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

KIMBERLY-CLARK CORPORATION
v.
PAPER CONVERTING INDUSTRY, INC.
Opposition No. 82,631
August 6, 1991
***1** Filed: September 24, 1990

Attorney for Petitioner

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Attorney for Opposer

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Assistant Commissioner for Trademarks

On Petition to the Commissioner

Decision

Paper Converting Industry, Inc., (Paper Converting), the applicant in the proceeding, has petitioned the Commissioner, pursuant to Trademark Rule 2.146(e)(2), to reverse the interlocutory order of the Trademark Trial and Appeal Board denying its motion to dismiss the opposition. Petitioner further requests a stay of discovery pending final determination of the petition.

Facts

Application Serial No. 73/803,128 was published for opposition on January 16, 1990. On February 13, 1990, Kimberly-Clark Corporation (Kimberly-Clark) requested a sixty day extension of time for filing an opposition, which was granted by the Trademark Trial and Appeal Board, extending Kimberly-Clark's time to file a notice of opposition to April 16, 1990. A notice of opposition was timely filed by Kimberly-Clark. On June 11, 1990, the Administrator of the Trademark Trial and Appeal Board notified applicant and opposer that applicant's answer to the opposition was due within forty days.

On July 23, 1990, Paper Converting filed a motion to dismiss the opposition because the opposition was untimely filed. Specifically, Paper Converting maintains that granting an initial extension request for more than thirty days violates Section 13(a) of the Trademark Act. [FN1]

On September 5, 1990, the Trademark Trial and Appeal Board denied the contested motion to dismiss "inasmuch as cause therefor has not been shown. Section 13(a) of the Lanham Act does not require that a first extension of time to file an opposition be for thirty days only. Nor is there any such limitation inherent in Trademark Rule 2.102(c). The Board routinely grants first extensions of time to oppose for sixty days, where such requests for extension include a showing of good cause for extension beyond thirty days." Applicant's time to answer the opposition was reset to twenty days from September 5, 1990. The answer was timely filed on September 17, 1990. This petition was filed on September 24, 1990. The Board granted a stay of proceedings inasmuch as the petition to the Commissioner is potentially dispositive of the proceeding.

Analysis

Section 13 of the Trademark Act was amended in 1975. The legislative history indicates the purpose of the amendment was to allow for automatic extensions:

> These automatic extensions are needed because the 30-day opposition period is many times insufficient for the preparation of an opposition.... The proposal recognizes the need for a longer period for preparing and filing opposition. It provides for an automatic extension of the 30-day period on request by a prospective opposer. For the great majority of cases (est. 95%) no opposition is filed. In these cases the opposition period terminates 30 days after publication of the mark for opposition and the mark is duly registered. It is for this reason that the alternative of extending the opposition period is not believed to be the better solution. Thus, there is no need to delay registration of unopposed marks (95%) beyond the present 30- day opposition period for the sake of the 5% which are opposed.

***2** S.Rep. No. 93-1400, reprinted at 1974 U.S.Code Cong. and Adm.News, p. 7132.

Petitioner argues that the Board ignored the explicit language of Section 13(a) of the statute and Rule 2.102(c) because "the statute is clear that the first extension shall be only for thirty days."

> Upon written request prior to the expiration of the thirty-day period [in which to oppose a published mark], the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Commissioner for good cause when requested prior to the expiration of an extension.

15 U.S.C. § 1063(a). (Emphasis added by petitioner)

Petitioner also maintains that "[t]he statute also unambiguously provides that the Board may not simultaneously grant two consecutive extensions. As quoted above 'further extensions' may only be granted prior to the expiration of an extension already granted. Trademark Rule

of Practice 2.102(c), 37 C.F.R. § 2.102(c), is in full agreement. The rule, in pertinent part, states: 'A first extension of time for not more than thirty days will be granted upon request' "

The Commissioner will exercise supervisory authority under Trademark Rule 2.146(a)(3) to vacate an action of the Trademark Trial and Appeal Board only where the Board has committed a clear error or abuse of discretion. Riko Enterprises, Inc. v. Lindley, 198 USPQ 480 (Comm'r Pats. 1977).

Contrary to petitioner's arguments, Congress did not intend to limit the first extension of time to oppose to a thirty day period. In fact, there is nothing inherent in Section 13 to suggest such an intent. Section 13 requires the notice of opposition or extension request to be in writing; to be filed within thirty days of publication of the mark; to be accompanied by a showing of good cause if beyond the thirty day automatic extension; and to be filed before the expiration of an extension. In this case, opposer met the statutory requirements by filing its written request to extend time to oppose before the thirty day deadline. In essence, opposer requested the first automatic extension of thirty days and an extension of an additional thirty days, supported by the required showing of good cause, in one request rather than two.

No additional burden or injury resulted from the Board's granting of a sixty day extension. Opposer simply accomplished in one request what could, less expeditiously, have been accomplished in two requests. Further, opposer filed its notice of opposition within the sixty day period, thus putting to rest any arguments that opposer was merely delaying the registration of petitioner's mark. The practice of the Board allowing initial and subsequent extension requests to be granted for more than thirty day periods is in compliance with the statute and the rules; and, further, it serves to facilitate the opposition process.

Decision

***3** The petition is denied. The application and opposition files will be returned to the Trademark Trial and Appeal Board for resumption of the opposition proceeding. As noted in the Board's order dated October 25, 1990, Paper Converting's brief in opposition to opposer's motion to strike is due ten days from the date of this decision and Paper Converting's answers, or other responses, to opposer's discovery requests is due thirty-five days from the date of this decision.

Note 1--Converting's motion to dismiss. Paper Converting then, on August 20, 1990, filed a reply brief.

FN1. On August 10, 1990, Kimberly-Clark filed a response to Paper

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