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

RE: TRADEMARK APPLICATIONS OF RAYCHEM CORPORATION
Serial Nos. 74-000,751 and 74-000,774
June 17, 1991
***1** Petitions Filed: February 15, 1991

For: RAYNET; RAYNET and design
Both Filed: November 16, 1989

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On Petition

Raychem Corporation has petitioned the Commissioner for an order directing acceptance of substitute requests for extensions of time to file statements of use for the above referenced applications. Concurrently, petitioner has sought expedited handling of its petitions. Review of the petitions is undertaken pursuant to authority provided in Trademark Rules 2.146 and 2.148, 37 C.F.R. § § 2.146 and 2.148.

FACTS

The applications here in issue were filed pursuant to Trademark Act Section 1(b), 15 U.S.C. § 1051(b), the "intent to use" provision of the Lanham Act. The marks were approved for publication by the Examining Attorney following an initial review of the applications.

The mark RAYNET, the subject of the '751 application, was published for opposition in the March 27, 1990 issue of the Trademark Official Gazette. The mark RAYNET and design, the subject of the '774 application, was published for opposition in the April 17, 1990 issue of the Gazette. No oppositions were filed and notices of allowance were issued for the respective applications on June 19, 1990 and July 10, 1990.

Separate requests for extensions of time to file the required statements of use were submitted for each of the applications, on December 18, 1990 and January 7, 1991, respectively. Both requests were captioned in the applicant's (petitioner's) name and were executed by Dennis E. Kovach, denominated on the signature lines of the requests as

"Assistant Secretary." Notices approving the extension requests were issued by the Intent to Use and Divisional Unit, on January 22, 1991 and February 4, 1991, respectively.

On February 15, 1991, petitioner's counsel hand-filed the instant petitions. Except for the dates involved, the two petitions are identical in terms of their facts and the issues they raise. The petitions note that Mr. Kovach, "was set forth as Assistant Secretary for [the applicant] Raychem Corporation" in the extension requests. They go on to admit that Mr. Kovach is, in fact, not the Assistant Secretary of Raychem, but rather, is the Assistant Secretary of Raynet Corporation, a subsidiary of Raychem. Finally, the petitions note "that, generally, one without statutory authority may not execute a Request for Extension of Time on behalf of Applicant," and request acceptance of substitute extension requests that have been executed by an officer of Raychem. Petitioner also requests "expedited handling" of the petitions.

DECISION

***2** Petitioner has filed four petitions bearing on two distinct applications. Two of the petitions--one for each of the two applications--raise the main issues to be decided herein. The other two are essentially requests for expedited handling of the main petitions, but are framed as petitions.

1. Request for Expedited Handling of Petitions

Section 1102.03 of the Trademark Manual of Examining Procedure (TMEP) provides that all petitions to the Commissioner "should be attended to at once." Clearly, all those petitions pending at any particular moment cannot all be disposed of "at once." Thus, some system must be employed to dictate the order in which petitions are handled. The general practice is to process petitions based on the dates on which they have been "referred for decision." Generally, a petition is not assigned a "referred for decision" date until the petition fee has been paid, and all files or documents necessary to the resolution of the petition have been gathered together by the Office or submitted by the petitioner, as necessary.

Departures are sometimes taken from the normal processing of petitions. This can be done when equitable considerations favoring the petitioner warrant expedited handling; exception processing of a petition can also be undertaken when it raises an issue of first impression and addressing the issue expeditiously will serve the development of Office practice and procedure. In this case, petitioner has authorized the deduction of petition fees from a deposit account to pay for its petitions for expedited handling of the "main" petitions. However, the main petitions raise issues of first impression not previously addressed on petition; expeditious handling of the main petitions will help develop Office practice and procedure. Therefore, the petitions are accorded expedited handling without charge to petitioner.

2. Request for Acceptance of Substitute Extensions

A. Provisions of the Trademark Rules and Statute

To begin, it is necessary to review certain provisions of the Trademark Act and the Trademark Rules. These include those provisions which cover verification of an application and other documents relating to a mark and those provisions which govern the filing of a request for an initial extension of time to file a statement of use.

Subsections (a)(1)(A) and (b)(1)(A) of Section 1 of the Trademark Act, 15 U.S.C. § § 1051(a)(1)(A) and 1051(b)(1)(A), both note that a written application must be "verified by the applicant, or by a member of the firm or an officer of the corporation or association applying...."

Trademark Rule 2.20, 37 C.F.R. § 2.20, provides, in pertinent part, "an officer of the corporation or association making application for registration or filing a document in the Patent and Trademark Office relating to a mark may, in lieu of the oath, affidavit, verification, or sworn statement required ... in those instances prescribed in the individual rules, file a declaration...."

