

Re: Trademark Application of
Avlon Industries, Inc.

Serial No. 74-723200

On Petition

Filing Date: August 31, 1995

For: FIBER GUARD

Petition Filed: September 17, 1996

Nina International, Inc., has petitioned the Commissioner to accept its third request for extension of time to file a notice of opposition with respect to the above-identified application. The petition is denied under Section 13 of the Trademark Act and Trademark Rules 2.102(c) and 2.146.

FACTS

Trademark Application Serial No. 74-723200 published for opposition in the *Official Gazette* on April 16, 1996. On May 15, 1996, Petitioner filed an initial request for extension of time to file an opposition. Petitioner filed a second request for extension of time to oppose on June 11, 1996.

Petitioner's first and second extension requests were granted. The second extension granted Petitioner an extension of time until August 14, 1996 in which to file a Notice of Opposition.

A third request for extension of time to oppose was filed on August 19, 1996, and a fourth extension request was filed on September 13, 1996.

On August 29, 1996, the Trademark Trial and Appeal Board ("Board") issued a letter noting that Petitioner's third request for extension of time to oppose was filed after the expiration of the August 14, 1996 extension period. This petition followed.¹

ANALYSIS

Section 13(a), 15 U.S.C. §1063(a), of the Trademark Act states, in relevant part, that:

Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Commissioner for good cause **when requested prior to the expiration of an extension. . . .**
(emphasis added)

¹ In response to Petitioner's Notice of Opposition, on August 18, 1997 the Board issued a letter informing Petitioner that the Notice of Opposition could not be considered. The file was forwarded to the Finance Branch. On August 20, 1997, the \$200 opposition fee was processed for refund to Petitioner.

Pursuant to Trademark 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 in accordance with Trademark Rules 1.8 or 1.10. 37 C.F.R. §§ 1.6, 1.8, and 1.10. Under Trademark Rule 1.8, with certain specified exceptions, papers and fees are considered filed on time if they are addressed to the “Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513,” deposited with the United States Postal Service at least by the due date, and contain a certificate indicating the 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. 37 C.F.R. §1.8.

Petitioner acknowledges that its third extension request was mailed without a Certificate of Mailing under Rule 1.8. However, Petitioner asserts that the failure to include a Certificate of Mailing was strictly an oversight. Petitioner has also provided an unverified statement, signed by Petitioner’s counsel, stating that the third extension request “was in fact timely mailed to the Assistant Commissioner for Trademarks on August 14, 1996.”

Trademark Rules 2.146(a)(5) and 2.148 permit the Commissioner to waive any provision of the Rules which is not a provision of the statute, where an extraordinary situation exists, justice requires and no other party is injured thereby. Inadvertent omissions on the part of attorneys do not, however, constitute extraordinary situations within the purview of these rules. *In re Sotheby’s Inc.*, 18 USPQ2d 1969 (Comm’r Pats. 1989); *In re Tetrafluor Inc.*, 17 USPQ2d 1160 (Comm’r Pats. 1990); *In re Choay S.A.*, 16 USPQ2d 1461 (Comm’r Pats. 1990); *In re Bird & Son, Inc.*, 195 USPQ 586, 588 (Comm’r Pats. 1977).

More critical is the fact that the time period for filing an opposition or requesting an extension of time to oppose is set by statute. While Trademark Rules 2.146 and 2.148 permit the Commissioner to waive provisions of the Rules, the Commissioner has no authority to waive a requirement of the statute. Since the time period for requesting an extension of time to oppose is prescribed by statute, the Commissioner has no authority to waive this requirement. *In re Kabushiki Kaisha Hitachi Seisakusho*, 33 USPQ2d 1477 (Comm’r Pats. 1994); *In re Cooper*, 209 USPQ 670 (Comm’r Pats. 1980). Therefore, the subject extension request, which was received by the Board after the statutory time period, cannot be accepted on Petition.

DECISION

The petition is denied. The application file will be forwarded to the Intent-to-Use Division for issuance of a new Notice of Allowance.²

² The Office inadvertently issued a Notice of Allowance in this application, dated November 5, 1996. This Notice of Allowance does not appear to have been cancelled. On December 30, 1996, Applicant filed a Statement of Use.

The Intent-to-Use Division is instructed to take the following action. First, the November 5, 1996 Notice of Allowance (NOA), which issued improperly, must be cancelled. Second, Applicant’s \$100 fee for filing the Statement of Use (SOU) must be refunded. This decision will serve as notice to the Applicant of the reasons for cancellation of the original NOA and return of the \$100 SOU filing fee. Finally, the Office must issue a new Notice of Allowance.

Philip G. Hampton, II
Assistant Commissioner
for Trademarks

PGH:EKM

Date:

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