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

RE: TRADEMARK REGISTRATION OF BRITTAINS TULLIS RUSSELL, INC.
91-113
September 19, 1991
***1** Petition Filed: March 20, 1991

For: DECAFLAT
Registration No. 1,287,925
Issued: July 31, 1984

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On Petition

Brittains Tullis Russell, Inc. has petitioned the Commissioner for permission to file a substitute for a previously-filed declaration of continuing use of a mark, following the close of the statutory filing period. Review of the petition is undertaken pursuant to Trademark Rules 2.146(a)(3), 37 C.F.R. § 2.146(a)(3), and the general supervisory authority of the Commissioner.

The registration in question issued to Brittains Papers, Inc. on July 31, 1984. Pursuant to Section 8 of the Trademark Act, 15 U.S.C. § 1058, registrant was required to file, between July 31, 1989 and July 31, 1990, an affidavit or declaration either (1) attesting to continued use of the mark in commerce, or (2) admitting nonuse and explaining the circumstances which made nonuse excusable. On July 16, 1990, petitioner filed a combined declaration under Sections 8 and 15 of the Trademark Act. [FN1]

On November 13, 1990, the Affidavit-Renewal Examiner issued an action noting that the combined declaration could not be accepted. Specifically, the examiner noted that the declaration claimed continuing use of the mark for "paper" but the registration identified the goods as "decalcomania paper." The examiner noted that a Section 8 affidavit or declaration must set forth those goods recited in the registration on or in connection with which the mark remains in use in commerce. Since petitioner's declaration did not do so, it was determined to be unacceptable. Also, since the statutory filing period had passed, and a substitute for the declaration could not, therefore, be filed, the examiner noted that the registration would be processed for cancellation.

The registration was cancelled on January 23, 1991. The instant petition followed in timely fashion. It was accompanied by the proffered substitute for the combined declaration that was rejected by the Affidavit-Renewal Examiner. The substitute declaration asserts continuing use of the mark for "decalomania [sic] paper."

In the petition, counsel for petitioner notes that the identification was set forth in the original declaration as "paper" solely as the result of a typographical error. Counsel notes that the mark has been in continuous use, and remains in use, for "decalcomania paper." Finally, counsel references a recent change in Office practice which he claims allows for correction of a typographical error in an identification, subsequent to the close of the statutory filing period for a Section 8 affidavit or declaration. Therefore, counsel has requested that the substitute declaration submitted with the petition be accepted.

***2** A brief discussion of the policy change referenced by petitioner's counsel is in order. The change in policy is not specifically directed toward correction of typographical errors. Rather, the change is directed toward those cases where a registration's identification utilizes very broad language limited by other descriptive terms or qualifying language, but where the Section 8 affidavit or declaration filed to maintain the registration utilizes only the broad language.

Consider the following example: A registration issues for a mark used for "artists' supplies, namely, paint brushes, palettes and paper," but the Section 8 declaration filed to maintain that registration claims continuing use of the mark for "artists' supplies," without qualification. In the past, the Section 8 declaration would have been viewed as utilizing an identification so broad as to leave in question whether the mark was in continuing use for "paint brushes, palettes and paper." There would be no way to tell, from the face of the declaration, whether the registrant had ceased use on those items and, perhaps, begun use on other artists' supplies, such as "paints" or "palette knives," both of which would be in international classes different than "paint brushes, palettes and paper." (If this were the case, then the registration would have to be cancelled and the registrant would be required to file a new application for its new goods.) In short, in this example, based on the Section 8 declaration's reference to "artists' supplies," it would be impossible to determine whether there was continuing use of the registered mark for the goods recited in the registration.

When cases like these arose in the past, and there was no time remaining in the statutory filing period to allow for the timely filing of a substitute declaration, the registration would simply be cancelled for failure to file an acceptable declaration or affidavit. [FN2] In all likelihood, most such situations did not involve actual changes in the use of a mark; more likely, these situations arose because registrants inadvertently failed to include appropriate qualifying language from identifications listed on their registration certificates. Cancellation of a registration because of an inadvertent failure to complete a reference to an identification seemed an unduly harsh result, when the registered mark actually remained in use for the goods recited in the registration. Thus, Office policy was recently changed to allow a registrant facing these circumstances to file a

verified statement indicating that its mark remains in use for the specific goods set forth on its registration certificate.

In the case at hand, the corrected declaration submitted with the petition cannot be accepted as a substitute for the earlier, timely filed declaration, because the statutory filing period has passed. However, it can be accepted as serving the same purpose that would the filing of a verified "clarification" of the identification in the original declaration. Though the policy change was adopted after the filing and rejection of petitioner's declaration, there is no reason not to apply the policy to the case at hand to allow the clarification to be accepted. [FN3]

***3** Though the identification issue was the only issue raised by the Affidavit-Renewal Examiner in her Office action rejecting petitioner's combined declaration, there is one other issue that must be addressed. The original declaration was accompanied by specimens of use which can be characterized as a sales brochure and a price list. Such specimens are not usually accepted as evidence of proper trademark use because they do not show use of the mark on or in connection with the goods as they are sold or shipped in commerce. However, the substitute declaration filed by petitioner does have attached to it a sample of the goods with the mark affixed to it. This is an acceptable specimen evidencing trademark use.

Under Trademark Rule 2.162(e), 37 C.F.R. § 2.162(e), when a specimen submitted with a Section 8 affidavit or declaration is determined to be deficient, a substitute specimen can be filed after the statutory filing period for the affidavit or declaration haspassed. The substitute, however, must be supported by an affidavit or declaration attesting to its use in commerce prior to the expiration of the statutory filing period.

CONCLUSION

The petition is denied to the extent that it seeks acceptance of a substitute declaration outside the statutory filing period. The petition is granted to the extent that the substitute declaration is accepted as a verified response clarifying the nature of the actual use of petitioner's mark.

The registration, which had been cancelled, will be reinstated so that petitioner can have an opportunity to verify appropriate use of the substitute specimen. Petitioner is provided with 30 days from the mailing date of this decision to file an appropriate affidavit or declaration verifying use of the substitute specimen in commerce prior to the close of the sixth year following registration. The verification should be forwarded to this office for consideration.

FN1. The registration file reveals a course of correspondence between counsel for petitioner and the Assignment Branch of the PTO, which indicates petitioner is the original registrant and has merely changed its legal business name. Though the Assignment Branch records have not, to date, been changed to reflect the change of name, there is

sufficient evidence in the registration file to substantiate petitioner's claim of ownership of the registration here in issue.

FN2. Even though Section 8 declarations or affidavits of continuing use were not required, prior to the implementation of the Trademark Law Revision Act of 1988, to list goods or services, combined Section 8 and 15 filings were required to include such a listing. Further, many filers who only filed Section 8 declarations or affidavits routinely included references to goods or services anyway. Thus, these situations were not unusual.

FN3. Though the substitute declaration here accepted as a verified clarification to the identification in the original declaration contains a true typographical error, this issue has been addressed by the petition, which asserts use for the correct goods.

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