

Re: Trademark Application of :
 Cyber-Blitz Trading Services :
 Application Ser. No. 75-355876¹ :
 For: LOKI GOLF and design : On Petition
 Filing date: Not Assigned² :
 Petition Filed: October 10, 1997 :

Cyber-Blitz Trading Services has petitioned the Commissioner to accord a filing date of September 12, 1997, for the above-identified application which was denied a filing date for failure to comply with Trademark Rule 2.21(a)(5), 37 C.F.R. §2.21(a)(5). The petition is denied under Sections 1(b)(1)(A) and 44(d) of the Trademark Act, 15 U.S.C. §§1051(b)(1)(A) and 1126(d).

FACTS

Petitioner filed the subject trademark application on September 12, 1997. The application papers asserted two bases: use of the mark in commerce with the United States; and a claim of priority based on ownership of a Canadian application.

On October 1, 1997, the Pre-Examination Section rejected the application because it did not include (1) a specimen showing actual use of the mark on the goods, as required for applications filed based on use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a); and (2) a statement of a “bona fide intention to use the mark in commerce,” as required for applications claiming priority under Section 44(d), 15 U.S.C. §1126(d). This petition followed.

Petitioner explains that the reference to Section 1(a) in the initial application was in error and that it seeks registration solely under the provisions of Section 44(d). Petitioner argues that it has met the requirements of Section 44(d) in that its statement of actual use exceeds the requirement for a statement of a “bona fide intention to use the mark in commerce.” Petitioner bases its argument on *In re Vitamin Beverage Corp.*, 37 USPQ2d 1537 (Comm’r Pats. 1995), in which the Office accepted a statement of actual use, rather than a statement of a bona fide intention to use the mark in commerce, for an Extension of Time to File A Statement of Use.

DECISION

Petitioner’s statement of use in commerce was made in support of the Section 1(a) basis for registration. However, Petitioner specifically deleted its Section 1(a) basis. Therefore, as a

¹ This Serial Number has been misassigned. A new application, Serial Number 75-375516, for the same trademark and identifying the same goods was submitted by the Applicant and granted a filing date of October 20, 1997.

² The filing date is the issue on petition.

practical matter, Petitioner now cannot rely on that statement since, technically, it no longer is part of the application file.

Even if Petitioner can show that the statement remains a part of the application, Petitioner's position does not comply with the requirements set forth in Trademark Act Section 44(d). Section 44(d) entitles a foreign national to the benefit of priority based on an application filed in its home country. The statute specifically requires that the U.S. application include a statement that the Applicant has a bona fide intention to use the mark in commerce. An averment of actual use in the application papers does not meet the requirements of the statute:

There is no ambiguous language or language of exception. The requirement that a Section 44(d) applicant specifically set forth its bona fide intent to use the mark in commerce is a clear statutory requirement. The Commissioner is without authority to waive a statutory requirement. . . . There is no reason why, in such a case, the petitioner can not also set forth a statement regarding its actual use as additional information in the record. In this way, the application will contain the statutorily required language of a bona fide intention to use the mark in commerce as well as the additional clarifying language that, in this particular instance, the mark is actually in use in commerce.

In re Paul Wurth S.A. 21 USPQ2d 1631, 1633 (Comm'r Pats. 1991).

Nonetheless, Petitioner relies on *In re Vitamin Beverage Corp.* That case involved the filing of a Request for Extension of Time to File a Statement of Use under Section 1(d)(2) of the Trademark Act, 15 U.S.C. §1051(d)(2). It held that a statement that the mark is currently in use will be accepted by the Office as being substantially in compliance with the statutory requirement for a statement that the Applicant has a bona fide intention to use the mark in commerce.

