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

RE: TRADEMARK APPLICATION OF B.E.L.-TRONICS LIMITED
Serial No. 74-005,430 [FN1]
February 15, 1991
***1** Petition Filed: March 12, 1990

For: LEGEND
Filed: November 27, 1989 [FN2]

Counsel for Petitioner

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On Petition

B.E.L.-Tronics Limited has petitioned the Commissioner for an order granting a filing date to the application it submitted on November 27, 1989 to register the mark LEGEND for "radar detectors" in international class 9. The application was rejected by the Supervisor of the Application Section. Review of this petition is undertaken pursuant to Trademark Rules 2.146(a)(3), 37 C.F.R. § § 2.146(a)(3).

FACTS

The relevant passages of petitioner's application include the following:

--The application notes that petitioner "has adopted and intends to use" the mark shown in the application's accompanying drawing for class 9 radar detectors.

--The application asserts petitioner's intent to use the mark in Canada, petitioner's home country, and also asserts: "The trademark is intended to be used in Foreign Commerce from Canada into the United States in respect of the class named above."

--Next, the application recites: "This application is based on Canadian Application No. 638,407 filed August 11, 1989 and a certified copy of the registration to issue from that application will be filed in due course."

--Finally, the application recites the intended method of use of the mark and notes that five specimens "showing the mark as actually used will be submitted in due course."

While petitioner's application was "accepted" by the Mail Room and accorded a serial number, upon further review by personnel in the Application Section the application was found deficient. The serial number was declared "misassigned" and an action issued by the

Supervisor of the Application Section on December 28, 1989 noted for petitioner that its application was deficient because it failed to include a statement of petitioner's bona fide intention to use its mark in commerce. [FN3] This petition followed.

DECISION

1. The Application Section's Review

Trademark Rule 2.146(a)(3) permits the Commissioner to invoke supervisory authority in appropriate circumstances. This authority will not be invoked, however, unless an action taken by an Office employee is determined to have been taken in error.

Neither the application nor its transmittal letter sets forth, through explicit reference to the Trademark Act, the basis or bases upon which the application was submitted. The Rules of Practice require each application to establish a basis for filing to receive a filing date. Trademark Rule 2.21(a)(5), 37 C.F.R. § 2.21(a)(5). While the Rules do not require specific references to provisions of the Trademark Act to establish the basis or bases of an application, an applicant's failure to provide such a reference can result in a determination that no acceptable basis has been set forth. In re Trademark Application of Choay S.A., 16 U.S.P.Q.2d 1461 (Comm'r Pats.1990) (clear language in an application which was consistent only with an application filed pursuant to Section 44(e) insufficient to establish basis for filing pursuant to Section 44(d), notwithstanding submission of the U.S. application within 6 months of the filing of petitioner's foreign application).

***2** In this case, petitioner's failure to make clear reference to specific provision(s) of the Trademark Act pursuant to which its application was submitted required the Application Section to determine the probable basis for filing. The only language in the application which suggests a basis for filing is that paragraph, quoted above in full, which begins, "This application is based on Canadian Application No. 638,407 filed...." Accordingly, the Application Section construed the application as one filed pursuant to Section 44(d) of the Trademark Act, 15 U.S.C. § 1126(d).

2. Establishing a Basis for Filing

To establish a basis for filing in accordance with Trademark Act Section 44(d), the applicant must include in its application a "claim of a bona fide intention to use the mark in commerce and a claim of a benefit of a prior foreign application" (emphasis added). Trademark Rule 2.21(a)(5)(iii), 37 C.F.R. § 2.21(a)(5)(iii). Clearly, this provision of the Rules requires an application filed pursuant to Section 44(d) to set forth two distinct "claims."

While petitioner did not literally "claim" the benefit of a prior foreign application, its application contains language sufficient to meet this requirement. Established Office practice allows an applicant

filing under Section 44(d) to meet the requirement by including in its application a "statement" of priority. Thus, when an application filed with the Office includes language indicating that another application has been filed indicates that filing in the U.S. was effected within 6 months of the prior foreign filing, then this will be accepted as a "statement" of priority. Trademark Manual of Examining Procedure (TMEP) Section 1003.02.

Since petitioner's application meets the second of the two requirements set forth in Rule 2.21(a)(5)(iii), the only remaining question is whether the application included a "claim of a bona fide intention to use the mark in commerce." Again, though the Rules require a "claim" to be set forth, actual Office practice is not so strict as to require precise, literal compliance with this requirement for Section 44(d) applications. Indeed, Section 44(d) itself only requires inclusion of "a statement that the applicant has a bona fide intention to use the mark in commerce."

