

Mr. L. Fallasha Erwin  
Commercial Law Corp., P.C.  
220 Bagley, Suite 1010  
Detroit, MI 48226

Re: Petition to Revive Application Serial No. 74-525032  
Applicant: Mayce Edward Christopher Webber  
For: THE FAB 5

Dear Mr. Erwin:

This will acknowledge receipt of the petition to revive the above-identified application, filed August 13, 1997.

Decision: Petition to Revive is hereby DENIED.

## **FACTS**

On May 16, 1994, Applicant applied for registration of the above trademark. A Notice of Allowance was issued on October 24, 1995, for the mark as used on goods in five classes. A Statement of Use or a Request for Extension of Time to File a Statement of Use was due within six months of the mailing date of the Notice of Allowance, i.e., on or before April 24, 1996.

Counsel for applicant filed the first Request for Extension of Time to File a Statement of Use on March 22, 1996.

Applicant was notified on June 13, 1996 of the denial of his first extension request due to insufficient fees, as required by Trademark Act § 1(d)(2), 15 U.S.C. §1051(d)(2). The subject application, covering five classes, required a total fee of \$500. Counsel for applicant paid \$400. Applicant was then granted 30 days to submit the deficient amount, or to specify the class(es) to which the fee should be applied. Counsel was advised that if no class was specified by the applicant, the highest numbered International Class(es) would be abandoned, but the remaining class(es) would continue. On July 8, 1996, counsel for applicant submitted additional fees of \$200 and specified that the applicant wanted to continue in four of the five classes originally provided, omitting Class 41.

The credit history of Applicant's file indicates that this \$200 was refunded on October 24, 1996. If you have not received this refund, you may contact Hae Park, at (703) 308-8910, ext. 35.

A Notice of Approval of the Extension Request was mailed to counsel on September 17, 1996, stating that applicant had 12 months from the mailing date of the Notice of Allowance to file a Statement of Use, and indicating that the Notice of Allowance date was October 24, 1995.

When no Statement of Use, or Request for an Extension of Time to File a Statement of Use was filed in this Office by October 24, 1996, this application was deemed abandoned on October 25,

1996. A Notice of Abandonment was mailed to counsel on June 13, 1997. This petition followed.

## ANALYSIS

Trademark Rule 2.66 provides that an application abandoned for failure to file a Statement of Use within the statutory period (Trademark Rule 2.65(c)), may be revived as a pending application if a showing is made that the delay was unavoidable. This petition to revive is denied because unavoidable delay has not been shown.

### *1. Failure to read not unavoidable.*

Counsel for applicant states that his assistant mischaracterized the Notice of Approval as requiring a Statement of Use or an Extension of Time to File a Statement of Use within 12 months of the mailing date of the Notice of Approval, rather than within 12 months of the Notice of Allowance, as clearly stated.

The attorney of record was aware of the due date well in advance, and had a duty to keep adequate records, allocate sufficient time, and take whatever action was necessary to file a Statement of Use, or a Request for an Extension of Time to File a Statement of Use, within the time prescribed by statute. If counsel delegated the responsibility for preparing the response to his employees or associates, he had a duty to supervise and follow up to ensure that a proper response was filed within the six month statutory response period.

Counsel's failure, and failure by counsel's assistant, to read the Notice of Approval properly cannot be said to constitute unavoidable delay for purposes of Rule 2.66.

### *2. Delay due to non-receipt or late-receipt of Notice of Approval not unavoidable*

Counsel for applicant also contends that the delay in filing the Statement of Use, or Request for Extension of Time to File a Statement of Use, was unavoidable due to the Office's failure to provide adequate notice of approval of the extension request filed March 22, 1996. However, Trademark Rule 2.89(g) clearly states that "[f]ailure to notify the applicant of the grant or denial of the request prior to the expiration of the existing period or requested extension does not relieve the applicant of the responsibility of timely filing a statement of use under §2.88." Nor does the filing of a petition to revive stay the time for filing these papers. TMEP §1105.05(d)(v). See *In re Hoffmann-La Roche Inc.*, 25 USPQ2d 1539 (Comm'r Pats. 1992).

Thus, an applicant's delay in filing an extension request or a Statement of Use because of the delay in receiving a notice of approval of an earlier filed extension request is not deemed to be unavoidable, within the meaning of Rule 2.66.

## APPLICANT MAY FILE A NEW APPLICATION

Applicant may file a new application. This Office will not hold the abandonment of this application

as being prejudicial to the Applicant in the filing of a new application. Currently, the application filing fee is \$245.00 per class.

If you have any questions or need further assistance, please feel free to call Hae Park at (703) 308-8910, ext. 35.

Sincerely,

Nancy L. Omelko  
Administrator for Petitions  
Office of the Assistant Commissioner for Trademarks  
(703) 308-8910, ext. 39

NLO/hsp