deputy Assistant Commissioner
for Trademarks

RMA:NLO:SMW

Date:

Attorney for Petitioner:

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