

Trademark Application of :
 Golden Books Publishing Company, Inc. :
 Serial No. 74/688006 : On Petition
 Filing Date: June 14, 1995 :
 For: BROTHERS OF THE SPEAR :
 Petition Filed: May 13, 1997 :

Golden Books Publishing Company, 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. Trademark Rules 2.89(g) and 2.146(a)(3) provide authority for the requested review. The petition is denied under Section 1(d)(2) of the Trademark Act, 15 U.S.C. § 1051 (d)(2).

FACTS

A Notice of Allowance issued for the subject application on April 16, 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 May 2, 1996, Petitioner filed its first Request for Extension of Time to File a Statement of Use. The extension request was approved, affording Petitioner the opportunity to file a Statement of Use, or a second Request for an Extension of Time to File a Statement of Use, within twelve months from the mailing date of the Notice of Allowance.

On March 5, 1997, Petitioner filed a second Request for Extension of Time to File a Statement of Use. In an office Action dated April 23, 1997, the Applications Examiner in the ITU/Divisional Unit denied the extension request because it was not accompanied by the prescribed fee, 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. §2.89.¹ 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.

According to the unverified petition², funds in the amount of \$5,000.00 were wire transferred from Petitioner's bank account to Petitioner's deposit account on April 23, 1997.³ Petitioner contends that the extension request should be granted since the prescribed fee for the second extension request was available in the deposit account on the same day the refusal letter was issued.

¹ The application file contains a memo from a terminal operator with the Deposit Account Branch of the Fee Accounting Division which states that insufficient funds were available in the specified deposit account on March 25, 1997.

² Trademark Rule 2.146(c) requires that when facts are to be proved in a petition, proof in the form of affidavits or declarations in accordance with §2.20 shall accompany the petition.

DECISION

Section 1 (d)(2) of the Trademark Act specifically requires that the extension request be filed within six months of the date of issuance of the notice of allowance, or within a previously approved extension period, and that it “be accompanied by payment of the prescribed fee. “ Since these requirements are statutory, they cannot be waived by the Commissioner. *In re Stakis plc*, 25 USPQ2d 1529 (Comm’r Pats. 1992).

Rule 1.25(a), 37 C.F.R. § 1 25(a), regarding deposit accounts clearly states:

(a) ... A minimum deposit of \$ 1,000 is required for paying any fees due or in ordering any services offered by the office... An amount sufficient to cover all fees, services, copies, etc., requested must always be on deposit. Charges to accounts with insufficient funds will not be accepted...

The record herein indicates that on March 25, 1997, office personnel attempted to charge the deposit account for the \$100.00 fee and found insufficient funds. Given the requirements of Rule 1.25 regarding deposit accounts and the administrative need to have the funds available in the account at the time the authorization is presented for debiting, the Applications Examiner acted properly in denying the extension request.

Pursuant to 37 C.F.R. §2.146(a)(3), the Commissioner may invoke supervisory authority in appropriate circumstances. However, in this instance, the time period in which to file the second extension request expired on April 16, 1997. Since Petitioner did not wire the requisite funds to the deposit account until April 23, 1997, the extension request cannot be accepted. The petition is denied. The application will remain abandoned.

Philip G. Hampton, II
Assistant Commissioner
for Trademarks

PGH:NLO:CLB

Date:

Attorney for Petitioner:

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³ Attached to the petition is a copy of a funds transfer receipt from Chase Manhattan Bank to U.S. Patent and Trademark office for \$5,000.00 on behalf of Petitioner.