

Re: Trademark Application of :
 910748 Ontario Ltd. :
 Serial No. 74/619780 : On Petition
 Filing Date: January 10, 1995 :
 For: GREW :
 Petition Filed: October 8, 1996 :

910748 has petitioned the Commissioner to accept a Statement of Use filed in connection with the above application. Trademark Rule 2.146(a)(3) provides authority for the requested review.

FACTS

A Notice of Allowance issued for the subject application on December 5, 1995. Pursuant to Section I(d) of the Trademark Act, a Statement of Use, or Request for an 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.

On June 5, 1996, Petitioner filed a Statement of Use. In an Office Action dated August 19, 1996, the Applications Examiner in the ITU/Divisional Unit notified Petitioner that the papers submitted June 5, 1996 did not comply with the minimum requirements for filing a Statement of Use, because the prescribed fee, as required by Trademark Rule 2.88(e)(1), had not been submitted. This petition followed.

Counsel for Petitioner states that the failure to include the fee with the Statement of Use was a result of a clerical error.

DECISION

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

Within six months of the issuance of the notice of allowance ... the applicant shall file in the Patent and Trademark Office, together with such number of specimens or facsimiles of the mark as used in commerce as may be required by the Commissioner and payment of the prescribed fee, a verified statement that the mark is in use in commerce and specifying the date of the applicant's first use of the mark in commerce, those goods or services specified in the notice of allowance on or in connection with which the mark is used in commerce, and the mode or manner in which the mark is used on or in connection with such goods or services.

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 an extraordinary situation exists, justice requires and no other party is injured thereby. However, the Commissioner has no

³ Of course, this does not include drawing pages, fee checks, or the specimens necessary for use applications which, by their very nature, must be separate items.

¹ Registration was renewed under Section 9 of the Trademark Act. 15 U.S.C. §9 on October 28, 1995.

¹ The correct translation of “maternalbearbeitung” is “material treatment.” The error in translation is noted by Petitioner in subsequent correspondence.

¹ Trademark Rule 2.165(a)(2), 37 C.F.R. Section 2.165(a)(2) states that a request for reconsideration shall be a condition precedent to a petition to the Commissioner to review a refusal of an affidavit, unless the first action refusing the affidavit directs the registrant to petition the Commissioner for relief. Although not directed to petition, it was reasonable for Petitioner to conclude that a request for reconsideration would be ineffective. Thus the petition is deemed properly filed.

Petitioner submitted a revised declaration under Sections 8&15 with the petition. However, since this document was filed after the statutory period, it will not be considered.

Re: Trademark Application of :
 The Sherwin-Williams Company :
 Serial No. 75/011045 :
 Filing Date: October 26, 1995 : On Petition
 For: GRANITE :
 Petition Filed: January 16, 1997 :

The Sherwin-Williams Company has petitioned the Commissioner to reverse the decision of the Legal Assistant at the Trademark Trial and Appeal Board denying a request for an extension of time to file a notice of opposition to the registration of the above referenced mark. Trademark Rule 2.146(a)(3) provides authority for the requested review. The petition is denied under Section 13 of the Lanham Act. (15 U.S.C. § 1063).

FACTS

The above identified mark was published in the *Official Gazette* on June 4, 1996. Petitioner then filed four requests for extensions of time to file an opposition, which were subsequently granted through December 1, 1996.

On December 4, 1996, accompanied by a certificate of mailing, Petitioner filed a fifth request for extension of time. By letter dated December 26, 1996, the Legal Assistant at the Trademark Trial and Appeal Board informed Petitioner that the extension request filed December 4, 1996, was untimely, as it was received following the expiration of the previous extension period. Therefore, the extension request was denied. This Petition followed.

Petitioner argues that since the Applicant has agreed to extending the date for potential opposition, it is a burdensome and unrealistic interpretation of the rules that a stipulated extension request is to be denied.

DECISION

Pursuant to 35 U.S.C. §6 and 37 C.F.R. §2.146(a)(3), the Commissioner may invoke supervisory authority in appropriate circumstances. However, the Commissioner will reverse the Trademark Trial and Appeal Board's denial of a request for an extension of time to file a Notice of Opposition only where there has been a clear error or abuse of discretion. *Kimberly-Clark Corporation v. Paper Converting Industry, Inc.*, 21 USPQ2d 1875 (Comm'r Pats. 1991), *In re Su Wung Chong dba Mido Trading Co*, 20 USPQ2d 1399 (Comm'r Pats. 1991); *In re Software Development Systems Inc.*, 17 USPQ2d 1094 (Comm'r Pats. 1990); *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093 (Comm'r Pats. 1990).

Section 13 of the statute requires that "[a]ny person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of Section 12 of this Act of the mark