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

RE: TRADEMARK APPLICATION OF LS BEDDING
Serial No. 73-799,458 [FN1]
June 12, 1990
***1** Petition Filed: February 12, 1990

For: BODYLINE and design
Filing Date: none assigned

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Assistant Commissioner for Trademarks

On Petition

LS BEDDING, a limited company of Belgium, has petitioned the Commissioner for an order granting its application a filing date of November 15, 1989. Trademark Rule 2.146(a)(3), 37 C.F.R. Section 2.146(a)(3), provides appropriate authority for review of the request.

The instant petition is in the form of an unverified statement. [FN2] The statement, taken in conjunction with its attachments, indicates that petitioner's application was received by the Mail Room of the Patent and Trademark Office on May 10, 1989. The application contained a claim of priority under Trademark Act Section 44(d), 15 U.S.C. Section 1126(d), based on a Benelux application filed on November 9, 1988.

The Supervisor of the Trademark Application Section wrote to petitioner and explained that the application could not be accorded a filing date since the basis for filing was Section 44(d) but the application was received more than six months after the filing of petitioner's Benelux application. This letter also informed petitioner that the application papers would be held in the Application Section as "informal" for a period of six months. The letter apprised petitioner that if its Benelux application matured into a registration, then petitioner could, within that six month period, submit a certified copy or certification of the registration to the Application Section. "Once received," the letter stated, "the application will be accorded a filing date."

Petitioner submitted the certified copy and a signed translation thereof by first class mail, under a Certificate of Mailing in compliance with Rule 1.8, 37 C.F.R. Section 1.8, dated November 15, 1989. The submissions were received in the Mail Room, as indicated by

date stamps on the certified copy and translation, on November 17, 1989. According to petitioner's statement, the application papers and certified copy of petitioner's Benelux registration were returned to petitioner under cover of a Notice of Incomplete Trademark Application mailed February 1, 1990.

In response to the notice, petitioner resubmitted, on February 12, 1990, the returned materials and a check for the application filing fee. Petitioner requested the Supervisor of the Trademark Application Section to grant the application a filing date of November 15, 1989. The request was deemed "in the nature of a petition" and was perfected as such upon filing of the petition fee.

Issue

Petitioner's application was originally intended to be filed under the provisions of Trademark Act Section 44 as it existed prior to the section's amendment on November 16, 1989 in conjunction with implementation of the Trademark Law Revision Act of 1988. For applications based on any provision of Section 44 and filed on or after November 16, 1989, the Rules of Practice in Trademark Cases require an affidavit or declaration under Rule 2.20 attesting to the applicant's bona fide intention to use its mark in commerce or the application will be denied a filing date. Trademark Rule 2.21(a)(5), 37 C.F.R. Section 2.21(a)(5). Such an averment was not required for applications based on Section 44 and filed prior to November 16, 1989. The issue raised by the instant petition is whether petitioner's application may be considered as having been filed on November 15, which would make it subject to the filing date provisions for Section 44 then in effect, or whether it must be considered as filed on November 17, which would subject the application to the amended version of Rule 2.21.

Decision

***2** Petitioner does not dispute the contention that its application was not entitled to receive a filing date on May 10, 1989 as a Section 44(d) application. Its only claim is that the mailing of a certified copy of its Benelux registration on November 15, 1989 under a certificate of mailing by first class mail under Rule 1.8 dictates that the certified copy be deemed as received by the Office on that date. Such a contention, if accepted, would entitle petitioner's application to a filing date of November 15 because submission of a certified copy of its Benelux registration on that date would have "completed" the application filed earlier and held informal. The application would have been acceptable under the terms of Section 44 and Rule 2.21 if deemed as complete no later than November 15.

The contention advanced by the petitioner cannot, however, be accepted. The terms of Trademark Rules 1.6, 1.8 and 1.10, 37 C.F.R. Sections 1.6, 1.8 and 1.10, require the Office to consider the certified copy of petitioner's Benelux registration as having been filed in the Mail Room on November 17, 1989.

