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

RE: TRADEMARK APPLICATION OF IMI CORNELIUS INC.
94-86
May 13, 1994
***1** Petition Filed: February 3, 1994

For: ULTRA FLOW-1
Serial No. 74/235,743
Filing Date: January 6, 1992

Robert M. Anderson

Acting Assistant Commissioner for Trademarks

On Petition

IMI Cornelius 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

A Notice of Allowance issued on April 20, 1993 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. Pursuant to Section 1(d) of the Act, a Statement of Use, or request for an 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 October 15, 1993, petitioner timely filed a Request for Extension of Time to File a Statement of Use. The request was signed by applicant's in-house counsel. In an Office action dated January 6, 1994, the Applications Examiner in the ITU/Divisional Unit denied the extension request because the statement of continued bona fide intention to use the mark in commerce had not been signed by a president, vice-president, secretary or treasurer of the corporate applicant. Petitioner was advised that, since the period of time within which to file an acceptable extension request had expired, the application would be abandoned in due course.

This petition followed. In a declaration accompanying the petition, petitioner declares that the in-house attorney who signed the extension request is an employee of the corporation employed in the "New Product Development" division; and that he works closely with the engineers responsible for the project involving the subject mark and has full knowledge of the daily operations of the company. A substitute extension request properly signed by a corporate officer has been submitted with the petition.

DECISION

Pursuant to Section 1(d)(2) of the Trademark Act, 15 U.S.C. § 1051(d)(2), and Trademark Rule 2.89(a)(3), 37 C.F.R. § 2.89(a)(3), any request for extension of time in which to file a Statement of Use must be properly verified by the applicant. Specifically, the request must include a verified statement by the applicant that the applicant has a continued bona fide intention to use the mark in commerce.

Section 1105.05(d) of the Trademark Manual of Examining Procedure (TMEP), In re Compuadd Corp., 25 U.S.P.Q.2d (Comm'r Pats.1992) and In re Raychem Corp., 20 U.S.P.Q.2d 1355 (Comm'r Pats.1991) enumerate past Office practice with respect to the verification of extension requests, i.e., the request must include a statement of a continued bona fide intention to use the mark in commerce, and only those individuals who possess statutory authority to sign the original application are permitted to sign the request for an extension of time. The "color of authority" provisions of Trademark Rule 2.71(c) have been expressly precluded from application to extension requests. [FN1] Thus, in the present case, the Applications Examiner properly refused acceptance of the extension request because it did not appear to be signed by a corporate officer of applicant.

***2** However, if verification is provided by an individual with color of authority in connection with Statements of Use or an application, Office practice has been to allow an applicant to correct the defective execution by submitting a substitute verification during examination, properly signed by the applicant as defined by the Trademark Act. See TMEP § 803 et seq.

The practice of requiring verification of extension requests by the applicant as defined by the Trademark Act was established when the Trademark Law Revision Act of 1988 was implemented on November 16, 1989, and the ITU/Divisional Unit was in its infancy with respect to handling the voluminous filings of extension requests, divisional requests and Statements of Use. [FN2]

After further consideration of the capabilities of the now firmly established and functioning ITU/Divisional Unit, and in light of the fact that there is no express limitation upon the "color of authority" provision of Rule 2.71(c), the practice enumerated in TMEP § 1105.05(d), In re Compuadd and In re Raychem, supra, is overruled to the extent that the "color of authority" provisions of Rule 2.71(c) will be applied to both extension requests and Statements of Use.

Thus, any extension request verified by an individual other than the applicant as defined by the Trademark Act will be deemed acceptable provided that, (1) the color of authority of the signer is established and, (2) that a properly signed substitute verification is submitted within thirty days from the date of notification by the ITU/Divisional Unit of the improper verification. If no timely response is received, the ITU/Divisional Unit will abandon the application.

In the present case, petitioner has shown that the signatory of the extension request had the requisite color of authority to sign on behalf of the applicant. In addition, a substitute request properly

signed by a corporate officer has been submitted, thus satisfying the requirements of Rule 2.71(c).

Accordingly, the petition is granted. The application will be forwarded to the ITU/Divisional Unit for acceptance of the extension request.

FN1. Under Rule 2.71(c), "[a] verification or declaration which is signed by a person having color of authority to sign, is acceptable for the purpose of determining the timely filing of the paper. Persons having color of authority to sign are those who have first-hand knowledge of the truth of the statements in the verification or declaration and who also have actual or implied authority to act on behalf of the applicant. However, a properly signed substitute verification or declaration must be submitted before the application will be approved for publication or registration, as the case may be."

FN2. Statements of Use that bear a signature are examined for compliance with Rule 2.71(c) by Examining Attorneys and do not affect the workflow processing of the ITU/Divisional Unit.

33 U.S.P.Q.2d 1062

END OF DOCUMENT