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

RE: TRADEMARK APPLICATION OF DR. ALFRED HACKMACK
Serial No. 74/007181 [FN1]
March 19, 1990
***1** Petition Filed: February 7, 1990

For: DIGTRANS
Filing Date: December 4, 1989 [FN2]

Attorney for Petitioner

Thomas L. Adams

Jeffrey M. Samuels

Assistant Commissioner for Trademarks

On Petition

Dr. Alfred Hackmack has petitioned the Commissioner to restore the original filing date for the above-identified application which was cancelled for failure to comply with the filing requirements of 37 C.F.R. § 2.21.

Petitioner filed the subject application pursuant to Section 44(d) of the Act on December 4, 1989. In a letter dated January 8, 1990, the Supervisor of the Trademark Application Section notified petitioner that the filing date would be cancelled because the application failed to include: (1) a statement of bona fide intention to use the mark in commerce, and a claim of the benefit of a prior foreign application; and (2) a statement, on the drawing page, concerning priority filing information under Section 44(d) of the Trademark Act. The application papers were returned and the filing fee was scheduled for refund. This petition followed.

Petitioner has resubmitted the original application papers. A review of the application reveals that the required statement that the "applicant has a bona fide intention to use the mark in commerce," and a claim of the benefit of a prior foreign application are included in the application. The original drawing page, however, does not contain the foreign priority information.

Trademark Rule 2.146(a)(3) permits the Commissioner to invoke supervisory authority in appropriate circumstances such as this. With respect to the alleged omission of the statement of bona fide intention to use the mark in commerce and the claim of priority, the Trademark Applications Supervisor clearly erred by refusing to grant the original filing date on this basis, because the application contained the required statements.

The second issue is whether it was appropriate to refuse the

application a filing date because the heading did not contain the priority filing information. Trademark Rule 2.21 concerning the requirements for receiving a filing date requires:

(3) A drawing of the mark sought to be registered substantially meeting all the requirements of section 2.52.

Trademark Rule 2.52(d) requires the drawing to contain a heading which includes, inter alia, "the priority filing date of the relevant foreign application in an application claiming the benefit of a prior foreign application in accordance with section 44(d) of the Act."

Office policy concerning the requirement that the heading of the drawing page include the filing date of the foreign application in a U.S. application claiming priority under Section 44(d) of the Trademark Act has been relaxed, as discussed in a recent memorandum from the Office of the Director of Trademark Operation:

***2** In the case of the drawing heading, the applicant should only be denied a filing date if the applicant omits the heading entirely. The applicant should be granted a filing date if individual elements of the [heading] are missing, such as the filing date of the foreign application in a U.S. application claiming priority under Trademark Act Section 44(d). This is a change in policy.

There is no valid reason to exclude this application from the benefit of this change in policy.

The petition is granted. The Trademark Applications Supervisor is directed to grant petitioner its original filing date of December 4, 1989. [FN3] The petition fee is waived and will be refunded because the petition was necessitated by Office error.

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

FN2. The filing date is the issue on petition.

FN3. Petitioner has refiled an application for the same mark for the identical goods, based only on Section 1(b) of the Act, (because the six month period in which to file pursuant to Section 44(d) of the Act had expired). These papers will be consolidated with that file. The Examining Attorney is directed to examine the application papers which include both a Section 1(b) and 44(d) claim.

16 U.S.P.Q.2d 1895

END OF DOCUMENT