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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

97-246(R)

Re: Trademark Application of :
Rhone-Poulenc Agrochime :
Serial No. 74/502771 :
Filing Date: March 21, 1994 : On Petition
For: CERGARD :
Request for Reconsideration Filed: December 30, 1998¹ :

Rhone-Poulenc Agrochime has requested reconsideration of the Commissioner's decision dated September 15, 1998, denying its petition to accept the second Request for Extension of Time to File a Statement of Use ("extension request") in connection with the above-identified application. Although the Trademark Rules do not specifically provide for requests for reconsideration of decisions on petitions, the Commissioner has the discretion to consider such requests pursuant to 37 C.F.R. §2.146(a)(3). The Request for Reconsideration ("Request") is denied under 15 U.S.C. §1051(d)(2).

FACTS

Petitioner filed a second extension request on April 1, 1996. In a letter dated July 15, 1996, the extension request was denied because it did not include a verified statement that the applicant had a continued bona fide intention to use the mark in commerce pursuant to 15 U.S.C. §1051(d)(2). On June 4, 1997, Petitioner filed a request that the Commissioner reverse the denial of the second extension request because it contained an allegation of use and that such an allegation exceeded the requirements of a statement of a bona fide intention to use the mark in commerce. On September 15, 1998, the petition was denied because the phrase "in commerce" was omitted from the statement alleging that the mark was in use. This Request was filed on December 30, 1998.

There are two issues for review. First, Petitioner requests that the Commissioner accept the Request filed December 30, 1998, as timely. Counsel for Petitioner declares that he did not receive the decision to deny the petition until December 22, 1998, three months after the decision was issued. Second, Petitioner requests reconsideration of the decision to deny the second extension request because it did not contain the statutory language "in commerce." Petitioner contends that the wording contained in the second extension request, "Actual use of the mark has

¹ On July 13, 1999, Petitioner filed supplemental papers in support of the Request for Reconsideration.

commerced [emphasis added] on goods in Classes 1 and 7..." properly alleges commercial use of the mark in full compliance with the statutory requirements of 15 U.S.C. §1051(d)(2).

ANALYSIS

Timeliness

37 C.F.R. §2.146(d), provides that a petition to the Commissioner "on any matter not otherwise specifically provided for shall be filed within 60 days from the date of mailing of the action from which relief is requested." However, 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 instance, the petition to the Commissioner was decided on September 15, 1998. However, Petitioner did not receive the petition decision until December 22, 1998, a date subsequent to the 60 day response period. Petitioner filed this Request eight (8) days after receipt of the petition decision. The circumstances in this situation are extraordinary in that Petitioner could not have filed the Request during the time period prescribed by the Rules. Accordingly, the Commissioner will waive the requirement under 37 C.F.R. §2.146(d), and consider the filing of the Request timely.

Omission of the Statutory Language "in Commerce"

The statute clearly requires that a statement alleging use of the mark or a bona fide intention to use the mark include the language "in commerce." 15 U.S.C. §1051. "Commerce" is defined as "all commerce which may lawfully be regulated by Congress." 15 U.S.C. §1127.

In this instance, Petitioner neither asserted a bona fide intention to use the mark *in commerce* or that the mark was in use *in commerce*. Rather, the extension request stated the "Actual use of the mark has commerced on goods..." Petitioner argues that the term "commerced" is the past tense of commerce; that "commerce" is an intransitive verb; and that the allegation is in full compliance with the statutory requirement of 15 U.S.C. §1052(d)(2).

While the modern use of "commerce" is as a noun to connote, among other things, "the buying and selling of goods, esp. when done on a large scale between cities, states, or countries, trade,"² Petitioner relies on the archaic use of the term "commerce" as an intransitive verb. As a verb, "commerce" means "to have personal dealings (with),"³ or to "commune." Commune by definition is "to talk over: DISCUSS."⁴ In the context of the Petitioner's allegation, the use of "commerced" is incongruous. In fact, the term appears to be a misprint of "commenced," and a

² WEBSTER'S NEW WORLD COLLEGE DICTIONARY 280 (3rd ed. 1996).

³ WEBSTER'S NEW WORLD COLLEGE DICTIONARY 280 (3rd ed. 1996).

⁴ WEBSTER'S NEW COLLEGiate DICTIONARY 224, 225 (1979).

more reasonable reading of Petitioner's allegation is that "Actual use of the mark has commenced on goods..."⁵

Based on the statutory requirement that the applicant state a bona fide intention to use the mark in commerce and the significance of the term "commerce" as defined by statute, the Commissioner cannot grant Petitioner's request to accept the statement "Actual use of the mark has commenced on goods," as in full compliance with the statutory requirements of 15 U.S.C. §1051(d)(2).

DECISION

The Request is denied. The application remains abandoned.

Robert M. Anderson
Acting Assistant Commissioner
for Trademarks

RMA:CLB

Date:

Attorney for Petitioner:

Donald L. Dennison, Esq.
Dennison, Meserole, Pollack & Scheiner
612 Crystal Square 4
1745 Jefferson Davis Highway
Arlington, VA 22202

⁵ Petitioner refers to the wording in the second extension request as "actual use had commenced" in the petition to the Commissioner filed June 4, 1997.