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

RE: TRADEMARK REGISTRATION OF RONALD H. COWAN DBA KJAZ BROADCASTING CO.
90-100
September 26, 1990
***1** Petition Filed: April 6, 1990 [FN1]

For: KJAZ 92.7 FM & Design
Registration No. 1,225,389
Issued: January 25, 1983

Attorney for Petitioner

Gregory N. Owen

Owen, Wickersham & Erickson

Jeffrey M. Samuels

Assistant Commissioner for Trademarks

On Petition

Ronald H. Cowan dba KJAZ Broadcasting Co. has petitioned the Commissioner to reverse the decision of the Affidavit-Renewal Examiner to cancel the above- cited registration and to accept the petitioner's declaration under Sections 8 and 15 of the Trademark Act.

Facts

Registration No. 1,225,389 issued on January 25, 1983, and therefore, to avoid cancellation of the registration an affidavit or declaration conforming to Section 8 requirements had to be filed between January 25, 1988 and January 25, 1989.

On January 9, 1989 the petitioner filed a combined Section 8 and 15 declaration. Although the declaration had been prepared for the signature of the sole proprietor, setting forth the signatory's name as "Ronald H. Cowan" and containing the language that Mr. Cowan owns the registration, it was not in fact signed by Mr. Cowan. Rather, the name "Ronald H. Cowan" was signed in the signature space and the word "by" was written before the designation "James T. O'Dea, his attorney in fact." A general power of attorney, appointing James T. O'Dea as his lawful attorney-in-fact, and executed by Ronald H. Cowan, accompanied the declaration.

On May 31, 1989, the Affidavit-Renewal Examiner issued an action stating that acceptance of the combined declaration was withheld because the declaration must be executed by the Registrant. The action further stated that the only exception to this is when a manager or

similar persons are in a position to know of their own knowledge the facts regarding use. The petitioner was given six months to respond with evidence of such knowledge.

On July 11, 1989 the petitioner responded by submitting a substitute declaration signed by Ronald H. Cowan. On August 14, 1989 the Affidavit-Renewal Examiner withheld acceptance because the declaration was filed after the sixth year following the date of registration, and therefore, could not be considered. The Examiner reiterated her position that if Mr. O'Dea had the necessary knowledge and authority to sign for the registrant, evidence of such must be received by the end of the six month period for responding to the May 31st letter.

On September 18, 1989, petitioner sent a response, supported by a declaration under 37 C.F.R. 2.20, executed by Mr. O'Dea in which he declares that he is employed as General Manager of Cowan Enterprises, which oversees operation of KJAZ Broadcasting Company, and that part of his responsibilities include overseeing use of the registered mark.

On November 17, 1989, the Examiner stated that the previous Office actions were in error because an individual cannot delegate or authorize someone else to sign the affidavit on his behalf. Such a delegation of authority would only apply to corporations. The action further advised that the mark would be cancelled in due course.

***2** This petition followed on April 6, 1990. [FN2]

Issue Presented

The first issue in this case is whether the filing of a declaration signed by an employee of the registrant can be considered to be a "filing by the registrant" as required by Section 8 of the Trademark Act and an "execution by the registrant" as required by Trademark Rule 2.162(a). As the Commissioner stated in In re Schering Agrochemicals Limited, 6 USPQ 2d 1815 (Comm'r Pats.1987):

> [I]n certain limited circumstances, as determined by the Commissioner, a Section 8 affidavit may be considered as being filed by the registrant even though it was executed by someone other than the registrant (or an officer of a corporate registrant). In this regard, the registrant is responsible for establishing that its specific situation involves circumstances warranting such a broad construction of "registrant."

Analysis: Filing and Execution By Registrant

Section 8(a) of the Trademark Act requires that the affidavit of continued use be "filed by the registrant" and Trademark Rule 2.162(a) requires that the affidavit be "executed by the registrant." Section 1 of the Trademark Act addresses a similar issue in relation to the filing of an application by requiring an application to be "verified by the application ... or an officer of the corporation ... applying..." It is reasonable to conclude in relation to the filing of a Section 8 affidavit that, under ordinary circumstances, the appropriate person to

execute the affidavit for an individual registrant is that individual.

Concerning filing an affidavit required under Section 8 of the Act, the court in In re Precious Diamonds, Inc., 208 USPQ 410, 411 (C.C.P.A.1980), suggested that "the term 'registrant' might be more broadly construed to overcome a technical defect while, at the same time, meeting the legislative purpose [of Section 8]."

Failure to comply with the statutory requirement that the registrant file the affidavit of continued use is not a technical defect. However, in view of the purpose of the provision, the Patent and Trademark Office may conclude that a specific Section 8 affidavit or declaration is properly filed and executed by the registrant even if it is not signed by an officer of a corporate registrant. Thus, in certain limited circumstances, a person other than an officer of a corporate registrant may establish facts regarding that person's relationship to the registrant, personal knowledge of the use of the mark, and registrant's ratification of the action to warrant the conclusion that the filing of a Section 8 affidavit or declaration by that person may beconstrued as filing and execution by the registrant. See: In re Schering Agrochemicals Limited, 6 U.S.P.Q.2d 1815 (Comm'r Pats.1987).

In this case, petitioner supplemented its petition with a declaration pursuant to 37 C.F.R. § 2.20, executed by Mr. O'Dea, detailing his knowledge of use of the trademark and the authority granted to him with a general power of attorney.

***3** Petitioner has also provided a declaration under 37 C.F.R. § 2.20 executed by the petitioner, in which he declares that Mr. O'Dea, as general manager of the petitioner's businesses, has been granted a general power of attorney and that Mr. O'Dea had authority to sign the subject Section 8 and 15 document.

However, although the record establishes the authority of Mr. O'Dea to sign a Section 8 declaration on behalf of the petitioner, in this instance the petition must be denied. Mr. O'Dea did not sign the document on his own behalf, but rather on behalf of the Mr. Cowan, and the declaration purports to be in the name of the Mr. Cowan. Thus, there is in fact no verification of the Section 8 declaration, since Mr. Cowan has not signed the document, and Mr. O'Dea has not sworn, himself, to the statement made in the declaration.

Decision

Accordingly, the petition is denied. The registration file will be cancelled in due course.

Should petitioner wish to file a new application for registration of its mark, the Office will, upon request, expedite handling of the application. See Trademark Manual of Examining Procedure, § 1102.03.

FN1. The petition was perfected on April 30, 1990, by payment of the petition fee required under 37 C.F.R. § 2.6(k).

FN2. Petitioner provides a declaration of Gregory N. Owen, attorney for petitioner, in which he declares that on January 11, 1990 he telephoned the Examiner, who said she would not reconsider her decision and advised petitioner to file a petition to the Commissioner.

18 U.S.P.Q.2d 1407

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