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

RE: TRADEMARK APPLICATION OF ROBERT D. KINSMAN
93-267
December 6, 1993
***1** Petition Filed: September 27, 1993

For: IN LIMBO
Serial No. 74/001,520
Filing Date: November 16, 1989

Robert M. Anderson

Acting Assistant Commissioner for Trademarks

On Petition

Robert D. Kinsmen 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

A Notice of Allowance issued on July 17, 1990 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 a 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 January 4, 1991, petitioner filed the first of a series of five timely extension requests that were granted by the ITU/Divisional Unit, extending the time to file a Statement of Use through July 17, 1993. On July 9, 1993, petitioner filed a Statement of Use and an extension request as well as specimens and a check in the amount of $100.

In a letter dated August 31, 1993, the Paralegal Specialist in the ITU/Divisional Unit denied the Statement of Use because it failed to include a verification or declaration as required by Trademark Act Section 1(d), 37 C.F.R. § 1051(d)(2). [FN1]

This petition followed. Petitioner declares that verification of the Statement of Use was inadvertently omitted and, further, that the omission was entirely unintentional.

DECISION

Section 1(d)(1) of the Trademark Act states that a Statement of Use must contain "a verified statement that the mark is in use in commerce and specifying the date of the applicant's first use of the mark in

commerce, those goods or services specified in the notice of allowance ... and the mode or manner in which the mark is used on or in connection with such goods or services (emphasis added)." 37 C.F.R. § 1051(d)(1).

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. In re Culligan International Co., 915 F.2d 680, 16 U.S.P.Q.2d 1234 (Fed.Cir.1990); In re Raychem Corp., 20 U.S.P.Q.2d 1355 (Comm'r Pats.1991). Since the requirement for verification of a Statement of Use is statutory, it cannot be waived by the Commissioner.

Furthermore, even if the requirement for verification of a Statement of Use was 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** The petition is denied. The application will remain abandoned. Applicant may wish to consider filing a new application. The Office will not hold the denial of this petition to be prejudicial to the applicant in the filing of a new application. [FN2]

FN1. In addition to refusing to accept the Statement of Use, the extension request was denied by the Paralegal Specialist because it would cause the total time period in which the applicant may file a Statement of Use to exceed 36 months following the issuance of the Notice of Allowance, and would thus be in contravention of Section 1(d)(2) of the Trademark Act, 37 C.F.R. § 1051(d)(2), and Trademark Rule 2.89(c), 37 C.F.R. § 2.89(c). However, petitioner has requested review of the denial of the Statement of Use only, and therefore neither the denial of the extension request, nor the issue of the filing fee for the extension request, will be reviewed on petition.

FN2. NOTE: For your information, the Patent and Trademark Office recently published a notice of proposed rulemaking regarding its intention to increase the fee for filing a trademark application from $210 to $245 per class. 58 Fed.Reg. 39102 (July 21, 1993); 1152 TMOG 91 (July 27, 1993). An applicant may call the Office at (703) 308-HELP to determine the correct filing fee before filing a new application.

33 U.S.P.Q.2d 1057

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