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

RE: TRADEMARK APPLICATION OF THE DU PONT MERCK PHARMACEUTICAL COMPANY
94-266
February 2, 1995
***1** Petition Filed: March 21, 1994

For: AVIVA
Serial No. 74/204,852
Filing Date: September 18, 1991

Philip G. Hampton, II

Assistant Commissioner for Trademarks

On Petition

The Du Pont Merck Pharmaceutical Company has petitioned the Commissioner to review the Examining Attorney's final refusal to accept the application and Statement of Use filed for the above mark. Trademark Rules 2.63(b) and 2.146(a)(1) provide authority for the requested review.

FACTS

The subject application was filed on September 18, 1991. The application identifies the Applicant as a general partnership composed of two corporate general partners, however, the application was signed by Mr. Thomas J. Bucknum, "Senior Vice President, General Counsel and Secretary" of Applicant. The application was examined and the mark approved for publication on December 16, 1991. After publication of the mark on April 28, 1992, a Notice of Allowance subsequently issued on July 21, 1992.

On November 5, 1992, Petitioner filed a Statement of Use signed by the same individual who signed the original application. In an Office Action dated March 29, 1993, the Examining Attorney required the Applicant to explain whether the signatory had color of authority to sign the application and Statement of Use, and to submit a substitute declaration signed by a general partner of Applicant. TMEP § 803.07; 37 C.F.R. § 2.32(a).

In a letter filed September 28, 1993, Petitioner argued that the application and Statement of Use were properly signed by the Applicant as required by the statute and rules, and as stated in the Trademark Trial and Appeal Board decision In re Hercofina, 207 USPQ 777 (TTAB 1980). In support of this contention, petitioner submitted the following documents: (1) a declaration of the signatory attesting to his personal knowledge of the facts contained in the application and Statement of Use; (2) portions of the Partnership Agreement; (3) portions of a "Consent in Lieu of Meeting of the Partnership Board of The Du Pont Merck Pharmaceutical Company;" (4) a "Delegation of

Authority;" and (5) an opinion letter from Applicant's outside counsel.

The Partnership Agreement, specifically Article 3, established a "Partnership Board" whose function is to manage the business and affairs of the Applicant. This "Board" is to be operated by a "president" and other "key employees;" the president "shall have the authority to manage and operate the business of the Partnership" and "may delegate authority to ... managers and to other Partnership personnel."

The unsigned copy of portions of a "Consent in Lieu of Meeting of the Partnership Board of The Du Pont Merck Pharmaceutical Company," concerns the creation of various officer positions for the members of the Partnership Board, including the signatory, as follows:

***2** The undersigned, constituting all of the members of the Partnership Board ... hereby approve and adopt the following resolutions by written consent pursuant to ... the Partnership Agreement....

Election of Officers

RESOLVED, that, until further action by this Board, the titles and functions of the officers of the Company shall be as set forth ...; and further

RESOLVED, that all persons holding such offices be and hereby are designated "Key Employees" of the Company (as defined in the Partnership Agreement); and further

RESOLVED, that the persons listed ... hereto be and hereby are elected to the offices set forth opposite their respective names, to hold office until the election and qualification of their respective successors or until their earlier resignation or removal.

OFFICERS OF THE COMPANY

Senior Vice President, General Counsel and Secretary

The General Counsel and Secretary shall be responsible for all legal affairs of the Company, shall give notice and take minutes of meetings of the Partnership Board, and shall enjoy all powers commonly incident to the office.

Thomas J. Bucknum

Senior Vice President, General Counsel and Secretary

The "Delegation of Authority" document, signed by the "President and Chief Executive Officer" of Applicant and dated June 19, 1991, expressly authorized the signatory to handle all trademark matters for Applicant, as follows:

The undersigned ... hereby delegates to the Senior Vice President, General Counsel and Secretary (presently Thomas J. Bucknum), and his or her delegates, the authority to execute on behalf of the Company.

1. All documents required or useful to be filed in any government office in any country in connection with (a) filing of applications for patents, trademarks, and copyrights, including without limitation applications filed under the Patent Cooperation Treaty and the European

Patent Convention, and (b) any proceedings concerning patents, trademarks and copyrights and applications therefor owned by the Company or its affiliates or any other entity; and

2. All documents required or useful to be filed in any court, governmental agency or other body in connection with the filing, prosecution, defense or settlement of any litigation, administrative proceeding or alternate dispute resolution proceeding involving the Company or its affiliates.

