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

RE: TRADEMARK APPLICATION OF TOKIWA MFG. CO., LTD.
Serial No. 74-068,352 [FN1]
August 27, 1991
***1** Petition Filed: January 4, 1991

For: TOKIWA
Filing Date: June 12, 1990 [FN2]

Attorney for Petitioner

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Assistant Commissioner for Trademarks

On Petition

Tokiwa Mfg. Co., Ltd. has petitioned the Commissioner to grant a filing date of June 12, 1990 to the above-captioned application. Trademark Rule 2.146(a)(3) provides the authority for the requested review.

Petitioner filed an application pursuant to Section 1(a) of the Trademark Act, to register the above-identified trademark on June 12, 1990. Subsequently, on December 12, 1990, the filing date was cancelled and the papers were returned to the petitioner. In the Notice of Incomplete Trademark Application, the Supervisor of the Trademark Application Section stated that the application did not satisfy all of the requirements set forth in 37 C.F.R. Section 2.21(a) necessary to receive a filing date. In particular, it was noted that the goods or services in connection with which the mark is used, or is intended to be used, had not been identified in accordance with Trademark Rule 2.21(a)(4).

Although Petitioner utilized its own application format rather than completing the Patent and Trademark Office form, it appears that Petitioner's application was, in fact, stylized after the Office form incorporating a fill- in-the-blank type of format.

One portion of Petitioner's application reads:

> The above-identified applicant, on information and belief, has adopted and is using the trademark shown in the accompanying drawing for:

Petitioner, failed to list any information in this section of the application, leaving a blank where the goods or services were to be identified. Petitioner filled in all other pertinent portions of its application papers, including the method of use clause where it

specified that "[t]he mark is used by applying it to Parts and Accessory [sic] of Piano Action (Striking Mechanism) such as 'shank', 'flange', 'wippen' and 'backcheck' and five (5) specimens showing the mark as actually used are presented herewith." Additionally, the heading to the drawing page contains, among other things, the following statement:

Goods/Services: Parts and accessory [sic] of piano action (striking mechanism) such as 'shank', 'flange', 'wippen" and 'backcheck'.

The petitioner argues that "[w]hile the application was informal in that the goods were not listed in the proper place in the application document, the application document did at the time of its filing contain all the necessities." The issue raised by this petition is not whether the petitioner had listed the goods or services anywhere in the application papers, but rather, whether Petitioner's failure to list the identification in the appropriate place on its application form precludes the Application Section from granting the application a filing date.

***2** The Supervisor of the Application Section, in accordance with Office policy, ruled that Petitioner's improper placement of the identification of goods was tantamount to failure to include an identification in the written application. Trademark Rule 2.146(a)(3), 37 C.F.R. Section 2.146(a)(3) permits the Commissioner to invoke his supervisory authority in appropriate circumstances. In this case, however, the rejection of the application as submitted will not be reversed.

The Trademark Examining Operation receives hundreds of applications to register trademarks and service marks each day. Each application must pass an initial review to determine whether the minimum requirements for receiving a filing date, as set forth in Trademark Rule 2.21, 37 C.F.R. Section 2.21, have been met. The volume of work that must be handled by the clerical personnel of the Application Section allows only a brief period for review of each application. It would prove an administrative burden on the Office to require each employee of the Application Section engaged in the initial review of applications to search every section of every paper for any and all items of information that must be included in a minimally sufficient application.

Further, Office procedures established by the Director of the Trademark Examining Operation and set forth in "Examination Guide 1-90: Supplemental Guidelines Concerning the Trademark Law Revision Act of 1988 and the Revised Rules of Practice in Trademark Cases" require examining attorneys to "consider only the identification of goods and services stated in the proper place for the identification in the written application to determine entitlement to a filing date." Examining attorneys are precluded by policy from considering "the drawing, the specimens, the method-of-use clause, the dates-of-use clause or anywhere else in the application to determine the applicant's entitlement to a filing date."

Additionally Section 1 of the Trademark Act, as revised on November 16, 1989, sets out the requirements for filing a trademark application. Specifically, the written application must include, among other things "the goods on or in connection with which the mark is used." The

drawing is a separate requirement under Section 1, and is not a component of the written application.

Accordingly, the procedures followed by the Application Section of the Trademark Examining Operation, in this case, were consistent with Office policy. While an applicant may be required occasionally to re-file an application that has not been properly prepared, the great majority of applicants benefit from enforcement of a policy that fosters expeditious processing of the hundreds of applications that reach the Office daily in proper form.

Trademark Rules 2.146(a)(5) 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. All three conditions must be satisfied before a waiver is granted. Applicant did not complete the section of the written application which sets forth the goods on which the mark is being used. Oversights that could have been prevented by the exercise of ordinary care or diligence are not extraordinary situations as contemplated by the Trademark Rules. In re Bird & Son, Inc., 195 USPQ 586 (Comm'r Pats.1977).

***3** For the foregoing reasons, the petition is denied. The application papers will be returned to the petitioner.

FN1. This Serial No. was originally assigned to the application papers as filed on June 12, 1990. When the filing date was subsequently cancelled and the application papers returned to the petitioner, this serial number was declared "misassigned".

FN2. The filing date is the issue on petition.

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