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

B AND E SALES COMPANY, INC., PETITIONER
v.
THE ANDREW JERGENS COMPANY, RESPONDENT
Opposition Nos. 69,286 and 70,929
April 27, 1988

Allen M. Krass, Esq.

***1** Krass & Young

2855 Coolidge, Suite 210

Troy, Michigan 48084-9871

William G. Pecau, Esq.

Pennie & Edmonds

1155 Avenue of the Americas

New York, NY 10036

Donald W. Peterson

Deputy Commissioner of Patents and Trademarks

DECISION DENYING PETITION

B and E Sales Company, Inc. (B & E), applicant in the two above-referenced oppositions, petitions the Commissioner under 37 CFR 2.145(d) to extend the time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit, or in the alternative, under 37 CFR 2.148, to waive the sixty-day requirement of the filing rule. The petition is denied.

BACKGROUND

The Trademark Trial and Appeal Board (board) issued a decision dated August 21, 1987, sustaining two oppositions filed by respondent The Andrew Jergens Company. No request for reconsideration was filed. Accordingly, a notice of appeal was due in the U.S. Patent and Trademark Office (PTO) on October 20, 1987, sixty (60) days after the date of the board's decision. 37 CFR 2.145(d).

On October 20, 1987, B & E mailed its notice of appeal to the PTO using a "certificate of mailing." See 37 CFR 1.8. Counsel for petitioner states that the notice of appeal was prepared and given to his secretary for filing. An affidavit by the secretary states that on

October 20, 1987, she was "given charge of filing a notice of appeal" in connection with the referenced oppositions. It is further stated that the secretary called the board and was informed by a receptionist, who is said to have consulted with a staff attorney, that the certificate of mailing procedure was sufficient for this document. The secretary then "mailed the notice of appeal via first class mail in accord [sic accordance] with the procedure of 35 [sic 37] CFR 1.8(a)."

Section 1.8 provides a procedure for mailing papers to the PTO with a certificate of mailing, however, the rule includes several enumerated exceptions to this procedure. Under paragraph 1.8(a)(2)(ix), notices of appeal to the Federal Circuit are listed as an exception to the use of a certificate of mailing. Accordingly, since B & E's notice of appeal was not received (and therefore not filed) in the PTO until October 23, 1987, it was filed three days late. In re Thrifty Corp., 231 USPQ 560 (Comm'r Pat. 1986).

Respondent opposes the petition, arguing that petitioner has not made a sufficient showing to grant the petition for "sufficient cause" under 37 CFR 1.145(d) or as an "extraordinary circumstance" under 37 CFR 1.148.

OPINION

***2** The time to file a notice of appeal to the Federal Circuit may be extended by the Commissioner upon a showing of sufficient cause. 37 CFR 1.145(d). Recently, in Sweats Fashions, Inc. v. Pannill Knitting Co., 2 USPQ 2d 1380, 1382 (Comm'r Pat.1987), the Commissioner discussed what constitutes a showing of "sufficient cause" and held that it is not to be determined by comparison with the standard of "excusable neglect." In Sweats, there was a showing of sufficient cause where the lateness was due to an unexplained failure in the firm's central docketing system in combination with a miscalculation of the sixty-day appeal period by counsel in her own back-up system for noting deadlines.

In the present case, there is no allegation by counsel that he was familiar with the Trademark Rules of Practice with respect to filing a notice of appeal to the Federal Circuit. Nor does he allege that he attempted to determine the proper method for filing such an appeal even though he was apparently aware of the fact that it was the last day for filing the notice of appeal. Rather, counsel for petitioner delegated the responsibility for determining the appropriate method for filing the notice of appeal to his secretary. His secretary alleges that she was advised by a receptionist at the board that the certificate of mailing procedure was sufficient for the document and that she then mailed the notice of appeal in accordance with the procedure of 35 CFR 1.8(a).

While it is unfortunate that counsel's secretary may have relied on the board's employee, practitioners are expected to know the rules. Compare In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat.1985) (petitioner's reliance upon a telephone inquiry to the solicitor's office was misplaced since, "he is presumed either to know the provisions of the rules or at the least to be able to obtain and interpret those rules"); In re Jones, 542 F.2d 65, 191 USPQ 249, (CCPA

1976) (attorneys appearing before the court are presumed to have knowledge of the provisions of the current court rules); Potter v. Dann, 201 USPQ 574, (D.D.C.1978) (Markey C.J. CCPA sitting by designation) (unawareness of rules is not a basis for finding unavoidable delay). Moreover, it is not clear that counsel's secretary indicated what type of notice of appeal was to be filed. If the board's employee assumed it was an appeal to the Trademark Trial and Appeal Board, then the certificate of mailing procedure would have been correct.

In addition, it is apparent that counsel and his secretary were aware of 37 CFR 1.8(a). If counsel had simply reviewed the rule, it would have been readily apparent that there are exceptions to the use of the certificate of mailing procedure. The first sentence reads: "Except in the cases enumerated below, papers and fees required to be filed in the Patent and Trademark Office within a set period of time will be considered as being timely filed...." 37 CFR 1.8(a) (emphasis added). Thus, although petitioner contends that justice requires that the extension be granted since the mistake in filing arose from misinformation originating with the board, it would appear instead that the mistake was the result of counsel's failure to review the rule. Similarly, rejected is petitioner's argument that the lack of substantive injury or harm to respondent is a basis for granting an extension of time. As indicated in In re Sivertz, supra, 227 USPQ at 256, lack of injury to another party or to the public is not recognized as a sufficient basis for waiving provisions of the rules. "To do otherwise would defeat the purpose of the rule." Id.

***3** Petitioner's request pursuant to 37 CFR 2.148 to waive the sixty-day filing provision in 37 CFR 2.145(d) is also denied. Petitioner has not shown that the late filing was the result of an extraordinary situation where justice requires waiver of a rule. See Gustafson v. Strange, 227 USPQ 174 (Comm'r Pat.1985) (counsel's unawareness of provisions of 37 CFR 1.8(a) is not an extraordinary case, and that unawareness does not show that justice requires waiver of any provision of § 1.8); In re Sivertz, supra (unawareness of 37 CFR 1.304 time limit for notice of appeal does not constitute "extraordinary situation"). [FN1] Dresser Industries, Inc. v. Safety-Kleen Corp., 183 USPQ 180 (Comm'r Pat.1974), cited by petitioner, is inapposite since the subject petitions requesting extensions of time to seek rehearing or reconsideration at the board (construed by the Commissioner as requests for waiver of a time requirement) were not filed out-of-time and were in fact granted. Thus, there was no untimely notice of appeal at issue in that case.

Petitioner's request for a retroactive extension of time to file a notice of appeal to the Federal Circuit is denied.

FN1. Indeed, as discussed in Sweats Fashions, Inc. v. Pannill Knitting Co., supra, 2 USPQ 2d at 1381-82, the "extraordinary situation" standard for waiving time requirements under 37 CFR 2.148 is a stricter standard than "sufficient cause," added to 37 CFR 2.145 by amendment in 1976.

END OF DOCUMENT