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

RE: TRADEMARK REGISTRATION OF CAPP ENTERPRISES, INC.
93-37
June 7, 1993
***1** Petition Filed: November 13, 1992

For: FEARLESS FOSDICK
Registration No. 561,332
Renewed: July 15, 1972
Issued: July 15, 1952

Robert M. Anderson

Acting Assistant Commissioner for Trademarks

On Petition

Capp Enterprises, Inc. has petitioned the Commissioner to renew the above identified registration. Trademark Rules 2.146(a)(2), 2.146(a)(5), 2.148and 2.184(b) provide authority for the requested review.

Facts

The above registration issued on July 15, 1952, for the mark FEARLESS FOSDICK for "comic drawings, published in daily and Sunday newspapers." The registration was renewed on July 15, 1972. Pursuant to Section 9 of the Trademark Act, an application for second renewal of the registration was due to be filed within the six months preceding July 15, 1992, or, on payment of a late fee, within the three month grace period following that date.

On February 18, 1992, petitioner filed a renewal application stating that the mark is still in use in interstate commerce on the goods recited in the registration, along with a specimen showing the mark currently used. The specimen was in the nature of a book containing reproductions of comic drawings. By letter dated June 12, 1992, the Affidavit-Renewal Examiner notified petitioner that renewal was withheld because the specimen showed use of the mark on goods different from those identified in the registration. Petitioner was advised that it must file a new specimen prior to expiration of the period for which the registration was issued or renewed, or within the grace period thereafter with a late fee of $100 per class.

Petitioner filed a request for reconsideration of the refusal of renewal on June 30, 1992. The Affidavit-Renewal Examiner denied the request for reconsideration in a letter dated September 30, 1992. Petitioner was advised that the registration was expired and that any request for relief was limited to a petition to the Commissioner.

On October 8, 1992, petitioner filed a request to amend the identification of goods to "reproductions of comic drawings, published

in daily and Sunday newspapers." By letter dated June 1, 1993, the Post Registration Applications Examiner notified petitioner that the proposed amendment could not be entered, because it represents a broadening of the description of goods. Section 7(e) of the Trademark Act, 15 U.S.C. § 1057(e). Petitioner was advised that the amendment was defective for the additional reasons that it was neither verified by the registrant, nor accompanied by the required fee. 15 U.S.C. § 1057(e); 37 C.F.R. § § 2.6(a)(11) and 2.173(a).

This petition was filed November 13, 1992. Petitioner asserts that the mark is no longer used on comic drawings published in daily and Sunday newspapers, but is now used on reproductions of comic drawings; that the proposed amendment is a clarification of the existing identification of goods and as such is permissible pursuant to 37 C.F.R. § 2.71(b); [FN1] and that the proposed amendment would not affect the right of the public to make business decisions concerning likelihood of confusion.

Standard of Review

***2** Trademark Rule 2.146(a)(3) permits the Commissioner to invoke his 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 Co., 142 USPQ 278 (Comm'r Pats.1964). No clear error or abuse of discretion has occurred in the instant case.

Refusal of Renewal of the Registration

Section 9 of the Trademark Act, 15 U.S.C. § 1059, requires that an application for renewal of a registration be filed within six months prior to the expiration of the period for which the registration was issued or renewed or, on payment of a late fee, within the three month grace period following that date. A complete renewal application must include, inter alia, a statement of the goods or services for which the mark is being used, and a specimen showing how the mark is currently used. In re Culligan International Co., 915 F.2d 680, 16 U.S.P.Q.2d 1234 (Fed.Cir.1990); In re Holland American Wafer Co., 737 F.2d 1015, 222 USPQ 273 (Fed.Cir.1984). The purpose of the renewal specimen is to aid the Patent and Trademark Office in determining whether or not the registered mark is still in use in commerce. In re. E.M. Townsend & Co., 143 USPQ 318 (Comm'r Pats.1964).

The goods identified in a renewal application must be the same as those recited in the registration. Goods not recited in the registration cannot be included in the application for renewal. If the wording of the identification in the renewal application is not precisely the same as that set forth in the registration, it may be regarded as representing different goods or services. Trademark Manual of Examining Procedure § 1605.08.

It follows that the renewal specimen must show use of the mark on the

same goods or services that are identified in the registration. A specimen evidencing use of the mark on different goods or services does not meet the requirements of the statute. This is true even if the specimen evidences use of the mark on goods or services that are closely related to those recited in the registration.

In this case, the registration covers only "comic drawings, published in daily and Sunday newspapers," but the renewal specimen shows use of the mark on "reproductions of comic drawings ..." in book form. The Affidavit-Renewal Examiner reasonably concluded that the specimen showed use of the mark on goods different from those recited in the registration. Therefore, the refusal to renew the registration was proper.

Propriety of Section 7 Amendment

While petitioner has not requested review of the Examiner's adverse action on its proposed amendment, the Commissioner shall exercise his supervisory authority under 37 C.F.R. § 2.146(a)(3) to review such action, because the proposed amendment was submitted in response to the refusal of renewal which is the subject of the petition.

***3** The standards for determining the propriety of an amendment to the identification of goods under Section 7 are the same as those used for determining whether a renewal specimen shows use of the mark on the goods identified in the registration. If a renewal specimen shows use of a mark on goods which are different from those recited in the registration, then the renewal application must be rejected. Similarly, if a request for amendment of a registration's identification sets forth goods that are different from those in the registration, then the request for amendment must be denied.

While Section 7(e) of the Act and Trademark Rule 2.173 permit amendment of a registration to restrict the scope of the identified goods or services, amendments which broaden the scope of goods or services identified in the registration are impermissible. In re Carter Hawley Hale Stores, Inc., 200 USPQ 179 (Comm'r Pats.1978).

In this case, it is not disputed that the renewal specimen evidences use of the mark on goods that are closely related to the goods recited in the registration. However, the goods are simply not the same. Since "reproductions of comic drawings, published in daily and Sunday newspapers" does not encompass reproductions of the comic drawings in book form, the Examiner did not err or abuse her discretion in refusing to amend the mark.

Petitioner asserts that it is no longer using the mark for comic drawings published in daily and Sunday newspapers because the creator of the drawings has passed away and is no longer producing the drawings for publication in newspapers. However, an amendment to a registration which is not otherwise permissible cannot be rendered acceptable simply because of changed circumstances. If the focus of petitioner's business has changed, it is free to file a new application for registration of the mark on or in connection with the goods on which the mark is now used.

The petition is denied. The registration file shall be forwarded to the Post Registration Section for notation on the file and entry in the TRAM (Trademark Reporting and Monitoring) System that the registration has expired.

FN1. 37 C.F.R. § 2.71(b) pertains only to amendment of applications for registration of marks. Amendment of registrations is governed by 15 U.S.C. § 1057 and 37 C.F.R. § 2.173.

32 U.S.P.Q.2d 1855

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