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

LOTUS DEVELOPMENT CORPORATION
v.
NARADA PRODUCTIONS, INC.
Opposition No. 83,330
September 4, 1991
***1** Filed: October 25, 1990

Attorney for Petitioner

Juerg Zundel

Narada Productions, Inc.

Jeffrey M. Samuels

Assistant Commissioner for Trademarks

On Petition to the Commissioner

DECISION

Narada Productions, Inc. [Narada] has petitioned the Commissioner for review of an action of the Trademark Trial and Appeal Board. Specifically, petitioner challenges the Board's institution of Opposition No. 83,330 as improper. Review of the petition is undertaken pursuant to Trademark Rule 2.146(a)(3), 37 C.F.R. § 2.146(a)(3).

FACTS

Narada's mark, NARADA LOTUS and design, was published for opposition in the Official Gazette on Tuesday, May 16, 1989. On June 14, 1989, under a certificate of mailing in accordance with Rule 1.8, 37 C.F.R. § 1.8, Lotus Development Corporation [Lotus] timely mailed a request for an extension of time to file a Notice of Opposition. The request sought "a 30-day extension ... that is an extension to July 17, 1989." Following its receipt in the Office's mail room, this extension request was misdirected to another part of the Patent and Trademark Office and was not forwarded to the Trademark Trial and Appeal Board.

On July 17, 1989, in accordance with proper mailing procedures, Lotus mailed a second extension request. This request sought "an additional 30-day extension of time ... that is an extension to August 16, 1989." On August 15, 1989, again in accordance with proper mailing procedures, Lotus mailed a third extension request, which sought "a 30-day extension ... that is an extension to September 15, 1989." Finally, on September 14, 1989, also in accordance with proper mailing procedures, Lotus filed its Notice of Opposition.

At least in part because of the misdirection of the initial extension request, a registration was inadvertently permitted to issue to Narada on August 8, 1989, despite the above referenced filings. On September 25, 1989, the Board received from Lotus a copy of the misdirected initial extension request along with a request that Narada's inadvertently issued registration be cancelled. A few days later, the original of the misdirected extension request finally arrived at the Board.

On June 25, 1990, the Board forwarded the file for the inadvertently issued registration to the Office of the Assistant Commissioner for Trademarks for cancellation. The registration was cancelled and Narada's application was restored to pending status so that the Board could institute the Opposition proceeding here in issue. On August 31, 1990, the Board instituted the Opposition. The instant petition was timely filed on October 25, 1990.

DECISION

In its petition to the Commissioner, Narada has argued that the Opposition proceeding in issue was improperly instituted by the Board. Narada has asked for both reconsideration of the Commissioner's order cancelling the inadvertently issued registration and review of the Board's institution of the Opposition. In its response to the petition, Lotus has argued that its various extension requests were timely and that its Notice of Opposition was also timely. Lotus asserts that the Commissioner and the Board have recognized these "facts" by, respectively, cancelling the registration as inadvertently issued and instituting the Opposition proceeding. Though for reasons entirely different than those argued by Narada, the petition must be granted and the Board's institution of the Opposition proceeding must be vacated.

1. Rules and Policies Governing Extension Requests

***2** Under Trademark Act Section 13, 15 U.S.C. § 1063, an initial request for an extension of time to file an opposition must be filed within the 30-day period immediately following publication of the mark for opposition. The statute empowers the Commissioner to grant further extensions "for good cause when requested priorto the expiration of an extension." Trademark Rule 2.102(c), 37 C.F.R. § 2.102(c), provides further detail on the filing of extension requests. The following points which bear on the case at hand can be gleaned from a review of the rule:

1. An extension request must be filed "before expiration of thirty days from the date of publication or within any extension of time previously granted" and "should specify the period of extension desired."

2. The first extension "for not more than thirty days will be granted upon request" and subsequent extensions "may be granted by the Board for good cause."

3. Extensions "aggregating more than 120 days from the date of publication ... will not be granted except upon (1) a written consent or stipulation signed by the applicant or its authorized representative, or (2) a written request by the potential opposer or its authorized representative stating that the applicant or its authorized representative has consented to the request, and including proof of service on the applicant or its authorized representative, or (3) a showing of extraordinary circumstances, it being considered that a potential opposer has an adequate alternative remedy by a petition for cancellation."

