Commissioner of Patents and Trademarks
Patent and Trademark Office (P.T.O.)

RE: TRADEMARK REGISTRATION OF HOME FASHIONS, INC.
Registration No. 1,301,202
August 30, 1991
***1** Petition Filed: January 30, 1991

For: LOUVERDRAPE
Issued: October 23, 1984

Attorney for Petitioner

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Assistant Commissioner for Trademarks

On Petition

Home Fashions, Inc. has petitioned the Commissioner for an order reversing a partial cancellation of the above referenced registration. Review of the petition is undertaken pursuant to Trademark Rules 2.146 and 2.148, 37 C.F.R. § § 2.146 and 2.148.

Petitioner's mark is used on or in connection with "blinds" of varying compositions. In this case, composition determines classification; since the blinds in question are of three different types, the registration issued in three international classes.

Pursuant to Section 8 of the Trademark Act, 15 U.S.C. § 1058, an affidavit or declaration attesting to continued use of the mark in commerce, for the goods recited in the registration, was required to be filed between October 23, 1989 and October 23, 1990. An appropriate declaration was filed on September 17, 1990.

On December 20, 1990, the Affidavit-Renewal Examiner issued an action noting the sole deficiency in petitioner's submission. Specifically, she noted that the registration issued for goods in three classes but that the petitioner had filed only two specimens evidencing use of the mark. The examiner noted that Section 8 requires submission of a specimen for each class of goods or services in a registration and also noted that since the sixth year following issuance of the registration had closed, the deficiency in the number of specimens could not be remedied. Accordingly, the examiner concluded the registration's highest numbered class of goods would be cancelled. [FN1]

Counsel for petitioner subsequently challenged the propriety of the Affidavit-Renewal Examiner's action in a letter addressed to the Commissioner of Patents and Trademarks, and in telephone conversations

with the Trademark Legal Administrator. The instant petition was filed shortly thereafter.

Trademark Rule 2.165(a)(2), 37 C.F.R. § 2.165(a)(2), states that a request for reconsideration is a condition precedent to the filing of a petition to the Commissioner for review of an Affidavit-Renewal Examiner's refusal to accept a Section 8 affidavit or declaration. In this case, however, counsel knew from his discussions with the Trademark Legal Administrator that the examiner's action was viewed as appropriate under the circumstances and a request for reconsideration would have been denied. Accordingly, the requirement that petitioner pursue a request for reconsideration is waived and the petition is deemed appropriate.

Section 8 of the Trademark Act does not actually contain a "per class" specimen requirement; the section simply states that an affidavit or declaration must have attached to it "a specimen or facsimile showing current use of the mark." However, 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."

***2** Counsel for petitioner acknowledges the terms of Rule 2.162(e) but argues the "rule does not state that a single specimen is not acceptable to show use of the mark on goods covered by each of the classes set forth in the registration." In addition, counsel notes that the rule permits substitution of an acceptable specimen of use for a deficient specimen, even though the sixth year following registration has passed. Counsel argues that acceptance of a substitute specimen after the sixth year "represents a far greater deviation from the letter of the Trademark Statute" than does acceptance of a single specimen for more than one class of goods when the same specimen is used for all the goods in each of the classes covered by the registration. Finally, counsel argues that it is inequitable to cancel a class of goods from petitioner's registration when the declaration was filed forty days prior to its deadline date but was not examined until three months later, after the sixth year had passed and it was too late for the filing of an additional specimen.

The last argument is the most easily disposed of. While it is regrettable that notification of the deficiency in petitioner's Section 8 declaration did not occur until after the close of the statutory filing period, the responsibility to submit proper filings rests with petitioner and its counsel. Although the Patent and Trademark Office attempts to notify parties as to defective papers to permit timely correction or refiling, it has no obligation to do so. In re Holland American Wafer Co., 222 USPQ 273 (Fed.Cir.1984). In addition, petitioner's argument on this point is cast as a plea for equitable relief. The plea is not well taken when there was a period of one year in which the declaration in question could have been filed and filing was delayed until just more than a month remained.

Though Petitioner's central argument is set forth in somewhat skeletal fashion, it may be summed up as follows: (1) the Trademark Act itself does not require a specimen for each class; (2) it is only a Trademark Rule that contains the "per class" specimen requirement; (3) compliance with a rule may be waived by the Commissioner in certain

"extraordinary situations"; and (4) in any event, the rule is sufficiently vague to allow it to be read to permit the filing of single specimen for a multi-class registration, when the same specimen is used in all classes.

