

Re: Trademark Registration of :
 Advance Delivery & Chemical :
 Systems, Inc. :
 Registration No. 1,598,017 :
 Issued: May29, 1990 : On Petition
 For: ADCs and Design :
 Petition Filed: November 18, 1996 :

Advanced Delivery & Chemical Systems, Inc., has petitioned the Commissioner to accept its Combined Declaration of Continuous Use and Incontestability, filed under Sections 8 and 15 of the Trademark Act. The petition is denied under Trademark Rule 2.146.

FACTS

The above-identified registration issued on May 29, 1990. Pursuant to Section 8 of the Trademark Act, 15 U.S.C. § 1058, an affidavit of use in commerce, (or acceptable non-use), was required to be filed in the office on or before May 29, 1996. Petitioner filed its combined affidavit under Sections 8 and 15 on October 22, 1996.

ANALYSIS

Petitioner provides two explanations for the tardiness of its Section 8 Affidavit. First, Petitioner was unaware of the requirements with respect to maintenance of its trademark registration. Second, the law firm retained by Petitioner failed to actually notify Petitioner of the deadline for filing the Section 8 affidavit.

Since issuance of the registration, Petitioner has moved its offices. However, Petitioner filed a forwarding order with the U.S. Post office, so that correspondence sent to its former address would be forwarded.

In July 1995, and again in January 1996, the law firm of record in the underlying application sent letters to Petitioner, informing petitioner of the Section 8 requirement. The January 1996 letter was returned later in the month, with an explanation that the Petitioner's forwarding order had expired. Two months later, in March, 1996, the original letter of July 1995 was returned, also noting that the forwarding order had expired.¹

¹ Petitioner indicates that it "ceased operations in Illinois" sometime in 1994. The petition is silent on the matter of when the forwarding order was filed with the U. S. Postal Service and the duration of the forwarding order. However, even if Petitioner could demonstrate that the forwarding order should have been in effect when the law firm's July 1995 letter was mailed, the petition would still be denied. This is so because the requirement for timely submission of a Section 8 affidavit is a statutory requirement.

As a practical matter, even after the return of the July 1995 and January 1996 letters, Petitioner's law firm had plenty of time to contact Petitioner and notify it about the upcoming deadline for filing the Section x affidavit. Petitioner could also have contacted the law firm to determine if any further action needed to be taken with respect to its trademark registration.

Petitioner argues that the law firm's failure to contact Petitioner after it knew Petitioner had moved constitutes a unique and extraordinary circumstance justifying grant of its petition.

The Commissioner has no authority to extend or waive the statutory period for filing an acceptable affidavit under Section 8 of the Act. *In re Mother Tucker's Food Experience Canada Inc.*, 5F.2d1402, 17USPQ2d1795 (Fed.Cir.1991), *In re Precious Diamonds, Inc.*, 635 F.2d 845, 208 USPQ 410 (C.C.P.A. 1980); *In re Kruysman, Inc.*, 199 USPQ 110 (Comm'r Pats. 1977); *Ex parte Buchicchio*, 118 USPQ 40 (Commtr Pats. 1958). The legislative history of Section 8 clearly indicates that a specific cut-offtime was contemplated for submission of the Section 8 affidavit, failing which, the registration would be cancelled even though the mark may still be in use. Accordingly, although it is clear that it was the intent of Congress that Section 8 serve to keep live marks on the register, it also mandated a specific cut-off date, whether the mark is still in use or not, for submission of the Section 8 affidavit.

DECISION

The petition is denied. The registration will be cancelled in due course.

Philip G. Hampton, II
Assistant Commissioner
for Trademarks

PGH:EKM

Date:

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