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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

99-9

Re: Trademark Application of :
Performance Chemicals Handels GmbH :
Misassigned Application Serial No. 75/416361 :
For: PC STAB : On Petition
Filing Date: January 12, 1998¹ :
Petition Filed: October 21, 1998 :

Performance Chemicals Handels GmbH (“Petitioner”) has petitioned the Commissioner to restore the filing date of January 12, 1998 to the above-referenced application papers. The petition is denied under 15 U.S.C. §1126(d) and 37 C.F.R. §2.20.

FACTS

The above-referenced application papers were filed on January 12, 1998. The application papers asserted one basis: a claim of priority under 15 U.S.C. §1126(d) (“§44(d)”) based on ownership of an application filed in Germany on June 20, 1997 (the “foreign application”).

On September 11, 1998, the Pre-Examination Section returned the application papers with a Notice of Incomplete Trademark Application because the application papers were not filed within 6 months from the filing date of the foreign application. This petition followed.

Petitioner’s Arguments

Petitioner asserts that while Applicant was not entitled to any benefit of a priority claim, the inclusion of the statutory reference to Applicant’s “bona fide intent to use its mark in commerce” in the application should be treated as an attempt to file the application under 15 U.S.C. §1051(b) (“§1(b)”).

Petitioner also asserts that it filed a subsequent application in which a claim of a bona fide intent to use the mark in commerce was stated for the same mark in connection with the same goods under §1(b).² Petitioner believes that this subsequent application presents further evidence of its bona fide intent to use the mark in commerce in connection with the above-referenced application.

¹ The filing date is the issue on petition.

² Petitioner filed a copy of the subsequent application, which contains a signed declaration dated October 12, 1998. Office records do not yet indicate that the subsequent application is of record.

ANALYSIS

Petitioner did not aver dual bases.

If an applicant wishes to assert §1(b) in addition to §44 as the basis for filing, the Office will not presume from the mere inclusion of the statement of a bona fide intention to use the mark in commerce, which is required of all §44 applicants, that the application is filed on both bases. *In re Miguez*, 16 USPQ2d 1458 (Comm’r Pats. 1990). The applicant must supply the averments and submission related to each asserted basis as stated in 37 C.F.R. §2.21(a)(5); *see also* TMEP §1006.02.

TMEP §1006.02 states that an applicant may indicate dual bases either (1) by referring to the relevant statutory sections, §§1(b) and 44(d), or 15 U.S.C. §§1051(b) and 1126(e); or (2) by repeating the statement of a bona fide intention to use the mark in commerce; or (3) by referring to an ‘additional’ basis for filing, a ‘second’ basis for filing, ‘two’ bases for filing or the equivalent.

It is undisputed that a claim of a bona fide intention to use the mark in commerce was included in the application. However, this claim was associated with the clear averment of Petitioner’s intent to claim the priority benefit under §44(d). No further averment in connection with another filing basis was made such as, a reference to another statutory section, a repeated statement of bona fide intention to use the mark in commerce or a reference to an additional or second basis, or to two bases. Therefore, a basis other than §44(d) was not stated.

The subsequent 1(b) application does not satisfy the statutory requirements for a second basis in the subject application papers.

For purposes of determining entitlement to a filing date or whether two bases have been asserted, the Office will consider the written application only. The Office will not consider any material in the drawing or a cover letter or any place else, other than the written application. TMEP §1006.02.

To receive a filing date, all applications must contain a verification or declaration in accordance with 37 C.F.R. §2.33(b) that is signed by the applicant. The declaration must aver to the information contained in the written application. *See* 37 C.F.R. §2.21(a)(6). The declaration must be made on the same paper as the document being verified. *See* 37 C.F.R. §2.20.³

Petitioner’s verified statement of bona fide intent to use the mark in commerce under §1(b) for the subsequent application does not entitle Petitioner to a §1(b) basis in connection with the

³ 37 C.F.R. §2.20 states, in pertinent part:

The applicant...may...file a declaration that all statements made of his own knowledge are true and that all statements made on information and belief are believed to be true, if, and only if, the declarant is, *on the same paper*, warned that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001), and may jeopardize the validity of the application or document or any registration resulting therefrom. (emphasis added)

subject application papers. The §1(b) averment in the subsequent application is referenced outside of the subject application papers. Furthermore, the declaration supporting the bona fide intention to use the mark in commerce statement in the subsequent application is dated October 12, 1998 and verifies information contained in the subsequent application, not the subject application papers as required under 37 C.F.R. §2.20.

DECISION

Having failed to meet the minimum requirements to receive a filing date under 15 U.S.C. §1126(d) and 37 C.F.R. §2.21, the petition is denied. The application papers are returned herewith.

Robert M. Anderson
Deputy Assistant Commissioner
for Trademarks

Date:

RMA:SLC

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