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

RE: TRADEMARK APPLICATION OF SWISSCO FOODS LIMITED
Serial No. 74-158,143
July 13, 1992
***1** Request for Reconsideration Filed: January 28, 1992

For: NORD LAND A UNIQUE DELICACY and design
Filed: April 18, 1991 [FN1]

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Assistant Commissioner for Trademarks

On Request for Reconsideration

Swissco Foods Limited is requesting reconsideration of a Commissioner's decision dated December 6, 1991, denying its petition for a filing date of February 23, 1990 for the above identified application. Although the Trademark Rules do not specifically provide for requests for reconsideration of decisions on petitions, such requests may be considered pursuant to Trademark Rule 2.146(a)(3).

Facts

On February 23, 1990, petitioner filed an application for registration of the above identified mark, pursuant to Section 44(d) of the Trademark Act, based upon an application filed in Canada on October 4, 1989. This application was filed in conjunction with three unrelated applications, under a certificate of mailing by Express Mail, pursuant to 37 C.F.R. § 1.10. Three of these applications were assigned filing dates and serial numbers, and forwarded for examination. The fourth application, the subject of the instant petition, was apparently lost or misplaced after its receipt in the Office Mail Room.

Counsel for petitioner states that in December of 1990, she noticed that a filing receipt for the instant application had never been received, whereupon a search was conducted in the Office. When this search failed to show the existence of the application, a petition for a filing date was filed on January 18, 1991. A copy of the application was submitted with the petition.

The petition was supported by the declaration, pursuant to 37 C.F.R. § 2.20, of petitioner's counsel, who verified submission of the

instant application on February 23, 1990, along with the other three applications.

Due to an Office error, the January 18, 1991 submission was processed as a new application, and was not immediately forwarded to the Office of the Assistant Commissioner for Trademarks for consideration on petition. The application was accorded a filing date of April 18, 1991, [FN2] pursuant to Section 1(b) of the Trademark Act, based upon a claim of a bona fide intention to use the mark in commerce. The Examining Attorney discovered the petition during examination, and forwarded it to the Office of the Assistant Commissioner in August of 1991.

In a decision dated December 6, 1991, the Commissioner denied the petition, on the ground that petitioner had not exercised due diligence in the prosecution of its application. The Commissioner noted that the petition was not filed until about 11 months after the application was first submitted for filing; that, at the time the application was filed, filing receipts were generally issued within 2 to 3 months of the filing date; [FN3] that petitioner was represented by an experienced trademark practitioner who was undoubtedly aware of the usual time frames within which filing receipts and initial Office actions are issued; and that, even if counsel had not noticed the Office's failure to issue a filing receipt within the usual time frame for the application here in issue, the Office's issuance in June, 1990 of Office actions on the three other applications that had been mailed in the same envelope as the instant application should have served to indicate that something was amiss with the fourth application. The Commissioner acknowledged that the Office was not without fault in this case, but held that counsel for petitioner must share the blame for failing to take action at an earlier point in time. Accordingly, the petition to accord the application a filing date of February 23, 1990 was denied. The filing date was changed from April 18, 1991 to January 18, 1991, the date on which the application had been resubmitted with the petition, and the application was returned to the Examining Attorney for resumption of examination. [FN4]

***2** This request for reconsideration was filed January 28, 1992. Petitioner contends that there is no time limit on the applicability of Rule 1.10, and no obligation for an applicant to monitor the status of matters pending in the Patent and Trademark Office.

In the alternative, petitioner contends that it was duly diligent in the filing of the petition. Petitioner's counsel has verified that she changed law firms between the time of filing the application and the time of the filing the petition; that both her present and former law firms monitor and docket applications filed in the Office; that when she left her former firm in April of 1990, the established procedure was that if a postcard or filing receipt was not received within approximately five months after filing, the docketing clerk would bring this fact to the attention of the attorney; that, for some unknown reason, this procedure was not followed in the instant case; that all docketing matters at the former firm were handled by a docketing clerk; that, after changing firms, she no longer had access to the docketing books; that the three applications which had been filed along with the instant application remained with her former firm and, as such, she was not privy to information about the issuance of filing receipts and Office actions in connection with those applications; that the

relocation of an attorney results in unavoidable delays; that, since some types of actions by the Patent and Trademark Office, such as notices of publication, do not always issue in connection with a case in less than ten months, it is not unusual that a file may not come up for review in less than a year; and that she took immediate action when the absence of a filing receipt for this application was noticed.

