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**THIS DISPOSITION
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Paper No. 13
RLS/T

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *Société Martiniquaise des Eaux de Source-Somes*

Serial No. 75/649,669

George W. Lewis of Jacobson, Price, Holman & Stern for
Société Martiniquaise des Eaux de Source-Somes.

Ingrid Eulin, Trademark Examining Attorney, Law Office 111
(Craig Taylor, Managing Attorney).

Before Simms, Bottorff and Holtzman, Administrative
Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Société Martiniquaise des Eaux de Source-Somes
(applicant), a French limited liability society, has
appealed from the final refusal of the Trademark Examining
Attorney to register the mark CHANFLOR for spring water,
mineral water and carbonated water.¹ The Examining Attorney
has made final a requirement for a substitute verification

¹ Application Serial No. 75/649,669, filed March 1, 1999, based upon allegations of a bona fide intention to use the mark in commerce. Applicant has also based its application upon French Registration No. 1,359,718, issued June 20, 1986, under Section 44(e) of the Act.

or declaration because the original application was signed on July 23, 1998, more than seven months before the application was filed. Applicant and the Examining Attorney have submitted briefs but no oral hearing was requested.

Relying upon Section 1 of the Trademark Act, 15 USC §1051, Trademark Rule 2.32(a),² and TMEP §803.04, the Examining Attorney maintains that applicant's application was not filed within a reasonable time after the application was signed. In this regard, the Examining Attorney indicates that the Office considers six months to be a reasonable time from the date of execution of the application to the filing date. The Office has this requirement in order to ascertain that applicant has a bona fide intention to use the mark as of the time of the filing of the application. When the delay is longer than six months and where the circumstances warrant, the Examining Attorney has discretion, in accordance with the Trademark Manual, to require a substitute verification. Here, the Examining Attorney contends that applicant has submitted no explanation of the circumstances for the delay other than in applicant's initial response where applicant's counsel

² The current rule is Rule 2.33(c).

indicated that the application was filed within several days of the receipt of the final filing instructions from applicant. Applicant indicated that the act of forwarding the filing instructions was sufficient affirmation of applicant's continued bona fide intention to use the mark in commerce. While applicant did submit a substitute verification (dated December 22, 1999) with a request for reconsideration, it is the Examining Attorney's position that that substitute verification was for a different application (Serial No. 75/724,126) seeking registration of the mark CHANFLOR with a design element. Because that substitute declaration is not directed to the mark herein sought to be registered (the word mark CHANFLOR alone), the Examining Attorney has not accepted that as a substitute verification.

Applicant, on the other hand, argues that it is not a statutory requirement or even a mandatory regulatory requirement that the declaration be executed contemporaneously with the filing of the application. Rather, applicant maintains that this is a matter of discretion within the Examining Attorney's jurisdiction. Here, as noted, applicant indicates that the application was filed (on March 1, 1999) within several days after receiving final filing instructions from counsel's French

client. According to applicant's attorney, that is sufficient affirmation of applicant's continued bona fide intention to use the mark in commerce.

Even if not, counsel argues that the copy of the substitute application and declaration filed in connection with its co-pending application seeking to register the mark CHANFLOR and design should be accepted to show the requisite bona fide intention to use this mark at the time of filing. It is counsel's position that the substitute declaration meets the requirements of TMEP §803.04. In this regard, counsel notes that the goods in both applications are the same and that the mark is the same in both applications, except that the instant application is for the mark in typed form without any design element. Applicant argues that the allegations relative to applicant's bona fide intention to use the mark with the design element in commerce are necessarily the same with respect to the word mark alone. In other words, that application necessarily incorporates the subject mark, according to applicant.

Trademark Rule 2.32(b) requires that the application include a verified statement that meets the requirements of Trademark Rule 2.33. One of the requirements of that rule (2.33(c)) is that, if the verified statement is not filed

within a reasonable time after it is signed, the Office may require the applicant to submit a substitute verification of applicant's continued use or bona fide intention to use the mark in commerce.

Section 803.04 of the Trademark Manual provides:

All applications and papers must be filed within a reasonable time after their execution. The Office considers six months between execution and filing as reasonable for all applicants and all papers. No new verification should be required if the paper is filed within six months of execution.

The examining attorney has discretion to accept papers where a longer delay has occurred if circumstances warrant. However, this discretion should be exercised in view of the underlying reasons for the requirement for timely filing. The filing of applications under §1(a), amendments to allege use under §1(c) or statements of use under §1(d) of the Trademark Act must be timely to ensure that the applicant's statement of use of the mark in commerce is valid at the time of filing. Similarly, the requirement for a statement of the applicant's bona fide intention to use the mark in commerce in conjunction with applications under §§1(b) and 44 and requests for extensions of time to file statements of use under §1(d) reinforces the need for timely filing of such papers to ensure that the statement is valid at the time of filing.

For example, it may be reasonable to accept a statement of use which was originally prepared for filing as an amendment to allege use if it exceeds the guideline by a modest amount of time. This would be appropriate if the delay was due to Office processing times and the bar against filing the statement of use prior to issuance of the notice of allowance. However, if there is a delay which exceeds the guideline by a

substantial period of time, due to the filing of an opposition or other unusual circumstances, a new verification should be required.

If an application, an amendment to allege use or a statement of use is filed more than six months after its execution and the applicant has not provided an acceptable explanation for the delay, the Office will require that the applicant either (1) provide a satisfactory explanation for the delay between execution and filing or (2) submit re-executed papers or a statement, which is verified or which includes a declaration in accordance with 37 C.F.R. §2.20, of the applicant's continued use of the mark in commerce or continued bona fide intent to use the mark in commerce, as appropriate.

Here, applicant's application was filed more than seven months after the time it was signed. Because the application was not signed within a reasonable time before it was filed, we believe the Examining Attorney acted appropriately in requiring applicant to submit a new verification asserting a continued bona fide intention to use the mark in commerce. Nor did applicant submit a satisfactory explanation for the delay. The statement that applicant's counsel received final filing instructions just before the application was filed does not adequately explain the reason for the delay. Nor has applicant explained why it was unable to file a substitute verification in this case as required by the Examining Attorney.

The only remaining question is whether the verification (actually a substitute application) submitted in connection with applicant's application to register the word mark with design was sufficient and should have been accepted by the Examining Attorney in this case. We believe that it was not sufficient. The declaration must pertain to the mark shown in this application, not in another application filed by applicant to register a different mark. See Trademark Rule 2.33(b)(2) ("In an application under section 1(b) or section 44 of the Act, the verified statement must allege: That the applicant has a bona fide intention to use the mark shown in the accompanying drawing..." [emphasis added]); cf. Trademark Rule 2.52(a), and *In re Who? Vision Systems Inc.*, 57 USPQ2d 1211, 1217 (TTAB 2000) (the mark sought to be registered is the mark depicted on the drawing page, not elsewhere in the application papers). Accordingly, we believe the Examining Attorney also acted within her discretion in rejecting this substitute verification. See *In re Hacot-Colombier*, 105 F.3d 616, 41 USPQ2d 1523, 15 (Fed. Cir. 1997) (Board has authority to enforce the trademark rules).

Decision: The requirement for a substitute verification is affirmed.