

Re: Trademark Application of :
American Vaccine Corporation :
Serial No. 75/053,576 :
Filing Date: February 5, 1996 : On Petition
For: ANAVACEL :
Petition Filed: September 10, 1998 :

American Vaccine Corporation has petitioned the Commissioner to reverse the denial of the Requests 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.

FACTS

On June 10, 1998, Petitioner filed a third Request for Extension of Time to File a Statement of Use. The request was filed by North American Vaccine, Inc. and signed by Edward J. Jones, the President of American Vaccine Corporation. On June 24, 1998, the Applications Examiner in the ITU/Divisional Unit denied the extension request because the applicant of record, American Vaccine, Inc, did not file it.

Petitioner was granted 30 days to submit evidence that the party who filed the extension request was the owner of the mark at the time the request was filed. Petitioner did not respond and a Notice of Abandonment issued on July 13, 1998. This petition followed.

Petitioner states that the filing of the extension request in the name of North American Vaccine, Inc. was an inadvertent typographical error. North American Vaccine, Inc. is a wholly owned subsidiary of American Vaccine Corporation and an officer of the applicant corporation properly signed the extension.

DECISION

Pursuant to Section 1(d)(2) of the Trademark Act and Trademark Rule 2.89, the owner of the mark must file the Request for Extension of Time to file a Statement of Use. An applicant may submit evidence that the party who filed the extension request was the owner of the mark at the time the request was filed, even after expiration of the time for filing the Statement of Use. However, if the party who filed the extension request was not the owner of the mark at the time the request was filed, a substitute verification in the name of the true owner cannot be filed unless there is time remaining in the statutory period for filing the Statement of Use. TMEP §1105.05(d). *In re Raychem Corp.*, 20 USPQ2d 1355, 1358 (Comm'r Pats. 1991). Furthermore,

the fact that the individual who signed the extension request had statutory authority to sign cannot overcome the denial of an extension request if the owner of the mark did not file the extension request. *See In re Colombo Inc.* 33 USPQ2d 1530 (Comm'r Pats. 1994).

An applicant may correct certain mistakes in the applicant's name in an extension request, just as a mistake in setting forth an applicant's name is permitted in an application for registration. For example, clerical errors such as the mistaken addition or omission of terms such as "The" or "Inc." may be corrected by amendment. An applicant may also correct an ambiguity as to who is the owner of the mark. Where an individual and a corporation are each identified as the owner in different places in an application, the application may be amended to indicate which party is the proper applicant. However, an amendment substituting one entity for another is not permitted. TMEP §§802.07 and 1201.02(c). *In re Colombo Inc.* 33 USPQ2d 1530 (Comm'r Pats. 1994).

In this case, the mistake can not be corrected. It is not a minor clerical error and there is no ambiguity in the extension request. North American Vaccine, Inc. is a legal entity who is not the owner of the application. Since the extension request was filed by an entity that is not the applicant of record, it cannot be accepted.

The petition is denied. The application remains abandoned. The \$100 fee for filing a substitute third extension request will be refunded in due course.

Robert M. Anderson
Deputy Assistant Commissioner
for Trademarks

RMA:JCL

Date:

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