Commissioner of Patents and Trademarks
Patent and Trademark Office (P.T.O.)

RE: TRADEMARK APPLICATION OF SOVRAN FINANCIAL CORPORATION
Serial No. 74-026060
July 29, 1991
***1** Petition Filed: July 31, 1990 [FN1]

For: SOVRAN TELEPHONE CONNECTION
Filing Date: February 6, 1990

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On Petition

Sovran Financial Corporation has petitioned the Commissioner pursuant to Trademark Rule 2.146 to reconsider the refusal to accept its Amendment to Allege Use, filed pursuant to Section 1(c) of the Trademark Act.

Petitioner filed the above-identified application on February 6, 1990, pursuant to Section 1(b) of the Trademark Act. Thereafter, on May 1, 1990, counsel for the petitioner and the examining attorney entered into an Examiner's Amendment regarding a disclaimer of the terminology TELEPHONE CONNECTION and specifying the date the application declaration was signed. The application was then approved for publication on the Principal Register on May 29, 1990.

In its unverified petition [FN2], Petitioner states that it filed an amendment to allege use on July 9, 1990 which was rejected as untimely on July 26, 1990. This petition followed. [FN3]

Trademark Rule 2.76(a), 37 C.F.R. Section 2.76(a), specifies the appropriate time period for filing an amendment to allege use in connection with an intent-to-use application. That Rule states in pertinent part:

> [An amendment to allege use may be filed] at any time between the filing of the application and the date the examiner approves the mark for publication or the date of expiration of the six-month response period after issuance of a final action. Thereafter, an allegation of use may be submitted only as a statement of use.... If an amendment to allege use is filed outside the time period specified in this paragraph, it will be returned to the applicant. (emphasis added)

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. All three conditions must be satisfied before a waiver is granted. This is not such a situation.

In order for applications filed under Section 1(b) to be properly handled by the Office, it is necessary that there be some period of time during which no additional filings or amendments will be accepted. This is necessary in order to assure that these applications are published in the Official Gazette with the appropriate information and that there are not undue delays in sending these files to publication. Moreover, if the status of these applications is not carefully monitored it would be difficult, if not impossible, to determine whether a Notice of Allowance or a Certificate of Registration should issue following survival of the opposition period.

***2** Petitioner argues that Patent Rule 1.2, as made applicable to trademark cases through Trademark Rule 2.1, requiring all business with the Patent and Trademark Office to be in writing applies to examining attorneys as well as Applicants. Therefore, since the applicant was not informed, in writing, that the mark was approved for publication on May 29, 1990, Petitioner asserts that it should not have been prevented from filing its amendment to allege use after that date. Such an argument is specious. Rule 1.2 does not require all actions taken by the examining attorney to be in writing. In fact, examining attorneys are encouraged to conduct telephone or in-person interviews, where such action would be helpful and expeditious. See, TMEP sections 1107.04 and 1111.01.

Additionally, Petitioner had access to the information necessary to determine when it could properly and timely file its amendment to allege use. Beginning on February 20, 1990, the Patent and Trademark Office provided telephone access to current status and status date information for all federal trademark applications and registration records maintained in the Office's automated system. Notice of the availability or the Trademark Status Line was published in the March 27, 1990 Official Gazette. 1112 TMOG 49.

If the call to the Trademark Status Line does not suggest the onset of the "blackout period" [FN4], then the amendment to allege use may be filed. Although it is always possible that the mark could be approved for publication on the same day, but shortly after, the applicant has checked the Trademark Status Line, Office policy holds that the blackout period does not begin until the day after a mark is approved for publication. Therefore, an intent to use applicant who wishes to file an amendment to allege use can always beat the onset of the blackout period if (1) a call to the Trademark Status Line reveals that the application has not entered the blackout period, and (2) the amendment to allege use is filed the same day by U.S. Postal Service Express Mail in accordance with Rule 1.10, 37 C.F.R. Section 1.10. Even if the examining attorney approves the application for publication the same day that the amendment to allege use is mailed in accordance with Rule 1.10, the amendment to allege use will be deemed to be timely filed. See, July 23, 1991 Official Gazette, 1128 TMOG 56.

Rule 2.76(a) makes it clear that there is a period of time during which amendments to allege use will not be considered to be timely

filed and will be returned to the applicant. Knowing this and, in the instant situation, knowing that an Examiner's Amendment resolving all outstanding issues had already been entered into, the petitioner had the responsibility of monitoring the status of its application if it intended to timely file an amendment to allege use.

***3** It has previously been determined that inadvertent omissions and/or oversights that could have been prevented by the exercise of ordinary care or diligence do not constitute extraordinary situations within the purview of Trademark Rules 2.146(a)(5) and 2.148. In re Bird & Son, Inc., 195 USPQ 586 (Comm'r Pats. 1977).

Accordingly, the petition is denied. The application will be returned to the Publication and Issue Section for issuance of the Notice of Allowance.

FN1. The petition was perfected by payment of the fee required under Trademark Rule 2.6(k) on September 18, 1990.

FN2. Rule 2.146(c) requires that facts to be proved in ex parte cases be in the form of affidavits or declarations in accordance with § 2.20.

FN3. A notice of publication under 12(a) subsequently issued by the Office on August 25, 1990 stating that the mark would be published in the Official Gazette on September 25, 1990.

FN4. The common terminology used to describe that period of time, during the prosecution of an intent to use application, when neither an amendment to allege use nor a statement of use can be filed.

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