



**UNITED STATES DEPARTMENT OF  
COMMERCE**

**Patent and Trademark Office**

ASSISTANT COMMISSIONER FOR TRADEMARKS  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Re: Trademark Registration of : 97-496  
World Wide Distributing Co., Inc. :  
Registration No. 1658793 :  
Issued: October 1, 1991 : On Petition  
For: BODY EEZ :  
Informal Petition Filed: November 18, 1997<sup>1</sup> :

World Wide Distributing Co., Inc. has petitioned the Commissioner to accept a Combined Affidavit of Use and Incontestability under Sections 8 and 15 of the Trademark Act, 15 U.S.C. §§1058 and 1065, filed in connection with the above-identified registration. The petition is denied.

## **FACTS**

The above-identified registration issued on October 1, 1991. Pursuant to Section 8 of the Trademark Act, 15 U.S.C. §1058, Petitioner was required to file an affidavit or declaration of continued use or excusable nonuse between the fifth and sixth year after the registration date, i.e., between October 1, 1996 and October 1, 1997. On October 2, 1997, Petitioner filed its Combined Affidavit of Use and Incontestability under Sections 8 and 15 of the Trademark Act.

## **DECISION**

As indicated above, Section 8 of the Trademark Act requires a registrant to file an affidavit or declaration of continued use or excusable nonuse between the fifth and sixth year after the date of issuance of the registration. The affidavit or declaration must be both executed and filed within the sixth year after the registration date. Trademark Rule 2.162(a); TMEP §1603.03.

Pursuant to Rule 1.6, the filing date of a document is its date of receipt in the Patent and Trademark Office, unless the document is filed either in accordance with Trademark Rule 1.8 or Trademark Rule 1.10. Rule 1.8 provides that papers and fees may be considered timely filed if

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<sup>1</sup> The Office records indicate that on April 17, 1998, Petitioner submitted a fee of \$300 for filing a substitute combined Section 8 and 15 affidavit and a petition to the Commissioner. The Office issued a refund of \$100 by Treasury check. For reasons explained in this decision, the Office will issue an additional refund of \$100 so that the total refund amount is \$200 covering the combined affidavit. The remaining \$100 will be processed as the filing fee for this petition. The petition remains unverified since no supporting affidavit or declaration under 37 C.F.R. § 2.20 has been submitted.

they are deposited with the United States Postal Service prior to the due date, and contain a certificate indicating the correct PTO mailing address and date of deposit, signed by a person with a reasonable basis to expect that the correspondence will be mailed on or before the date indicated. Rule 1.10 provides for the filing of papers and fees by Express Mail.

In this instance, the Section 8 affidavit was executed on September 30, 1997, but was not received in the PTO until October 2, 1997, one day past the due date. Registrant did not use either the Rule 1.8 certificate of mailing or the Rule 1.10 Express Mail mailing procedures. Therefore, the filing date of Petitioner's affidavit is October 2, 1997.

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.*, 925 F.2d 1402, 17 USPQ2d 1795 (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 (Comm'r Pats. 1958).

The legislative history of Section 8 clearly indicates that a specific cut-off time 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.

The petition is denied. The registration will be cancelled in due course. Should Petitioner wish to file a new application for registration of its mark, the Office will, upon request, expedite handling of the application. See TMEP section 1102.03.

Philip G. Hampton, II  
Assistant Commissioner  
For Trademarks

PGH:NLO:HES

Date:

Attorney for Petitioner:

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