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

RE: TRADEMARK APPLICATION OF UNISEARCH LIMITED
Refusal No. 007302
August 22, 1991
***1** Petition Filed: August 24, 1990

For: GRAPEVINE
Filing Date: August 2, 1990 [FN1]

Virginia Taylor, Kilpatrick & Cody for Petitioner

Jeffrey M. Samuels

Assistant Commissioner for Trademarks

On Petition

Unisearch Limited, an Australian corporation, has petitioned the Commissioner to grant the above-captioned application its original filing date of August 2, 1990 which was cancelled for failure to comply with the requirements of Trademark Rule 2.21. Trademark Rule 2.146(a)(3) provides the authority for the requested review.

On August 2, 1990, Petitioner filed an application claiming priority pursuant to Section 44(d) of the Act based on its Australian application filed on February 7, 1990. Thereafter, a Notice of Incomplete Trademark Application was issued informing the petitioner that a filing date could not be accorded the submitted papers because "[u]nder Section 44(d) of the Trademark Act, the applicant must supply a claim of bona fide intention to use the mark in commerce and a claim of the benefit of a prior foreign application." (emphasis added) This petition followed.

Petitioner argues that the requirement to state that the applicant has a bona fide intention to use the mark in commerce is invalid as contrary to "Section 44D.-(4) of the Treaty of Paris which provides that no formalities other than a declaration of priority may be required at the time of filing of a treaty priority application."

Section 44(d)(1), of the Trademark Act of 1946, as amended, specifically requires Applicants as described in Section 44(b), who wish to claim the priority filing date of their foreign application, to file their U.S. application within 6 months from the date on which the application was first filed in the foreign country. Section 44(d)(2) provides that the application must conform "as nearly as practicable to the requirements of this Act, including a statement that the applicant has a bona fide intention to use the mark in commerce." Section 44 also relates back to Section 1 of the Act which sets forth the requisite components of an application. There, it is specified that the statement of bona fide intention to use the mark in commerce must be verified by the applicant.

Accordingly, in conformance with the requirements of the Trademark

Act of 1946 the Supervisor of the Trademark Application Section properly refused to accord the application a filing date without the required statement of a bona fide intention to use the mark in commerce.

The petition is denied. The application papers will be returned to the Petitioner. [FN2]

FN1. The filing date is the issue on petition.

FN2. On August 24, 1990, Petitioner simultaneously resubmitted its application papers with its petition. Although those papers have been serialized as application number 74-110498, they can not be accorded a filing date because, once again, the papers lacked a statement of Applicant's bona fide intention to use the mark in commerce, and the papers were resubmitted more than six months after the filing of the Australian application upon which the Section 44(d) claim was based. 15 U.S.C. § § 1051(b) and 1126(d).

21 U.S.P.Q.2d 1559

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