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

RE: TRADEMARK REGISTRATION OF MAYTAG CORPORATION
Registration No. 514,790
March 7, 1991
***1** Petition filed: May 9, 1990

For: NORGE (stylized)
Renewal granted: December 26, 1989
Issued: September 6, 1949

Counsel for Petitioner

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Assistant Commissioner for Trademarks

On Petition

Maytag Corporation has petitioned the Commissioner to amend the renewal certificate issued February 6, 1990 to accord the referenced registration a renewal term of 20 years, rather than the ten years that was granted. Review of the petition is undertaken pursuant to Trademark Rules 2.146 and 2.148, 37 C.F.R. § § 2.146 and 2.148.

FACTS

Petitioner's application for a second renewal of the subject registration, filed pursuant to Section 9 of the Trademark Act, 15 U.S.C. § 1059, was received by the Office on April 27, 1989. On June 8, 1989, the Affidavit/Renewal Examiner issued an Office action noting that acceptance of the renewal application was being withheld because Office records indicated title to the registration to be vested in a party other than petitioner.

Petitioner was instructed as follows: "Evidence of ownership in the present claimant should be recorded in the Assignment Branch. Such evidence must show title to be vested in the present claimant as of a date at least as early as April 21, 1989, the date of execution of the [renewal] application." Petitioner was also instructed to notify the examiner when the evidence had been filed for recording, and was required to respond to the Office action within six months to avoid having the renewal application be deemed abandoned.

On November 14, 1989, petitioner filed a response to the Office action. The response noted that a certificate of merger substantiating

petitioner's claim of ownership of the subject registration had been recorded in the Assignment Branch on April 17, 1989. On December 26, 1989, the Affidavit/Renewal Examiner approved the renewal application, and on January 2, 1990 an action was mailed noting the grant of renewal. A renewal certificate noting both the date of approval of the renewal application and the grant of a ten year term of renewal was issued on February 6, 1990. This petition followed.

DECISION

1. Renewal Applications and the Trademark Law Revision Act

The Trademark Law Revision Act of 1988, implemented on November 16, 1989, amended Section 9 of the Trademark Act by reducing the term of any registration renewed on or after the effective date of the act from 20 years to 10 years. [FN1] The Rules of Practice in Trademark Cases, which were amended to accord with changes in the Trademark Act, specifically address the issue of renewal terms for registrations issued before, on, and after the effective date of the revision act.

Trademark Rule 2.181, 37 C.F.R. § 2.181, covers the "[t]erm of original registrations and renewals," and provides:

***2** "(a)(1) Registrations issued or renewed under the Act, prior to November 16, 1989 ... remain in force for twenty years from their date of issue or expiration....

(2) Registrations issued or renewed under the Act on or after November 16, 1989 ... remain in force for ten years from their date of issue or expiration...."

The provisions in Rule 2.181 clearly were drafted to provide for the transition from practice under the formerly effective provisions of the Lanham Act to practice under the revised act. This rule was promulgated only after considerable discussion within the Office and following receipt of comments from interested members of the public. In addition, the Office published various notices and announcements to inform trademark owners, the members of the trademark bar, and interested members of the public at large, as to Office policy regarding the processing of renewal applications during the transition to practice under the revised statute and rules.

The initial notice was published in the Official Gazette in early May, 1989. This notice announced: "Any registration that is renewed by the Patent and Trademark Office (PTO) before Nov. 16, 1989, shall be renewed for a period of twenty years from the end of the expiring period.... [A]ny registration that is renewed by the PTO onor after Nov. 16, 1989, shall be renewed for a period of ten years from the end of the expiring period...." 1102 TMOG 5 (May 2, 1989).

Thereafter, a notice of proposed rulemaking was published in the Federal Register on May 4, 1989, at 54 FR 19286, in the Official Gazette on May 16, 1989, at 1102 TMOG 47-70, and in the Bureau of National Affairs' Patent, Trademark & Copyright Journal on May 11, 1989, at 38 PTCJ 43-71. This notice invited interested members of the public to submit comments on proposed revisions to the Trademark Rules, including the revision to Rule 2.181, the essence of which had been covered in the May 2, 1989 O.G. notice on renewal applications.

