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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

97-391(R)

Re: Trademark Application of :
Bain Hogg Group PLC :
Serial No. 75/189156¹ : On Request for Reconsideration
For: BAIN HOGG :
Request for Reconsideration Filed: February 13, 1998 :

Bain Hogg Group PLC requested reconsideration of the Commissioner's decision dated January 14, 1998, denying its petition to restore an earlier filing date in connection with the above-referenced application. Although the Trademark Rules do not specifically provide for requests for reconsideration of decisions on petition, the Commissioner has the discretion to consider such requests pursuant to Trademark Rule 2.146(a)(3), 37 C.F.R. §2.146(a)(3). Upon reconsideration, the petition is denied under Sections 1(a) and 44(d) of the Trademark Act, 15 U.S.C. §§1051(a) and 1126(d).

FACTS

On October 21, 1996, Petitioner filed an application for registration of the above-referenced mark under Sections 1(a) and 44(d)² of the Trademark Act. The application materials were returned to Petitioner along with a Notice of Incomplete Trademark Application, dated July 25, 1997. The Notice stated that the applicant failed to state that "the applicant has a *bona fide* intention to use the mark in commerce" to support its Section 44 basis. The Notice did not address the deficiency of any attempt by the applicant to assert use of the mark in commerce under Section 1(a).

Petitioner filed a petition on August 21, 1997, to restore the earlier filing date asserting that "the Applicant did not omit to allege use but only omitted the use dates...[and] also alleges priority based upon the UK application." Counsel for Petitioner noted further that the Petitioner was prejudiced by the Office's nine month delay in declaring that this application was deficient for purposes of receiving a filing date.

The Commissioner denied the petition on January 14, 1998, stating that the statutory requirements for a statement of the applicant's *bona fide* intention to use the mark in commerce under Section 44(d) and for the date of first use in commerce under Section 1(a) were not

¹ This serial number was declared "misassigned" and will not be reassigned to this application.

² Petitioner's claim of priority was based on an application that was filed in the U.K. on April 19, 1996.

satisfied in the application at the time of filing. In response to the nine month delay in misassigning Petitioner's application, the Commissioner advised Petitioner that filing a proper application is ultimately the responsibility of the Petitioner. Petitioner's Request for Reconsideration followed on February 13, 1998.

Petitioner's Arguments on Reconsideration

Petitioner maintained that the statutory requirement for a statement that the applicant has a *bona fide* intention to use the mark in commerce under Section 44(d) was satisfied in the application as filed. Petitioner asserted that the submission of specimens, two statements in its application that the mark is in use, inclusion of a method-of-use clause and a claim of priority "can be construed together to meet the necessary language showing Applicant's bona fide intent to use the mark in commerce."

Petitioner stated further that its statement that the mark is in use in commerce implied the applicant's *bona fide* intention to use the mark in commerce. Petitioner distinguished its case from *In re Paul Wurth S.A.*, 21 USPQ2d 1631 (Comm'r Pats. 1991) wherein a Section 44(d) basis was asserted, but not a Section 1(a) basis, contrary to Petitioner's case.

Petitioner also stated that the omission of the date of first use in commerce was inadvertent and not prejudicial to the Office or to the public, presumably to assert that Petitioner did meet the statutory requirements for applications filed under Section 1(a) despite the omission.

Petitioner also stated that an extraordinary situation exists due to the time taken to notify Petitioner of the application's deficiency.

ANALYSIS

Petitioner did not meet the statutory requirement for a statement of an applicant's bona fide intention to use the mark pursuant to Section 44(d).

Applications that are filed based on an application filed in a convention or treaty country under Section 44(d) of the Trademark Act must state "the applicant's *bona fide* intention to use the mark in commerce." 15 U.S.C. §1126(d). The Commissioner cannot waive this statutory requirement. *In re Unisearch Limited*, 21 USPQ2d 1559 (Comm'r Pats. 1991); *In re Paul Wurth S.A.*, 21 USPQ2d 1631 (Comm'r Pats. 1991); *In re Investigacion Y Desarrollo de Cosméticos, S.A.*, 19 USPQ2d 1717 (Comm'r Pats. 1991). Submission of specimens, an averment of actual use of the mark, the method-of-use clause and the claim of priority cannot be construed together to meet the statutory requirement for a claim of an applicant's *bona fide* intention to use the mark in commerce.

