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

RE: INFORMAL TRADEMARK APPLICATION OF UNISTAR RADIO NETWORKS, INC.
93-249
February 11, 1993
***1** Petition Filed: August 12, 1992

For: HOT COUNTRY and design
Serial No. 74/225,390 [FN1]
Application Received: November 18, 1991 [FN2]

J. David Sams

Acting Assistant Commissioner for Trademarks

On Petition

Unistar Radio Networks, Inc. has petitioned the Commissioner to accord a filing date of November 18, 1991 to the above identified application. Petitioner further requests "permission to submit this petition out of time." Trademark Rules 2.146(a)(3), 2.146(a)(5) and 2.148 provide authority for the requested review.

Facts

Petitioner attempted to file the above identified application on November 18, 1991, pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), for the mark HOT COUNTRY for "radio broadcasting services via satellite transmission in International Class 38 ... and radio programming services via satellite in International Class 41...." The papers were initially accorded a filing date of November 18, 1991, and serialized as Application Serial No. 74/225, 390. Subsequently, this filing date was cancelled and the serial number was declared misassigned. Petitioner states that on March 2, 1992, a Notice of Incomplete Trademark Application was mailed, stating that the application was denied a filing date because the words "in commerce" had been omitted from the applicant's claim of a bona fide intention to use the mark.

This petition was filed August 12, 1992. Petitioner contends that its allegation of a bona fide intention to use the mark for radio broadcasting and programming services "via satellite" can only mean that the mark will be used in commerce which is regulated by Congress, because satellite transmissions are regulated by the Federal Communications Commission (FCC).

With respect to the timeliness of the petition, petitioner asserts that the filing of the petition "out of time" was due to the substitution of its trademark counsel and the "unavoidable delay" [FN3] resulting from the transfer of relevant documentation from petitioner's prior counsel to its current counsel; that the situation is extraordinary because several radio stations have attempted to infringe

petitioner's mark; and that the failure to obtain the November 18, 1991 filing date might prejudice petitioner's rights in the mark in any action required to be taken against subsequent infringers.

Petitoner's Senior Vice President, Neil Sargent, has submitted an affidavit in which he states that in September of 1991, petitioner embarked on an extensive national advertising campaign to announce its broadcasting and programming services under the subject mark; that between September, 1991 and November, 1991, petitioner spent approximately $50,000 to promote HOT COUNTRY radio broadcasting and programming services; that subsequent to commencing its advertising campaign, petitioner received notice from its affiliates that several radio stations had commenced using the name HOT COUNTRY and were currently infringing petitioner's mark; that petitioner's prior trademark counsel informed petitioner that the application had been denied a filing date and that a new application would have to be filed; that in April of 1992, petitioner hired a new trademark attorney; and that, at the time the new attorney was hired, the mailing date and particulars of the Notice of Incomplete Trademark Application were not known, because the files were still in the possession of the previous counsel.

***2** Petitioner's new attorney, Nicholas L. Coch, has submitted an affidavit stating that in April of 1992, he met with petitioner to discuss petitioner's trademark program; that at the time of such meeting, the mailing date and the particulars of the Notice of Incomplete Trademark Application were not known to him, because the files were still in the possession of petitioner's previous counsel; that copies of the relevant papers were forwarded to him in late May of 1992, after the permissible time period for filing the petition had expired; and that, upon review of the application, he immediately commenced research for the preparation and filing of the instant petition.

Decision

Trademark Rule 2.146(d) provides that a petition to the Commissioner must be filed within sixty days of the mailing date of the Office action from which the relief is requested. In this case, petitioner received the Notice of Incomplete Trademark Application on March 2, 1992, but did not file this petition until August 12, 1992.

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.

The fact that a party employs a new attorney is not an extraordinary situation, within the meaning of Rules 2.146(a)(5) and 2.148. When the services of its first attorney were terminated, petitioner had a duty to ascertain the status of pending matters and take whatever action was necessary to comply with outstanding deadlines.

Furthermore, petitioner's present attorney, Mr. Koch, acknowledges

that he received a copy of the Notice of Incomplete Trademark Application in "late May, 1992." Notwithstanding the receipt of such notice, counsel waited until August 12, 1992 to file the petition. Thus, even if the date counsel actually received the Notice of Incomplete Trademark Application is used as the starting point for measuring the petition's timeliness, the petition was untimely filed.

Petitioner's allegation that third parties may be infringing the subject mark is not deemed to be a circumstance in which justice requires a waiver of the 60 day deadline for filing the petition. If anything, petitioner's delay in filing the petition stands at odds with its claim that the situation is so urgent as to require immediate action.

Accordingly, the petition is denied as untimely.

Had the petition been timely filed, it would have been denied on the merits. Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), requires that a party applying for registration of a mark based upon a bona fide intention to use the mark in commerce file a written application, "verified by the applicant ... specifying applicant's bona fide intention to use the mark in commerce." To "specify" is "[t]o mention specifically; to state in full and explicit terms; to point out; to tell or state precisely or in detail...." Black's Law Dictionary 1255 (5th ed. 1979).

***3** The requirements for receipt of a filing date are set forth in Trademark Rule 2.21, 37 C.F.R. § 2.21. Because the granting of a filing date to an application potentially establishes a date of constructive use of the mark, these requirements are strictly enforced. Rule 2.21(a)(5)(iv) requires that an application filed under Section 1(b) of the Act include "[a] claim of a bona fide intention to use the mark in commerce."

Both the statute and rule clearly require an express averment that the applicant has a bona fide intention to use a mark in commerce. The applicant's bona fide intention to use the mark in commerce will not be inferred from the nature of the services, or from other circumstances surrounding the filing of the application. The wording "in commerce" is essential, and its omission results in the denial of a filing date.

The petition is denied. The petition papers are returned herewith.

FN1. The serial number has been declared "misassigned" and will not be reassigned to the application.

FN2. The filing date is the issue on petition.

FN3. Under 15 U.S.C. § 1062(b) and 37 C.F.R. § 2.66, an application which is abandoned for failure to respond to an Office action can be revived if the applicant can show that the delay in responding was "unavoidable." There is no provision in the Trademark Act or the Trademark Rules of Practice for consideration of an untimely petition to restore a filing date to an informal application based upon a

showing of unavoidable delay. However, 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.

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