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

RE: TRADEMARK APPLICATION OF EL TAURINO RESTAURANT, INC.
96-14
June 18, 1996
Petition Filed: October 16, 1995

For: EL TAURINO
Serial No. 74/416163
Filing Date: July 23, 1993

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On Petition

El Taurino Restaurant, Inc. has petitioned the Commissioner to reverse the denial of a Request for Extension of Time to File a Statement of Use in connection with the above-identified application. Trademark Rules 2.89(g) and 2.146(a)(3) provide authority for the requested review.

FACTS

A Notice of Allowance issued for the subject application on March 29, 1994. Pursuant to Section 1(d) of the Trademark 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 August 4, 1994, Petitioner filed its first Request for Extension of Time to File a Statement of Use, which was approved. Therefore, Petitioner had twelve months from the mailing date of the Notice of Allowance in which to file either a Statement of Use or a second Request for an Extension of Time to File a Statement of Use.

On March 17, 1995, Petitioner filed a second Request for Extension of Time to File a Statement of Use. In an Office Action dated September 18, 1995, the Applications Examiner in the ITU/Divisional Unit denied

the second extension request because it did not include a showing of "good cause," as required by Section 1(d)(2) of the Trademark Act, 15 U.S.C. § 1051(d)(2), and Trademark Rule 2.89(b)(4), 37 C.F.R. § 2.89(b)(4). Specifically, Petitioner did not include any statement regarding its ongoing efforts to use the mark in commerce. Petitioner was advised that, since the period of time within which to file an acceptable extension request or Statement of Use had expired, the application would be abandoned in due course. This petition followed.

Petitioner states that the omission of the statement of the efforts being undertaken by the Applicant to make use of the mark in commerce from its second extension request was inadvertent. The petition was accompanied by a substitute second extension request which included a statement of Petitioner's ongoing efforts to make use of the mark as of the date the second extension request was filed.

ANALYSIS

Statutory Requirements For Extension Requests Under Section 1(d)(2)

Section 1(d)(2) of the Trademark Act, 15 U.S.C. § 1051(d)(2), provides:

> The Commissioner shall extend, for one additional 6-month period, the time for filing the statement of use under paragraph (1), upon written request of the Applicant before the expiration of the 6-month period provided in paragraph (1). In addition to an extension under the preceding sentence, the Commissioner may, upon a showing of good cause by the Applicant, further extend the time for filing the statement of use under paragraph (1) for periods aggregating not more than 24 months, pursuant to written request of the Applicant made before the expiration of the last extension granted under this paragraph. Any 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 and specifying those goods or services identified in the notice of allowance on or in connection with which the Applicant has a continued bona fide intention to use the mark in commerce. Any request for an extension under this paragraph shall be accompanied by payment of the prescribed fee. The Commissioner shall issue regulations setting forth guidelines for determining what constitutes good cause for purposes of this paragraph.

"Good Cause" Standard Under Section 1(d)(2) hand Trademark Rule 2.89(b)(4)

Section 1(d)(2) of the Trademark Act and Trademark Rule 2.89(b)(4) require that, before second and subsequent extension requests may be granted, the Applicant must make a showing of "good cause." TMEP § 1105.05(d)(ii). Trademark Rule 2.89(d)(2) explains the nature of "good cause," as follows:

> The showing required by paragraph (b)(4) of this section must include:
>
> (2) A statement of Applicant's ongoing efforts to make use of the

mark in commerce on or in connection with each of the goods or services specified in the verified statement of continued bona fide intention to use required under paragraph (b) of this section. Those efforts may include, without limitation, product or service research or development, market research, manufacturing activities, promotional activities, steps to acquire distributors, steps to obtain required governmental approval, or other similar activities. In the alternative, a satisfactory explanation for the failure to make such efforts must be submitted.

Past Practice of the Office With Respect to Showing of "Good Cause"

It has been the practice of the Office to deny petitions to grant second and subsequent Requests for Extension of Time to File a Statement of Use where a showing of "good cause," including a statement of Applicant's ongoing efforts to make use of the mark in commerce or a satisfactory explanation for the failure to make such efforts, was missing from the extension request as filed. The Commissioner held that the requirement for a showing of good cause was a statutory requirement that must be satisfied prior to the expiration of the statutory period for filing the Statement of Use, and that, even under Trademark Rules 2.146(a)(5) and 2.148, he was without authority to waive this statutory requirement. The result of this policy was the abandonment of applications when the Applicant had no time left in the period for filing the extension request. See In re SPARC International Inc., 33 USPQ2d1479 (Comm'r Pats. 1994); In re Twin Cities Public Television Inc., 25 USPQ2d 1535 (Comm'r Pats. 1992).

Change of Office Policy With Respect to Showing of "Good Cause"

Upon further consideration and review of Section 1(d)(2) of the Trademark Act, the Commissioner has determined that the only statutory elements required for filing an extension request are: (1) a verified statement that the Applicant has a continued bona fide intention to use the mark in commerce, (2) a specification of the goods or services identified in the Notice of Allowance on or in connection with which the Applicant has a continued bona fide intention to use the mark in commerce, and (3) payment of the prescribed fee for at least one class of goods or services. Although additional information is required in order to receive approval of the extension request, no other information is explicitly required to be submitted before expiration of the statutory filing period.

When a statutory provision does not expressly require an element to be present for a document to be considered filed, the Applicant must be given additional time to perfect any further requirements of the rules. That is because the rule may not expand the requirements of the statute to the detriment of the Applicant. Therefore, the policy rationales given in SPARC and Twin Cities for denying petitions to grant second and subsequent extension requests which do not include a showing of good cause are explicitly overruled. To be clear, while a showing of "good cause" under Section 1(d)(2) of the Trademark Act and Trademark Rule 2.89(b)(4) must be made before the Commissioner may grant a second

or subsequent extension request, such a showing is not a statutory requirement for filing an extension request.

Supplementing Statement of Ongoing Efforts Permitted only on Petition to the Commissioner

Although this change permits the submission of a showing of good cause after expiration of the statutory filing period, this showing may only be made in a petition to the Commissioner. Requiring the ITU/Divisional Unit of the Office to allow additional time for an Applicant to supplement its extension request with a showing of good cause would place an unmanageable burden on that section of the Office. Therefore, this decision will not affect the examination of extension requests by Applications Examiners. The Applications Examiners will continue to deny second and subsequent extension requests that do not include a showing of good cause. An Applicant may supplement its request with a verified statement of its ongoing efforts to use the mark in commerce, or a satisfactory explanation for the failure to make such efforts, only upon petition to the Commissioner. [FN1]

DECISION

The petition to accept Applicant's second extension request for examination is granted. The application file will be returned to the Applications Examiner in the ITU/Divisional Unit for examination consistent with this decision. [FN2]

FN1. Under Trademark Rule 2.89(g), such a petition must be filed within one month of the mailing date of the Office action denying the request. The filing of the petition will not stay the time for filing a Statement of Use or further extension request. In re Hoffmann-La Roche, Inc., 25 USPQ2d 1539 (Comm'r Pats. 1992); TMEP § 1105.05(d)(v).

FN2. The Applications Examiner may consider the showing of good cause for the second extension request filed with the petition. Petitioner filed a third extension request on September 20, 1995, and a fourth extension request March 29, 1996, which must also be examined.

42 U.S.P.Q.2d 1220

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