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

RE: TRADEMARK APPLICATION OF KABUSHIKI KAISHA KANEDA KIKAI SEISAKUSHO,
AND
KABUSHIKI KAISHA TOKYO KIKAI SEISAKUSHO
89-264
September 28, 1990
***1** Petition Filed: December 6, 1989

For: FPPR
Serial No. 73-833,859 [FN1]
Filing Date: Not Assigned

Attorney for Petitioners

B. Franklin Griffin, Jr.

Griffin, Branigan & Butler

Jeffrey M. Samuels

Assistant Commissioner for Trademarks

On Petition

The joint applicants listed above have petitioned the Commissioner for an order granting their request for transfer of a certified copy of a foreign registration for their mark. The copy is contained in the file for an application that has been abandoned. Petitioners request its transfer to the file for the above referenced, subsequently-filed application. In addition, the petition requests that the application be considered as properly filed on October 26, 1989, the date on which the Office received the application and the foreign registration transfer request. The petition will be reviewed under Rule 2.146, 37 C.F.R. § 2.146.

FACTS

Petitioners are two companies sharing a parent/subsidiary relationship. As joint applicants, they obtained a registration for the mark FPPR in their home country of Japan. Subsequently, petitioner Kabushiki Kaisha Kaneda Kikai Seisakusho filed an application seeking registration of the mark in the United States, pursuant to Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e).

Registration was refused on the ground that the "applicant"D' in the U.S. application was not the registrant listed in the foreign registration that served as the basis for the U.S. application. The Examining Attorney handling this initial U.S. application noted that the defect could not be corrected and made the refusal final.

Thereafter, on October 26, 1989, the application now in question was submitted to the Office. A photocopy of the certified copy of the home registration was attached to the new application. The application was also accompanied by a separate document which requested that the initial application, properly identified by its serial number, be abandoned and also requesting that the certified copy of the home country registration contained therein be transferred to the new application.

In a letter dated November 8, 1989, the Supervisor of the Application Section rejected the application as a Section 44(d) application filed more than six months after the filing of the foreign application providing the basis for a claim of priority. Counsel for petitioners then contacted the Supervisor, explained that the application was based on Section 44(e), and noted that its application would be complete if the Application Section would simply make the requested transfer. Counsel was informed that the transfer was not permitted. The instant petition followed.

DECISION

Initially, it must be determined whether the Supervisor of the Application Section erred in refusing to honor petitioner's transfer request. Though Trademark Rule 2.146(a)(3) permits the Commissioner to reverse the action of an Examiner in appropriate circumstances, this will be done 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 Co., 142 USPQ 278 (Comm'r Pats.1964).

***2** In this case, the Supervisor of the Application Section did not commit clear error in refusing to make the requested transfer. As counsel for petitioners has noted, Rule 2.26, 37 C.F.R. § 2.26, permits an applicant to request the transfer of a drawing from a previously filed, abandoned application to the file for a new application seeking registration of the same mark. In support of the contention that the transfer request was proper and ought to have been granted, counsel for petitioners notes that the request complied with the procedural requirements set forth in Rule 2.26 regarding transfers of drawings. However, since the Rules clearly provide for transfer of drawings, it follows that the drafters of the Rules would have provided for transfers of other items from abandoned applications had they intended to do so. Thus, the Supervisor of the Application Section properly determined that she lacked the authority to grant the transfer request.

Since it is clear that the Supervisor had no authority to grant petitioners' request, it next must be determined whether it is within the power of the Commissioner to grant the request. Under Rule 2.146(a)(4), 37 C.F.R. § 2.146(a)(4), a petition to the Commissioner may be filed "in any case not specifically defined and provided for"D' by the Trademark Rules. Petitioners' transfer request is just such a case. As noted in the petition, the Rules do not expressly permit or expressly prohibit transfers of certified copies of foreign registrations.

There are two aspects of petitioners' request that must be examined. First, can the certified copy be removed from the now abandoned application? Second, can the certified copy be associated with a Section 44(e) application to enable that application to meet the requirements for receiving a filing date?

Clearly, no useful purpose is served by barring removal of the certified copy from the now abandoned application, since the file will simply sit in the Office's warehouse and be destroyed after two years have passed. Further, there is no substantive reason why the certified copy cannot be removed. Trademark Rule 2.25, 37 C.F.R. § 2.25, does state that the papers in an application file "'will not be returned for any purpose."D' The prohibition against returning application papers is, however, solely a requirement of the Rules, is not a statutory requirement, and could be waived by the Commissioner in appropriate circumstances. In any event, petitioners have not sought removal of the certified copy for the purpose of having it returned. Rather, they merely have requested the Office to transfer the certified copy in the same way in which a drawing might be transferred. It is clear, then, that no practical or substantive reasons bar removal of the certified copy from the abandoned application.

