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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
OFFICE OF ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 Crystal Drive
Arlington, Virginia 22202-3513

98-149

Re: Trademark Registration of :
Karl Grossman :
Registration No. 1654547 :
Issued: August 20, 1991 : On Petition
For: MUSIC FOCUS :
Petition Filed: December 8, 1997 :

Karl Grossman has petitioned the Commissioner to accept a combined Section 8 and Section 15 Affidavit filed in connection with the above identified registration. Trademark Rules 2.146(a)(3), 2.146(a)(5) and 2.148 provide authority for the requested review.

FACTS

The above registration issued on August 20, 1991. Pursuant to Section 8 of the Trademark Act, 15 U.S.C. §1058, Registrant was required to file, between August 20, 1996 and August 20, 1997, an affidavit or declaration of continued use of the mark in commerce or excusable nonuse.

No affidavit or declaration was received prior to the expiration of the sixth year following the registration date. Registrant filed this petition on December 8, 1997. The registration was cancelled February 23, 1998.

Petitioner explains that US Postal Service caused the delay in the filing of the combined Section 8 and Section 15 Affidavit. On August 16, 1997, Petitioner mailed an assignment of the registration and the combined affidavits to Petitioner's Attorney. The documents were sent by priority mail with the assurance of the US Postal Service that the documents would be received by August 20, 1997. Thereafter, incident to a clerical error committed by the US Postal Service, the documents were not received by Petitioner's Attorney until August 25, 1997. An affidavit signed by a representative of the US Postal Services and attesting to such facts was included with the petition.

DECISIONS

Trademark Rules 2.146(a)(5) and 2.148 permit a waiver of any rule that is not a provision of the statute, where an extraordinary situation exists, justice requires and no other party is injured thereby. However, the Commissioner has no authority to waive a requirement of the statute.

Pursuant to Section 8 of the Trademark Act, 15 U.S.C. §1058, a registrant must file an affidavit or declaration of continued use or excusable nonuse between the fifth and sixth year after the

date of issuance of the registration. The affidavit or declaration required by Section 8 must be both executed and filed within the sixth year after the registration date. Trademark Rule 2.162(a); TMEP §1603.03.

The legislative history of Section 8 clearly indicates that a specific cut-off time was contemplated for submission of the Section 8 affidavit, failing which, the registration would be cancelled even though the mark may still be in use. Accordingly, although it is clear that it was the intent of Congress that Section 8 serve to keep live marks on the register, it also mandated a specific cut-off date, whether the mark is still in use or not, for submission of the Section 8 affidavit.

Although the circumstances in the Petition are unfortunate, the time period for filing an acceptable affidavit under Section 8 of the Act cannot be extended or waived because it is statutory. *In re Mother Tucker's Food Experience (Canada) Inc.*, 925 F.2d 1402, 17 USPQ2d 1795 (Fed. Cir. 1991); *In re Precious Diamonds, Inc.*, 635 F.2d 845, 208 USPQ 410 (C.C.P.A. 1980); *In re Kraysman, Inc.*, 199 USPQ 110 (Comm'r Pats. 1977); *Ex parte Buchicchio*, 118 USPQ 40 (Comm'r Pats. 1958).

The petition is denied. The registration remains cancelled.

Since the registration will remain cancelled, the Office need not determine the petition as to whether the Office may accept an untimely filed Section 15 Affidavit. Should Petitioner wish to file a new application for registration of its mark, the Office will, upon request, expedite handling of the application. See TMEP §1102.03.

Philip G. Hampton, II
Assistant Commissioner
for Trademarks

PGH:NLO:JAD

Date:

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