

PART 1—RULES OF PRACTICE IN PATENT CASES

EDITORIAL NOTE: Part 1 is placed in the separate grouping of parts pertaining to patents regulations.

TRADEMARKS

PART 2—RULES OF PRACTICE IN TRADEMARK CASES

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AUTHORITY: 15 U.S.C. 1113, 15 U.S.C. 1123, 35 U.S.C. 2, Section 10(c) of Pub. L. 112-29, unless otherwise noted.

SOURCE: 30 FR 13193, Oct. 16, 1965, unless otherwise noted.

EDITORIAL NOTE: Nomenclature changes to part 2 appear at 68 FR 14337, Mar. 25, 2003.

§ 2.1 [Reserved]

§ 2.2 Definitions.

(a) *The Act* as used in this part means the Trademark Act of 1946, 60 Stat. 427, as amended, codified in 15 U.S.C. 1051 *et seq.*

(b) *Entity* as used in this part includes both natural and juristic persons.

(c) *Director* as used in this chapter, except for part 11, means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

(d) *Federal holiday within the District of Columbia* means any day, except Saturdays and Sundays, when the United States Patent and Trademark Office is officially closed for business for the entire day.

(e) The term *Office* means the United States Patent and Trademark Office.

(f) The acronym *TEAS* means the Trademark Electronic Application System, available at <http://www.uspto.gov>.

(g) The acronym *ESTTA* means the Electronic System for Trademark Trials and Appeals, available at www.uspto.gov.

(h) The term *international application* as used in this part means, in addition to the definition in section 60 of the Act, an application seeking an extension of protection of an international registration in an initial designation filed under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.

(i) The term *subsequent designation* as used in this part means a request for extension of protection of an international registration made after the International Bureau registers the mark on the International Register.

(j) The term *holder* as used in this part means, in addition to the definition of a “holder of an international registration” in section 60 of the Act, the natural or juristic person in whose name an international registration seeking an extension of protection to the United States is recorded on the International Register.

(k) The term *use in commerce* or *use of the mark in commerce* as used in this

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part means, in addition to the definition of “use in commerce” in section 45 of the Act:

(1) For a trademark or service mark, use of the mark in commerce by an applicant, owner, or holder on or in connection with the goods or services specified in a U.S. application, amendment to allege use, statement of use, or affidavit or declaration of use or excusable nonuse;

(2) For a collective trademark or collective service mark, use of the mark in commerce by members on or in connection with the goods or services specified in a U.S. application, amendment to allege use, statement of use, or affidavit or declaration of use or excusable nonuse;

(3) For a collective membership mark, use of the mark in commerce by members to indicate membership in the collective organization as specified in a U.S. application, amendment to allege use, statement of use, or affidavit or declaration of use or excusable nonuse; and

(4) For a certification mark, use of the mark in commerce by authorized users on or in connection with the goods or services specified in a U.S. application, amendment to allege use, statement of use, or affidavit or declaration of use or excusable nonuse.

(1) The term *bona fide intention to use the mark in commerce* as used in this part means, for a trademark or service mark, that an applicant or holder has a bona fide intention to use the mark in commerce on or in connection with the goods or services specified in a U.S. application or international application/subsequent designation.

(m) The term *bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce* as used in this part means:

(1) For a collective trademark or collective service mark, that an applicant or holder has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the goods or services specified in a U.S. application or international application/subsequent designation;

(2) For a collective membership mark, that an applicant or holder has a bona fide intention, and is entitled, to

exercise legitimate control over the use of the mark in commerce by members to indicate membership in the collective organization as specified in a U.S. application or international application/subsequent designation; and

(3) For a certification mark, that an applicant or holder has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce by authorized users on or in connection with the goods or services specified in a U.S. application or international application/subsequent designation.

(n) The term *verified statement*, and the terms *verify, verified, or verification* as used in this part refers to a statement that is sworn to, made under oath or in an affidavit, or supported by a declaration under §2.20 or 28 U.S.C. 1746, and signed in accordance with the requirements of §2.193.

[54 FR 37588, Sept. 11, 1989, as amended at 68 FR 48289, Aug. 13, 2003; 68 FR 55762, Sept. 26, 2003; 73 FR 47685, Aug. 14, 2008; 78 FR 20197, Apr. 3, 2013; 80 FR 33178, June 11, 2015]

§2.6 Trademark fees.

- (a) Trademark process fees.
 - (1) Application filing fees.
 - (i) For filing an application on paper, per class\$600.00
 - (ii) For filing an application through TEAS, per class\$400.00
 - (iii) For filing a TEAS Reduced Fee (RF) application through TEAS under §2.23, per class\$275.00
 - (iv) For filing a TEAS Plus application through TEAS under §2.22, per class\$225.00
 - (v) Additional processing fee under §§2.22(c) or 2.23(c), per class\$125.00
 - (2) *Amendment to allege use.* (i) For filing an amendment to allege use under section 1(c) of the Act on paper, per class\$200.00
 - (ii) For filing an amendment to allege use under section 1(c) of the Act through TEAS, per class\$100.00
 - (3) *Statement of use.* (i) For filing a statement of use under section 1(d)(1) of the Act on paper, per class\$200.00
 - (ii) For filing a statement of use under section 1(d)(1) of the Act through TEAS, per class\$100.00
 - (4) *Extension of time for filing statement of use.* (i) For filing a request under section 1(d)(2) of the Act for a six-month extension of time for filing a statement of use under section 1(d)(1) of the Act on paper,

per class.....	\$225.00	(14) <i>Filing section 8 affidavit during grace period.</i> (i) Additional fee for filing a section 8 affidavit during the grace period on paper, per class.....	\$200.00
(ii) For filing a request under section 1(d)(2) of the Act for a six-month extension of time for filing a statement of use under section 1(d)(1) of the Act through TEAS, per class.....	\$125.00	(ii) Additional fee for filing a section 8 affidavit during the grace period through TEAS, per class.....	\$100.00
(5) <i>Application for renewal of a registration fees.</i> (i) For filing an application for renewal of a registration on paper, per class.....	\$500.00	(15) <i>Petitions to the Director.</i> (i) For petitions to the Director filed on paper.....	\$200.00
(ii) For filing an application for renewal of a registration through TEAS, per class.....	\$300.00	(ii) For petitions to the Director filed through TEAS.....	\$100.00
(6) <i>Renewal during grace period.</i> (i) Additional fee for filing a renewal application during the grace period on paper, per class.....	\$200.00	(16) <i>Petition to cancel.</i> (i) For filing a petition to cancel on paper, per class.....	\$500.00
(ii) Additional fee for filing a renewal application during the grace period through TEAS, per class.....	\$100.00	(ii) For filing a petition to cancel through ESTTA, per class.....	\$400.00
(7) <i>Publishing mark under section 12(c).</i> (i) For filing to publish a mark under section 12(c) on paper, per class.....	\$200.00	(17) <i>Notice of opposition.</i> (i) For filing a notice of opposition on paper, per class.....	\$500.00
(ii) For filing to publish a mark under section 12(c) through TEAS, per class.....	\$100.00	(ii) For filing a notice of opposition through ESTTA, per class.....	\$400.00
(8) <i>New certificate of registration.</i> (i) For issuing a new certificate of registration upon request of registrant, request filed on paper.....	\$200.00	(18) <i>Ex parte appeal.</i> (i) For ex parte appeal to the Trademark Trial and Appeal Board filed on paper, per class.....	\$300.00
(ii) For issuing a new certificate of registration upon request of registrant, request filed through TEAS.....	\$100.00	(ii) For ex parte appeal to the Trademark Trial and Appeal Board filed through ESTTA, per class.....	\$200.00
(9) <i>Certificate of correction of registrant's error.</i> (i) For a certificate of correction of registrant's error, request filed on paper.....	\$200.00	(19) <i>Dividing an application.</i> (i) Request to divide an application filed on paper, per new application created.....	\$200.00
(ii) For a certificate of correction of registrant's error, request filed through TEAS.....	\$100.00	(ii) Request to divide an application filed through TEAS, per new application created.....	\$100.00
(10) <i>Disclaimer to a registration.</i> (i) For filing a disclaimer to a registration, on paper.....	\$200.00	(20) <i>Correcting deficiency in section 8 affidavit.</i> (i) For correcting a deficiency in a section 8 affidavit via paper filing.....	\$200.00
(ii) For filing a disclaimer to a registration, through TEAS or ESTTA.....	\$100.00	(ii) For correcting a deficiency in a section 8 affidavit via TEAS filing.....	\$100.00
(11) <i>Amendment of registration.</i> (i) For filing an amendment to a registration, on paper.....	\$200.00	(21) <i>Correcting deficiency in renewal application.</i> (i) For correcting a deficiency in a renewal application via paper filing.....	\$200.00
(ii) For filing an amendment to a registration, through TEAS or ESTTA.....	\$100.00	(ii) For correcting a deficiency in a renewal application via TEAS filing.....	\$100.00
(12) <i>Affidavit under section 8.</i> (i) For filing an affidavit under section 8 of the Act on paper, per class.....	\$225.00	(22) <i>Extension of time for filing notice of opposition under § 2.102(c)(1)(ii) or (c)(2).</i> (i) For filing a request for an extension of time to file a notice of opposition under § 2.102(c)(1)(ii) or (c)(2) on paper.....	\$200.00
(ii) For filing an affidavit under section 8 of the Act through TEAS, per class.....	\$125.00	(ii) For filing a request for an extension of time to file a notice of opposition under § 2.102(c)(1)(ii) or (c)(2) through ESTTA.....	\$100.00
(13) <i>Affidavit under section 15.</i> (i) For filing an affidavit under section 15 of the Act on paper, per class.....	\$300.00	(23) <i>Extension of time for filing notice of opposition under § 2.102(c)(3).</i> (i) For filing a request for an extension of time to file a notice of opposition under § 2.102(c)(3) on paper.....	\$300.00
(ii) For filing an affidavit under section 15 of the Act through TEAS, per class.....	\$200.00		

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- (ii) For filing a request for an extension of time to file a notice of opposition under § 2.102(c)(3) through ESTTA\$200.00
- (b) Trademark service fees.
 - (1) For printed copy of registered mark, copy only. Service includes preparation of copies by the Office within two to three business days and delivery by United States Postal Service; and preparation of copies by the Office within one business day of receipt and delivery to an Office Box or by electronic means (*e.g.*, facsimile, electronic mail)\$3.00
 - (2) Certified or uncertified copy of trademark application as filed processed within seven calendar days\$15.00
 - (3) Certified or uncertified copy of a trademark-related official record \$50.00
 - (4) Certified copy of a registered mark, showing title and/or status:
 - (i) Regular service\$15.00
 - (ii) Expedited local service\$30.00
 - (5) Certified or uncertified copy of trademark records, per document except as otherwise provided in this section\$25.00
 - (6) For recording each trademark assignment, agreement or other document relating to the property in a registration or application
 - (i) First property in a document\$40.00
 - (ii) For each additional property in the same document\$25.00
 - (7) For assignment records, abstract of title and certification, per registration\$25.00
 - (8) Additional Fee for Overnight Delivery\$40.00
 - (9) Additional Fee for Expedited Service\$160.00
 - (10) For processing each payment refused (including a check returned “unpaid”) or charged back by a financial institution\$50.00
 - (11) Deposit account service charge for each month when the balance at the end of the month is below \$1,000.....\$25.00

[81 FR 72706, Oct. 21, 2016]

§ 2.7 Fastener recordal fees.

