

Re: Trademark Application of :
 Sherwin Incorporated :
 Serial No. 74/602994 : **On Petition**
 Filing Date: November 25, 1994 :
 For: AQUA-CHEK :
 Petition Filed: September 9, 1996 :

Sherwin Incorporated 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. The petition is denied under Trademark Rules 2.89(g) and 2.146(a).

FACTS

On January 2, 1996, a Notice of Allowance issued for the subject application. Pursuant to Section l(d) of the Trademark Act, Applicant had six months from the mailing date of the Notice of Allowance to file a Statement of Use or a Request for Extension of Time to File a Statement of Use, i.e., on or before July 2, 1996.

On May 17, 1996, Petitioner filed a timely Request for Extension of Time to File a Statement of Use. In an Office Action dated August 14, 1996, the Applications Examiner in the ITU/Divisional Unit denied the extension request since 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 l(d)(2), 15 U.S.C. §1051(d)(2), and Trademark Rule 2.89, 37 C.F.R §2.89.^{1_2} Petitioner was advised that, since the period of time within which to file an acceptable extension request or Statement of Use had expired, the application would be abandoned in due course.

This petition was filed on September 9, 1996.²

DECISION

Section l(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

¹ The extension request was also deficient inasmuch as it was not accompanied by the prescribed fee required by Trademark Rule Section 2.89, 37 C.F.R. Section 2.89.

² Petitioner submitted herewith a substitute first extension request containing the requisite fee and averments and a second extension request. However, the substitute request was filed after the statutory six-month period and will not be considered.

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. Since this is a statutory requirement, it must be satisfied prior to the expiration of the period for filing the Statement of Use. *In re Hoffmann-La Roche Inc.*, 25 USPQ2d 1539, 1541 (Comm'r Pats. 1992); *In re Custom Technologies, Inc.*, 24 USPQ2d 1712 (Comm'r Pats. 1991); TMEP §§1105.05(d)(i) and 1105.05(d)(ii).

Since Petitioner's first extension request, filed May 17, 1996, did not include a verified statement of Applicant's bona fide intent to use the mark in commerce with reference to the intended goods or services, the Applications Examiner properly denied it.

The petition is denied. The application is abandoned. The \$100 filing fees for the substitute first extension request and the second extension request will be refunded in due course.

Philip G. Hampton, II
Assistant Commissioner
for Trademarks

PGH:NLO:CLB

Date:

Attorney for Petitioner:

Robert L. Risley, Esq.
A Professional Law Corporation
790 E. Colorado Blvd., Ninth Floor
Pasadena, CA 91101-2113