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

RE: TRADEMARK APPLICATION OF ARNAUD GILLIER AND THIERRY GILLIER
Refusal No. 6143; 6771
March 28, 1991
***1** Petition Filed: June 28, 1990

For: ARNAUD & THIERRY GILLIER
Filing Date: June 18, 1990 [FN1]

Attorney for Petitioner

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On Petition

Arnaud Gillier and Thierry Gillier have petitioned the Commissioner, pursuant to 37 C.F.R. § 2.146(a) to accord their trademark application a filing date of June 18, 1990. If granted, the request would allow petitioners to claim a priority filing date under Section 44(d) of the Trademark Act, 15 U.S.C. § 1126(d), and an effective filing date of December 18, 1989.

FACTS

Petitioners, citizens of France, filed an application to register their mark, ARNAUD & THIERRY GILLIER in France on December 18, 1989. The U.S. application was filed on June 18, 1990, the last day of the six month convention priority period under 15 U.S.C. § 1126(d) on which to claim a priority filing date.

The application form listed three bases for application. The box preceding the first basis was checked for use of the mark in commerce under Section 1(a) of the Act, for the following goods in Class 25: sweaters, trousers, skirts, jackets, blazers, tunics, tights, dresses, coats, raincoats, vests, headbands, socks, scarves, bandanas, belts, gloves, capes, cloaks, jeans, T-shirts and dressing gowns.

The box preceding the second basis was checked for applicant's bona fide intention to use the mark in commerce under Section 1(b) for all the goods in Class 3 and for the following goods in Class 25: shoes, boots, slippers, hats, berets and cowls.

The box preceding the third basis was also checked indicating that

the application was based on Section 44(d) of the Act for all the goods in the application.

The Application Section initially stamped the application papers with a receipt date of June 18, 1990. However, the filing date was cancelled and the application papers returned to petitioners with a notification that the application was informal because petitioners had alleged both Sections 1(a) and 1(b) as bases for the application. This petition, filed June 28, 1990, followed. Petitioners had resubmitted the application papers along with their petition. The petition, however, became separated from the application papers and was mislaid in the Office for a period of time. In the meantime, the application papers submitted with the petition were sent to the Application Section and were reviewed again for their adequacy to receive a filing date. The papers were stamped with a receipt date of June 28, 1990 but this date was also cancelled. The papers were returned to the petitioners under refusal number 006771, again, because both Sections 1(a) and 1(b) had been alleged as bases for the application.

***2** Petitioners argue that although the application involved goods in two different classes and was filed with three separate bases, petitioners "[were] careful to avoid claiming intent to use and actual use of the same goods, and [were] under the impression that there would accordingly be no conflict between these two provisions."

DECISION

The Trademark Law Revision Act of 1988 amended Section 1 of the Act to permit the filing of an application to register a mark on the Principal Register based on a claim of a bona fide intention to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. Section 1051(b). Trademark Rule 2.21 sets forth the requirements for receiving a filing date. Specifically, Trademark Rule 2.21(a)(5), 37 C.F.R. § 2.21(a)(5) enumerates the acceptable bases for filing applications. Although the Act was amended to allow applicants to file an application based on an intention to use a mark in commerce, there is in the Trademark Rules of Practice, a clearly stated prohibition against the filing of an application based on both use of a mark in commerce under Section 1(a) and based on a bona fide intention to use the mark in commerce under Section 1(b) of the Act. Trademark Rule 2.33(d), 37 C.F.R. Section 2.33(d).

Trademark Rule 2.33(d) reads as follows:

> An applicant may not file under both sections 1(a) and 1(b) of the Act in a single application, nor may an applicant in an application under section 1(a) of the Act amend that application to seek registration under section 1(b) of the Act.

Under the Trademark Act, a national of a foreign country that is a party to any convention or treaty relating to trademarks to which the United States is also a party, as defined by Section 44(b) of the Act, 15 U.S.C. § 1126(b), may have its U.S. trademark application "accorded the same force and effect as would be accorded the same application if filed in the United States on the same date on which the application was first filed in such foreign country." Trademark Act Section 44(d),

15 U.S.C. § 1126(d). Foreign applicants may allege Section 44 as an additional basis for registration in conjunction with either use in commerce under Section 1(a) or a bona fide intention to use the mark in commerce under Section 1(b). (emphasis added).

