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

RE: TRADEMARK APPLICATION OF LUIS DEVESA MIGUEZ
Serial No. 74/015,299 [FN1]
June 15, 1990
***1** Petition Filed: February 23, 1990 [FN2]

For: LAVICLIN
Filing Date: January 2, 1990 [FN3]

Attorney for Petitioner

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On Petition

Luis Devesa Miguez petitioned the Commissioner for reinstatement of the original filing date for the above-captioned application which was cancelled because the papers were not in compliance with the filing requirements set out in 37 C.F.R. § 2.21.

On January 2, 1990, petitioner submitted its application with declaration pursuant to 37 C.F.R. § 2.20, setting forth the following:

> Applicant has a bona fide intention to use the mark in commerce on or in connection with the above identified goods. (15 U.S.C. 1051 et seq., as amended). Applicant intends to use the mark on or in connection with the above-identified goods by printed labels applied to the containers for the goods and in other ways customary to the trade.
>
> Applicant has a bona fide intention to use the mark in commerce on or in connection with the above identified goods and, accompanying this application, submits a certified coopy (sic) of a foreign registration in accordance with 15 U.S.C. § 1126(e), as amended.

In a letter dated February 9, 1990, the Supervisor of the Trademark Application Section notified petitioner that the application papers were being returned and the filing date cancelled because the certification or certified copy of the foreign registration had not been submitted, as required to receive a filing date under 37 C.F.R. § 2.21(a)(5)(ii). This petition followed.

Petitioner argues that although the filing requirements for applications filed under Section 44(e) of the Act had not been met, the requirements for receiving a filing date for applications filed under Section 1(b) were met.

Trademark Rule 2.146(a)(3) permits the Commissioner to invoke

supervisory authority in appropriate circumstances. However, the Commissioner will reverse the action of the Supervisor of theTrademark Application Section 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 Company, 142 USPQ 278 (Comm'r Pats.1964).

37 C.F.R. § 2.21(a)(5) enumerates the acceptable bases for filing applications:

(ii) A claim of bona fide intention to use the mark in commerce and a certification or certified copy of the foreign registration on which the application is based in an application under section 44(e) of the Act, or ...

***2** (iv) A claim of bona fide intention to use the mark in commerce in an application under section 1(b) of the Act;

A review of the originally filed papers which have been submitted with the petition reveals that a certification or certified copy of the foreign registration was not included [FN4], and therefore, the filing requirements for applications filed under Section 44(e) were not met.

With respect to petitioner's claim that the application was also filed pursuant to Section 1(b) of the Act, such a dual-based application must specifically be indicated. As noted at page 61 of Examination Guide 3-89, issued as a supplement to the Trademark Manual of Examining Procedure, Revision 7:

The Office will not presume that an application under Section 44 is also based on intent to use under Trademark Act Section 1(b), 15 U.S.C. Section 1051(b). If the applicant wishes to assert both bases, the applicant must indicate so specifically. If the applicant indicates that Section 44 is the basis, and nothing more, and the applicant fails to comply with the relevant Section 44 filing date requirements, the applicant will be denied a filing date, even if the application includes a statement of a bona fide intention to use the mark in commerce.

In this case petitioner did not clearly indicate that the application was being filed under Section 1(b) as an additional basis, therefore, the Supervisor of the Trademark Application Section did not err by refusing to accord a filing date for this application. However, the Commissioner will exercise supervisory authority here because it is apparent that petitioner intended to file pursuant to Section 1(b) as well as Section 44(e) because the application does set out, in a paragraph separate from the Section 44(e) basis, a statement of bona fide intention to use the mark in commerce, setting forth the intended manner of use of the mark on the goods.

The petition is granted. The Trademark Applications Section is directed to accord this application a filing date of January 2, 1990 and is authorized to charge petitioner's deposit account in the amount of $175 for payment of the refunded application fee.

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

FN2. The petition was perfected on April 24, 1990 by payment of the filing fee required under 37 C.F.R. § 2.6(k).

FN3. The filing date is the issue on petition.

FN4. Only a photocopy of the foreign registration was included with the application.

16 U.S.P.Q.2d 1458

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