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

RE: TRADEMARK APPLICATION OF OMEGA-3 MARKETING, INC.
94-229
November 10, 1994
***1** Petition Filed: June 16, 1994 [FN1]

For: OGGS
Serial No. 74/319,338
Filing Date: October 2, 1992

Philip G. Hampton, II

Assistant Commissioner for Trademarks

On Petition

Omega-3 Marketing, Inc. has petitioned the Commissioner to revive the above identified application. Trademark Rules 2.89(g) and 2.146(a)(3) provide authority for the requested review.

Facts

On May 4, 1993, 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. Petitioner's first request for extension of time to file a Statement of Use was filed on November 3, 1993, and was approved.

Petitioner filed a second extension request on April 29, 1994. The request was filed on PTO Form 1581 (Rev. 9-89), a pre-printed form supplied by the Patent and Trademark Office. The form contains an allegation that "Applicant has a continued bona fide intention to use the mark in commerce in connection with the following goods/services: (Check one below)." The applicant is then required to check the appropriate box and fill in any necessary blanks. The two alternatives available to the applicant are as follows:

Those goods/services identified in the Notice of Allowance in this application

Those goods/services identified in the Notice of Allowance in this application except: (Identify goods/services to be deleted from application)

Petitioner failed to check either of these boxes. In an Office Action dated June 2, 1994, the Applications Examiner in the ITU/Divisional Unit of the Office denied the extension request because it did not specify the goods or services on or in connection with which the applicant had a contined bona fide intention to use the mark in commerce, as is required by Section 1(d)(2) of the Trademark Act, 15 U.S.C. § 1051(d)(2), and Trademark Rule 2.89(b)(3), 37 C.F.R. § 2.89(b)(3).

Petitioner was advised that its only recourse was to petition the Commissioner. This petition was filed June 16, 1994.

Decision

Section 1(d)(2) of the Trademark Act, 15 U.S.C. § 1051(d)(2), and Trademark Rule 2.89(b)(3), 37 C.F.R. § 2.89(b)(3), clearly and explicitly require that a request for an extension of time to file a Statement of Use include a verified statement that the applicant has a continued bona fide intention to use the mark in commerce, specifying those goods or services on or in connection with which the applicant has a continued bona fide intention to use the mark. Since this is a statutory requirement, it must be satisfied prior to the expiration of the period for filing the Statement of Use. In re Hoffmann-La Roche Inc., 25 U.S.P.Q.2d 1539, 1541 (Comm'r Pats.1992); In re Custom Technologies, Inc., 24 U.S.P.Q.2d 1712 (Comm'r Pats.1992); TMEP § 1105.05(d)(1).

***2** In this case, Petitioner failed to check either of the boxes available for identifying the goods on which it had a continued bona fide intention to use the mark in commerce. However, a reasonable reading of the extension request would indicate that the applicant either had a continued bona fide intention to use the mark in commerce in connection with all the goods identified in the Notice of Allowance, or a continued bona fide intention to use the mark in commerce in connection with less than all the goods identified in the Notice of Allowance. It is therefore reasonable to assume that the failure to specify any goods that should be deleted from the application was meant to indicate that the extension request was to cover all of the goods identified in the Notice of Allowance.

Since Trademark Rule 2.146(a)(3) permits the Commissioner to invoke supervisory authority in appropriate circumstances, the petition is granted, and the extension request is approved. The application file will be forwarded to the ITU/Divisional Unit of the Office to await the filing of a Statement of Use.

Henceforth, where an applicant files a request for extension of time to file a Statement of Use on PTO Form 1581, and the applicant fails to check either of the boxes available for identifying the goods or services on or in connection with which it has a continued bona fide intention to use the mark in commerce, the Applications Examiners in the ITU/Divisional Unit may assume that the applicant has a continued bona fide intention to use the mark in commerce on or in connection with all the goods or services identified in the Notice of Allowance, and may approve the request.

FN1. The petition was perfected by submission of the petition fee, required by Trademark Rule 2.6(a)(15), on August 12, 1994.

33 U.S.P.Q.2d 1158

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