- (a) Application fee for recordal of insignia\$20.00
- (b) Renewal of insignia recordal.....\$20.00
- (c) Surcharge for late renewal of insignia recordal\$20.00

[61 FR 55223, Oct. 25, 1996]

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REPRESENTATION BY ATTORNEYS OR OTHER AUTHORIZED PERSONS

AUTHORITY: Secs. 2.11 to 2.19 also issued under 35 U.S.C. 31, 32.

§ 2.11 Applicants may be represented by an attorney.

Representation before the Office is governed by § 11.14 of this chapter. The Office cannot aid in the selection of an attorney.

[73 FR 47685, Aug. 14, 2008]

§§ 2.12–2.16 [Reserved]

§ 2.17 Recognition for representation.

(a) *Authority to practice in trademark cases.* Only an individual qualified to practice under § 11.14 of this chapter may represent an applicant, registrant, or party to a proceeding before the Office in a trademark case.

(b)(1) *Recognition of practitioner as representative.* To be recognized as a representative in a trademark case, a practitioner qualified under § 11.14 of this chapter may:

- (i) File a power of attorney that meets the requirements of paragraph (c) of this section;
- (ii) Sign a document on behalf of an applicant, registrant, or party to a proceeding who is not already represented by a practitioner qualified under § 11.14 of this chapter from a different firm; or
- (iii) Appear in person on behalf of an applicant, registrant, or party to a proceeding who is not already represented by a practitioner qualified under § 11.14 of this chapter from a different firm.

(2) *Signature as certificate of authorization to represent.* When a practitioner qualified under § 11.14 of this chapter appears in person or signs a document pursuant to paragraph (b) of this section, his or her personal appearance or signature shall constitute a representation to the Office that he or she is authorized to represent the person or entity on whose behalf he or she acts. The Office may require further proof of authority to act in a representative capacity.

(c) *Requirements for power of attorney.* A power of attorney must:

- (1) Designate by name at least one practitioner meeting the requirements of § 11.14 of this chapter; and

(2) Be signed by the individual applicant, registrant, or party to a proceeding pending before the Office, or by someone with legal authority to bind the applicant, registrant, or party (e.g., a corporate officer or general partner of a partnership). In the case of joint applicants or joint registrants, all must sign. Once the applicant, registrant, or party has designated a practitioner(s) qualified to practice under § 11.14 of this chapter, that practitioner may sign an associate power of attorney appointing another qualified practitioner(s) as an additional person(s) authorized to represent the applicant, registrant, or party. If the applicant, registrant, or party revokes the original power of attorney (§ 2.19(a)), the revocation discharges any associate power signed by the practitioner whose power has been revoked. If the practitioner who signed an associate power withdraws (§ 2.19(b)), the withdrawal discharges any associate power signed by the withdrawing practitioner upon acceptance of the request for withdrawal by the Office.

(d) *Power of attorney relating to multiple applications or registrations.* (1) The owner of an application or registration may appoint a practitioner(s) qualified to practice under § 11.14 of this chapter to represent the owner for all existing applications or registrations that have the identical owner name and attorney through TEAS.

(2) The owner of an application or registration may file a power of attorney that relates to more than one trademark application or registration, or to all existing and future applications and registrations of that owner, on paper. A person relying on such a power of attorney must:

(i) Include a copy of the previously filed power of attorney; or

(ii) Refer to the power of attorney, specifying the filing date of the previously filed power of attorney; the application serial number (if known), registration number, or *inter partes* proceeding number for which the original power of attorney was filed; and the name of the person who signed the power of attorney; or, if the application serial number is not known, submit a copy of the application or a copy

of the mark, and specify the filing date.

(e) *Canadian attorneys and agents.* (1) A Canadian patent agent who is registered and in good standing as a patent agent under § 11.6(c) may represent parties located in Canada before the Office in trademark matters.

(2) A Canadian attorney or agent who is registered or in good standing with the Canadian Intellectual Property Office, but not registered as a patent agent under § 11.6(c), may represent parties located in Canada if he or she has been authorized to do so by the Director of the Office of Enrollment and Discipline, pursuant to § 11.14(f) of this chapter.

(f) *Non-lawyers.* A non-lawyer may not act as a representative except in the limited circumstances set forth in § 11.14(b) of this chapter. Before any non-lawyer who meets the requirements of § 11.14(b) of this chapter may take action of any kind with respect to an application, registration or proceeding, a written authorization must be filed, signed by the applicant, registrant, or party to the proceeding, or by someone with legal authority to bind the applicant, registrant, or party (e.g., a corporate officer or general partner of a partnership).

(g) *Duration of power of attorney.* (1) For purposes of recognition as a representative, the Office considers a power of attorney filed while an application is pending to end when the mark registers, when ownership changes, or when the application is abandoned.

(2) The Office considers a power of attorney filed after registration to end when the mark is cancelled or expired, or when ownership changes. If the power was filed in connection with an affidavit under section 8, 12(c), 15 or 71 of the Trademark Act, renewal application under section 9 of the Act, or request for amendment or correction under section 7 of the Act, the power is deemed to end upon acceptance or final rejection of the filing.

[74 FR 54906, Oct. 26, 2009, as amended at 80 FR 2310, Jan. 16, 2015]

§ 2.18 Correspondence, with whom held.

(a) *Establishing the correspondence address.* (1) If a written power of attorney

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that meets the requirements of § 2.17 is filed, the Office will send correspondence to the practitioner designated in the power.

(2) If a practitioner qualified under § 11.14 of this chapter transmits a document(s) on behalf of an applicant, registrant, or party to a proceeding who is not already represented by another qualified practitioner from a different firm, the Office will send correspondence to the practitioner transmitting the documents.

(3) If an application, registration or proceeding is not being prosecuted by a practitioner qualified under § 11.14 of this chapter and the applicant, registrant, or party to the proceeding designates a correspondence address in writing, the Office will send correspondence to the designated address if appropriate.

(4) If an application, registration or proceeding is not being prosecuted by a practitioner qualified under § 11.14 of this chapter and the applicant, registrant, or party to the proceeding has not designated a correspondence address in writing, but a domestic representative has been appointed, the Office will send correspondence to the domestic representative if appropriate.

(5) If the application, registration or proceeding is not being prosecuted by a practitioner qualified under § 11.14 of this chapter, the applicant, registrant, or party to the proceeding has not designated a correspondence address, and no domestic representative has been appointed, the Office will send correspondence directly to the applicant, registrant, or party to the proceeding.

(6) The Office will send correspondence to only one address in an *ex parte* matter.

(7) Once the Office has recognized a practitioner qualified under § 11.14 of this chapter as the representative of an applicant or registrant, the Office will communicate and conduct business only with that practitioner, or with another qualified practitioner from the same firm. The Office will not conduct business directly with the applicant or registrant, or with another practitioner from a different firm, unless the applicant or registrant files a revocation of the power of attorney under § 2.19(a), and/or a new power of attorney

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that meets the requirements of § 2.17(c). A written request to change the correspondence address does not revoke a power of attorney.

(b) *Changing the correspondence address.* (1) If a physical or e-mail correspondence address changes, the applicant, registrant, or party to a proceeding must file a written request to change the correspondence address. The request should be promptly filed.

(2) A request to change the correspondence address must be made in writing, signed by the applicant, registrant, or party to a proceeding, someone with legal authority to bind the applicant, registrant, or party (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with § 2.193(e)(9).

(3) If an applicant or registrant files a new power of attorney that meets the requirements of § 2.17(c), the Office will change the correspondence address to that of the practitioner named in the power.

(4) If a practitioner qualified under § 11.14 of this chapter transmits a document(s) on behalf of an applicant, registrant, or party to a proceeding who is not already represented by another qualified practitioner, the Office will construe this as including a request to change the correspondence address to that of the practitioner, and will send correspondence to the practitioner.

(c) *Post registration filings under sections 7, 8, 9, 12(c), 15, and 71.* (1) Even if there is no new power of attorney or written request to change the correspondence address, the Office will change the correspondence address upon the examination of an affidavit under section 8, 12(c), 15 or 71 of the Trademark Act, renewal application under section 9 of the Act, or request for amendment or correction under section 7 of the Act. If a practitioner qualified under § 11.14 of this chapter transmits the affidavit, renewal application, or section 7 request, the Office will send correspondence to the practitioner. If the owner of the registration is not represented by a qualified practitioner, the Office will send correspondence directly to the owner, or to the domestic representative if appropriate, in accordance with paragraph (a).

(2) Once the Office establishes a correspondence address upon examination of an affidavit, renewal application, or section 7 request, a written request to change the address in accordance with the requirements of paragraph (b)(2) of this section is required to change the address during the pendency of that filing.

[74 FR 54906, Oct. 26, 2009]

§ 2.19 Revocation or withdrawal of attorney.

(a) *Revocation.* (1) Authority to represent an applicant, registrant or party to a proceeding before the Office may be revoked at any stage in the proceedings of a trademark case, upon written notification signed by the applicant, registrant, or party to the proceeding, or by someone with legal authority to bind the applicant, registrant, or party (e.g., a corporate officer or general partner of a partnership). In the case of joint applicants or joint registrants, all must sign.

(2) When a power of attorney is revoked, the Office will communicate directly with the applicant, registrant, or party to the proceeding, or with the new attorney or domestic representative if appropriate.

(3) A request to change the correspondence address does not revoke a power of attorney.

(4) A new power of attorney that meets the requirements of § 2.17(c) will be treated as a revocation of the previous power.

(b) *Withdrawal of attorney.* If the requirements of § 11.116 of this chapter are met, a practitioner authorized to represent an applicant, registrant, or party to a proceeding in a trademark case may withdraw upon application to and approval by the Director or, when applicable, upon motion granted by the Trademark Trial and Appeal Board. The practitioner should file the request to withdraw soon after the practitioner notifies the client of his/her intent to withdraw. The request must include the following:

(1) The application serial number, registration number, or proceeding number;

(2) A statement of the reason(s) for the request to withdraw; and

(3) Either

(i) A statement that the practitioner has given notice to the client that the practitioner is withdrawing from employment and will be filing the necessary documents with the Office; that the client was given notice of the withdrawal at least two months before the expiration of the response period, if applicable; that the practitioner has delivered to the client all documents and property in the practitioner's file concerning the application, registration or proceeding to which the client is entitled; and that the practitioner has notified the client of any responses that may be due, and of the deadline for response; or

(ii) If more than one qualified practitioner is of record, a statement that representation by co-counsel is ongoing.

