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

RE: TRADEMARK REGISTRATION OF WASTE MANAGEMENT OF NORTH AMERICA, INC.
88-142
September 18, 1989
***1** Petition Filed: December 1, 1988

For: THE CROWD PLEASER
Registration No. 1,193,919
Issued: April 20, 1982

Attorney for Petitioner

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Jeffrey M. Samuels

Assistant Commissioner for Trademarks

On Petition

Waste Management of North America, Inc. has petitioned the Commissioner, pursuant to Trademark Rule 2.148, for a waiver of the requirement that a combined declaration under Sections 8 and 15 of the Trademark Act be executed by an officer of petitioner.

An affidavit or declaration pursuant to Section 8 was required to be filed in connection with Registration No. 1,193,919 by April 20, 1988. Petitioner filed a combined declaration under Sections 8 and 15 on April 18, 1988 bearing the signature of Charlie Gillenwater, Director of petitioner.

By letter dated September 21, 1988, the Affidavit-Renewal Examiner withheld acceptance of the declaration pending receipt of a statement by the petitioner that the person who signed theaffidavit was an officer of the corporation. She further advised that if the person who signed the affidavit was not an officer of the corporation a petition to the Commissioner under Trademark Rule 2.148 could be filed requesting a waiver of the officer requirement of Rule 2.20. This petition followed.

As a supplement to the petition, Mr. Gillenwater declares in a declaration in accordance with Trademark Rule 2.20 that:

(1) In his day-to-day duties, he oversees the marketing of THE CROWD PLEASER and daily observes the placement of this product throughout the United States;

(2) He was aware of these facts as of the time he executed the declaration of continued use and incontestability in the above matter, that is, as of April 13, 1988; and

(3) He is the most knowledgeable person within the registrant

corporation with regard to the installation, marketing and sale of the product sold under the trademark THE CROWD PLEASER.

The petition has also been supplemented with a statement of Herbert A. Getz, Vice President and General Counsel of registrant which indicates that Mr. Gillenwater has authority to sign the declaration regarding the above- referenced trademark on behalf of Waste Management of North America, Inc.

Issue Presented

The first question is whether a waiver of Trademark Rule 2.20 is an appropriate or necessary action herein. Trademark Rule 2.20 permits an officer of a corporation to file a declaration in lieu of an affidavit, on behalf of a corporation making an application or filing a document in the Patent and Trademark Office. Trademark Rule 2.20 clearly permits a registrant to submit an acceptable declaration concerning the truth of the statement of facts required in affidavit form by Section 8 of the Trademark Act. However, just as the rule is not applied restrictively by the Patent and Trademark Office to preclude declarations in conformance with law which differ from the form stated in the rule (i.e., declarations in conformance with 28 U.S.C. 1764), it should not be applied to preclude appropriate persons other than an officer of a corporate registrant from signing a declaration to be filed under Section 8 of the Act in a particular case.

***2** Thus, the primary issue in this case is whether the filing of a declaration signed by Mr. Gillenwater, a non-officer of this corporate registrant, can be considered to be a "filing by the registrant" as required by Section 8 of the Trademark Act, and an "execution by the Registrant" as required by Trademark Rule 2.162(a) 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."

Consideration of Issue by Post Registration Section

Furthermore, the phrase "as determined by the Commissioner," which appears in the quote above, is not to be construed so narrowly as the Post Registration Section has, to require a petition to the Commissioner in the first instance. Whether the declaration is filed and executed by the registrant, pursuant to Section 8 of the Act and Trademark Rule 2.162(a), is an issue for the Post Registration Examiner to consider during his or her review of the acceptability of a Section 8 filing. The Examiner's determination may be reviewed by the Commissioner in accordance with Trademark Rule 2.146 and 2.165. Thus, the Post Registration Section erred in adhering to its above-stated

policy.

Analysis: Filing and Execution by Registrant

Section 8(a) of the Trademark Act requires that the affidavit of continued use be "filed by the registrant" and Trademark Rule 2.162(a) requires that the affidavit be "executed by the registrant." Section 1 of the Trademark Act addresses a similar issue in relation to the filing of an application by requiring an application to be "verified by the applicant ... or an officer of the corporation ... applying...." It is reasonable to conclude in relation to the filing of a Section 8 affidavit that, under ordinary circumstances, the appropriate person to execute for a corporate registrant is a corporate officer.

Concerning the filing of an affidavit required under Section 8 of the Act, the court in In re Precious Diamonds, Inc. 208 USPQ 410, 411 (CCPA 1980), 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)."

The submission of an affidavit of continued use pursuant to Section 8 of the Act serves the purpose of removing from the register marks which are no longer in use. Thus, if the mark is actually in use and the required affidavit is filed as the court in Morehouse Manufacturing Corp. v. J. Strickland & Co., 160 USPQ 715, 720 (CCPA 1969) noted, "no public purpose is served by cancelling the registration of a technically good trademark because of a minor technical defect in an affidavit."

***3** Failure to comply 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 the provision, the Patent and Trademark Office may conclude that a specific Section 8 affidavit or declaration is properly filed and executed by the registrant even if it is not signed by an officer of a corporate registrant. Thus, in certain limited circumstances, a person other than an officer of a corporate registrant may establish facts regarding that person's relationship to the registrant, personal knowledge of the use of the mark, and registrant's ratification of the action to warrant the conclusion that the filing of a Section 8 affidavit or declaration by that person may be construed as filing and execution by the registrant. See In re Schering Agrochemicals Limited. supra%u.

The statement of Mr. Getz and the declaration of Mr. Gillenwater demonstrate that Mr. Gillenwater is a corporate employee in a position of authority who has personal knowledge of the facts as to use or nonuse of the mark in question.

Decisions

The petition is granted to the extent that the registration file will be forwarded to the Affidavit-Renewal Examiner who is directed to consider the affidavit signed by the Director as being properly filed

by the registrant.

19 U.S.P.Q.2d 1076

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