

Re: Trademark Application of :
 DSC Communications Corporation :
 Serial No. 74-702829 :
 Filing Date: July 18, 1995 : On Petition
 For: PCSPAN :
 Petition Filed: April 18, 1997 :

DSC Communications Corporation has petitioned the Commissioner to accept its second Request for Extension of Time to File a Statement of Use. The petition is denied under Section 1(d)(2) of the Trademark Act, and Trademark Rules 2.89(g) and 2.146.

FACTS

The Notice of Allowance issued on February 20, 1996, for the above-identified application. On August 5, 1996, Petitioner filed its first Request for Extension of Time to File a Statement of Use (“Extension Request”). The first extension request was approved, permitting Petitioner to file a second extension request or a Statement of Use within twelve months of the mailing date of the Notice of Allowance.

Petitioner filed its second extension request on February 13, 1997. In an Office Action dated March 21, 1997, the Legal Instrument Examiner in the ITU/Divisional Unit denied the second extension request because it did not include a verified statement that the Applicant had a continued bona fide intention to use the mark in commerce, as required by 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. 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.

ANALYSIS

Statement of “Bona Fide Intention to Use in Commerce” is Statutory Requirement

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, 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 and/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 Hoffman-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).

“Extraordinary Situation” Standard Under Rule 2.146

For the sake of completeness, Petitioner’s argument regarding the standard of review applicable in this situation will be discussed. However, even if meritorious, Petitioner’s arguments regarding a particular standard of review would fail because of the statutory nature of the requirement at issue. Nowhere in Petitioner’s second extension request does the wording “bona fide intention to use the mark in commerce” appear. As noted above, the requirement that the wording “bona fide intention to use the mark in commerce” appear in extension requests is a statutory requirement. The Commissioner has no authority to waive a requirement of the statute.

Petitioner states that the omission of the words “in commerce” represents a purely unintentional typographical error. Referring to the standard of “unavoidable” delay contained in Trademark rule 2.66(a), 37 C.F.R. §2.66(a), Petitioner notes that “unavoidable” is not limited to “acts of God.” Instead, citing TMEP §1112.05, Petitioner indicates that “unavoidable” means reasonable steps were taken, or precautionary systems were in place, to prevent the error causing the delay, but that the delay occurred in spite of such precautions.

Trademark Rule 2.66 applies when an application is abandoned for failure to timely respond (to an Office Action), or for failure to timely file a Statement of Use. Trademark Rule 2.146(a)(3) applies to petitions to invoke the supervisory authority of the Commissioner. In this petition, there is no question that the second extension request was filed on time. The issue is whether the omission of the wording “in commerce” is fatal to acceptance of the extension request. Therefore, the appropriate standard of review would be the “extraordinary situation” standard under Trademark Rule 2.146.

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. All three conditions must be satisfied before a waiver is granted. In this case, even if the requirement for a statement of “bona fide intention to use the mark in commerce” were not statutory, the circumstances presented here do not justify a waiver of the rules. An oversight or inadvertent omission is not an extraordinary situation, within the meaning of Rules 2.146(a)(5) and 2.148. *In re Tetrafluor Inc.*, 17 USPQ2d 1160 (Comm’r Pats. 1990); *In re Choay S.A.*, 16 USPQ2d 1461 (Comm’r Pats. 1990); *In re Bird & Son, Inc.*, 195 USPQ 586 (Comm’r Pats. 1977).

DECISION

The petition is denied. The application will remain abandoned. Petitioner may consider re-filing the application. The Office will not hold the denial of this petition to be prejudicial to the Applicant in the filing of a new application.

Philip G. Hampton, II
Assistant Commissioner
for Trademarks

PGH:EKM

Date:

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