Paper No. 15
RFC

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB MARCH 30, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Spearhead Holdings, Inc.

Serial No. 74/398,247

Charles W. Quinn of Dann Dorfman Herrell and Skillman for Spearhead Holdings, Inc.

Cheryl A. Butler, Trademark Examining Attorney, Law Office 107 (Thomas Lamone, Managing Attorney).

Before Cissel, Seeherman and Chapman, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On June 7, 1993, the above-referenced application was filed, based on applicant's assertion that it intended to use the mark "COLORBURST" in commerce on "egg coloring kits," in Class 28. In addition to claiming it possessed a bona fide intention to use the mark, applicant, through the declaration of its president, who executed the application, stated that "the undersigned hereby states on his/her own

behalf and on behalf of Applicant, Spearhead Holdings, Inc., that he/she believes Applicant, Spearhead Holdings, Inc., will be, upon the filing of this application, the owner of the mark ColorBurst sought to be registered for use on and in connection with egg coloring kits…"

The Examining Attorney held that this language did not satisfy the requirement of the Lanham Act for a verified statement that applicant either believes it is entitled to use the mark sought to be registered, or believes itself to be the owner of the mark sought to be registered. The Examining Attorney required a proper verified statement.

Applicant took issue with the requirement, arguing that ownership could come about only as a result of use, so that, in the absence of actual use of the mark, applicant could not claim that it owned the mark until the intent-to-use application had been filed, which would entitle applicant to constructive use as of the filing date of the application. Applicant did not address the alternative option provided under Section 1(b) of the Act of claiming that it believed itself to be entitled to use the mark it intends to use and seeks to register.

In view of applicant's failure to comply with the requirement for a substitute verified statement which meets the requirement of the statute, the Examining Attorney made

the requirement final. Applicant timely filed a Notice of Appeal. Both applicant and the Examining Attorney filed briefs. Applicant did not request an oral hearing before the Board.

Interestingly, following the brief timely filed on April 15, 1998 by Examining Attorney Butler, applicant, on May 15, 1998, filed a "REPLY TO EXAMINING ATTORNEY'S APPEAL BRIEF," to which counsel for applicant attached an unexecuted copy of a declaration which meets the requirements of the statute. In the proposed declaration, the declarant states that "applicant believes applicant to be the owner of the mark for which registration is sought and applicant believes applicant is entitled to use the mark in commerce." Counsel for applicant acknowledged that the copy of the declaration which was submitted was unsigned, but explained that the original had been forwarded to applicant for execution, and that the appeal would be moot when the executed version was forwarded to the Board after applicant's counsel received it back from applicant.

The Board has received no further papers in this regard from applicant or applicant's counsel. We must therefore decide this appeal on its merits, as if

applicant's counsel had not offered to comply with the requirement.

In any event, the Examining Attorney is correct in requiring a declaration which satisfies the statutory requirement for a verified allegation that applicant believes that it is entitled to use the mark in commerce. Our decision is not based on applicant's argument concerning the fact that applicant might not be technically correct in asserting ownership of the mark until the filing of its application based on its intention to use the mark. Instead, our ruling is based on a point not even argued by applicant in opposition to the requirement, that the statute itself, in Section 1(b)(1)(A), provides that in the case of an application based on the intent to use the mark, in lieu of a verified assertion of ownership, an applicant must include "a statement to the effect that the person making the verification believes himself, herself, or the firm, corporation, or association in whose behalf he or she makes the verification, to be entitled to use the mark in commerce…" Applicant has not explained why this provision of the statute does not apply in this case.

Accordingly, the requirement for an acceptable

verified statement that applicant believes that it is entitled to use the mark it seeks to register is affirmed.

R. F. Cissel

E. J. Seeherman

B. A. Chapman
Administrative Trademark Judges
Trademark Trial and Appeal Board