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

RE: TRADEMARK APPLICATION OF KABUSHIKI KAISHA HITACHI SEISAKUSHO
94-124
May 4, 1994
***1** Petition Filed: December 6, 1993

For: I-ZTAT
Serial No. 74/215,986
Filing Date: October 28, 1991

Robert M. Anderson

Acting Assistant Commissioner for Trademarks

On Petition

i-STAT Corporation has petitioned the Commissioner to reverse the decision of the Applications Examiner at the Trademark Trial and Appeal Board denying a request for an extension of time to file a notice of opposition to the registration of the above referenced mark. Trademark Rule 2.146(a)(3) provides authority for the requested review.

FACTS

The mark in the subject intent-to-use application published for opposition in the Official Gazette on July 14, 1992. Petitioner timely filed several requests for extensions of time to file an opposition which were granted by the Board, extending the time to file an opposition through October 19, 1993.

On October 20, 1993, petition filed a request for a thirty day extension of time with a certificate of service and a certificate of mailing by Express Mail with this same date. By letter dated November 23, 1993, the Applications Examiner at the Board informed the petitioner that the extension request was not timely filed, and the request was summarily denied. This petition followed. [FN1]

Counsel for petitioner declares that the extension request was filed one day late because an employee miscalculated the due date for the request by adding one additional day to the thirty day period of time of the previous extension. Counsel asserts that this employee mistakenly believed that the federal holiday of Columbus Day, which occurred on October 11, 1993, affected the time period for filing the request.

DECISION

Trademark Rules 2.146(a)(5) and 2.148 permit the Commissioner to waive any provision of the Rules which is not a provision of the

statute, where an extraordinary situation exists, justice requires and no other party is injured thereby. However, the Commissioner has no authority to waive a requirement of the statute.

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. "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 further extensions of time for filing [an] opposition may be granted by the Commissioner for good cause when requested prior to the expiration of an extension (emphasis added)."

Section 13 was expressly amended in 1982 to require that any further extension requests, and the Notice of Opposition, be filed prior to the expiration of any previous extensions. Public Law 97-247 § 13(a) 1982.

Petitioner's failure to file the subject extension request prior to the expiration date of the previous extension request, and thus prior to the due date for filing an opposition, is in violation of the time restraints dictated by the statute. Since the time period for filing an opposition or requesting an extension of time to oppose is prescribed by statute, the Commissioner has no authority to waive this requirement. In re Cooper, 209 USPQ 670 (Comm'r Pats.1980).

***2** Furthermore, even if the time period for filing an opposition or requesting an extension of time to oppose was not statutory, the circumstances presented here do not justify a waiver of the rules. An oversight or a misunderstanding of trademark practice and procedure is not an extraordinary situation, within the meaning of Rules 2.146(a)(5) and 2.148. In re Tetrafluor Inc., 17 U.S.P.Q.2d 1160 (Comm'r Pats.1990); In re Choay S.A., 16 U.S.P.Q.2d 1461 (Comm'r Pats.1990); In re Bird & Son, Inc., 195 USPQ 586 (Comm'r Pats.1977).

Accordingly, the petition is denied. The application file will be forwarded to the ITU/Divisional Unit for issuance of the Notice of Allowance.

FN1. Petitioner has filed additional requests for extensions of time to file an opposition, requesting additional time to file an opposition through March 17, 1994. It is unclear whether additional extension requests or a notice of opposition have been filed.

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