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

RE: TRADEMARK REGISTRATION OF KABUSHIKI KAISHA FUJIMAK (FUJIMAK CORPORATION)
94-60
May 12, 1994
***1** Petition Filed: January 19, 1994

For: FUJIMAK
Registration No. 1,427,198
Issued: February 3, 1987

Robert M. Anderson

Acting Assistant Commissioner for Trademarks

On Petition

Kabushiki Kaisha Fujimak (Fujimak Corporation) has petitioned the Commissioner to reinstate Class 7, which was cancelled from the above identified registration for failure to meet the requirements of Section 8 of the Trademark Act. Trademark Rules 2.146(a)(3) and 2.165(b) provide authority for the requested review.

Facts

The subject registration issued on February 3, 1987, for the mark FUJIMAK, in International Classes 7 and 11. Pursuant to Section 8 of the Trademark Act, 15 U.S.C. § 1058, Registrant was required to file an affidavit or declaration of continued use or excusable nonuse between the fifth and sixth year after the registration date, i.e., between February 3, 1992 and February 3, 1993.

On February 3, 1993, Petitioner filed a combined declaration under Sections 8 and 15 of the Trademark Act, with respect to both classes. The Class 7 specimen was in the nature of a photocopy of a photograph of the goods, on which the mark was not visible. On February 11, 1993, Petitioner filed a supplemental communication, attaching "the original specimens of the facsimile copies previously submitted on February 3, 1993." By letter dated June 10, 1993, the Post Registration Affidavit Renewal Examiner notified Petitioner that acceptance of the declaration was withheld as to Class 7, because no proper specimen had been filed; that the Class 7 specimen filed February 3, 1993 did not show use of the mark; and that the substitute specimen filed February 11 was unacceptable because it was filed after the expiration of the statutory filing period. On January 18, 1994, the Examiner issued a notice stating that the declaration was accepted as to Class 11, and that Class 7 was to be cancelled.

This petition was filed January 19, 1994. Petitioner contends that the substitute specimen filed February 11, 1993 should be accepted pursuant to 37 C.F.R. § 2.162(e), which permits a registrant who has

submitted a deficient specimen to cure the deficiency after expiration of the sixth year following the registration date. The petition is supported by the declaration, under 37 C.F.R. § 2.20, of the Trademark Administrator who prepared the combined declaration for mailing to the Patent and Trademark Office, who asserts that the specimen filed February 11, 1993 was the original of the facsimile specimen filed February 3, 1993.

Decision

Section 8 of the Trademark Act, 15 U.S.C. § 1058, provides, in part:

[T]he registration of any mark under the provisions of this Act shall be cancelled 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).

***2** For the convenience of applicants and registrants, the Patent and Trademark Office permits the filing of certain papers by facsimile transmission, as well as the filing of facsimile copies and photocopies of documents by mail or by hand. TMEP § 702.04. However, a party who chooses to file a photocopy or facsimile copy of a document must satisfy all applicable requirements as of the time of filing. This means that the facsimile copy itself must, on its face, satisfy all such requirements. If a signature, word or other element of a facsimile copy of a document is not visible, it is deemed to have been omitted. Generally, the fact that the original from which the facsimile copy was made did show the missing element is irrelevant, unless the original is received in the Office within the statutory filing period.

Trademark Rule 2.162(e), 37 C.F.R. § 2.162(e), requires that the affidavit:

[s]tate that the registered mark is in use in commerce, list the goods or services recited in the registration on or in connection with which the mark is in use in commerce, and specify the nature of such commerce ... The statement must be accompanied by a specimen or facsimile, for each class of goods or services, showing current use of the mark. 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)."

While Trademark Rule 2.162(e) permits a registrant who has submitted a deficient specimen to cure the deficiency after the sixth year has expired, an omission of the required specimen cannot be cured after expiration of the sixth year. Because Section 8 of the Act and Trademark Rule 2.162(e) require the filing, within the statutory filing period, of a specimen showing current use of "the mark," a specimen that does not show the mark is, in effect,an omission of a specimen showing use of the registered mark. See In re Darnell, --- U.S.P.Q.2d -

--- (Comm'r Pats.1993) (copy attached).

Here, the specimen filed within the sixth year did not show the registered mark. Office practice has dictated that if the mark is not visible on the submitted specimen, the Post Registration Section will refuse to consider a substitute specimen unless there is time remaining in the statutory filing period. Thus, the Examiner did not err in refusing to consider the substitute specimen filed February 11, 1993.

However, Trademark Rule 2.146(a)(3) permits the Commissioner to invoke supervisory authority in appropriate circumstances. Henceforth, where an affidavit or declaration of continued use is accompanied by a photocopy or facsimile copy of a specimen on which the mark is not visible, the registrant will be given an opportunity to submit evidence that the original from which the photocopy or facsimile copy was made did show the mark. If the registrant submits an original specimen bearing the mark, together with an affidavit or declaration stating that the facsimile specimen filed within the sixth year was a true copy of said original, then the timely filed specimen will be treated as a "deficient" specimen that can be cured after expiration of the statutory filing period, pursuant to Trademark Rule 2.162(e). [FN1]

***3** In the instant case, Petitioner has satisfied these criteria. On February 3, 1993, Petitioner timely filed a specimen consisting of a photocopy of a photograph on which the mark was not visible. On February 11, 1993, after expiration of the statutory filing period, Petitioner supplemented the record with the original photograph bearing the mark, together with a statement that it was in fact the original photograph from which the timely filed facsimile specimen was made. Accordingly, the Section 8 declaration and the substitute specimen, taken together, satisfy the essential requirements for a declaration of continued use. The record now shows that the timely filed specimen was in fact a reproduction of a photograph showing the mark on the goods. The timely filed specimen was "deficient" because it was a poor copy on which the mark was not visible. The deficiency was cured by submission of the substitute specimen on February 11, 1993.

The petition is granted. The registration file will be forwarded to the Post Registration Section for further action in accordance with this decision.

FN1. The question of what constitutes a deficient specimen must be decided on a case by case basis by the Affidavit Renewal Examiner. If the Examiner determines that the original from which the timely filed facsimile specimen was made does not show the mark, or shows a materially altered mark, then the registrant will not be permitted to cure the deficiency after expiration of the statutory filing period.

33 U.S.P.Q.2d 1374

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