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

RE: TRADEMARK REGISTRATION OF SOTHEBY'S, INC.
89-182
October 24, 1989
***1** Petition Filed: August 3, 1989

For: COLLECTORS' CARROUSEL
Registration No. 1,199,538
Registered: June 29, 1982

Attorney for Petitioner

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Assistant Commissioner for Trademarks

On Petition

Sotheby's, Inc. has petitioned the Commissioner to allow late acceptance of its response to an Office action issued in connection with a combined declaration under Sections 8 and 15 of the Trademark Act. Trademark Rules 2.146(a)(3), 2.146(a)(5) and 2.148 provide appropriate authority for the requested review.

The above-identified registration issued on June 29, 1982. Pursuant to Section 8 of the Trademark Act, 15 U.S.C. § 1058, registrant was required to file an affidavit or declaration of continued use or excusable nonuse between the fifth and sixth year after the registration date, i.e., between June 29, 1987 and June 29, 1988.

On May 16, 1988, petitioner, through its attorney of record, filed a combined declaration pursuant to Sections 8 and 15 of the Trademark Act. In an Office action dated November 8, 1988, the Affidavit-Renewal Examiner, inter alia, notified petitioner that Office records showed title to the registration in the original registrant, Sotheby Parke Bernet Inc., rather than in Sotheby's, Inc. Acceptance of the declaration was withheld pending receipt of evidence showing ownership in the present claimant such as recordation of an assignment, merger or change of name with the Assignment Branch of the Patent and Trademark Office. Petitioner was advised that in the absence of a proper response filed within six months of the mailing date of the action, a cancellation order would be issued. Petitioner was further advised that the filing of a document in the Assignment Branch would not stay the six month period for responding to the action.

Petitioner failed to file a timely response by the due date of May 8, 1989. On July 19, 1989, the Affidavit-Renewal Examiner notified

petitioner that the registration was being forwarded for cancellation. Petitioner was advised that if it had in fact responded to the action dated November 8, 1988, evidence of such response should be submitted within 30 days of the mailing date, with a petition to the Commissioner, to prevent cancellation.

This petition was filed August 3, 1989. Accompanying the petition is the affidavit of Diana Villarnovo Lopez, Vice-President and Associate General Counsel of petitioner. Ms. Villarnovo asserts that petitioner was represented by [another attorney] on November 8, 1988; that she was never advised by the prior attorney that an official action issued on November 8, 1988 requiring that a chain of title from Sotheby Parke Bernet Inc. to Sotheby's, Inc. be filed in the Patent and Trademark Office in connection with the subject registration; that she recently retained a new attorney to handle all trademark work for petitioner; and that she was first advised on July 28, 1989, after receipt of the Office letter dated July 19, 1989, that an official action had issued on November 8, 1988. A substitute power of attorney was submitted with the petition. Evidence that the necessary chain of title documents had been recorded with the Assignment Branch on March 9, 1989, was also submitted.

***2** Petitioner contends that the late-filed response should be accepted because the original declaration was timely filed; the original declarant was in fact the owner of the registration; petitioner filed for recordation of the chain of title for the above registration prior to the May 8, 1989 deadline; the petition was filed very soon after petitioner obtained knowledge of the May 8, 1989 deadline; petitioner never had any intention to abandon the registration; and substantial prejudice will occur if the registration is cancelled.

Section 8(a) of the Trademark Act and Trademark Rule 2.161 provide that a registration shall be cancelled unless the registrant files an affidavit or declaration of continued use or excusable nonuse between the fifth and sixth year after the registration date. Trademark Rule 2.165(a)(1) provides, in part:

> If the affidavit or declaration ... is insufficient or defective, the affidavit or declaration will be refused and the registrant will be notified of the reason. Reconsideration of such refusal may be requested within six months from the date of the mailing of the action.

While the Trademark Act requires an affidavit or declaration to be filed within the sixth year following registration, a defect which is not a requirement of the statute may be corrected within the six months following the mailing date of the action. The rules do not provide for any extensions of time beyond that. Petitioner herein did comply with the statutory time set for filing the combined declaration, but failed to respond to the Office action within the six month response period set forth in Trademark Rule 2.165(a)(1). The filing for recordation of assignment documents with the Assignment Division on March 9, 1989, did not constitute a response to the Office action of November 8, 1988, nor did such filing stay the time for responding to the Office action.

Trademark Rule 2.146(a)(3) permits the Commissioner to invoke supervisory authority in appropriate circumstances. Trademark Rules 2.161 and 2.162(a) require that the registrant execute and file the

affidavit or declaration within the sixth year. Trademark Rule 2.186 permits an assignee to take any required action in relation to a registration "provided that the assignment has been recorded." Since the records of the Assignment Branch of this Office did not show title to the registration in petitioner, the Affidavit-Renewal Examiner acted correctly in refusing to accept the original declaration absent evidence showing ownership in petitioner.

Pursuant to Trademark Rules 2.146(a)(5) and 2.148, the Commissioner may waive any rule which is not a requirement 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.

While the Commissioner sympathizes with petitioner, the circumstances described herein do not justify a waiver of Trademark Rule 2.165(a)(1). The failure of a party's attorney to take a required action or to notify the party of its rights does not create an extraordinary situation, as contemplated by Trademark Rules 2.146(a)(5) and 2.148. The neglect of a party's attorney is imputed to that party and the party is bound by the consequences. See Herman Rosenberg and Parker-Kalon Corp. v. Carr Fastener Co., 10 USPQ 106 (2d Cir.1931); Williams v. The Five Platters, Inc., 184 USPQ 744 (C.C.P.A.1975); The Coach House Restaurant, Inc. v. The Coach and Six Restaurants, Inc., 223 USPQ 176 (TTAB 1984); In re Reck, 227 USPQ 488 (Comm'r Pats.1985).

***3** Accordingly, the petition is denied. The registration will be forwarded to the Post Registration Division to be cancelled in due course.

Should petitioner wish to file a new application for registration of its mark, the Office will, upon request, expedite handling of the application. See: Trademark Manual of Examining Procedure, § 1102.03.

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