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

RE: TRADEMARK REGISTRATION OF METROTECH
92-161(R)
February 11, 1993
***1** Request for Reconsideration Filed: November 12, 1992

For: METROTECH
Registration No. 1,330,038
Issued: April 9, 1985

J. David Sams

Acting Assistant Commissioner for Trademarks

On Request For Reconsideration

Metrotech has requested reconsideration of the Commissioner's decision dated September 13, 1992, denying its petition to reinstate Class 37 and Class 42 services which have been cancelled in the above-identified registration. Although the Trademark Rules do not specifically provide for requests for reconsideration of decisions on petitions, such requests may be considered pursuant to Trademark Rule 2.146(a)(3), 37 C.F.R. § 2.146(a)(3).

Facts

The above registration issued on April 9, 1985 for services in three classes. 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 April 9, 1990 and April 9, 1991.

On April 5, 1991, petitioner filed a combined declaration under Sections 8 and 15 of the Trademark Act. Accompanying the combined declaration was one original specimen and two copies thereof of an advertisement from the real estate section of a newspaper. The advertisement reads:

METRO TECH BROOKLYN

VAULTED CLIMATE CONTROL HIGH SECURITY BUILDING

Situated at MetroTech Brooklyn, State of the art facility, 25,000 Sq. Ft (approx.). Full climate control, fire proof, 15 two tiered vaults on three floors of concrete and steel building. Brand new 40 tons cooling system, humidity control, fumigation, sterilizing and fresh air circulation system, smoke detection with CO sub2 dry gas fire suspension system, extensive security alarm system, recently stored

items value to $300,000,000 (three hundred million). Extremely low insurance rates due to unique nature of building.

Could be used for any high security storage, computer data, films, records, valuable stocks, documents, legal tender, fine arts, antiques, museums' storage, wines, furs, jewelry exchange or bank use. Main floor beautiful art deco finish, high ceilings, could be used for retail trade or customer service. Available each floor (approx. 8000 sq. ft.) or entire building. Immediate occupancy, below market rate, lease or sale. Brokers protected.

CALL MR. SHAH AT 212-560-0193

In a letter dated August 21, 1991, the affidavit/renewal examiner refused the combined declaration for the recited services of "planning and layout of technology centers," in Class 37, and "design of technology centers," in Class 42, because the specimens only supported use of the mark for the recited services of "leasing a technological center and providing support services therefore (sic)" in Class 36. The affidavit/renewal examiner stated that if petitioner believed the specimens showed use of the mark for the recited Class 37 and Class 42 services, petitioner should submit an explanation. The letter also stated that if no response was received within six months, Classes 37 and 42 would be cancelled from the registration.

***2** A memo to the file by the affidavit/renewal examiner indicates that, on February 3, 1992, she had a telephone conversation with petitioner wherein petitioner agreed to the canceling of the Class 37 and Class 42 services in order that an acceptance notice could issue with respect to the recited Class 36 services. On February 6, 1992, the Class 37 and Class 42 services were cancelled and the combined declaration was accepted with respect to the recited Class 36 services.

However, on February 11, 1992, the Patent and Trademark Office received a written response from petitioner arguing that the specimens were "sufficient to show use of the word METROTECH in the general services of all classes although it is acknowledged that the ad does not make specific references to these services." Petitioner also submitted new specimens. [FN1] In a letter dated March 12, 1992, the affidavit/renewal examiner stated that petitioner had agreed during the telephone conversation of February 3, and also in the response received February 11, that specimens were not filed before the expiration of the sixth year following registration which show use with respect to Classes 37 and 42.

On May 18 and May 21, 1992, petitioner filed petition papers requesting that the decision of the affidavit/renewal examiner be reversed or that the rules be suspended in order to accept the combined declaration for all three classes. In a decision dated September 13, 1992, the Commissioner denied the petition, holding that the combined declaration had been properly denied. Petitioner filed the request for reconsideration on November 12, 1992.

Analysis

Section 8 of the Trademark Act requires that an affidavit or declaration of continued use be accompanied by a specimen showing current use of the mark. While the Act does not actually state a "per-class" specimen requirement, Trademark Rule 2.162(e), 37 C.F.R. § 2.162(e), does state that the affidavit or declaration must "be accompanied by a specimen or facsimile, for each class of goods or services, showing current use of the mark." (emphasis added) This rule was amended, effective November 16, 1989, to implement the Section 8 provisions of the Trademark Law Revision Act of 1988, Section 110 of Pub.L. 100-667. See 54 Fed.Reg. 19,301 (1989).

Notice of the statutory requirement that a specimen of current use be attached to a Section 8 affidavit or declaration was printed in the Official Gazette on July 11, 1989. The notice was entitled "Section 8 Requirements For Trademark Registrations" and stated, in part:

> If the registrant fails to file, before the end of the sixth year following registration, an affidavit or declaration that includes a proper specimen or facsimile for each class of goods or services to which the registration pertains, the registration will be cancelled as to that class of goods or services. After the end of the sixth year following registration, the Patent and Trademark Office will not accept a substitute Section 8 affidavit or declaration filed to correct the omission of a proper specimen or facsimile. (emphasis added) 1104 TMOG 19 (July 11, 1989).

***3** Office practice permits acceptance of a single specimen for more than one class of goods or services if the specimen evidences use of the mark for the relevant goods or services in the different classes. In re Home Fashions, Inc., 21 U.S.P.Q.2d 1947 (Comm'r Pats.1991). The Commissioner in In re Home Fashions specifically noted that:

> When an insufficient number of specimens is submitted with a Section 8 affidavit or declaration for a multi-class registration, cancellation of classes in excess of the number of specimens submitted will no longer be automatic. If the specimens that are submitted, on their face, clearly evidence continuing use of the mark for goods or services in each of the classes covered by the registration, then no classes will be cancelled solely due to an insufficiency in the number of specimens. (emphasis added) (Case at 1950.)

