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

RE: TRADEMARK APPLICATION OF GAMLA ENTERPRISES N.A. INC.
94-21
February 28, 1994
***1** Petition Filed: October 25, 1993

For: GENACO OPTICS and design
Serial No. 74/282,826
Filing Date: June 8, 1992

Robert M. Anderson

Acting Assistant Commissioner for Trademarks

On Petition

Gamla Enterprises N.A. Inc. has petitioned the Commissioner to accept a Statement of Use filed in connection with the above application. Trademark Rule 2.146(a)(3) provides authority for the requested review.

FACTS

The Notice of Allowance for the subject intent-to-use application issued on February 2, 1993. On August 2, 1993, petitioner filed a Statement of Use. In an Office action dated September 1, 1993, the Applications Examiner in the ITU/Divisional Unit notified petitioner that the papers submitted August 2, 1993 did not comply with the minimum requirements for filing a Statement of Use, because the prescribed fee, as required by Trademark Rule 2.88(e)(1), had not been submitted. Petitioner was advised that, since the period of time within which to file an acceptable Statement of Use had expired, the application would be abandoned in due course.

The application was then declared abandoned with an effective date of abandonment of August 3, 1993. This petition was then filed on October 25, 1993.

Petitioner's counsel argues that a check for the prescribed fee was inadvertently and unintentionally not included with the Statement of Use. However, the original application contained a general authorization "to charge any additional fees which may be required, or to credit any overpayment, to" a specified deposit account number. According to counsel for petitioner, "[n]o restriction was ever placed on the duration of the authorization, thus when the Statement of Use was received without the prescribed fee, the Commissioner was authorized at that time to charge the deposit account of applicant's attorneys."

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. Since the requirement that a Statement of Use be accompanied by a filing fee is statutory, it cannot be waived by the Commissioner. In re L.R. Sport, Inc., 25 U.S.P.Q.2d 1533 (Comm'r Pats.1992). Thus petitioner's inadvertent omission of the filing fee for the Statement of Use is in contravention of the statute and cannot be waived in this instance. 37 C.F.R. § 1051(d)(1).

Furthermore, even if the requirement for timely submission of the filing fee for a Statement of Use were not statutory, the circumstances presented here do not justify a waiver of the rules. An oversight or inadvertent omission 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).

***2** Petitioner's argument that the blanket authorization contained in the original application to utilize the law firm deposit account for any "additional fees" is sufficient authorization to debit their account for the filing fee for the Statement of Use is not persuasive.

Although Rule 1.25(b), 37 C.F.R. § 1.25(b), permits the filing of a "general authorization to charge all fees, or only certain fees, set forth in § § 1.16 to 1.18 to a deposit account containing sufficient funds ..., either for the entire pendency of the application or with respect to a particular paper filed," it is noted that Rules 1.16 through 1.18 relate only to patent fees. There is no provision in the Rules for, nor does Office practice permit, the filing of a general authorization to charge a deposit account for all trademark fees which may become due during the pendency of a trademark application. A trademark applicant must submit required fees, or an authorization to charge such fees to a deposit account, with each paper when filed.

Accordingly, the petition is denied. The application will remain abandoned. The $100 filing fee submitted with the petition for the Statement of Use will be refunded in due course.

33 U.S.P.Q.2d 1476

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