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

RE: TRADEMARK REGISTRATION OF RUTH L. RATNY
Registration No. 1,134,824
May 13, 1992
***1** Petition Filed: January 23, 1992

For: CLIO
Issued: May 6, 1980

Petitioner, pro se: Clio Enterprises, Inc.

Attorney for Assignee

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Jeffrey M. Samuels

Assistant Commissioner for Trademarks

On Petition

Clio Enterprises, Inc. has petitioned the Commissioner for a "declaration of interference" between itself and Ruth L. Ratny, an individual claiming ownership of the above identified registration by assignment from petitioner. Trademark Rule 2.146(a)(3) provides authority for the requested review.

Facts

The registration was issued to petitioner on May 6, 1980. On November 1, 1991, Ruth L. Ratny recorded with the Assignment Branch of the Office a document purporting to be an assignment, dated September 27, 1991, in which petitioner, Clio Enterprises, Inc., assigns all rights, title and interest in and to the registered mark to Ruth L. Ratny or her nominee. The document appears to have been executed by William Evans as president of Clio Enterprises, Inc., in the form of a notarized affidavit.

The document was first submitted for recordation on or about September 30, 1991. In a communication dated October 24, 1991, the Assignment Branch of the Office notified the claimed assignee that the document had been examined and found non-recordable, because it had not been certified by a notary public to be a true copy of an original document. The document was resubmitted for recordation on November 1, 1991, accompanied by a notarized "Certification," that "the attached is a true and accurate copy of the original assignment ... dated September

27, 1991," signed by the claimed assignee of the registration, Ruth L. Ratny.

This petition was filed January 23, 1992. The petition contains the affidavit of petitioner's Secretary, Wayne Deas, who asserts that commencing in August, 1991, petitioner had entered into negotiations with Ruth Ratny for the sale of petitioner's stock or assets; that during the ensuing weeks, various drafts of intent and proposed contracts were exchanged by the parties and their respective attorneys; that no deal was ever finalized; that in late September, because of petitioner's financial difficulties, Ratny questioned whether petitioner still owned the mark; that in order to assuage Ratny's fears, petitioner's president, William Evans, sent Ratny via facsimile "what he believed to be proof that petitioner retained its rights to use of the mark;" that the document Evans faxed was a copy of an assignment that had been attached to one of the proposed contracts submitted by Ratny to petitioner; that Evans never delivered the original assignment, nor did he intend to assign the mark; and that, unbeknownst to petitioner, Ratny submitted the copy of the assignment to the PTO for recordation as a valid assignment. Petitioner contends that the assignment was not properly recorded, because it is neither an original document nor certified to be a true copy of the original.

Decision

***2** Section 16 of the Trademark Act, 15 U.S.C. § 1066, provides for the declaration of an interference proceeding under extraordinary circumstances, where an application is made for the registration of a mark which is likely to be confused with a mark previously registered, or with a mark for which another has previously made application. The provisions of Section 16 are operative only in a situation where there exists a likelihood of confusion involving a mark which is the subject of a pending application for registration of a mark. There is no provision in the Trademark Act or the Trademark Rules of Practice for the declaration of an "interference" to determine questions of ownership of a registered mark.

Because the requested "declaration of interference" is an inappropriate remedy, the petition will be considered as a petition to expunge an assignment from the records of the Assignment Branch of the Office. Trademark Rule 2.146(a)(3) provides the Commissioner with the authority to review the actions of the Assignment Branch of the Office in regard to its recording of documents, and to invoke supervisory authority in appropriate circumstances.

Petitioner correctly asserts that this Office will record only an original document or a legible certified copy of an original. If a document submitted for recording is not the original instrument, it must be certified, either in the form of a notarized affidavit or a declaration under 37 C.F.R. § 2.20, that the document is a true copy of the original. Trademark Manual of Examining Procedure § 501.05(a). See notice at 836 O.G. TM 145 (March 28, 1967).

In the instant case, notwithstanding petitioner's contentions to the contrary, the document submitted for recordation on November 1, 1991

was in fact certified by the claimed assignee in a notarized affidavit to be "a true and accurate copy of the original assignment of the registered mark CLIO from Clio Enterprises, Inc. to Ruth L. Ratny, dated September 27, 1991." Petitioner itself submitted a copy of the certification as its Exhibit B. Accordingly, the Assignment Branch did not err by recording the document.

The mere act of recording a document is a ministerial act. The Assignment Branch does not examine the substance of the transaction or inquire into the intent of the parties. If the document appears on its face to be an assignment, then it may be recorded.

Acceptance of a document for recordation does not mean that the Office has made a determination of ownership of the mark. The Office will determine ownership only if the claimed assignee attempts to take an action in an Office proceeding that can be taken only by the owner of the registration. For example, if an assignee files an application to renew a registration, the Examiner of Trademarks must determine whether the renewal applicant is the current owner of the registered mark. Trademark Manual of Examining Procedure § 502.

***3** Office policy regarding the recording of documents is directed toward maintaining a complete history of claimed interests in a mark. Therefore, an assignment which is properly recorded will not be expunged, even if it is subsequently found to be invalid. Since the act of recording a document is not a determination of the document's validity, maintaining a complete record of claimed interests does not preclude a party from using a mark, or from establishing its ownership of the mark in a proper form, such as a federal court. [FN1]

If there is any error in a recorded document, it is the responsibility of the registrant to clarify the record, usually by recording another document which explains and corrects any inconsistency or inaccuracy in the record chain of title. In re Abacab International Computers Ltd., 21 U.S.P.Q.2d 1078 (Comm'r Pats.1987). For example, petitioner herein could file for recordation of an affidavit stating that the document recorded on November 1, 1991, is not a true copy of an original assignment, and that the mark has never been assigned. [FN2]

The petition is denied.

FN1. A final court order relating to ownership of a registration could be recorded in the PTO.

FN2. If petitioner submits such an affidavit, along with the required fee and a copy of this decision, the Assignment Branch is directed to accept it for recordation as a document relating to title.

24 U.S.P.Q.2d 1713

END OF DOCUMENT