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

RE: TRADEMARK APPLICATION OF SASSON LICENSING CORPORATION
Serial No. 74/423,468
October 11, 1994
***1** Filing Date: August 12, 1993

For: OO LA LA
Petition Filed: October 11, 1994

Philip G. Hampton, II

Assistant Commissioner for Trademarks

On Petition

Parfums Loris Azzaro, S.A. has petitioned the Commissioner to direct the Trademark Trial and Appeal Board to accept a Request for an Extension of Time to Oppose. Trademark Rule 2.146(a)(3) provides authority for the requested review.

FACTS

The above mark published in the Official Gazette on January 18, 1994. On February 14, 1994, with a Certificate of Mailing dated February 10, 1994, Petitioner filed a thirty-day first Request for an Extension of Time to File a Notice of Opposition which was granted by the Trademark Trial and Appeal Board (the Board), extending Petitioner's time to file a Notice of Opposition through March 19, 1994. [FN1]

On August 24, 1994, Counsel for Petitioner submitted, by facsimile transmission, a declaration to the Board that a second thirty-day Request for an Extension of Time, utilizing a Certificate of Mailing under Rule 1.8, had been mailed on March 21, 1994. Accompanying the declaration was a photocopy of the Extension Request and Certificate of Mailing reconstructed from Counsel's word processor. Counsel explained that his firm retains such papers in their computer.

In an undated letter, the Applications Examiner at the Board refused acceptance of the faxed second Extension Request because "potential opposer has not shown proof that the original [second] extension of time was timely filed." [FN2] This Petition followed. No executed copy of the second Extension Request was submitted with the Petition, and Counsel declares that "[h]ard copies were not maintained." According to Counsel's computer records, the second Extension Request was generated and saved on March 21, 1994. A reply brief was submitted by the Applicant on October 17, 1994.

DECISION

1. Did the Board Commit Clear Error in Refusing to Accept the Second Extension Request?

The first issue presented is whether the Board's denial of the second Extension Request was either an abuse of discretion or a clear error that would justify the Commissioner to invoke his supervisory authority pursuant to Trademark Rule 2.146(a)(3). The Commissioner will reverse the action of an Applications Examiner only where there has been a clear error or abuse of discretion. No clear error or abuse of discretion has occurred in the instant case.

The timely filing of documents in the Patent and Trademark Office requires that they actually be received in the Office within the set period. 37 C.F.R. § 1.6. In response to public concern about the uncertainty of mail delivery, the Office has created procedures that Applicants can use to ensure timely filing of documents. When mailing a document to the Office just before the due date, an applicant can take precautions such as including a return receipt postcard, or using a certificate of mailing under 37 C.F.R. § 1.8.

***2** Under Trademark Rule 1.8, 37 C.F.R. § 1.8, subject to certain specified exceptions, papers are considered timely filed as of the date of deposit with the U.S. Postal Service if they are properly addressed, deposited with the U.S. Postal Service as first class mail prior to the expiration of the set period, and include a Certificate of Mailing by first class mail on or before the deadline. However, an exact copy of the disputed document, with an executed Certificate of Mailing thereon, is the only evidence that is accepted by the Office to prove its deposit.

In the present case, Petitioner submitted no physical evidence to show that the second Request for an Extension of Time to File a Notice of Opposition had been received in the Office within the statutory time period, and thus the Applications Examiner properly refused to accept the unexecuted computer- generated facsimile copy submitted on August 24, 1994.

2. Can Trademark Rule 1.8 Be Waived?

The second issue presented is whether the requirements of Trademark Rule 1.8(a) can be waived to permit the Office to accept Petitioner's second Request for an Extension of Time to File a Notice of Opposition. Trademark Rules 2.146(a)(5) and 2.148 permit the Commissioner, in certain circumstances, to waive any provision of the Rules which is not a provision of the statute.

Section 13 of the Trademark Act, 15 U.S.C. § 1063, provides that a party who believes he would be damaged by the registration of a mark may file a notice of opposition within thirty days after the date of publication of the mark. Thus, the time period for filing an Opposition or requesting an Extension of Time to Oppose is a statutory requirement that the Commissioner is without authority to waive. In re Kabushiki Kaisha Hitachi Seisakusho, 33 U.S.P.Q.2d 1477 (Comm'r Pats. 1994); In re Cooper, 209 USPQ 670 (Comm'r Pats. 1980).

In the present case, the Commissioner cannot waive Rule 1.8, since to do so would effectivly waive Section 13 of the Trademark Act. In

addition, the fact that Counsel's firm did not retain executed hard copies of documents filed with this Office, and cannot prove that the document was timely filed, is not an extraordinary circumstance justifying a waiver of Rule 1.8.

Accordingly, the Petition is denied. The application will be returned to the Trademark Trial and Appeal Board for processing and then forwarded for issuance of the registration. Petitioner is not without a remedy. Once the subject mark registers, it is free to file a petition to cancel, pursuant to 15 U.S.C. § 1064.

FN1. March 19, 1994, fell on a Saturday and, according to Trademark Rule 1.7, the next Extension Request would have been due "on the next succeeding day which is not a Saturday, Sunday, or a Federal holiday." In this case, the second Extension Request would thus have been due on Monday, March 21, 1994.

FN2. The Applications Examiner also stated that she was responding to a "request for reconsideration." Since no other refusal letter appears in the file, it is assumed that this is in reference to a previous telephone conversation between the Applications Examiner and Petitioner's Counsel on August 24, 1994. No written memorandum of such a telephone conversation appears in the file, nor is there a declaration from Petitioner's Counsel about such a conversation.

35 U.S.P.Q.2d 1510

END OF DOCUMENT