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

RE: TRADEMARK APPLICATION OF METAUX PRECIEUX S.A. METALOR
97-65(R)
Registration No. 1,598,131
June 24, 1998
***1** Issued: May 29, 1990

FOR: DELTA AND DESIGN
Request Filed: June 5, 1997

Attorney for Petitioner:

Jess M. Collen, Esq.

McGlew and Tuttle

Box 306

Scarborough Station

Scarborough, New York 10510-0806

Philip G. Hampton, II

Assistant Commissioner for Trademarks

On Request for Reconsideration

Metaux Precieux S.A. Metalor has requested reconsideration of the April 10, 1997 Commissioner's decision affirming the Affidavit-Renewal Examiner's refusal to accept the Section 8 Affidavit filed in connection with the above-referenced registration. The petition is granted under Section 8 of the Trademark Act and Trademark Rule 2.146.

FACTS

Petitioner filed its Section 8 affidavit of continued use of the mark within the statutory period, including a specimen of use. The specimen accompanying the Section 8 affidavit and the mark as it appears on the registration certificate are shown below:





Mark as registered

Mark as shown on specimen

The issue on petition was whether Petitioner could provide an acceptable specimen of use after the close of the statutory period. Citing In re Darnell, 33 USPQ2d 1372 (Comm'r Pats. 1993), the Commissioner denied the petition because specimens showing use of a different or materially-altered mark could not be cured after expiration of the period for filing the Section 8 affidavit. Specifically, the Commissioner noted that Section 8 of the Trademark Act and Trademark Rule 2.162(e) required the filing, within the statutory period, of a specimen showing current use of the mark. A specimen showing use of a different mark, the Commissioner stated, was, in effect, omission of a specimen. Therefore, such a specimen was not merely "deficient" but omitted, and the omission could not be cured after the expiration of the statutory period.

Section 8(a) of the Trademark Act, 15 U.S.C. § 1058(a) reads as follows:

(a) Each certificate of registration shall remain in force for ten years: Provided [emphasis in original], That the registration of any mark under the provisions of this Act shall be canceled 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 [emphasis added], 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. Special notice of the requirement for such affidavit shall be attached to each certificate of registration.

Thus, as long as the Registrant claims that its mark is still in use in commerce, Section 8 requires a specimen or facsimile showing current use of the mark to be attached to the Section 8 affidavit.

ANALYSIS

***2** It has been the practice of the Office, in accordance with In re Darnell, supra, to deny petitions to accept new specimens filed after the close of the statutory period for filing a Section 8 affidavit, where the specimens accompanying the Section 8 affidavit showed a materially different mark from the mark in the registration certificate. Under the interpretation contained in Darnell, the Office determined that if the specimen showing current use of the mark demonstrated use that was so different from the mark as registered as to constitute a material alteration of the mark, the specimen had, in

effect, been omitted. Therefore, since an explicit requirement of the statute, i.e., that a specimen of current use accompany the Section 8 affidavit, was not met, the omission could not be cured after the expiration of the statutory period for filing the Section 8 affidavit.

Trademark Rule 2.162(e), 37 C.F.R. § 2.162(e) reads, in pertinent part, as follows:

> If the specimen or facsimile is found to be deficient, a substitute specimen or facsimile may be submitted and considered, even though filed after the sixth year has expired, provided it is supported by an affidavit or declaration pursuant to § 2.20 verifying that the specimen or facsimile was in use in commerce prior to the expiration of the sixth year. [Emphasis added.]

In re Darnell defined a specimen as "deficient" if, for example, the Registrant submitted an advertisement as a specimen of trademark usage of a mark for goods. In re Brittains Tullis Russell, Inc., 23 USPQ2d 1457 (Comm'r Pats. 1992). Therefore, as long as the mark as registered appeared on the specimens, even if the specimens were not of the correct type to support use for the registered goods and/or services, the specimens were considered "deficient" and thus curable.

The requirement for submission of an affidavit of continued use under Section 8 of the Act serves the purpose of removing from the register marks that 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 (C.C.P.A. 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." Petitioner has submitted a substitute specimen identical to the mark in the registration certificate, with a supporting declaration claiming that the specimen was in use during the sixth year of registration.

In this case, the mark shown on the specimen filed with the Section 8 Affidavit is "DELTA" preceded by "V-". The mark on the registration certificate is "DELTA" within a border that also contains a check mark or a "V" extended on the left side. "DELTA" is the primary source indicator in the mark. The "V-" on the specimen filed with the Section 8 affidavit, and check mark in the registration certificate are somewhat similar.

***3** Pursuant to 35 U.S.C. § 6 and 37 C.F.R. § 2.146(a)(3), the Commissioner may invoke supervisory authority in appropriate circumstances. Because the mark on the specimen contains "DELTA," the dominant element of the mark, and because there are similarities between the "V-" in the specimen and the check mark on the registration certificate, the Commissioner will determine that the specimen is deficient, thus permitting submission of a substitute specimen after the statutory period.

In re Darnell Overruled

In re Darnell is overruled to the extent that it states that a specimen that shows use of a different or materially altered mark may

[not] be cured after the sixth year of registration. Rather, the test for whether a specimen submitted during the statutory period is considered "deficient" and, therefore, correctable, is whether: (1) it contains the dominant portion of the registered mark; and (2) the Registrant can provide a specimen showing the registered mark, supported by a declaration that the specimen was in use in commerce during the sixth year of registration.

DECISION

Upon further consideration, the petition is granted. The file will be forwarded to the Post-Registration Division for consideration of Registrant's Section 8 affidavit.

(P.T.O.)

END OF DOCUMENT