

James A. Sebesta  
1040 Sanabel Ct. N.E.  
St. Petersburg, FL 33702

97-291

Re: Trademark Application of :  
Norix Group, Inc., :  
Serial No. 74/695298 :  
Filing Date: June 29, 1995 : On Petition  
For: INCARCEREST :  
Petition Filed: April 10, 1997 :

Norix Group, Inc., has petitioned the Commissioner to revive the above identified application. Trademark Rules 2.89(g) and 2.146(a)(3) provide authority for the requested review.

## FACTS

A Notice of Allowance issued for the subject application on June 11, 1996. 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 November 1, 1996, Petitioner filed a Request for Extension of Time to File a Statement of Use. In an Office Action dated March 20, 1997, the Manager 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. This petition followed.

## DECISION

Section 1(d)(2) of the Act and Trademark Rule 2.89 clearly and explicitly require that the statement of the applicant's continued bona fide intention to use the mark in commerce be verified by the applicant. *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).

Trademark Rules 2.146(a)(5) and 2.148 permit the Commissioner to waive any requirement of the rules, not being a requirement of the statute, in an extraordinary circumstance, when justice requires and no other party is injured. However, the requirement to include a verified statement of applicant's continued bona fide intention to use the mark in commerce with the request to extend time to file a statement of use is statutory and the Commissioner is without authority to wave it.

Accordingly, the petition is denied and the application will remain abandoned. The \$100 submitted for the second extension request will be refunded in due course.

Philip G. Hampton, II  
Assistant Commissioner  
for Trademarks

PGH:NLO:CPS

Date:

Attorney for Petitioner:

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