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

RE: TRADEMARK REGISTRATION OF ANNA VERONIKA MURRAY DBA MURRAY SPACE SHOE
CORPORATION AND MURRAY SPACE SHOE, INC.
Registration No. 440,188
October 21, 1991
***1** Petition Filed: January 17, 1991

For: SPACE SHOE
Renewed: August 17, 1968
Issued: August 17, 1948

Attorney for Petitioner

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Assistant Commissioner for Trademarks

On Petition

Anna Veronika Murray dba Murray Space Shoe Corporation and Murray Space Shoe, Inc., jointly, have petitioned the Commissioner to review the action of the Post Registration Affidavit-Renewal Examiner denying renewal of the above identified registration. Trademark Rules 2.146(a)(2) and 2.184(b), 37 C.F.R. § § 2.146(a)(2) and 2.184(b), provide authority for the requested review.

Facts

The above registration issued on August 17, 1948, and was renewed on August 17, 1968.Pursuant to Section 9 of the Trademark Act, an application for second renewal of the registration was due to be filed within the six months preceding August 17, 1988, or, on payment of a late fee, within the three month grace period following that date.

On July 26, 1988, an application for renewal of the registration was filed by Mrs. Anna Murray, doing business as Murray Space Shoe Corporation. The application was accompanied by the required fee and a specimen showing the mark as currently used. The application was signed by Anna Murray. [FN1]

On August 16, 1988, a second application for renewal was filed in the name of Murray Space Shoe, Inc. and Anna Veronika Murray, jointly. This second application was signed by Franklin Espriella as president of Murray Space Shoe, Inc. The application stated that Murray Space Shoe,

Inc. was co-owner with Anna Veronika Murray, as successors-in-interest to the rights of Alan E. Murray (deceased) and Lucile Marsh Murray; that the mark was still in use in commerce on the goods recited in the registration; that the co-owner of the application, Anna Veronika Murray, had previously paid the renewal fee and submitted the specimens in support of the application for renewal; and that, therefore, it was not believed that any additional fee or specimens were required. [FN2]

By letters mailed April 21, 1989, [FN3] the Affidavit-Renewal Examiner notified each of the renewal applicants that the Office had received two renewal applications for the registration, one by Mrs. Anna Murray claiming ownership, and another by Murray Space Shoe, Inc. claiming co-ownership with Anna Veronika Murray; that the records of the Patent and Trademark Office showed joint ownership of the registration; that a renewal application by joint owners must be signed by each of the owners acknowledging joint ownership with the other; that although the application by Murray Space Shoe, Inc. acknowledges joint ownership with Anna Veronika Murray, it was not signed by Mrs. Murray; and that the application by Anna Murray did not acknowledge joint ownership with Murray Space Shoe, Inc. The letter further stated that since the time for filing a proper renewal application ended on November 17, 1988, the registration had expired.

***2** On October 23, 1989, a response to the letters of April 21, 1989, was filed by Murray Space Shoe, Inc. and Anna Veronika Murray dba Murray Space Shoe Corporation, jointly. The response was accompanied by a photocopy of an uncertified "status copy" of the registration, dated August 26, 1988, showing record title to the registration in the name of Anna Veronika Murray dba Murray Space Shoe Corporation. The renewal applicants stated that, in view of this status copy, it was not understood how the Affidavit-Renewal Examiner determined that the registration was jointly owned by Anna Veronika Murray and Murray Space Shoe, Inc. Nevertheless, "to expedite proceedings," the response was accompanied by a third renewal application, executed by both parties as joint owners.

By letter dated September 5, 1990, the Affidavit-Renewal Examiner notified the joint renewal applicants that the status copy of August 26, 1988 was incorrect. The Examiner attached a corrected status copy dated August 31, 1990, showing record title in Anna Veronica (sic) Murray and Murray Space Shoe, Inc. The Examiner's letter further stated that renewal could not be granted based on the newly-executed renewal application because it was received after the statutory period for filing, and that the registration had expired.

This petition was filed January 17, 1991. Petitioner contends that according to the records of the Patent and Trademark Office, as evidenced by the status copy mailed August 26, 1988, the record owner of the registration when the first renewal application was filed on July 26, 1988 was Anna Veronika Murray dba Murray Space Shoe Corporation, and, accordingly, the first renewal application was proper. Petitioner contends that it is entitled to rely on the records of the Patent and Trademark Office, as evidenced by the 1988 status copy. Petitioner further contends that the 1990 status copy relied on by the Examiner shows incorrect ownership of the registration. In the alternative, petitioner contends that, if the registration was owned jointly by Anna Veronika Murray dba Murray Space Shoe Corporation and

Murray Space Shoe, Inc., then both owners had properly filed timely applications for renewal, albeit in separate documents. Petitioner requests that the failure of both owners to execute a joint renewal application should be treated as "a mere technicality" which was corrected by filing the third renewal application on October 23, 1989.