The mere averment of actual use in the application papers does not meet the requirements of the statute for securing a filing date under Section 44(d).

There is no ambiguous language or language of exception. The requirement that a Section 44(d) application specifically set forth its bona fide intent to use the mark in

commerce is a clear statutory requirement. The Commissioner is without authority to waive a statutory requirement...

In re Paul Wurth S.A. at 1633.

While the applications at issue in *In re Paul Wurth S.A.* may not have had clear assertions of a use basis under Section 1(a) together with a Section 44(d) basis, the applicant in *In re Paul Wurth*, did attempt to rely on statements that each of the marks were actually in use to support its position that the statutory requirement for a *bona fide* intention to use the mark in commerce had been satisfied. In this case, Petitioner made a similar assertion in its petition. Therefore, *In re Paul Wurth* does control on the issue of whether the statement that the mark is in use meets the statutory requirement. It is noted further that Petitioner did not have a Section 1(a) basis in the application due to the omission of the date of first use in commerce. *See infra*.

The Commissioner went on to state in *In re Paul Wurth* that “[t]here is no reason why, in such a case, the petitioner can not also set forth a statement regarding its actual use as additional information in the record. In this way, the application will contain the *statutorily required language of a bona fide intention to use the mark in commerce* as well as the additional clarifying language that, in this particular instance, the mark is actually in use in commerce.” *In re Paul Wurth* at 1633 (emphasis added); *see also In re Cyber-Blitz Trading Services*, _____ USPQ2d _____ (Comm’r Pats. 1998)(a copy of which is attached). Unless an applicant files an application based on use of the mark in commerce under Section 1(a), the applicant must state its *bona fide* intention to use the mark in commerce to perfect a basis under Sections 1(b), 44(d) and/or 44(e) when filing a new application.

Petitioner did not meet the minimum requirement for a date of first use in commerce pursuant to Section 1(a).

When an application is filed based on use of the mark in commerce, the applicant must supply in addition to the other minimum filing date requirements, the date of first use in commerce and at least one specimen of the mark used. Trademark Rule 2.21(a)(5)(i), 37 C.F.R. §2.21(a)(5)(i). The date of first use in commerce is an allegation, which must be set forth in the body of the verified application in order to receive a filing date. Because Petitioner’s written application does not include a date of first use of the mark in commerce, it does not satisfy Trademark Rule 2.21(a)(5)(i) and is not entitled to a filing date.

The Office’s delay in notifying Petitioner that its application did not meet the minimum requirements to receive a filing date does not amount to extraordinary circumstances.

While the Office regrets that Petitioner was not promptly notified of the deficiencies in its application, Petitioner is ultimately responsible for filing proper documents. In this case, Petitioner’s papers failed to perfect any basis for filing the application at the time of filing. While the Office attempts to notify parties as to defective papers to permit timely refileing, 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 Broadcasting Corp. of Santa Rosa*, 16 USPQ2d 1456 (Comm’r Pats. 1990). Furthermore, any delay in informing Petitioner of the application papers’ deficiencies

does not amount to an extraordinary situation. *cf. In re Colombo, Inc.*, 33 USPQ2d 1530 (Comm'r Pats. 1994)(Neither the Office's failure to notify applicant of deficiencies nor inadvertent failure to comply with statutory requirement amount to unavoidable delay). Even if it was found that the delay did amount to extraordinary circumstances, Petitioner filed the defective application papers on the last day of the priority period, and had no further opportunity to secure the claim of priority with respect to its U.K. application. Furthermore, Petitioner may re-file its application.

DECISION

The petition is denied. Petitioner's papers will be returned.

Philip G. Hampton, II
Assistant Commissioner
For Trademarks

Date:

PGH:SLC

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