

Re: Trademark Application of :
 Yamaha Hatsudoki Kabushiki Kaisha :
 Serial No. 74/593,531 :
 Filing Date: November 1, 1994 : On Request for Reconsideration
 For: STAR ROYALE :
 Request Filed: April 24, 1998 :

Yamaha Hatsudoki Kabushiki Kaisha has requested reconsideration of the Commissioner's decision dated February 23, 1998, denying its Petition to Revive 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 Trademark Rule 2.146(a)(3). The Request upon reconsideration is denied.

FACTS

On February 13, 1996, a Notice of Allowance issued for the subject application. Pursuant to Section 1(d) of the Trademark Act, a Statement of Use, or Request for Extension of Time to File a Statement of Use, was required to be filed within six months of the mailing date of the Notice of Allowance.

Petitioner's first two Requests for Extension of Time to File a Statement of Use were approved. On July 31, 1997, Petitioner filed its third extension request. In an Office Action dated August 20, 1997, the Applications Examiner in the ITU/Divisional Unit denied the extension request because it did not include a verified statement that the Applicant has a continued "bona fide intention to use the mark in commerce", as required by Trademark Act Section 1(d)(2), 15 U.S.C. §1051(d)(2), and Trademark Rule 2.89, 37 C.F.R. §2.89.

The third request merely stated that: "Applicant has not yet made use of the mark in commerce on or in connection with the goods identified in the Notice of Allowance; however, Applicant is making the following ongoing efforts to use the mark in commerce on or in connection with each of the goods: Applicant is continuing to research and develop the goods upon which the mark will be used."

A Petition to the Commissioner was filed on September 22, 1997 requesting that the application be revived. Petitioner alleged that the statement in its third extension request that ongoing efforts are being made to use the mark in commerce satisfied the statutory requirements of Section

1(d)(2) of the Trademark Act, 15 U.S.C. §1051(d)(2). In a decision dated February 23, 1998, the Commissioner denied the Petition to Revive. Specifically, the Commissioner held that the statement of “ongoing efforts” to use the mark did not satisfy the statutory requirement of Section 1(d)(2) which requires a statement of “bona fide intention to use the mark in commerce”. The Commissioner held the Applications Examiner in the ITU/Divisional Unit did not err in denying the third extension request.

This Request for Reconsideration followed. In its Request, Petitioner reasserts that the statute does not require an applicant to use the specific words “bona fide intention to use the mark in commerce”, citing *In re Vitamin Beverage Corp.*, 37 USPQ2d 1537 (Comm’r Pats. 1995). Petitioner alleges that as long as Petitioner has expressed its intent to use its mark in commerce, the statutory requirement is satisfied. *Id.*

ANALYSIS

Petitioner’s contention that its statement of ongoing efforts to use the mark in commerce along with an explanation of those efforts satisfies the statutory requirement of Section 1(d)(2) of the Trademark Act is not persuasive for two reasons. First, Petitioner’s contention overlooks the requirement that second and subsequent extension requests must contain both a statement of bona fide intent to use the mark in commerce and a statement of good cause setting forth Petitioner’s “ongoing efforts” to use the mark. These are separate requirements of the statute and the rules. Second, even if they were not separate requirements of the statutes and the rules, Petitioner’s statement of “ongoing efforts” is not the statutory equivalent of a statement of *bona fide intent* to use the mark in commerce.

Statement of Bona Fide Intent to Use the Mark and Statement of Good Cause are Separate Requirements

Section 1(d)(2) of the Trademark Act, 15 U.S.C. §1051(d)(2), provides in pertinent part:

The Commissioner shall extend, for one additional 6-month period, the time for filing the statement of use under paragraph (1), upon written request of the applicant before the expiration of the 6-month period provided in paragraph (1). In addition to an extension under the preceding sentence, the Commissioner may, **upon a showing of good cause by the applicant**, further extend the time for filing the statement of use under paragraph (1) for periods aggregating not more than 24 months . . . **Any request for an extension under this paragraph shall be accompanied by a verified statement that the applicant has a continued bona fide intention to use the mark in commerce** and specifying those goods or services identified in the notice of allowance on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce.

Thus, the statute requires that second and subsequent extension requests include **both**: a showing of good cause and a verified statement of bona fide intent to use the mark. Trademark Rule 2.89(d)(2) sets forth the guidelines for what constitutes good cause and explains the nature of “good cause,” as follows:

The [good cause] showing required by paragraph (b)(4) of this section must include:

(2) A statement of applicant’s ongoing efforts to make use of the mark in commerce on or in connection with each of the goods or services specified in the verified statement of continued bona fide intention to use required under paragraph (b) of this section. Those efforts may include, without limitation, product or service research or development, market research, manufacturing activities, promotional activities, steps to acquire distributors, steps to obtain required governmental approval, or other similar activities. (emphasis added).