A number of respondents (four organizations and two individuals), either in written comments or in oral testimony provided at a public hearing, suggested that the proposed Rule 2.181 was ambiguous. They asserted that the rule as proposed to be amended was ambiguous because "renewal" of a registration, as used in the rule, could be read to occur on (a) the twentieth anniversary of a registration's issuance, or (b) when a proper renewal application is filed, or (c) when the renewal application is processed and a renewal certificate is issued. As a result, these respondents proposed that the rule be amended to provide that the anniversary date of the original registration control the length of the renewal term. Thus, under this view, any registration with an expiration date prior to November 16, 1989, would receive a 20-year renewal term so long as a proper renewal application were filed and accepted, regardless of the timing of either the filing or acceptance.

***3** The Office published a summary of all comments generated by the notice of proposed rulemaking in the Federal Register on September 11, 1989, at 54 FR 37562, and in the Official Gazette on October 3, 1989, at 1107 TMOG 7. The publication of these comments was accompanied by the Office's response, which noted: "The PTO believes that the date of the grant of the renewal application controls whether the term of renewal of a registration is 20 years or ten years. Accordingly, the recommendation that [Rule 2.181] be modified ... has not been adopted." The published response went on to note, however, that "the PTO will do everything possible to maximize the chance that the renewal [for those registrations expiring prior to November 16, 1989] will be granted prior to November 16, 1989, so that the term of renewal will be twenty years."

The day after these comments and the PTO's response were published in the Federal Register, a second notice on renewal applications was published in the Official Gazette. 1106 TMOG 25 (September 12, 1989). This notice was denominated as a revision of the earlier notice published in May, 1989, and was designed to remedy the ambiguity from which it allegedly suffered. The September 12 notice made it clear that the date on which the Office accepted a renewal application would determine whether a particular registration was granted a renewal term of 10 years or 20 years; the notice clearly indicated that the length of the renewal term would not be determined by either the ending date of the expiring period or the filing date of the renewal application.

2. The Petition is Denied on the Merits

(A) Petitioner's Arguments

The essence of petitioner's argument is as follows: (1) The Congress intended renewals "effective before November 16, 1989" to run for 20 years and intended those "effective on or after November 16, 1989" to run for 10 years. (2) The "effective date" of petitioner's second renewal must be September 6, 1989, "which is the last day of the previous term." (3) The Trademark Law Revision Act did not go into effect until November 16, 1989, which postdates the "effective date" of

petitioner's second renewal. (4) The 10 year renewal term for petitioner's second renewal therefore is the result of ex post facto application of the Trademark Law Revision Act, contrary to the intent of Congress.

Petitioner's approach is not necessarily unfounded. As noted in the preceding discussion of the process through which the Trademark Rules were revised, other organizations and individuals argued in support of a policy which would treat the expiration date of a term of registration as the "effective date" of a renewal, for the purpose of determining whether a renewal term would run 20 years or 10 years. In any event, petitioner's whole argument rests on the contention that the "effective date" of petitioner's second renewal is the last day of its expiring term. The Office, however, does not take such an approach. Rather, the Office takes the approach that the "effective date" of a renewal is the date the renewal application is accepted by the Office. The ending date of a registration's expiring term simply marks the date from which any renewal term will run, for the purpose of calculating when the renewal term will end.

(B) Office Practice and Statutory Authority

***4** When the Office issues a registration or approves an application for renewal, the Office has taken an action which is relative to "status." [FN2] Thus, the status change from "pending application" to "registration" results when a registration issues; and the status change from "registered" to "renewed" results when an application for renewal is accepted. The calculation of registration terms and renewal terms are distinct matters which need not necessarily be tied to the status changes which yield the "effective dates" of registrations and renewals.

