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

RE: TRADEMARK APPLICATION OF COMDIAL CORPORATION
93-157
September 21, 1993
***1** Petition Filed: April 26, 1993

For: TELEPATH
Serial No. 74-146556
Filing Date: March 8, 1991

Robert M. Anderson

Acting Assistant Commissioner for Trademarks

On Petition

Comdial Corporation has petitioned the Commissioner to reverse the denial of Request for Extension of Time to File a Statement of Use in connection with the above identified application. Trademark Rules 2.89(g) and 2.146(a)(3) provide authority for the requested review.

On August 11, 1992, petitioner timely filed its first Request for Extension of Time to File a Statement of Use. The extension request was approved, affording petitioner the opportunity to file a Statement of Use, or second request for an extension of time to file a Statement of Use, within twelve months from the mailing date of the Notice of Allowance. Petitioner filed a second extension request on February 16, 1993.

In an Office action dated March 30, 1993, the Paralegal Specialist in the ITU/Divisional Unit denied the 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. Section 1051(d)(2), and Trademark Rule 2.89(b)(4), 37 C.F.R. § 2.89(b)(4). Petitioner was advised that, since the period of time within which to file an acceptable extension request or Statement of Use had expired, the application would be abandoned in due course. This petition followed.

In its petition, Applicant asserts that neither the Lanham Act nor the Trademark Rules requires the applicant to state with specificity the type of ongoing efforts being made to use a mark. Therefore, the statement contained in applicant's second request for extension of time to file a statement of use that "Applicant has made ongoing efforts to use the mark" should, in and of itself, be sufficient.

Section 1(d)(2) of the Act and Trademark Rule 2.89(b)(4) require that a second extension request include a showing of good cause, in addition to the allegation of a continued bona fide intention to use the mark in commerce. Trademark Rule 2.89(d)(2) further explains the nature of "good cause," as follows:

> The showing required by paragraph (b)(4) of this section must include:
>
> (2) A statement of applicant's ongoing efforts to make use of the

mark in commerce on or in connection with each of the goods or services specified in the verified statement of continued bona fide intention to use required under paragraph (b) of this section. Those efforts may include, without limitation, product or service research or development, market research, manufacturing activities, promotional activities, steps to acquire distributors, steps to obtain required governmental approval, or other similar activities. In the alternative, a satisfactory explanation for the failure to make such efforts must be submitted.

***2** It is noted that the Rule requires "[a] statement of applicant's ongoing efforts" not "a statement that applicant is making ongoing efforts." In fact, the Trademark Manual of Examining Procedure specifically explains that "[a] mere assertion that the applicant is engaged in ongoing efforts is not sufficient; the efforts must be specified. TMEP § 1105.05(d)(ii). [FN1]

Since petitioner's extension request merely set forth a statement that it had made ongoing efforts but did not specify any type(s) of ongoing efforts that were actually being made, the extension request did not include a showing of good cause, and it was properly denied. The requirement to assert a showing of good cause in an extension request 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).

Furthermore, even if the requirement to assert a showing of good cause were not statutory, the circumstances presented here do not justify a waiver of the rules. 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. Counsel's misinterpretation of the rules does not constitute an extraordinary situation.

The petition is denied. The application is abandoned.

FN1. "TMEP" refers to the Trademark Manual of Examining Procedure (2nd Edition, 1993), which is available by subscription from the Superintendent of Documents, United States Government Printing Office, Customer Service Section SSOS, Washington, D.C. 20402 (Stock Number 903-010-00000-2) for $19.00 ($23.75 for foreign mailing). Although the second edition of the TMEP was not published until June of 1993, months after the pertinent events occurred, a similar explanation was clearly set forth in Examination Guide 3-89: Implementation of the Trademark Law Revision Act of 1988 and the amended Rules of Practice in Trademark Cases, issued as a supplement to the Trademark Manual of Examination Procedure (TMEP), Revision 7, and published in the Official Gazette on October 11, 1989, 1110 TMOG 465.

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