Trademark Rules 2.146(a)(5) and 2.148, 37 C.F.R. § § 2.146(a)(5) and 2.148, permit the Commissioner to waive any provision of the rules which is not directly reflective of a provision of the statute (1) where an extraordinary situation exists, (2) where justice requires waiver, and (3) when no other party would be injured by waiver. All three conditions must be satisfied before a waiver is granted.

The instant case does not present an appropriate set of circumstances justifying waiver of Rule 2.162(e). The present situation is not extraordinary in nature. Counsel for petitioner has admitted that he intended to file a specimen for each class, as the rules require, but cannot say for sure that he acted in accordance with his intention. Inadvertent omissions on the part of attorneys do not constitute extraordinary situations within the purview of the rules. In re Bird & Son, Inc., 195 USPQ 586, 588 (Comm'r Pats.1977).

***3** In regard to the final point of petitioner's central argument, the contention that Rule 2.162(e) is vague is rejected. Counsel's admission of his intent to file a specimen for each class supports the conclusion that the Rule's "per class" specimen requirement is clear. However, while the Rule is not viewed as suffering from vagueness, counsel's comparative analysis of the present situation and those situations in which substitute specimens may be filed is well taken, though overstated. [FN2]

As noted, Rule 2.162(e) requires submission of "a specimen or facsimile, for each class of goods or services, showing current use of the mark." Consider a slight change in the sentence structure of this portion of the rule, resulting in a requirement that the registrant submit "a specimen showing current use of the mark for each class of goods or services." Had the rule been drafted in this way it would more clearly contemplate submission of a single specimen, even for a multi-class registration, in those circumstances when the single specimen would result in a showing of "use of the mark" for goods in each class covered by the registration.

The purpose behind both Section 8 and Trademark Rule 2.162 is to have the register reflect the actual commercial use of a registered mark. Registrations for marks which are no longer in use, or which are only in more restrictive use than their registration certificates indicate, should be cancelled in whole or in part, as appropriate. On the other hand, the purpose of the statute and rules is not served through cancellation of a class of goods or services in a registration when it is shown that the mark remains in use for all the goods or services recited in the registration.

Office policy has recently been changed to allow for a more liberal reading of the "per class" specimen requirement of Rule 2.162(e). When an insufficient number of specimens is submitted with a Section 8 affidavit or declaration for a multi-class registration, cancellation of classes in excess of the number of specimens submitted will no longer be automatic. If the specimens that are submitted, on their

face, clearly evidence continuing use of the mark for goods or services in each of the classes covered by the registration, then no classes will be cancelled solely due to an insufficiency in the number of specimens. The revised policy has been applied in a recent petition decision and is in the process of being implemented in the Post Registration Section.

In the case at hand, the specimens do not, in and of themselves, evidence use for goods in every class covered by petitioner's registration. Nonetheless, they do not contain specific references to any particular type of petitioner's blinds and could easily be used for all types. Further, counsel for petitioner has affirmatively stated that the two identical specimens that were submitted are in fact used for all of petitioner's goods. Finally, there is a note in the registration file from the Examining Attorney that initially handled the application that matured into this registration. It is adjacent to a specimen nearly identical to the two that have been submitted with the Section 8 declaration in question and notes: "This specimen is used for all three classes."

***4** Given these factors, it is reasonable to accept the two submitted specimens as evidence of petitioner's continuing use of the mark for goods in all the classes covered by the registration. Though the recent change in policy allowing for a more liberal reading of Rule 2.162(e) was adopted subsequent to the processing and examination of petitioner's declaration, there is no reason not to apply the policy to the case at hand.

The petition is granted. The notice from the Affidavit-Renewal Examiner indicating that class 24 would be cancelled is vacated. A substitute notice indicating acceptance of the declaration for all three classes will be prepared and issued. Since declaration fees for only two classes have been deducted from the deposit account of petitioner's counsel, an additional fee of $200 will be deducted.

FN1. It is Office practice, in those situations where an insufficient number of fees is paid for a particular multi-class filing, to apply the fees to the lowest numbered classes. The Affidavit-Renewal Examiner evidently applied this practice to the case at hand because of the insufficient number of specimens. While the examiner should have given petitioner the option of specifying which classes in the registration the specimens were submitted for, the resolution of this petition renders it unnecessary to address this issue further.

FN2. The comparison is overstated to the extent that it suggests the provision allowing for the filing of a substitute specimen after the close of the statutory filing period is contrary to the spirit of the Trademark Act. However, this is a non-issue in the instant petition and will not be discussed further.

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