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

RE: TRADEMARK REGISTRATION OF COOPER INDUSTRIES, INC.
Registration No. 1,227,368
June 12, 1990
***1** Petition Filed: June 5, 1989

For: BITLITE
Issued: February 15, 1983

Attorney for Petitioner

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Cooper Industries, Inc.

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Assistant Commissioner for Trademarks

On Petition

Cooper Industries, Inc. has filed a petition requesting that the Commissioner, pursuant to authority granted him by Trademark Rule 2.148, 37 C.F.R. Section 2.148, waive "the Officer Requirements" of Rule 2.20, 37 C.F.R. Section 2.20. The petitioner ultimately seeks acceptance of a combined affidavit filed under Sections 8 and 15 of the Trademark Act, 15 U.S.C. Sections 1058 and 1065, for Registration No. 1,227,368.

Facts

An affidavit or an equivalent declaration attesting to continued use in commerce of the BITLITE mark was required, under Section 8 of the Trademark Act, to be filed with the Office no later than February 15, 1989. Petitioner filed a combined Section 8 and 15 declaration on December 12, 1988 which set forth the required facts and averments. The combined declaration was signed by Duane F. Emmert, identified in the declaration as General Counsel of the Registrant corporation.

On March 9, 1989, the Affidavit/Renewal Examiner withheld acceptance of the declaration because it had not been executed by an officer of the corporation. Petitioner was granted six months to file a response attesting to Mr. Emmert's status as an officer of the corporation, if appropriate. The Examiner noted that if Mr. Emmert was not an officer of the corporation that a petition would have to be filed requesting waiver of the officer requirement of Rule 2.20. This petition, which admits that Mr. Emmert is not an officer of petitioner, followed.

Issue Presented

The first question is whether a waiver of Trademark Rule 2.20 is an appropriate or necessary action in this case. That rule permits an officer of a corporation to file a declaration, in lieu of an oath, affidavit, verification or sworn statement, whenever a corporate applicant or registrant, in connection with the filing of an application or other document is required to attest to the truth of particular facts. In this case, petitioner utilized the declaration form provided for by Rule 2.20, in lieu of the affidavit called for by Sections 8 and 15 of the Trademark Act, to verify the truth of statements of fact regarding the use and legal status of the BITLITE mark.

The Rules of Practice in Trademark Cases currently set forth declarations conforming to the requirements of Rule 2.20 as the only alternative to the oaths, affidavits, verifications or sworn statements that are at times required of applicants and registrants. However, Office practice actually allows applicants and registrants who are required to attest to the truth of facts to utilize a variety of legally acceptable supporting statements (e.g., declarations conforming to the requirements of 28 U.S.C. 1764). Therefore, it is clearly not current Office practice to apply Rule 2.20 in a rigid or restrictive fashion. Accordingly, it should not be applied restrictively to require that an officer of a corporation always be the signator on a Rule 2.20 declaration when another person might just as appropriately do so on the corporation's behalf.

***2** Thus, the issue on which the instant petition actually turns is not "the officer requirement" of Rule 2.20. Rather, the primary issue is whether the declaration signed by Mr. Emmert, not an officer of this corporate registrant, can be considered to be execution and filing of the combined declaration "by the registrant". As the Commissioner stated in In re Schering Agrochemicals Limited, 6 U.S.P.Q.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: Execution and Filing by Registrant

Trademark Rule 2.162(a), 37 C.F.R. Section 2.162(a), requires that the Section 8 affidavit of continued use be "executed by the registrant." Section 8, in subsection (a), requires that the affidavit be "filed by the registrant."

Section 1 of the Trademark Act, 15 U.S.C. 1051, requires each application to be "verified by the applicant ... or an officer of the corporation ..." if the applicant is a corporation. If an officer is required to verify any application filed by a corporation, it is

reasonable to conclude that an officer must also verify or execute the Section 8 affidavit. However, it has been 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]." In re Precious Diamonds, Inc., 208 USPQ 410, 411 (CCPA 1980).

By including Section 8 in the Trademark Act, Congress provided the Office with a mechanism for clearing the register of marks that have been abandoned or whose use has lapsed without an acceptable excuse for non-use. Thus, if a mark is actually in use and the required affidavit is filed, then "no public purpose is served by cancelling the registration of a technically good trademark because of a minor technical defect in an affidavit." Morehouse Manufacturing Corp. v. J. Strickland & Co., 160 USPQ 715, 720 (CCPA 1969).

