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

RE: TRADEMARK APPLICATIONS OF HOFFMANN-LA ROCHE INC.
March 16, 1992
***1** Petitions Filed: August 26, 1991 [FN1]

For: PANTOTHAIOL
Serial No. 74-027,374

For: PANSOLEX
Serial No. 74-027,373

For: OLEOPAN
Serial No. 74-027,372
Filing Dates: February 9, 1990

David A. Seligman

Associate Vice President and Assistant Secretary

Hoffmann-La Roche Inc.

Jeffrey M. Samuels

Assistant Commissioner for Trademarks

On Petition

Hoffmann-La Roche Inc. has petitioned the Commissioner to invoke his supervisory authority pursuant to Trademark Rule 2.63(b) [FN2] to accept the request for extension of time within which to file a statement of use for the above-captioned applications. Trademark Rule 2.146 provides authority for the requested review.

The subject applications were filed based upon a bona fide intention to use the mark in commerce, pursuant to Section 1(b) of the Trademark Act. Each was published for opposition on September 18, 1990. When no oppositions were filed, notices of allowance were mailed by the U.S. Patent and Trademark Office on December 11, 1990.

Under Section 1(d) of the Act, petitioner was required to file, within six months of the mailing date of the notice of allowance, a verified statement that the mark is in use in commerce or a verified request to extend time in which to file such a statement. Petitioner timely filed a request to extend time to file a statement of use, with respect to each of these applications, on May 24, 1991. The averments in the extension requests were set out as follows:

The undersigned states that he is Associate Vice President and Assistant Secretary of applicant corporation and is properly authorized to execute this Request for Extension of Time to File a Statement of Use on behalf of the applicant; to the best of his knowledge he believes the applicant to be the owner of the trademark sought to be registered; and all statements made of his own knowledge are true and

all statements made on information and belief are believed to be true.

On August 5, 1991, the Applications Examiner in the ITU/Divisional Unit denied the requests because they did not include a complete verification or declaration. Specifically, the statements did not indicate that the declarant was "warned that willfull (sic) false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001), and may jeopardize the validity of the application or document or any registration resulting therefrom." She further advised that since the period for filing an acceptable extension request or a statement of use had expired, the applications would be processed for abandonment in due course. These petitions followed.

Petitioner submits that the requests substantially comply with the requirements of the statute and the rules. However, this decision will not reach the question of whether petitioner has submitted acceptable extension requests because the records in the Patent and Trademark Office show that no statements of use or second extension requests have been timely filed.

***2** Section 1(d) of the Act provides that further extensions of time to file a statement of use may be filed, "for periods aggregating not more than 24 months, pursuant to written request of the applicant made before the expiration of the last extension granted...." Trademark Rule 2.89(g) states that "[t]he applicant will be notified of the grant or denial of a request for an extension of time, and of the reasons for a denial. Failure to notify the applicant of the grant or denial of the request prior to the expiration of the existing period or requested extension does not relieve the applicant of the responsibility of timely filing a statement of use under § 2.88." The rule continues: "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. If the petition is granted, the term of the requested six-month extension which was the subject of the petition will run from the date of the expiration of the previously existing six-month period for filing a statement of use."

As noted above, statements of use and further requests to extend time to file statements of use must be filed before the expiration of the previously existing six-month period. If granted by petition, the first extension request for each of these applications would have expired on December 11, 1991. Petitioner has filed no statements of use or further requests to extend time to file statements of use before the expiration of this deadline. Therefore, the applications are abandoned.

The petitions are denied. The application files will be processed for abandonment.

FN1. Payment of the petition fees, required under Trademark Rule 2.6(a)(15), was submitted on September 26, 1991.

FN2. Trademark Rule 2.63(b) applies only to petitions filed as a result of an examining attorney's action.

25 U.S.P.Q.2d 1539

END OF DOCUMENT