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

RE: TRADEMARK APPLICATION OF AMETHYST INVESTMENT GROUP
95-183
July 14, 1995
***1** Petition Filed: October 31, 1994

For: MIZANI
Serial No. 74-348242
Filing Date: January 13, 1993

Philip G. Hampton, II

Assistant Commissioner for Trademarks

On Petition

Amethyst Investment Group has petitioned the Commissioner to accept as timely filed its Request for Extension of Time to File a Statement of Use for the above-identified application. Trademark Rule 2.146, 37 C.F.R. Section 2.146, provides authority for the requested review.

FACTS

A Notice of Allowance issued for the subject application, which is based on a bona fide intention to use the mark in commerce, pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. Section 1051(b), on September 7, 1993. Pursuant to Section 1(d) of the Act, either a Statement of Use, or a Request for an Extension of Time to File a Statement of Use, was required to be filed within six months after the mailing date of the Notice of Allowance.

Petitioner timely filed and was granted its first Request for an Extension of Time to File a Statement of Use, thereby extending the period to file a Statement of Use until September 7, 1994.

A second Request for an Extension of Time to File a Statement of Use was received in the Patent and Trademark Office by Express Mail and was given a filing date of September 8, 1994. Enclosed was an unsigned certificate of mailing by Express Mail indicating that the date of deposit with the United States Postal Service (USPS) was September 7, 1994.

By letter dated January 23, 1995, the Applications Examiner for the ITU/Divisional Unit notified Petitioner that the papers were late and would not be accepted as timely filed. Petitioner was advised that the application would be abandoned in due course. The application was abandoned effective September 8, 1994. This Petition was filed on October 31, 1994. [FN1] Petitioner has submitted a copy of the Express Mail mailing label showing the date of deposit with the USPS as September 7, 1994.

DECISION

The timely filing of documents in the Patent and Trademark Office requires that they actually be received in the Office within the set period. Pursuant to Rule 1.6, 37 C.F.R. Section 1.6, trademark papers are stamped with the date of receipt in the Office, unless such papers are filed in accordance with Rule 1.10, 37 C.F.R. Section 1.10, which provides for the filing of papers and fees by Express Mail with a certificate. However, in order to claim the benefits of Rule 1.10, a party must comply with the specific requirements set forth therein, including inter alia, a certificate of mailing by Express Mail which states the date of mailing and is signed by the person mailing the papers.

The Patent and Trademark Office has recognized the problematic nature of the requirement for a certificate of mailing by Express Mail and its apparent redundancy in purpose, inasmuch as the date of deposit with the USPS has already been entered on the mailing label by a disinterested third party, the USPS. Therefore, by notice published in the Official Gazette on May 16, 1995, the Office announced its proposal to amend Rule 1.10 by, among other things, deleting the certificate of mailing requirement. 1174 TMOG 92. Pursuant to the proposal, the requirement has been waived for all correspondence filed in the Patent and Trademark Office on or after May 16, 1995. Id.

***2** Trademark Rule 2.146(a), 37 C.F.R. Section 2.146(a), permits the Commissioner to invoke supervisory authority, and waive Patent and Trademark Office rules, where appropriate. Though the recent waiver of the certificate requirement was adopted subsequent to the filing of Petitioner's Request for Extension of Time to File a Statement of Use, it is reasonable to extend the benefit of that waiver to the case at hand, where the USPS employee has already independently supplied proof that the papers were timely deposited as Express Mail on September 7, 1994.

Accordingly, the Petition is granted and the extension request is deemed filed on September 7, 1994. The application will be forwarded to the ITU/Divisional Unit of the Office for further action. Any future communications should be directed to that Unit.

FN1. Petitioner filed its third Request for Extension of Time to File a Statement of Use on March 6, 1995.

END OF DOCUMENT