

Re: Trademark Application of :  
 Maytag Corporation :  
 Application No. 74-340656 :  
 Filing Date: December 16, 1992 : On Petition  
 For: ROCK ISLAND and Design :  
 Petition Filed: October 29, 1996 :

Northeast Illinois Regional Commuter Railroad Corporation, d/b/a/ METRA/Metropolitan Rail, has petitioned the Commissioner to grant its Request for Extension of Time to Oppose the above-identified trademark application. The petition is denied under Section 13 of the Trademark Act.

## FACTS

Trademark application Serial No. 74-340656 published for opposition on December 27, 1994. On January 26, 1995, Petitioner filed a Request for Extension of Time to Oppose (“Extension Request”). The request was granted. Subsequently, Petitioner filed nineteen additional Requests for Extension of Time to Oppose, for a total of twenty extension requests.

Petitioner filed its twentieth extension request on October 15, 1996. In a letter dated October 16, 1996, the Legal Assistant at the Trademark Trial and Appeal Board (“Board”), notified Petitioner that the twentieth extension request was denied as untimely. Specifically, the Legal Assistant noted that Petitioner had previously been granted an extension of time until October 11, 1996 in which to file a Notice of Opposition. Since the twentieth extension request was filed one day outside the previously-extend period, a further extension could not be granted.<sup>1</sup>

This petition followed.

## ANALYSIS

### *Petitioner's Argument*

Petitioner acknowledges that its twentieth extension request was not filed with the Office until October 15, 1996. However, Petitioner argues that, because it made timely and specific arrangements for the hand-delivery of the extension request, but such arrangements failed due to the courier's inability to locate a place to make an after-hours delivery to the U.S. Patent and Trademark Office, its petition presents extraordinary circumstances justifying a waiver of Section 13 of the Trademark Act.

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<sup>1</sup> October 11, 1996 fell on a Friday. Monday, October 14, 1996 was a federal holiday as defined in Rule 1.6(a)(1), 37 C.F.R. §1.6(a)(1). Therefore, Tuesday, October 15, 1996, was the next day on which business could be conducted with the U.S. Patent and Trademark Office. For this reason, the Legal Assistant informed Petitioner that its extension request was one day (rather than two days) late.

Petitioner notes that, if the Office has no discretion to waive Section 13 of the Trademark Act, then a late-filed extension request would be denied even where the party making the filing was in a car accident or disabled prior to filing.

*Commissioner Can Waive Rules But  
Cannot Waive Statutory Requirements*

Trademark Rules 2.146 and 2.148 permit the Commissioner to waive any provision of the rules which is not also a provision of the Trademark Act. Section 13 of the Trademark Act is a statutory provision; it is not a rule. Section 13 prescribes the time period for filing an opposition or requesting an extension of time to oppose. Therefore, the Commissioner cannot waive the requirement that further extension requests be filed prior to the expiration of a previously-granted extension. *In re Kabushiki Kaisha Hitachi Seisakusho*, 33 USPQ2d 1477 (Comm'r Pats. 1994); *In re Cooper*, 209 USPQ 670 (Comm'r Pats. 1980).

The Commissioner is sympathetic to Petitioner's argument that inability to waive a requirement of the statute may have seemingly harsh results. However, in this instance, Petitioner is not without a remedy. Petitioner may continue to negotiate with the Applicant. Should negotiations fail, Petitioner may file a Petition to Cancel under Section 14 of the Trademark Act, 15 U.S.C. §1064, if the subject application matures to registration.

*Petition Would Be Denied, Even If Requirement Not Statutory*

Petitioner should note that, even if the requirement for filing an extension request prior to the expiration of a previously-granted extension was not a statutory requirement, the circumstances presented here do not justify a waiver of the rules.

Trademark Rules 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: (1) an extraordinary situation exists, (2) justice requires, and (3) no other party is injured thereby. All three conditions must be satisfied before a waiver is granted. Under the circumstances presented in this petition, it is clear that the Applicant would not be injured by grant of the petition. However, the threshold requirement, namely, that an extraordinary situation exist, is not met. Oversights that could have been prevented by the exercise of ordinary care or diligence are not extraordinary situations as contemplated by the Trademark Rules. *In re Tetrafluor Inc.*, 17 USPQ2d 1160 (Comm'r Pats. 1990); *In re Choay S.A.*, 16 USPQ2d 1461 (Comm'r Pats. 1990); *In re Bird & Son, Inc.*, 195 USPQ 586 (Comm'r Pats. 1977).

The deadline for filing the twentieth extension request was known in advance. The U.S. Patent and Trademark Office maintains an "after-hours" Customer Window in the lobby of the Crystal Plaza 2 Building, 2011 South Clark Place, Arlington, Virginia. The fact that the courier could not find the Customer Window, or was not informed of its existence, is not an extraordinary situation. The Customer Window is open until at least 10:00 p.m. Eastern Time, Monday-Friday. Therefore, even after the courier's return, Petitioner's attorney could have contacted the Office

(or someone in another firm that does business with the U.S. Patent and Trademark Office), to determine the exact location of the Customer Window and could have re-sent the extension request in time to meet the October 11, 1996 deadline.

Of course, the extension request could have been mailed on October 11, 1996, using either a "Certificate of Mailing or Transmission" under Rule 1.8, 37 C.F.R. §1.8, or via "Express Mail" from the U.S. Post Office, under Rule 1.10, 37 C.F.R. §1.10, and retained the October 11, 1996 filing date.

## **DECISION**

The petition is denied. The application file will be returned to the ITU/Divisional Unit for consideration of Applicant's Request to Divide the application, its Statement of Use, and its first Request for Extension of Time to File a Statement of Use.

Philip G. Hampton, II  
Assistant Commissioner  
for Trademarks

PGH:EKM

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