2. The Extension Requests Here in Issue

The 30-day opposition period following publication of Narada's mark ended on June 15, 1989. As noted in the previous discussion of the facts, the initial extension request filed by Lotus, though misdirected following receipt, was timely mailed before this deadline. This initial request sought an extension of 30 days through July 17, 1989. A 30-day extension running from the close of the opposition period would have run from June 16, 1989 through July 15, 1989, not July 17, 1989. Thus, Lotus requested a 30-day extension through a date 32 days after the close of the opposition period.

Under Rule 2.102(c), Lotus had a right to a 30-day extension of time without any requirement that it assert the existence of "good cause" for granting the extension. On the other hand, it was not entitled to receive an extension of more than 30 days except upon a showing of good cause for granting the longer extension. The initial extension request did not assert good cause for granting an extension of more than 30 days, and thus, Lotus was only entitled to an extension of 30 days.

Lotus may have framed its request in the manner it did because a 30-day extension would have expired on Saturday, July 15. However, issues regarding the effective beginning and ending dates of extensions, and issues regarding the timely filing of extension requests are distinct matters. Lotus was not entitled to request a 32-day extension, absent a showing of good cause, simply because a 30-day extension would have expired on a weekend. Rather, it was entitled to a 30-day extension and, under Rule 1.7, 37 C.F.R. § 1.7 would have been permitted to mail a subsequent extension request in accordance with Rule 1.8 as late as the following Monday, July 17, 1989. However, the beginning date of any such subsequent extension would have been calculated to run from Sunday, July 16, 1989, rather than from the day of mailing of the request.

***3** While the second extension request filed by Lotus was timely mailed on July 17, the mistake in calculating the initial extension "threw off" the calculation of the second and third 30-day extension periods. Thus, Lotus ultimately calculated that its third 30-day extension allowed it until Friday, September 15, 1989 to file its Notice of Opposition. The notice was then mailed in accordance with Rule 1.8 on September 14, 1989.

In fact, Rule 2.102(c) states that extensions of time aggregating more than 120 days from the date of publication will not be granted

except under certain specified conditions, e.g., with the applicant's written consent or under a showing of extraordinary circumstances. In re Software Development Systems Inc., 17 U.S.P.Q.2d 1094 (Comm'r Pats.1990); In re Societe Des Produits Nestle S.A., 17 U.S.P.Q.2d 1093 (Comm'r Pats.1990).

In this case, the 120-day period following publication ended on September 13, 1989. Lotus did not meet the requirements for receiving an extension beyond this date. The Board's approval of extension requests aggregating more than 120 days from the date of publication was therefore in error and must be reversed. As a consequence, the Notice of Opposition mailed on September 14, 1989, 121 days after publication, must be rejected.

It is unfortunate that the misdirection of the initial extension request prevented the Board from addressing this situation following its original submission; it is similarly unfortunate that the Board did not address the situation when the third extension request was filed. However, the Office has no obligation to inform parties of errors in papers to allow for their timely correction or refiling. See In re Holland American Wafer Co., 222 USPQ 273 (Fed.Cir.1984). Finally, it is regrettable this situation was not noted when the Notice of Opposition was filed 121 days after publication. Nonetheless, the institution of the Opposition must be vacated.

Contrary to the position argued by counsel for Lotus, the earlier cancellation of the registration as inadvertently issued does not constitute an affirmance that all of the extension requests here in issue, as well as the Notice of Opposition, were timely filed. Rather, the registration was cancelled simply because it was inadvertently issued at a point in time (during the second extension) when it should not have. While the Board's institution of the Opposition proceeding may be taken as an indication that it found the extension requests and Notice of Opposition timely, the Board's actions have been shown to be in error.

CONCLUSION

The petition is granted. The Board's institution of Opposition No. 83,330 is hereby vacated. While the earlier cancellation of the inadvertently issued registration was proper, Narada may elect to have that registration certificate returned to it. The Office's computerized data bases would then be updated to indicate the re-issuance of the registration. Otherwise, Narada may choose to have the application file returned to the Publication and Issue section for re- issuance of a new registration. Narada must indicate its choice within 30 days of the date of this decision. Lotus may, if it so desires, pursue relief through a cancellation proceeding after a registration issues.

23 U.S.P.Q.2d 1310

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