Since the Office's approach to renewals of registrations is to consider a registration to be "renewed" only upon approval of the application for renewal, the term of renewal that can be granted to the renewed registration is dictated by the statutory authority bestowed by Congress upon the Office at the time of renewal. Therefore, for any registration due to expire prior to November 16, 1989, if the Office approved an application for renewal prior to that date, then the Office had the authority to grant a renewal term of 20 years; on the other hand, if the Office approved the application for renewal after that date, then the Office no longer was possessed of the authority to grant a renewal term of 20 years.

(C) No Basis for Relief Has Been Established

Petitioner has failed to assert any basis for its petition. Before it can be determined whether there is any basis upon which petitioner can be granted the "relief" it requests, a determination must be made as to whether there is any basis for the petition.

Trademark Rule 2.146(a)(3), 37 C.F.R. § 2.146(a)(3) permits the Commissioner to invoke his supervisory authority in appropriate

circumstances. In this case, petitioner has not asserted that any particular employee of the Office erred in either the handling of petitioner's renewal application or in the processing and issuance of a renewal certificate with a 10-year term of renewal. Even if such an assertion had been advanced as the basis for the petition, the petition would have to be denied since no employee of the Office has been shown to have abused discretion, acted in error, or otherwise accorded petitioner's renewal application inequitable processing.

Trademark Rules 2.146(a)(5) and 2.148, 37 C.F.R. § § 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. The provisions of Trademark Rule 2.181(a) govern the circumstances surrounding petitioner's renewal application, and dictate that petitioner is entitled to only a 10-year renewal term. Petitioner, however, has not specifically requested waiver of the application of this rule. Even if waiver of the rule had been requested, waiver would have to be denied. As noted above in the discussion of the Office's statutory authority relevant to renewals, since petitioner's renewal application was not approved until after November 16, 1989, the Office was without statutory authority to grant petitioner a 10-year renewal term. In this case, Rule 2.181(a) could not be waived because it embodies the requirements of the statute.

***5** The only other possible basis for the instant petition is Trademark Rule 2.146(a)(4), 37 C.F.R. § 2.146(a)(4), which provides the Commissioner with authority to consider a petition "in any case not specifically defined and provided for by this Part of Title 37 of the Code of Federal Regulations." Again, petitioner has not asserted this as the basis for its petition and even had it done so, the petition would have to be denied. For petitioner to avail itself of this provision, it would have to be shown that equity demanded granting petition relief. In this case, there has been no such showing.

Less than two weeks before its renewal application was filed, petitioner had filed a request with the Assignment Branch for recording of the document of merger, a document which was later pointed to as substantiation of petitioner's claim of ownership of the subject registration. Nonetheless, petitioner did not mention this fact either in the renewal application or in the accompanying transmittal letter.

Perhaps petitioner assumed that recording would be completed quickly enough that a clear chain of title to petitioner would be present in Office records by the time the Affidavit/Renewal Examiner considered the renewal application; indeed, this very well may have occurred. However, a review of the contents of the registration file indicates that a title report had been entered in the file as of March 22, 1989, which revealed title to the registration in petitioner's assignor. Since the renewal application was filed approximately a month later, the Affidavit/Renewal Examiner may have presumed it unlikely that an assignment had been filed for recording in the intervening period. In any case, there is no evidence in the file that the Affidavit/Renewal Examiner asked for a title report from the Assignment Branch subsequent to the filing of the renewal application.

Petitioner may argue that the examiner should have sought such a report. Even if this point is conceded, there is no evidence of record to indicate that such a report would have revealed title in petitioner. [FN3] Further, even if it is assumed that a title report, if requested, would have revealed title to be in petitioner, it is clear that petitioner could have increased the likelihood that such a report would have been requested by simply noting, when it filed the renewal application, that documents had recently been submitted for recording.