Non-compliance 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 Section 8, the Commissioner may determine that a particular affidavit or declaration was properly executed and filed "by the registrant" even if it is not signed by an officer of a corporate registrant. Thus, in certain limited circumstances, the signing of a Section 8 affidavit or declaration for a corporate registrant by a non-officer may be construed as execution and filing "by the registrant" if facts are set forth to establish an appropriate relationship between the signer and the registrant, the signer's actual knowledge of use of the mark, and registrant's ratification of the signer's action. See In re Schering Agrochemicals Limited, supra.

Decision

***3** Petitioner argues that the Section 8 declaration executed by its general counsel should be considered as executed and filed "by the registrant" for the following reasons: (1) Past general counsels for petitioner have held corporate officer status and have executed "renewal Affidavits and Declarations"; (2) As general counsel of petitioner's legal department, Mr. Emmert is a "member of the firm" which satisfies the requirements of Rule 2.20; and, (3) Mr. Emmert's signing of the rejected Section 8 declaration constitutes proof of his actual knowledge of use of the mark.

In essence, petitioner appears to argue that its current general counsel should be allowed to act on its behalf as an officerbecause previous general counsels have actually been officers. In fact, given petitioner's history of granting officer status to previous general counsels, it would appear that the present general counsel's lack of officer status is the result of a conscious business decision by petitioner, rather than an unintentional oversight.

As an alternative to its first argument regarding the status of its general counsel, petitioner appears to be arguing that its general counsel is a "member of the firm" and thus was a proper signer of the Section 8 declaration. This argument attributes too broad a meaning to the type of entity encompassed by the reference in Rule 2.20 to a "firm." The Trademark Act requires applications to register marks to be

submitted to the Office in writing and to be "verified by the applicant, or by a member of the firm or an officer of the corporation or association." Trademark Act Section 1, 15 U.S.C. Section 1051.

The various sections of the Act and the Rules of Practice in Trademark Cases are replete with such references. Clearly, the various circumstances under which individuals must sign documents require that the individual "applicant" sign for himself or herself, that "a member of the firm" sign on behalf of a partnership or other organized business without corporate attributes, and that an officer sign on behalf of any "corporation or association" structured to have officers. Since the statute and the rules clearly distinguish between signator requirements applicable to "firms" and those applicable to "corporations", the former cannot be read to include the latter without muddying otherwise clear language. Further, if petitioner's interpretation of references to execution of documents by "a member of the firm" were accepted, then any employee of a corporation could sign documents on its behalf. This is a result clearly not in keeping with the law of corporations nor intended by the drafters of the Trademark Act and the Rules of Practice.

Petitioner's third and final point seems intended to establish that the circumstances presented by the instant case justify a broad construction of the term "registrant." When such a contention is advanced, however, it is the registrant's burden to establish the sufficiency of the circumstances warranting the broader construction. In re Schering Agrochemicals Ltd., 6 U.S.P.Q.2d 1815, 1816 (Comm'r Pats. 1987). The two key points necessary to establish existence of the requisite circumstances involve proving the signer's actual knowledge of use of the mark in issue and demonstrating that the act of signing by the non-officer signator has been ratified by the corporation. The petitioner has failed to prove either point and, thus, has not met its burden.

***4** Petitioner has chosen to rely solely on the fact that Mr. Emmert signed petitioner's Section 8 declaration to establish his "actual knowledge" of use of the mark in issue. However, petitioner has failed to set forth the source of the signer's actual knowledge of use of the mark. No evidence has been offered to establish that Mr. Emmert is in a position which would reveal to him, as a matter of course, the required actual knowledge that a non-officer signator of a Section 8 declaration would have to possess. In addition, no evidence has been offered to establish that the declarant's actions are ratified by the corporate registrant.

In sum, the record does not provide adequate support for finding the declaration to have been executed and filed "by the registrant." Accordingly, the petition is denied. The registration file will be returned to the Post Registration section for cancellation of the subject registration in due course.

16 U.S.P.Q.2d 1453

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