

Re: Trademark Application of :
CATO Industrial Co., Ltd. :
Serial No. 74/638876 :
Filing Date: February 28, 1995 : On Petition
For: KONZERT and Design :
Petition Filed: May 19, 1997 :

CATO Industrial Co., Ltd, 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 July 23, 1996. Pursuant to Section 1 (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 January 17, 1997, Petitioner filed a Statement of Use. In an Office Action April 3, 1997, the Paralegal Specialist in the ITU/Divisional Unit notified Petitioner that the papers submitted January 17, 1997, did not comply with the minimum requirements for filing a Statement of Use, because the prescribed fee, and a verified statement that the mark is in use in commerce 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 verified statement with the Statement of Use was an unintentional defect caused by the secretary. Counsel does not explain why the fee for the Statement of Use was not included.

DECISION

Section 1(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, as stated in the statute, certain requirements for a statement of use are statutory and the Commissioner has no authority to waive them. For example, the extension request did not contain a verified statement that the applicant had a bona fide intent to use the mark in commerce, nor did it contain the prescribed fee. Since these requirements are statutory, they cannot be waived by the Commissioner.

Accordingly, the petition is denied. The application will remain abandoned. The fee of \$100 for the Statement of Use submitted with the petition, will be refunded in due course.

Philip G. Hampton, II
Assistant Commissioner
for Trademarks

PGH:NLO:CPS

Date:

Attorney for Petitioner:

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