In view of Trademark Rule 2.89 governing what constitutes a showing of good cause, the statement made by Petitioner in its third extension request, with respect to its “ongoing efforts” to use the mark in commerce with an explanation of those efforts, merely satisfies the requirement that Petitioner submit a showing of good cause with its extension request. *See generally In re Comdial Corp.*, 32 USPQ2d 1863 (Comm’r Pats. 1993)(A mere statement that applicant is engaged in ongoing efforts to use the mark does not satisfy a showing of good cause; *those efforts must be specified.*)

Neither the statute nor the rule contemplates that the statement of good cause and the statement of bona fide intent be one in the same. To hold that a statement of good cause satisfies the requirement that an applicant has a continued bona fide intent to use the mark or that a statement of bona fide intent to use the mark satisfies the requirement for a showing of good cause would nullify the requirement that both statements be present. 15 U.S.C. §1051(b); 37 C.F.R. 2.89. Thus, while the third extension request contained a showing of good cause, it did not include a separate statement of bona fide intent to use the mark in commerce. 15 U.S.C. §1051(b)(2).¹

Ongoing Efforts to Use the Mark Cannot be Construed as a Statement of Bona Fide Intent to Use the Mark

Even if the requirements for a statement of good cause and for a statement of bona fide intent to use the mark were not two separate requirements of the statute, Petitioner’s statement of “ongoing efforts to use the mark in commerce” in conjunction with an explanation of those efforts cannot be construed as a statement of bona fide intention to use the mark.

¹Even though a statement of good cause can be submitted on Petition after the expiration of the statutory filing period for a Statement of Use, *In re El Taurino Restaurant, Inc.*, 41 USPQ2d 1220 (Comm’r Pats. 1996), for the reasons stated below, the statement of “ongoing efforts to use the mark in commerce” cannot be construed as Petitioner’s statement of “bona fide intent to use the mark in commerce.”

In *In re Vitamin Beverage, supra*, 37 USPQ2d 1537 relied on by Petitioner, the Commissioner held that the statute does not require that an extension request use the *specific words* “bona fide intent to use the mark in commerce”. However, the statute and the rules clearly require a statement that applicant has a *bona fide intention* to use its mark. *Id.* at 1538. In *In re Vitamin Beverage, bona fide intent* to use the mark in commerce was found because, among other things, “Use in Commerce” is defined under the Act as the *bona fide use* of a mark in the ordinary course of trade. 15 U.S.C. §1127 (emphasis added). Thus, the statutory requirement was met. However, nothing in the statements made by Petitioner in its third extension request verifies that Petitioner has a continued *bona fide intent* to use the mark.

Petitioner maintains that its actions speak louder than its words and that by conducting product research and development its intent is exhibited. Even assuming Petitioner has an “intent” to use the mark in commerce, the statutory requirement is a *bona fide intent* to use the mark in commerce, not merely an intent. Merely having good cause for not yet using the mark is not the legal equivalent of a good faith intent to use the mark in commerce.

The Commissioner cannot presume merely from the wording used by Petitioner that Petitioner has the requisite “bona fide intent”. Asserting ongoing efforts to use the mark in commerce in conjunction with an explanation of those efforts does not satisfy the statutory requirement. In as much as the requirement to set forth a statement of continued *bona fide intention* to use the mark is statutory, the Commissioner has no authority to waive it. *In re Hoffmann-La Roche Inc.*, 25 USPQ2d 1539, 1541 (Comm’r Pats. 1992); *In re Custom Technologies, Inc.*, 24 USPQ2d 1712 (Comm’r Pats. 1991); TMEP §§1105.05(d)(i) and 1105.05(d)(ii).

DECISION

Accordingly, the Request upon reconsideration is denied. The application will remain abandoned.

Philip G. Hampton, II
Assistant Commissioner
for Trademarks

PGH:NLO:DDS

Date:

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Black's Law Dictionary defines "intention" as the "determination to act in a certain way or to do a certain thing." *Black's Law Dictionary* defines "bona fide" as "in or with good faith; honestly, openly and sincerely". While Petitioner may very well be continuing to research and develop the goods upon which the mark will be used, merely continuing with ongoing *efforts* to use the mark in commerce is not the legal equivalent of acting in *good faith* to use the mark in commerce. Petitioner's statement of ongoing efforts to use the mark, even when viewed in conjunction with an identification of the efforts being made, does not amount to an assertion of the Petitioner's bona fide intention to use the mark in commerce. There is nothing in the statements made by Petitioner, and the Commissioner cannot presume, that Petitioner's actions are being done in "good faith".

¹Even though a statement of good cause can be submitted on Petition after the expiration of the statutory filing period for a Statement of Use, *In re El Taurino Restaurant, Inc*, 41 USPQ2d 1220 (Comm'r Pats. 1996), for the reasons stated below, the statement of "ongoing efforts to use the mark in commerce" cannot be construed as Petitioner's statement of "bona fide intent to use the mark in commerce."