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UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
OFFICE OF ASSISTANT COMMISSIONER FOR TRADEMARKS  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

98-652

Re: Trademark Application of :  
Sanford Acquisition Company :  
Registration No. 1,672,989 :  
Issued: July 21, 1992 : On Petition  
For: SPD AND DESIGN :  
Petition Filed: August 31, 1998 :

Sanford Acquisition Company has petitioned the Commissioner to accept a combined Section 8 and 15 declaration filed in connection with the above identified registration. 37 C.F.R. §§2.146(a)(3), 2.146(a)(5) and 2.148 provide authority for the requested review. The petition is denied.

#### FACTS

The above registration issued on January 21, 1992. 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 January 21, 1997 and January 21, 1998. On January 21, 1998, Dana Corporation filed a combined declaration under Sections 8 and 15 of the Act.

In an Office Action dated March 10, 1998, the Affidavit-Renewal Examiner withheld acceptance of the combined declaration pending receipt of evidence showing ownership in the present claimant such as recordation of an assignment, merger or change of name with the Assignment Branch of the Patent and Trademark Office. The records of the Assignment Branch of the Patent and Trademark Office showed title to the registration to be vested in Sanford Acquisition Company, Michigan Corporation, rather than Dana Corporation, Virginia Corporation. Petitioner was advised that in the absence of a proper response filed within six months of the mailing date of the action, a cancellation order would be issued.

On April 10, 1998, Petitioner filed a second combined declaration in the name of Sanford Acquisition Company. In a letter dated July 21, 1998, Post Registration Examiner notified Petitioner that the registration was cancelled for failure to comply with the statutory requirements for filing Section 8 and 15 Affidavits. The Post Registration Examiner's letter indicated that the registration would be canceled because the affidavit was filed after the sixth year following the date of registration. This petition followed.

Petitioner asserts that the January 21, 1998 affidavit was inadvertently misfiled in the name of Dana Corporation, the parent corporation of registrant, Sanford Acquisition Company. Petitioner

requests the Commissioner to review the action of the Post Registration Examiner and accept the amended Affidavit filed April 10, 1998.

## ANALYSIS

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....

The statute specifically requires that the affidavit be filed by the “registrant,” prior to the expiration of the sixth year after the date of registration. The term “registrant” includes both the original registrant, and a person who has acquired ownership through proper transfer of title. Section 45 of the Trademark Act, 15 U.S.C. §1127; TMEP §1603.05. Where an assignee seeks to file a Section 8 affidavit, the assignee must establish its ownership of the mark. Ownership is established by submitting documentary evidence of a chain of title from the original owner to the assignee, or by specifying the reel and frame number where such evidence is recorded in the Patent and Trademark Office. 37 C.F.R. §3.73(b); TMEP §§502 and 1603.05(a). *In re Caldon Company Limited Partnership*, 37 USPQ2d 1539 (Comm’r Pats. 1995).

Office practice permits applicants and registrants to correct a mistake in the manner or form in which the applicant’s/registrant’s name is set out in the application for registration and in subsequent filing of affidavits of use. TMEP §§802.07, 1201.02(c) and 1603.05(b). A request to correct a mistake in the applicant’s or registrant’s name is permissible where: (1) there is ambiguity as to who the owner of the mark is or there is a mistake in the identification of the applicant’s/registrant’s name or entity type; (2) the party who filed the papers is the owner of the mark; and (3) the misidentification does not name a different existing legal entity. *See Accu Personnel Inc. V. Accustaff Inc.*, 38 USPQ2d 1443 (TTAB 1996); *In re Colombo Inc.*, 33 USPQ2d 1530 (Comm’r Pats. 1994); *In re Atlanta Blue Print Co.*, 19 USPQ2d 1078 (Comm’r Pats. 1990).

When held to the standard, Petitioner’s affidavit fails with respect to the second and third requirements. In this case, the Affidavit/Renewal Examiner properly withheld acceptance of the affidavit since the affidavit was filed by a party that did not own the mark, and the affidavit clearly identified the name of a different existing legal entity.

The Section 8 and 15 affidavit was submitted in the name of Dana Corporation. The assignment Branch records of the Office show title of the mark to be vested in Sanford Acquisition Company. Petitioner has not provided any evidence of a transfer of title to the present claimant, Dana Corporation nor recorded appropriate documents with the Assignment Branch of the

Office, that establish a complete chain of title from Sanford to Dana. Trademark Rule 3.73; TMEP §1603.05(a).

When a Section 8 affidavit is timely filed by the owner of the registration, but the records of the Patent and Trademark Office show title in another party, the party who filed the affidavit may submit evidence of its ownership of the registration even if the sixth year following the date of registration has expired. TMEP §1603.11. However, if the party who filed the affidavit was not the owner of the registration at the time the affidavit was filed, a substitute affidavit in the name of the true owner cannot be filed unless there is time remaining in the statutory filing period. *In re Precious Diamonds, Inc.*, 635 F.2d 845, 208 USPQ 410 (C.C.P.A. 1980); *In re Weider*, 212 USPQ 947 (Comm'r Pats. 1981).

## DECISION

37 C.F.R. §§2.146 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. However, the Commissioner has no authority to waive a requirement of the statute. Here, Petitioner has declared that the name listed on the affidavit was an inadvertent clerical error and subsequently filed a corrected affidavit listing the correct owner of record. However, the amended affidavit submitted April 10, 1998, was filed after the sixth year following the date of registration. Because the requirement that the registrant file the affidavit between the fifth and sixth year after the date of registration is statutory, it cannot be waived.

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

Robert M. Anderson  
Deputy Assistant Commissioner  
for Trademarks

RMA:NLO:SMW

Date:

Attorney for Petitioner:

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