

99-493

Re: Trademark Application of :
De Ladoucette :
Registration No. 860,263 :
Issued: November 12, 1968 : Petition
For: COMTE LAFOND and :
Design :
Petition Filed: June 24, 1999 :

De Ladoucette has petitioned the Commissioner to accord the above-identified registration a renewal term of twenty (20) years, rather than a 10 year term and to hold the above-identified registration valid and in full force. 37 C.F.R. §2.146(a)(3) provides authority for the requested review. The Petition is denied.

FACTS

The above-identified registration issued on November 12, 1968. On October 31, 1988, Petitioner filed an application for renewal. On February 27, 1989, the Affidavit/Renewal Examiner issued a letter noting that the records of the United States Patent and Trademark Office (“Office”) indicated that title to the registration was vested in a party other than the party who filed the renewal application. On August 24, 1989, Petitioner submitted the necessary evidence to support that the registrant had changed its name and as such, the party who submitted the renewal application was the owner of the registration. On January 31, 1990, a renewal certificate was issued noting both the date of approval of the renewal application and the grant of a 10-year term of renewal to the registration.

A second renewal application was due on November 12, 1998. Petitioner did not file a renewal application within the statutory period in which the renewal application must be filed. 15 U.S.C. § 1059.¹ This Petition followed.

Petitioner alleges that the above-identified registration should have been granted a renewal term of twenty (20) years, not ten (10) years when the registration was renewed on January 31, 1990. Petitioner alleges that it filed its first renewal application more than one year before November 16, 1989, the effective date when the United States laws changed the term of a registration from twenty years to ten years for marks registered or renewed on or after November 16, 1989. Petitioner maintains that the delay in accepting the renewal application was due to the fact that the Office did not timely process the renewal application.

¹ Since no renewal application was filed, the registration will expire in due course.

Petitioner further alleges that the policy of according a registration a renewal term based on the date the registration was renewed as opposed to the original registration issuance date is unfair. Petitioner asserts that the renewal date should determine the renewal period and any mark due for renewal prior to November 16, 1989 (the “effective date”) should have been renewed for twenty (20) years. Petitioner further alleges that the change in calculating the renewal date was established without public discussion or notice.

Finally, Petitioner asserts that because counsel for Petitioner was unaware of the manner in which the Office was handling renewal applications, the above-identified registration was docketed on counsel for Petitioner’s docketing system for a twenty (20) year term. Specifically, counsel for Petitioner asserts that its docketing system calculated the renewal term based on the laws in effect at the time. Since Petitioner filed its renewal application in 1988, more than one year before the effective date of the change in the law, and because the renewal application was due on November 12, 1988, a year before the effective date of the change in the law, the database automatically assigned a twenty (20) year term to the above-identified registration reflecting the next renewal due date as November 12, 2008.

ANALYSIS

Relevant Law on Point

The Trademark Law Revision Act of 1988 (“revised Act”), implemented on November 16, 1989, amended 15 U.S.C. §1059 of the Trademark Act by reducing the term of any registration renewed on or after the effective date of the Act from 20 years to 10 years.

15 U.S.C. §1059 provides in part:

- (a) Each registration may be renewed for periods of ten years from the end of the expiring period upon payment of the prescribed fee and the filing of a verified application therefor, setting forth those goods or services recited in the registration on or in connection with which the mark is still in use in commerce and having attached thereto a specimen or facsimile showing current use of the mark, or showing that any nonuse is due to special circumstances which excuse such nonuse and it is not due to any intention to abandon the mark. Such application may be made at any time within six months before the expiration of the period for which the registration was issued or renewed, or it may be made within three months after such expiration on payment of the additional fee herein prescribed.

37 C.F.R. §2.181 was drafted to provide for the transition from practice under the formerly effective provisions of the Trademark Act to the practice under the revised Act. 37 C.F.R. §2.181 provides in pertinent part:

(a)(1) Registrations issued or renewed under the Act, prior to November 16, 1989. . . remain in force for twenty years from their date of issue or expiration.

..
(2) Registrations issued or renewed under the Act on or after November 16, 1989 . . . remain in force for ten years from their date of issue or expiration

*Granting the Above-Identified Registration a Ten-Year Term
is Consistent with the Office Policy that was Published*

Rule 2.181 was promulgated only after considerable discussion within the Office and following receipt of comments from interested members of the public. *See generally In re Maytag Corp.*, 21 USPQ2d 1615 (Comm’r Pats. 1991). The decision in *In re Maytag* outlines the policy behind the Office’s practice and specifically identifies the levels of notice provided by the Office to the public regarding its changes in practices.

