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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

98-637

Re: Trademark Application of :
The Mashantucket Pequot Tribe :
Serial No. 75/101633 :
Filing Date: May 9, 1996 : On Petition
For: BANK ROLL :
Petition Filed: August 27, 1998 :

The Mashantucket Pequot Tribe (“Petitioner”) has petitioned the Commissioner to reverse the denial of the second Request for Extension of Time to File a Statement of Use (the “Extension Request”) in connection with the above-identified application. The petition is denied under 15 U.S.C. §1051(d)(2) and 37 C.F.R. 2.89(b)(3).

FACTS

A Notice of Allowance issued for the subject application on July 22, 1997. Petitioner filed its first Extension Request on January 15, 1998. The extension was approved, allowing Petitioner twelve months from the Notice Allowance issuance date to file the Statement of Use, or second Extension Request.

On July 15, 1998, Petitioner filed the second Extension Request. This request did not include the verified statement that the applicant had a continued *bona fide* intention to use the mark in commerce. Rather, Petitioner stated the following: “Applicant is presently finalizing plans for a series of slot machines which is likely to include the mark of the present application. These machines are custom products and are expected to be available by November-December 1998. At that time, Applicant will engage in promotional activities relative to the new series of slot machines. Literature for the new games is presently being created.”

In an Office Action dated July 30, 1998, the Legal Instruments Examiner of the ITU/Divisional Unit denied the Extension Request because it did not include a verified statement that the applicant has a continued *bona fide* intention to use the mark in commerce with the specified goods or services, as required by 15 U.S.C. § 1051(d)(2) and 37 C.F.R. §2.89(b)(3). Petitioner was advised further that the application would be abandoned in due course because the period of time within which to file an acceptable Extension Request or Statement of Use expired.¹ This petition followed.

¹ The Office Action also included an instruction to include a statement of good cause if the applicant filed a petition to the Commissioner. It appears that Petitioner did include a statement of good cause when the second Extension Request was filed and that the reference in the Office Action was inserted inadvertently.

Petitioner's Argument

Petitioner maintained that while the “black letter phrase ‘that Applicant has a continued bona fide intention to use the mark in commerce’” was omitted inadvertently, the remaining statements contained in the Extension Request did indicate this statutory intent.

ANALYSIS

The statutory requirements in 15 U.S.C. §1051(d)(2) are set forth, in part, as follows:

The Commissioner shall extend for one additional 6-month period, the time for filing the statement of use under paragraph (1), upon written request of the applicant before the expiration of the 6-month period provided in paragraph (1). In addition to an extension under the preceding sentence, the Commissioner may, upon a showing of good cause by the applicant, further extend the time for filing the statement of use under paragraph (1) for periods aggregating not more than 24 months...Any request for an extension under this paragraph shall be accompanied by a verified statement that the applicant has a continued bona fide intention to use the mark in commerce and specifying those goods or services identified in the notice of allowance on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce...

Thus, the statute requires that second and subsequent extension requests include both a showing of good cause and a verified statement of *bona fide* intention to use the mark. The Trademark Rules set forth what constitutes good cause and explains the nature of “good cause,” in 37 C.F.R. 2.89(d)(2). This rule reads, in part:

The [good cause] showing required by paragraph (b)(4) of this section must include:

(2) *A statement of applicant's ongoing efforts to make use of the mark in commerce on or in connection with each of the goods or services specified in the verified statement of continued bona fide intention to use required under paragraph (b) of this section. Those efforts may include, without limitation, product or service research or development, market research, manufacturing activities, promotional activities, steps to acquire distributors, steps to obtain required governmental approval, or other similar activities...* (emphasis added)

Neither the statute nor the rules contemplate that the statement of good cause and the statement of *bona fide* intent be one in the same. To hold that a statement of good cause satisfies the requirement that an applicant has a continued *bona fide* intent to use the mark or that a statement of *bona fide* intent to use the mark satisfies the requirement for a showing of good cause would nullify the requirement that both statements be present. 15 U.S.C. §1051(b); 37 C.F.R. 2.89.

The Commissioner may 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. The requirement that an extension request verify that applicant has a “*bona fide* intention to use

the mark in commerce” is statutory and cannot be waived. Because 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-LaRoche 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).

The good cause and *bona fide* intention to use statements are distinct statutory requirements for Extension Requests, and are not legal equivalents. 15 U.S.C. §1051(d). Hence, while the Petitioner’s second Extension Request included a showing of good cause, it did not include a separate statement of *bona fide* intention to use the mark in commerce. 15 U.S.C. § 1051(b)(2).

DECISION

Accordingly, the petition is denied. The application will be abandoned in due course.

Robert M. Anderson
Deputy Assistant Commissioner
for Trademarks

Date:

RMA:SLC

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