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

RE: TRADEMARK REGISTRATION OF MCLACHLAN TOUCH, INC.
87-42
November 16, 1987
***1** Petition Filed: July 20, 1987

For: Miscellaneous Design
Registration No. 1,434,015
Issued: March 24, 1987

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On Petition

The Formal Wear Accessory Company, Inc. has petitioned the Commissioner to accept its Notice of Opposition as having been timely filed. Trademark Rule 2.146(a)(3) provides appropriate authority for consideration of this request.

The above identified mark was published for opposition as Application Serial No. 73/612,826 on December 30, 1986. The last day for filing a Notice of Opposition or Request for an Extension of Time to Oppose was January 29, 1987. Since no opposition or request for an extension of time to oppose had been received during the opposition period, the mark was registered on March 24, 1987, as Registration No. 1,434,015.

Petitioner's attorney states in the petition that on January 21, 1987, he mailed a request for a 60 day extension of time to oppose, with a certificate of mailing pursuant to Trademark Rule 1.8(a).

Petitioner included with the petition a copy of this request which states as the reason for the extension request that "Petitioner is now investigating the circumstances of use in the products set forth in said application and additional time is needed to complete the investigation and take appropriate action." [FN1] The copy of the request contains a certificate of mailing pursuant to Trademark Rule 1.8(a). The Patent and Trademark Office has no record that this request was ever received.

Petitioner's Notice of Opposition, with a certificate of mailing dated March 16, 1987, was received by the Patent and Trademark Office on March 18, 1987. By letter dated July 1, 1987, the Trademark Trial and Appeal Board informed the petitioner that it was without authority to consider the opposition since it was not timely filed.

Section 13 of the Trademark Act, 15 U.S.C. 1063, provides that upon "written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Commissioner for good cause when requested prior to the expiration of an extension."

Trademark Rule 1.8 establishes procedures for the timely filing of certain papers (as described in Rule 1.8(a)) with the Patent and Trademark Office by depositing the papers with the U.S. Postal Service. The rule is "intended to solve, in part, the problems caused by delays in the delivery of papers by mail to the Patent and Trademark Office within the time periods set for response by applicants." 41 Fed.Reg. 43720 (October 4, 1976). See also 41 Fed. Reg. 24895 (June 21, 1976), and 942 O.G. 1073 (January 20, 1976). This practice was established to avoid prejudicing a party before the Office due to a Patent and Trademark Office or U.S. Post Office error resulting in lost correspondence.

***2** Trademark Rule 1.8(b) provides that, with a required showing, correspondence which complies with the requirements of Trademark Rule 1.8(a) will be considered as being timely filed even though it was not received by the Patent and Trademark Office. Application of Rule 1.8(b) to grant the Extension Request and, thus, institute the Opposition at this time would require an Office determination that the registration was inadvertently issued, cancellation of the subject registration number, and restoration of the application to pendency.

Petitioner did not comply with the requirements of Trademark Rule 1.8(b) because the petition does not include a declaration as required by the rule. Therefore, the petition is denied. The opposition is not timely filed and Registration No. 1,434,015 will remain active. The Trademark Trial and Appeal Board is directed to refund the petitioner's opposition fee.

However, even if petitioner was to comply fully with the requirements of Rule 1.8(b), the petition would be denied for the following reasons. The Commissioner will exercise with caution his inherent authority to cancel a registration that has been issued inadvertently. Cancellation of this registration as inadvertently issued could potentially result in considerable hardship for the registrant, who has conducted business for more than 8 months on the assumption that the registration is

valid. Whereas, if the registration is not declared to be inadvertently issued by the Office, and the opposition is not instituted, there is no undue prejudice to the petitioner because the same rights could be determined in a cancellation proceeding. Therefore, while compliance with Rule 1.8(b) would result in a timely filed opposition, the opposition would not be instituted in this case because, on balance, an equal alternative remedy exists for the petitioner.

FN1. Petitioner's attorney expresses his belief that the grant of the Extension of Time to Oppose is "pro forma." The petitioner could not assume that the extension had been granted since the Board has the discretion to deny requests for extensions of time to file oppositions in excess of 30 days, and petitioner's request was for a 60 day Extension of Time to Oppose. See Trademark Rule 2.102(c). However, should it be determined that this Request was timely filed, petitioner has set forth sufficient cause to grant the Extension for the second 30 day portion of the 60 day request.

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