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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re PMSI, Inc.

Serial No. 76667397

Stanley B. Kita of Howson & Howson LLC for PMSI, Inc.

Deirdre G. Robertson, Trademark Examining Attorney, Law
Office 111 (Craig D. Taylor, Managing Attorney).

Before Hairston, Walsh and Ritchie, Administrative
Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

PMSI, Inc. (PMSI) has appealed the Examining
Attorney's repeated refusal to approve the statement of use
in this case on the grounds that the applicant, that is,
the owner of the application and mark, did not file the
statement of use. We will recount the relevant facts which
are not in dispute.

On October 13, 2006, AmerisourceBergen Corp. (ABC)
filed the involved application to register the mark PMSI
MSA in standard characters for services identified as

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"healthcare cost containment, namely, medical, pharmacy, durable medical equipment and specialty service reimbursements for third party payers under government sponsored programs" in International Class 35. ABC filed the application under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), based on a statement of its bona fide intention to use the mark in commerce. The application was published for opposition on January 8, 2008. On April 1, 2008, the USPTO mailed the notice of allowance which required ABC to file a statement of use within six months of the mailing date, that is, by October 1, 2008.

On September 8, 2008, ABC signed a statement of use with regard to Application Serial No. 76667397. Also on September 8, 2008, and after signing the statement of use, ABC signed an assignment of the PMSI MSA mark and Application Serial No. 76667397, among other things, to PMSI, Inc. (PMSI). We conclude that the assignment took effect immediately when ABC signed the assignment document. Nothing in the document indicates otherwise, and indeed, PMSI does not argue otherwise.

On September 10, 2008, ABC mailed the statement of use to the USPTO with a certificate of mailing. The USPTO received the statement of use on September 12, 2008. On September 11, 2008, PMSI transmitted the document assigning

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the PMSI MSA mark and Application Serial No. 76667397 from ABC to PMSI electronically to the USPTO for recording. The USPTO recorded the assignment document on that same date, September 11, 2008. The Examining Attorney did not issue an office action on the statement of use until October 9, 2008. Neither ABC nor PMSI filed a request for an extension of time to file the statement of use in this case. Therefore, the time to file a new statement of use or to correct any substantive defects in the statement of use had expired by the time the Examining Attorney acted on the statement of use.

The Examining Attorney argues that ABC, identified as the applicant and owner of the mark in the statement of use, was not the owner of the mark or the application on the date ABC filed the statement of use, September 10, 2008.

Applicant argues,

The Examining Attorney improperly held that ABC was not the owner of the mark when the SOU was filed on September 10, 2008. As of that date, the USPTO records would have shown that ABC, the original Applicant, was the owner of record of the application and entitled to take action, namely to file a SOU to issue the allowed application for registration. The assignment to PMSI was submitted the day after the SOU was filed for the purpose of insuring that the registration would issue in the name of the assignee of the mark and goodwill pursuant to § 502 T.M.E.P.

Applicant's Brief at 4-5 (emphasis in the original).

In its argument PMSI focuses on the impact of the timing of the recording of assignment, but PMSI discounts the importance of the timing of the assignment itself, citing Assignment Rule 3.54, which states,

The recording of a document pursuant to § 3.11 is not a determination by the Office of the validity of the document or the effect that the document has on the title to an application, a patent, or a registration. When necessary, the Office will determine what effect a document has, including whether a party has the authority to take an action in a matter pending before the Office.

37 C.F.R. § 3.54 (emphasis added).

PMSI argues further that the discrepancy underlying the refusal here is merely the result of its own early attention to the recording of the assignment and the promptness of the USPTO in effecting the recording through its electronic system. PMSI also argues that its intent was obvious when one views the sequence in the timing of the signing of the statement of use and the assignment.

The fundamental flaw in applicant's argument is that it fails to address the effect of the assignment on the application and the statutory requirements attendant to the filing of a statement of use. To decide this appeal, we must first consider the effect of the assignment applicant recorded as Assignment Rule 3.54 contemplates. The only

conclusion we can draw from our review of the assignment document applicant recorded is that the document effected a transfer of ownership of the application on September 8, 2008. The effect of that document was to transfer ownership of the application from ABC to PMSI on that date. Therefore, on September 8, 2008, PMSI stepped into the shoes of ABC as owner of the application. PMSI became "the applicant."

Trademark Act Section 1(d)(1), 15 U.S.C. § 1051(d)(1), requires, in relevant part, that "Within six months after the date on which the notice of allowance with respect to the mark is issued ... the applicant shall file in the Patent and Trademark Office ... a verified statement that the mark is in use in commerce..." 15 U.S.C. § 1051(d)(1) (emphasis added). On September 10, 2008, when ABC filed the statement of use, PMSI, not ABC, was "the applicant." Therefore, the statement, which ABC filed, was not in compliance with the statutory requirement. See *In re Colombo Inc.*, 33 USPQ2d 1530 (Comm'r Pat. 1994).

In fact, we would reach the same conclusion whether or not there had been an attempt to record the assignment. The prompt filing and recording of the assignment document simply disclosed the existence of the defect in the filing of the statement of use to the Examining Attorney. In the

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absence of the recording, the defect would still be present and could potentially serve as grounds for attacking any resulting registration. *See Huang v. Tzu Wei Chen Food Co. Ltd.*, 849 F/2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988). Faced with the knowledge of the assignment, the Examining Attorney's action was entirely proper in this case.

Before concluding we hasten to add that we have no doubt that both ABC and PMSI acted with the best intent and even in earnest to secure early issuance of the registration in the assignee's name. We regret that ABC and PMSI failed to comply with the statutory requirements in the process. ABC and PMSI could have avoided this circumstance simply by filing the statement of use before effecting the assignment.

Decision: We affirm the refusal on the grounds that ABC was not "the applicant" when ABC filed the statement of use.