

Susan Upton Douglass, Esq.
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633 Third Ave.
New York, New York 10017

Re: Petition to Revive Application Serial No. 74-415090
Applicant: Stock Company "Nakhodka Oil Seatrade Port"
For: Miscellaneous Design

Dear Ms. Douglass:

This will acknowledge receipt of the petition to revive the above-identified application, filed November 6, 1996.

Decision: Petition to Revive is hereby DENIED.

This application was abandoned for failure to file a Statement of Use, or Request for Extension of Time to File a Statement of Use, within 6 months of the Notice of Allowance, i.e., on or before February 29, 1996.¹

In any petition to revive an abandoned application, the applicant must show that the delay in responding was unavoidable. Delays due to circumstances that could have been avoided with the exercise of care and attention are not considered unavoidable delays.

The term "unavoidable" means that reasonable steps had been taken, or precautionary systems were in operation which were designed to avoid the circumstances which caused the delay, but the delay occurred despite these precautions. If there were reasonable precautions that could have been taken to anticipate and avoid the delay, and those precautions were not taken, then the delay is considered avoidable and the petition to revive the application will not be granted. TMEP §1112.05(b)(i).

In this case, there has been no showing that reasonable precautions were taken to avoid the circumstances that caused the delay. Based on the verified explanation and supporting exhibits, the applicant's counsel in the U.K. faxed to the attorney of record in the U.S. a Request for an Extension of Time to File a Statement of Use on February 28, 1996, one day before the extension request was due. Furthermore, the applicant's attorney in the U.K. requested that the attorney of record confirm receipt of the instructions to file the extension request. Based on the record, no confirmation was received. Given the importance of statutory filing deadlines in this Office, the foreign counsel should have known to contact the attorney of record prior to the expiration of the time for filing the extension request to ensure that it was received for timely filing. However, foreign counsel did not speak with the attorney of record until March 18, 1996, approximately two and one-half weeks past the expiration date. Foreign counsel's written reminder was sent on March 28, 1996, one month past the expiration date.

The fact that a party's attorney failed to timely file a response does not amount to unavoidable delay. A duly appointed attorney is the applicant's legal representative, and the applicant is bound by the consequences of the actions of the attorney. *In re Sotheby's Inc.*, 18 USPQ2d 1969 (Comm'r Pats. 1989).

When the applicant is located in a foreign country, it is essential that adequate time be allocated to the preparation, execution and submission of time sensitive documents in order to avoid abandonment of an application for failure to timely file such documents. In this instance, execution of the extension request in a foreign country one day before the filing date and failure to confirm with the attorney of record receipt of the document on or before the filing date does not constitute a situation in which reasonable time allowances were made to ensure timely submission of the document to the Office. Therefore, while the delay may have been inadvertent or unintentional, it cannot be said to have been unavoidable.

The applicant states that it took all appropriate steps to monitor this application and that the application was abandoned due to the unfortunate breakdown of the local attorney.² However, there is nothing in the record to establish that the application became abandoned because of the health status of local counsel. As explained above, the verified explanation and evidence indicate that the application became abandoned for failure to allocate sufficient time to file the extension request and to confirm receipt of the extension request with local counsel for timely filing.

Even if local counsel failed to file the extension request due to illness, the petition still would be denied. As stated above, there is a duty to allocate sufficient time for the preparation and filing of essential documents. Delaying the preparation of the documents until the last few days of the response period does not allow for contingencies, such as a sudden illness, that may delay submission of the document. Sudden illness of counsel on the last day of the response period is not unavoidable.

Since applicant has not shown that the delay in filing the extension request was unavoidable, the petition to revive is denied. The applicant may wish to consider filing a new application. The Office will not hold the denial of this petition to be prejudicial to the applicant in the filing of a new application. Currently, the application filing fee is \$245.00 per class.

The filing fees for the Extensions of Time to File a Statement of Use will be refunded. However, the \$100 petition fee will not be refunded.

Hope E. Slonim
Staff Attorney
Office of the Assistant Commissioner
for Trademarks

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¹ The Petitioner refers to an outstanding Office action. However, an Office action is not the concern in this instance. In order to avoid abandonment, either a Statement of Use or a Request for an Extension of Time to File a Statement of Use, executed by the applicant, must have been filed within six months of the Notice of Allowance.

² Petitioner's review in May 1996 of an on-line database which reports the status of U.S. trademark registrations and applications is noted. Since updates to such databases may occur several weeks or months after a change is made, it is not surprising that the subject application was not yet showing as "abandoned."