***3** Trademark Act Section 1(d)(2), 15 U.S.C. § 1051(d)(2), deals with the initial request, following issuance of a notice of allowance, for an extension of time to file a statement of use. This provision of the statute notes that one six-month extension of the time for filing a statement of use shall be granted by the Commissioner simply "upon written request of the applicant [filed] before the expiration of the 6-month period [following issuance of a notice of allowance] ..." (emphasis added).

Trademark Rule 2.89(a), 37 C.F.R. § 2.89(a), also deals with such extension requests. The relevant portions of the rule that apply in this case provide:

"The applicant may request a six-month extension of time to file the statement of use ... by submitting: (1) A written request, before the expiration of the six-month period following the issuance of a notice of allowance.... and (3) A verified statement by the applicant [attesting to various matters] ..." (emphasis added).

B. Summary of Arguments Raised by Petitioner

As noted, subsections (a)(1)(A) and (b)(1)(A) of Section 1 of the Trademark Act require applications to be verified by the applicant; an application filed by a corporation must be verified by an officer of the applicant. It follows then, that a verified extension request "of the applicant," provided for by Section 1(d)(2) of the statute, must also be signed by an officer, if the applicant is a corporation. The provision in Rule 2.20 which provides that an officer of a corporation

may file a declaration in lieu of an oath or verification when such is required for a document filed with the Office provides support for this conclusion. Indeed, petitioner has not challenged this point and has admitted that "one without statutory authority" is not empowered to execute an extension request for a corporate applicant.

Nonetheless, petitioner argues that the "present situation is extraordinary," asserts that no other party would be harmed by acceptance of the properly- verified substitute extension requests, and concludes that "justice requires" their acceptance. Though not explicitly framed as such, this portion of petitioner's argument essentially constitutes a request for relief pursuant to Trademark Rules 2.146(a)(5) and 2.148, 37 C.F.R. § § 2.146(a)(5) and 2.148. These two rules provide for the waiver or suspension of other provisions of the Trademark Rules which are not statutory in nature (1) in extraordinary situations, (2) when justice requires such action, and (3) when such an action would not injure another party. As applied in previous petition decisions, waiver of non-statutory provisions of the rules is conditioned on all three requirements for waiver being shown to exist.

In this regard, petitioner's request for relief can be construed as requesting waiver of the provision in Rule 2.89 which requires filing of an extension request within the initial six-month period following issuance of the notice of allowance. In the alternative, petitioner's request can be construed as requesting waiver of the provision in Rule 2.89 which requires that an extension request be verified and filed by "the applicant." Finally, petitioner has presented two arguments why the term "applicant," as used in Rule 2.89 and in Section 1(d)(2) of the statute, should be construed broadly enough to include non-officers of corporate applicants. The two arguments for waiver of provisions of Rule 2.89 will be dealt with first, followed by consideration of the two arguments seeking broadened construction of the term "applicant."

C. Requests for Waiver of Rule 2.89

***4** The provisions of Rule 2.89 and Section 1(d)(2) of the statute clearly contain two distinct requirements for an initial extension request filed in an "intent to use" application, which must be addressed in this case. One requirement is that the extension request be filed within a specific time period; the second requirement is that the request be verified and filed by the applicant.

Petitioner's request for relief can be construed as a request for waiver of the provision of Rule 2.89 which dictates that an initial extension request be filed before the expiration of the initial six-month period following issuance of the notice of allowance. If this provision of Rule 2.89 were waived, then the properly-verified substitute extension requests submitted with the instant petitions could be accepted for filing. However, the deadline for initial extension requests is not only set forth in Rule 2.89, but is also set forth in Section 1(d)(2) of the statute. Since the deadline is statutory in nature, compliance with the deadline cannot be waived on petition. Accordingly, to the extent petitioner's request for relief is construed as a request for leave to file the substitute extension

requests after the prescribed time period for filing has passed, the request must be denied.

Apart from being construed as a request for waiver of the filing deadline set forth in Rule 2.89, petitioner's request for relief can also be construed as a request for waiver of the provision in the rule which requires that the applicant verify and file the request for an extension of time to submit a statement of use. This would allow for "validation" [FN1] of the initial set of extension requests signed by Mr. Kovach.