Finally, note that the Affidavit/Renewal Examiner's Office action withholding acceptance of the renewal application issued on June 8, 1989. By that time, or shortly thereafter, the Assignment Branch had likely returned to petitioner the documents it had submitted for recording, stamped with the Reel and Frame numbers of the microfilm containing a copy of the document. Even if recording and return of the documents is assumed to have taken three times as long as average (i.e., 90 days or so), petitioner would have known of the recording as of mid-July, 1989. Had the Affidavit/Renewal Examiner's Office action been respondedto in July, or even in August or September, the examiner could have approved petitioner's renewal application well before November 16, 1989, thus ensuring a 20-year renewal term for the registration.

***6** While petitioner's response to the Office action was timely, it can scarcely be held to have been so prompt as to support a claim for extraordinary equitable relief. Further, notices published in the Official Gazette in September and October of 1989 clearly noted that renewal applications approved after November 16, 1989 would yield only 10-year renewal terms. Given publication of these notices, petitioner's decision to wait until November 14, 1989 to file its response to the Affidavit/Renewal Examiner's Office action provides nothing in the way of compelling support for its request for extraordinary equitable relief.

3. The Petition is Denied as Untimely

Under Trademark Rule 2.146(d), 37 C.F.R. § 2.146(d), "a petition on any matter not otherwise specifically provided for shall be filed within sixty days from the date of mailing of the action from which relief is requested." In this case, the renewal certificate noting both the date of approval of the renewal application and the fact that term of renewal was to run ten years had the seal of the Commissioner affixed on February 6, 1990.

The date on which the seal of the Commissioner is affixed to a renewal certificate for a registration is also the date on which notice of the registration's renewal is published in the Official Gazette. Regular Office practice calls for the mailing of the renewal certificate on the date of publication, or within the few days immediately following publication.

Although the Affidavit-Renewal Examiner had issued an action on January 2, 1990 indicating that the application for renewal had been approved, this action did not specifically note either the date of approval or the renewal term. Thus, petitioner may not have been aware

of these facts until the renewal certificate itself issued on February 6, 1990, or within days of that date. Therefore, the issuance of the renewal certificate is the action from which petitioner seeks relief, and it is the date of this certificate from which the timeliness of the instant petition must be measured.

The petition was filed approximately 90 days after the date of the renewal certificate. As noted, the general rule is that a petition must be filed within 60 days of the mailing date of the action from which relief is requested. Assuming that regular Office procedures were followed in issuing the renewal certificate, the instant petition must be considered untimely. It must be presumed that regular Office procedures were followed, unless petitioner establishes otherwise with an appropriate offer of proof. Petitioner has not set forth any facts or circumstances which would support waiver of the 60-day standard set forth in Rule 2.146(d). Accordingly, apart from being denied on the merits, the petition is denied as untimely.

CONCLUSION

The petition fails to set forth any basis upon which relief can be granted and is therefore denied on the merits. Further, the petition is denied as untimely. In its petition, petitioner noted, "if this petition is denied, then registrant respectfully requests a complete statement of the legal position of the U.S. Patent and Trademark Office in this regard." This decision should suffice as a response to this request.

FN1. In addition, Section 8 of the Trademark Act, 15 U.S.C. § 1058, was amended to reduce the terms for original registrations from 20 years to 10 years.

FN2. In this context, the word "status" is used in a conceptual sense and not in the technical sense that would apply if the discussion involved the Office's automated records. In those records, changes in the "status" of an application or registration yield very particular results.In the context of this discussion the status changes discussed are discussed in a conceptual sense and not as if they constitute the technical changes that would be recorded in Office records.

FN3. Though the "date of recording" of the certificate of merger is April 17, that is not the date of actual recording. It is simply Office practice to list the mail room receipt date of any document submitted for recording as the "date of recording," even though actual recording, on average, will not occur until a month or so later. Thus, any request for a title report that would have been transmitted to the Assignment Branch prior to late May likely would not have revealed the recording of the document of merger.

21 U.S.P.Q.2d 1615

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