

Re: Trademark Application of
Sottsu Agency Co., Ltd.
Serial No. 74/551735
Filing Date: July 20, 1994
Mark: GUNDAM
Petition Filed: August 5, 1996

On Petition

Gund, Inc. has petitioned the Commissioner to reverse the decision of the Legal Assistant at the Trademark Trial and Appeal Board denying a Request for Extension of Time to File a Notice of Opposition to the registration of the above referenced mark. The petition is denied under Section 13 of the Trademark Act, 15 U.S.C. §1063.

FACTS

The subject mark published for opposition in the Official Gazette on March 12, 1996. Petitioner filed a first Request for a 60-day Extension of Time to Oppose registration of the mark, which the Trademark Trial and Appeal Board (Board) granted through June 10, 1996. The second 30-day extension request was filed on June 13, 1996, three days late. In error, the Board gave Petitioner until July 10, 1996, to file the third extension request. The third extension request was filed on July 11, 1996. In a letter dated July 19, 1996, the Legal Assistant at the Trademark Trial and Appeal Board denied Petitioner's third extension request filed on July 11, 1996, because it was filed one day after the expiration of the previously granted extension period.

This petition was filed on August 5, 1996.

DECISION

Petitioner requests that the filing of the third extension request be deemed to be in substantial compliance with Section 13 of the Trademark Act, 15 U.S.C. §1063, and Trademark Rule 1.8, 37 C.F.R. §1.8, because it was executed and mailed on July 9, 1996, before the deadline of July 10, 1996. Although Petitioner declares that the papers were mailed as first class mail, no certificate of mailing was included. Since the record indicates that the second extension request was also mailed without a certificate of mailing and was late, this decision will address the timeliness of both the second and third extension requests.

The timely filing of documents in the Patent and Trademark Office requires that they actually be received in the Office within the set period. 37 C.F.R. §1.6. In response to public concern about the uncertainty of mail delivery, the Office has created procedures that applicants can use to ensure timely filing of documents. When mailing a Request for Extension of Time to Oppose to the Office just before the due date, an applicant can use a certificate of mailing under Rule 1.8. However, in order to claim the benefits of Rule 1.8, an applicant must comply with the specific

requirements set forth in the rule. Rule 1.8(a)(1)(ii) requires the correspondence to include a certificate of mailing which states the date of mailing and is signed by a person who has a reasonable basis to expect that the correspondence would be mailed on or before the date indicated. This requirement for a separate certificate of mailing is strictly enforced. Since neither the second or third extension requests were filed with a certificate of mailing, the requirements of Rule 1.8 were not satisfied. Merely executing and mailing an extension request before the deadline is not enough to meet the requirements of Rule 1.8.

Section 13 of the Trademark Act, 15 U.S.C. §1063, provides that a Notice of Opposition may be filed within thirty days after the date of publication of a mark, that upon written request prior to the expiration of the thirty day period, the time for filing an opposition may be extended for an additional thirty days, and that further extensions of time for filing an opposition may be granted by the Commissioner for good cause when requested prior to the expiration of an extension. Here, neither the second or third extension request were file prior to the expiration of a previously granted extension period. Therefore, the requirements of Section 13 were not met.

Since the time for filing an opposition or requesting an extension of time to oppose is a statutory requirement, the Commissioner has no authority to waive the requirement. *In re Kabushiki Kaisha Hitachi Seisakusho*, 33 USPQ2d 1477 (Comm'r Pats. 1994); *In re Cooper*, 209 USPQ 670 (Comm'r Pats. 1980).

The petition is denied. The application file will be returned to the Trademark Trial and Appeal Board and then forwarded for issuance of the registration. Petitioner is not without a remedy. Once the subject mark registers, a petition to cancel, pursuant to 15 U.S.C. §1064, may be filed.

Philip G. Hampton, II
Assistant Commissioner
for Trademarks

PGH:JCL

Date:

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