

Re: Trademark Application of  
Black Entertainment Television, Inc.  
Serial No. 74/499040  
Filing Date: March 10, 1994  
For: BET ON JAZZ  
Petition Filed: August 22, 1996

On Petition

Black Entertainment Television, Inc. has petitioned the Commissioner to reverse the denial of a Request for Extension of Time to File a Statement of Use in connection with the above identified application. Trademark Rules 2.89(g) and 2.146(a)(3) provide authority for the requested review.

**FACTS**

A Notice of Allowance issued for the subject application on April 11, 1995. On October 10, 1995, Petitioner filed its first Request for Extension of Time to File a Statement of Use. The extension request was approved, affording Petitioner the opportunity to file a Statement of Use, or a second Request for an Extension of Time to File a Statement of Use, within twelve months from the mailing date of the Notice of Allowance.

On April 11, 1996, Petitioner filed a Request for Extension of Time to File a Statement of Use. In an Office Action dated July 23, 1996, the Applications Examiner in the ITU/Divisional Unit denied the extension request because it did not include a showing of good cause, as required by Trademark Act Section 1(d)(2), 15 U.S.C. §1051(d)(2), and Trademark Rule 2.89(b)(4), 37 C. F. R. §2.89(b)(4).<sup>1</sup> This Petition followed.

Petitioner states the absence of a statement showing good cause was inadvertent.

**DECISION**

Section 1(d)(2) of the Trademark Act, 15 U.S.C. §1051(d)(2), and Trademark Rule 2.89(b)(4), 37 C.F.R. §2.89(b)(4), require that a second or subsequent Request for Extension of Time to File a Statement of Use include a showing of good cause.

It had previously been the practice of the Office to deny petitions to grant second and subsequent Requests for Extension of Time to File a Statement of Use where the showing of good cause was not filed prior to the expiration of the statutory period for filing the Statement of Use. The Commissioner had held that the requirement for a showing of good cause was a statutory requirement that must be satisfied prior to the statutory deadline, and that, even under Trademark Rules 2.146(a)(5) and 2.148, he was without authority to waive the statutory requirement. See *In re SPARC International Inc.*, 33 USPQ2d 1479 (Comm'r Pats. 1994); *In re Twin Cities Public Television Inc.*, 25 USPQ2d 1535 (Comm'r Pats. 1992).

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<sup>1</sup> A third extension request and Statement of Use were filed on October 8, 1996.

In a recent decision, *In re El Taurino Restaurant, Inc.*, USPQ2d, Pet'n No. 96-14 (Comm'r Pats., June 18, 1996) (copy attached), the Commissioner changed this policy, determining that while the showing of good cause was required in order to receive approval of the extension request, it was not required by statute to be filed before the expiration of the statutory filing period. The Commissioner reversed *SPARC, supra* and *Twin Cities, supra*, to the extent that they held that the Commissioner was without authority on petition to accept a showing of good cause filed after expiration of the statutory time for filing the extension request.

However, under the policy set forth in *El Taurino, supra*, a showing of good cause filed after expiration of the statutory filing period can be accepted only upon petition to the Commissioner. *El Taurino* does not affect the examination of extension requests by Applications Examiners in the ITU/Divisional Unit. The Examiners will continue to deny second and subsequent extension requests that do not include a showing of good cause. The Applicant may then supplement its extension request with a verified statement of its ongoing efforts to use the mark in commerce, or a satisfactory explanation for the failure to make such efforts, in a petition to the Commissioner, filed within one month of the mailing date of the Office Action denying the extension request, pursuant to Trademark Rule 2.89(g).

In this case, the petition was accompanied by a verified statement, signed by Applicant, setting forth its ongoing efforts to make use of the mark. Under 35 U.S.C. §6 and 37 C.F.R. §2.146(a)(3), the Commissioner may invoke supervisory authority in appropriate circumstances.

The petition is granted, and the showing of good cause for the second extension request is accepted. The application file will be returned to the Applications Examiner in the ITU/Divisional Unit for further action in accordance with this decision.

Philip G. Hampton, II  
Assistant Commissioner  
for Trademarks

PGH:NLO:RJD

Date:

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