



**UNITED STATES DEPARTMENT OF
COMMERCE**

Patent and Trademark Office

ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 Crystal Drive
Arlington, Virginia 22202-3513

99-397

Re: Trademark Application of :
Gene Logic Inc. :
Serial No.: 75/497,315¹ :
Filing Date: June 2, 1998² : On Petition
For: Miscellaneous Design :
Petition Filed: March 5, 1999 :

Gene Logic Inc. has petitioned the Commissioner to accord a filing date of June 2, 1998, to the above-identified application. 37 C.F.R. §2.146(a)(3) provides authority for the requested review.

FACTS

Petitioner filed an application for registration of the above-identified mark based on an intent to use the mark in commerce pursuant to 15 U.S.C. §1051(b). The papers were initially accorded a filing date of June 2, 1998, and serialized as Application Serial No. 75/497,315. Subsequently, the filing date was cancelled and the papers were returned to Petitioner with a Notice of Incomplete Trademark Application, indicating that the application could not be granted a filing date because a verified statement of the Applicant's bona fide intention to use the mark "in commerce" was omitted therefrom. 37 C.F.R §2.21(a)(5)(iv). Emphasis added.

This Petition followed. Counsel for Petitioner argues that Petitioner's statement on the first page of the application, that it has a "bona fide intent to use the mark on the accompanying drawing," coupled with the statement in the declaration, that "under 15 U.S.C. §1051(b), applicant is entitled to use the mark in commerce," fulfill the statutory and regulatory requirements for receiving a filing date.

Petitioner asserts further that it has filed a Community Trademark application and an application in Japan claiming the filing date of the subject application as a priority filing date under the Paris Convention for Protection of Industrial Property. Petitioner asserts that it was not notified of the deficiency in the filing date requirements until eight months after its original filing and that, in the interest of equity, the Commissioner should accord Petitioner its original filing date.

ANALYSIS

The requirements for receipt of a filing date are set forth in 37 C.F.R. §2.21. All the requirements of Trademark Rule 2.21(a) must be satisfied before an application can be granted a filing date.

¹ This Serial Number has been declared "misassigned" and will not be reassigned to the application.

² The filing date is the issue on Petition.

For an application based on an intent to use the mark in commerce, both the statute and applicable rule clearly and unequivocally require an averment that the applicant has a *bona fide intention to use a mark in commerce*. 15 U.S.C. §1051(b); 37 C.F.R. §2.21(a)(5)(iv). The wording "in commerce" is essential for the Office to grant applicant a filing date. *In re Unistar Radio Networks, Inc.*, 30 USPQ2d 1390 (Comm'r Pats. 1993). Because the granting of a filing date to an application potentially establishes a date of constructive use of the mark, these requirements are strictly enforced.

The statutory requirement for a statement of bona fide intent to use the mark in commerce is not satisfied by an assertion that the applicant "is entitled to use" the mark in commerce, or that "no one else has the right to use" the mark in commerce. Even when viewed in conjunction with a statement of a bona fide intention to use a mark anywhere, these statements do not amount to an assertion of the applicant's bona fide intention to use the mark in commerce.³ *In re Unistar Radio Networks, Inc.*, 30 USPQ2d at 1393; *see also In re Paul Wurth, S.A.*, 21 USPQ2d 1631 (Comm'r Pats. 1991).

37 C.F.R. §§ 2.146(a)(5) and 2.148 permit the Commissioner to waive any provision of the Rules which is not a provision of the statute, where an extraordinary situation exists, justice requires and no other party is injured thereby. Hence, even if, as Petitioner maintains, the denial of the filing date to the subject application could cause Petitioner to lose its claims of priority in the European Community and Japan, which Petitioner maintains unjustly prejudices Petitioner, the Commissioner has no authority to waive the requirement that the application contain a verified statement of Petitioner's bona fide intention to use the mark in commerce, as that is a statutory requirement. *In re Investigacion Y Desarrollo de Cosméticos, S.A.*, 19 USPQ2d 1717 (Comm'r Pats. 1991).

DECISION

For the foregoing reasons, the Petition is denied.⁴

Robert M. Anderson
Acting Assistant Commissioner
for Trademarks

RMA:DDS

Date:

³ Counsel for Petitioner alleges that the facts in the instant Petition are distinguishable from those in *In re Unistar* because in that case, the application did not contain any statement of "in commerce". Petitioner's assumption is not supported by the facts of record in that case. In fact, Petitioner's assumption is likely erroneous as the application in *In re Unistar* presumably contained a declaration similar to the declaration upon which Petitioner relies here to find its statement of "in commerce".

⁴ It appears that, on February 24, 1999, Petitioner refiled the subject application and that application has been assigned Application Serial No. 75/647081.

Attorney for Petitioner:

Michael F. Clayton, Esq.
Nancy L. Rowe, Esq.
Elisa A. D'Andrea, Esq.
Morgan, Lewis & Bockius, LLP
1800 M Street, N.W.
Washington, D.C. 20036