While the requests were filed in the name of the corporate applicant, their declarations were signed by an officer of another corporation. This corporation is a distinct legal entity, albeit one in which applicant owns a majority of the stock. To accept this first set of extension requests would require waiver of the provisions of Rule 2.89 which provide first, that the "applicant request" the extension of time and, second, that the request be supported by a verified statement "by the applicant" [read, in this case: officer of the corporation]. These provisions of the rule cannot be waived because they are statutory in nature. The two provisions set forth in the rule are reflective of the requirement set forth in Section 1(d)(2) of the statute that conditions the Commissioner's grant of an extension on the filing of "a written request of the applicant."

Finally, regardless of the construction accorded petitioner's request for waiver of Rule 2.89, and putting aside the fact that the provisions of the rule that are sought to be waived are statutory in nature, the request for relief would have to be denied because the circumstances presented by the instant petitions are not extraordinary in nature. The fact that a particular petitioner, if its petition were denied, would face the potential loss of substantive rights, does not constitute an "extraordinary situation" under the rules governing petitions to the Commissioner. Rather, the circumstances must be such that they precluded petitioner's compliance with the particular rule sought to be waived. Here, the rule in issue is clear, and no circumstances have been alleged which prevented petitioner's compliance with the rule.

D. Request for Broad Construction of "Applicant"

***5** As an alternative to its request for waiver of provisions of Rule 2.89, petitioner has sought to have the extension requests verified by Mr. Kovach "validated" on petition through application of either (1) the "color of authority" doctrine set forth in Trademark Rule 2.71(c), 37 C.F.R. § 2.71(c), or (2) the doctrine sometimes employed in post-registration matters resulting in broad construction of the term "registrant."

Various provisions of Section 1 of the Trademark Act require proper signatures by officers of corporate applicants on applications, extension requests and statements of use. However, as petitioner has noted, Rule 2.71(c) provides that "color of authority" signatures on applications may be accepted for the purpose of determining the sufficiency of the application for filing. In addition, as petitioner has also noted, Rule 2.71(c) extends this practice to statements of

use. [FN2] See "Examination Guide 3-89: Implementation of the Trademark Law Revision Act of 1988 and the Amended Rules of Practice in Trademark Cases," published as a supplement to the TMEP, at pages 43-44 (discussing Rule 2.71(c)) and pages 34-35 (discussing application of "color of authority" provisions to statements of use); See also, 54 Fed.Reg. 37,570 (September 11, 1989) (discussion of "color of authority" provision within discussion of changes and additions to Trademark Rules).

Petitioner seeks to extend the "color of authority" provision of Rule 2.71(c) to a request for extension of time to file a statement of use.If this were done, then the timely filed extension requests executed by Mr. Kovach could be considered for their acceptability as requests having been executed and filed by one with "color of authority" to act on behalf of the applicant. This request to extend the "color of authority" doctrine to cover the instant case must be denied.

Through the "color of authority" provision of Rule 2.71(c), the Office has chosen to accord a broader construction to the term "applicant" under particular circumstances. Specifically, these circumstances involve showing that the signer has "first-hand knowledge of the truth of the statements in the verification or declaration" and also has "actual or implied authority to act on behalf of the applicant."

Petitioner clearly believes a broader construction of the term "applicant" is warranted in the case at hand. However, as petitioner acknowledges in its petitions, the Office has specifically chosen not to employ the broad construction of "applicant" in regard to extension requests and has announced this policy in the aforementioned examination guide published as a supplement to the TMEP. The examination guide states: "The 'color of authority' provision of Trademark Rule 2.71(c), 37 C.F.R. Section 2.71(c), does not apply to the filing of requests for extensions of time."

***6** The Office has specifically chosen not to utilize the "color of authority" doctrine in connection with extension requests. One basis for this decision is rooted in administrative concerns. Applications and statements of use, unless they are determined not to comply with even the minimum acceptable terms for filing, are eventually examined by attorneys. Examining Attorneys can be expected to be able to handle questions involving "color of authority." Requests for an extension of time to file a statement of use are only examined by the clerical personnel in the Intent to Use and Divisional Unit, who are not likely to be as adept in making the legal judgments inherent in the handling of "color of authority" issues.

In addition, substitute verifications must be supplied for applications and statements of use filed with "color of authority" signatures. The time frames within which these two types of documents are processed allow for the later substitution of properly verified documents. However, Office policy calls for quick processing of extension requests and this policy would be undercut if applicants and the clerical employees of the Intent to Use Unit had to engage in protracted correspondence concerning execution and "color of authority" issues. Accordingly, the Office has simply adopted a policy which

precludes the use of "color of authority" signatures on extension requests.

