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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
OFFICE OF ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 Crystal Drive
Arlington, Virginia 22202-3513

97-246

Re: Trademark Application of :
Rhone-Poulenc Agrochimie :
Serial No. 74/502771 :
Filing Date: March 21, 1994 : On Petition
For: CERGARD :
Petition Filed: June 4, 1997 :

Rhone-Poulenc Agrochimie has petitioned the Commissioner to reverse the denial of a Request for Extension of Time to File a Statement of Use in connection with the above identified application. Trademark Rules 2.89(g) and 2.146(a)(3) provide authority for the requested review. The petition is denied under Trademark Act §1(d)(2), 15 U.S.C. §1051(d)(2).

FACTS

A Notice of Allowance issued for the subject application on April 4, 1995. Pursuant to Section 1(d) of the Trademark Act, a Statement of Use, or Request for an Extension of Time to File a Statement of Use, was required to be filed within six months of the mailing date of the Notice of Allowance.

On October 4, 1995, Petitioner filed its first Request for Extension of Time to File a Statement of Use. The extension request was approved, affording Petitioner the opportunity to file a Statement of Use, or a second Request for an Extension of Time to File a Statement of Use, within twelve months from the mailing date of the Notice of Allowance. Petitioner filed a second extension request on April 1, 1996. [1]

In an Office Action dated July 15, 1996, the Legal Instruments Examiner in the ITU/Divisional Unit denied the extension request because it did not include a verified statement that the applicant has a continued bona fide intention to use the mark in commerce, specifying those goods or services identified in the notice of allowance on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce, as required by Trademark Act Section 1(d)(2), 15 U.S.C. §1051(d)(2), and Trademark Rule 2.89, 37 C.F.R. §2.89. Petitioner was advised that, since the period of time within which to file an acceptable

[1] Petitioner filed a Statement of Use on June 14, 1996. The Statement of Use was considered untimely inasmuch as the second extension request was denied and the time for filing a Statement of Use expired April 4, 1996.

extension request or Statement of Use had expired, the application would be abandoned in due course. [2]

In the petition that followed,[3] Petitioner requests that the Commissioner overrule the denial of the second extension request since it contained a statement that actual use of the mark had commenced but additional time was needed to provide the necessary labeling to accompany the Statement of Use. Petitioner cites *In re Vitamin Beverage Corp.* 37 USPQ2nd 1537 (Comm'r Pats. 1995), in support of its position that the second extension request which contained an allegation of use of the mark exceeded the requirements of a statement of bona fide intent to use, and therefore, should have been granted.

ANALYSIS

Section 1(d)(2) of the Trademark Act, 15 U.S.C. §1051(d)(2), and Trademark Rule 2.89, 37 C.F.R. §2.89, clearly and explicitly require that a Request for Extension of Time to file a Statement of Use include a verified statement that the applicant has a continued bona fide intention to use the mark in commerce, specifying those goods or services on or in connection with which the applicant has a continued bona fide intention to use the mark. However, "the Office will accept as being substantially in compliance with the statutory requirement that an extension request be accompanied by a verified statement that the applicant has a continued bona fide intention to use the mark in commerce[,] the applicant's allegation that ***the mark is in use in commerce*** on or in connection with the goods or services identified in the Notice of Allowance." *In re Vitamin Beverage, supra.* [emphasis added]

Petitioner correctly asserts that the phrase "bona fide intent to use the mark" may be substituted with wording that the mark is in use because actual use surpasses the statutory requirement for a bona fide intent to use. *In re Vitamin Beverage, supra.* However, another essential component of the statutory language required when filing a Request for an Extension of Time to File a Statement of Use under Section 1(d)(2) of the Act is the phrase "in commerce." Regardless of whether an applicant is asserting a bona fide intent to use the mark or alleging that actual use of the mark has commenced, the phrase "in commerce" must be included when filing an extension request. *In re Vitamin Beverage, supra; In re Custom Technologies, Inc.,* 24 USPQ2d 1712 (Comm'r Pats. 1991).

In this instance, Petitioner's second extension request alleging that use of the mark had commenced omitted the phrase "in commerce." Since the statutory language "in commerce" was not contained in the verified statement that use had commenced, the Legal Instruments Examiner properly denied the second extension request.

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[2] A Notice of Abandonment was mailed on August 2, 1996. On August 16, 1996 and March 19, 1997, Petitioner filed documents requesting that the Notice of Abandonment be rescinded. In both letters, Petitioner referenced its July 26, 1996 letter in which Petitioner responded to the denial of the second extension request. However, the Office has no record of the July 26, 1996 document.

[3] The petition, filed June 4, 1997, was inadvertently withdrawn by the Office on January 10, 1998.

DECISION

The petition is denied. The application is abandoned. The $200 fee for filing the Statement of Use will refunded in due course.

Applicant may wish to 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.

Philip G. Hampton, II
Assistant Commissioner
for Trademarks

PGH:NLO:CLB

Date:

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