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

RE: TRADEMARK APPLICATION OF DOCRITE, INC.
96-120
August 7, 1996
***1** Petition Filed: February 16, 1996

For: DOCPERFECT
Serial No. 74/627,038
Filing Date: January 30, 1995

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Philip G. Hampton, II

Assistant Commissioner for Trademarks

On Petition

Novell, Inc. has petitioned the Commissioner to waive the requirements of Trademark Rule 2.102(c)(2) and grant a request for an extension of time to file a Notice of Opposition to the registration of the above identified mark. The petition is granted, under Trademark Rules 2.146(a)(3), 2.146(a)(5) and 2.148.

FACTS

The subject mark published for opposition on September 19, 1995. Petitioner filed three requests for extensions of time to oppose, which were granted through January 17, 1996. On January 17, 1996, Petitioner

filed a request for an additional thirty day extension, through February 16, 1996. This fourth extension request contained a statement that the Applicant's attorney had consented to the extension during a telephone conversation on January 15, 1996.

By letter dated January 30, 1996, the Legal Assistant at the Trademark Trial and Appeal Board informed Petitioner that the extension request, if granted, would result in total extensions of time aggregating 150 days from the date of publication of the mark and, therefore, could not be granted, because the circumstances recited in the request were not deemed extraordinary, and there was no indication that Applicant was served a copy of the extension request, as required by Trademark Rule 2.102(c). This petition was filed February 16, 1996, under a certificate of mailing dated February 13, 1996. The petition included a request that the Commissioner stay the requirement for submission of additional extension requests pending disposition of the petition. [FN1] Due to an Office error, the petition was not promptly associated with the file, and a Notice of Allowance issued on May 14, 1996.

DECISION

As of January 17, 1996, when Petitioner's fourth extension request was filed, Trademark Rule 2.102(c), 37 C.F.R. § 2.102(c), provided as follows with respect to extension requests aggregating more than 120 days from the date of publication:

> (E)xtensions of time to file an opposition aggregating more than 120 days from the date of publication of the application will not be granted except upon (1) a written consent or stipulation signed by the applicant or its authorized representative, or (2) a written request by the potential opposer or its authorized representative stating that the applicant or its authorized representative has consented to the request, and including proof of service on the applicant or its authorized representative, or (3) a showing of extraordinary circumstances, it being considered that a potential opposer has an adequate alternative remedy by a petition for cancellation.

***2** Trademark Rule 2.102(c)(2) explicitly required not just that the extension request include a statement of the Applicant's consent thereto, but that the request also include proof of service on the Applicant or its representative. Since Petitioner's fourth extension request did not include proof of service, the Legal Assistant acted properly in denying it.

The purpose of Rule 2.102(c)(2) is to ensure that the Applicant be notified of the filing of a consented extension request, so that the Applicant can apprise the Board if in fact there had been no consent to the extension. Recently, the Office determined that the requirement for proof of service was unnecessary when the extension request includes a statement that the Applicant has consented to an extension. It is the practice of the Board to send a copy of the extension request to the Applicant along with the Board's action on the request, and this practice provides the Applicant with the opportunity, upon receipt of the copy of the extension request from the Board, to raise an objection as to the potential opposer's misrepresentation of its consent.

Accordingly, effective July 15, 1996, Trademark Rule 2.102(c)(2) was amended to delete the requirement that proof of service be submitted when a request for an extension of time to oppose aggregating more than 120 days from the date of publication is based upon a written statement by the potential opposer that the Applicant has consented to the extension. Elimination of Requirement for Proof of Service in Consented Requests for Extensions of Time to File a Notice of Opposition, 61 Fed.Reg. 36825 (July 15, 1996).

Although this amendment was adopted subsequent to the filing of Petitioner's fourth extension request, it is reasonable to extend the benefit of the amendment to the case at hand, wherein the extension request included a statement that the Applicant's attorney had consented to the requested extension.

Under35 U.S.C. § 6 and 37 C.F.R. § 2.146(a)(3), the Commissioner may invoke supervisory authority in appropriate circumstances, and 37 C.F.R. § § 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.

In this case, the Commissioner has determined that the Applicant will not be harmed by the granting of this petition. Although granting the petition may ultimately result in an opposition proceeding, if this petition were denied, Petitioner could petition to cancel the registration once it issued. It is in the interest of both the Applicant and the Office to dispose of the disputed issues prior to registration of the mark. It would not benefit the Applicant to rely on a registration issued by this Office and devote resources to the development of its mark, only to have the registration later ordered cancelled. Furthermore, the situation is deemed to be extraordinary, in that Petitioner's fourth extension request was denied based upon the requirements of a rule which the Office believes is unnecessary, and which is no longer in effect.

***3** The petition is granted. The Notice of Allowance will be cancelled, and the application file will be forwarded to the Trademark Trial and Appeal Board for further action in accordance with this decision.

FN1. The filing of a petition to the Commissioner to review the denial of a request for an extension of time to oppose does not relieve the potential opposer of the responsibility for filing a Notice of Opposition or requesting further extensions of time to oppose. 37 C.F.R. § 2.146(g). However, in order to avoid the need for filing repeated extension requests, the potential opposer may simply file, prior to the expiration of the extension which is the subject of the petition, or prior to the expiration of a subsequent extension, a request for a further extension of time to oppose until a specified time after the Board's action following determination of the petition. Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 211.02.

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