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

RE: TRADEMARK REGISTRATION OF SCHERING AGROCHEMICALS LIMITED
86-103
November 9, 1987
***1** Petition Filed: December 30, 1986

For: TAKTIC
Registration No. 1,144,696
Issued: December 30, 1980

Attorney for Petitioner

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Assistant Commissioner for Trademarks

On Petition

FACTS

Schering Agrochemicals Limited [FN1] has petitioned the Commissioner, pursuant to Trademark Rule 2.148, and by reference to the Trademark Manual of Examining Procedure Section 1603.05, for a waiver of Trademark Rule 2.20 to permit an individual other than an officer of a corporate registrant to execute a declaration under Section 8 of the Trademark Act.

Section 8 of the Trademark Act, 15 U.S.C. 1058, provides for cancellation of a registration unless, within one year after the end of the fifth year following the date of registration, the registrant files an affidavit or declaration of use in commerce.

An affidavit or declaration pursuant to Section 8 of the Trademark Act was required to be filed in connection with Registration No. 1,144,696 by December 30, 1986. On that date, a Section 8 declaration signed by George J. Raymond, and declaring that he is the Marketing Director of Nor-Am Chemical Company, was filed. Nor-Am Chemical Company is identified in the petition as the exclusive licensee of petitioner. Petitioner and Nor-Am Chemical Company are further identified as wholly-owned subsidiaries of Schering AG. The attorney for petitioner explained that a Section 8 declaration signed by an officer of the registrant could not be obtained in a timely fashion because of holidays and vacations of the registrant. The declaration was accompanied by a petition to the Commissioner for acceptance of the Section 8 declaration.

BASIS FOR PETITION

Petitioner has requested, under Rule 2.148, a waiver of Rule 2.20. Trademark Rule 2.20 permits an officer of a corporation to execute a declaration, in lieu of an affidavit, on behalf of a corporation. In appropriate circumstances, the Commissioner may waive this requirement that the declaration be executed by an officer. As explained in Section 1603.05 of the Trademark Manual of Examining Procedure, the Commissioner has made certain exceptions in the past, in relation to a Section 8 declaration, for managers or similar persons who are in positions of authority in the registrant corporation if they are in a position to know, of their own knowledge, the facts as to the use or non-use of the mark.

However, Rule 2.20 is not relevant to the issue presented in this petition. This is not a question under Rule 2.20 of whether a non-officer employee of a corporate registrant can appropriately execute the Section 8 declaration, but rather, whether the situation herein warrants the conclusion that the affidavit has been filed by the registrant, as required by the statute, even though it was not executed by the registrant. Therefore, this petition will be treated as a request to invoke the supervisory authority of the Commissioner, pursuant to Trademark Rule 2.146(a)(3), to determine whether the Section 8 declaration is filed by the registrant.

ANALYSIS

***2** Section 8(a) of the Trademark Act requires that the affidavit or declaration be filed by the registrant. The Commissioner does not have the authority to waive a requirement of the statute.

However, in relation to this Section 8 requirement, the court, in In re Precious Diamonds, Inc., 208 USPQ 410, 411 (CCPA 1980), suggested that "the term 'registrant' in the statute might be more broadly construed to overcome a technical defect while, at the same time, meeting the legislative purpose" of Section 8.

The purpose of requiring Section 8 affidavits is to automatically remove 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 UPSQ 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."

Thus, in 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."

CONCLUSION

The facts of record in this petition are insufficient to justify such a broad construction of the term "registrant." Mr. Raymond's declaration, submitted on December 30, 1986, contains no evidence or verified statements that he is in a position to know of his own knowledge the facts regarding use of the mark. There is no indication that the declarant's actions are ratified by the petitioner. There is insufficient information regarding the relationship between the petitioner and Nor-Am Chemical Company. Declarant also fails to indicate whether he is an officer of Nor-Am Chemical Company. For these reasons, the record does not provide adequate support for the declaration to be considered as having been filed by the petitioner.

The petition is denied. The file will be forwarded to the Post Registration Division for cancellation of the subject registration in due course.

FN1. Schering Agrochemicals Limited (formerly FBC Limited), the petitioner, is the registrant of record in the Patent and Trademark Office. The assignment from the original registrant, The Boots Company Limited, to FBC Limited was recorded with the Office on August 6, 1982. The above-noted change of name was recorded on February 2, 1987.

6 U.S.P.Q.2d 1815

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