[74 FR 54907, Oct. 26, 2009, as amended at 80 FR 2310, Jan. 16, 2015]

DECLARATIONS

§ 2.20 Declarations in lieu of oaths.

Instead of an oath, affidavit, or sworn statement, the language of 28 U.S.C. 1746, or the following declaration language, may be used:

The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

[80 FR 33178, June 11, 2015]

APPLICATION FOR REGISTRATION

AUTHORITY: Secs. 2.21 to 2.47 also issued under sec. 1, 60 Stat. 427; 15 U.S.C. 1051.

§ 2.21 Requirements for receiving a filing date.

(a) The Office will grant a filing date to an application under section 1 or section 44 of the Act that is in the English language and contains all of the following:

(1) The name of the applicant;

(2) A name and address for correspondence;

(3) A clear drawing of the mark;

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(4) A listing of the goods or services; and

(5) The filing fee for at least one class of goods or services, required by § 2.6.

(b) If the applicant does not submit all the elements required in paragraph (a) of this section, the Office will deny a filing date and issue a notice explaining why the filing date was denied.

[64 FR 48918, Sept. 8, 1999, as amended at 68 FR 55762, Sept. 26, 2003; 73 FR 67767, Nov. 17, 2008]

§ 2.22 Requirements for a TEAS Plus application.

(a) A trademark/service mark application for registration on the Principal Register under section 1 and/or section 44 of the Act will be entitled to a reduced filing fee under § 2.6(a)(1)(iv) if it is filed through TEAS and includes:

(1) The applicant's name and address;

(2) The applicant's legal entity;

(3) The citizenship of an individual applicant, or the state or country of incorporation or organization of a juristic applicant;

(4) If the applicant is a partnership, the names and citizenship of the applicant's general partners;

(5) A name and address for correspondence;

(6) An e-mail address for correspondence, and an authorization for the Office to send correspondence concerning the application to the applicant or applicant's attorney by e-mail;

(7) One or more bases for filing that satisfy all the requirements of § 2.34. If more than one basis is set forth, the applicant must comply with the requirements of § 2.34 for each asserted basis;

(8) Correctly classified goods and/or services, with an identification of goods and/or services from the Office's *Acceptable Identification of Goods and Services Manual*, available through the TEAS Plus form. In an application based on section 44 of the Act, the scope of the goods and/or services covered by the section 44 basis may not exceed the scope of the goods and/or services in the foreign application or registration;

(9) If the application contains goods and/or services in more than one class, compliance with § 2.86;

(10) A filing fee for each class of goods and/or services, as required by § 2.6(a)(1)(iii);

(11) A verified statement that meets the requirements of § 2.33, dated and signed by a person properly authorized to sign on behalf of the owner pursuant to § 2.193(e)(1);

(12) A clear drawing of the mark. If the applicant does not claim standard characters, the applicant must attach a digitized image of the mark in .jpg format. If the mark includes color, the drawing must show the mark in color;

(13) If the mark is in standard characters, a mark comprised of only characters in the Office's standard character set, currently available at <http://www.uspto.gov>, typed in the appropriate field of the TEAS Plus form;

(14) If the mark includes color, a statement naming the color(s) and describing where the color(s) appears on the mark, and a claim that the color(s) is a feature of the mark;

(15) If the mark is not in standard characters, a description of the mark;

(16) If the mark includes non-English wording, an English translation of that wording;

(17) If the mark includes non-Latin characters, a transliteration of those characters;

(18) If the mark includes an individual's name or portrait, either (i) a statement that identifies the living individual whose name or likeness the mark comprises and written consent of the individual, or (ii) a statement that the name or portrait does not identify a living individual (*see* section 2(c) of the Act);

(19) If the applicant owns one or more registrations for the same mark, and the owner(s) last listed in Office records of the prior registration(s) for the same mark differs from the owner(s) listed in the application, a claim of ownership of the registration(s) identified by the registration number(s), pursuant to § 2.36; and

(20) If the application is a concurrent use application, compliance with § 2.42.

(b) In addition to the filing requirements under paragraph (a) of this section, the applicant must:

(1) File the following communications through TEAS:

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(i) Responses to Office actions (except notices of appeal under section 20 of the Trademark Act);

(ii) Requests to change the correspondence address and owner's address;

(iii) Appointments and/or revocations of power of attorney;

(iv) Appointments and/or revocations of domestic representative;

(v) Voluntary amendments;

(vi) Amendments to allege use under section 1(c) of the Act or statements of use under section 1(d) of the Act;

(vii) Requests for extensions of time to file a statement of use under section 1(d) of the Act; and

(viii) Requests to delete a section 1(b) basis.

(2) Maintain a valid email correspondence address and continue to receive communications from the Office by email.

(c) If an application does not fulfill the requirements of paragraphs (a) and (b) of this section, the applicant must pay the processing fee required by § 2.6(a)(1)(v). The application will retain its original filing date, provided that when filed, the application met the filing date requirements of § 2.21.

(d) The following types of applications cannot be filed as TEAS Plus applications:

(1) Applications for certification marks (see § 2.45);

(2) Applications for collective trademarks and service marks (see § 2.44);

(3) Applications for collective membership marks (see § 2.44); and

(4) Applications for registration on the Supplemental Register (see § 2.47).

[70 FR 38773, July 6, 2005, as amended at 74 FR 54907, Oct. 26, 2009; 79 FR 74638, Dec. 16, 2014; 80 FR 2310, Jan. 16, 2015; 80 FR 33178, June 11, 2015]

§ 2.23 Requirements for a TEAS RF application.

(a) A trademark, service mark, certification mark, collective membership mark, or collective trademark application for registration on the Principal or Supplemental Register under section 1 and/or section 44 of the Act will be entitled to a reduced filing fee under § 2.6(a)(1)(iii) if it is filed through TEAS and includes:

(1) An email address for correspondence; and

(2) An authorization for the Office to send correspondence concerning the application to the applicant or applicant's attorney by email.

(b) In addition to the filing requirements under paragraph (a) of this section, the applicant must:

(1) File the following communications through TEAS:

(i) Responses to Office actions (except notices of appeal under section 20 of the Trademark Act);

(ii) Requests to change the correspondence address and owner's address;

(iii) Appointments and/or revocations of power of attorney;

(iv) Appointments and/or revocations of domestic representative;

(v) Voluntary amendments;

(vi) Amendments to allege use under section 1(c) of the Act or statements of use under section 1(d) of the Act;

(vii) Requests for extensions of time to file a statement of use under section 1(d) of the Act; and

(viii) Requests to delete a section 1(b) basis.

(2) Maintain a valid email correspondence address, and continue to receive communications from the Office by email.

(c) If an application does not meet the requirements of paragraphs (a) and (b) of this section, the applicant must pay the processing fee required by § 2.6(a)(1)(v). The application will retain its original filing date, provided that when filed, the application met the filing date requirements of § 2.21.

[79 FR 74639, Dec. 16, 2014]

§ 2.24 Designation and revocation of domestic representative by foreign applicant.

(a)(1) If an applicant is not domiciled in the United States, the applicant may designate a domestic representative (*i.e.*, a person residing in the United States on whom notices or process in proceedings affecting the mark may be served) by either:

(i) Setting forth the name and address of the domestic representative in the initial application; or

(ii) Filing a separate designation setting forth the name and address of the

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domestic representative, signed by the applicant, someone with legal authority to bind the applicant (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under §11.14 of this chapter.

(2) If the applicant does not file a document designating the name and address of a person residing in the United States on whom notices or process in proceedings affecting the mark may be served, or if the last person designated cannot be found at the address given in the designation, then notices or process in proceedings affecting the mark may be served on the Director.

(3) The mere designation of a domestic representative does not authorize the person designated to represent the applicant unless qualified under §11.14 of this chapter.

(b) A request to change or revoke a designation of domestic representative must be signed by the applicant, someone with legal authority to bind the applicant (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under §11.14 of this chapter.

[74 FR 54907, Oct. 26, 2009]

§ 2.25 Documents not returnable.

Except as provided in §2.27(e), documents filed in the Office by the applicant or registrant become part of the official record and will not be returned or removed.

[73 FR 67768, Nov. 17, 2008]

§ 2.27 Pending trademark application index; access to applications.

(a) An index of pending applications including the name and address of the applicant, a reproduction or description of the mark, the goods or services with which the mark is used, the class number, the dates of use, and the serial number and filing date of the application will be available for public inspection as soon as practicable after filing.

(b) Except as provided in paragraph (e) of this section, access to the file of a particular pending application will be permitted prior to publication under §2.80 upon written request.

(c) Decisions of the Director and the Trademark Trial and Appeal Board in

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applications and proceedings relating thereto are published or available for inspection or publication.

(d) Except as provided in paragraph (e) of this section, the official records of applications and all proceedings relating thereto are available for public inspection and copies of the documents may be furnished upon payment of the fee required by §2.6.

(e) Anything ordered to be filed under seal pursuant to a protective order issued or made by any court or by the Trademark Trial and Appeal Board in any proceeding involving an application or a registration shall be kept confidential and shall not be made available for public inspection or copying unless otherwise ordered by the court or the Board, or unless the party protected by the order voluntarily discloses the matter subject thereto. When possible, only confidential portions of filings with the Board shall be filed under seal.

[36 FR 25406, Dec. 31, 1971, as amended at 48 FR 23134, May 23, 1983; 48 FR 27225, June 14, 1983; 73 FR 67768, Nov. 17, 2008]

THE WRITTEN APPLICATION

§ 2.31 [Reserved]

§ 2.32 Requirements for a complete trademark or service mark application.

(a) The application must be in English and include the following:

(1) A request for registration;

(2) The name of the applicant(s);

(3)(i) The citizenship of the applicant(s); or

(ii) If the applicant is a corporation, association, partnership or other juristic person, the jurisdiction (usually state or nation) under the laws of which the applicant is organized; and

(iii) If the applicant is a domestic partnership, the names and citizenship of the general partners; or

(iv) If the applicant is a domestic joint venture, the names and citizenship of the active members of the joint venture;

(4) The address of the applicant;

(5) One or more bases, as required by §2.34(a);

(6) A list of the particular goods or services on or in connection with which the applicant uses or intends to use the

mark. In a U.S. application filed under section 44 of the Act, the scope of the goods or services covered by the section 44 basis may not exceed the scope of the goods or services in the foreign application or registration;

(7) The international class of goods or services, if known. See § 6.1 of this chapter for a list of the international classes of goods and services.

