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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
OFFICE OF ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 Crystal Drive
Arlington, Virginia 22202-3513

98-645

Re: Trademark Application of :
Mas-Hamilton Group, Inc. :
Serial No. 75/050601 :
Filing Date: January 29, 1996 : On Petition
For: SUPER SHELVES :
Petition Filed: September 15, 1998 :

Mas-Hamilton Group, Inc. 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. 37 C.F.R. §§2.89(g) and 2.146(a)(3) provide authority for the requested review. The petition is denied.

FACTS

A Notice of Allowance issued for the subject application on August 5, 1997. 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 February 4, 1998, Petitioner filed its first Request for Extension of Time to File a Statement of Use. The extension request was approved, affording Petitioner the opportunity to file a Statement of Use, or a second Request for an Extension of Time to File a Statement of Use, within twelve months from the mailing date of the Notice of Allowance.

On July 31, 1998, Petitioner filed a second Request for Extension of Time to File a Statement of Use. 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 used the mark in commerce yet on all goods specified in the Notice of Allowance; however, Applicant is in the process of developing labels and other materials in anticipation of using the mark in commerce on or in connection with those goods identified in the Notice of Allowance."

In an Office Action dated August 19, 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 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. This petition followed.

Petitioner contends that a reasonable reading of the extension request makes clear that such a bona fide intention to use the mark in commerce exists and was declared.

ANALYSIS

Statement of Bona Fide Intent to Use the Mark and Statement of Good Cause are Separate Requirements

Section 1(d)(2) of the Trademark Act, 15 U.S.C. §1051(d)(2), provides in pertinent part:

The Commissioner shall extend, for one additional 6-month period, the time for filing the statement of use under paragraph (1), upon written request of the applicant before the expiration of the 6-month period provided in paragraph (1). In addition to an extension under the preceding sentence, the Commissioner may, **upon a showing of good cause by the applicant**, further extend the time for filing the statement of use under paragraph (1) for periods aggregating not more than 24 months . . . **Any request for an extension under this paragraph shall be accompanied by a verified statement that the applicant has a continued bona fide intention to use the mark in commerce** and 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.

Thus, the statute requires that second and subsequent extension requests include **both**: a showing of good cause and a verified statement of bona fide intent to use the mark. Trademark Rule 2.89(d)(2) sets forth the guidelines for what constitutes good cause and explains the nature of "good cause," as follows:

The [good cause] showing required by paragraph (b)(4) of this section must include:

(2) A **statement of applicant's ongoing efforts to make use of the mark in commerce on or in connection with each of the goods or services** specified in the verified statement of continued bona fide intention to use required under paragraph (b) of this section. Those efforts may include, without limitation, product or service research or development, market research, manufacturing

activities, promotional activities, steps to acquire distributors, steps to obtain required governmental approval, or other similar activities. (emphasis added).

In view of Trademark Rule 2.89 governing what constitutes a showing of good cause, the statement made by Petitioner in its second extension request, with respect to its “ongoing efforts” to use the mark in commerce with an explanation of those efforts, merely satisfies the requirement that Petitioner submit a showing of good cause with its extension request. *See generally In re Comdial Corp.*, 32 USPQ2d 1863 (Comm'r Pats. 1993)(A mere statement that applicant is engaged in ongoing efforts to use the mark does not satisfy a showing of good cause; *those efforts must be specified.*)

Neither the statute nor the rule contemplates that the statement of good cause and the statement of bona fide intent be one in the same. To hold that a statement of good cause satisfies the requirement that an applicant has a continued bona fide intent to use the mark or that a statement of bona fide intent to use the mark satisfies the requirement for a showing of good cause would nullify the requirement that both statements be present. 15 U.S.C. §1051(b); 37 C.F.R 2.89. Thus, while the second extension request contained a showing of good cause, it did not include a separate statement of bona fide intent to use the mark in commerce. 15 U.S.C. §1051(b)(2).¹

Ongoing Efforts to Use the Mark Cannot be Construed as a Statement of Bona Fide Intent to Use the Mark

Even if the requirements for a statement of good cause and for a statement of bona fide intent to use the mark were not two separate requirements of the statute, Petitioner’s statement of “ongoing efforts to use the mark in commerce” in conjunction with an explanation of those efforts cannot be construed as a statement of bona fide intention to use the mark.

DECISION

In *In re Vitamin Beverage Corp.*, 37 USPQ2d 1537 (Comm’r Pats. 1995), the Commissioner held that the statute does not require that an extension request use the *specific words* “bona fide intent to use the mark in commerce”. However, the statute and the rules clearly require a statement that applicant has a *bona fide intention* to use its mark. *Id.* at 1538. In *In re Vitamin Beverage*, *bona fide intent* to use the mark in commerce was found because, among other things, “Use in Commerce” is defined under the Act as the *bona fide use* of a mark in the ordinary course of trade. 15 U.S.C. §1127 (emphasis added). Thus, the statutory requirement was met. However, nothing in the statements made by Petitioner in its second extension request verifies that Petitioner has a continued *bona fide intention* to use the mark.

¹Even though a statement of good cause can be submitted on Petition after the expiration of the statutory filing period for a Statement of Use, *In re El Taurino Restaurant, Inc.*, 41 USPQ2d 1220 (Comm’r Pats. 1996), for the reasons stated below, the statement of “ongoing efforts to use the mark in commerce” cannot be construed as Petitioner’s statement of “bona fide intent to use the mark in commerce.”

The Commissioner cannot presume merely from the wording used by Petitioner that Petitioner has the requisite “bona fide intent”. Asserting ongoing efforts to use the mark in commerce in conjunction with an explanation of those efforts does not satisfy the statutory requirement. In as much as the requirement to set forth a statement of continued *bona fide intention* to use the mark is statutory, the Commissioner has no authority to waive it. *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).

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

Robert M. Anderson
Deputy Assistant Commissioner
for Trademarks

RMA:NLO:RJD

Date:

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