

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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June 18, 2019

Cancellation No. 92066846

*Provide Commerce, Inc.*

*v.*

*Natural Pack, Inc.*

**Elizabeth Dunn, Administrative Trademark Judge:**

In its May 13, 2019 response to the Board's show cause order, Respondent explains that it was a mistake to permit Registration No. 4204425 to be cancelled under Section 8 of the Trademark Act, and not an attempt to avoid judgment. Accordingly, the Board will not enter judgment against Respondent.

Registration No. 4204425 must remain cancelled. The Board notes Respondent's request "to file the Section 8 affidavit to maintain its registration", but the deadline for the filing is set by statute.<sup>1</sup> Trademark Act Section 8 (a) ("[T]he registration of

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<sup>1</sup> See *Checkers Drive-In Rests., Inc. v. Comm'r of Patents & Trademarks*, 51 F.3d 1078, 1085, 34 USPQ2d 1574, 1581 (D.C. App. 1995), cert. denied 516 U.S. 866 (1995) ("[I]n establishing cancellation as the penalty for failure to file the required affidavit, Congress made no exception for the innocent or the negligent. Thus, the Commissioner had no discretion to do other than cancel Checkers's service mark registration in this case."); *In re Mother Tucker's Food Experience (Can.) Inc.*, 925 F.2d 1402, 1405, 17 USPQ2d 1795, 1798 (Fed. Cir. 1991) ("It was not within the Commissioner's discretionary authority to waive this requirement."); cf. *In re Holland Am. Wafer Co.*, 737 F.2d 1015, 1018, 222 USPQ 273, 275 (Fed. Cir. 1984) ("Timeliness set by statute is not a minor technical defect which can be waived by the Commissioner."); Trademark Manual of Examining Procedure § 1604 (2019) ("TMEP").

any mark shall be canceled by the Director unless the owner of the registration files in the United States Patent and Trademark Office affidavits that meet the requirements of subsection (b), within the following time periods: Within the 1-year period immediately preceding the expiration of 6 years following the date of registration under this Act or the date of the publication under section 12(c) [or] The owner may file the affidavit required under this section within the 6-month grace period immediately following the expiration of the periods established in paragraphs (1) and (2), together with the fee described in subsection (b) and the additional grace period surcharge prescribed by the Director.”).

In view thereof, Petitioner is now allowed until **twenty days from the date of this order** to apprise the Board whether petitioner wishes to go forward with the cancellation proceeding, or to have the cancellation proceeding dismissed without prejudice as moot. *See Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154, 1156 (TTAB 1989); and Trademark Trial and Appeal Board Manual of Procedure § 602.02(b).

If Petitioner fails to respond, the Board may dismiss the proceeding without prejudice as moot.