(8) If the mark is not in standard characters, a description of the mark;

(9) If the mark includes non-English wording, an English translation of that wording; and

(10) If the mark includes non-Latin characters, a transliteration of those characters, and either a translation of the transliterated term in English, or a statement that the transliterated term has no meaning in English.

(b) The application must include a verified statement that meets the requirements of § 2.33.

(c) The application must include a drawing that meets the requirements of § 2.51 and § 2.52.

(d) The application must include fee required by § 2.6 for each class of goods or services.

(e) For the requirements of a multiple-class application, see § 2.86.

(f) For the requirements of all collective mark applications, see § 2.44.

(g) For the requirements of a certification mark application, see § 2.45.

[64 FR 48918, Sept. 8, 1999, as amended at 73 FR 13784, Mar. 14, 2008; 73 FR 67768, Nov. 17, 2008; 80 FR 33178, June 11, 2015]

§ 2.33 Verified statement for a trademark or service mark.

(a) The application must include a verified statement.

(b)(1) In an application under section 1(a) of the Act, the verified statement must allege:

That the applicant believes the applicant is the owner of the mark; that the mark is in use in commerce; that to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when applied to the goods or services of such other person, to cause confusion or mistake, or to deceive; that the specimen shows the mark as used on or in connection with the goods or services; and that the facts set forth in the application are true.

(2) In an application under section 1(b) or 44 of the Act, the verified statement must allege:

That the applicant has a bona fide intention to use the mark in commerce; that the applicant believes the applicant is entitled to use the mark in commerce on or in connection with the goods or services specified in the application; that to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when applied to the goods or services of such other person, to cause confusion or mistake, or to deceive; and that the facts set forth in the application are true.

(c) If the verified statement in paragraph (b)(1) or (2) of this section is not filed within a reasonable time after it is signed, the Office may require the applicant to submit a substitute verified statement attesting that the mark was in use in commerce as of the application filing date, or the applicant had a bona fide intention to use the mark in commerce as of the application filing date.

(d) [Reserved]

(e) In an application under section 66(a) of the Act, the verified statement, which is part of the international registration on file with the International Bureau, must allege that:

(1) The applicant/holder has a bona fide intention to use the mark in commerce that the U.S. Congress can regulate on or in connection with the goods or services specified in the international application/subsequent designation;

(2) The signatory is properly authorized to execute the declaration on behalf of the applicant/holder;

(3) The signatory believes the applicant/holder to be entitled to use the mark in commerce that the U.S. Congress can regulate on or in connection with the goods or services specified in the international application/subsequent designation; and

(4) To the best of his/her knowledge and belief, no other person, firm, corporation, association, or other legal entity has the right to use the mark in commerce that the U.S. Congress can regulate either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods or services of such other person, firm, corporation, association, or other legal entity, to cause confusion, or to cause mistake, or to deceive.

(f) In an application for concurrent use under § 2.42, the verified statement

in paragraph (b)(1) of this section must be modified to indicate that no other person except as specified in the application has the right to use the mark in commerce.

[80 FR 33178, June 11, 2015]

§ 2.34 Bases for filing a trademark or service mark application.

(a) An application for a trademark or service mark must include one or more of the following five filing bases:

(1) *Use in commerce under section 1(a) of the Act.* The requirements for an application under section 1(a) of the Act are:

(i) The applicant's verified statement that the mark is in use in commerce. If the verified statement is not filed with the initial application, the verified statement must also allege that the mark was in use in commerce as of the application filing date;

(ii) The date of the applicant's first use of the mark anywhere on or in connection with the goods or services;

(iii) The date of the applicant's first use of the mark in commerce;

(iv) One specimen showing how the applicant uses the mark in commerce; and

(v) If the application specifies more than one item of goods or services in a class, the dates of use in paragraphs (a)(1)(ii) and (iii) of this section are required for only one item of goods or services specified in that class.

(2) *Intent-to-use under section 1(b) of the Act.* In an application under section 1(b) of the Act, the applicant must verify that the applicant has a bona fide intention to use the mark in commerce. If the verified statement is not filed with the initial application, the verified statement must also allege that the applicant had a bona fide intention to use the mark in commerce as of the application filing date.

(3) *Registration of a mark in a foreign applicant's country of origin under section 44(e) of the Act.* The requirements for an application under section 44(e) of the Act are:

(i) The applicant's verified statement that the applicant has a bona fide intention to use the mark in commerce. If the verified statement is not filed with the initial application, the Office will require submission of the verified

statement, which must also allege that the applicant had a bona fide intention to use the mark in commerce as of the application filing date.

(ii) A true copy, a photocopy, a certification, or a certified copy of a registration in the applicant's country of origin showing that the mark has been registered in that country, and that the registration is in full force and effect. The certification or copy of the foreign registration must show the name of the owner, the mark, and the goods or services for which the mark is registered. If the foreign registration is not in the English language, the applicant must submit a translation.

(iii) If the record indicates that the foreign registration will expire before the U.S. registration will issue, the applicant must submit a true copy, a photocopy, a certification, or a certified copy of a proof of renewal from the applicant's country of origin to establish that the foreign registration has been renewed and will be in full force and effect at the time the U.S. registration will issue. If the proof of renewal is not in the English language, the applicant must submit a translation.

(4) *Claim of priority, based upon an earlier-filed foreign application, under section 44(d) of the Act.* The requirements for an application under section 44(d) of the Act are:

(i) A claim of priority, filed within six months of the filing date of the foreign application. Before publication or registration on the Supplemental Register, the applicant must either:

(A) Specify the filing date, serial number and country of the first regularly filed foreign application; or

(B) State that the application is based upon a subsequent regularly filed application in the same foreign country, and that any prior-filed application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without having any rights outstanding, and has not served as a basis for claiming a right of priority.

(ii) The applicant's verified statement that the applicant has a bona fide intention to use the mark in commerce. If the verified statement is not filed with the initial application, the Office will require submission of the

verified statement, which must also allege that the applicant had a bona fide intention to use the mark in commerce as of the application filing date.

(iii) Before the application can be approved for publication, or for registration on the Supplemental Register, the applicant must establish a basis under section 1 or 44 of the Act.

(5) *Extension of protection of an international registration under section 66(a) of the Act.* In an application under section 66(a) of the Act, the international application/subsequent designation must contain a signed declaration that meets the requirements of § 2.33(a), (e).

(b) *More than one basis.* In an application under section 1 or 44 of the Act, an applicant may claim more than one basis, provided the applicant satisfies all requirements for the bases claimed. In such case, the applicant must specify each basis and the goods or services to which that basis applies. An applicant must specify the goods or services covered by more than one basis. Section 1(a) and 1(b) of the Act may not both be claimed for identical goods or services in the same application. A basis under section 66(a) of the Act may not be combined with another basis.

[64 FR 48919, Sept. 8, 1999, as amended at 67 FR 79522, Dec. 30, 2002; 68 FR 55763, Sept. 26, 2003; 73 FR 67768, Nov. 17, 2008; 77 FR 30207, May 22, 2012; 80 FR 33179, June 11, 2015]

§ 2.35 Adding, deleting, or substituting bases.

(a) In an application under section 66(a) of the Act, an applicant may not add, substitute or delete a basis, unless the applicant meets the requirements for transformation under section 70(c) of the Act and § 7.31 of this chapter.

(b) In an application under section 1 or section 44 of the Act:

(1) Before publication for opposition, an applicant may add or substitute a basis, if the applicant meets all requirements for the new basis, as stated in § 2.34, § 2.44, or § 2.45. The applicant may delete a basis at any time.

(2) After publication, an applicant may add or substitute a basis in an application that is not the subject of an *inter partes* proceeding before the Trademark Trial and Appeal Board, but only with the express permission of

the Director, after consideration on petition. Republication will be required. The amendment of an application that is the subject of an *inter partes* proceeding before the Board is governed by § 2.133(a).

(3) When an applicant substitutes one basis for another, the Office will presume that there was a continuing valid basis, unless there is contradictory evidence in the record, and the application will retain the original filing date, including a priority filing date under section 44(d), if appropriate.

(4) If an applicant properly claims a section 44(d) basis in addition to another basis, the applicant will retain the priority filing date under section 44(d) no matter which basis the applicant perfects.

(5) The applicant may add or substitute a section 44(d) basis only within the six-month priority period following the filing date of the foreign application.

(6) When the applicant adds or substitutes a basis, the applicant must list each basis and specify the goods, services, or collective membership organization to which that basis applies.

(7) When the applicant deletes a basis, the applicant must also delete any goods, services, or collective membership organization covered solely by the deleted basis.

(8) Once an applicant claims a section 1(b) basis as to any or all of the goods or services, or a collective membership organization, the applicant may not amend the application to seek registration under section 1(a) of the Act for identical goods or services or the same collective membership organization, unless the applicant files an allegation of use under section 1(c) or section 1(d) of the Act.

[68 FR 55763, Sept. 26, 2003, as amended at 80 FR 33180, June 11, 2015]

§ 2.36 Identification of prior registrations.

Prior registrations of the same or similar marks owned by the applicant should be identified in the application if the owner(s) last listed in Office

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records of the prior registrations differs from the owner(s) listed in the application.

[80 FR 2310, Jan. 16, 2015]

§ 2.37 Description of mark.

A description of the mark must be included if the mark is not in standard characters. In an application where the mark is in standard characters, a description may be included and must be included if required by the trademark examining attorney.

[73 FR 13784, Mar. 14, 2008]

§ 2.38 Use by predecessor or by related companies.

(a) If the first use of the mark was by a predecessor in title or by a related company (sections 5 and 45 of the Act), and the use inures to the benefit of the applicant, the dates of first use (§§ 2.34(a)(1) (ii) and (iii)) may be asserted with a statement that first use was by the predecessor in title or by the related company, as appropriate.

(b) The Office may require such details concerning the nature of the relationship and such proofs as may be necessary and appropriate for the purpose of showing that the use by related companies inures to the benefit of the applicant and does not affect the validity of the mark.

(Sec. 5, 60 Stat. 429; 15 U.S.C. 1055)

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37589, Sept. 11, 1989; 64 FR 48920, Sept. 8, 1999; 80 FR 2310, Jan. 16, 2015]

§ 2.39 [Reserved]

§ 2.41 Proof of distinctiveness under section 2(f).

(a) *For a trademark or service mark—(1) Ownership of prior registration(s).* In appropriate cases, ownership of one or more active prior registrations on the Principal Register or under the Trademark Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness if the goods or services are sufficiently similar to the goods or services in the application; however, further evidence may be required.

(2) *Five years substantially exclusive and continuous use in commerce.* In appropriate cases, if a trademark or service mark is said to have become dis-

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tinctive of the applicant's goods or services by reason of the applicant's substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, a showing by way of verified statements in the application may be accepted as prima facie evidence of distinctiveness; however, further evidence may be required.

