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Re: Petition to Revive Application Serial No. 74/608453  
Applicant: Aegon USA, Inc.  
For: S.I.D. SUPPLEMENTAL INSURANCE DIVISION and design

Dear Mr. Ehrlich:

This will acknowledge receipt of the petition to revive the above-referenced application, filed September 11, 1996.

Decision: Petition to Revive is DENIED.

## **FACTS**

The application was abandoned for failure to respond to an Office Action dated December 7, 1995 within 6 months of the mailing date. Counsel, Clifford Schoenberg, declares for the Applicant that the failure to respond to the Office Action within the statutory time period was attributed to the transfer of trademark files handled by a group of patent and trademark practitioners that moved from Rosenman & Colin, the previous correspondent law firm of record, to Graham & James. The failure to respond to the Office Action was also attributed to the sudden death of Mark Sparrow, the attorney of record, "who was at all times the only person responsible for this application."

Counsel declares that after the departure of this group of patent and trademark practitioners, all trademark matters and their files were transferred to the departing group. Counsel received assurances from Mark Sparrow that all trademark matters were taken care of. However, upon Mark Sparrow's sudden and unexpected death, the firm's file for the referenced application could not be located. In the absence of the file, it was impossible to tell whether a response was filed. The Office has no record of a timely response having been filed in connection with the referenced application.

## **ANALYSIS**

In any petition to revive an abandoned application, the applicant must show that the delay in responding was unavoidable. 37 C.F.R. §2.66. The term "unavoidable" means that reasonable steps had been taken, or precautionary systems were in operation which were designed to avoid the circumstances which caused the delay, but the delay occurred despite these precautions. If there were reasonable precautions that could have been taken to anticipate and avoid the delay, and those precautions were not taken, then the delay is considered avoidable and the petition to

revive the application will not be granted. TMEP §§1112.05(b) and 1112.05(b)(i). Delays due to circumstances that could have been avoided with the exercise of care and attention are not considered unavoidable delays.

1. *Transfer of the Trademark Files from Rosenman & Colin to Graham & James*

Misplacement of a file during an office move is not considered unavoidable. The deadline for filing a response to an Office Action is known six months in advance, and applicants are responsible for keeping adequate records and making proper allocations of time to meet the deadline. While the transfer of files from one address to another may cause some logistical problems, it is reasonable to expect that appropriate precautions will be taken to avoid misplacement of time sensitive documents so that legal deadlines can be met. TMEP §1112.05(b)(v).

In this case, there is no evidence that any steps were taken to avoid misplacement of files during the move of Applicant's corporate offices. In fact, there is no evidence of record of any docketing procedures being in place to avoid misplacement of time sensitive documents. Therefore, the delay is not considered unavoidable.

2. *Death of Attorney Mark Sparrow*

Death of an attorney does not alone justify delay; there can be immediate inspection of docket records or of actual files to determine response dates and to plan appropriate ways to meet them. TMEP §1112.05(b)(v). The fact that no evidence of a sound and reliable docketing procedure was in place to keep track of all pending trademark files led to the inability of the firm to inspect immediately this application file. This fact is not justified by the attorney's sudden and unexpected death.

Applicant may wish to consider filing a new application. The Office will not hold the denial of this petition to be prejudicial to the Applicant in the filing of a new application. Currently, the application filing fee is \$245.00 per class.

Sincerely,

Sarah Lee Chung  
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Office of the Assistant Commissioner  
for Trademarks  
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