

Re: Trademark Application of :  
 The Sherwin-Williams Company :  
 Serial No. 75/011045 :  
 Filing Date: October 26, 1995 : On Petition  
 For: GRANITE :  
 Petition Filed: January 16, 1997 :

The Sherwin-Williams Company has petitioned the Commissioner to reverse the decision of the Legal Assistant at the Trademark Trial and Appeal Board denying a request for an extension of time to file a notice of opposition to the registration of the above referenced mark. Trademark Rule 2.146(a)(3) provides authority for the requested review. The petition is denied under Section 13 of the Lanham Act. (15 U.S.C. § 1063).

## FACTS

The above identified mark was published in the *Official Gazette* on June 4, 1996. Petitioner then filed four requests for extensions of time to file an opposition, which were subsequently granted through December 1, 1996.

On December 4, 1996, accompanied by a certificate of mailing, Petitioner filed a fifth request for extension of time. By letter dated December 26, 1996, the Legal Assistant at the Trademark Trial and Appeal Board informed Petitioner that the extension request filed December 4, 1996, was untimely, as it was received following the expiration of the previous extension period. Therefore, the extension request was denied. This Petition followed.

Petitioner argues that since the Applicant has agreed to extending the date for potential opposition, it is a burdensome and unrealistic interpretation of the rules that a stipulated extension request is to be denied.

## DECISION

Pursuant to 35 U.S.C. §6 and 37 C.F.R. §2.146(a)(3), the Commissioner may invoke supervisory authority in appropriate circumstances. However, the Commissioner will reverse the Trademark Trial and Appeal Board's denial of a request for an extension of time to file a Notice of Opposition only where there has been a clear error or abuse of discretion.

*Kimberly-Clark Corporation v. Paper Converting Industry, Inc.*, 21 USPQ2d 1875 (Comm'r Pats. 1991), *In re Su Wung Chong dba Mido Trading Co*, 20 USPQ2d 1399 (Comm'r Pats. 1991); *In re Software Development Systems Inc.*, 17 USPQ2d 1094 (Comm'r Pats. 1990); *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093 (Comm'r Pats. 1990).

Section 13 of the statute requires that “[a]ny person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of Section 12 of this Act of the mark sought to be registered.” Since the time for filing an extension of time to oppose is a statutory requirement, the Commissioner has no authority to waive the requirement. *In re Kabushiki Kaisha Hitachi Seisakusho*, 33 USPQ2d 1477 (Comm’r Pats. 1994); *In re Cooper*, 209 USPO 670 Comm’r Pats. 1980).

The petition is denied. The application file will be returned to the Trademark Trial and Appeal Board and then forwarded for issuance of the registration. Petitioner is not without a remedy. Once the subject mark registers, it is free to file a petition to cancel, pursuant to 15 U.S.C. §1064.

Philip G. Hampton, II  
Assistant Commissioner  
for Trademarks

PGH:NLO:RJD

Date:

Attorney for Petitioner:

Jess M. Collen, Esq.  
Box 306, Scarborough Station  
Scarborough, NY 10510-0806