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

RE: TRADEMARK APPLICATIONS OF PAUL WURTH S.A.
Refusal Nos. 008502 and 009593 [FN1]
June 19, 1991
***1** Petitions Filed: December 13, 1990

For: EU-BRAIN

For: EU-BRAIN and design

For: Miscellaneous Design
Filing Date: Not Assigned [FN2]

Attorney for Petitioner

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On Petition

Paul Wurth S.A. has petitioned the Commissioner pursuant to Trademark Rule 2.146 to exercise his supervisory authority and accord a filing date of September 27, 1990 for the above-captioned applications which were denied filing dates for failure to comply with Trademark Rule 2.21(a)(5). Trademark Rule 2.146(a)(3) provides appropriate authority for the requested review.

On September 27, 1990, Petitioner filed the three subject trademark applications claiming priority pursuant to Section 44(d) of the Trademark Act based on its ownership of three corresponding Benelux applications. In addition to specifying the applicable serial number and filing date for the corresponding Benelux application, the petitioner stated, in each application, that "[t]he mark is presently being used in interstate commerce by a related company".

Thereafter, a Notice of Incomplete Trademark Application issued relative to all three applications. It specified that the papers were incomplete as filed and were not being accorded a filing date since they failed to establish a basis for filing. Specifically, it was noted that under Section 44(d), among other things, there must be a claim of a bona fide intention to use the mark in commerce. [FN3]

Petitioner then refiled the same documents on October 25, 1990 together with a cover letter explaining why the statement of a bona fide intent to use the mark in commerce had not been provided. The application papers were once again returned to the petitioner with a

Notice of Incomplete Trademark Application that pointed to the lack of a claim of a bona fide intent to use the mark. [FN4]

This petition followed.

Petitioner does not dispute there was not a claim of a bona fide intention to use the mark in commerce. Rather, petitioner states:

> Because the "magic" phrase of "bona fide intent to use" is not present in the application is clearly of no consequence here. The fact is that a statement of "bona fide intent to use" would be inaccurate under these circumstances as the marks are "presently used in commerce".

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Applicant's attorney advised Applicant that stating "Applicant had a bona fide intent to use" the mark was incorrect and untruthful as Applicant was actually using the mark. Thus, Applicant simply stated the true and accurate facts of its trademark usage.

Under the Trademark Law Revision Act of 1988, all applications not based on use in commerce pursuant to Section 1(a) of the Act are required to state a bona fide intent to use the mark in commerce for the specified goods or services. This includes applications based on Section 44.

***2** Section 44(d) of the Act, which entitles a foreign national to the benefit of priority based on an application filed in its home country, specifically requires, among other things, that:

> (1) the application filed in the United States is filed within six months from the date on which the application was first filed in the foreign country; [and]
>
> (2) the application conforms as nearly as practicable to the requirements of the Act, including a statement that the applicant has a bona fide intention to use the mark in commerce; ....

Reference to the actual language of Section 44(d) illustrates that this requirement was meant for all 44(d) applications in that any and all mention of actual use in commerce was deleted from this section of the Act. In fact, Section 44(d) used to include the language "but use in commerce need not be alleged." This was replaced with the language "including a statement that the applicant has a bona fide intention to use the mark in commerce." As such, this Section now requires the inclusion of this statement as part of every Section 44(d) claim. There is no ambiguous language or language of exception. Accordingly, 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.

It is, however, further noted that the petitioner believes that specifying a claim of bona fide intent to use the mark in commerce is "incorrect and untruthful" when actual use of the mark in commerce has begun. 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. A complete record will therefore be submitted.

Since it is a clear statutory requirement that a Section 44(d) applicant specifically state that it has a bona fide intention to use the mark in commerce, the petition is denied.

FN1. The refusal numbers apply to all three applications. The first goes to the refusal of the September 27, 1990 filing of the three applications and the second is to their October 25, 1990 refiling.

FN2. The filing date is the issue on petition.

FN3. The Notice of Incomplete Trademark Application also noted that a claim of a bona fide intent to use the mark in commerce is required under Section 1(b). There is, however, no indication that Petitioner intended to file under Section 1(b) as well.

FN4. In this Notice of Incomplete Trademark Application, the petitioner was also advised that under Section 1(a) a date of first use in commerce must be specified. Once again, there is no indication that the petitioner intended to apply on a dual basis. It is further noted that this second refiling of the applications was more than six months after the filing date of the Benelux applications upon which petitioner was basing its Section 44(d) claims.

1991 WL 332564 (Com'r Pat. & Trademarks), 21 U.S.P.Q.2d 1631

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