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

RE: TRADEMARK APPLICATION OF CUSTOM TECHNOLOGIES, INC.
Serial No. 74/009,549
September 12, 1991
***1** Petition Filed: February 11, 1991

For: VERTIVEYOR
Filing Date: December 11, 1989

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On Petition

Custom Technologies, Inc. has petitioned the Commissioner pursuant to 37 C.F.R. § 2.146(a) to grant an extension of time for filing a Statement of Use pursuant to 37 C.F.R. § 2.89(g) for the above-captioned application.

The subject application, filed based upon a bona fide intention to use the mark in commerce, pursuant to Section 1(b) of the Trademark Act, was published for opposition on April 24, 1990. When no opposition was filed, the Notice of Allowance issued on July 17, 1990. Pursuant to Section 1(d) of the Act, a Statement of Use, or request for an extension of time to file a Statement of Use, was required to be filed within six months of the mailing date of the Notice of Allowance.

On January 14, 1991, petitioner filed a request for an extension of time for filing a Statement of Use. The request was initially granted by the ITU/DivisionalUnit in an undated Notice of Approval of Extension Request. However, in an Office action dated January 31, 1991, the Applications Examiner in the ITU/Divisional Unit indicated that, upon further review, the request was denied because it did not include a verified statement by the applicant that the applicant has a continued bona fide intention to use the mark in commerce. Specifically, the phrase "in commerce" had been omitted from the request. This petition was filed on February 11, 1991.

Petitioner maintains that it filed a proper extension request because the request indicated that petitioner "still maintains an intent to use the subject mark" which can only "connote to the Office an intent to use the mark in commerce," which was referred to in the original application. Further, the declaration accompanying the request included a statement of continued bona fide intention to use the mark.

Section 1(d) of the Trademark Act specifies that the Commissioner shall extend the time for filing the Statement of Use, upon timely written request by the applicant. However, "[a]ny request for an extension under this paragraph shall be accompanied by a verified statement that the applicant has a continued bona fide intention to use the mark in commerce...."

Contrary to petitioner's argument that there is no statutory requirement that the exact words "in commerce" must be used in the verified statement, the statute explicitly requires the request to include a verified statement that "the applicant has a bona fide intention to use the mark in commerce." The statute is not served by reference, after the filing of the extension request, to a conforming statement in the original application. The statement must be included in the extension request itself.

***2** Trademark Rules 2.146(a)(5) and 2.148 permit the Commissioner to waive any requirement of the rules, not being a requirement of the statute, in an extraordinary circumstance, when justice requires and no other party is injured. However, the requirement to include the phrase "in commerce" in an extension request for filing a Statement of Use is statutory and the Commissioner has no authority to waive it. In re Kruysman, Inc., 199 USPQ 110 (Comm'r Pats.1977); Ex parte Buchicchio, 118 USPQ 40 (Comm'r Pats.1958); Ex parte Radio Corporation of America, 114 USPQ 403 (Comm'r Pats.1957).

Even if inclusion of the phrase "in commerce" were not a statutory requirement, petitioner has presented no showing of extraordinary circumstance. 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).

The petition is denied. The application file will be forwarded to the Examining Attorney to be processed for abandonment.

24 U.S.P.Q.2d 1713

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