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

RE: TRADEMARK APPLICATION OF CARNICON DEVELOPMENT COMPANY
92-172
September 21, 1992
***1** Petition Filed: May 20, 1992

For: GOLDEN RAINBOW
Serial No. 74/087,493
Filing Date: August 13, 1990

Jeffrey M. Samuels

Assistant Commissioner for Trademarks

On Petition

Carnicon Development Company has petitioned the Commissioner to accept an "Amendment Alleging Use" filedin connection with the above application. The petition will be construed as a request to accept a Statement of Use. [FN1] Trademark Rule 2.146(a)(3) provides authority for the requested review.

Facts

The subject application was filed August 13, 1990, for the mark GOLDEN RAINBOW, for services in Classes 41 and 42. The mark was published for opposition on April 30, 1991. When no opposition was filed, a Notice of Allowance issued on July 23, 1991. Pursuant to Section 1(d) of the Act, a Statement of Use, or request for an extension of time to file a Statement of Use, was required to be filed within six months of the mailing date of the Notice of Allowance.

On January 23, 1992, petitioner filed an "Amendment Alleging Use," in which it stated that it "first used the ... mark [in connection with the services] in interstate commerce at least as early as September, 1990," and that "[t]he mark has been used by applying it to advertising and promotional materials...." Five specimens of use of the mark were submitted with the "Amendment."

In an Office action dated March 20, 1992, the Paralegal Specialist in the ITU/Divisional Unit notified petitioner that the papers submitted January 23, 1992 did not comply with the minimum requirements for filing a Statement of Use, because they did not include a verified statement that the mark "is now in use in commerce." [FN2] Petitioner was advised that, since the period of time within which to file an acceptable Statement of Use had expired, the application would be abandoned in due course. Subsequently, the application was in fact abandoned, effective January 24, 1992.

This petition was filed May 20, 1992. Petitioner contends that the statements contained in the Statement of Use as filed are sufficient to

satisfy the requirements of Rule 2.88(e)(3). In the alternative, petitioner requests that the Commissioner accept the petition as a Request for Extension of Time for Filing a Statement of Use. A check in the amount of $200 was enclosed with the petition, $100 for the petition fee and $100 for the "extension request." [FN3] On July 22, 1992, petitioner supplemented the petition with a "Supplemental Amendment Alleging Use," in which it verified that the mark is now in use in commerce.

Decision

Trademark Rule 2.88(e), 37 C.F.R. § 2.88(e), sets forth the minimum requirements that a Statement of Use must meet before it can be referred to an examining attorney for examination. Incoming Statements of Use are reviewed in the ITU/Divisional Unit of the Office to determine compliance with these requirements.

***2** Rule 2.88(e)(3) requires that the Statement of Use include a verification or declaration, signed by the applicant, stating that "the mark is in use in commerce." Since petitioner's Statement of Use did not include this statement, it was not clear error on the part of the Paralegal Specialist to refuse to accept it.

However, Trademark Rule 2.146(a)(3) permits the Commissioner to invoke supervisory authority in appropriate circumstances, and this is an appropriate situation in which to invoke such authority. Petitioner's assertion of a verified date of first use in commerce, coupled with the statement of the current method of use of the mark, can be interpreted as substantially in compliance with the requirement that it allege that "the mark is in use in commerce." Accordingly, the document filed January 23, 1992 meets the minimum requirements of Rule 2.88(e)(3) for filing a Statement of Use.

This is consistent with Office practice with respect to applications filed under Section 1(a) of the Act, based on use in commerce. Although the statute requires a verified statement that "the mark is in use in commerce," the omission of such statement does not result in loss of the filing date. Rather, the applicant is permitted to supply the statement during examination of the application. [FN4]

The petition is granted. The application will be revived, and the Statement of Use will be forwarded to the Examining Attorney for examination.

The excess $100 submitted with this petition will be refunded in due course.

FN1. A party who files an application based on a bona fide intention to use a mark in commerce must make use of the mark in commerce before the mark can register. An Amendment to Allege Use, pursuant to Section 1(c) of the Trademark Act, may be filed at any time between the filing of the application and the date the examining attorney approves the mark for publication. After a mark has published, a Statement of Use must be filed, pursuant to Section 1(d) of the Act, within 6 months of the date

of issuance of the Notice of Allowance, or prior to the expiration of a previously granted extension of time to file a Statement of Use. An untimely filed Amendment to Allege Use may be resubmitted as a Statement of Use. In this case, while petitioner's "Amendment" was filed too late to be examined as an Amendment to Allege Use, it can be accepted as a Statement of Use, since it was filed within six months of the issuance of the Notice of Allowance.

FN2. Section 1(d) of the Act and Trademark Rule 2.88(e)(3) require that the Statement of Use contain an allegation that "the mark is in use in commerce." The word "now" is not necessary.

FN3. The fee for filing a petition to the Commissioner is $100, regardless of the number of classes in the application, 37 C.F.R. § 2.6(a)(15), but the fee for filing a Request for Extension of Time for Filing a Statement of Use is $100 per class. 37 C.F.R. § 2.6(a)(4). However, since the decision on this petition makes it unnecessary to consider petitioner's alternative request for relief, the fee deficiency is moot.

FN4. In this case, petitioner has already supplemented the Statement of Use with the required allegation of current use of the mark.

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