Decision

15 U.S.C. § 1059, which provides, in part:

(a) Each registration may be renewed ... upon payment of the prescribed fee and the filing of a verified application therefor, setting forth those goods or services recited in the registration on or in connection with which the mark is still in use in commerce and having attached thereto a specimen or facsimile showing current use of the mark ...

Trademark Rule 2.183, 37 C.F.R. § 2.183, promulgated in accordance with the Commissioner's authority under Section 9, sets forth the following procedural requirements for renewal of a registration:

***3** Requirements of application for renewal

(a) The application for renewal must include a statement which is verified or which includes a declaration in accordance with § 2.20 by the registrant setting forth the goods or services recited in each class for which renewal is sought in the registration on or in connection with which the mark is still in use in commerce ... (emphasis added)

(b) The declaration or verified statement ... must be filed within the period prescribed for applying for renewal. If defection or insufficient, [it] cannot be completed after the period for applying for renewal has passed ...

Although Section 9 of the Act does not specifically require that the renewal application be verified by registrant, Rule 2.183 does require verification "by the registrant." Furthermore, the rule requires that the declaration or verified statement be filed within the period prescribed by the statute for applying for renewal.

The term "registrant" includes the original registrant as well as successors and assigns who have acquired ownership through proper transfer of title. Section 45 of the Trademark Act, 15 U.S.C. § 1127. An action with respect to a registration which must be taken by the registrant can be taken by an assignee only if the assignment has been recorded with the Assignment Branch of this Office, or if other proof of the assignment has been submitted. Trademark Rule 2.186, 37 C.F.R. § 2.186. The party taking the required action is responsible for establishing that it is the owner of the registration, through appropriate evidence. Therefore, when a person or entity other than the original registrant applies for renewal, the Office must search its records to ascertain the record owner of the registration, in order to determine whether the application has been properly executed and filed by the registrant.

In the instant case, the records of this Office show clear chain of title from the original registrant to Murray Space Shoe, Inc. and Anna Veronika Murray, dba Murray Space Shoe Corporation, as joint owners.

The registration was issued August 17, 1948 to Alan E. Murray, an individual United States citizen. By order of the Superior Court of Fairfield County, Connecticut, dated July 14, 1975 and recorded in the Patent and Trademark Office November 29, 1979, title to the registration was transferred to Alan E. Murray and Lucile Marsh Murray, as joint owners. Lucile Marsh Murray assigned her interest in the registration to Murray Space Shoe New York Corporation and Murray Space Shoe Carolina Corporation by agreement dated October 16, 1979, recorded November 29, 1979. Murray Space Shoe New York Corporation and Murray Space Shoe Carolina Corporation assigned their interest in the registration to Franklin Espriella and Marie J. Dermer by agreement dated October, 1979, recorded November 29, 1979, who in turn each assigned their interest in the registration to Murray Space Shoe, Inc., by two separate agreements dated December 18, 1979, recorded May 11, 1981. Upon the death of Alan E. Murray, his half interest in the registration passed through the executor of his estate to Anna Veronika Murray, dba Murray Space Shoe Corporation, by documents dated January 21, 1980, recorded March 18, 1980.

***4** Thus, since May 11, 1981, the records of this Office have shown title to the registration in Murray Space Shoe, Inc. and Anna Veronika Murray, dba Murray Space Shoe Corporation, as joint owners. Anna Veronika Murray dba Murray Space Shoe Corporation has never been the sole owner of the registration. Therefore, the status copy of the registration dated August 26, 1988 is incorrect. [FN4]

Accordingly, the "registrant" is Murray Space Shoe, Inc. and Anna Veronika Murray, as joint owners. The issue presented herein is whether a renewal application was timely filed "by the registrant," as required by Section 9.

The application filed July 26, 1988, by Anna Veronika Murray dba Murray Space Shoe Corporation, cannot be accepted, even when viewed in conjunction with the application filed August 16, 1988, as having been filed by the registrant, because it names an improper party as owner of the mark.

The application filed October 23, 1989 cannot be accepted because it was not filed within the statutory period for filing set forth in Section 9. The Commissioner cannot extend, suspend, or waive the time for filing a complete application for renewal. In re Culligan International Co., 915 F.2d 680, 16 U.S.P.Q.2d 1234 (Fed.Cir.1990); In re Holland American Wafer Co., 737 F.2d 1015, 222 USPQ 273 (Fed.Cir.1984); In re Michaels Stern & Co., Inc., 199 USPQ 382 (Comm'r Pats. 1978); Ex parte Firmenich & Co., 137 USPQ 476 (Comm'r Pats. 1963).