Decision

Petitioner's argument that there is no obligation to monitor the status of matters pending in the Patent and Trademark Office, and no time limit on the filing of petitions to restore filing dates to lost applications, is not persuasive.

To avoid prejudicing the rights of third parties, petitions to the Commissioner are required to be filed within a reasonable time after the disputed event. Timely filing of petitions is especially important in a case such as this, where there would be no notice to the public for a substantial period of time that an application was on file in the Office.

The Office places the burden of inquiring about the status of pending applications squarely on applicants and their attorneys. Such inquiry must be made reasonably soon after becoming aware that an action has not materialized at the time such action should normally be expected.

Restoring an earlier filing date to an application is an extraordinary equitable remedy which is granted only in the most compelling circumstances. A party who has not been diligent in prosecuting an application generally does not present a compelling case for extraordinary equitable relief.

Petitioner suggests that requiring an applicant to exercise reasonable diligence in prosecuting an application is a new policy for which rules and regulations must be promulgated before implementation. However, this is not in fact a new policy. The Office has long required a showing of diligence of action, both in filing the petition and in monitoring the status of the application, as an essential element of a successful petition. See Hancock, Notes From The Patent Office, 61 Trademark Rep. 42, 44 (1971).

***3** Accordingly, petitioner's argument that there is no obligation to monitor the status of its application is rejected. However, upon reconsideration, in view of the specific facts and circumstances presented in this case, petitioner's alternative request for relief, on the ground that itscounsel has acted with reasonable diligence in the filing of the instant petition, is granted.

As noted above, a petition for an earlier filing date for an application is a request for extraordinary equitable relief, which must necessarily be decided on a case by case basis. In a situation such as this, where a party receives no filing receipt, Office action or other acknowledgment of its application from the Office, a petition for a filing date is rarely considered timely filed if more than six months have elapsed since the submission of the application. Applicants or

their attorney should have expected to receive either a filing receipt, a telephone call, a written action or a notice of publication within six months from filing. Before six months has elapsed, applicant should consult the Office to determine the cause of this delay.

The relocation of a party's attorney does not excuse its failure to monitor the status of matters pending before the Office. Due to the importance of filing dates in trademark cases, it is incumbent on an attorney who relocates to take action to ensure that all records are properly transferred and docketed, that all necessary changes of address are filed in the Office, and that correspondence from the Office is timely received at the attorney's new location.

In this case, however, counsel has verified that both her present and former law firms monitor and docket applications filed in the Patent and Trademark Office; that she had reason to believe that it would be called to her attention if no filing receipt was received within five months after filing this application, and that she had no actual knowledge that filing receipts and Office actions had issued in connection with the three applications that were filed contemporaneously with the instant application.

Accordingly, the request upon reconsideration is granted. The application will be accorded a filing date of February 23, 1990, and will be examined as a dual basis application, pursuant to Sections 1(b) and 44(d) of the Trademark Act. [FN5]

The file will be forwarded to the Office of Trademark Program Control for processing, and then to the law office to await applicant's response to the outstanding Office action.

FN1. The filing date is the issue raised by the petition.

FN2. It is unclear why the application was not accorded a filing date of January 18, 1991.

FN3. There was a backlog of cases in fiscal year 1990 that has since been reduced. At present, filing receipts are issued within 4-6 weeks of the filing date.

FN4. An Office action was issued February 3, 1992.

FN5. The filing of this request for reconsideration does not stay the time for applicant's response to the Office action dated February 3, 1992. Trademark Rule 2.146(g). Upon entry of such response, if the Examining Attorney deems the application to be in condition for publication, the application will be suspended pending receipt of the Canadian registration.

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