The undersigned ratifies fully all actions already taken by the above-named delegate and his delegates in accordance with the authority granted hereby.

In the "opinion" letter, Applicant's outside counsel described Applicant as a "joint venture organized as a Delaware general partnership" that is a juristic entity able to sue and be sued and able to enter into contractual agreements, among other things. This attorney also stated that Applicant's "Senior Vice President, General Counsel and Secretary" had been "duly authorized to execute on behalf of the Company trademarks applications statements of use and any other documents required or useful to be filed with the Patent and Trademark Office in connection with applications for trademarks."

***3** On January 21, 1994, the Examining Attorney issued a final Office Action stating the following:

The request that the applicant's Statement of Use and original application be signed by one of the general partners is hereby made FINAL.

The reference that the applicant makes to In re Hercofina, 207 USPQ 777 (TTAB 1980) is noted. However, the ruling in the above mentioned case refers to joint ventures, not partnerships. Despite the applicant's assertion to the contrary, the Office continues to take the position that partnerships and joint ventures are not synonymous. Therefore, inasmuch as the applicant has identified itself as a partnership, the statutory requirement relating to partnership applies.

If the applicant has mistakenly identified itself as a partnership when in fact it is a joint venture, the applicant must amend the preamble to correct the entity designation. Under those circumstances, the signature as it now appears would be acceptable.

On March 21, 1994, Applicant filed a Notice of Appeal and a Petition to the Commissioner, and on March 28, 1994, with a certificate of mailing dated March 24, 1994, Applicant filed a Request for Reconsideration of the Examining Attorney's final refusal. In a letter dated April 28, 1994, the Examining Attorney "noted" the Request for Reconsideration and suspended action on the application for three months pending the "ruling" on the petition. [FN1]

On July 5, 1994, the Trademark Trial and Appeal Board suspended proceedings on the appeal and forwarded the application to the Commissioner for review of the petition. In a footnote, the Board noted that the Examining Attorney was not aware of the appeal inasmuch as the notice had not been associated with the file at the time she suspended the application.

Counsel for Applicant argues on petition that the Examining Attorney incorrectly refused acceptance of the application and Statement of Use based solely upon TMEP § 803.07, a section that is not supported by

either the statute or recent case law, and that the application and Statement of Use were properly signed by the Applicant.

DECISION

Propriety of Petition and Standard of Review

Trademark Rule 2.146(a)(1) allows for the filing of a petition to the Commissioner when relief is sought "[f]rom any repeated or final formal requirement of the examiner in the ex parte prosecution of an application if permitted by [37 C.F.R.] § 2.63(b)." The referenced Rule 2.63(b), in pertinent part, states, "the applicant may respond [to a second or subsequent Office Action] by filing a timely petition to the Commissioner for relief from a formal requirement if.... (2) the examiner's action is made final and such action is limited to subject matter appropriate for a petition to the Commissioner."

According to Trademark Rule 2.146(b), "[q]uestions of substance arising during the ex parte prosecution of applications, including, but not limited to, questions arising under sections 2, 3, 4, 5, 6 and 23 of the Act of 1946, are not considered to be appropriate subject matter for petitions to the Commissioner."

***4** In cases where a refusal to register is based on an Applicant's alleged failure to comply with the technical requirements set forth in the Trademark Rules of Practice, such refusal will generally be petitionable. "The question involved in such a case is more nearly one of administrative practice and procedure under the Trademark Rules of Practice and, therefore, falls comfortably within the review function of the Commissioner under Trademark Rule 2.146." In re Stenographic Machines Inc., 199 USPQ 313, 316 (Comm'r Pats 1978) In the present case, the issue regarding the proper signatory for an application and Statement of Use filed by a partnership Applicant is clearly one of procedure and practice under the rules, and is properly reviewable on petition.

