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

RE: TRADEMARK APPLICATION OF SPARC INTERNATIONAL, INC.
93-258
December 27, 1993
***1** Petition Filed: July 9, 1993

For: SPARCCOMPATIBLE
Serial No. 74/098,026
Filing Date: September 18, 1990

Robert M. Anderson

Acting Assistant Commissioner for Trademarks

On Petition

SPARC International, 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

The subject application was filed under Section 1(b) of the Trademark Act, based upon the applicant's bona fide intention to use the mark in commerce. A Notice of Allowance issued on October 8, 1991. Petitioner's first Request for Extension of Time to File a Statement of Use was timely filed on March 31, 1992. On October 8, 1992, petitioner timely filed its second Request for Extension of Time to File a Statement of Use, asserting that "Applicant believes that it has made valid use of the mark in commerce, and is in [sic] process of preparing the Statement of Use; however, if the Statement of Use is not prepared and filed by the current deadline, applicant will need additional time in which to file the Statement of Use."

On April 8, 1993, petitioner filed a third Request for Extension of Time to File a Statement of Use, again asserting that "Applicant believes that it has made valid use of the mark in commerce, and is in process of preparing the Statement of Use; however, if the Statement of Use is not prepared and filed by the current deadline, applicant will need additional time in which to file the Statement of Use."

In an Office action dated June 9, 1993, the Applications Examiner in the ITU/Divisional Unit denied the third extension request because it did not include a showing of good cause, as required by Trademark Act Section 1(d)(2), 15 U.S.C. § 1051(d)(2), and Trademark Rule 2.89(b)(4), 37 C.F.R. § 2.89(b)(4). This petition was filed July 9, 1993.

Decision

Section 1(d)(2) of the Trademark Act, 15 U.S.C. § 1051(d)(2), and Trademark Rule 2.89(b)(4), 37 C.F.R. § 2.89(b)(4), require that a second or subsequent request for extension of time to file a Statement of Use include a showing of good cause. This is a statutory requirement that cannot be waived by the Commissioner. In re Twin Cities Public Television, Inc., 25 U.S.P.Q.2d 1535 (Comm'r Pats.1992). The statute provides that the "Commissioner shall issue regulations setting forth guidelines for determining what constitutes good cause...." Section 1(d)(2) of the Trademark Act, 15 U.S.C. § 1051(d)(2).

Trademark Rule 2.89(d)(2), 37 C.F.R. § 2.89(d)(2), promulgated in accordance with the Commissioner's authority under Section 2(d)(2) of the Act, requires that the showing of good cause include a statement of the applicant's ongoing efforts to make use of the mark in commerce on or in connection with each of the goods or services for which the applicant has a continued bona fide intention to use the mark in commerce. A mere assertion that the applicant is engaged in ongoing efforts is not sufficient; the efforts must be specified. TMEP § 1105.05(d)(ii).

***2** The Office has determined that the allegations that an applicant "has made use of the mark in commerce and is in the process of preparing a Statement of Use" is an affirmation of ongoing efforts to use the mark that is substantially in compliance with the requirements of Section 1(d)(2) of the Trademark Act and Trademark Rule 2.89(d)(2) for a showing of good cause. Thus, in this case, petitioner's assertions that it "believed it had made valid use of the mark and was in the process of preparing a Statement of Use, but that it would need additional time if the Statement of Use were not prepared and filed by the current deadline" were deemed sufficient to constitute substantial compliance with the statutory requirement for a showing of good cause for its second extension request, filed October 8, 1992.

However, Trademark Rule 2.89(d)(2) requires that the showing of good cause include a statement of an applicant's "ongoing" efforts to make use of the mark on the goods, and "ongoing" means "[p]rogressive or evolving." The American Heritage Dictionary (2nd College Ed.1982). Accordingly, petitioner's repetition in its third extension request of the allegations set forth in the second extension request is not, without more, a statement of the applicant's ongoing efforts.

While the requirement that a second or subsequent extension include a showing of good cause is statutory, the requirement for a statement of the applicant's ongoing efforts to make use of the mark is set by rule, and as such can be waived by the Commissioner under appropriate circumstances. 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. All three conditions must be satisfied before a waiver is granted.

Although petitioner gives no reason for its failure to include a statement of its ongoing efforts to make use of the mark in its third extension request, it is presumed that such failure was inadvertent. However, it is settled that oversights and inadvertent omissions are not extraordinary situations, within the meaning of Trademark 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).

The petition is denied. The application is abandoned. The $100 fee for filing the fourth extension request, filed October 8, 1993, will refunded in due course.

33 U.S.P.Q.2d 1479

END OF DOCUMENT