In regard to the second inquiry noted above, a substantive issue is raised when the certified copy is associated with petitioners' Section 44(e) application to allow that application to be considered as complete and acceptable for filing. For any application filed pursuant to Section 44(e), Rule 2.21(a), 37 C.F.R. § 2.21(a), requires submission of "a certification or certified copy of the foreign registration on which the application is based." D' However, Section 44(e) specifically requires that such an application "shall be accompanied by a certification or a certified copy of the registration in the country of origin of the applicant"D' (emphasis added). Therefore, while petitioners' transfer request is not substantively barred because the certified copy would have to be removed from an abandoned application file, use of the certified copy to complete a Section 44(e) application might be viewed as contrary to the express language of the statute. The question then, is whether the words "accompanied by"D' must be interpreted to require simultaneous submission of the Section 44(e) application and the supporting certified copy of the home country registration?

***3** The federal statute that provides for removal of a lawsuit from a state court to a federal district court, 28 U.S.C. § 1446, until quite recently, required "'[e]ach petition for removal...shall be accompanied by a bond..."D' (emphasis added). [FN2] In one case, the Seventh Circuit Court of Appeals was "squarely presented"D' with the question "whether a petition for removal in proper form and filed in the District Court in apt time, together with a bond not filed simultaneously with the petition but filed subsequently and within the time allowed for the filing of the petition, is sufficient to legally effect the removal."D' Tucker v. Kerner, 186 F.2d 79, 81 (7th Cir.1950).

The court reasoned that the bond was filed in timely fashion and the defendants could have strictly complied with the statute had they simply filed a duplicate petition contemporaneously with the filing of

the bond. Turner, 186 F.2d at 82. Thus, the court determined "it would bear on the absurd to hold... the defendants could file another petition 'accompanied' by a bond but that they could not file a bond in connection with or in support of the petition on file."D' Turner, 186 F.2d at 82. Accordingly, the court rejected plaintiff's contention that the statutory language required the petition and bond to be filed simultaneously, and held "accompanied"D' could also be construed to mean "'in relation to, connected with, or to follow."D' Turner, 186 F.2d at 82. The court concluded by holding that "the procedure employed was a substantial, if not literal, compliance with the statute."D' Turner, 186 F.2d at 83. More recently, the Turner rationale was relied on by the Court of Appeals for the Sixth Circuit. See Fakouri v. Pizza Hut of America, Inc., 824 F.2d 470, 473 (6th Cir.1987).

The instant petition presents a situation closely analogous to that faced by the Turner court. The phrase that the court was required to interpret, i.e., "'shall be accompanied by,"D' is the exact phrase from Section 44(e) that is here in issue. Further, it is conceivable that petitioners herein could have petitioned for waiver of the Rule 2.25 prohibition against return of application papers, and sought the return of the certified copy. If such a petition were filed and granted, petitioners then could have filed the current application "accompanied by"D' a certified copy of their home country registration. Just as the Turner court found that it would have been "absurd"D' to hold that the defendants therein could have filed a duplicate petition with their bond but they could not file a bond to supplement their petition, it would be pointless here to have required petitioners to seek return of the certified copy so that they could simply re-submit it "accompanied by"D' their application.

***4** The requirement of Section 44(e) that an application based on that section "'shall be accompanied by"D' a certified copy of the home country registration serves to ensure that the Office will have the means to ascertain the propriety of the applicant's claim that it is has a valid basis for filing the application and for obtaining a registration under the provisions of the section. In this case, the Office could determine whether petitioners had a valid basis for filing their application because a photocopy of the certified copy accompanied the second application and the request for transfer directed the Office to the location, within its own files, where an original of the photocopy could be found. Further, the Examining Attorney that handled the original application of petitioner Kabushiki Kaisha Kaneda Kikai Seisakusho had, in effect, previously determined that petitioners herein had a right to apply to register their mark under Section 44(e) only as joint applicants relying on the home country registration now in issue.

In sum, it appears that no substantive reason bars removal of the certified copy from the initial, abandoned application. Also, the subsequent association of the certified copy with petitioners, under the facts of this particular case, would not circumvent either the requirements of Section 44(e) or the Office's ability to assess whether petitioners had a proper basis for filing their application. Petitioners request for transfer of the certified copy may therefore be approved. In addition, given their substantial compliance with the requirements of Rule 2.21 as of the filing of the second application and the separate request for transfer of the certified copy,

petitioners are entitled to a filing date of October 26, 1989.

CONCLUSION

The certified copy of the home country registration, and the translation thereof, are hereby removed from abandoned application Serial No. 73-745,825. The application here in issue shall be forwarded to the Application Section accompanied by the certified copy and translation, will be granted a filing date of October 26, 1989, and will be further processed to prepare it for examination in accordance with this decision.

FN1. This serial number has been declared "misassigned"D' and will not be reassigned to petitioner's application.

FN2. The requirement was contained in subsection (d) of the removal statute. This subsection was deleted in 1988 by the Judicial Improvements and Access to Justice Act, Pub.L. 100-702, Title X, § 1016(b), 102 Stat. 4669. Deletion of the subsection was effected when Congress determined that a bond was not required at all when removing an action to federal court, since no bond is required when an action is originally filed in a federal court. See House Report 100-889, August 26, 1988. Thus, the deletion of the subsection was entirely unrelated to judicial interpretations of subsection (d), and the case law construing its language was not, therefore, affected by the change.

18 U.S.P.Q.2d 1084

END OF DOCUMENT