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

RE: TRADEMARK REGISTRATION OF THE BONNEAU COMPANY
January 2, 1992
***1** Petition Filed: March 12, 1991

For: OPTI-CLIPS
Registration No. 615,752
Renewed: November 8, 1975
Issued: November 8, 1955

For: SUN SNOOZERS
Registration No. 642,912
Renewed: March 19, 1977
Issued: March 19, 1957

For: OPTI-CLIPOVER
Registration No. 666,855
Renewed: September 9, 1978
Issued: September 9, 1958

For: FOSTER GRANT
Registration No. 703,527
Renewed: August 30, 1980
Issued: August 30, 1960

For: COMFORMATIC
Registration No. 872,979
Expired: July 15, 1989
Issued: July 15, 1969

For: THE SUNFIGHTERS
Registration No. 903,493
Expired: December 1, 1990
Issued: December 1, 1970

For: AQUA-MATES
Registration No. 904,720
Renewed: December 22, 1990
Issued: December 22, 1970

For: EYE FLYERS
Registration No. 923,781
Issued: November 16, 1971

For: CRYSTAL GAZERS
Registration No. 925,092
Issued: December 7, 1971

For: MOOD MODULES and design
Registration No. 930,481
Issued: March 7, 1972

For: FF77 IMPACT
Registration No. 940,469
Issued: August 8, 1972

For: THE YOUNG WORLD OF FOSTER GRANT
Registration No. 959,802
Issued: May 29, 1973

For: THE GREAT IMPERSONATORS
Registration No. 960,848
Issued: June 12, 1973

For: THE MOOD MAKERS
Registration No. 960,849
Issued: June 12, 1973

For: ALUMIN-EYES
Registration No. 964,154
Issued: July 17, 1973

For: AUTO-FLIPS
Registration No. 986,405
Issued: June 18, 1974
Cancelled: December 9, 1980

For: Design
Registration No. 993,392
Issued: September 24, 1974

For: FG FG FG and design
Registration No. 995,260
Issued: October 8, 1974

For: ISN'T THAT YOU BEHIND THOSE FOSTER GRANTS
Registration No. 1,147,544
Issued: February 24, 1981

For: FG (stylized)
Registration No. 1,156,236
Issued: June 2, 1981

For: SPEC 1000
Registration No. 1,253,656
Issued: October 11, 1983

For: FOSTER GRANT
Registration No. 1,255,021
Issued: October 25, 1983

For: FG (stylized)
Registration No. 1,264,781
Issued: January 24, 1984
Cancelled: May 18, 1981

For: FOSTER GRANT
Registration No. 1,303,854
Cancelled: March 4, 1991
Issued: November 6, 1984

For: SPS SOLAR PROTECTION SYSTEM

Registration No. 1,335,232
Issued: May 14, 1985

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On Petition

The Bonneau Company [FN1] has petitioned the Commissioner to order the Assignment Division of the Patent and Trademark Office to record a trademark assignment from the Bank of New York Commercial Corporation in favor of the Foster Grant Corporation with respect to the above identified registrations. Trademark Rule 2.146(a)(3) provides authority for the requested review.

Facts

Petitioner states that it submitted a document entitled "Trademark Assignment" to the Assignment Division for recordation on January 17, 1991. On February 21, 1991, the Assignment Division returned the document to petitioner, stating that it was found non-recordable because "[i]ndexing is not permitted against a previously recorded assignment."

***2** This petition was filed March 12, 1991. In an unverified statement made through its attorney, [FN2] petitioner asserts that it is the purchaser for value of the above identified registrations; that its predecessor in interest, the Foster Grant Corporation (FGC), had entered into a Loan and Security Agreement with the Bank of New York Commercial Corporation (Bank) whereby the Bank was granted a security interest in the registrations; that said loan agreement was recorded in the Patent and Trademark Office; that the Bank had released its lien on the trademarks and reassigned its rights in the marks to FGC, as evidenced by a Trademark Assignment dated December 14, 1990. It is this Trademark Assignment which petitioner now seeks to record. A photocopy of the Assignment, signed by the Bank as assignor, was enclosed with this petition. Also enclosed with the petition was a "Schedule," which lists each of the above registrations by registration number, mark and registration date. [FN3]

On December 6, 1991, petitioner supplemented its petition with (1) a photocopy of the Trademark Assignment which it seeks to record, certified in a declaration under 37 C.F.R. § 2.20 by petitioner's attorney to be a true copy of the original document; and (2) a list of

the trademarks which are referenced in the Trademark Assignment, said list having been previously recorded at Reel 520, Frames 724 and 725.

