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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

98-575

Re: Trademark Application of :
California State Railroad Musuem :
Foundation :
Serial No: 74/669372 : On Petition
Filing Date: May 3, 1995 :
For: D GREEN AND ROASTED :
AND DESIGN :
Petition Filed: July 31, 1998 :

California State Railroad Museum Foundation 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. 37 C.F.R. §§2.89(g) and 2.146(a)(3) provide authority for the requested review. The petition is denied.

FACTS

A Notice of Allowance issued for the subject application on September 24, 1996. Petitioner filed two Requests for Extension of Time to File a Statement of Use that were approved. On March 24, 1998, Petitioner filed a third Request for Extension of Time to File a Statement of Use.

In an Office Action dated April 29, 1998¹, the Legal Instruments 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, 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, 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. Petitioner was advised that, since the period of time within which to file an acceptable extension request or Statement of Use had expired, the application would be abandoned in due course. This petition followed.

The third extension request stated that: "Applicant has continued to pursue its plans to use the mark in commerce by refining its business plans, meeting with its graphic artists and public relations consultants to develop marketing and promotional material ...Applicant currently plans test launches of such goods..."

¹ The April 29, 1998 Office Action was inadvertently mailed to the Applicant instead of the correspondence address of record. A copy of that Action is provided with this letter.

Petitioner alleges that the third extension request met the requirement of the rule because the request included a verification of a continued intent to use the mark in commerce and the rule does not require the specific wording “bona fide”. Petitioner’s arguments are based on the decisions of *In Re Vitamin Beverage*, 37 USPQ2d 1537 and *In re Custom Technologies, Inc* 24, USPQ2d 1712.

ANALYSIS

Petitioner has overlooked 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. Even if they were not separate requirements of the statutes and the rules, Petitioner’s statements set forth in the extension request are not the statutory equivalent of a statement of *bona fide* intent to use the mark in commerce. Petitioner’s statements given in the third extension request are merely examples of ongoing efforts to use the mark in commerce, and do not meet the requirements of the statute.

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 second 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 second 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).²

DECISION

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 intention* 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 intention* to use the mark.

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).

Although petitioner’s extension request verifies applicants ongoing efforts to make use of the mark in commerce on or in connection with the services identified in the Notice of Allowance, Petitioner has not shown within or in addition to its statement of good cause, that the applicant has a bona fide intent to use the mark in commerce as required by the statute.

²Even 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.”

Given the fact Petitioner is in the process of developing its products for actual use, without a verified statement that its intent is bona fide, no such showing has been made in the extension request or on petition.

Accordingly, the petition is denied. The application will remain abandoned.

Robert M. Anderson
Acting Assistant Commissioner
For Trademarks

RMA:NLO:SMW

Date:

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