

Re: Trademark Application of :
 Griffin Corporation :
 Serial No. 74/723489 :
 Filing Date: August 30, 1995 : On Petition
 For: INFERNO :
 Petition Filed: May 14, 1998 :

Griffin Corporation 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.

FACTS

A Notice of Allowance issued for the subject application on August 27, 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.

Petitioner filed two Requests for Extension of Time to File a Statement of Use. The extension requests were approved, affording Petitioner the opportunity to file a Statement of Use, or a third Request for an Extension of Time to File a Statement of Use, within eighteen months from the mailing date of the Notice of Allowance.

Petitioner filed a third extension request on February 27, 1998. This request did not include the phrase "bona fide intention to use the mark in commerce." The statement was limited to the following: "Applicant has not yet used the mark in commerce on or in connection with all goods or services specified in the Notice of Allowance. However, applicant has made the following ongoing efforts to use the mark in commerce on or in connection with each of the goods or services specified above: Applicant is ready to begin production on the goods. However, applicant is waiting on governmental approval of the goods."

In an Office Action dated April 14, 1998, 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 extension request or Statement of Use had expired, the application would be abandoned in due course.

Petitioner contends that it is clear from reading the entire extension request that Applicant had the requisite bona fide intent to use the mark.

DECISION

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. 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).

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. However, the Commissioner has no authority to waive a requirement of the statute.

Accordingly, the Petition is denied. The application will remain abandoned.

Philip G. Hampton, II
Assistant Commissioner
for Trademarks

PGH:NLO:RJD

Date:

Attorney for Petitioner:

Robert E. Richards, Esq.
Jones & Askew
37th Floor
191 Peachtree Street, N.E.
Atlanta, GA 30303-1769