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

RE: TRADEMARK APPLICATION OF BLAIR CAMPBELL
93-16
March 31, 1993
***1** Petition Filed: November 6, 1992

For: QUICKSPLINT
Serial No. 74/114,610
Filing Date: November 13, 1990

Robert M. Anderson

Acting Assistant Commissioner for Trademarks

On Petition

Blair Campbell has petitioned the Commissioner to accept a Statement of Use filed in connection with the above application. Trademark Rules 2.146(a)(3), 2.146(a)(5) and 2.148 provide authority for the requested review.

Facts

The subject application was filed under Section 1(b) of the Trademark Act, based upon the applicant's bona fide intention to use the mark in commerce. The mark was published for opposition on January 14, 1992. When no opposition was filed, a Notice of Allowance issued on April 7, 1992. 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 September 30, 1992, petitioner filed a Statement of Use. In an Office action dated October 22, 1992, the Applications Examiner in the ITU/Divisional Unit notified petitioner that the papers submitted September 30, 1992 did not comply with the minimum requirements for filing a Statement of Use, because the applicant had not submitted at least one specimen or facsimile of the mark as used in commerce, as required by Trademark Rule 2.88(e)(2). 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 abandoned, effective October 8, 1992.

This petition was filed November6, 1992. Three specimens of use of the mark were submitted with the petition. Petitioner asserts that his product can be used as either a splint or a prosthetic device; that after this application was filed, he realized that the identification of goods covered only use of the product as a prosthetic device and not as a splint; that he then filed a second application, Serial No. 74/272,191, based on use in commerce, for the mark QUICKSPLINT for splints; that the two applications constitute one product; that

applicant could have filed a single application covering use of the product as both a prosthetic device and as a splint; and that the specimens submitted with the petition are identical to those submitted in connection with Application Serial No. 74/272,191.

Decision

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 (emphasis added).

***2** Trademark Rule 2.88(e), 37 C.F.R. § 2.88(e), sets forth the minimum requirements that a Statement of Use must meet before it can be referred to an examining attorney for examination. The Statement of Use must include (1) the fee prescribed in § 2.6; (2) at least one specimen or facsimile of the mark as used in commerce; and (3) a verification or declaration signed by the applicant stating that the mark is in use in commerce. Deficiencies in a Statement of Use can be corrected only if there is time remaining in the period for filing the Statement of Use. 37 C.F.R. § 2.88(g). There is no provision in the Trademark Act or the Trademark Rules of Practice for transfer of a specimen from one application to a related application.

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 that a Statement of Use be accompanied by at least one specimen is statutory, it cannot be waived by the Commissioner.

Furthermore, even if the requirement for timely submission of a specimen with a Statement of Use were not statutory, the circumstances presented here do not justify a waiver of the rules. Neither the fact that applicant is the owner of a second application containing a different identification of goods for a "single product," which could have been combined with the subject application, nor the fact that the specimens submitted with Application Serial No. 74/272,191 support use of the mark in connection with the goods which are the subject of the instant application constitutes an extraordinary situation, within the meaning of Trademark Rules 2.146(a)(5) and 2.148.

The petition is denied. The application is abandoned.

33 U.S.P.Q.2d 1055

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