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

RE: TRADEMARK APPLICATION OF VITAMIN BEVERAGE CORPORATION
94-212
September 5, 1995
***1** Petition Filed: July 25, 1994

For: OLD NEW ORLEANS STYLE
Serial No. 74/230,642
Filing Date: December 13, 1991

Philip G. Hampton, III

Assistant Commissioner for Trademarks

On Petition

Vitamin Beverage Corporation has petitioned the Commissioner to reverse the denial of a Request for Extension of Time to File a Statement of Use in connection with the above identified application. Trademark Rules 2.89(g) and 2.146(a)(3) provide authority for the requested review.

Facts

A Notice of Allowance issued for the subject application on May 18, 1993. Pursuant to Section 1(d) of the Trademark Act, a Statement of Use, or request for an extension of time to file a Statement of Use, was required to be filed within six months of the mailing date of the Notice of Allowance. On October 19, 1993, Petitioner filed its first request for an extension of time to file a Statement of Use, which was approved. On May 18, 1994, Petitioner filed a second request for an extension of time to file a Statement of Use, in which it asserted that:

> Applicant's mark is currently in use in commerce in connection with the goods identified in the Notice of Allowance. Applicant intended to file a Statement of Use in connection with the instant application by May 18, 1994. However, through an inadvertent error, the specimens supporting such use were lost in shipment to applicant's counsel. Accordingly, it is respectfully requested that the time for filing the Statement of Use be extended.

In an Office Action dated June 29, 1994, the Paralegal Specialist in the ITU/Divisional Unit denied the extension request because it did not include a verified statement that the applicant has a continued bona fide intention to use the mark in commerce, specifying those goods or services identified in the notice of allowance on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce, as required by Trademark Act Section 1(d)(2), 15 U.S.C. § 1051(d)(2), and Trademark Rule 2.89, 37 C.F.R. § 2.89. Petitioner was advised that, since the period of time within which to file an acceptable extension request or Statement of Use had expired, the

application would be abandoned in due course.

On June 3, 1994, the Applicant filed a Statement of Use. On July 8, 1994, the Paralegal Specialist issued an Office Action advising Petitioner that its Statement of Use was untimely filed because it was received after the expiration of the existing extension period. The filing fee for the Statement of Use was refunded on or about July 21, 1994.

This petition was filed July 25, 1994. Petitioner contends that its statement that the mark is actually in use in commerce subsumes the statement that it has a continued bona fide intention to use the mark in commerce.

Decision

***2** Section 1(d)(2) of the Trademark Act, 15 U.S.C. § 1051(d)(2), provides:

> The Commissioner shall extend, for one additional 6-month period, the time for filing the statement of use under paragraph (1), upon written request of the applicant before the expiration of the 6-month period provided in paragraph (1). In addition to an extension under the preceding sentence, the Commissioner may, upon a showing of good cause by the applicant, further extend the time for filing the statement of use under paragraph (1) for periods aggregating not more than 24 months, pursuant to written request of the applicant made before the expiration of the last extension granted under this paragraph. Any request for an extension under this paragraph shall be accompanied by a verified statement that the applicant has a continued bona fide intention to use the mark in commerce and specifying those goods or services identified in the notice of allowance on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce. Any request for an extension under this paragraph shall be accompanied by payment of the prescribed fee. The Commissioner shall issue regulations setting forth guidelines for determining what constitutes good cause for purposes of this paragraph (emphasis added).

Until now, the Patent and Trademark Office has taken the position that an allegation of use in commerce does not satisfy the statutory requirement that an extension request be accompanied by a verified statement that the applicant has a continued bona fide intention to use the mark in commerce. Therefore, the Paralegal Specialist acted properly in denying the extension request.

After further consideration and review of the legislative history of the Trademark Law Revision Act of 1988, which became effective November 16, 1989, the Office has decided to change its practice in this area, and to grant Petitioner's second Request for Extension of Time to File a Statement of Use.

Legislative History & Analysis

The Legislative History, Reports, Testimony, and Annotated Statutory

Text: Trademark Law Revision Act of 1988, (Public Law 100-667), reported at p. 25/177 of the USTA publication states:

Requests for extensions of the period of time in which to file the statement of use must be accompanied by a statement of continued bona fide intent-to-use. This requirement takes into account the surrounding circumstances as of the time when the continued bona fide intent is stated. The absence of concrete steps to commence use of the mark in commerce taken by the applicant since the filing of the previous statement of bona fide intent may cast doubt on the bona fide nature of the intent.