(3) *Other evidence.* In appropriate cases, where the applicant claims that a mark has become distinctive in commerce of the applicant's goods or services, the applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, verified statements, depositions, or other appropriate evidence showing duration, extent, and nature of the use in commerce and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness.

(b) *For a collective trademark or collective service mark—(1) Ownership of prior registration(s).* See the requirements of paragraph (a)(1) of this section.

(2) *Five years substantially exclusive and continuous use in commerce.* In appropriate cases, if a collective trademark or collective service mark is said to have become distinctive of the members' goods or services by reason of the members' substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, a showing by way of verified statements in the application may be accepted as prima facie evidence of distinctiveness; however, further evidence may be required.

(3) *Other evidence.* In appropriate cases, where the applicant claims that a mark has become distinctive in commerce of the members' goods or services, the applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, verified statements, depositions, or other appropriate evidence showing duration, extent, and nature of the use in

commerce, and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness.

(c) *For a collective membership mark—*
 (1) *Ownership of prior registration(s).* In appropriate cases, ownership of one or more active prior registrations on the Principal Register or under the Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness if the goods, services, or nature of the collective membership organization are sufficiently similar to the collective membership organization in the application; however, further evidence may be required.

(2) *Five years substantially exclusive and continuous use in commerce.* In appropriate cases, if a collective membership mark is said to have become distinctive of indicating membership in the applicant's collective membership organization by reason of the members' substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, a showing by way of verified statements in the application may be accepted as prima facie evidence of distinctiveness; however, further evidence may be required.

(3) *Other evidence.* In appropriate cases, where the applicant claims that a mark has become distinctive in commerce of indicating membership in the applicant's collective membership organization, the applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, verified statements, depositions, or other appropriate evidence showing duration, extent, and nature of the members' use in commerce, and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness.

(d) *For a certification mark—*(1) *Ownership of prior certification mark registration(s).* In appropriate cases, ownership

of one or more active prior certification mark registrations on the Principal Register or under the Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness if the authorized users' goods or services are sufficiently similar to the goods or services certified in the application, subject to the limitations of the statement set forth in § 2.45(a)(4)(i)(C); however, further evidence may be required.

(2) *Five years substantially exclusive and continuous use in commerce.* In appropriate cases, if a certification mark is said to have become distinctive of the certified goods or services by reason of the authorized users' substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, a showing by way of verified statements in the application may be accepted as prima facie evidence of distinctiveness; however, further evidence may be required.

(3) *Other evidence.* In appropriate cases, where the applicant claims that a mark has become distinctive of the certified goods or services program, the applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, verified statements, depositions, or other appropriate evidence showing duration, extent, and nature of the authorized users' use in commerce and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness.

(e) *Certification marks with geographical matter.* Paragraph (d) of this section does not apply to geographical matter in a certification mark certifying regional origin because section 2(e)(2) of the Act does not apply to certification marks that are indications of regional origin.

[80 FR 33180, June 11, 2015]

§ 2.42 Concurrent use.

(a) Prior to seeking concurrent use, an application for registration on the

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Principal Register under the Act must assert use in commerce and include all the application elements required by the preceding sections, in addition to § 2.44 or § 2.45, if applicable.

(b) The applicant must also include a verified statement that indicates the following, to the extent of the applicant's knowledge:

(1) For a trademark or service mark, the geographic area in which the applicant is using the mark in commerce; for a collective mark or certification mark, the geographic area in which the applicant's members or authorized users are using the mark in commerce;

(2) For a trademark or service mark, the applicant's goods or services; for a collective trademark, collective service mark, or certification mark, the applicant's members' or authorized users' goods or services; for a collective membership mark, the nature of the applicant's collective membership organization;

(3) The mode of use for which the applicant seeks registration;

(4) The concurrent users' names and addresses;

(5) The registrations issued to or applications filed by such concurrent users, if any;

(6) For a trademark or service mark, the geographic areas in which the concurrent user is using the mark in commerce; for a collective mark or certification mark, the geographic areas in which the concurrent user's members or authorized users are using the mark in commerce;

(7) For a trademark or service mark, the concurrent user's goods or services; for a collective trademark, collective service mark, or certification mark, the concurrent user's members' or authorized users' goods or services; for a collective membership mark, the nature of the concurrent user's collective membership organization;

(8) The mode of use by the concurrent users or the concurrent users' members or authorized users; and

(9) The time periods of such use by the concurrent users or the concurrent users' members or authorized users.

(c) For the requirements to amend an application to concurrent use, see § 2.73.

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(d) For the requirements of a concurrent use proceeding, see § 2.99.

[80 FR 33181, June 11, 2015]

§ 2.43 Service mark.

In an application to register a service mark, the application shall specify and contain all the elements required by the preceding sections for trademarks, but shall be modified to relate to services instead of to goods wherever necessary.

(Sec. 3, 60 Stat. 429; 15 U.S.C. 1052)

§ 2.44 Requirements for a complete collective mark application.

(a) A complete application to register a collective trademark, collective service mark, or collective membership mark must include the following:

(1) The requirements specified in § 2.32(a) introductory text through (a)(4), (a)(8) through (10), (c), and (d);

(2)(i) For a collective trademark or collective service mark, a list of the particular goods or services on or in connection with which the applicant's members use or intend to use the mark; or

(ii) For a collective membership mark, a description of the nature of the membership organization such as by type, purpose, or area of activity of the members; and

(iii) In a U.S. application filed under section 44 of the Act, the scope of the goods or services or the nature of the membership organization covered by the section 44 basis may not exceed the scope of the goods or services or nature of the membership organization in the foreign application or registration.

(3)(i) For a collective trademark or collective service mark application, the international class of goods or services, if known. See § 6.1 of this chapter for a list of the international classes of goods and services; or

(ii) For a collective membership mark application filed under sections 1 or 44 of the Act, classification in U.S. Class 200; and for a collective membership mark application filed under section 66(a) of the Act, the international class(es) assigned by the International Bureau in the corresponding international registration.

(4) One or more of the following five filing bases:

(i) *Use in commerce under section 1(a) of the Act.* The requirements for an application under section 1(a) of the Act are:

(A) A statement specifying the nature of the applicant's control over the use of the mark by the members;

(B) For a collective trademark or collective service mark, the date of the applicant's member's first use of the mark anywhere on or in connection with the goods or services and the date of the applicant's member's first use of the mark in commerce; or for a collective membership mark, the date of the applicant's member's first use anywhere to indicate membership in the collective organization and the date of the applicant's member's first use in commerce. If the application specifies more than one item of goods or services in a class, the dates of use are required for only one item of goods or services specified in that class;

(C) One specimen showing how a member uses the mark in commerce; and

(D) A verified statement alleging:

That the applicant believes the applicant is the owner of the mark; that the mark is in use in commerce; that the applicant is exercising legitimate control over the use of the mark in commerce; that to the best of the signatory's knowledge and belief, no other persons except members have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods, services, or collective membership organization of such other persons to cause confusion or mistake, or to deceive; that the specimen shows the mark as used in commerce by the applicant's members; and that the facts set forth in the application are true.

(ii) *Intent-to-use under section 1(b) of the Act.* The requirement for an application based on section 1(b) of the Act is a verified statement alleging:

That the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce; that to the best of the signatory's knowledge and belief, no other persons, except members,

have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods, services, or collective membership organization of such other persons, to cause confusion or mistake, or to deceive; and that the facts set forth in the application are true.

(iii) *Registration of a mark in a foreign applicant's country of origin under section 44(e) of the Act.* The requirements for an application under section 44(e) of the Act are:

(A) The requirements of § 2.34(a)(3)(ii) and (iii); and

(B) A verified statement in accordance with paragraph (a)(4)(ii) of this section.

(iv) *Claim of priority, based upon an earlier-filed foreign application, under section 44(d) of the Act.* The requirements for an application under section 44(d) of the Act are:

(A) The requirements of § 2.34(a)(4)(i) and (iii); and

(B) A verified statement in accordance with paragraph (a)(4)(ii) of this section.

(v) *Extension of protection of an international registration under section 66(a) of the Act.* The requirement for an application under section 66(a) of the Act is a verified statement alleging that the applicant/holder has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce that the U.S. Congress can regulate on or in connection with the goods or services specified in the international application/subsequent designation; that the signatory is properly authorized to execute the declaration on behalf of the applicant/holder; and that to the best of his/her knowledge and belief, no other person, firm, corporation, association, or other legal entity, except members, has the right to use the mark in commerce that the U.S. Congress can regulate either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods, services, or collective membership organization of such other person, firm, corporation, association, or other legal entity, to cause confusion, or to cause mistake, or to deceive.

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(b) *Verification not filed within reasonable time or omitted.* (1) If the verified statement in paragraph (a)(4)(i)(D), (a)(4)(ii), (a)(4)(iii)(B), or (a)(4)(iv)(B) of this section is not filed within a reasonable time after it is signed, the Office may require the applicant to submit a substitute verified statement attesting that, as of the application filing date, the mark was in use in commerce and the applicant was exercising legitimate control over the use of the mark in commerce; or, as of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce; or

(2) If the verified statement in paragraph (a)(4)(i)(D), (a)(4)(ii), (a)(4)(iii)(B), (a)(4)(iv)(B), or (a)(4)(v) of this section is not filed with the initial application, the verified statement must also allege that, as of the application filing date, the mark was in use in commerce and the applicant was exercising legitimate control over the use of the mark in commerce; or, as of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce.

(c) *More than one basis.* In an application under section 1 or 44 of the Act, an applicant may claim more than one basis, provided the applicant satisfies all requirements for the bases claimed. In such case, the applicant must specify each basis, followed by the goods, services, or collective membership organization to which that basis applies. An applicant must specify the goods, services, or collective membership organization covered by more than one basis. Section 1(a) and 1(b) of the Act may not both be claimed for identical goods, or services, or the same collective membership organization in one application. A basis under section 66(a) of the Act may not be combined with another basis.

(d) *In an application for concurrent use under § 2.42,* the verified statement in paragraph (a)(4)(i)(D) of this section must be modified to indicate that no other persons except members and the concurrent users as specified in the application have the right to use the mark in commerce.

(e) *Multiple-class applications.* For the requirements of a multiple-class application, see § 2.86.

[80 FR 33181, June 11, 2015]

§ 2.45 Requirements for a complete certification mark application; restriction on certification mark application.