Even before implementation of the Trademark Law Revision Act of 1988 enabling applications to be filed based upon a bona fide intention to use the mark in commerce, foreign applicants have always had the opportunity to allege two bases for registration. They were allowed to allege Section 44 as a basis in conjunction with their use in commerce under Section 1(a) of the Act. When the additional basis for filing was added pursuant to the 1988 amendments, these foreign applicants were allowed, in addition, to allege Section 44 in conjunction with a claim of bona fide intention to use the mark in commerce under Section 1(b) of the Act. Thus, the choices facing the foreign applicants after the 1988 amendments have expanded and include: 1) alleging Section 44 as a basis along with Section 1(a) of the Act, or 2) alleging Section 44 as a basis along with Section 1(b) of the Act. These choices are constrained, however, by the absolute prohibition against the allegation of bases under Sections 1(a) and 1(b) of the Act in the same application.

***3** In the present instance, petitioners have alleged Section 1(a) as a basis for "sweaters, trousers, skirts, jackets, blazers, tunics, tights, dresses, coats, raincoats, vests, headbands, socks, scarves, bandanas, belts, gloves, capes, cloaks, jeans, T-shirts and dressing gowns" in Class 25. Petitioners have asserted a claim of priority under Section 44(d) with regard to these goods based on its application filed six months earlier in France. In the same application, petitioners have alleged Section 1(b) as a basis for "shoes, boots, slippers, hats, berets and cowls" in Class 25 and all of its goods recited separately in Class 3. Petitioners have also claimed a priority filing date with regard to these goods. Petitioners' counsel argues that the language at page 63 in the "Examination Guide 3-89", issued on October 11, 1989 as a supplement to the Trademark Manual of Examining Procedure (TMEP), can be interpreted as supporting counsel's understanding that filing under two bases is permitted. This language reads as follows:

> Applicants may allege Section 44 as an additional basis for registration in conjunction with either use in commerce under Section 1(a) or intent to use under Section 1(b). In such a case, an applicant may also allege different bases for the application as to specific goods or services within a class.... (emphasis added)

The operative phrases here are "either use in commerce under Section 1(a)" and "or intent to use under Section 1(b)" with which Section 44 can be alleged as an additional basis, and the word "such." The either/or usage clearly sets up the mutually exclusive categories of "use" and "intent to use" as bases for filing. The cases which fall into the "such" category are instances where Section 44 has been alleged in addition to use in commerce under Section 1(a) or where Section 44 has been alleged in addition to an intent to use under Section 1(b). In any case, this clarification with regard to the allegation of dual bases must be read and understood in the context of the absolute prohibition against the use of Sections 1(a) and 1(b) as combined bases in the same application. This is clearly elucidated in Trademark Rule 2.33(d). It is further explained in the Examination Guide 3-89, supra, in a paragraph that immediately precedes the passage

quoted above and relied upon by petitioners' counsel. In fact, the paragraph explaining this prohibition ends thus:

> If an applicant submits an application asserting both Section 1(a) and 1(b) bases for registration, the Office will not grant a filing date and will return the papers to the applicant (emphasis added)

Trademark Rule 2.146(a)(3) permits the Commissioner to invoke supervisory authority in appropriate circumstances. However, the Commissioner will reverse the action of the Supervisor of the Trademark Application Section in a case such as this only where there has been a clear error or abuse of discretion. In re Richards-Wilcox Manufacturing Co., 181 USPQ 735 (Comm'r Pats.1974); Ex parte Peerless Confection Company, 142 USPQ 278 (Comm'r Pats.1964).

***4** Trademark Rule 2.33(d) unambiguously states that an applicant may not assert both Section 1(a) and Section 1(b) as bases for filing in a single application. Further, the Examination Guide 3-89, supra, referred to by petitioners' counsel fully explains the consequences of such a filing. Since petitioners filed their application asserting both Sections 1(a) and 1(b) as bases in the same application, the refusal to grant a filing date for the application was proper.

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. In this instance, petitioners' counsel claims that denial of the filing date would deny petitioners of their priority filing date under Section 44(d). Counsel further claims that this was the first time that a multiple bases filing was prepared by counsel and that the equity of the situation requires the granting of the filing date.

Although the Commissioner sympathizes with the petitioners, the situation described herein does not justify the waiver of Rule 2.33(d). Oversights that could have been prevented by the exercise of ordinary care or diligence, by the party or the attorney are not extraordinary situations as contemplated by the Trademark Rules. See In re Bird and Sons, Inc., 195 USPQ 586 (Comm'r Pats.1977). Further, the Trademark Office publicized the changes in the Trademark Rules of Practice well before the implementation of the 1988 amendments in order to apprise the trademark community of these changes. Theprivate bar as well as the general public were put on notice that there were significant changes and that these changes would be effective as of November 16, 1989.

Accordingly, the petition is denied. The application papers will be returned to the petitioners along with the uncashed check to cover the filing fee.

FN1. The filing date is the issue on petition.

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