Even if the instant situation, for the sake of argument, is considered under the "color of authority" doctrine, petitioner's request for relief must be denied. Petitioner has filed a declaration signed by Mr. Kovach that is sufficient to establish his "first-hand knowledge" of the continuing bona fide intention to use the marks in issue. Mr. Kovach serves as Assistant Secretary and Director, Intellectual Property Law, of Raynet Corporation. Raynet is the subsidiary of petitioner that will eventually engage in use of the marks (such use inuring to petitioner's benefit). However, there is nothing in the record to indicate that Mr. Kovach was possessed of the "actual authority" to act on petitioner's behalf. Further, petitioner has failed to even argue that the circumstances establish the "implied authority" of Mr. Kovach to act on petitioner's behalf.

Petitioner's final argument seeks validation of the extension requests verified by Mr. Kovach through use of a broadened construction of the term "applicant," analogous to the broadened construction given the term "registrant" in In re Trademark Registration of Cooper Industries, Inc., 16 U.S.P.Q.2d 1453 (Comm'r Pats. 1990). Petitioner asserts that the Cooper decision holds that a declaration of continued use filed pursuant to Section 8 of the Trademark Act can be accepted, despite improper verification, when the signer of the declaration is shown to have "knowledge of the facts" concerning use of the registered mark.

The instant case presents a different situation than that presented in the post registration context in which Cooper and similar cases have arisen. In post registration cases where the Office is urged to apply a broadened construction of the term "registrant," a registration has issued for a mark in actual use in commerce and the registration has generally been in effect for between five and six years. The policy behind Section 8 of the Trademark Act is the removal of "deadwood" from the register. The broad construction of the term "registrant," to allow for the maintenance of valid registrations for marks that remain in actual use, is not contrary to the purpose of Section 8 and allows registrants to retain valuable rights they have accrued over a period of time.

***7** In the instant case, the marks have never been used and petitioner's loss of "rights" is limited to the loss of the still contingent constructive dates of first use. In addition, the Office must encourage applicants to comply with the clear provisions of the Trademark Act and the Trademark Rules that govern the prosecution of applications for registration. To allow for a broadened construction of the term "applicant" in this case would undercut the Office's stated policy that "color of authority" signatures are not acceptable on extension requests.

Finally, even if the Cooper rationale was applied to the instant case petitioner's request for relief would have to be denied. As with its argument regarding the "color of authority" doctrine, petitioner fails to note the second prong of the Cooper decision. Apart from showing the signer's actual knowledge of the use of the mark, Cooper requires "registrant's ratification of the signer's action." In re Cooper, 16

U.S.P.Q.2d at 1455 (citing In re Schering Agrochemicals Limited, 6 U.S.P.Q.2d 1815 (Comm'r Pats.1987). Though the instant petitioner has established Mr. Kovach's knowledge of the circumstances surrounding the intention to use the marks in issue, petitioner has not ratified his action.

E. Petitioner's Plea for Equitable Relief

Petitioner argues that any refusal of its request to permit filing of the substitute extension requests would cause "manifest injustice ... as the present application[s] would become abandoned and such could result in significant loss in substantive rights to Applicant." "Justice" has been defined to mean "the quality of conforming to principles of reason, to generally accepted standards of right and wrong, and to the stated terms of laws, rules, agreements, etc., in matters affecting persons who could be wronged or unduly favored." 727 The Random House College Dictionary (emphasis added). The fact that petitioner's applications may become abandoned and petitioner would lose the potential constructive dates of first use for the marks in issue does not mean that denial of the petitions at hand would constitute "manifest injustice."

There has been no error or abuse of discretion by Office personnel which has resulted in the situation at hand. Further, the "just" treatment of all applicants requires the Office, in this case, to adhere to the "stated terms" of laws and rules absent a compelling reason to draw an exception. Petitioner has not presented compelling enough arguments to warrant drawing such an exception to the stated terms of the Trademark Act and Trademark Rules. It is petitioner's own failure to comply with the "stated terms" of laws and rules, of which petitioner was clearly aware, that has given rise to the instant situation.

CONCLUSION

The petitions are denied. The applications will be returned to the Intent to Use and Divisional Unit for the preparation and issuance of actions retracting the acceptance of the approvals issued for the extension requests in issue. Since the time for filing properly verified extension requests has passed, the applications will be declared abandoned.

FN1. Though they are not substantively acceptable because they do not comply with the requirements of the Trademark Rules and the statute, the extension requests were "approved" by the Intent to Use and Divisional Unit. Therefore, with the instant petitions, the previous "approval" of the extension requests is sought to be validated on petition.

FN2. "Color of authority" signatures may also be accepted on amendments to allege use filed pursuant to Trademark Rule 2.76(e)(3), 37 C.F.R. §

2.76(e)(3).

1991 WL 326571 (Com'r Pat. & Trademarks), 20 U.S.P.Q.2d 1355

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