(a) A complete application to register a certification mark must include the following:

(1) The requirements specified in § 2.32(a) introductory text through (a)(4), (a)(8) through (10), (c), and (d);

(2) A list of the particular goods or services on or in connection with which the applicant's authorized users use or intend to use the mark. In an application filed under section 44 of the Act, the scope of the goods or services covered by the section 44 basis may not exceed the scope of the goods or services in the foreign application or registration;

(3) For applications filed under section 1 or 44 of the Act, classification in U.S. Class A for an application certifying goods and U.S. Class B for an application certifying services. For applications filed under section 66(a) of the Act, the international class(es) of goods or services assigned by the International Bureau in the corresponding international registration;

(4) One or more of the following five filing bases:

(i) *Use in commerce under section 1(a) of the Act.* The requirements for an application under section 1(a) of the Act are:

(A) A statement specifying what the applicant is certifying about the goods or services in the application;

(B) A copy of the certification standards governing use of the certification mark on or in connection with the goods or services specified in the application;

(C) A statement that the applicant is not engaged in the production or marketing of the goods or services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods or services that meet the certification standards of the applicant;

(D) The date of the applicant's authorized user's first use of the mark

anywhere on or in connection with the goods or services and the date of the applicant's authorized user's first use of the mark in commerce. If the application specifies more than one item of goods or services in a class, the dates of use are required for only one item of goods or services specified in that class;

(E) One specimen showing how an authorized user uses the mark in commerce; and

(F) A verified statement alleging:

That the applicant believes the applicant is the owner of the mark; that the mark is in use in commerce; that the applicant is exercising legitimate control over the use of the mark in commerce; that to the best of the signatory's knowledge and belief, no other persons except authorized users have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods or services of such other persons, to cause confusion or mistake, or to deceive; that the specimen shows the mark as used in commerce by the applicant's authorized users; and that the facts set forth in the application are true.

(ii) *Intent-to-use under section 1(b) of the Act.* The requirements for an application based on section 1(b) of the Act are:

(A) A statement specifying what the applicant will be certifying about the goods or services in the application;

(B) A statement that the applicant will not engage in the production or marketing of the goods or services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods or services that meet the certification standards of the applicant; and

(C) A verified statement alleging:

That the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce; that to the best of the signatory's knowledge and belief, no other persons, except authorized users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods or services of such

other persons, to cause confusion or mistake, or to deceive; and that the facts set forth in the application are true.

(iii) *Registration of a mark in a foreign applicant's country of origin under section 44(e) of the Act.* The requirements for an application under section 44(e) of the Act are:

(A) The requirements of § 2.34(a)(3)(ii) and (iii);

(B) The requirements in paragraphs (a)(4)(ii)(A) and (B) of this section; and

(C) A verified statement in accordance with paragraph (a)(4)(ii)(C) of this section.

(iv) *Claim of priority, based upon an earlier-filed foreign application, under section 44(d) of the Act.* The requirements for an application under section 44(d) of the Act are:

(A) The requirements of § 2.34(a)(4)(i) and (iii);

(B) The requirements in paragraphs (a)(4)(ii)(A) and (B) of this section; and

(C) A verified statement in accordance with paragraph (a)(4)(ii)(C) of this section.

(v) *Extension of protection of an international registration under section 66(a) of the Act.* The requirements for an application under section 66(a) of the Act are:

(A) The requirements of paragraphs (a)(4)(ii)(A) and (B) of this section; and

(B) A verified statement alleging that the applicant/holder has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce that the U.S. Congress can regulate on or in connection with the goods or services specified in the international application/subsequent designation; that the signatory is properly authorized to execute the declaration on behalf of the applicant/holder; and that to the best of his/her knowledge and belief, no other person, firm, corporation, association, or other legal entity, except authorized users, has the right to use the mark in commerce that the U.S. Congress can regulate either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or

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in connection with the goods or services of such other person, firm, corporation, association, or other legal entity, to cause confusion, or to cause mistake, or to deceive.

(b) *Verification not filed within reasonable time or omitted.* (1) If the verified statement in paragraph (a)(4)(i)(F), (a)(4)(ii)(C), (a)(4)(iii)(C), or (a)(4)(iv)(C) of this section is not filed within a reasonable time after it is signed, the Office may require the applicant to submit a substitute verified statement attesting that, as of the application filing date, the mark was in use in commerce and the applicant was exercising legitimate control over the use of the mark in commerce; or, as of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce; or

(2) If the verified statement in paragraph (a)(4)(i)(F), (a)(4)(ii)(C), (a)(4)(iii)(C), (a)(4)(iv)(C), or (a)(4)(v)(B) of this section is not filed with the initial application, the verified statement must also allege that, as of the application filing date, the mark was in use in commerce and the applicant was exercising legitimate control over the use of the mark in commerce; or, as of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce.

(c) *More than one basis.* In an application under section 1 or 44 of the Act, an applicant may claim more than one basis, provided the applicant satisfies all requirements for the bases claimed. In such case, the applicant must specify each basis, followed by the goods or services to which that basis applies. An applicant must specify the goods or services covered by more than one basis. Section 1(a) and 1(b) of the Act may not both be claimed for identical goods or services in the same application. A basis under section 66(a) of the Act may not be combined with another basis.

(d) *Concurrent use.* In an application for concurrent use under §2.42, the verified statement in paragraph (a)(4)(i)(F) of this section must be modified to indicate that no other persons except authorized users and concurrent users as specified in the appli-

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cation have the right to use the mark in commerce.

(e) *Multiple-class applications.* For the requirements of a multiple-class application, see §2.86.

(f) *Restriction on certification mark application.* A single application may not include a certification mark and another type of mark. The same mark for the same goods or services is not registrable as both a certification mark and another type of mark. See sections 4 and 14(5)(B) of the Act.

[80 FR 33182, June 11, 2015]

§2.46 Principal Register.

All applications will be treated as seeking registration on the Principal Register unless otherwise stated in the application. Service marks, collective marks, and certification marks, registrable in accordance with the applicable provisions of section 2 of the Act, are registered on the Principal Register.

§2.47 Supplemental Register.

(a) In an application to register on the Supplemental Register under section 23 of the Act, the application shall so indicate and shall specify that the mark has been in use in commerce.

(b) In an application to register on the Supplemental Register under section 44 of the Act, the application shall so indicate. The statement of lawful use in commerce may be omitted.

(c) An application under section 66(a) of the Act is not eligible for registration on the Supplemental Register.

(d) A mark in an application to register on the Principal Register under section 1(b) of the Act is eligible for registration on the Supplemental Register only after an acceptable amendment to allege use under §2.76 or statement of use under §2.88 has been timely filed.

(e) An application for registration on the Supplemental Register must conform to the requirements for registration on the Principal Register under section 1(a) of the Act, so far as applicable.

[54 FR 37590, Sept. 11, 1989, as amended at 68 FR 55763, Sept. 26, 2003; 73 FR 67769, Nov. 17, 2008]

§ 2.48 Office does not issue duplicate registrations.

If two applications on the same register would result in registrations that are exact duplicates, the Office will permit only one application to mature into registration, and will refuse registration in the other application.

[73 FR 67769, Nov. 17, 2008]

DRAWING

AUTHORITY: Secs. 2.51 to 2.55 also issued under sec. 1, 60 Stat. 427; 15 U.S.C. 1051.

§ 2.51 Drawing required.

(a) In an application under section 1(a) of the Act, the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services.

(b) In an application under section 1(b) of the Act, the drawing of the mark must be a substantially exact representation of the mark as intended to be used on or in connection with the goods and/or services specified in the application, and once an amendment to allege use under § 2.76 or a statement of use under § 2.88 has been filed, the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services.

(c) In an application under section 44 of the Act, the drawing of the mark must be a substantially exact representation of the mark as it appears in the drawing in the registration certificate of a mark duly registered in the applicant's country of origin.

(d) In an application under section 66(a) of the Act, the drawing of the mark must be a substantially exact representation of the mark as it appears in the international registration.

[68 FR 55763, Sept. 26, 2003]

§ 2.52 Types of drawings and format for drawings.

A drawing depicts the mark sought to be registered. The drawing must show only one mark. The applicant must include a clear drawing of the mark when the application is filed. There are two types of drawings:

(a) *Standard character (typed) drawing.* Applicants who seek to register words, letters, numbers, or any combination thereof without claim to any particular font style, size, or color must submit a standard character drawing that shows the mark in black on a white background. An applicant may submit a standard character drawing if:

(1) The application includes a statement that the mark is in standard characters and no claim is made to any particular font style, size, or color;

(2) The mark does not include a design element;

(3) All letters and words in the mark are depicted in Latin characters;

(4) All numerals in the mark are depicted in Roman or Arabic numerals; and

(5) The mark includes only common punctuation or diacritical marks.

(b) *Special form drawing.* Applicants who seek to register a mark that includes a two or three-dimensional design; color; and/or words, letters, or numbers or the combination thereof in a particular font style or size must submit a special form drawing. The drawing should show the mark in black on a white background, unless the mark includes color.

(1) *Marks that include color.* If the mark includes color, the drawing must show the mark in color, and the applicant must name the color(s), describe where the color(s) appear on the mark, and submit a claim that the color(s) is a feature of the mark.

(2) *Three dimensional marks.* If the mark has three-dimensional features, the drawing must depict a single rendition of the mark, and the applicant must indicate that the mark is three-dimensional.

(3) *Motion marks.* If the mark has motion, the drawing may depict a single point in the movement, or the drawing may depict up to five freeze frames showing various points in the movement, whichever best depicts the commercial impression of the mark. The applicant must also describe the mark.

(4) *Broken lines to show placement.* If necessary to adequately depict the commercial impression of the mark,

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the applicant may be required to submit a drawing that shows the placement of the mark by surrounding the mark with a proportionately accurate broken-line representation of the particular goods, packaging, or advertising on which the mark appears. The applicant must also use broken lines to show any other matter not claimed as part of the mark. For any drawing using broken lines to indicate placement of the mark, or matter not claimed as part of the mark, the applicant must describe the mark and explain the purpose of the broken lines.

(5) *Description of mark.* A description of the mark must be included.

(c) *TEAS drawings.* A drawing filed through TEAS must meet the requirements of §2.53.

(d) *Paper drawings.* A paper drawing must meet the requirements of §2.54.

(e) *Sound, scent, and non-visual marks.* An applicant is not required to submit a drawing if the mark consists only of a sound, a scent, or other completely non-visual matter. For these types of marks, the applicant must submit a detailed description of the mark.

[68 FR 55763, Sept. 26, 2003, as amended at 73 FR 13784, Mar. 14, 2008; 73 FR 67769, Nov. 17, 2008]

§2.53 Requirements for drawings filed through the TEAS.

The drawing must meet the requirements of §2.52. In addition, in a TEAS submission, the drawing must meet the following requirements:

(a) *Standard character drawings.* If an applicant seeks registration of a standard character mark, the applicant must enter the mark in the appropriate field on the TEAS form, and check the box to claim that the mark consists of standard characters.

(b) *Special form drawings:* If an applicant is filing a special form drawing, the applicant must attach a digitized image of the mark to the TEAS submission that meets the requirements of paragraph (c) of this section.

