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

RE: TRADEMARK REGISTRATION OF SIEMENS AKTIENGESELLSCHAFT
94-216
February 2, 1995
***1** Petition Filed: June 6, 1994

For: NOTEPHONE (stylized)
Registration No. 1,824,965
Issued: March 8, 1994

Robert M. Abderson

Deputy Assistance Commissioner for Trademarks

On Petition

Lotus Development Corp. has petitioned the Commissioner to cancel the above registration as inadvertently issued and to reset the time period for filing a Notice of Opposition against registration of the above identified mark. Review of this petition is undertaken pursuant to Trademark Rule 2.146(a)(3), 37 C.F.R. § 2.146(a)(3).

FACTS

The subject mark was published for opposition in the Official Gazette on December 14, 1993. On January 12, 1994, [FN1] Petitioner filed a request for an extension of time to file a Notice of Opposition through February 13, 1994. On February 16, 1994, with a certificate of mailing dated February 11, 1994, Petitioner filed another request for extension through March 13, 1994. The above identified registration issued on March 8, 1994. This petition was subsequently filed on June 6, 1994. [FN2] On June 29, 1994, with a certificate of mailing dated June 27, 1994, Applicant filed a response to the petition. [FN3] Petitioner then filed a reply to the response, bearing a certificate of mailing dated July 18, 1994.

Counsel for Petitioner asserts that the two extension requests were timely filed and that the Office mistakenly issued the above registration while the underlying application was the subject of an unexpired Extension Request.

Petitioner requests that the registration be canceled, and that the time for filing the Notice of Opposition be reset for some time following the cancellation date of the registration.

DECISION

Section 13 of the Trademark Act, 15 U.S.C. § 1063, provides that a Notice of Opposition may be filed within thirty days after the date of

publication of a mark; that upon written request prior to the expiration of the thirty-day period, the time for filing an opposition shall be extended for an additional thirty days; and that further extensions of time for filing an opposition may be granted by the Board for good cause when requested prior to the expiration of an extension.

Where a registration issues from an application that is the subject of an unexpired extension of time to oppose, such a registration is called an "inadvertently issued" registration. The Commissioner has the authority to cancel an inadvertently issued registration; however, that inherent authority is to be exercised with caution. In re Trademark Registration of Mc Lachlan Touch inc., 6 U.S.P.Q.2d 1395 (Comm'r Pats.1987). In the present case, Petitioner timely filed two extension requests, and during the extension time period, the subject mark registered.

Current Office practice holds that the inadvertent issuance of a registration which is the subject of an unexpired extension of time to oppose does not serve to stay the running of the extension of time to oppose; that is, it does not relieve the potential Opposer of the responsibility for filing an opposition, or further requests for extensions of time to oppose. See Lotus Development Corp. v. Narada Productions, Inc., 23 U.S.P.Q.2d 1310 (Comm'r Pats.1991). Petitioner has not continued to file extension requests nor has a Notice of Opposition been filed since the filing of this petition.

***2** Prior to the Lotus decision, however, if the Commissioner canceled an inadvertently issued registration, Potential Opposer's time for opposing was automatically reset by the Board. In such cases, the running of Potential Opposer's extension of time to oppose was deemed by the Board to have been suspended by the inadvertent issuance of the registration. When the time to oppose was reset, Potential Opposer normally was allowed thirty days for the purpose of filing an extension of time to oppose or a Notice of Opposition; and the running of the 120-day period of Trademark Rule 2.102(c) was considered to have been tolled for the length of the suspension, if the suspension began during the 120-day period.

Upon further consideration, the pre-Lotus practice of suspending the Potential Opposer's time period for filing additional requests for extensions of time to oppose, or a Notice of Opposition, where a registration has inadvertently issued, appears to be more in keeping with the spirit of the Trademark Act. A Potential Opposer cannot logically file an opposition against a registration, and it is not beneficial administratively for the Office to require a Potential Opposer to continue filing papers with the Office.

Accordingly, the petition is granted and the subject registration will be canceled in due course. When the application file is returned to the Board, the Board will reset Potential Opposer's time to oppose according to the above guidelines.

FN1. The extension request is dated-stamped January 14, 1994, and appears to be a copy of a facsmile letter. No certificate of mailing or certificate of transmission appears anywhere thereon nor is one appended to the extension request. However, Petitioner has submitted a

copy of the date-stamped receipt which bears the date January 12, 1994.

FN2. On March 9, 1994, Petitioner filed a request with the consent of Applicant, for a ninety-day extension of time through June 6, 1994.

FN3. Although Trademark Rule 2.146(e)(1) provides that an Applicant may submit a response to a petition filed in cases where the Board has denied a request for an extension of time to file a notice of opposition, there is no rule or regulation that provides for the filing of a response in cases such as this where a registration has inadvertently issued while the underlying application was the subject of an unexpired request for an extension of time to oppose.

34 U.S.P.Q.2d 1862

END OF DOCUMENT