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

RE: TRADEMARK REGISTRATION OF BONBONS BARNIER S.A.
90-121
August 24, 1990
***1** Petition Filed: May 30, 1990

For: BARNIER
Registration No. 1,271,338
Issued: March 20, 1984

Attorney for Petitioner

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Assistant Commissioner for Trademarks

On Petition

Bonbons Barnier S.A. has petitioned the Commissioner for an order accepting a declaration attesting to continued use of the above-referenced mark. The affidavit was filed to maintain the listed registration and was rejected as insufficient by the Affidavit-Renewal Examiner. Review of this petition is appropriate under Trademark Rules 2.146 and 2.165, 37 C.F.R. § § 2.146 and 2.165.

Facts

The registration in question issued March 20, 1984. Pursuant to Section 8 of the Trademark Act, 15 U.S.C. § 1058, registrant was required to file, between March 20, 1989 and March 20, 1990, an affidavit or declaration either (1) attesting to continued use of the mark in commerce, or (2) admitting nonuse and explaining the circumstances which made nonuse excusable.

On March 19, 1990, registrant submitted a declaration attesting to the fact that the mark in the registration "has been in continuous use in commerce between France and the United States as evidenced by the attached specimen showing the mark as currently used." Though the caption for the declaration noted that the mark was registered in international class 30, neither the caption nor the declaration itself listed the specific goods for which the mark is being used.

In an action issued May 15, 1990, the Affidavit-Renewal Examiner refused to accept the declaration and noted: "The goods were omitted. A registrant must file an affidavit setting forth the goods or services

recited in the registration on or in connection with which the mark is in use in commerce before expiration of the sixth year following the registration date. Since the statutory period for filing this affidavit has expired, the registration will be cancelled."

Trademark Rule 2.165(a)(2), 37 C.F.R. § 2.165(a)(2), states that a request for reconsideration shall be a condition precedent to a petition to the Commissioner to review a refusal of an affidavit, unless the first action refusing the affidavit directs the registrant to petition the Commissioner for relief. The refusal herein did not so direct the petitioner. However, registrant did call the Affidavit-Renewal Examiner to discuss the rejection of the declaration and was advised to file the instant petition. Thus, the petition is deemed properly filed.

Decision

1. The Requirements of the Statute and Rules

Section 8 of the Trademark Act, as amended by the Trademark Law Revision Act of 1988 (effective November 16, 1989), in pertinent part states:

***2** That the registration of any mark under the provisions of this Act shall be cancelled by the Commissioner at the end of six years following its date, unless within one year next preceding the expiration of such six years the registrant shall file in the Patent and Trademark Office an affidavit setting forth those goods or services recited in the registration on or in connection with which the mark is in use in commerce.... (emphasis added)

Rule 2.162, 37 C.F.R. § 2.162, in pertinent part states:

The affidavit or declaration ... must: (e) State that the registered mark is in use in commerce, list the goods or services recited in the registration on or in connection with which the mark is in use in commerce, and specify the nature of such commerce....

2. The Examiner's Rejection of the Declaration was Proper

The Trademark Act requires an affidavit or declaration to be filed within the sixth year following registration. However, a defect which does not relate to a statutory requirement may be corrected within the six months following the mailing date of the Office action rejecting the affidavit or declaration and noting the defect. For example, if a registrant fails to specify the type of commerce in which its mark is being used, then the defect can be corrected subsequent to the six year deadline for filing the declaration. The instant case, however, involves a substantive deficiency.

The clear terms of the Trademark Act section here in issue require the Section 8 affidavit or declaration to specify the appropriate goods or services for which the mark remains in use in commerce. Nonetheless, Office policy does allow a registrant filing such an affidavit or

declaration to "incorporate by reference" the identification of goods or recitation of services set forth in the relevant registration certificate. In the instant case, the registrant's declaration did not list the goods for which the mark is being used and did not explicitly incorporate by reference the identification set forth in the registration certificate.

Registrant, however, essentially argues that the declaration did identify the goods, inferentially, through incorporation by reference. Specifically, registrant notes that the mark in question was registered for only one product, that the declaration "stated clearly that the mark is in continuous use in commerce," and that the specimens submitted with the declaration "showed use of the mark with the goods of the application, namely candies." Therefore, registrant reasons, the statement of use in the declaration must be interpreted and read as a statement attesting to use of the mark for the goods listed in the registration, i.e., "candies."

The Trademark Act expressly requires the owner of a registration to file "an affidavit [or declaration] setting forth [the] goods or services" for which the mark is used (emphasis added). This express requirement of the statute must be read as applying to all registrations, whether they list one item in one class or a multitude of items in a variety of classes. The requirement is not met through the filing of a declaration that fails to identify the goods, even if accompanying specimens do identify the goods, because the statute requires the affidavit or declaration itself to "set forth" the goods. Accordingly, the Examiner acted properly when she rejected the declaration for non-compliance with the requirements of the statute.

***3** 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 Examiner 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). Since, in this case, the Examiner did not commit clear error or abuse her discretion, the refusal to accept registrant's declaration will not be reversed.

Conclusion

The petition is denied. The registration 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.

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