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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

99-345

Re: Trademark Application of :
The Millennium Society :
Serial No. 75/006,752 :
Filing Date: October 17, 1995 : On Petition
For: COUNTDOWN 2000 :
Petition Filed: :

The Millennium Society has petitioned the Commissioner to accept a Request for an Extension of Time to File a Statement of Use in connection with the above referenced application. The petition is denied under 15 U.S.C. §1051(d)(2).

FACTS

A Notice of Allowance was issued for the above referenced application on February 25, 1997. Petitioner filed four Requests for Extension of Time to File a Statement of Use. The first three of these were accepted, but the fourth was rejected, because it did not include a verified statement of Petitioner's continued bona fide intention to use the mark in commerce on the goods identified in the application, as required by Trademark Act Section 1(d)(2), 15 U.S.C. Section 1051(d)(2). In a letter dated March 25, 1999, the Legal Instruments Examiner advised Petitioner that its only recourse was to petition the Commissioner, since the time for filing a Statement of Use or an extension request had expired.

The present petition followed. Petitioner asserts on petition that it has a continued bona fide intent to use the mark in commerce on the goods identified in the application.

ANALYSIS

Section 1(d)(2) of the Trademark Act, 15 U.S.C. §1051(d)(2), and 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. Because this requirement is statutory, 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, Petitioner's verified statement of its continuing bona fide intention to use the mark in commerce in connection with the goods identified in the application was not made within the time for filing a Statement of Use. This time period expired on February 25, 1999, and the required statement was not made until April 19, 1999, the date on which the petition was filed.

DECISION

The petition is denied, and the application will remain abandoned. Petitioner may wish to file a new application. This Office will not hold the abandonment of this application as being prejudicial to the Applicant in the filing of a new application. Currently, the application filing fee is \$245.00 per class.

Robert M. Anderson
Acting Assistant Commissioner
for Trademarks

RMA:AL

Date:

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