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

RE: TRADEMARK APPLICATION OF STAKIS PLC
92-77
August 14, 1992
***1** Petition Filed: February 7, 1992

For: LEISURE LODGE
Serial No. 74/013,397
Filing Date: December 22, 1989

Attorney for Petitioner

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Fleit, Jacobson, Cohn, Price, Holman & Stern

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Assistant Commissioner for Trademarks

On Petition

Stakis plc has petitioned the Commissioner, pursuant to 37 C.F.R. § 2.146, to accept a late filed $100 filing fee for a second request for extension of time to file a statement of use, and thus to revive an abandoned class in the subject application. Trademark Rules 2.66, 2.146(a)(5) and 2.148 provide appropriate authority for the requested review.

Facts

The notice of allowance for the subject two-class intent-to-use application issued on November 20, 1990. Pursuant to Section 1(d) of the Trademark Act, petitioner was required to file a statement of use or a request for an extension of time to file a statement of use within six months after the date of issuance of the notice of allowance.

On May 7, 1991 petitioner timely filed a request for an extension of time to file a statement of use. The extension request was granted, extending the time for filing a statement of use until November 20, 1991.

On November 19, 1991, petitioner timely filed a second request for an extension of time to file a statement of use, however, only one filing fee was submitted for the two class application. On February 13, 1992, the Paralegal Specialist of the ITU/Divisional Unit mailed an ITU Examiner's Note to the File which referenced a telephone conversation on February 6, 1992 between the Paralegal Specialist and the attorney of record, Mr. Mark Tidman. [FN1] Specifically, the Examiner's Note

stated that Mr. Tidman was informed that the second fee had been omitted from the extension request; and he chose to delete Class 42 from the application based upon this information. [FN2]

A petition was filed on February 7, 1992, the day immediately following the above referenced telephone conversation. The filing fee for the second extension request has been submitted with the petition. [FN3]

Petitioner's counsel asserts, in the unverified petition, [FN4] that the merger of the law firm Berman & Aisenberg with Fleit, Jacobson, Cohn, Price, Holman & Stern, which resulted in a physical move of files from Berman & Stern to Fleit, Jacobson, Cohn, Price, Holman & Stern on October 26, 1991, caused some confusion with respect to the filing of documents with the Patent and Trademark Office and resulted in the firm's failure to either attach a check in the appropriate amount or to authorize the Office to charge the firm's deposit account. Counsel for petitioner submits that the failure to attach a check in the appropriate amount was an "inadvertent error."

Decision

Under Section 1(d)(1) of the Trademark Act, a statement of use or a request for an extension of time to file a statement of use must be filed "within six months after the date on which the notice of allowance with respect to a mark is issued." Section 1(d)(2) of the Act requires that a subsequent extension request must be filed "upon written request of the applicant before expiration of the 6-month period provided in paragraph (1)."

***2** Section 1(d)(2) of the Trademark Act expressly provides that any request for an extension of time to file a statement of use "shall be accompanied by payment of the prescribed fee."

Trademark Rule 2.89(b), which outlines the requirements for the filing of a second extension request with which to file a statement of use, also states that the request must include "the fee prescribed in § 2.6." Trademark Rule 2.6(a)(4) sets the fee for extension requests at $100 per class.

Petitioner timely filed a second extension request accompanied by one filing fee for a two-class application, thus causing the abandonment of one class in the application. Citing to a law firm merger as the reason for the failure to submit the proper fees for the extension request, petitioner acknowledges that both the fee for the second class and language directing the Office to debit a deposit account for any fee deficiency were mistakenly omitted due to the disruption caused by the physical move of files between law firms.

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.

While the transfer of files from one law firm to another may cause considerable disruption and some logistical problems, it is reasonable to expect that appropriate precautions will be taken to keep adequate records and make proper allocation of time to meet necessary deadlines and to avoid abandonment of the application. In fact, counsel for petitioner filed the second extension request in a timely manner despite the disruption caused by the merger.

Although it appears that the omission of the filing fee for the second class in the second extension request was inadvertent and unintentional, it does not constitute unavoidable delay as contemplated by Rule 2.66.

Trademark Rules 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, allowing petitioner to submit the filing fee for an extension request beyond the statutory time period for filing a statement of use 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).

***3** 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. Inadvertent omissions, or 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).

Accordingly, the petition is denied. [FN5] The application will proceed only with respect to the Class 41 services.

FN1. The Examiner's Note appears to contain a typographical error in that it mistakenly references the issue of the fee deficiency with respect to the expired time period for the filing of the first extension request, instead of the expired time period for the filing of the second request.

FN2. There is a discrepancy between the petition and the Examiner's Note with respect to the numbered class deleted from the application. In the petition, counsel for petitioner states that Class 42 has been retained and Class 41 deleted, whereas in the Examiner's Note, Mr. Tidman expressly chose to delete Class 42 and retain Class 41.

FN3. Although the petition refers to the submission of two checks in the amount of $100 each for both the petition and the extension request, only one check appears to have been submitted. However, petitioner has authorized the Office to debit a numbered deposit account for any fee deficiency.

FN4. Trademark Rule 2.146(c) requires any brief in support of the petition, in which facts are to be proved, to be in the form of a affidavit or declaration pursuant to 37 C.F.R. § 2.20.

FN5. Inasmuch as the filing fee for the second class in the extension request did not accompany the petition, nor was petitioner's deposit account debited, no refund shall be necessary.

25 U.S.P.Q.2d 1529

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