Re: Trademark Application of

Kanebo Kabushiki Kaisha (Kanebo, Ltd.)

Serial No. 1,624,902 On Petition

Registration Date: November 27, 1990

For: SAVINA

Petition Filed: April 29, 1997

Kanebo Kabushiki Kaisha (Kanebo, Ltd.) has petitioned the Commissioner to accept a Section 8 declaration for Class 21 goods, filed in connection with the above identified registration. Trademark Rules 2.146(a)(2) and 2.165(b) provide authority for the requested review.

## **FACTS**

The above registration was issued on November 27, 1990, for two international classes: 21 (wiping cloth) and 24 (textile fabrics for use in the manufacture of clothing). Pursuant to Section 8 of the Trademark Act, 15 U.S.C. §1058, Registrant was required to file an affidavit or declaration of continued use or excusable nonuse between the fifth and sixth year after the registration date, i.e., between November 27, 1995 and November 27, 1996.

On February 27, 1996, Petitioner filed a combined declaration, under Sections 8 and 15 of the Trademark Act, a check for \$200 and a hang tag with the mark SAVINA on the front. The inside of the tag identifies the type of fabric and provides instructions for the care and cleaning of the fabric, clearly for the goods in class 24. No other specimens were included and the cover letter accompanying the combined declaration stated: "(W)e attach Check No. 51600 in the amount of Two Hundred Dollars (\$200.00) to cover the official fees for filing in *one (1) International Class*" (emphasis added).

On July 17, 1997, the Affidavit/Renewal Examiner issued an Office Action notifying Petitioner that the declaration could not be accepted for Class 21 because the required specimen was not submitted. No response was received to this Office Action and on March 16, 1997, the combined declaration was accepted as to Class 24, and canceled as to Class 21. This petition was filed on April 29, 1997.

Counsel for Petitioner declares that he didn't responded to the July 17, 1997 Office Action because it was never received. The petition includes a response to the Office Action which includes a specimen for Class 21 and a declaration signed by counsel attesting to its use on the date of execution of the combined declaration.

## **DECISION**

Section 8 of the Trademark Act, 15 U.S.C. §1058, requires that an affidavit or declaration under

Section 8 of the Act be accompanied by a specimen showing current use of the mark. While the Act does not actually contain a "per class" specimen requirement, Trademark Rule 2.162(e), 37 C.F.R. §2.162(e), does state that the affidavit or declaration must "be accompanied by a specimen or facsimile, for each class of goods or services, showing current use of the mark."

Pursuant to Trademark Rule 2.1 62(e), a registrant who has submitted a "deficient" specimen for a class of goods or services may cure the deficiency after the sixth year has expired, if the registrant verifies that the substitute specimen or facsimile was in use in commerce prior to the expiration of the sixth year. However, an omission of the required specimen for a particular class is a substantive deficiency that cannot be cured after expiration of the statutory period for filing the Section 8 declaration.

In this case, the specimen submitted with the combined declaration was applicable only to the goods in Class 24 and does not apply to the goods in Class 21. Furthermore, the substitute specimen submitted with the petition cannot be accepted in as much as the Commissioner is without the authority to accept a specimen submitted after the expiration of the statutory period. *Inre Mother Tucker's Food Experience (Canada) Inc.*, 925 F.2d 845, 208 USPQ 410 (C.C.P.A. 1980). While the Commissioner regrets that Petitioner did not receive the Office Action dated July 17, 1996, it would be futile to forward the registration file to the Examiner to consider a response which cannot cure the substantive deficiency in the Section 8 declaration.

Accordingly, the petition is denied. The registration will remain canceled for the goods in Class 21. Should Petitioner wish to file a new application for registration of the mark in this class, the Office will upon request, expedite handling of the application. *See* TMEP §1102.03.

Philip G. Hampton, II Assistant Commissioner for Trademarks

PGH:JCL:DHM

Date:

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