

Re: Trademark Application of :
 Clucas Diving & Marine :
 Engineering Ltd. :
 Serial No. 75/436356¹ :
 Filing Date: February 18, 1998² : On Petition
 For: R.I.P. ROUND :
 Petition Filed: May 21, 1998 :

Clucus Diving & Marine Engineering Ltd. has petitioned the Commissioner to restore its original filing date of February 18, 1998, which was cancelled, for failure to comply with the filing requirements set forth in 37 C.F.R. §2.21. Trademark Rule 2.146, 37 C.F.R. §2.146 provides authority for review of this issue. The Petition is denied under Sections 1(b)(1) and 44(d) of the Trademark Act, 15 U.S.C. §§ 1051(b)(1) and 1126(d).

FACTS

On February 18, 1998, Petitioner filed an application for registration of the above-identified mark in the United States based on a British application filed on June 13, 1997.

On April 6, 1998, the papers were returned to Applicant. The application was refused a filing date because the application was not filed within six (6) months from the filing date of the foreign application under Section 44(d). 37 C.F.R. §2.21(a)(5)(iii). This Petition followed.

Petitioner alleges that even if the Office determined that the application was not entitled to priority under Section 44(d), that the filing date of February 18, 1998 should be restored. Specifically, Petitioner argues that the requirements for receiving a filing date under Section 1(b) were met. Petitioner alleges that the application contains the necessary language that the “Applicant has a bona fide intent to use the mark in U.S. and foreign commerce, between the United Kingdom and The United States”.

ANALYSIS

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 the Office of Trademark Services 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.

¹ The serial number has been declared “misassigned” and will not be reassigned to the application.

² The filing date is the issue on Petition.

37 C.F.R. §2.21(a)(5) enumerates the acceptable bases for filing applications as follows:

(iii) A claim of a bona fide intention to use the mark in commerce and a claim of the benefit of a proper foreign application in an application filed in accordance with §44(d) of the Act³, or

(iv) A claim of a bona fide intention to use the mark in commerce in an application under §1(b) of the Act.

Requirements for Section 44(d) Basis for Filing were not Satisfied

An applicant claiming the benefit of Section 44(d) must file the application in the United States within six months of the filing date of the first-filed foreign application. 15 U.S.C. §1126. The application must also include a statement that the applicant has a bona fide intention to use the mark in commerce. 15 U.S.C. §1051. A review of the application papers reveals that the United States application was filed on February 18, 1998. The application claimed priority under Section 44(d) based on a British application filed on June 13, 1997. Therefore, the filing date of the U.S. application was more than six months after the date on which the application was first filed in the foreign country. Accordingly, the filing requirements for an application filed under Section 44(d) were not met. The Legal Instruments Examiner did not err in denying the application a filing date.

Alternative Basis for Filing not Asserted

Petitioner asserts that if the Office determined that the application could not be afforded a filing date under Section 44(d) that the applicant should have been granted a filing date under Section 1(b) since the requirements for filing under Section 1(b) were met.

An applicant that intends to file asserting more than one basis must specifically indicate each basis. The Office does not presume from the inclusion of an allegation of the applicant's bona fide intention to use the mark in commerce, which is required of all applicants filing under Section 44, that Section 1(b) of the Act is claimed as an additional basis. TMEP §1006.02. *See In re Miguez*, 16 USPQ2d 1458 (Comm'r Pats. 1990). If a Section 44(d) basis for filing is asserted, and that basis fails under Trademark Rule 2.21(a)(5), 37 C.F.R. §2.21(a)(5), the Office will deny a filing date unless the applicant has indicated Section 1(a) or Section 1(b) as a second basis for filing.

To assert a dual bases, the applicant must supply the averments and submissions related to each asserted basis as stated in Trademark Rule 2.21(a)(5), 37 C.F.R. §2.21(a)(5), and the applicant must clearly indicate that it is asserting two bases. This requirement can be satisfied in a number of ways. Specifically, the applicant may indicate so:

³ Section 44(d) of the Act specifically requires that the application in the United States be filed within six months from the date on which the application was first filed in the foreign country

- (1) by referring to the relevant statutory sections, for example, §§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.

See generally TMEP §1006.02. In this case, Petitioner did not clearly indicate that the application was being filed under Section 1(b) in addition to Section 44(d). Therefore, the Legal Instruments Examiner did not err by refusing to accord a filing date to this application under Section 1(b).

DECISION

The Petition is denied. The application papers will be returned to Petitioner.⁴

Philip G. Hampton, II
Assistant Commissioner
for Trademarks

PGH:NLO:DDS

Date:

Attorney for Petitioner:

Lawrence S. Wick, Esq.
Leydig, Voit & Mayer, Ltd.
Two Prudential Plaza, Suite 4900
180 N. Stetson Street
Chicago, Illinois 60601-6780

⁴ The application fee will be refunded in due course.