(c) *Requirements for digitized image:* The image must be in .jpg format and scanned at no less than 300 dots per inch and no more than 350 dots per inch with a length and width of no less than 250 pixels and no more than 944 pixels. All lines must be clean, sharp and

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solid, not fine or crowded, and produce a high quality image when copied.

[68 FR 55764, Sept. 26, 2003, as amended at 70 FR 38774, July 6, 2005; 73 FR 67769, Nov. 17, 2008]

§2.54 Requirements for drawings submitted on paper.

The drawing must meet the requirements of §2.52. In addition, in a paper submission, the drawing should:

(a) Be on non-shiny white paper that is separate from the application;

(b) Be on paper that is 8 to 8.5 inches (20.3 to 21.6 cm.) wide and 11 to 11.69 inches (27.9 to 29.7 cm.) long. One of the shorter sides of the sheet should be regarded as its top edge. The image must be no larger than 3.15 inches (8 cm) high by 3.15 inches (8 cm) wide;

(c) Include the caption “DRAWING PAGE” at the top of the drawing beginning one inch (2.5 cm.) from the top edge; and

(d) Depict the mark in black ink, or in color if color is claimed as a feature of the mark.

(e) Drawings must be typed or made with a pen or by a process that will provide high definition when copied. A photolithographic, printer’s proof copy, or other high quality reproduction of the mark may be used. All lines must be clean, sharp and solid, and must not be fine or crowded.

[68 FR 55764, Sept. 26, 2003]

§2.56 Specimens.

(a) An application under section 1(a) of the Act, an amendment to allege use under §2.76, and a statement of use under §2.88 must each include one specimen per class showing the mark as used on or in connection with the goods or services. When requested by the Office as reasonably necessary to proper examination, additional specimens must be provided.

(b)(1) A trademark specimen is a label, tag, or container for the goods, or a display associated with the goods. The Office may accept another document related to the goods or the sale of the goods when it is impracticable to place the mark on the goods, packaging for the goods, or displays associated with the goods.

(2) A service mark specimen must show the mark as used in the sale or advertising of the services.

(3) A collective trademark or collective service mark specimen must show how a member uses the mark on the member's goods or in the sale or advertising of the member's services.

(4) A collective membership mark specimen must show use by members to indicate membership in the collective organization.

(5) A certification mark specimen must show how a person other than the owner uses the mark to reflect certification of regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of that person's goods or services; or that members of a union or other organization performed the work or labor on the goods or services.

(c) A photocopy or other reproduction of a specimen of the mark as used on or in connection with the goods, or in the sale or advertising of the services, is acceptable. However, a photocopy of the drawing required by § 2.51 is not a proper specimen.

(d)(1) The specimen should be flat, and not larger than 8½ inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long. If a specimen of this size is not available, the applicant may substitute a suitable photograph or other facsimile.

(2) If the applicant files a specimen exceeding these size requirements (a "bulky specimen"), the Office will create a digital facsimile of the specimen that meets the requirements of the rule (*i.e.*, is flat and no larger than 8½ inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long) and put it in the record. The Office may destroy the original bulky specimen.

(3) In the absence of non-bulky alternatives, a specimen of use in another appropriate medium may be designated as acceptable by the Office.

(4) For a TEAS submission, the specimen must be a digitized image in .jpg or .pdf format.

[64 FR 48921, Sept. 8, 1999, as amended at 68 FR 55764, Sept. 26, 2003; 73 FR 67769, Nov. 17, 2008; 77 FR 30207, May 22, 2012; 80 FR 33183, June 11, 2015]

§§ 2.57–2.58 [Reserved]

§ 2.59 Filing substitute specimen(s).

(a) In an application under section 1(a) of the Act, the applicant may submit substitute specimens of the mark as used on or in connection with the goods or in the sale or advertising of the services, or as used to indicate membership in the collective organization. The applicant must submit a verified statement that the substitute specimen was in use in commerce at least as early as the filing date of the application. The verified statement is not required if the specimen is a duplicate or facsimile of a specimen already of record in the application.

(b) In an application under section 1(b) of the Act, after filing either an amendment to allege use under § 2.76 or a statement of use under § 2.88, the applicant may submit substitute specimens of the mark as used on or in connection with the goods or in the sale or advertising of the services, or as used to indicate membership in the collective organization. If the applicant submits substitute specimen(s), the applicant must:

(1) For an amendment to allege use under § 2.76, submit a verified statement that the substitute specimen(s) was in use in commerce prior to filing the amendment to allege use.

(2) For a statement of use under § 2.88, submit a verified statement that the substitute specimen(s) was in use in commerce either prior to filing the statement of use or prior to the expiration of the deadline for filing the statement of use.

[80 FR 33183, June 11, 2015]

EXAMINATION OF APPLICATION AND
ACTION BY APPLICANTS

AUTHORITY: Secs. 2.61 to 2.69 also issued under sec. 12, 60 Stat. 432; 15 U.S.C. 1062.

§ 2.61 Action by examiner.

(a) Applications for registration, including amendments to allege use under section 1(c) of the Act, and statements of use under section 1(d) of the Act, will be examined and, if the applicant is found not entitled to registration for any reason, applicant will be notified and advised of the reasons

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therefor and of any formal requirements or objections.

(b) The Office may require the applicant to furnish such information, exhibits, affidavits or declarations, and such additional specimens as may be reasonably necessary to the proper examination of the application.

(c) Whenever it shall be found that two or more parties whose interests are in conflict are represented by the same attorney, each party and also the attorney shall be notified of this fact.

[30 FR 13193, Oct. 16, 1965, as amended at 37 FR 2880, Feb. 9, 1972; 54 FR 37592, Sept. 11, 1989; 77 FR 30207, May 22, 2012]

§ 2.62 Procedure for filing response.

(a) *Deadline.* The applicant's response to an Office action must be received within six months from the date of issuance.

(b) *Signature.* The response must be signed by the applicant, someone with legal authority to bind the applicant (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(2).

(c) *Form.* Responses must be filed through TEAS, transmitted by facsimile, mailed, or delivered by hand, as set out in § 2.190(a). Responses sent via email will not be accorded a date of receipt.

[73 FR 67769, Nov. 17, 2008, as amended at 74 FR 54908, Oct. 26, 2009; 80 FR 2310, Jan. 16, 2015]

§ 2.63 Action after response.

(a) *Repeated non-final refusal or requirement.* After response by the applicant, the examining attorney will review all statutory refusals and/or requirement(s) in light of the response.

(1) If, after review of the applicant's response, the examining attorney issues a non-final action that maintains any previously issued substantive refusal(s) to register or repeats any requirement(s), the applicant may submit a timely response to the action under § 2.62(a).

(2) If, after review of the applicant's response, the examining attorney issues a non-final action that contains no substantive refusals to register, but maintains any requirement(s), the ap-

plicant may respond to such repeated requirement(s) by filing a timely petition to the Director for relief from the repeated requirement(s) if the subject matter of the repeated requirement(s) is appropriate for petition to the Director (*see* § 2.146(b)).

(b) *Final refusal or requirement.* Upon review of a response, the examining attorney may state that the refusal(s) to register, or the requirement(s), is final.

(1) If the examining attorney issues a final action that maintains any substantive refusal(s) to register, the applicant may respond by timely filing:

(i) A request for reconsideration under paragraph (b)(3) of this section that seeks to overcome any substantive refusal(s) to register, and comply with any outstanding requirement(s), maintained in the final action; or

(ii) An appeal to the Trademark Trial and Appeal Board under §§ 2.141 and 2.142.

(2) If the examining attorney issues a final action that contains no substantive refusals to register, but maintains any requirement(s), the applicant may respond by timely filing:

(i) A request for reconsideration under paragraph (b)(3) of this section that seeks to comply with any outstanding requirement(s) maintained in the final action;

(ii) An appeal of the requirement(s) to the Trademark Trial and Appeal Board under §§ 2.141 and 2.142; or

(iii) A petition to the Director under § 2.146 to review the requirement(s), if the subject matter of the requirement(s) is procedural, and therefore appropriate for petition.

(3) Prior to the expiration of the time for filing an appeal or a petition, the applicant may file a request for reconsideration of the final action that seeks to overcome any substantive refusal(s) and/or comply with any outstanding requirement(s). Filing a request for reconsideration does not stay or extend the time for filing an appeal or petition. The Office will enter amendments accompanying requests for reconsideration after final action if the amendments comply with the rules of practice in trademark cases and the Act.

(4) Filing a request for reconsideration that does not result in the withdrawal of all refusals and requirements, without the filing of a timely appeal or petition, will result in abandonment of the application for incomplete response, pursuant to § 2.65(a).

(c) If a petition to the Director under § 2.146 is denied, the applicant will have six months from the date of issuance of the Office action that repeated the requirement(s), or made it final, or thirty days from the date of the decision on the petition, whichever date is later, to comply with the requirement(s). A requirement that is the subject of a petition decided by the Director subsequently may not be the subject of an appeal to the Trademark Trial and Appeal Board.

(d) If an applicant in an application under section 1(b) of the Act files an amendment to allege use under § 2.76 during the six-month response period after issuance of a final action, the examining attorney will examine the amendment. The filing of such an amendment does not stay or extend the time for filing an appeal or petition.

[80 FR 2310, Jan. 16, 2015]

§ 2.64 Reinstatement of applications and registrations abandoned, cancelled, or expired due to Office error.

(a) *Request for Reinstatement of an Abandoned Application.* The applicant may file a written request to reinstate an application abandoned due to Office error. There is no fee for a request for reinstatement.

(1) *Deadline.* The applicant must file the request by not later than:

(i) Two months after the issue date of the notice of abandonment; or

(ii) Two months after the date of actual knowledge of the abandonment and not later than six months after the date the trademark electronic records system indicates that the application is abandoned, where the applicant declares under § 2.20 or 28 U.S.C. 1746 that it did not receive the notice of abandonment.

(2) *Requirements.* A request to reinstate an application abandoned due to Office error must include:

(i) Proof that a response to an Office action, a statement of use, or a request

for extension of time to file a statement of use was timely filed and a copy of the relevant document;

(ii) Proof of actual receipt by the Office of a response to an Office action, a statement of use, or a request for extension of time to file a statement of use and a copy of the relevant document;

(iii) Proof that the Office processed a fee in connection with the filing at issue and a copy of the relevant document;

(iv) Proof that the Office sent the Office action or notice of allowance to an address that is not the designated correspondence address; or

(v) Other evidence, or factual information supported by a declaration under § 2.20 or 28 U.S.C. 1746, demonstrating Office error in abandoning the application.

(b) *Request for Reinstatement of Cancelled or Expired Registration.* The registrant may file a written request to reinstate a registration cancelled or expired due to Office error. There is no fee for the request for reinstatement.