As noted in *In re Maytag*, a notice of proposed rulemaking was published in the *Federal Register* on May 4, 1989, at 54 FR 19286, in the *Official Gazette*, on May 16, 1989, at 1102 TMOG 47-70, and in the Bureau of National Affairs’ *Patent, Trademark & Copyright Journal* on May 11, 1989, at 38 PTCJ 43-71. This notice invited interested members of the public to submit comments on proposed revisions to the Trademark rules. The Office subsequently published a summary of all the comments generated by the notice and the Office’s responses to the comments in the *Federal Register* on September 11, 1989, at 54 FR 37562, and in the *Official Gazette* on October 3, 1989, at 1107 TMOG 7.

Further, the day after the comments and responses were published in the *Federal Register*, the Office published a second notice in the *Official Gazette* on September 12, 1989, relating to the proposed rulemaking on the Trademark Law Revision Act. *Official Gazette*, 1106 TMOG 25 (September 12, 1989). This notice made it clear that the date on which the Office accepted a renewal application would determine whether a particular registration was granted a renewal term of 10 years or 20 years; the notice clearly indicated that the length of the renewal term would not be determined by either the ending date or the expiring period or the filing date of the renewal application. As noted in *In re Maytag Corp.*:

When the Office issues a registration or approves an application for renewal, the Office has taken an action that is relative to status. Thus, the status change from “pending application” to “registration” results when a registration issues; and the status change from “registered” to “renewed” results when an application for renewal is accepted. The calculation of registration terms and renewal terms are distinct matters which need not necessarily be tied to the status changes which yield the “effective dates” of registrations and renewals. [Footnote omitted]

In re Maytag, 21 USPQ2d at 1617-1618. Thus, the Office provided the public with adequate notice of the rule change, an opportunity to comment on the changes to the rules prior to their

implementation, and a clear justification for calculating the renewal period from the date the renewal application is actually accepted by the Office.

Since the renewal application of Petitioner was not accepted until January 31, 1990, pursuant to 37 C.F.R. §2.181, the registration was properly granted a renewal term of ten (10) years.

Time for Filing a Renewal Cannot be Extended

37 C.F.R. §2.146(a)(3) permits the Commissioner to invoke his supervisory authority in appropriate circumstances. However, 15 U.S.C. §1059 clearly requires that a complete renewal application be filed within the time limits set forth therein. The Commissioner cannot extend, suspend, or waive the time for filing a complete application for renewal for any reason. *In re Culligan International Co.*, 915 F.2d 680, 16 USPQ2d 1234 (Fed. Cir. 1990); *In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984); *In re Michaels Stern & Co., Inc.*, 199 USPQ 382 (Comm'r Pats. 1978); *Ex parte Firmenich & Co.*, 137 USPQ 476 (Comm'r Pats. 1963). As Petitioner did not file a second renewal application within the time frame set by statute, the above-identified registration will expire.

*Even if the Ten Year Renewal Period Were not Statutory,
There is no Showing of Extraordinary Circumstances*

Petitioner further alleges that due to the circumstances in this case that the renewal term for the above-identified registration should be changed from ten (10) years to twenty (20) years. As noted above, the determination of the renewal term of the above-identified registration is governed by 37 C.F.R. §2.181. As Rule 2.181 embodies the requirements of the statute, the Commissioner is without the authority to waive the Rule. Thus, the Office cannot accord Petitioner a 20-year renewal term. *See generally In re Maytag*, 21 USPQ 1615 (Comm'r Pats. 1991).

Nonetheless, even if the calculation of the renewal term, pursuant to Rule 2.181, were not statutory, the circumstances presented here do not justify a waiver of the rules. 37 C.F.R §§ 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. However, 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).

While counsel for Petitioner may have docketed the time frame for filing the second renewal application in conjunction with the above-identified registration based on its understanding of the law at the time, the renewal certificate provided Petitioner with notice that the renewal term was ten years and the published notices from the Office provided Petitioner with information regarding how the Office was handling renewal applications accepted after the November 16, 1989 effective

date. Thus, counsel for Petitioner was on adequate notice that the renewal term for the instant registration was a 10-year term.

DECISION

The Petition is denied. The registration will expire in due course. Petitioner may file a new application for the above-identified mark and request that that application be deemed special due to the fact that the above-identified registration expired inadvertently. *See* TMEP 1102.03.

Robert M. Anderson
Deputy Assistant Commissioner
for Trademarks

RMA:DDS

Date:

Attorney for Petitioner:

Lawrence E. Abelman, Esq.
Abelman, Frayne & Schwab
150 East 42nd Street
New York, NY 10017-5612