Nowhere does the statute require that the applicant use the specific words or phrase "bona fide intention to use" the mark. What the statute does require is a statement that applicant has a bona fide intention to use its mark. Black's Law Dictionary defines "statement" as "an allegation, a declaration of matters of fact." By stating that the mark is currently in use, the applicant, in this case, has made an allegation or declaration that exceeds the statutory requirement of a mere continuing bona fide intent to use the mark. The applicant avers that, in fact, use in commerce has been effected.

***3** Section 45 defines "Use in Commerce" as the "bona fide use of a mark in the ordinary course of trade...." This is the same phraseset out in Section 1(d)(2), minus the word "intention." Black's Law Dictionary defines "intention" as the "determination to act in a certain way or to do a certain thing. Here the "certain thing to be done" is use of the mark in commerce. Petitioner has stated its bona fide intention to use the mark in commerce by declaring that it is, in fact, using the mark in commerce. Thus, the Petitioner has surpassed the statutory requirements of Section 1(d)(2).

The Legislative History, Reports, Testimony, and Annotated Statutory Text: Trademark Law Revision Act of 1988, (Public Law 100-667), reported at p. 44/196 of the USTA publication states:

Amendment of the definition of "use in commerce" is one of the most far- reaching changes the legislation contains. Revised to eliminate the commercially transparent practice of token use, which becomes unnecessary with the legislation's provisions for an intent-to-use application system, ...

The committee intends that the revised definition of "use in commerce "be interpreted to mean commercial use which is typical in a particular industry. Additionally, the definition should be interpreted with flexibility so as to encompass various genuine, but less traditional, trademark uses, such as those in test markets, infrequent sales of large or expensive items, or ongoing shipments of a new drug to clinical investigators by a company awaiting FDA approval, and to preserve ownership tights in a mark if, absent an intent to abandon, use of a mark is interrupted due to special circumstances. Finally, the revised definition is intended to apply to all aspects of the trademark registration process, from applications to register, whether they are based on use or intent-to-use, and statements of use filed under Section 13 of the Act, to affidavits of use filed under Section 8, renewals and issues of abandonment....

Crocker National Bank v. Canadian Imperial Bank of Commerce, 223 USPQ 909, 914 (TTAB 1984) (quoting Chief Judge Markey in In re Nantucket, Inc., 213 USPQ 889, 892 (CCPA 1982)) notes that:

Each part or section of a statute should be construed in connection with every other part or section so as to produce a harmonious whole ..., and it is not proper to confine interpretation to the one section to be construed.

The statute and legislative history of the Lanham Act and its amendments are focused on use of the mark in commerce. Under the TLRA, U.S. law was amended to permit filers who have a bona fide intention to use the mark in commerce to apply to register their marks. However, with the exception of applications filed under Section 44 of the Act, use in commerce is a requirement for registration.

Even for applications under Section 44, the statute requires the assertion of a bona fide intention to use the mark in commerce in order for a filing date to be granted. Furthermore, when filing a Section 8 affidavit, or renewal application, foreign registrants must provide proof of use of the mark in commerce, or explain why non-use is excusable. Finally, a third party may petition to cancel a registration owned by a foreign filer after a period two years' non-use on the part of the registrant.

***4** It is clear from the legislative history that the intent of the statute is to make use in commerce, (or excusable non-use), a requirement for continued federal protection of all marks. Therefore, once an applicant makes a declaration that the mark is currently in use in commerce, it would defy congressional intent to treat such a statement as an incurable deficiency under Section 1(d)(2). As a practical matter, once an applicant provides a declaration of actual use in an extension request, subsequent requests for extensions of time in which to file a Statement of Use should be rare.

Change to Office Practice

Effective immediately, paralegals in the ITU/Divisional Unit of the Office will accept as being substantially in compliance with the statutory requirement that an extension request be accompanied by a verified statement that the applicant has a continued bona fide intention to use the mark in commerce the applicant's allegation that the mark is in use in commerce on or in connection with the goods or services identified in the Notice of Allowance.

The petition is granted. The application will be forwarded to the ITU/Divisional Unit for further action in accordance with this decision.

37 U.S.P.Q.2d 1537

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