In the request for reconsideration, petitioner argues that the subject specimens support "the additional services since support services for technology centers impliedly include 'planning and layout of technology centers' and 'design of technology centers'." However, this argument is inapposite. Even assuming arguendo that the ambiguous phrase "support services" has a nexus with the specifically-recited Class 37 and Class 42 services, the "support services" language that petitioner wishes to rely upon does not come from the specimens. Instead, reference to this language is only found within the identification of the services appearing on the registration certificate.

While people would understand from the specimen advertisement that a preexisting building is offered for lease or sale, they would neither associate the mark [FN2] with the offering of customized services identified as "design of technology centers," e.g., architectural services for others, in Class 42, [FN3] nor with "planning and layout

of technology centers" for others in Class 37. [FN4]

Petitioner also argues that it "is entitled to submit substitute specimens." While Rule 2.162(e) provides for the submission of a substitute specimen where a timely-filed specimen for a class is "deficient," the omission altogether of a specimen for a particular class cannot be cured after expiration of the statutory period for filing the Section 8 affidavit or declaration. Moreover, Trademark Manual of Examining Procedure (TMEP) § 1603.07, cited by petitioner, has been superseded by the Trademark Law Revision Act of 1988, amended Rule 2.162 and the Official Gazette notice of July 11, 1989, discussed above. [FN5]

Petitioner also relies upon In re Brittains Tullis Russel Inc., 23 U.S.P.Q.2d 1457 (Comm'r Pats.1992), a case which primarily dealt with the identification of goods, but which also permitted substitute specimens--labels for goods--where a sales brochure and price list had been submitted originally.

Brittains Tullis is distinguishable from the present case because the specimen sales brochure and price list affirmed that the mark was in use for the recited Class 16 paper goods and, thus, the registrant had submitted a specimen for Class 16 within the per-class requirement of Rule 2.162(e). The specimens were found to be technically "deficient" within the meaning of the rule as they did not "show use of the mark on or in connection with the goods as they are sold or shipped in commerce." Case at 1459. Hence, the substitute label specimens could be accepted. In contrast, petitioner omitted altogether filing specimens in support of the Class 37 and Class 42 services before the expiration of the statutory filing period. The specimens that petitioner did submit within this period did not show any association between the mark and the recited Class 37 and Class 42 services. [FN6]

***4** Petitioner filed the subject specimens with its combined declaration just four days before the end of the statutory period. Because the specimens, filed before the end of the sixth year, evidence use of the mark for the recitedClass 36 services only, petitioner did not comply with the statutory requirement for timely filing specimens to support the recited Class 37 and Class 42 services.

Inasmuch as no new facts or persuasive arguments have been raised by petitioner, the request upon reconsideration is denied.

FN1. Petitioner has not verified that these specimens were in use in commerce prior to the expiration of the sixth year.

FN2. See infra note 6.

FN3. Class 42 covers "services rendered ... requiring a high degree of mental activity and relating to theoretical or practical aspects of complex branches of effort ... demand[ing] ... deep and extensive university education or equivalent experience; such services rendered by representatives or professionals such as engineers, chemists, physicists, etc...." World Intellectual Property Law Organization,

International Classification of Goods and Services for the Purposes of the Registration of Marks, at Part I, 27 (5th ed. 1987).

FN4. Class 37 "includes mainly services rendered by contractors or subcontractors in the construction or making of permanent buildings...." World Intellectual Property Law Organization, International Classification of Goods and Services for the Purposes of the Registration of Marks, at Part I, 23 (5th ed. 1987).

FN5. The dated TMEP section, cited by petitioner, also states a per-class requirement: "There must be such a 'showing' as to each class on which action is sought in the registration."

FN6. The requirements for a service mark specimen differ from the requirements for a trademark specimen for goods. Implicit in the statutory definitions of a "service mark" and "use in commerce" is the requirement that there be an association between the mark and the services, i.e., that the mark be used in such a manner that it would be readily perceived as identifying the source of such services. See generally In re Universal Oil Products Co., 167 USPQ 245 (TTAB1970), aff'd 177 USPQ 456, 457 (CCPA1973); In re Advertising and Marketing Development Inc., 821 F.2d 614, 2 U.S.P.Q.2d 2010 (Fed.Cir.1987); In re Duratech Industries Inc., 13 U.S.P.Q.2d 2052 (TTAB1989); In re Moody's Investors Service Inc., 13 U.S.P.Q.2d 2043 (TTAB1989); In re Brown & Portillo, Inc., 5 U.S.P.Q.2d 1381 (TTAB1987); In re Hughes Aircraft Company, 222 USPQ 263 (TTAB1984); In re Vsesoyuzny Ordena Trudovogo Krasnogo Znameni Nauchoissledovatelsky Gorno-Metallurgichesky Institut Tsvetnykh Metallov "Vnitsvetmet," 217 USPQ 70 (TTAB1983), aff'd, 219 USPQ 69 (TTAB1983); In re J.F. Pritchard and Company and Kobe Steel, Ltd., 201 USPQ 951 (TTAB1979). See also Reddy Communications v. Environmental Action Foundation, 477 F.Supp. 936, 203 USPQ 144, 151 (D.D.C.1979); In re Walker Research, Inc., 228 USPQ 691 (TTAB1986); In re Information Builders Inc., 213 USPQ 593 (TTAB1982); In re Wataburger Systems, Inc., 209 USPQ 429 (TTAB1980).

33 U.S.P.Q.2d 1049

END OF DOCUMENT