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

IN RE: FORTEX INDUSTRIES, INC.
U.S. Registration No. 1,525,715
December 3, 1990

By: Jeffrey M. Samuels

Assistant Commissioner

Decision on Petition

***1** Fortex Industries, Inc. (Fortex) has petitioned the Commissioner pursuant to 37 CFR § § 2.146 and 2.148 to suspend the rules to amend its Certificate of Registration to include additional goods to conform to a court order entered by the United States District Court for the Eastern District of New York.

Background

On September 29, 1975, Fortiflex, Inc. (predecessor in interest to petitioner) filed a trademark application seeking to register its trademark FORTIFLEX and Design for "rubber and plastic pails, buckets and tubs"D' in International Class 21. The application was published for opposition on July 26, 1977. An opposition was filed by Soltex Polymer Corporation (Soltex) which owned a trademark for FORTIFLEX for plastic resins. Opposition proceedings were instituted on May 8, 1978, before the Trademark Trial and Appeal Board (TTAB). The opposition proceeded to the point of setting a date for oral argument before the TTAB.

In March 1981, opposer Soltex filed a civil action for infringement in the United States District Court for the Eastern District of New York (District Court) against applicant and others. On November 16, 1981, applicant requested the TTAB to suspend all proceedings pending the outcome of the civil action. The TTAB suspended proceedings on December 22, 1981.

The District Court entered a decision and written opinion on September 23, 1986, finding little likelihood of confusion would result from applicant's use of FORTIFLEX on its animal feeder line due to the different markets for animal feeders and plastic resins. (Exhibit A to Petition at unnumbered pages 52-53 [FN1]). However, because there was a market overlap for industrial containers, applicant was permitted to continue to use FORTIFLEX provided it used a disclaimer disclaiming association with opposer. (Exhibit A at 55).

On January 22, 1987, the District Court further entered a Final Judgment Order which provides in pertinent part:

6. Defendant, Fortiflex, Inc. shall have the right to register on the Principal Register of the United States Patent and Trademark Office, the trademark FORTIFLEX and stylized logo as applied to its

animal feeder line and its industrial container line of products; the Commissioner of Patents is hereby ordered to dismiss Opposition No. 60,860 to defendant Fortiflex, Inc.'s application for registration of the trademark FORTIFLEX and logo application serial number 64,300, and to grant the defendant, Fortiflex, Inc. registration on the Principal Register of the trademark FORTIFLEX and logo as appears in said application for buckets, pails, tubs, animal feeders and industrial containers made from a blend of rubber and plastic, and the plaintiff is ordered to take no further or additional action before the United States Patent Trademark Office respecting said defendant's right to said registration inconsistent with the Court's findings of fact and conclusions of law in this action.

***2** The decision of the District Court was affirmed on appeal on November 3, 1987. See Soltex Polymer Corporation v. Fortex Industries, Inc., 832 F.2d 1325, 4 U.S.P.Q.2d 1785 (2d Cir.1987).

On May 20, 1988, applicant filed with the TTAB a motion to dismiss the opposition and register its trademark FORTIFLEX and design pursuant to the District Court Order. The motion to dismiss was granted and the opposition was dismissed with prejudice on July 20, 1988. The registration, identifying the goods as filed, issued on the Principal Register on February 21, 1989, as U.S. Reg. No. 1,525,715.

Upon receipt of the registration, petitioner Fortex noted that the identification of goods was as originally filed in the application and had not been amended to the list of goods indicated by the District Court. On August 2, 1989, petitioner filed a "Petition for Correction"D' requesting the description of goods be changed pursuant to section 7 of the Act, 15 U.S.C. § 1057 [FN2] .

On October 19, 1989, petitioner was notified by the Patent and Trademark Office (PTO) that the registration could not be amended because the new identification of goods exceeded the scope of the goods identified in the original application and a reexamination of the file would be required. (Exhibit F). The PTO's decision was based on Section 7 of the Trademark Act which prohibits amendments to a registration when the character of the mark is materially altered. [FN3] It is from this decision that petitioner has filed this petition to the Commissioner.

Differences between the goods recited in the registration and the goods ordered to be registered by the District Court

The application was processed for registration as ordered by the District Court. However, the description of the goods in the application is different from the description of the goods set out in the District Court's Order. The application as filed sought registration for "rubber and plastic pails, buckets and tubs"D' in International Class 21. The District Court Order describes the goods as "buckets, pails, tubs, animal feeders and industrial containers made from a blend of rubber and plastic."DD'

Petitioner requests that the identification of goods set forth in its

application, and now the registration, be corrected to conform with the goods set forth in the District Court Order.

The identification of goods as set out in the District Court's Order differs from the application in two material respects:

(1) "Animal feeders,"D' not identified as goods in the application, are sought to be added to the registration; and

(2) "Industrial containers,"D'also not identified as goods in the application, are sought to be added to the registration and they fall into a different international class, i.e., International Class 20.

