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

RE: TRADEMARK APPLICATION OF SKY IS THE LTD.
96-336
December 6, 1996
***1** Petition Filed: September 13, 1996

For: BIBLE BREAD
Serial No. 74-526,616
Filing Date: May 20, 1994

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Philip G. Hampton, II

Assistant Commissioner for Trademarks

On Petition

Sky is the Ltd. has petitioned the Commissioner to accept a Statement of Use filed on April 24, 1996, in connection with the above application. The petition is granted under Trademark Rule 2.146(a)(3).

FACTS

A Notice of Allowance issued for the subject application on November 7, 1995. Pursuant to Section 1(d) of the Trademark 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 April 24, 1996, Petitioner filed a Statement of Use. In an Office letter dated July 24, 1996, the Legal Instruments Examiner in the ITU/Divisional Unit notified Petitioner that the papers submitted on April 24, 1996, 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, effective May 8, 1996. This petition was then filed on September 13, 1996. [FN1]

Petitioner declares that a check for the Statement of Use was inadvertently or unintentionally omitted. However, the initial application included a written general authorization from the Applicant stating that "should any additional fees be required in connection with this application, please charge to Deposit Account No. 23-2185." Petitioner states that since no restrictions were placed on the duration of the authorization of the deposit account, when the Statement of Use was received without the prescribed fee, the ITU/Divisional Unit should have charged the Statement of Use fee to Petitioner's deposit account.

DECISION

Trademark Rule 2.146(a)(3) permits the Commissioner to invoke supervisory authority in appropriate circumstances and this is such a circumstance. The petition is granted.

Section 1(d)(1) of the Trademark Act, 15 U.S.C. § 1051(d)(1), provides, in part, that:

> Within six months of the issuance of the notice of allowance ... the applicant shall file in the Patent and Trademark Office, together with such number of specimens or facsimiles of the mark as used in commerce as may be required by the Commissioner and payment of the prescribed fee, 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 on or in connection with which the mark is used in commerce, and the mode or manner in which the mark is used on or in connection with such goods or services.

***2** 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." Rules 1.16 through 1.18 relate specifically to patent fees. It has been the practice of the Office to deny petitions to the Commissioner to accept a general authorization to charge a deposit account for all trademark fees which may become due during the pendency of a trademark application. Past Office practice required that a trademark Applicant submit required fees, or an authorization to charge such fees to a deposit account, with each paper when filed. The result of this policy was the abandonment of applications when the Applicant had no time left in the period for filing the Statement of Use. In re Gamla Enterprises N.A. Inc., 33 USPQ2d 1476 (Comm'r Pats. 1994).

Upon further consideration and review of Rules 1.16 through 1.18, and 1.25(b), the Commissioner has determined that since the Rules do not expressly prohibit a general authorization to charge a deposit account for all trademark fees that may become due during the pendency of an application, that such authorizations may be accepted. In re Gamla,

supra, is therefore overruled.

However, a general authorization to charge Petitioner's deposit account will be effective only on petition to the Commissioner. Requiring the Office mailroom and the ITU/Divisional Unit of the Office to check each application file for a general authorization to charge a deposit account would place an undue and unmanageable burden on those sections of the Office.

The application file shall be forwarded to the ITU/Divisional Unit for further processing.

FN1. Petitioner perfected its petition by submitting a declaration in accordance with 37 C.F.R. § 2.20, on November 13, 1996, as required by Trademark Rule 2.146(c).

42 U.S.P.Q.2d 1799

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