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

RE: TRADEMARK APPLICATIONS OF SCHERING-PLOUGH HEALTHCARE PRODUCTS, INC. [FN1]
July 15, 1992
***1** Petitions Filed: May 20, 1992

For: ARCH GUARD
Serial No. 74/002,997
Abandonment Date: April 21, 1992
Filing Date: November 17, 1989

For: COMFORT MINDER
Serial No. 74/071,976
Abandonment Date: April 20, 1992
Filing Date: June 22, 1990

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On Petition

Schering-Plough Healthcare Products, Inc. has petitioned the Commissioner to reverse the ITU/Divisional Unit Applications Examiner's denial of its second extension of time to file statements of use, and to reinstate the above- captioned applications. Trademark Rules 2.146(a)(3) and 2.148 provide authority for the requested review.

Facts

Application Serial No. 74/002,997

The Notice of Allowance for the above subject application issued on April 16, 1991. On July 12, 1991, petitioner timely filed a request for an extension of time to file a statement of use. The extension request was granted, affording petitioner the opportunity to file a statement of use within twelve months from the mailing date of the Notice of Allowance.

On March 27, 1992, petitioner timely filed a second request for an extension of time to file a statement of use. Asserting good cause, petitioner explained the following:

Applicant has a continuing bona fide intent to use the mark in commerce in connection with those goods identified in the Notice of Allowance in this application ... The product intended to be sold under this trademark is still under development. A prototype of the product, an advanced-designed arch support, has undergone a first round of consumer testing. Additional time is need [sic] in order to improve the product. As soon as the product has been fully developed, it will be sold under the trademark ARCH GUARD.

In a letter dated April 23, 1992, the ITU/Divisional Unit Applications Examiner denied the extension request under Trademark Rule 2.89(d)(1), because the request failed to include an allegation that the applicant has not yet made use of the mark in commerce on all the goods or services specified 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.

The application was declared abandoned on April 27, 1992, for failure to file a statement of use. This petition followed.

Application Serial No. 74/071,976

The Notice of Allowance for the above application issued on April 9, 1991. On August 19, 1991, petitioner timely filed a request for an extension of time to file a statement of use. The extension request was approved, granting applicant up to twelve months from the mailing date of the notice of allowance to submit a statement of use.

On March 27, 1992, petitioner timely filed a second request for extension of time with which to file a statement of use. Asserting good cause, petitioner explained the following:

***2** Applicant has a continuing bona fide intent to use the mark in commerce in connection with those goods identified in the Notice of Allowance in this application ...

The product intended to be sold under this trademark is under development. Applicant is working on identifying the technology for the manufacturing the insoles. When the technology for manufacturing the insole has been fully developed, the product will be sold under the trademark COMFORT MINDER.

In a letter dated April 21, 1992, the ITU/Divisional Unit Applications Examiner denied the request under Trademark Rule 2.89(d)(1), because the request failed to include an allegation that the applicant has not yet made use of the mark in commerce on all the goods or services specified 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.

The application was declared abandoned on April 20, 1992, for failure to file a statement of use. This petition followed.

In both petitions, counsel for petitioner argues that it has complied with all statutory requirements and rules.

Decision

Section 1(d)(1) of the Trademark Act provides, for applications filed under a Section 1(b) basis, that a statement of use must be filed within six months from the date on which the notice of allowance is issued. Requests for extensions of time with which to file a statement of use may be granted for six month time periods, and may not exceed 24 months.

In a first 6-month extension request under Section 1(d)(2) of the Trademark Act, there is no requirement for a showing of good cause:

(2) The Commissioner shall extend, for one additional 6-month period the time for filing the statement of use under paragraph (1), upon written request of the applicant before the expiration of the 6-month period provided in paragraph (1).

Any additional extension requests, however, must include a showing of good cause:

In addition to an extension under the preceding sentence, the Commissioner may, upon a showing of good cause by the applicant, further extend the time for filing a statement of use under paragraph (1) for periods aggregating not more that 24 months, pursuant to written request of the applicant made before the expiration of the last extension granted under this paragraph. (emphasis added)

All extension requests must also include a verified statement that the applicant has a 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 applicant has a bona fide intention to use the mark in commerce, and the required filing fee. 37 C.F.R. § § 2.89(b)(2) and (3).

Trademark Rule 2.89(d) sets forth guidelines to explain the nature of good cause and the showing required in an extension request, which must include the following:

(1) An allegation that the applicant has not yet made use of the mark in commerce on all the goods and services specified 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; and

***3** (2) A statement of applicant's ongoing efforts to make use of the mark in commerce.... Those efforts may include, without limitation, product or service research or development, market research, manufacturing activities, promotional activities, steps to acquire distributors, steps to obtain required governmental approval, or other similar activities. In the alternative, a satisfactory explanation for the failure to make such efforts must be submitted.

In the subject applications, the ITU/Divisional Unit Applications Examiner properly denied the second extension requests solely for failure to comply with Trademark Rule 2.89(d)(1). Both of the requests were timely, accompanied by the necessary fees and declarations of continuing bona fide intention to use the mark in commerce with those goods identified in the notice of allowance, as well as explanations regarding good cause in accordance with the guidelines enumerated above.

Trademark Rule 2.146(a)(3) permits the Commissioner to invoke supervisory authority in appropriate circumstances. This situation is appropriate to invoke such authority.

In the instant petitions, petitioner complied with all of the statutory requirements of Section 1(d) of the Act in both extension requests. Although Rule 2.89(d)(1) requires that an applicant include in an extension request an express allegation that the mark has not yet been used in commerce, that allegation may be considered to be implicit in the requirement under Rule 2.89(b)(3) that applicant assert a continued bona fide intention to use the mark in commerce.

If an applicant has asserted a "continued bona fide intention to use the mark in commerce," it can be assumed that either applicant has not yet made use of the mark in commerce on all of the goods specified in the notice of allowance, or that even if use has already been made in commerce, an applicant may be uncertain as to whether that use is sufficient. In either case, applicant may seek an extension of time. This situation is not dissimilar to that of an application filed under Section 1(b) of the Act where the applicant is allowed to subsequently amend its dates-of-use clause to predate the filing date.

For the foregoing reasons, the subject extension requests are found to be substantially in compliance with Rule 2.89. Omission of applicant's express allegation that the mark is not yet in use in commerce on all of the goods or services is not a fatal omission if applicant has expressly alleged its continued bona fide intention to use the mark in commerce.

Accordingly, the petitions are granted. The applications will be reinstated and forwarded to the ITU/Divisional Unit for further action consistent with this decision.

FN1. The records of the Assignment Branch of the Patent and Trademark Office do not show an assignment to the present petitioner for application Serial No. 74/002,997.

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