The instant case is controlled by *In re Paul Wurth* since it concerns the denial of a filing date under Section 44, not an extension request for an application based on the intent to use provisions of Section 1(b). *In re Paul Wurth* was not overruled by *In re Vitamin Beverage Corp.*

One significant difference between Section 1(b) and 44 of the Trademark Act is that Applicants who rely on Section 1(b) as a filing basis must establish use of the mark prior to registration, or the application will become abandoned. In contrast, Applicants who rely solely on Section 44 are not required to demonstrate use in order to obtain registration.³ *Crocker National Bank v.*

Canadian Imperial Bank of Commerce, 223 USPQ 909 (TTAB 1984). In fact, the first time evidence of use usually is required for Section 44 Applicants is upon the filing of an Affidavit of Continued Use under Section 8 of the Trademark Act, 15 U.S.C. §1058. This does not occur until five to six years after registration.

³ As noted above, the original application papers asserted as one of the filing bases use of the mark in commerce with the United States under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a). However, in the petition, the Applicant amended its application by specifically deleting references to Section 1(a).

The statement of actual use in *In re Vitamin Beverage Corp.* was not evaluated in the context of granting a filing date. It was accepted by the Office in part because the Applicant already had met its filing requirements and obtained a filing date under Section 1(b), but still was required to validate use of its mark by submitting appropriate specimens. The statement of actual use in this instance is different because the Section 44 Applicant would not be required to submit specimens or otherwise substantiate use of its mark in order to obtain registration.

After the decision in *Crocker National Bank v. Canadian Imperial Bank of Commerce*, there was significant concern with the advantageous position of Section 44 applicants over domestic applicants. Therefore, when Congress enacted the Trademark Law Revision Act of 1988, it implemented the intent to use provisions of Section 1(b). It also required all applications based on Section 1(b) and Section 44 to state a bona fide intent to use the mark in commerce for the specified goods or services. The reason Congress included the bona fide intent language in Section 44 specifically was to create a more level playing field for domestic applicants relying on Section 1(b) and foreign applicants relying on Section 44 as a filing basis. Given the desire to seek greater parity between domestic and foreign applicants, the language of the statute itself, that “the applicant has a bona fide intention to use the mark in commerce,” is critical and must be contained in an application filed pursuant to Section 44(d). When introducing H.R. 4156, Representative Moorhead made the following statement:

The legislation puts American and foreign businesses on essentially the same footing when they apply to register trademarks in the United States. It does this by allowing domestic applicants to file applications to register marks without first using these marks in commerce; they can base their applications on an intention to use the mark, rather than on actual use, as the law currently requires. While the bill eases the application requirements for U.S. businesses, it increases them for foreign applicants. Presently, foreign companies can file and obtain a U.S. trademark registration without first using the mark at all, anyplace. They do not even have to state that they have an intention to use the mark in the United States. If enacted, this legislation would require that they state such an intent.

The Legislative History, Reports, Testimony and Annotated Statutory Text: Trademark Law Revision Act of 1988, (Public Law 100-667), reported at page 129 of the USTA publication.

By accepting and applying Petitioner’s arguments, the Office arguably could be placing Section 44(d) Applicants in a more favorable position than other Applicants. For example, foreign Applicants who indicate Section 44(d) on their application papers but who fail to provide the specific language of the statute would be able to keep their U.S. filing dates and proceed as Section 1(a) Applicants, so long as other statutory requirements are met. Domestic Applicants

have no similar alternative. That is, U.S. Applicants who file based on Section 1(b) must include the statutory language of a “bona fide intention to use the mark in commerce” or their applications are considered void as filed. Furthermore, domestic Applicants who file an application based on use in commerce under Section 1(a) of the statute are denied a filing date if they omit a filing requirement, such as specimens or the date of first use in commerce. They are not permitted to amend the filing basis to Section 1(b). The initial purpose of Section 44 was to

implement the provisions of the International Convention of Paris for the Protection of Industrial Property. Since the passage of the Trademark Law Revision Act, it is clear that Section 44 is not meant necessarily to place foreign Applicants in a more favorable position than domestic Applicants or other foreign Applicants who cannot rely on Section 44.

Accordingly, the petition is denied.

Philip G. Hampton, II
Assistant Commissioner
for Trademarks

PGH:NLO:HES

Date:

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