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

RE: TRADEMARK APPLICATION OF CHOAY S.A.
Serial No. 73-734567
February 22, 1990
***1** Petition filed: May 1, 1989

For: FRAXIPARINE and design
Filed: October 20, 1988 [FN1]

Attorney for Petitioner

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On Petition

Choay S.A. has petitioned the Commissioner seeking an order that its trademark application be accorded a filing date of June 16, 1988. The request, if granted, would allow petitioner to claim a priority filing date under Section 44(d) of the Trademark Act, 15 U.S.C. § 1126(d), and an effective filing date of December 16, 1987. The petition will be reviewed under Trademark Rules 2.146(a)(3), 2.146(a)(5) and 2.148, 37 C.F.R. § § 2.146(a)(3), 2.146(a)(5) and 2.148.

Facts

The evidence in the subject application file indicates that petitioner filed an application to register its mark in France on December 16, 1987. Six months later, on June 16, 1988, the instant application was forwarded by U.S. Postal Service Express Mail to the Patent and Trademark Office. Since the requirements of Rule 1.10, 37 C.F.R. § 1.10, were met by petitioner, the U.S. application would have been considered to have been filed in the Office as of June 16, 1988 if all requisite requirements for receiving a filing date had otherwise been satisfied.

The U.S. application form contains the following language: "The mark was registered in France on the 16th day of December 1987; No. 1,440,473 and said registration is now in full force and effect. A certified copy of such registration is presented herewith."

The Office's Application Section initially stamped the application papers with a receipt date of June 16, 1988. However, the supervisor of the Application Section notified petitioner by letter on October 5,

1988 that the application had apparently been filed pursuant to the provisions of Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e), and could not be accorded a filing date because the application was not accompanied by a certification or certified copy of the foreign registration providing the basis for filing under Section 44(e). The letter noted that the application would be held informal for a period of six months pending submission of the certification or certified copy.

On October 20, 1988, petitioner filed a certified copy of its French registration, and an English translation thereof, with the Application Section. The transmittal letter accompanying the certified copy and translation noted that the Applicant wished "to confirm its desire to claim priority based upon the filing of a corresponding Application No. 894.596 which matured into Registration No. 1.440.473." The application was accorded a filing date of October 20, 1988 and was forwarded to the Trademark Examining Operation for examination. An Office action was issued by the assigned Examining Attorney on January 11, 1989. The instant petition was filed on May 1, 1989.

Decision

***2** Under the Trademark Act, a national of a foreign country that is a party to any convention or treaty relating to trademarks to which the United States is also a party, as defined by Section 44(b) of the Act, 15 U.S.C. § 1126(b), may have its U.S. trademark application "accorded the same force and effect as would be accorded to the same application if filed in the United States on the same date on which the [applicant's] application" was first filed in its country of origin, if "the application in the United States is filed within 6 months from the date on which the application was first filed in the foreign country" (emphasis added). Trademark Act Section 44(d), 15 U.S.C. § 1126(d).

An applicant is only considered to have "filed" an application within the Office when the materials submitted as an application satisfy the requirements for a filing date set forth in Trademark Rule 2.21, 37 C.F.R. § 2.21. The rule requires applicants pursuing registration under Section 44 of the Trademark Act to provide "a certification or certified copy of a foreign registration if the application is based on such foreign registration pursuant to section 44(e) of the Trademark Act, or a claim of the benefit of a prior foreign application in accordance with section 44(d) of the Act."

Petitioner clearly did not meet the former of the two alternatives for applications filed under Section 44, because a certified copy of its foreign registration was not filed until approximately four months after submission of the application form, drawing and fee.

The question then becomes whether the petitioner satisfied the second alternative, i.e., submission of a "claim of the benefit of a prior foreign application in accordance with section 44(d)."

Based on the previously recited language contained in petitioner's application, the supervisor of the Application Section determined a proper "claim of the benefit of a prior foreign application" had not

been set forth. Trademark Rule 2.146(a)(3) permits the Commissioner to invoke his supervisory authority in appropriate circumstances. However, the Commissioner will reverse the action of the 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 Co., 142 USPQ 278 (Comm'r Pats.1964).

Established Office practice precludes denying an applicant a priority filing date under Section 44(d) solely for failure of the application to include a "claim" of priority. However, Office practice does require the applicant to indicate in some manner that it is "relying on priority" to obtain a filing date. Thus, the inclusion of a statement that an application has been filed in a particular country on a specified date will be taken to establish a "claim" or "statement" of priority when the record shows that filing in the United States was effected within six months of the foreign filing. Trademark Manual of Examining Procedure (TMEP) Section 1003.02.

***3** Petitioner's application includes no claim of the benefit of Section 44(d), no indication that it intended to rely on a priority filing date, and no statement indicating that any application was filed on any particular day. On the contrary, the clear language of the application was consistent only with that required of an application based on Section 44(e). Under the circumstances, it was not clearly erroneous for the Application Section to deny petitioner a filing date of June 16, 1988.

Trademark Rules 2.146(a)(5) and 2.148 permit the Commissioner to waive any provision of the Rules which is not a provision of the statute, where an extraordinary situation exists, justice requires and no other party is injured thereby. All three conditions must be satisfied before a waiver is granted.

The circumstances described herein do not justify a waiver of Rule 2.21(a)(6) and its requirement that an applicant filing an application under Section 44(d) include a "claim" of priority. The petition notes that the failure to set forth a claim of priority was "due to an oversight." Oversights that could have been prevented by the exercise of ordinary care or diligence are not extraordinary situations as contemplated by the Trademark Rules. In re Bird & Son, Inc., 195 USPQ 586 (Comm'r Pats.1977).

Accordingly, the petition is denied. The filing date of the application shall remain October 20, 1988, the date on which petitioner complied with the requirements for receiving a filing date for an application pursuant to Section 44(e) of the Trademark Act.

The application will be returned to the Examining Attorney for consideration of petitioner's timely filed response to the Office action of January 11, 1989.

FN1. This date is the present filing date listed on the file wrapper for the application and in the Trademark Reporting and Monitoring System (TRAM).

16 U.S.P.Q.2d 1461

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