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

RE: TRADEMARK APPLICATION OF CANNON RUBBER LIMITED
96-174
December 02, 1996
***1** Petition Filed: March 22, 1996

For: NIPLETTE
Serial No. 74/410222
Filing Date: July 6, 1993

Attorney for Petitioner:

Anibal Jose Cortina, Esq.

Ruden, McClosky, Smith, Schuster & Russell, P.A.

P.O. Box 1900

Fort Lauderdale, Florida 33302

Philip G. Hampton, II

Assistant Commissioner for Trademarks

On Petition

Cannon Rubber Limited has petitioned the Commissioner to accept a Statement of Use filed in connection with the above-identified application. Trademark Rule 2.146 provides authority for the requested review.

FACTS

On November 1, 1994, a Notice of Allowance issued for the subject application. 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, i.e., on or before May 1, 1995.

On April 28, 1995, Petitioner filed its first Request for Extension of Time to File a Statement of Use, which was granted. On November 3, 1995, Petitioner filed both a Statement of Use and a second Request for Extension of Time to File a Statement of Use. In an Office Action dated January 25, 1996, the Applications Examiner in the ITU/Divisional Unit notified Petitioner that neither the Statement of Use nor the extension request could be accepted because they had not been filed within the existing granted extension period. 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 declared

abandoned. The fees for both the Statement of Use and the second extension request were subsequently refunded. This petition followed. [FN1]

According to a supplemental declaration submitted by Petitioner's counsel, the Statement of Use and the extension request were mailed with Certificates of Mailing under Trademark Rule 1.8, 37 C.F.R. § 1.8.

DECISION

Revision of Trademark Rule 1.8

Trademark Rule 1.8, 37 C.F.R. § 1.8, has recently been amended. Specifically, Rule 1.8(a)(2) has been amended to remove the exclusions formerly listed in § 1.8(a)(2)(ii)(B) through (F). Therefore, Statements of Use, under 15 U.S.C. § 1051(d)(1) are now considered timely if they are mailed or transmitted by thedue date and in compliance with Rule 1.8(a)(1). Communications with the Patent and Trademark Office, 1192 TMOG 95 (November 26, 1996).

Under 35 U.S.C. 2.146(a)(3), the Commissioner may invoke supervisory authority in appropriate circumstances, and 37 C.F.R. § § 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.

***2** Although the amendment to Rule 1.8 was adopted subsequent to the filing of Petitioner's Statement of Use and second extension request, it is reasonable to extend the benefit of the amendment to the case at hand. The situation is deemed extraordinary, in that Petitioner's Statement of Use was rejected as untimely based upon the requirements of a rule which the Office believes to be unnecessary, and which is no longer in effect.

Petitioner's declaration evidence shows that Petitioner fully complied with the provisions of Rule 1.8. Therefore, the Statement of Use is considered to be timely, because it was deposited with the U.S. Postal Service as first class mail in an envelope addressed to the Commissioner of Patents and Trademarks on November 1, 1995.

Accordingly, the petition is granted. The application file will be forwarded to the ITU/Divisional Unit for examination of the Statement of Use. [FN2]

FN1. Trademark Rule 2.89(g), 37 C.F.R. § 2.89(g), requires that "[a] petition from the denial of a request for an extension of time to file a statement of use shall be filed within one month from the date of mailing of the denial of the request." Since the Office Action refusing to accept the Statement of Use and extension request as timely was mailed on January 25, 1996, the petition is untimely with respect to acceptance of the extension request. However, since the timeliness of a petition requesting review of an Examiner's refusal to accept a

Statement of Use is not specifically provided for elsewhere in the Rules, the sixty-day period set forth in Trademark Rule 2.146(d), 37 C.F.R. § 2.146(d), is applicable. Therefore, Petitioner's request for acceptance of its Statement of Use may be considered on the merits.

FN2. Although the filing fee for the Statement of Use and second extension request have been refunded, Petitioner was inadvertently charged twice for filing this petition, since the petition fee and the Statement of Use fee are $100, Petitioner is not required to provide an additional fee in order to perfect its Statement of Use. The internal records of the Trademark Office will be updated to property attribute the $100 Statement of Use fee.

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