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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

98-552

Re: Trademark Registration of :
Schmid Laboratories, Inc.¹ :
Registration No - . 1,040,505 :
Issued: June 1, 1976 : On Petition
For: FOUREX :
Petition Filed: July 14, 1998 :

Schmid Products Corporation of Puerto Rico has petitioned the Commissioner to review the action of the Post Registration Affidavit-Renewal Examiner denying renewal of the above identified registration. Trademark Rules 2.146(a)(2) and 2.184(b), 37 C.F.R. §§2.146(a)(2) and 2.184(b), provide authority for the requested review. The petition is denied.

FACTS

The above-referenced mark was registered on the Principal Register on June 1, 1976. The Combined Declaration under Sections 8 and 15 of the Trademark Act for this registration was accepted on October 12, 1982. On January 30, 1996, the Petitioner filed the Application for Renewal under Section 9 of the Trademark Act (the "renewal application") in connection with the registration.

In a letter dated April 8, 1996, the Affidavit-Renewal Examiner notified Petitioner that renewal was withheld because the records of the Assignment Branch of the Trademark Office showed title to the registration to be vested in the registrant, rather than in Petitioner. Petitioner was required to establish ownership of the registration as of a date at least as early as the date of execution of the renewal application, by (1) recording appropriate documents in the Assignment Branch, or (2) submitting proof of the transfer of title to the present claimant.

By letter dated December 1, 1997, Petitioner stated that it was in the process of obtaining the required Assignment ownership documents, which were quite extensive, and requested additional time to submit those documents. On January 14, 1998, the Affidavit-Renewal Examiner refused acceptance of the renewal application because Petitioner failed to establish ownership of the above-referenced mark. The Affidavit/Renewal Examiner identified breaks in

¹ The records of the Assignment Branch of the Patent and Trademark Office indicate that the above-referenced registration was assigned to Schmid Products Corporation of Puerto Rico at Reel No. 0367, Frame No. 0805.

the chain of title between (1) Schmid Products Corporation of Puerto Rico, Delaware corporation and LRC North America, Inc, Delaware Corporation, recorded at Reel 0367, Frame No. 0805; and (2) Schmid Products Corporation of Puerto Rico, Delaware Corporation and Cook Bates Company, Inc, Florida Corporation and LRC Surety Products, Delaware Corporation, both, parties to a merger recorded at Reel 0760, Frame 0022.

This petition was filed July 14, 1998. Petitioner was granted 90 days to submit documentary evidence that showed legal title had been transferred to the Renewal applicant, LRC North America, Inc. A supplement to the petition was filed December 9, 1998.

ANALYSIS

If the owner, as set forth in the application for renewal, is not the same person or the same legal entity as the registrant shown in the registration, continuity of title from the registrant to the present owner must be shown. Trademark Rule 3.73, 37 C.F.R. §3.73, states, in part:

When the assignee of the entire right, title and interest seeks to take action in a matter before the Office with respect to a . . . registration, . . . the assignee must establish its ownership of the property to the satisfaction of the Commissioner. Ownership is established by submitting to the Office documentary evidence of a chain of title from the original owner to the assignee or by specifying (e.g. reel and frame number, etc.) where such evidence is recorded in the Office.

During the renewal period the Renewal applicant filed several responses with the office, none of which included any documents evidencing Petitioner's continued efforts to review or correct the break in the chain of title.

Further, Petitioner has declared in its supplement to the petition that the breaks in the chain of the title are the result of errors in the recordation of the assignment documents. However, Petitioner has not provided the Office with any documents that show that a correction to those alleged errors has been filed with the Assignment Branch of the Office.

Section 9 of the Trademark Act requires a verified application setting forth the goods or services recited in the registration on or in connection with which the mark is still in use in commerce...." Trademark Rule 2.183 requires the renewal application to be verified by the registrant. Here the renewal applicant was notified that the chain of title was not clear so as to show that the renewal applicant was the proper party to submit the verified application.

Petitioner has not shown continuity of title from Schmid Products Corporation of Puerto Rico to LRC North America, Inc., thus establishing LRC North America, Inc. as the proper renewal applicant.

The petition is denied. The registration file will be returned to Post Registration for further processing.

Robert M. Anderson
Acting Assistant Commissioner
For Trademarks

RMA:NLO:SMW

Date:

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