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

RE: TRADEMARK APPLICATION OF NASH & ZULLO PRODUCTIONS, INC.
92-130
August 14, 1992
***1** Petition Filed: December 31, 1991

For: THE SPORTS HALL OF SHAME
Serial No. 74/039,501
Filed: March 19, 1990

Attorney for Petitioner

L.S. Van Landingham, Jr., Esq.

Jeffrey M. Samuels

Assistant Commissioner for Trademarks

On Petition

Nash & Zullo Productions, Inc. has petitioned the Commissioner, pursuant to 37 C.F.R. § § 2.66 and 2.146, to accept its first request for extension of time to file a statement of use, or permit substitution of a corrected extension request, and to revive the above abandoned application. Trademark Rules 2.146 and 2.148 provide appropriate authority for the requested review.

Facts

The notice of allowance for the subject intent-to-use application issued on December 25, 1990. Pursuant to Section 1(d) of the Trademark Act, a statement of use or a request for an extension of time to file a statement of use was due to be filed within six months after the issuance date of a notice of allowance, i.e., between December 25, 1990 and June 25, 1991.

On June 25, 1991, petitioner filed a request for an extension of time to file a statement of use that was signed by petitioner's counsel. In a letter dated August 1, 1991, the ITU/Divisional Unit Applications Examiner denied the extension request because "the statement of applicant's continued bona fide intention to use the mark in commerce is not verified by the applicant, as required by Trademark Act Section 1(d)(2)" and Trademark Rule 2.89(a)(3). The period of time for filing an acceptable extension request or statement of use having expired, the ITU/Divisional Unit Applications Examiner notified petitioner that the application would be abandoned in due course.

On June 24, 1991, the application was declared abandoned. [FN1] Petitioner subsequently filed a statement of use on December 24, 1991,

and a substitute extension request on December 26, 1991. This petition was then filed on December 31, 1991. [FN2]

In a letter dated February 27, 1992, the Secretary to the Managing Attorney of the ITU/Divisional Unit notified petitioner that its application had been mistakenly abandoned and that it would be reinstated and forwarded to the ITU/Divisional Unit for further prosecution.

On April 23, 1992, the Paralegal Specialist of the ITU/Divisional Unit notified petitioner that the reinstatement letter had been generated in error, and that the application file would be submitted to the Administrator for Trademark Classification and Practice for review of the petition to the Commissioner. Petitioner was also informed that the application would remain abandoned in the interim.

Petitioner's counsel contends that the signing of the extension request by the attorney of record was proper and complies with the requirement of Trademark Rule 2.89(a)(3). Both the declaration of Mr. Bruce M. Nash, president of petitioner, and Mr. L.S. Van Landingham, petitioner's counsel, explain that Mr. Nash was unexpectedly unavailable to execute the extension request and thus Mr. Van Landingham, as attorney of record and with specific authorization from Mr. Nash, executed the extension request.

Decision

1. Timeliness of Petition

***2** Under Trademark Rule 2.89(g), "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 (emphasis added)." The denial of the extension request was mailed on August 1, 1991, however, the petition was filed almost four months later, on December 31, 1991, and well beyond the specified one month time period. Therefore, the petition is denied as untimely.

Even if the petition had been timely filed, it would have been denied on the merits.

2. Signatory Requirements for a Request for an Extension of Time to File a Statement of Use

Section 1(d)(2) of the Trademark Act requires "a verified statement that the applicant has a continued bona fide intention to use the mark in commerce and specifying those goods or services identified in the notice of allowance on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce."

Under Trademark Rule 2.89(a)(3), a request for an extension of time must include "[a] verified statement by the applicant that the applicant has a continued bona fide intention to use the mark in

commerce, specifying those goods or services identified in the notice of allowance on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce (emphasis added)."

Examination Guide 3-89, titled "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 Examining Procedure and appeared in the Official Gazette on November 21, 1989, 1108 TMOG 30.

