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

RE: TRADEMARK APPLICATION OF INVESTIGACION Y DESARROLLO DE COSMETICOS, S.A.
Serial No. 74/049,037 [FN1]
March 26, 1991
***1** Petition Filed: August 28, 1990

For: SELVERT and design
Filing Date: April 16, 1990 [FN2]

Attorney for petitioner

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Jeffrey M. Samuels

Assistant Commissioner for Trademarks

On Petition

Investigacion Y Desarrollo de Cosmeticos, S.A. has petitioned the Commissioner to grant the subject application a filing date of April 16, 1990 or, in the alternative, accord the priority claim based on the International Convention. The Commissioner has authority to review this matter under Trademark Rules 2.146 and 2.148.

On April 16, 1990, petitioner filed an application to register its mark pursuant to Section 44(d) of the Trademark Act based on an application filed in Spain on December 4, 1989. The actual application papers, which were resubmitted with the petition, show the PTO Mail Room date stamp of April 16, 1990 stamped "cancelled." Petitioner has provided a declaration pursuant to 37 C.F.R. § 2.20, in which an employee of petitioner's counsel declares that he received an Office action dated June 4, 1990, returning the papers and indicating that the filing date was cancelled because the application did not include a statement that applicant has a "bona fide intention to use the mark in commerce." [FN3] During a telephone conversation with an employee of the Trademark Office, declarant states that he was assured that the applicant would not lose the foreign priority date if petitioner filed a new trademark application claiming "bona fide intention to use the mark in commerce" plus a certified copy of the foreign registration.

Petitioner filed another application on June 18, 1990 which included the required statement of bona fide intention to use the mark in commerce. This second application was rejected in a Notice of Incomplete Trademark Application mailed on August 15, 1990 because it was filed more than six months after the filing of the foreign application. This petition followed.

In the petition, counsel for petitioner states that the first application was mailed on April 11, 1990, and that counsel "filed with

the mail room of the United States [Patent and Trademark] Office on April 13, 1990 personally a preliminary amendment relating to this application and specifically amending the application by claiming that the applicant has a bona fide intention to use the mark in commerce on/or in connection with the goods/services recited previously in this application." [FN4] As noted above, the papers were returned as incomplete, leading counsel's employee to contact the PTO and subsequently file another application containing the statement of bona fide intention to use the mark in commerce. That application was also rejected because it was filed beyond the statutory period for filing an application pursuant to Section 44(d). Counsel submits that the requirement set forth in the Notice of Incomplete Trademark Application of June 4, 1990 was, in fact, met at the time the initial application papers were received on April 16, 1990. Petitioner maintains that it would be inequitable to require petitioner to wait to file when the foreign registration has issued.

***2** Trademark Rule 2.146(a)(3) permits the Commissioner to invoke his supervisory authority in appropriate circumstances. However, the Commissioner will reverse the action of an Supervisor of the 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 Co., 142 USPQ 278 (Comm'r Pats. 1964).

Effective November 16, 1989, all applications filed pursuant to Section 44(d) of the Trademark Act are required to include a statement that the applicant has a bona fide intention to use the mark in commerce. The statute also requires an application pursuant to Section 44(d) to be filed within six months from the date on which the application was first filed in the foreign country. Further, Section 1 of the Act requires the application to be "verified by the applicant."

Trademark Rule 2.21 sets forth the requirements for receiving a filing date. Rule 2.21(a)(5) sets out the four bases for filing a application, one of which is (iii) "[a] claim of a bona fide intention to use the mark in commerce and a claim of the benefit of a prior foreign application in an application filed in accordance with section 44(d) of the Act." Rule 2.21(a)(6) requires an application to include "[a] verification or declaration in accordance with § 2.33(b) signed by the applicant." Contingent on registration of the mark, the filing of an application for the Principal Register now establishes a constructive date of first use, therefore, the application must be signed by the applicant in order to receive a filing date.

The claim of bona fide intention to use the mark in commerce is an averment which must be supported by an affidavit or declaration in accordance with Trademark Rule 2.20 and, must be executed by the applicant because only the applicant can know if it has a bona fide intention to use the mark in commerce. Petitioner's reliance on a verbal assurance that it would not lose the foreign priority date was inappropriate. An application pursuant to Section 44(d) must be filed before the expiration of the six month period following application in the foreign country and must fulfill the requirements for receiving a filing date under Trademark Rule 2.21 at that time. Further, Rule 1.2 provides that no attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is

disagreement or doubt.

In this case, the "Preliminary Amendment" filed in connection with this application was neither executed by an officer of the corporate applicant, nor submitted in affidavit or declaration format. Therefore, the Supervisor of the Trademark Application Section acted properly by refusing to incorporate the unverified statement of petitioner's counsel for the purpose of granting a filing date.

Furthermore, the second application, although conforming with the requirement to claim a bona fide intention to use the mark in commerce, was submitted after the expiration of the statutory six month period and, therefore, was properly refused a filing date.

***3** Trademark Rules 2.146(a)(5) and 2.148 permit the Commissioner to waive any requirement of the rules, not being a requirement of the statute, in an extraordinary circumstance, when justice requires and no other party is injured. However, the requirement for a foreign applicant to verify its bona fide intention to use the mark in commerce is statutory and the Commissioner has no authority to waive it. In re Kruysman, Inc., 199 USPQ 110 (Comm'r Pats. 1977); Ex parte Buchicchio, 118 USPQ 40 (Comm'r Pats. 1958); Ex parte Radio Corporation of America, 114 USPQ 403 (Comm'r Pats. 1957).

The petition is denied. The application papers and supporting documents will be returned to petitioner.

FN1. Petitioner filed another application for this mark for identical goods on June 18, 1990 which was serialized 74/069,922.

FN2. The filing date is the issue on petition.

FN3. Petitioner has not provided a copy of the Notice of Incomplete Trademark Application with the petition.

FN4. Counsel has provided a copy of the preliminary amendment complete with a photocopy of a post card showing receipt in the PTO on April 13, 1990.

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