Regardless of whether it is framed as a "claim" or a "statement," the language employed in an application to indicate the applicant's "bona fide intention to use the mark in commerce" must meet two criteria. First, the intention to use the mark must be a "bona fide" or "good faith" intention to use. Second, the intention to use the mark must be an intention to use the mark "in commerce."

The language of petitioner's application clearly indicates an intention to use the mark "in commerce," specifically in commerce between the United States and Canada. However, it is equally clear that petitioner has nowhere asserted that its stated intention to use the mark is "bona fide" or in "good faith."

***3** Counsel for petitioner nonetheless argues "it is clear from the context of the application that there is indeed a bona fide intent to use the trade mark in the United States of America." Counsel notes that the vice president of the petitioner signed the application and declaration "all clearly acknowledging the serious intent to use the trade mark in the United States of America." Finally, counsel poses the question, "Why, otherwise, would the applicant undertake the costs and expenses of instructing the undersigned and paying the application fees to the United States of America if it did not have a bona fide intent to use the trade mark?"

Whether it is likely that the petitioner would expend time and money in an effort to secure a U.S. registration for its mark absent a "serious intent" to use the trade mark in the U.S. is not a question that need be answered here. It is clear that any application filed pursuant to Section 44(d) must include a "claim" or "statement" of the applicant's "bona fide" or "good faith" intention to use a mark "in commerce." [FN4] The requirement that Section 44(d) applications include a statement of "bona fide" intention to use the mark in commerce" is analogous to the requirement that applications filed under Section 1(b), 15 U.S.C. § 1051(b), specify "applicant's bona fide intention to use the mark in commerce."

Section 1(b) specifies that an applicant may file an application based on a bona fide intention to use a mark in commerce "... under circumstances showing the good faith" of the applicant. Office policy

on the ex parte examination of applications precludes an evaluation of, or inquiry into, the good faith of the applicant. Trademark Examining Operation (TMEO) Examination Guide 3-89, issued as a supplement to the TMEP, revision 7, at page 10, 1108 TMOG 30, 33. Rather, Office policy considers "applicant's sworn statement of a bona fide intention to use the mark in commerce" as "sufficient evidence of good faith."

As with statements of a "bona fide" or "good faith" intention to use a mark that are included in Section 1(b) applications, trademark Examining Attorneys will not evaluate such statements that are included in Section 44 applications. Therefore, it is incumbent upon such applicants to include in their applications a "sworn statement" of the applicant's "bona fide" or "good faith" intention to use a mark in commerce.

These standards were further clarified in TMEO Examination Guide 1-90. In Section A(1) of Exam Guide 1-90, at page 1, in regard to Section 1(b) applications it is noted: "The applicant may use the words 'good faith' instead of 'bona fide.' " Also, in Section C(1), at page 9, in regard to the filing date requirements for Section 44 applications it is noted: "The policies concerning the form and the placement of the statement in the written application set forth with respect to intent-to-use applications apply equally to applications under Section 44."

***4** In sum, petitioner did not include in its application a written "claim" or "statement" establishing its "bona fide" or "good faith" intention to use its mark in commerce, and the Office will not infer "circumstances showing the good faith" of the applicant when an application is lacking such a statement. Since the petitioner failed to include such a statement, its application pursuant to Section 44(d) cannot be accorded a filing date for failure to comply with Rule 2.21(a)(5)(iii).

3. The Petition is Untimely

Trademark Rule 2.146(d), 37 C.F.R. § 2.146(d), provides that a petition to the Commissioner must be filed within sixty days of the mailing date of the Office action from which the relief is requested. The action of the Supervisor of the Application Section was mailed December 28, 1989. This petition to the Commissioner was not filed until March 12, 1990.

CONCLUSION

The petition is denied. Also denied is petitioner's request that its petition fee be refunded. Since the Application Section did not err in refusing to accord petitioner's application a filing date, filing of the petition was not necessitated by Office error. The application papers are hereby returned to petitioner.

FN1. This serial number has been declared misassigned and will not be reassigned to this application.

FN2. The filing date is an issue in this petition.

FN3. The action also noted that the application was being rejected based on petitioner's failure to include priority filing information in the heading of the drawing sheet. Based on subsequent clarification of Office policy, this omission would not stand as sufficient grounds for refusing to accept the application. However, the resolution of this petition renders this issue superfluous.

FN4. This requirement applies equally to applications filed pursuant to Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e). That provision of the statute allows the owner of a foreign registration for a mark to rely on that registration as both a basis for filing an application in the U.S. and a basis for obtaining a U.S. registration. Applicants whose basis for filing is provided for by Section 44(d) most often rely on the basis for registration that is provided for by Section 44(e).

24 U.S.P.Q.2d 1397

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