The Requested Change

As stated above, the changed descriptionof goods adds new items, animal feeders and industrial containers. Also, designating the plastic goods as "'industrial containers"D', results in these goods being classified in International Class 20. Section 30 of the Act, 15 U.S.C. § 1112, provides that the Commissioner may establish a classification of goods and services:

***3** The applicant may apply to register a mark for any or all of the goods or services on or in connection with which he or she is using or has a bona fide intent to use the mark in commerce: Provided, That if the Commissioner by regulation permits the filing of an application for the registration of a mark for goods or services which fall within a plurality of classes, a fee equaling the sum of the fees for filing an application in each class shall be paid, . . .

Because the new identification of goods adds a class to the application, all of the statutory requirements governing applications, which have not been complied with in relation to the new class, should now be complied with [FN4]. These requirements include: providing specimens of the mark as used on those goods, [FN5] paying the filing fee for the new class, [FN6] conducting a search for the added goods and class, [FN7] and publishing the mark in the new class for opposition. [FN8] To circumvent these statutorily-mandated administrative procedures would affect the rights of others who were not parties to the case before the District Court.

Argument

Petitioner contends:

1. The PTO was notified that the District Court had ordered registration with an amended identification of goods;

2. The TTAB could have remanded the application to the examining division if necessary; and

3. The Commissioner should exercise his discretion because if he fails to do so petitioner "would be deprived of its court won right to register and use its mark on the goods provided . . . ."D' (Petition at 7).

Trademark Rules 2.71-2.75, 37 CFR § § 2.71-2.75, govern amendments

to applications during ex parte examination, and Rule 2.133, 37 CFR § 2.133, governs the amendment of an application during inter parte proceedings. Petitioner, then applicant, never requested the PTO to amend the identification of goods. (Exhibit G). Applicant's motion was to dismiss the opposition and register the mark. (Exhibit C). The motion was not to amend the identification of goods to conform to the District Court Order.

The District Court's authority over registrations is found in Section 37 of the Act, 15 U.S.C. § 1119. The statute provides:

> In any action involving a registered mark the court may determine the right to registration, order the cancelation of registrations, in whole or in part, restore canceled registrations, and otherwise rectify the register with respect to the registrations of any party to the action. Decrees and orders shall be certified by the court to the Commissioner, who shall make appropriate entry upon the records of the Patent and Trademark Office, and shall be controlled thereby. [FN9]

This grant of authority allows a district court to order the Commissioner to cancel registrations in whole or in part, and to restore cancelled registrations. The power to order a mark registered, however, is not expressly provided for in the statute. If it exists it must be implied either from the court's ability to "determine the right to registration,"D' or from the power to "'rectify the register."DD'

***4** There is no indication that the district court has ordered the PTO to circumvent the administrative procedures for registration established by Congress. Massa v. Jiffy Products Co., 240 F.2d 702, 112 USPQ 241 (9th Cir.), cert. denied, 353 U.S. 947 (1957). In Massa, the U.S. Court of Appeals for the Ninth Circuit affirmed a lower court decision which not only ordered cancellation of the registration of one party, but also ordered the granting of a registration to the other party, even prior to the filing of an application for registration. However, the court made it clear that the registration would be awarded upon proper application. Id. at 704, 707, 112 USPQ at 242, 244.

In Durox Co. v. Duron Paint Manufacturing Co., Inc., 320 F.2d 882, 138 USPQ 353 (4th Cir.1963), the Fourth Circuit held that a district court could modify a decision of the PTO by ordering registration as to some of the goods, but not others. However, the Fourth Circuit stated that while the PTO had indicated that it would issue a registration to Durox in accordance with the court's opinion, the PTO had also stated that, as a matter of administrative practice within the Patent Office, it would place the registration in Class 16. When Duron objected to registration in that class, the court stated: "We think it should be left to the Patent Office to determine as an administrative matter the appropriate classification for such registration."D' Id. at 885 n. 5, 138 USPQ at 355 n. 5.

Jeno's Inc. v. Commissioner of Patents and Trademarks, 498 F. Supp. 472, 208 USPQ 492 (D.Minn.1980) involved a civil action in the nature of mandamus to compel registration of plaintiff's trademark "PIZZA ROLLS."D' The court indicated that while it had previously entered a Consent Judgment ordering the Commissioner of Patents and Trademarks to deny an application for registration for Vitale's "PIZZAROLLAS,"D' and to issue a registration for Jeno's "PIZZA ROLLS"D' pursuant to its pending application, that order was not intended to change the law or

affect the rights of others not party to the case [FN10]. The court declined relief.

Courts have insisted upon compliance with the Trademark Act's statutory scheme. Supreme Wine Co. Inc. v. American Distilling Company, 203 F.Supp. 736, 133 USPQ 322 (S.D.N.Y.1962), modified, 310 F.2d 888, 135 USPQ 481 (2d Cir.1962), involved an appeal from a TTAB decision sustaining the defendant's opposition to registration of plaintiff's trademark. In affirming the TTAB's decision, the court declined to order the Commissioner to register defendant's mark which the defendant had continuously used prior to plaintiff's adoption of a similar mark, since:

***5** [T]he registerability of this mark may depend on the resolution of issues not involved in this proceeding which should be determined in the first instance by the Patent Office.