Since the petition is to be considered under Rule 2.146(a)(1), the standard of review is simply "whether the examiner's judgment was a correct one." Stenographic Machines, Inc., 199 USPQ at 316; In re Societe des Establissements Lenotre, 223 USPQ 1159, 1160 (Comm'r Pats.1984). This standard of review is to be distinguished from the standard of review under subsections (a)(2) and (a)(3) of Rule 2.146, which require a petitioner to prove clear error or abuse of discretion. Stenographic Machines Inc., 199 USPQ at 316.

The Proper Signatory for Applicant Partnership

Section 1 of the Trademark Act is silent on the issue of who may sign on behalf of a partnership Applicant, and states that a trademark application must be "verified by the applicant, or by a member of the firm or an officer of the corporation or association applying ... and including a statement to the effect that the person making the verification believes himself, or the firm, corporation or association

in whose behalf he makes the verification, to be the owner of the mark sought to be registered, ... and that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use such mark in commerce ..." (emphasis added).

The Trademark Manual of Examining Procedure (TMEP), which serves to reflect Office policy and procedure, indicates that a partnership is considered a "firm," TMEP § § 802.02(b) and 802.03(b), and that an application filed by a partnership must be signed by one of the general partners, TMEP § 803.07. [FN2] Based upon this enumerated and widely-followed Office practice, it cannot be said that the Examining Attorney was "incorrect" in her determination to refuse acceptance of the application and Statement of Use as improperly executed.

Although there is no case law regarding the acceptability of verification of a trademark application by an "officer" of an Applicant partnership, there is precedent with respect to the proper signatory for a joint venture Applicant. In In re Hercofina, 207 USPQ 777 (TTAB 1980), the Trademark Trial and Appeal Board (Board) determined that a trademark application was properly executed by a "general manager" of a joint venture who had (1) full responsibility for the every-day management of the company and who had (2) express authority to execute applications to register trademarks.

***5** The Board noted that Section 1 of the statute gives little guidance with respect to the proper signatory for any entity not a sole proprietorship or corporation, and as a consequence, the Board advised that, for most other cases, consideration must be given to the "nature of the applicant" as shown by the "peculiar facts and personality" of each case. Hercofina, 207 USPQ at 782-83.

In Hercofina, a copy of a "Joint Venture Agreement" was made of record which expressly appointed various "officials" to serve on a venture-created "Board of Managers" which ran the daily operations of the venture. This agreement stated that the "general manager" was "the chief executive and operating official of the Venture" having "general charge of the business and property of the Venture and sufficient and adequate authority to be the day-to- day manager of the affairs of the Venture." In addition, the "general manager" was expressly authorized to "execute, make, amend, deliver, file and abandon foreign and domestic applications, for and relating to letters patent and trademark and copyright registrations...." Hercofina, 207 USPQ at 780-81.

Although the central issue in the Hercofina case dealt with who is the proper signatory for a joint venture, there is no doubt that the facts of Hercofina and the instant case are closely aligned. In the present situation, the Applicant partnership created a "Partnership Board" much like the "Board of Managers" for the Hercofina joint venture. Both Boards appear to have similar functions in that they are responsible for managing the daily operation of the business through appointed officials. In both cases these operating officials have been given duties that are analogous to those of officers of a corporation, and indeed have been given officer titles such as "President" (in Hercofina, 207 USPQ at 780, the "general manager" was later designated as "President" of the Board) and "Senior Vice President, General Counsel and Secretary." In addition, both signatories have been given explicit authorization to act on the company's behalf with respect to

any trademark filings, and both signatories have had the requisite personal knowledge regarding the use of the trademark.

Based upon the above analysis, it appears that the individual who signed both the application and Statement of Use was a proper signatory for Applicant partnership, and the documents were thus properly executed as required by Section 1 of the statute.

Accordingly, the petition is granted, and the application will be returned to the Examining Attorney for action consistent with this decision.

FN1. Although the Examining Attorney did not review the Request for Reconsideration before forwarding the application file to the Commissioner's Office for review of the petition, inasmuch as no new evidence was submitted with the request and because the Examining Attorney correctly following Office policy with respect to the issue of signatory authority, there is no need to remand the application to the Examining Attorney in this instance.

FN2. None of these sections of the TMEP cite to any supporting statutory authority or case law.

34 U.S.P.Q.2d 1778

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