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Subject: TRADEMARK APPLICATION NO. 76585901 - EPIL HOSE - P-4032-3

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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/585901

APPLICANT: DERMAHOSE INC.

CORRESPONDENT ADDRESS:
MYRON AMER
MYRON AMER, P.C.
114 OLD COUNTRY ROAD, SUITE 310
MINEOLA, NEW YORK 11501



**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

MARK: EPIL HOSE

CORRESPONDENT'S REFERENCE/DOCKET NO: P-4032-3

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the examining attorney's final refusal to register the mark EPIL

HOSE for "pantyhose treated with inhibitors of hair growth." The examining attorney finally

refused registration on the basis that the declaration supporting the statement of use is

unacceptable. It is respectfully requested that this refusal be affirmed.

FACTS

On April 9, 2004, applicant applied for registration on the Principal Register of the mark

EPIL HOSE. Applicant based the application on Section 1(b), 15 U.S.C. Section 1126(b). On

January 25, 2005, the mark was published in the Official Gazette and a Notice of Allowance issued

on April 19, 2005. Applicant filed a statement of use on August 29, 2005. The examining attorney

advised applicant in a September 21, 2005 Office action that a substitute declaration was required

because the person who signed the declaration was not the actual declarant.

Applicant filed a response on October 11, 2005, asserting that a properly signed declaration

had been submitted. The examining attorney issued a final refusal on November 7, 2005.

Applicant requested reconsideration on November 22, 2005 and the examining attorney denied the

request on December 16, 2005.

The issue on appeal is whether the declaration in support of the statement of use is acceptable.

ARGUMENT

THE DECLARATION IN SUPPORT OF THE STATEMENT OF USE IS INSUFFICIENT.

A person who is properly authorized to sign on behalf of an applicant is: (1) a person with

legal authority to bind the applicant; (2) a person with firsthand knowledge of the facts and actual

or implied authority to act on behalf of the applicant; or (3) an attorney as defined in 37 C.F.R.

§10.1(c) who has an actual written or verbal power of attorney or an implied power of attorney

from the applicant. 37 C.F.R. §2.33(a); TMEP §804.04.

The declaration in support of the statement of use signed by “MYRON AMER, as Attorney”

reads as follows:

PAUL ZAIDMAN declares: That he is president of the applicant of the above-captioned application and has authorized MYRON AMER, as attorney, to execute this declaration on his behalf; that he believes said applicant to be the owner of the trademark sought to be registered and entitled to use the mark in commerce; that to the best of his knowledge and belief, no other person, firm, corporation or associate has the right to use said mark in commerce, either in the identical form or in such near resemblance thereto as may be likely, when applied to the goods of such other person, to cause confusion, or to cause mistake, or to deceive; that the mark was first used in intrastate and interstate commerce at least as early as August 17, 2005, and is still in use in such commerce; that the mark is used for “PANTYHOSE TREATED WITH INHIBITORS OR HAIR GROWTH” in International Class 25; that the mark is used on the packaging of the goods, there being submitted herewith pursuant to TMEP 905.04(b) a specimen, consisting of a stamping applied by a rubber stamp on the packaging of the goods, showing the manner in which the mark is used on the goods; that all statements made of his own knowledge are true and that all statements made upon information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any registration resulting therefrom.

Applicant’s attorney attempts to sign a declaration for which he makes no statement. Rather,

he is relying on statements made by Paul Zaidman. If the declaration is made by Paul Zaidman,

which is clear from the above language, “PAUL ZAIDMAN declares,” then it must be signed by

him. In the alternative, an attorney with the proper power of attorney from applicant may provide

the declaration. However, the attorney must make the statement in accordance with Trademark

Rules. There is no provision that relieves an attorney from the basic principles of being a

“declarant.” Pursuant to 37 C.F.R. §2.33(a), an attorney may be properly authorized to sign on

behalf of applicant. However, Trademark Rule 2.20 states that:

Instead of an oath, affidavit, verification, or sworn statement, the language of 28 U.S.C. 1746, or the following language may be used:

The *undersigned [emphasis added]* being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, *declares [emphasis added]* that all statements made of his/her knowledge are true; and all statements made on information and belief are believed to be true.

The above rule clearly contemplates that the declarant and the signer of the declaration must

be the same person. The declarant in the present case is Paul Zaidman, president of applicant, and

the signer of the declaration is Myron Amer, applicant's attorney. If the declaration is signed by

applicant's attorney, then it is the attorney who must make the averments required by Trademark

Rule 2.88(b)(1).

Applicant incorrectly relies only on 37 C.F.R. §2.33(a)(3), which refers to "an attorney...who has an actual or implied written or verbal power of attorney from applicant."

Although the Trademark Act allows an attorney who has actual or implied authority to act on

behalf of applicant, it does not negate the basic principle that a "declaration" must be signed by a

"declarant," i.e., the person who makes the statement. *See, e.g.,* Federal Rule of Evidence 801(b).

CONCLUSION

For the foregoing reasons, the refusal to register the mark because the declaration in support

of the statement of use is insufficient should be affirmed.

Respectfully submitted,

/Cynthia Sloan/
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