At page 26, Examination Guide 3-89 states:

> Any request for an extension of time must be filed by the entity which owns the mark as the time the request is filed and must be executed by an individual possessing statutory authority to do so on behalf of the specific type of entity. The individual must sign for an individual applicant, a general partner must sign for a partnership and an officer must sign for a corporation or association.
>
> If the request is signed by any other person, the request for an extension will be denied. Because the request must include a statement of continued bona fide intention to use the mark in commerce, only the applicant can execute the request under the Act. In the case of a request for an extension of time, the request cannot be re-executed by one with proper authority after the expiration of the time permitted for filing the statement of use. The "color of authority" provision of Trademark Rule 2.71(c), 37 C.F.R. § 2.71(c), does not apply to the filing of requests for extensions of time. (emphasis added)

In light of the foregoing, the extension request was properly denied. In addition, since petitioner had filed the deficient extension request on the last day of the six month time period for filing a statement of use or extension request, the application was properly abandoned thereafter. Inasmuch as the time period for the filing of a corrected extension request has expired, the corrected extension request is not timely and cannot be substituted for the statutorily deficient first extension request of record.

3. Unavoidable Delay under Trademark Rule 2.66

***3** Trademark Rule 2.66 provides for the revival of an application abandoned for failure to timely file a statement of use or a request for an extension of time to file a statement of use where it has been shown to the satisfaction of the Commissioner that "the delay was unavoidable."

The term "unavoidable" means that reasonable steps had been taken, or precautionary systems were in operation which were designed to avoid the circumstances which caused the delay, and the delay occurred despite these precautions. If there were reasonable provisions which should have been taken for anticipating and avoiding the delay and those precautions were not taken, then the delay is considered avoidable. Trademark Manual of Examining Procedure (TMEP) § 1112.05.

Petitioner argues that "the Applicant's president was not available for executing the Request Under Section 2.89 on June 25, 1991 as he was

in California and could not be reached by the Applicant's attorney with offices in Arlington, Virginia." However, such a situation is always a possibility, and applicant's attorney had the option of obtaining verification from another officer of applicant, or filing the extension request earlier so as to provide additional time to correct any deficiencies. The due date for the filing of an extension request is known in advance and the burden is on an applicant to keep adequate records and make proper allocation of time to meet necessary filing deadlines.

4. Trademark Rules 2.146(a)(5) and 2.148

Trademark Rule 2.146(a)(5) and 2.148 permit the Commissioner to waive any requirement of the rules not being a requirement of the statute, in an extraordinary circumstance, when justice requires and no other party is injured. However, the requirement for verification of the extension request by applicant is statutory, and accepting an extension request signed by applicant's attorney or allowing petitioner to submit a corrected substitute extension request beyond the time period for filing a statement of use or extension request would be, in effect, a waiver of a statutory requirement, and the Commissioner is without authority to waive such a requirement. In re Kruysman, Inc., 199 USPQ 119 (Comm'r Pats.1977); Ex parte Buchicchio, 118 USPQ 40 (Comm'r Pats.1958); Ex parte Radio Corporation of America, 114 USPQ 403 (Comm'r Pats.1957).

Furthermore, even if the Commissioner did have the authority to waive a statutory requirement, the circumstances described in this petition are not considered extraordinary, as contemplated by Trademark Rules 2.146(a)(5) and 2.148. Oversights that could have been prevented by the exercise of ordinary care do not constitute extraordinary situations within the purview of these rules. In re Bird & Son, Inc., 195 USPQ 586, 588 (Comm'r Pats.1977).

***4** Accordingly, the petition is denied. The application will remain abandoned; the statement of use papers will be returned to petitioner and the statement of use filing fee will be refunded in due course.

FN1. The abandonment date has been corrected, and currently the record reflects a date of abandonment of June 26, 1991.

FN2. Declarations supplementing the petition, signed by petitioner and petitioner's counsel, were submitted on January 22, 1992.

25 U.S.P.Q.2d 1531

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