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

RE: TRADEMARK APPLICATION OF RAFAEL GARCIA-MATA
Serial No. 73/821,781
March 1, 1991
***1** Petition Filed: July 9, 1990 [FN1]

For: LCH and design
Filing Date: August 28, 1989 [FN2]

Attorney for Petitioner

Michael J. Striker

Jeffrey M. Samuels

Assistant Commissioner for Trademarks

On Petition

Rafael Garcia-Mata has petitioned the Commissioner to accord an August 28, 1989 filing date for the above-captioned application. Trademark Rule 2.146(a)(3) provides authority for this review.

On August 28, 1989, petitioner filed an application pursuant to Section 44(d) of the Trademark Act, claiming priority based on an application filed in Argentina. The application papers were returned in a letter dated June 20, 1990 because the application was not filed within six months of the foreign application. This petition was filed on July 9, 1990.

Petitioner has provided a copy of a PTO form entitled "Application Record of Telephone Calls" which indicates that Mr. Ho, an employee of the PTO, telephoned petitioner's counsel on September 5, 1989. The notes on the form indicate, among other things, that counsel will send in an amendment; and that a letter was sent by the PTO to memorialize the conversation on that date. The Trademark Application Section subsequently notified petitioner, in a letter dated June 20, 1990, that petitioner failed to respond to the letter dated September 5, 1989 and, therefore, the application papers were being returned and the application fee refunded.

Counsel for petitioner has indicated in the unverified petition that it never received the letter dated December 5, 1989 (sic). Further, the foreign application was filed on July 29, 1989, as related to Mr. Ho during a telephone conversation in August of 1989. Counsel argues that while the application as filed does not specify the filing date of the foreign application, the application is still sufficient to obtain a filing date.

Trademark Rule 2.146(a)(3) permits the Commissioner to invoke supervisory authority in appropriate circumstances. However, the

Commissioner will reverse the action of the Trademark Application Section in a case such as this only where there has been a clear error or abuse of discretion. In re Richards- Wilcox Manufacturing Co., 181 USPQ 735 (Comm'r Pats.1974); Ex parte Peerless Confection Company, 142 USPQ 278 (Comm'r Pats.1964). For the reasons given below, the present circumstances do demonstrate clear error by the Application Section.

Section 44(d) of the Act permits certain applicants to file for registration in the U.S. based on the filing of a foreign application, provided that the U.S. application is filed within six months of the filing of the foreign application. [FN3]

Trademark Rule 2.21 sets forth the requirements for receiving a filing date. Applications filed under Section 44(d) of the Act must include "a claim of the benefit of a prior foreign application." [FN4]

***2** In this case the application stated:

The application to register in Argentina was filed on *** under Serial No. 1696056, and the priority of that application is claimed in accordance with the International Convention and Section 44(d) of the Act. Certificate of such registration will be presented upon issue.

Clearly, the application contained a claim of the benefit of a prior foreign application and, therefore, met the requirements for receiving a filing date under Rule 2.21. The Application Section erred by suspending the application to require additional information in order to ascertain whether the U.S. application was filed within the six month statutory period. When the application is in compliance with Rule 2.21 but the filing date of the foreign application has been omitted the proper procedure for the Trademark Application Section is to accord the application a filing date and serial number, and then forward the application to an examining attorney to inquire about the date of the foreign filing. If the filing of the foreign application predates the U.S. application by more than the statutory six month period, the examining attorney would then declare the application void ab initio and have the filing date cancelled.

The petition is granted. The Trademark Application Section is directed to accord an August 23, 1989 filing date for the subject application. Because the petition was necessitated by an Office error the fee, required under Trademark Rule 2.6(k), is waived and will be refunded. The application file will be held in the Office of the Assistant Commissioner for a period of thirty days pending resubmission of the refunded $175 filing fee.

FN1. The petition was perfected on August 3, 1990 by payment of the fee required under Trademark Rule 2.6(k).

FN2. The filing date is the issue on petition.

FN3. Section 44(d) was amended effective November 16, 1989 to require a statement of bona fide intention to use the mark in commerce. Because the subject application was filed before November 16, 1989, such a statement was not required. The issues presented in petition are not

affected by the changes to Section 44(d).

FN4. Rule 2.21 was amended effective November 16, 1989 to require Section 44(d) applications to also include a statement of bona fide intention to use the mark in commerce.

19 U.S.P.Q.2d 1239

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