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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

98-157

Re: Trademark Application of :
U.S. West Communications, Inc. :
Serial No. 74/678440 :
Filing Date: May 22, 1995 : On Petition
For: CALLCURFEW :
Petition Filed: January 3, 1998 :

US West Communications, Inc. 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. The Petition is denied under Trademark Rules 2.89(g) and 2.146(a).

FACTS

A Notice of Allowance was issued on March 12, 1996. Petitioner filed Requests for Extension of Time to File a Statement of Use on August 27, 1996 and on March 12, 1997. In a letter issued on January 6, 1998, the applications examiner denied the second extension request, because of a finding that Petitioner did not assert a continued bona fide intention to use the mark in commerce, as required by Trademark Act Section 1(d)(2), 15 U.S.C. Section 1052(d)(2) and Trademark Rule 2.89(b)(3), 37 C.F.R. Section 2.89(b)(3). Petitioner was further advised that the application was abandoned, because the time within which to file a proper extension request had passed. This Petition was filed on January 30, 1998, and subsequent extension requests were filed by the dates these requests would have become due had the application not abandoned.

DECISION

Section 1(d)(2) of the Trademark Act, 15 U.S.C. §1051(d)(2), and Trademark Rule 2.89, 37 C.F.R. §2.89, clearly and explicitly require that a Request for Extension of Time to file a Statement of Use include a verified statement that the applicant has a continued bona fide intention to use the mark in commerce, specifying those goods or services on or in connection with which the applicant has a continued bona fide intention to use the mark. Since this is a statutory requirement, it must be satisfied prior to the expiration of the period for filing the Statement of Use. *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).

Here, the Third Extension Request included the assertion that

“Applicant has a continued bona fide intention to use the mark in connection with the services identified in the notice of allowance, namely, telecommunications services, namely a service which allows customers to turn off incoming or outgoing telephone calls at specified times.” (First Extension Request at p.1).

While this assertion evidences a bona fide intention to *use* the mark, it does not signify an intention to use the mark in *commerce*.

Petitioner’s position that the Extension Request nevertheless evidences a bona fide intention to use the mark in commerce is based upon the presence of the following additional wording in the Request:

“While Applicant has not used the mark in commerce with the services identified in the Notice of Allowance, Applicant is making ongoing efforts, in the nature of market research and product development, to use the mark in connection with those services.” (First Request for Extension at p.1).

Petitioner argues that an “allegation . . . may be implied in the wording of the request.” (Petition t p.2).

This argument is not persuasive. Even an implicit assertion of an intention to use the mark in commerce cannot be discerned on a close reading of the Request for Extension. Petitioner’s statement of a bona fide intent to use the mark includes no reference to “commerce.” The reference to commerce which is made in the phrase which *follows* the statement of bona fide intent cannot be imported into the statement of bona fide intent. While these two phrases follow each other, they are placed in separate paragraphs, and have meanings which are entirely independent of each other. Furthermore, the second phrase includes no language which allows the conclusion that it is meant to modify the preceding phrase.

Petitioner also argues that it was prejudiced by the Office’s failure to notify it of the defect in the extension request until nearly ten months after the submission of the request. Petitioner asserts that had it received earlier notification, it could have submitted a new application at an earlier date. However, the delay in advising Petitioner of the defect, while regrettable, cannot provide grounds for granting this petition.

The Petition is denied. The application will remain abandoned. The fees paid for extension

requests in March 1997, March 1998 and August 1998 will be refunded in due course.¹

Philip G. Hampton, II
Assistant Commissioner
for Trademarks
PGH:NLO:AL

Date:

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¹ The fee paid for an Extension Request submitted in September, 1997 has already been refunded.