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

RE: TRADEMARK APPLICATION OF MERCK & CO., INC.
Serial No. 74/057,873
April 27, 1992
***1** Filing Date: May 10, 1990

For: CALCIDE
Petition Filed: November 29, 1991

Attorney for Petitioner

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Attorney for Applicant

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Meck & Company, Inc.

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Assistant Commissioner for Trademarks

On Petition

Alcide Corporation has petitioned the Commissioner to order that its Notice of Opposition to the registration of the above identified mark be considered timely filed, and that the Opposition commence forthwith. Trademark Rules 2.146(a)(3), 2.146(a)(5) and 2.148 provide authority for the requested review.

The subject application was filed on May 10, 1990, by Merck & Co., Inc., pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on a bona fide intention to use the mark in commerce. The application was published for opposition on August 13, 1991. Pursuant to Section 13 of the Act, an opposition, or request to extend time to oppose, was required to be filed within thirty days of the date of publication, in this case, September 12, 1991.

Another application, Serial No. 74/061,106, filed by Glo-Tex Chemicals, Inc., for the mark REACTIREZ, was also published for opposition on August 13, 1991. Serial Nos. 74/057,873 and 74/061,106 appeared on the same page of the Official Gazette.

On September 16, 1991, petitioner filed a request for extension of time to oppose, under a certificate of mailing dated September 11, 1991. In the extension request, the name of the applicant was set forth

as "Glo-Tex Chemicals, Inc.," and the application was identified as Serial No. 74/061,106. On the second page of the extension request, the mark which was the subject of the extension request was identified as "CALCIDE." The request for extension of time to oppose application Serial No. 74/061,106 was granted through October 12, 1991.

When no notice of opposition or request for extension of time to oppose was timely filed in connection with application Serial No. 74/057,873, a Notice of Allowance was issued on November 5, 1991.

In an unverified statement, [FN1] petitioner asserts that it intended to file a request for extension of time to oppose application Serial No. 74/057,873; that, due to a clerical error, it misidentified the applicant and the serial number of the application it wished to oppose; that this clerical error was not discovered until petitioner filed its Notice of Opposition, at which time it corrected the error; that it filed a Notice of Opposition against Serial No. 74/057,873 on October 8, 1991; that an employee of the Trademark Trial and Appeal Board telephoned petitioner's counsel on October 23, 1991 to ask why it had filed a Notice of Opposition against a mark that had published almost two months earlier; that he sent a facsimile copy of the extension request to the Board on October 23, 1991, and was advised by an employee of the Board that the opposition would be instituted; [FN2] and that on November 1, 1991, counsel received another call from an employee of the Board, advising him that the Notice of Opposition would not be considered effective. Petitioner contends that notwithstanding its misidentification of the name of the applicant and the serial number of the application it wished to oppose; it fully complied with all the requirements of Section 13 of the Act and Rule 2.102.

***2** The Commissioner will exercise supervisory authority under Trademark Rule 2.146(a)(3) to vacate an action of the Trademark Trial and Appeal Board only where the Board has committed a clear error or abuse of discretion. In re Societe Des Produits Nestle S.A., 17 U.S.P.Q.2d 1093 (Comm'r Pats.1990); Riko Enterprises, Inc. v. Lindsley, 198 USPQ 480 (Comm'r Pats. 1977).

Trademark Rule 1.5(c), 37 C.F.R. § 1.5(c), requires that any letter or communication relating to a trademark application identify the mark by the name of the applicant and by the serial number and filing date of the application.

In view of petitioner's failure to identify the applicant or the serial number of the application for which it sought an extension of time to oppose, it can hardly be said the Board erred or abused its discretion in refusing to accept the extension request filed September 16, 1991 as having been properly filed in connection with application Serial No. 74/057,873. Petitioner's "misidentification" is more than a minor typographical error. Petitioner identified a live application by serial number, name of applicant and date of publication, and caused an extension of time to file an opposition to be granted against said application.

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. However, the circumstances presented

here do not justify a waiver of Rule 1.5(c). Inadvertent errors and omissions that could have been prevented by the exercise of ordinary care are not extraordinary situations, as contemplated by the Trademark Rules. In re Tetrafluor Inc., 17 U.S.P.Q.2d 1160 (Comm'r Pats.1990); In re Choay S.A., 16 U.S.P.Q.2d 1461 (Comm'r Pats.1990); In re Bird & Son, Inc., 195 USPQ 586 (Comm'r Pats.1977).

Since the Notice of Opposition filed October 8, 1991 was not filed within 30 days of the date the mark was published, or within a previously granted extension period, it was not timely filed, and is not in compliance with the statute. In re Cooper, 209 USPQ 670 (Comm'r Pats.1980).

The petition is denied. The application will be forwarded to the Intent to Use Unit to await filing of a Statement of Use.

FN1. Trademark Rule 2.146(c) requires that when facts are to be proved in a petition, proof in the form of affidavits or declarations in accordance with § 2.20 shall accompany the petition.

FN2. Rule 1.2 of the Rules of Practice in Patent Cases, which is made applicable to trademark cases under Trademark Rule 2.1, indicates that "[t]he action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt."

24 U.S.P.Q.2d 1317

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