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

RE: TRADEMARK REGISTRATION OF ALFRED DUNHILL LIMITED
97-86
June 10, 1987
***1** Petition Filed: December 29, 1986

For: DUNHILL
Registration No. 859,052
Issued: October 22, 1968

Attorney for Petitioner

Albert Robin

Robin, Blecker & Daley

Margaret M. Laurence

Assistant Commissioner for Trademarks

On Petition

Alfred Dunhill has petitioned the Commissioner, pursuant to Trademark Rule 2.146, to review a decision refusing to amend the above-identified registration.

Trademark Registration No. 859,052 for DUNHILL issued on October 22, 1968 to Alfred Dunhill Limited (ADL) for 'men's toiletries--namely, pre-electric shave lotion, after shave lotion, shave cream, cologne, talcum powder, and personal deodorant, in Class 51 (Int. Cls. 3 and 5). The registration contained an exception to ADL's right of exclusive use of the mark, as follows:

> Dunhill Tailored Clothes, Inc., a New York corporation, located and doing business at 65 East 57th Street, New York, New York may use 'Dunhill Tailors' on eau de cologne for men; provided, however, that whenever Dunhill Tailored Clothes, Inc. so makes any use of 'Dunhill Tailors,' the word 'Tailors' shall always be horizontally juxtaposed to 'Dunhill' and shall always be in the same form, font, style, size, color and as prominent as 'Dunhill,' and provided further that Dunhill Tailored Clothes, Inc. shall not use 'Dunhill Tailors' in lower case type. Concurrent use with Dunhill Tailored Clothes, Inc.

On October 30, 1985, ADL requested, pursuant to Section 7(d) of the Trademark Act, that the above-quoted language be deleted. In support of this request, ADL submitted a document executed on July 26, 1985 and styled 'Assignment of Concurrent Use Rights'. The document recited that Dunhill Tailored Clothes (TAILORED), (the company named as the exception to ADL's right of exclusive use), assigned to ADL 'all of its concurrent use rights' in various registrations and applications, including Application Serial No. 516,819, which was subsequently registered under No. 1,351,849. The document also indicated that a

related company of ADL was acquiring all of TAILORED's right, title and interest to the mark DUNHILL TAILORS and the goodwill of the business symbolized by the mark.

On January 21, 1986 the Post-Registration Examiner required that the signature of the officer requesting the amendment be verified, and a second verified request to amend the registration, was filed on February 24, 1986. This request was denied by the Post-Registration Examiner on September 25, 1986 because the assignment document indicated that an unidentified company, and not ADL, was assigned all rights in the mark DUNHILL TAILORS, and that ADL could not be the owner of the concurrent use rights.

On October 2, 1986 ADL filed a response to this refusal. It submitted a copy of an assignment document executed July 26, 1985 by which TAILORED assigned to D.T. Acquisition Corp. (DT) all right, title and interest to the following marks:

DUNHILL TAILORS	Registration No. 773,223
DUNHILL TAILORS	Registration No. 860,777
PINSTRIPE	Registration No. 876,713

***2** ADL also submitted a copy of a second assignment document, executed on the same date, by which DT assigned the same marks and registrations to ADL. All of these documents were recorded in the Patent and Trademark Office.

On November 4, 1986 the Post-Registration Examiner maintained the refusal to amend the registration because the assignment documents submitted by ADL did not transfer the registration involved in the Section 7(d) request.

The subject petition was then filed.

ADL argues that the restriction should be deleted because ADL had acquired all relevant rights in the trademarks DUNHILL and DUNHILL TAILORS by virtue of the assignment by TAILORED to ADL of its concurrent rights in ADL's registration for DUNHILL, and the assignment by TAILORED to DT and by DT to ADL of TAILORED's registration No. 860,777 for DUNHILL TAILORS. Registration No. 860,777 is for, inter alia, 'eau de cologne for men'.

Section 7(d) of the Act provides in part:

> Upon application of the registrant and payment of the prescribed fee, the Commissioner for good cause may permit any registration to be amended or to be disclaimed in part: Provided, That the amendment or disclaimer does not alter materially the character of the mark.

Generally, determinations of concurrent use rights must be made by a court or by the Trademark Trial and Appeal Board, and parties cannot use Section 7(d) to impose concurrent restrictions on registrations or to remove such restrictions. In re Forbo North America, Inc., No. 84-38, ---- USPQ ---- (Com'r. Pats. August 31, 1984). Further, an exception to a registrant's exclusive right to use a mark, such as the exception in the subject registration, does not constitute a right separate from the other party's right in its mark. Thus, the so-called assignment of concurrent rights from TAILORED to ADL, without more,

does not constitute a basis for deleting the restriction listed in the registration on ADL's exclusive right to use the mark. In this respect, the Post-Registration Examiner was correct in refusing the amendment under Section 7(d) of the Act.

However, in the instant situation TAILORED owned the trademark DUNHILL TAILORS and registrations for this mark in International Classes 3, 14, 18, 20 and 25, and specifically for the goods listed in the exception to ADL's rights to exclusive use of the mark.

When TAILORED assigned its rights in the mark DUNHILL TAILORS, and the registrations for this mark, to ADL, all rights in the mark merged in ADL. TAILORED had been the only exception to ADL's right to exclusive use of the mark DUNHILL for the items listed in Registration No. 859,052. Thus, in this particular fact situation, the assignment of TAILORED's rights in the trademark DUNHILL TAILORS and its registrations to ADL had the effect of removing the limitation on ADL's exclusive right to use the mark. Moreover, removal of the limitation on DUNHILL's rights would not affect the rights of third parties. Therefore, it is acceptable to remove, pursuant to Section 7(d), the reference to the exception to the exclusive use right in ADL's registration.

***3** The petition is granted.

4 U.S.P.Q.2d 1383

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