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

RE: TRADEMARK APPLICATION OF SOCIETE DES PRODUITS NESTLE S.A.
Serial No. 73/786,171
July 13, 1990
***1** Petition Filed: January 25, 1990

For: TASTER'S CHOICE
Filing Date: March 13, 1989

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On petition

Shurfine-Central Corporation has petitioned the Commissioner pursuant to 37 C.F.R. § 2.146(e)(1) for reversal of the Trademark Trial and Appeal Board's refusal to accept its request for an additional extension of time in which to file a Notice of Opposition against the above-captioned application; and for acceptance of its Notice of Opposition submitted with the petition.

The above application was published for opposition on August 15, 1989. Petitioner filed a timely request for a sixty day extension of time to oppose; the period for opposition was consequently extended to November 13, 1989. On November 16, 1989, with certificate of mailing pursuant to 37 C.F.R. § 1.8, dated November 13, 1989, petitioner filed a request for an additional sixty day extension. In a letter dated January 9, 1990, the Applications Examiner at the Trademark Trial and Appeal Board notified petitioner that the additional extension of time requested on behalf of potential opposer, if granted, would result in total extensions of time aggregating 150 days from the date of publication of applicant's mark, and therefore, could not be granted because petitioner did not recite extraordinary circumstances in the request, and since there is no indication that applicant has consented thereto, the request is granted only to the extent that potential opposer is allowed until December 13, 1989 in which to file an

opposition. The Applications Examiner further informed petitioner "in the event that potential opposer has subsequently obtained applicant's consent to the requested extension, the Board will entertain a request for reconsideration." This petition followed. [FN1]

Petitioner contends that the circumstances are extraordinary in this case because the second request for an extension of time recited the existence of settlement discussions and was served on opposing counsel and not objected to; and the approval for an extension of time until December 13, 1989 was not mailed until January 9, 1990 even though the extension request was received by the Board on November 16, 1989.

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).

Trademark Rule 2.102(c) provides, in part:

***2** [E]xtensions of time to file an opposition aggregating more than 120 days from the date of publication of the application 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.

The Applications Examiner at the Board correctly determined that the circumstances recited in the request did not constitute an extraordinary situation as set out in Rule 2.101(c)(3), because the mere existence of ongoing settlement discussions does not constitute an extraordinary situation, and, in fact, are often utilized prior to determining whether to file a notice of opposition. Therefore, no error or abuse of discretion by the Board has been found. However, it was inappropriate for the Applications Examiner to notify petitioner that the Board would entertain a request for reconsideration should petitioner provide proof of a subsequently obtained consent to the requested extension. Proper practice for the Board would be to deny such a request for reconsideration. Cf. In re Sprang Industries, Inc., 225 USPQ 888 (Comm'r Pats.1985) (potential opposer must be identified with reasonable certainty); In re Software Development Systems, Inc., USPQ_____ (Comm'r Pats.1989) (proof of service on applicant or its authorized representative required).

Trademark Rules 2.146(a)(5) and 2.148 provides that the Commissioner may suspend a rule that is not a requirement of the statute in an extraordinary situation, when justice requires and no other party is injured thereby. Although it is regrettable that petitioner was not timely notified that the requestedextension was only partially granted, Rule 2.102(c) clearly requires consent of applicant or extraordinary circumstances. Omission of such requirements on the part of petitioner, or its attorney, is not considered an extraordinary situation to justify waiver of the rule. In re Bird & Son, Inc., 195 USPQ 586 (Comm'r Pats.1977).

The petition is denied. The application file will be returned to the Board, after which it will be forwarded to the Trademark Services Division for issuance of the registration.

Petitioner is not without remedy in this case. Once the mark in question registers, petitioner may file a petition to cancel the registration under 15 U.S.C. § 1064.

FN1. Applicant filed a memorandum in response to this petition on February 15, 1990.

17 U.S.P.Q.2d 1093

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