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

RE: TRADEMARK APPLICATION OF INFORMIX SOFTWARE, INC.
93-156
September 17, 1993
***1** Petition Filed: May 3, 1993

For: 4GL ++
Serial No. 74-195,304
Filing Date: August 16, 1991

Robert M. Anderson

Acting Assistant Commissioner for Trademarks

On Petition

Informix Software, Inc. has petitioned the Commissioner to revive the identified application, pursuant to Trademark Rule 2.66. [FN1]

FACTS

A Notice of Allowance issued on July 14, 1992 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 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.

Applicant submitted a statement of use on January 13, 1993. Subsequently, the examining attorney issued an office action on March 19, 1993. This Office received papers titled as "Petition For Revival Of Abandoned Application" and "Request For Extension Of Time ... to File a Statement of Use" on May 3, 1993.

ANALYSIS

The application is currently pending and not abandoned. [FN2] According to Rule 2.88(e), the statement of use submitted on January 13, 1993 met the minimum requirements. Petitioner has asserted that it is not yet using the mark for the identified software goods. Thus, he concludes that the statement of use is premature and invalid.

The petition is construed as an attempt to withdraw a previously and timely submitted statement of use. However, once applicant has filed the statement of use, the applicant may not withdraw the statement ofuse and return to the previous status of awaiting submission of the statement of use. 37 C.F.R. § 2.88(g); TMEP § 1105.05(f)(i)(C).

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.

Oversights that could have been prevented by the exercise of ordinary care or diligence are not extraordinary situations as contemplated by the Trademark Rules. 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). Petitioner's premature assertion of use in its statement of use is not an extraordinary situation.

A request for an extension of time to file a statement of use may be filed along with a statement of use or within the time remaining for filing a statement of use. 37 C.F.R. § 2.89(e)(1). The purpose of such a request is to secure additional time to correct any deficiency in the statement of use which is of a type which may be corrected before the expiration of the time permitted for filing the statement of use. Because the statement of use may not be withdrawn, the applicant must correct any such deficiency within the time provided to file the statement of use or the application will become abandoned. TMEP § 1105.05(iv).

***2** To qualify for an extension request filed under Rule 2.89(e)(1), the request must be filed within the six month period during which the statement of use was filed. Here applicant has submitted this request on May 3, 1993, almost 4 months after the expiration of that period. Therefore, the request cannot be used to extend time to cure any deficiencies in the statement of use.

DECISION

The petition is DENIED. Applicant has until September 20, 1993 to respond to the outstanding Office action. The application will be forwarded to the examining attorney. The $100 fee submitted in connection with the extension request will be scheduled for refund.

FN1. The petition is more appropriately reviewed under Trademark Rule 2.146. Trademark Rule 2.66 provides for revival of an abandoned application upon a showing that the applicant was unavoidably delayed in filing a document in a timely fashion. In this case, a Statement of Use was timely filed and met the requirements of the statute.

FN2. Confirmed in a telephone conversation on July 14, 1993 with Jerry Wright.

32 U.S.P.Q.2d 1861

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