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

RE: TRADEMARK REGISTRATION OF CALDON COMPANY LIMITED PARTNERSHIP
95-359
October 12, 1995
***1** Petition Filed: May 30, 1995 [FN1]

For: LEFM
Registration No. 1,532,840
Issued: April 4, 1989

Philip G. Hampton, II,

Assistant Commissioner for Trademarks

On Petition

Caldon Company Limited Partnership has petitioned the Commissioner to accept a Section 8 declaration filed in connection with the above identified registration. Trademark Rules 2.146(a)(3), 2.146(a)(5) and 2.148 provide authority for the requested review.

Facts

The above registration issued on April 4, 1989, to Westinghouse Electric Corporation. On July 14, 1989, an assignment of the registration from Westinghouse Electric Corporation to Caldon Company Limited Partnership was recorded in the Patent and Trademark Office. Pursuant to Section 8 of the Trademark Act, 15 U.S.C. § 1058, Registrant was required to file an affidavit or declaration of continued use or excusable nonuse between the fifth and sixth year after the registration date, i.e., between April 4, 1994 and April 4, 1995.

On September 19, 1994, a declaration of continued use of the mark was filed by Caldon, Inc. By letter dated March 16, 1995, the Affidavit Renewal Examiner notified Caldon, Inc. that acceptance of the affidavit was withheld because (1) the records of the Patent and Trademark Office showed title to the registration in Caldon Company Limited Partnership; and (2) the specimen was unacceptable. Caldon, Inc. was advised that it must submit evidence of its ownership of the registration by recording appropriate documents with the Assignment Branch of the Office, or by submitting other evidence of the transfer of title. In addition, Caldon, Inc. was required to submit a new specimen, supported by an affidavit or declaration under 37 C.F.R. § 2.20 stating that the substitute specimen had been in use in commerce prior to the expiration of the sixth year following the date of registration. Caldon, Inc. was advised that, in the absence of a proper response filed within six months of the mailing date of the Office Action, a cancellation order would be issued in due course.

This petition was filed May 30, 1995. In an unverified statement,

[FN2] Petitioner's Contract Administrator asserts that the registration was assigned from the original registrant to Caldon Company Limited Partnership on June 12, 1989; that Caldon Company Limited Partnership and Caldon, Inc. are separate entities, with Caldon Company Limited Partnership owning all the patents and trademarks of Caldon, Inc.; that the Section 8 affidavit was inadvertently filed in the name of Caldon, Inc.; that the Office Action did not state that a new affidavit by another entity must be filed before expiration of the sixth year following the date of registration, i.e., by April 5, 1995; and that she had discussed the situation with the Affidavit Renewal Examiner by telephone, and the Examiner had advised her to petition the Commissioner.

***2** The petition was accompanied by a "corrected" declaration, consisting of a photocopy of the declaration filed September 19, 1994, which had been executed by the President of Caldon Inc., with the Registrant's name amended and initialed by Petitioner's "Contract Administrator." [FN3] A new specimen was also enclosed with the petition; however, use of the specimen in commerce prior to the expiration of the sixth year was not verified in an affidavit or declaration under 37 C.F.R. § 2.20, as the Examiner had required.

Decision

Section 8 of the Trademark Act, 15 U.S.C. § 1058, provides, in part:

> [T]he 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 and attaching to the affidavit a specimen or facsimile showing current use of the mark, or showing that any nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark ... (emphasis added).

The statute specifically requires that the affidavit be filed by "the registrant," prior to the expiration of the sixth year after the date of registration. The term "registrant" includes both the original registrant, and a person who has acquired ownership through proper transfer of title. Section 45 of the Trademark Act, 15 U.S.C. § 1127; TMEP § 1603.05. Where an assignee seeks to file a Section 8 affidavit, the assignee must establish its ownership of the mark. Ownership is established by submitting documentary evidence of a chain of title from the original owner to the assignee, or by specifying the reel and frame number where such evidence is recorded in the Patent and Trademark Office. 37 C.F.R. § 3.73(b); TMEP § § 502 and 1603.05(a).

When a Section 8 affidavit is timely filed by the owner of the registration, but the records of the Patent and Trademark Office show title in another party, the party who filed the affidavit may submit evidence of its ownership of the registration even if the sixth year following the date of registration has expired. TMEP § 1603.11. However, if the party who filed the affidavit was not the owner of the registration at the time the affidavit was filed, a substitute

affidavit in the name of the true owner cannot be filed unless there is time remaining in the statutory filing period. In re Precious Diamonds, Inc., 635 F.2d 845, 208 USPQ 410 (C.C.P.A.1980); In re Weider, 212 USPQ 947 (Comm'r Pats.1981).

***3** Trademark Rules 2.146(a)(5) and 2.148 permit the Commissioner to waive any provision of the Rules which is not a provision of the statute, where an extraordinary situation exists, justice requires and no other party is injured thereby. However, the Commissioner has no authority to waive a requirement of the statute. In re Mother Tucker's Food Experience (Canada) Inc., 925 F.2d 1402, 17 U.S.P.Q.2d 1795 (Fed.Cir.1991). Because the requirement that the registrant file the affidavit between the fifth and sixth year after the date of registration is statutory, it cannot be waived.

Petitioner asserts that it was not notified that an affidavit in the name of Caldon Company Limited Partnership was due before the expiration of the sixth year until after the deadline had expired. While the Office regrets that Petitioner was not earlier notified of the statutory deficiency, it is the Registrant who is ultimately responsible for filing proper documents. Although the Office attempts to notify parties as to defective papers to permit timely refiling, it has no obligation to do so. In re Holland American Wafer Co., 737 F.2d 1015, 222 USPQ 273 (Fed.Cir.1984); In re Fuller-Jeffrey Broadcasting Corp. of Santa Rosa, 16 U.S.P.Q.2d 1456 (Comm'r Pats.1990).

The petition is denied. The registration will be cancelled in due course.

FN1. The petition was perfected by submission of the petition fee, required by Trademark Rule 2.6(a)(15), on September 20, 1995.

FN2. Trademark Rule 2.146(c), 37 C.F.R. § 2.146(c), requires that when facts are to be proved in a petition, proof in the form of affidavits or declarations in accordance with § 2.20 shall accompany the petition.

FN3. No substantive amendment may be made in a Section 8 declaration Changes in substance may be made only by way of a substitute or supplemental affidavit. TMEP § 1603 II Furthermore, the alteration of a verified document by someone other than the signatory is clearly inappropriate. A proper Section 8 declaration in the name of Caldon Company Limited Partnership would be verified by an officer of the declarant, in the form of a notarized affidavit or a declaration under 37 C.F.R. § 2.20, and accompanied by a filing fee in the amount of $100 per class of goods or services.

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