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

RE: TRADEMARK REGISTRATION OF KABUSHIKI KAISHA TOSHIBA TRADING AS TOSHIBA
CORPORATION
93-231
March 21, 1994
***1** Petition Filed: July 28, 1993

For: TOSHIBA
Registration No. 1,405,380
Issued: August 12, 1986

Robert M. Anderson

Acting Assistant Commissioner for Trademarks

On Petition

Kabushiki Kaisha Toshiba trading as Toshiba Corporation, has petitioned the Commissioner to reverse the decision of the Affidavit/Renewal examiner, refusing to accept its declaration under Sections 8 and 15 for the U.S. Classes 24 and 36. Trademark Rules 2.146(a)(3), 2.146(a)(5) and 2.148 provide authority for the requested review.

FACTS

The above registration covering nine U.S. classes issued on August 12, 1986. [FN1] Pursuant to Section 8 of the Trademark Act, 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 August 12, 1991 and August 12, 1992.

Petitioner filed its declarations under Sections 8 and 15 on August 3, 1992. Both declarations were filed for international classes 8, 9, 10 and 11, and included specimens referring to these classes as well as checks totaling $700 for any necessary filing fees.

On October 29, 1992, the Affidavit/Renewal Examiner of the Post-Registration Division telephoned counsel [FN2] for registrant and advised her to submit an affidavit clarifying the goods in their proper U.S. classes, and referred to Trademark Rule 2.85(b) which requires applications filed on or before August 31, 1973 to follow the U.S. classification schedule. The Examiner also requested the necessary fees and specimens of use for all applicable U.S. classes. [FN3]

On May 4, 1993, counsel for registrant submitted a response which lists the goods by U.S. class upon which registrant is still using its trademark. [FN4] In addition, registrant's counsel submitted a copy of the registration with the wording of the goods to be deleted from the Section 8 declaration highlighted by a florescent marker, and the goods to be covered by the Section 15 declaration contained in red ink

brackets. No specimens or filing fees were included with the response.

In a letter dated June 1, 1993, the Affidavit/Renewal Examiner notified registrant of a filing fee deficiency for the declarations to cover all U.S. classes, and referenced the telephone call of October 29, 1992. Specifically, the Examiner stated that the Section 8 declaration was filed in seven U.S. Classes and the Section 15 was filed for five U.S. classes, resulting in a total of $1200 in filing fees for both declarations. Registrant having paid $700 in filing fees left a $500 deficiency.

In addition, the Affidavit/Renewal Examiner informed registrant that specimens are lacking for U.S. Classes 24 and 36, and inasmuch as the statutory period for filing specimens has expired, these two classes must be cancelled. This petition followed.

Petitioner argues that it has met the statutory requirement to submit specimens of use covering all the goods as classified by the international classification system listed in the declaration filed under Section 8. However, petitioner asserts, there is no statutory requirement that specimens submitted with a declaration under Section 8 correspond to a particular classification system.

***2** Petitioner also believes that the deletion of the two U.S. classes from the registration would be, in effect, limiting registrant's rights and thus in contravention of Section 30 of the Trademark Act. Inasmuch as the purpose of Section 8 is to remove "deadwood" from the register, removing goods from a registration that are clearly still in use would not further the goal of Section 8. In addition, petitioner argues that deleting these classes will be detrimental to third parties who could mistakenly believe that registrant is no longer using its mark on those goods.

DECISION

Section 8 of the Trademark Act, 15 U.S.C. § 1058, provides, in part:

> [T]he registration of any mark under the provision of this Act shall be cancelled by the Commissioner at the end of six years following its date, unless within one year preceding the expiration of such six years the registrant shall file in the Patent and Trademark Office an affidavit setting forth those goods or services recited in the registration on or in connection with which the mark is in use in commerce and attaching to the affidavit a specimen or facsimile showing current use of the mark.... (emphasis added)

Trademark Rule 2.162(e) requires, additionally, that the Section 8 affidavit or declaration be accompanied by a specimen or facsimile "for each class of goods or services" upon which the mark is still in use (emphasis added).

Section 30 of the Trademark Act discusses classification of goods and services as follows:

> The Commissioner may establish a classification of goods and services, for convenience of Patent and Trademark Office administration, but not to limit or extend the applicant's or

registrant's rights....

In addition, Trademark Rule 2.85 establishes the classification schedules for trademark applications based upon their filing date. Specifically, Rule 2.85(b) provides that, "[w]ith respect to applications filed on or before August 31, 1973, and registrations issued thereon, including older registration issued prior to that date, the classification system under which the application was filed will govern for all statutory purposes, including, inter alia, the filing of petitions to revive, appeals, oppositions, petitions for cancellation, affidavits under section 8 and renewals, even though such petitions to revive, appeals, etc., are filed on or after September 1, 1973." (emphasis added).

Trademark Rule 2.146(a)(3) permits the Commissioner to invoke supervisory authority in appropriate circumstances such as this. Petitioner's arguments are convincing. In the present situation, application of Trademark Rule 2.85(b) would necessitate the cancellation of U.S. classes from the subject registration which are still in use in commerce. Because Section 30 of the Trademark Act expressly states that classification is meant to be a tool of administration for use by the Office, the Commissioner has no authority to cancel these classes inasmuch as the statutory requirements for the current international classes have been satisfied.

***3** Accordingly, the petition is granted. This Office will hold the registration file for 30 days from the date of this decision; allowing petitioner to correct the $100 filing fee deficiency for the Section 15 declaration during this time period. [FN5] The registration file will then be forwarded to the Post Registration Division for review of the combined declaration applying the international classification system.

FN1. The original registration encompasses U.S. classes 19, 21, 23, 24, 26, 31, 34, 36 and 44.

FN2. The telephone communication is in the form of a handwritten memo in the file, unsigned. There is no indication that a copy of this memo was submitted to registrant's counsel. However, the unverified petition refers to the telephone conversation and the response submitted by registrant on October 29, 1992, responds to the points raised in the memo.

FN3. Based upon the contents of the memo of the Affidavit/Renewal Examiner, it appears that the Examiner believed the original specimens to be deficient for some of the U.S. classes of goods, although neither the goods nor the precise classification was mentioned. However, the original specimens fail to encompass any of the goods in U.S. classes 24 and 36, and it is unclear how the specimens were in any way deficient for any of the other classes of goods.

FN4. The Section 8 declaration encompasses U.S. classes 21, 23, 24, 26, 34, 36, 44; and the Section 15 declaration covers U.S. classes 21, 26, 34, 36, 44.

FN5. The registration is active for four international classes; and the filing fee for the combined declaration is $800. Petitioner has paid a total of $700, leaving a filing fee deficiency of $100.

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