Id. at 739, 133 USPQ at 325.

Thus, while district courts may have implied jurisdiction to order registration of a particular mark, they have not exercised that jurisdiction so as to contravene the statutory rights granted to other parties to oppose registration of marks. The Act provides a statutory scheme which the Commissioner must follow to issue registrations. [FN11] Several of the statutory provisions will be circumvented if the PTO interprets the District Court's Order as one to "amend"D' or "correct"D' the description of goods as set out in applicant's original application without notice to the public.

In the instant case, petitioner did not have aregistration which was the subject of the infringement action. The Court, therefore, could only have "'determined the right to registration,"D' which it did. The Court determined that the petitioner had a right to register its mark for animal feeders and industrial containers vis-a-vis Soltex. [FN12] But petitioner did not have an application before the PTO for animal feeders or industrial containers. Rather, the goods as set out in the application were for rubber and plastic pails, buckets and tubs. The goods petitioner seeks to add, animal feeders and industrial containers, are critical to the court's finding of no likelihood of confusion. It is certainly possible that another party may not have opposed Fortex's original application but would oppose a registration of the same term for animal feeders or industrial containers.

Petitioner's request to amend the description of goods involves a material alteration to the character of the mark, namely the goods the mark identifies. To make the requested change without the initial examination and publication for opposition contemplated by the Trademark Act could impinge on the statutory rights of others (non-parties to the civil action) and would be contrary to the statutory scheme established by Congress. The District Court could not have intended the Commissioner to take any action which is contrary to statutory requirements. Likewise, the Commissioner has no discretion to waive the statutory requirements.

In light of the foregoing, the request to suspend the rules and amend the Certificate of Registration to include additional goods is DENIED. Petitioner may file a new application for any of the goods listed in the District Court's order. In compliance with that Order, the mark FORTIFLEX owned by Soltex Polymer Corporation will not be cited against

any new application. If no third- party opposes the application, the mark for all the goods will be registered.

The Commissioner notes Fortex's argument that it would "be deprived of its court won right to register it mark. . . ."D' (Petition at 7). It already has a registration for most of its goods. It will only be denied a registration if an unknown third-party that was not a party to the litigation establishes superior rights in the mark on animal feeders and/or industrial containers. Certainly the court did not intend to prejudice the rights of third-parties who had no notice of Fortex's attempt to register the mark for these goods.

Harry F. Manbeck, Jr.,

Commissioner of Patents and Trademarks

By: JEFFREY M. SAMUELS,

Assistant Commissioner for Trademarks

FN1. Because the pages in the exhibits to the petition are unnumbered, the pages have been counted to aid with reference to the record. It is further noted that counted pages 26-39 are duplicates of pages 12-25.

FN2. Petitioner requested relief under Section 7 of the Act and 37 CFR § 2.176. However, Section 7, 15 U.S.C. § 1057, contains a couple of subsections concerning amendments and corrections to certificates of registration. Accordingly, it is unclear whether petitioner claims that the amendment is necessary due to a PTO mistake or a mistake by petitioner. Regardless of the grounds, relief cannot be granted under either section due to the nature of the requested change. See discussion infra.

FN3. Section 7 of the Act, 15 U.S.C. § 1057, provides procedures for amending or correcting certificates of registration. In particular, subsection (e) provides:

Upon application of the registrant and payment of the prescribed fee, the Commissioner for good cause may permit any registration to be amended or to be disclaimed in part: Provided, That the amendment or disclaimer does not alter materially the character of the mark.

FN4. Section 12(a) of the Act, 15 U.S.C. § 1062(a), provides in pertinent part:

Upon the filing of an application for registration and payment of the prescribed fee, the Commissioner shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made and, if on such examination it shall appear that the applicant is entitled to registration, or would be entitled to registration upon the acceptance of the statement of use required by section 1051(d) of this title, the Commissioner shall cause the mark to be published in the Official Gazette of the Patent and Trademark Office: . . .

FN5. 15 U.S.C. § 1051(a)(1)(c).

FN6. 15 U.S.C. § 1051(a).

FN7. 15 U.S.C. § 1062(a)

FN8. 15 U.S.C. § § 1062(a) and 1063.

FN9. To date, a Certified Order of the District Court has not been received by the PTO.

FN10. The "other"D' who was not a party to the case was RJR Foods, Inc. which had opposed an earlier application by Jeno's for "PIZZA ROLLS"D' and which would have been denied the opportunity to oppose the registration based on the application before the court if the Commissioner had been ordered to register the mark without following the statutory procedures.

FN11. Section 12 of the Act, 15 U.S.C. § 1062.

FN12. We do not know whether the application, which matured into the registration, in question and the goods identified in it was before the District Court for review, inasmuch as the civil action was an independent infringement action, separate and apart from the opposition proceeding pending before the TTAB at the time.

18 U.S.P.Q.2d 1224

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