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

RE: TRADEMARK APPLICATION OF ALCO INDUSTRIES, INC.
94-259
February 2, 1995
***1** Petition Filed: September 12, 1994

For: QUALITY PRODUCTS FROM PEOPLE WHO CARE
Serial No. 74/303,159
Filing Date: August 6, 1992

Philip G. Hampton, II

Assistant Commissioner for Trademarks

On Petition

Alco Industries, Inc. has petitioned the Commissioner to reverse the denial of a Request for Extension of Time to File a Statement of Use in connection with the above-identified application. Trademark Rules 2.89(g) and 2.146(a)(3) provide authority for the requested review.

Facts

The above-identified application was filed under Section 1(b) of the Trademark Act, based upon the Applicant's bona fide intention to use the proposed mark in commerce. The mark was published for opposition on April 13, 1993. When no opposition was filed, a Notice of Allowance issued on July 6, 1993. Pursuant to Section 1(d) of the Trademark Act, a Statement of Use, or a Request for Extension of Time to File a Statement of Use, was required to be filed within six months of the mailing date of the Notice of Allowance.

On January 4, 1994, Petitioner timely filed its first Request for Extension of Time to File a Statement of Use. The extension request was approved, affording Petitioner the opportunity to file a Statement of Use, or a second Request for Extension of Time to File a Statement of Use, within twelve months of the mailing date of the Notice of Allowance. On July 1, 1994, Petitioner filed a second extension request, in which it stated "Applicant has not yet made use of the mark in commerce on all of the goods specified in the Notice of Allowance on or in connection with which Applicant has a continued bona fide intention to use the mark in commerce." Petitioner further stated "The mark, as set forth hereinabove, consists of the words 'QUALITY PRODUCTS FROM PEOPLE WHO CARE.' In view of the length of the mark, it is better suited for display on packaging for the goods, rather than on the goods themselves. The goods are presently in packages which do not include the mark and in view of the expense involved in redesigning packaging to include the mark, Applicant intends to use the mark in new packaging when such new packaging is developed for the goods."

In an Office Action dated August 23, 1994, the Applications Examiner

in the ITU/Divisional Unit denied the second extension request because it did not include a showing of good cause, as required by Trademark Act Section 1(d)(2) and Trademark Rule 2.89(b)(4). Petitioner was advised that, since the period of time within which to file an acceptable extension request or Statement of Use had expired, the application would be abandoned, effective July 7, 1994.

This petition was filed on September 12, 1994, under a certificate of mailing dated September 7, 1994. Petitioner contends that in its second extension request it submitted a satisfactory explanation for its failure to make ongoing efforts to use the mark in commerce on each of the goods specified in the verified statement of continued bona fide intention to use.

Decision

***2** Section 1(d)(2) of the Trademark Act and Trademark Rule 2.89(b)(4) require that a second extension request include a showing of good cause, in addition to an allegation of a continued bona fide intention to use the mark in commerce. Trademark Rule 2.89(d)(2) further provides that "good cause" may be established by either a showing of ongoing efforts to use the mark in commerce on or in connection with each of the goods or services specified in the verified statement of continued bona fide intention to use, or a satisfactory explanation for the failure to make such efforts.

In this case, Petition submitted as part of its second extension request a satisfactory explanation for its failure to make ongoing efforts to use the mark in commerce on each of the goods specified in the verified statement of continued bona fide intention to use. The explanation is clear: (1) the mark is long, so it fits on packaging for goods better than on goods themselves; (2) the goods are presently in packages which do not include the mark; (3) it is expensive to redesign the package to include the mark; and (4) when new packaging is developed for the goods, applicant intends to include the mark in the new packaging.

Since Trademark Rule 2.146(a)(3) permits the Commissioner to invoke his supervisory authority in appropriate circumstances and Petitioner has shown that the second extension request did include a showing of good cause, the declaration and documents are accepted and the petition is granted. The application will be reinstated and forwarded to the ITU/Divisional Unit to await the filing of a Statement of Use, or a third Request for Extension of Time to File a Statement of Use. Since this petition was necessitated by Office error, the petition filing fee will be refunded in due course.

Mary E. Hannon

Staff Attorney, Office of the Assistant Commissioner for Trademarks

The Commissioner's Decision mailed February 16, 1995, is amended as follows:

On page 1, under the heading "Facts," line 2 of the third paragraph is amended by substituting "good" for "goods."

On page 2, under the heading "Decision," line 2 of the paragraph is amended by substituting "good" for "goods."

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