Re: Trademark Registration of
Southern Health Plan, Inc.
Registration No. 1,542,813
Issued: June 6, 1989 On Petition
For: CURE and Design
Petition Filed: August 12, 1996

Southern Health Plan, Inc. has petitioned the Commissioner to reverse the Post Registration Affidavit-Renewal Examiner's refusal to accept a Section 8 affidavit filed in connection with the above-identified registration. Trademark Rules 2.146(a)(2) and 2.165(b), 37 C.F.R. §§2.146(a)(2) and 2.165(b), provide authority for the requested review. The petition is denied.

FACTS

The registration issued on June 6, 1989, for the mark CURE and design, for "providing advice and consultation to businesses in controlling the cost of employee health care benefits," in International Class 35. Under Section 8 of the Trademark Act, 15 U.S.C. §1058, Registrant was required to file an affidavit of continued use or excusable nonuse between the fifth and sixth year after the registration date, i.e., between June 6, 1994 and June 6, 1995. On June 5, 1995, Petitioner filed an affidavit stating that the "mark is still in use as evidenced by the specimen attached..."

By letter dated February 14, 1996, the Affidavit-Renewal Examiner ("Examiner") notified Petitioner that the affidavit could not be accepted because: (1) the type of commerce was not set forth; (2) the recitation of services was omitted; (3) no specimen had been filed; and (4) the required fee was not submitted. Petitioner was informed that, because the statutory requirement for filing a specimen had not been fulfilled, the registration would be processed for cancellation. This petition followed.

ANALYSIS

Petition is Ripe for Consideration

Under Trademark Rule 2.165(b), the filing of a request for reconsideration of the refusal of a Section 8 affidavit is a condition precedent to a petition to the Commissioner, unless the first action refusing the affidavit or declaration directs the Registrant to petition the Commissioner for relief.

Although the February 14, 1996 Office action does not direct the Registrant to petition the Commissioner, neither does it contain a six-month response clause indicating that a request for reconsideration could be filed. In fact, since the Office action stated that the registration would be processed for cancellation, it was reasonable for Petitioner to believe that a request for reconsideration would prove fruitless and that a timely-filed petition to the Commissioner was necessary. Therefore, the petition is ripe for consideration.

Standard of Review on Petition

Under Trademark Rules 2.146(a)(2) and 2.165(b), a Registrant may petition the Commissioner to review an Examiner's refusal to accept an affidavit filed under Section 8 of the Trademark Act. However, the Commissioner will reverse the action of an Examiner only where there has been a clear error or an abuse of discretion. *In re Richards-Wilcox Manufacturing Co.,* 181 USPQ 735 (Comm'r Pats. 1974).

Statutory Requirements of Section 8

Section 8 of the Trademark Act, 15 U.S.C. §1058, provides, in part:

> [T]he registration of any mark under the provisions of this Act shall be cancelled by the Commissioner at the end of six years following its date, unless within one year next preceding the expiration of such six years the registrant shall file in the Patent and Trademark Office an affidavit *setting forth those goods or services recited in the registration on or in connection with which the mark is in use in commerce and attaching to the affidavit a specimen or facsimile showing current use of the mark,* or showing that any nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark...(emphasis added).

Specimen of Use of the Mark [1]

Section 8 of the Trademark Act, as quoted above, specifically requires that a specimen or facsimile showing current use of the mark be attached to the affidavit. Because the specimen is required by statute, it must be submitted before the expiration of the sixth year after the date of registration. Trademark Rule 2.162(e), 37 C.F.R. §2 162(e); TMEP §1603.08. The Commissioner does not have the authority to extend or waive the deadline for Sling the specimen.

Petitioner invokes Trademark Rule 2.162(e), 37 C.F.R. §2.162(e), for the proposition that the lack of a specimen can be cured after the expiration of the statutory period. Trademark Rule 2.162(e) reads, in pertinent part, as follows:

> The statement [Affidavit under Section 8] must be accompanied by a specimen or facsimile, for each class of goods or services, showing current use of the mark. If the specimen or facsimile is found to be deficient, a

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[2] Trademark Rule 2.162(e) requires that the type of commerce be specified. However, this is not a statutory requirement and can be rectified after the deadline for filing the *affidavit* has expired. *Trademark Manual of Examining Procedure (TMEP)* § 1603.07. Therefore Petitioner's assertion that *its* Section 8 affidavit "clearly specifies the type of commerce" in which the mark is used will not be addressed in this decision. Likewise the Petitioner's arguments regarding acceptance of the Section 8 filing fee will not be addressed, because the fee is not a statutory requirement. Trademark Rule 2.162(e), 37 C.F.R.; §2.162(e).

substitute specimen or facsimile may be submitted and considered even though filed after the sixth year has expired...

Petitioner acknowledges that a specimen of use did not accompany its Section 8 affidavit. Therefore, it cannot avail itself of the remedy in Rule 2.162(e) because no specimen originally accompanied the Section 8 affidavit. Complete lack of a specimen is not considered to be merely a deficiency in the specimen.

Recitation of Services

Section 8 also expressly requires that the affidavit *"[s]et forth those goods or services recited in the registration* on or in connection with which the mark is in use in commerce...(emphasis added)." Although Office policy permits a Registrant to "incorporate by reference" the identification of goods or recitation of services set forth in the registration, such statement of incorporation must be explicit, requiring no interpretation or conjecture as to its meaning. *In re Bonhons Barnier S.A. 17* USPQ2d 1488, 1489 (Comm'r Pats. 1990). This requirement must be satisfied before the expiration of the sixth year following the date of registration, and it cannot be waived by the Commissioner. Trademark Rules 2.161 and 2.162(e); TMEP §1603.06.

DECISION

Petitioner essentially contends that its Section 8 affidavit should be accepted because the requirements for the filing of a specimen and recitation of services were not set forth on the Certificate of Registration, and because it was not notified of these requirements until after the statutory deadline had expired. While the Office regrets that Petitioner was not earlier notified of the statutory deficiencies in the Section 8 affidavit, [2] it is the Registrant who is ultimately responsible for filing proper documents. The Office attempts to notify parties as to defective papers to permit timely refiling, but it has no obligation to do so. *In re Holland American Wafer* Co., 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984).

The Commissioner sympathizes with the Petitioner, but he has no authority to extend or to waive the deadline for complying with the statutory requirements of Section 8 of the Trademark Act. *In re Mother Tucker's Food Experience (Canada) Inc. 925* F 2d 1402, 17 USPQ2d 1795 (Fed. Cir. *1991); In re Precious Diamonds, Inc.,* 635 F 2d 845, 208 USPQ 410 (C.C.P.A. 1980).

The petition is denied. The registration will be cancelled in due course.

Philip G. Hampton, II
Assistant Commissioner
for Trademarks

[2] It is noted that the Section 8 affidavit was filed only one day before the statutory deadline expired.

PGH:NLO:EKM

Date:

Attorney for Petitioner:

Elizabeth M. Cashman, Esq.
GLANKLER BROWN, PLLC
One Commerce Square
Seventeenth Floor
Memphis, Tennessee 38103