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

RE: TRADEMARK APPLICATION OF DANIEL WOLF
94-19
December 6, 1993
***1** Petition Filed: October 6, 1993

For: MODE TV
Serial No. 74/285,798
Filing Date: June 17, 1992

Robert M. Anderson

Acting Assistant Commissioner for Trademarks

On Petition

Daniel Wolf has petitioned the Commissioner to accept a $100 filing fee, filed after the six month period for filing an extension request, for a second class of services in a request for an extension of time to file a Statement of Use where the extension request was filed with a filing fee for only one class. Trademark Rules 2.146(a)(5) and 2.148 provide appropriate authority for the requested review.

FACTS

A Notice of Allowance issued on February 9, 1993 for the subject two class application in classes 38 and 41, whichis 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 July 30, 1993, petitioner filed a request for an extension of time to file a Statement of Use with a filing fee of $100 to cover one class in the application. According to the unverified petition, [FN1] on September 29, 1993, an Applications Examiner in the ITU/Divisional Unit informed petitioner by telephone that the Class 41 services would be abandoned due to petitioner's omission of the filing fee for the second class of services. [FN2] This petition followed. The Office subsequently received a check on November 15, 1993 in the amount of $100 to cover the second class of services in the application.

DECISION

Section 1(d)(2) of the Trademark Act requires that a request for an extension of time to file a Statement of Use "be accompanied by the prescribed fee." Trademark Rule 2.89 also reiterates that an extension request must include "[t]he fee prescribed in § 2.6." 37 C.F.R. §

2.89. The filing fee for a request for an extension of time to file a Statement of Use is $100 per class. 37 C.F.R. § 2.6(a)(4).

Section 1105.05(d) of the Trademark Manual of Examining Procedure and In re Stakis plc, 25 U.S.P.Q.2d 1529 (Comm'r Pats.1992) both enumerate past Office practice with respect to filing fees for extension requests, i.e., the filing fees for all classes must accompany the extension request or must be submitted prior to the expiration of the six month period for filing the request. Thus, in the present case, the Applications Examiner properly advised petitioner that the Class 41 services would be abandoned because only one fee had been timely submitted for the extension request.

However, if fees insufficient to cover all classes are submitted in connection with a Statement of Use or an application, Office practice allows an applicant to supplement the filing after the expiration of any statutory period. Trademark Manual of Examining Procedure (TMEP) § § 805.03, 810.01 and 1105.05(f)(vii).

***2** The practice of requiring the filing of fees for all classes in an extension request during the six month period for filing the extension request 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 the handling of voluminous filings of extension requests, divisional requests and Statements of Use.

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 statutory requirement that fees for all classes accompany extension requests, the practice outlined in TMEP § 1105.05(d) and in In re Stakis, supra, is overruled to the extent that extension requests accompanied by a filing fee sufficient for one class may be supplemented with fees for additional classes set forth in the Notice of Allowance, provided that any additional fees are submitted within thirty days from the date of notification by the ITU/Divisional Unit of the fee deficiency.

The thirty day deadline for responding to a fee deficiency letter will be strictly enforced and applicants will be encouraged to use deposit accounts or to utilize the express mail provisions of Trademark Rule 1.10. The certificate of mailing provisions of Trademark Rule 1.8 do not apply to extension requests, 37 C.F.R. § 1.8(a)(2)(xv), and any responses to a fee deficiency letter following Rule 1.8 will be date-stamped with the date of actual receipt by the Office.

If no timely response to a fee deficiency letter is received, the ITU/Divisional Unit will apply the fees to the lowest numbered classes in ascending order, unless, within the thirty day period, applicant expressly abandoned a specific unpaid-for class.

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

FN1. All facts to be proven on petition must be in the form of an affidavit or declaration under 37 C.F.R. § 2.20. 37 C.F.R. §

2.146(c).

FN2. Office practice requires the Applications Examiner to allow the applicant to choose which class(es) will go forward. If the applicant does not respond, the lower numbered class(es) will be maintained.

33 U.S.P.Q.2d 1054

END OF DOCUMENT