Rule 1.6(a) states: "Letters and other papers received in the Patent and Trademark Office are stamped with the date of receipt except where such letters and papers are filed in accordance with § 1.10. Any such letters and papers filed in accordance with § 1.10 will be stamped with the date of deposit as 'Express Mail' with the United States Postal Service...."

Rule 1.8(a) states: "Except in the cases enumerated below, papers and fees required to be filed in the Patent and Trademark Office within a set period of time will be considered as being timely filed if: ... [the rule then sets forth the address and sufficient first class postage requirements of the rule, as well as the requirement that a certificate indicating the paper's date of deposit in first class mail be signed and included with the paper] ... The actual date of receipt of the paper or fee will be used for all other purposes. This procedure does not apply to the following: ... (ii) The filing of trademark applications...." (Emphasis added).

The central contention of petitioner in this case fails to distinguish between the significance of "timely filing" of papers permitted to be filed under the provisions of Rule 1.8, and the use of the "actual date of receipt ... for all other purposes." Petitioner's November 17, 1989 response to the July 31, 1989 letter of the Supervisor of the Application Section, which held the originally submitted application to be informal, was actually received in the Mail Room within the six month period for response. It would have been held a "timely" response even if the six month response period had ended November 15, because of the use of the Certificate of Mailing.

Notwithstanding the "timely filing" of the response on November 15, it was not "received" until November 17. Under the clear terms of Rule 1.8, the date set forth in a Certificate of Mailing may only be used to determine the timeliness of a filing due within a given period of time, while the actual date of receipt is used for other purposes. In this case the "other purpose" for which the actual date of receipt must be used is the determination as to when petitioner had submitted to the Office all of the elements required for an application to receive a filing date. It is only the first date on which all the necessary elements for an application are present in the Office that can be considered the filing date of an application.

***3** Apart from petitioner's failure to distinguish between "timely filing" of papers and the "other purposes" for which only an actual date of receipt can be considered, petitioner also fails to consider the reference in Rule 1.8 to the "filing of trademark applications" as excepted from the coverage of the rule. Given the potential importance of a filing date of an application and the uncertainty of mail delivery in the First Class mail system, Rule 1.8 was carefully drafted to prevent its use as a means for obtaining a filing date for an application.

The essence of petitioner's case is the contention that it ought to be able to use Rule 1.8 to obtain a filing date for its application because it did not file "an application" by First Class mail on November 15, but simply filed, in timely fashion, a document necessary to sustain a previously submitted application. This is an untenable interpretation of Rule 1.8 which cannot be relied on in any way to

allow an applicant to obtain a filing date other than the date of actual receipt in the Office of all the elements of a complete application.

Since petitioner's submission of a certified copy of its Benelux registration may be considered a timely response to the notice of informal trademark application but may not be considered to have been received for the purposes of according its application a filing date until November 17, 1989, the sufficiency of the application papers must be judged in accordance with the requirements of the Trademark Act and the Rules of Practice as they existed on that day. Petitioner's application does not contain the requisite verified statement of a bona fide intention to use its mark in commerce and does not, therefore, comply with the requirements applicable to a Section 44 application filed on or after November 16, 1989. The Supervisor of the Application Section was therefore correct in returning the application papers to petitioner as an incomplete application. [FN3]

Accordingly, the petition is denied. The application materials submitted with the petition, including the certified copy and translation of petitioner's Benelux registration will be returned.

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

FN2. Trademark Rule 2.146(c), 37 C.F.R. Section 2.146(c) requires proof in the form of affidavits or declarations in accordance with Rule 2.20, 37 C.F.R. Section 2.20, to support the petition.

FN3. It appears that petitioner's application fee check was credited to application Serial No. 799,458. Since that serial number has been declared misassigned and the application was properly returned as incomplete the application fee is refundable. If the fee has not heretofore been scheduled for refund it will be so processed following entry of this petition decision.

16 U.S.P.Q.2d 1451

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