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

RE: TRADEMARK REGISTRATION OF ERIC DARNELL
93-199
September 30, 1993
***1** Petition Filed: May 20, 1993

For: Miscellaneous Design
Registration No. 1,395,408
Issued: May 27, 1986:

Robert M. Anderson

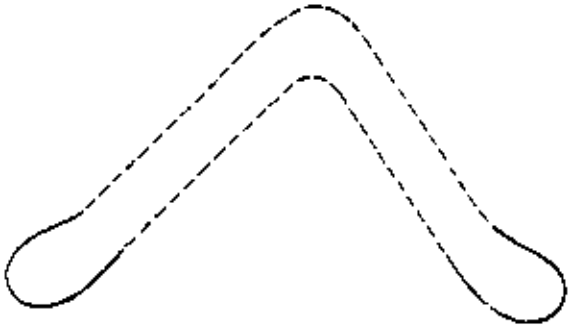
Acting Assistant Commissioner for Trademarks

On Petition

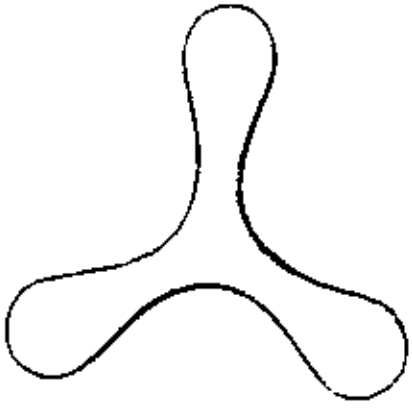
Eric Darnell has petitioned the Commissioner to reverse the Affidavit-Renewal Examiner's refusal to accept a Section 8 affidavit filed in connection with the above identified registration. Trademark Rules 2.146(a)(2) and 2.165(b) provide authority for the requested review.

The above registration issued May 27, 1986 on the Supplemental Register for a mark consisting of "a boomerang configuration with flared wing tips." 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 May 27, 1991 and May 27, 1992.

On May 27, 1992, petitioner filed a declaration of continued use of the mark, together with a specimen of current use of the mark. The registered mark and the mark shown on the specimen are set forth below:



Registered Mark



Mark Shown On Specimen

In an Office action dated August 31, 1992, the Affidavit-Renewal Examiner notified petitioner that acceptance of the affidavit was

withheld because the specimen did not show use of the mark shown in the registration. On September 30, 1992, petitioner filed a request for reconsideration, arguing that the specimen filed with the declaration did show use of the mark in the registration. The Examiner denied the request for reconsideration in an Office action dated November 17, 1992.

Petitioner filed a substitute specimen on December 23, 1992. In an Office action dated February 5, 1993, the Examiner advised petitioner that the substitute specimen could not be considered because it was filed after expiration of the sixth year following the date of registration. This petition was filed May 20, 1993.

Decision

Trademark Rule 2.146(a)(3) permits the Commissioner to invoke supervisory authority in appropriate circumstances. However, the Commissioner will reverse the action of an Examiner only where there has been a clear error or abuse of discretion. In re Richards-Wilcox Manufacturing Co., 181 USPQ 735 (Comm'r Pats.1974); Ex parte Peerless Confection Company, 142 USPQ 278 (Comm'r Pats.1964). No clear error or abuse of discretion has occurred in the instant case.

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). [FN1]

***2** 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)."

Because the statute requires that a specimen or facsimile showing current use of the mark be filed within the prescribed period, an omission of the required specimen cannot be cured after expiration of the sixth year. Trademark Manual of Examining Procedure (2nd ed. 1993) § 1603.08.

Pursuant to Trademark Rule 2.162(e), a registrant who has submitted a deficient specimen with a Section 8 affidavit may cure the deficiency

after the sixth year has expired. For example, a registrant who submits an advertisement as a specimen of trademark usage of a mark for goods may cure the deficiency after the sixth year has expired, as long as the advertisement pertained to the same goods recited in the registration. In re Brittains Tullis Russell, Inc., 23 U.S.P.Q.2d 1457 (Comm'r Pats.1992). However, a specimen showing use of the mark on or in connection with different goods or services cannot be cured after expiration of the sixth year. In re City Holdings, Inc., --- U.S.P.Q.2d ---- (Comm'r Pats.1993); In re Metrotech, --- U.S.P.Q.2d ---- (Comm'r Pats.1993) (copies attached).

Nor can a specimen that shows use of a different or materially altered mark 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 showing use of a different mark is, in effect, an omission of a specimen showing use of the registered mark.

In this case, the mark in the registration consists of a two-armed, boomerang shaped object with wing tips that are curved and flared outwardly whereas the mark on the specimen filed with the declaration consists of a three-armed, propeller shaped object with wing tips that are semi-circular and symmetrical. The overall impressions of the two configurations are dramatically different. Accordingly, the Affidavit-Renewal Examiner reasonably concluded that petitioner had not submitted a specimen of current use of the registered mark prior to the expiration of the sixth year following the registration date.

***3** Having determined that the specimen filed within the sixth year evidenced use of a mark that differed materially from the registered mark, the Examiner did not err or abuse her discretion in refusing to consider the substitute specimen filed after the sixth year had expired.

The petition is denied. The registration will be cancelled in due course.

FN1. Petitioner contends that Section 8 of the Act requires only a "showing," and not a specimen, of current use of the mark. Prior to the Trademark Law Revision Act of 1988, implemented on November 16, 1989, Section 8 contained no express requirement that the affidavit include a specimen of current use. However, effective November 16, 1989, Section 8 was amended to add a requirement that the affidavit include a "specimen or facsimile showing current use of the mark."

33 U.S.P.Q.2d 1372

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