Registration Nos. 872,979, 903,493, 986,405, 1,264,781 and 1,303,854

The records of the Patent and Trademark Office show that Registration Nos. 986,405, 1,264,781 and 1,303,854 have been cancelled, pursuant to Section 8 of the Trademark Act, for failure to file an affidavit of continued use of the mark in commerce. Office records also indicate that Registration Nos. 872,979 and 903,493 have expired, since they were not timely renewed pursuant to the provisions of Section 9 of the Act. Accordingly, the question presented in this petition is moot with respect to these registrations. The Office does not record documents with reference to cancelled or expired registrations. Further consideration of this petition will be in relation to the remaining registrations.

Decision

Under Trademark Rule 2.185, 37 C.F.R. § 2.185, the Assignment Division may record: (1) assignments, as provided for under Section 10 of the Trademark Act, of registered marks or marks for which an application for registration has been filed, and (2) other instruments which may relate to such marks, in the discretion of the Commissioner.

The document which petitioner seeks to record is a "Trademark Assignment" dated December 14, 1990, by the Bank of New York Commercial Corporation as Assignor, in favor of Foster Grant Corporation as Assignee. The assignment document recites that:

> Assignee previously executed and delivered its Term Note (the "Note") to Assignor for the principal sum of $3,000,000.00 and entered into a Loan and Security Agreement--Accounts Receivable, Inventory and Equipment dated March 14, 1986, between Assignor and Assignee (as amended from time to time, the "Loan Agreement"). In order to induce the Lender to execute and deliver the Loan Agreement and accept the Note, Assignee assigned to Assignor certain trademark rights pursuant to that certain Trademark Collateral Assignment dated March 14, 1986 and made by Assignee in favor of Assignor which was recorded in the Patent and Trademark Office on March 24, 1986 in Reel 0520 Frame 713-725 (the "Trademark Assignment").

***3** The document further provides, in part, that:

> 1. Assignor, without representation or warranty of any kind, hereby reassigns and conveys to Assignee all of its right, title and interest in to the trademark applications and trademarks listed on Schedule A of the Trademark Assignment together with the goodwill of the business to which each of the Trademarks relates and all of its other rights and interests under the Trademark Assignment ...

Pursuant to Trademark Rule 2.185(a)(1), in order to be recorded, an assignment document must identify a trademark application or registration by number. Office practice permits a party who seeks to record an assignment document to identify the relevant application or registration numbers in a cover letter or exhibit submitted

concurrently with the assignment document.

The procedure in the Assignment Division of the Office which is referred to as "indexing" is not available for assignments. That is, application serial numbers and registration numbers may not be submitted later for "indexing" or "cross-referencing" against a previously recorded assignment, unless approved by the Commissioner by way of petition under Trademark Rule 2.146. Trademark Manual of Examining Procedure § 501.11. Nor may applications or registrations be identified in an assignment document by merely incorporating by reference the applications or registrations set forth in a previously recorded document.

The record herein indicates that the documents filed with the Assignment Division for recordation on January 17, 1991 identified the registration numbers to which the assignment document pertained only by reference to the document "recorded in the Patent and Trademark Office on March 24, 1986 in Reel 0520 Frame 713-725." Such a reference does adequately identify the registrations assigned, and, as such, does not satisfy the requirements of Rule 2.185(a)(1). Accordingly, it cannot be said that the Assignment Division clearly erred in refusing to record the assignment document.

There is another reason, not raised by the Assignment Division, why the document submitted for recordation on January 17, 1991, was not recordable. 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, the required certification is to the fact that the document submitted is a true copy of the original and is made by a notary public or by a declaration under 37 C.F.R. § 2.20. Trademark Manual of Examining Procedure § 501.05(a). See notice at 836 O.G.TM 145 (March 28, 1967). The "Trademark Assignment" filed on January 17, 1991 was neither an original document, nor had it been certified to be a true copy of an original.

However, the petition papers filed herein, as supplemented December 6, 1991, include a copy of a Trademark Assignment which is certified in a declaration under 37 C.F.R. § 2.20 to be a true copy of the original, as well as a list of the registrations to which the assignment relates. As such, petitioner has now shown the Trademark Assignment to be recordable.

***4** The petition is granted. The Trademark Assignment submitted December 6, 1991, along with the "Certification" submitted therewith, and the Schedule which identifies the registrations by number will be forwarded to the Assignment Branch for recordation.

FN1. The records of this Office show title to Registration Nos. 872,979 and 1,264,781 in Foster Grant Corporation.

FN2. Rule 2.146(c) requires that, when facts are to be proved in ex parte cases, proof in the form of affidavits or declarations in accordance with § 2.20 shall accompany the petition.

FN3. It does not appear that this "Schedule" was included with the documents submitted to the Assignment Division for recordation on January 17, 1991. On December 6, 1991, petitioner's counsel submitted a statement that while the "Schedule" submitted with the petition on March 12, 1991 is not the "Schedule A" referenced in the assignment document, "Schedule A" does encompass all the registrations identified in the "Schedule" submitted with the original petition.

23 U.S.P.Q.2d 1455

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