For the reasons set forth below, however, the application filed August 16, 1988, executed by Murray Space Shoe, Inc., can be accepted as having been executed and filed "by the registrant."

The standards for determining whether a renewal application has been verified by the "registrant," within the meaning of Rule 2.183, are the same standards used to determine whether a Section 8 affidavit has been properly executed. The statutory requirement that the registrant file an affidavit of continued use or a renewal application cannot be waived. However, it has been held that, in certain limited

circumstances, the Commissioner may determine that a Section 8 affidavit or renewal application was properly executed and filed on behalf of a corporate registrant even though it was executed by someone other than a corporate officer. The acceptance of a signature by a non-officer is dependent upon the registrant's ability to establish facts regarding the signatory's relationship to the corporate registrant, the signatory's firsthand knowledge of use of the mark, and registrant's ratification of the signer's action. In re Cooper Industries Inc., 16 U.S.P.Q.2d 1453 (Comm'r Pats. 1990); In re Schering Agrochemicals Ltd., 6 U.S.P.Q.2d 1815 (Comm'r Pats. 1987).

The question of who is the proper party to execute an affidavit of continued use or a renewal application on behalf of joint registrants is one of first impression. Joint owners are individual parties rather than a single entity, each without authority to bind the other. For this reason, this Office has always required the signature of each of the owners in an application for registration of a mark under Section 1 of the Trademark Act. See Trademark Manual of Examining Procedure § § 802.03 and 803.08.

***5** Whenever possible, a renewal application or affidavit of continued use should be executed by each of the joint owners. However, this is not a statutory requirement which must be satisfied within a specified time period. The relationship between joint owners is such that a document signed by one of the owners can be considered as being properly executed and filed "by the registrant," if the signer's action is subsequently ratified by each of the other owners. By virtue of its ownership, each party has firsthand knowledge of the facts relating to the use of the mark, as well as implied authority to act on behalf of the registrant. Because the parties are in fact separate legal entities, any action taken with respect to a registration by less than all of the owners must be supplemented with an affidavit or declaration (37 C.F.R. § 2.20) by each of the co-owners, ratifying the facts stated in the application. Such a ratification can be accepted after expiration of the period for applying for renewal or filing an affidavit of continued use, because it is not a requirement of the statute. [FN5]

In this case, the renewal application filed October 23, 1989 contains a declaration, pursuant to Trademark Rule 2.20, signed by Anna Veronika Murray dba Murray Space Shoe Corporation, acknowledging co-ownership of the registration with Murray Space Shoe, Inc. and verifying the facts stated in the renewal application. While this document was filed too late to be accepted as a renewal application, it can be accepted for the purpose of ratifying the statements in the application which was filed on August 16, 1988 on behalf of the joint owners of the registration.

Accordingly, the petition is granted. The registration file will be forwarded to the Affidavit-Renewal Examiner, who is directed to consider the renewal application filed August 16, 1988 as being properly executed and filed by the registrant.

FN1. There is some inconsistency in setting forth the renewal applicant's name, in that the preamble states that "Mrs. Anna Murray, doing business as Murray Space Shoe Corporation ... now owns" the

registration, while the declaration asserts that Anna Murray "is an officer of Murray Space Shoe Corporation, the owner of [the registration]."

FN2. The second renewal application was filed under a cover letter which authorized a charge of any additional fees which may be required against the deposit account of the renewal applicant's attorney. Pursuant to this authorization, a second renewal fee was charged against the deposit account. Since the August 16, 1988 renewal application was filed by an entity different than the entity which filed the July 26, 1988 application, the second fee was properly charged.

FN3. Although the file copies of these letters are undated, the records of this Office indicate that they were in fact mailed April 21, 1989, and that each of the renewal applicants' copies were stamped as such.

FN4. The error in the status copy dated August 26, 1988 is regretted. However, the registrant is responsible for establishing ownership and filing proper documents. Petitioner's reliance on the uncertified status copy of the registration as proof of ownership is inappropriate.

FN5. This is not inconsistent with Office practice under Section 1 of the Act. An application for registration by joint applicants under Section 1 which is signed by only one party is granted a filing date. Additional declarations by the other owner(s) verifying the facts stated in the application must be submitted during prosecution of the application, before the mark can be approved for publication.

21 U.S.P.Q.2d 1937

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