(1) *Deadline.* The registrant must file the request by not later than:

(i) Two months after the issue date of the notice of cancellation/expiration; or

(ii) Where the registrant has timely filed an affidavit of use or excusable non-use under section 8 or 71 of the Act, or a renewal application under section 9 of the Act, two months after the date of actual knowledge of the cancellation/expiration and not later than six months after the date the trademark electronic records system indicates that the registration is cancelled/expired, where the registrant declares under § 2.20 or 28 U.S.C. 1746 that it did not receive the notice of cancellation/expiration or where the Office did not issue a notice.

(2) *Requirements.* A request to reinstate a registration cancelled/expired due to Office error must include:

(i) Proof that an affidavit or declaration of use or excusable nonuse, a renewal application, or a response to an Office action was timely filed and a copy of the relevant document;

(ii) Proof of actual receipt by the Office of an affidavit or declaration of use

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or excusable nonuse, a renewal application, or a response to an Office action and a copy of the relevant document;

(iii) Proof that the Office processed a fee in connection with the filing at issue and a copy of the relevant document;

(iv) Proof that the Office sent the Office action to an address that is not the designated correspondence address; or

(v) Other evidence, or factual information supported by a declaration under § 2.20 or 28 U.S.C. 1746, demonstrating Office error in cancelling/ expiring the registration.

(c) *Request for Reinstatement May be Construed as Petition.* If an applicant or registrant is not entitled to reinstatement, a request for reinstatement may be construed as a petition to the Director under § 2.146 or a petition to revive under § 2.66, if appropriate. If the applicant or registrant is unable to meet the timeliness requirement under paragraphs (a)(1) or (b)(1) of this section for filing the request, the applicant or registrant may submit a petition to the Director under § 2.146(a)(5) to request a waiver of the rule.

[82 FR 29407, June 29, 2017]

§ 2.65 Abandonment.

(a) An application will be abandoned if an applicant fails to respond to an Office action, or to respond completely, within six months from the date of issuance. A timely petition to the Director pursuant to §§ 2.63(a) and (b) and 2.146 or notice of appeal to the Trademark Trial and Appeal Board pursuant to § 2.142, if appropriate, is a response that avoids abandonment (*see* § 2.63(b)(4)).

(1) If all refusals and/or requirements are expressly limited to certain goods and/or services, the application will be abandoned only as to those goods and/or services.

(2) When a timely response by the applicant is a bona fide attempt to advance the examination of the application and is a substantially complete response to the examining attorney's action, but consideration of some matter or compliance with a requirement has been omitted, the examining attorney may grant the applicant thirty days, or to the end of the response period set forth in the action to which the sub-

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stantially complete response was submitted, whichever is longer, to explain and supply the omission before the examining attorney considers the question of abandonment.

(b) An application will be abandoned if an applicant expressly abandons the application pursuant to § 2.68.

(c) An application will be abandoned if an applicant in an application under section 1(b) of the Act fails to timely file either a statement of use under § 2.88 or a request for an extension of time for filing a statement of use under § 2.89.

[80 FR 2311, Jan. 16, 2015]

§ 2.66 Revival of applications abandoned in full or in part due to unintentional delay.

(a) *Deadline.* The applicant may file a petition to revive an application abandoned in full or in part because the applicant did not timely respond to an Office action or notice of allowance, if the delay was unintentional. The applicant must file the petition by not later than:

(1) Two months after the issue date of the notice of abandonment in full or in part; or

(2) Two months after the date of actual knowledge of the abandonment and not later than six months after the date the trademark electronic records system indicates that the application is abandoned in full or in part, where the applicant declares under § 2.20 or 28 U.S.C. 1746 that it did not receive the notice of abandonment.

(b) *Petition To Revive Application Abandoned in Full or in Part for Failure To Respond to an Office Action.* A petition to revive an application abandoned in full or in part because the applicant did not timely respond to an Office action must include:

(1) The petition fee required by § 2.6;

(2) A statement, signed by someone with firsthand knowledge of the facts, that the delay in filing the response on or before the due date was unintentional; and

(3) A response to the Office action, signed pursuant to § 2.193(e)(2), or a statement that the applicant did not receive the Office action or the notification that an Office action issued. If

the applicant asserts that the unintentional delay is based on non-receipt of an Office action or notification, the applicant may not assert non-receipt of the same Office action or notification in a subsequent petition. When the abandonment is after a final Office action, the response is treated as a request for reconsideration under § 2.63(b)(3) and the applicant must also file:

(i) A notice of appeal to the Trademark Trial and Appeal Board under § 2.141 or a petition to the Director under § 2.146, if permitted by § 2.63(b)(2)(iii); or

(ii) A statement that no appeal or petition is being filed from the final refusal(s) or requirement(s).

(c) *Petition To Revive Application Abandoned for Failure To Respond to a Notice of Allowance.* A petition to revive an application abandoned because the applicant did not timely respond to a notice of allowance must include:

(1) The petition fee required by § 2.6;

(2) A statement, signed by someone with firsthand knowledge of the facts, that the delay in filing the statement of use (or request for extension of time to file a statement of use) on or before the due date was unintentional; and one of the following:

(i) A statement of use under § 2.88, signed pursuant to § 2.193(e)(1), and the required fees for the number of requests for extensions of time to file a statement of use that the applicant should have filed under § 2.89 if the application had never been abandoned;

(ii) A request for an extension of time to file a statement of use under § 2.89, signed pursuant to § 2.193(e)(1), and the required fees for the number of requests for extensions of time to file a statement of use that the applicant should have filed under § 2.89 if the application had never been abandoned;

(iii) A statement that the applicant did not receive the notice of allowance and a request to cancel said notice and issue a new notice. If the applicant asserts that the unintentional delay in responding is based on non-receipt of the notice of allowance, the applicant may not assert non-receipt of the notice of allowance in a subsequent petition; or

(iv) In a multiple-basis application, an amendment, signed pursuant to § 2.193(e)(2), deleting the section 1(b) basis and seeking registration based on section 1(a) and/or section 44(e) of the Act.

(3) The applicant must file any further requests for extensions of time to file a statement of use under § 2.89 that become due while the petition is pending, or file a statement of use under § 2.88.

(d) *Statement of Use or Petition To Substitute a Basis May Not Be Filed More Than 36 Months After Issuance of the Notice of Allowance.* In an application under section 1(b) of the Act, the Director will not grant a petition under this section if doing so would permit an applicant to file a statement of use, or a petition under § 2.35(b) to substitute a basis, more than 36 months after the issue date of the notice of allowance under section 13(b)(2) of the Act.

(e) *Request for Reconsideration.* If the Director denies a petition to revive under this section, the applicant may request reconsideration, if:

(1) The applicant files the request by not later than:

(i) Two months after the issue date of the decision denying the petition; or

(ii) Two months after the date of actual knowledge of the decision denying the petition and not later than six months after the issue date of the decision where the applicant declares under § 2.20 or 28 U.S.C. 1746 that it did not receive the decision; and

(2) The applicant pays a second petition fee under § 2.6.

[82 FR 29408, June 29, 2017]

§ 2.67 Suspension of action by the Patent and Trademark Office.

Action by the Patent and Trademark Office may be suspended for a reasonable time for good and sufficient cause. The fact that a proceeding is pending before the Patent and Trademark Office or a court which is relevant to the issue of registrability of the applicant's mark, or the fact that the basis for registration is, under the provisions of section 44(e) of the Act, registration of the mark in a foreign country and the foreign application is still pending, will be considered prima facie good and sufficient cause. An applicant's request

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for a suspension of action under this section filed within the 6-month response period (see § 2.62) may be considered responsive to the previous Office action. The first suspension is within the discretion of the Examiner of Trademarks and any subsequent suspension must be approved by the Director.

[37 FR 3898, Feb. 24, 1972]

§ 2.68 Express abandonment (withdrawal) of application.

(a) *Written document required.* An applicant may expressly abandon an application by filing a written request for abandonment or withdrawal of the application, signed by the applicant, someone with legal authority to bind the applicant (*e.g.*, a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(2). A request for abandonment or withdrawal may not subsequently be withdrawn.

(b) *Rights in the mark not affected.* Except as provided in § 2.135, the fact that an application has been expressly abandoned shall not affect any rights that the applicant may have in the mark set forth in the abandoned application in any proceeding before the Office.

[80 FR 2311, Jan. 16, 2015]

§ 2.69 Compliance with other laws.

When the sale or transportation of any product for which registration of a trademark is sought is regulated under an Act of Congress, the Patent and Trademark Office may make appropriate inquiry as to compliance with such Act for the sole purpose of determining lawfulness of the commerce recited in the application.

[54 FR 37592, Sept. 11, 1989]

AMENDMENT OF APPLICATION

§ 2.71 Amendments to correct informalities.

The applicant may amend the application during the course of examination, when required by the Office or for other reasons.

(a) The applicant may amend the application to clarify or limit, but not to

broaden, the identification of goods and/or services or the description of the nature of the collective membership organization.

(b)(1) If the verified statement in an application under § 2.33 is unsigned or signed by the wrong party, the applicant may submit a substitute verification.

(2) If the verified statement in a statement of use under § 2.88, or a request for extension of time to file a statement of use under § 2.89, is unsigned or signed by the wrong party, the applicant must submit a substitute verification before the expiration of the statutory deadline for filing the statement of use.

(c) The applicant may amend the dates of use, provided that the amendment is verified, except that the following amendments are *not* permitted:

(1) In an application under section 1(a) of the Act, the applicant may not amend the application to specify a date of use that is subsequent to the filing date of the application;

(2) In an application under section 1(b) of the Act, after filing a statement of use under § 2.88, the applicant may not amend the statement of use to specify a date of use that is subsequent to the expiration of the deadline for filing the statement of use.

(d) The applicant may amend the application to correct the name of the applicant, if there is a mistake in the manner in which the name of the applicant is set out in the application. The amendment must be verified. However, the application cannot be amended to set forth a different entity as the applicant. An application filed in the name of an entity that did not own the mark as of the filing date of the application is void.

(e) An amendment that would materially alter the certification statement specified in § 2.45(a)(4)(i)(A) or (a)(4)(ii)(A) will not be permitted.

[64 FR 48922, Sept. 8, 1999, as amended at 80 FR 33184, June 11, 2015]

§ 2.72 Amendments to description or drawing of the mark.

(a) In an application based on use in commerce under section 1(a) of the

Act, the applicant may amend the description or drawing of the mark only if:

(1) The specimens originally filed, or substitute specimens filed under § 2.59(a), support the proposed amendment; and

(2) The proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application.

(b) In an application based on a bona fide intention to use a mark in commerce under section 1(b) of the Act, the applicant may amend the description or drawing of the mark only if:

(1) The specimens filed with an amendment to allege use or statement of use, or substitute specimens filed under § 2.59(b), support the proposed amendment; and

(2) The proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application.

(c) In an application based on a claim of priority under section 44(d) of the Act, or on a mark duly registered in the country of origin of the foreign applicant under section 44(e) of the Act, the applicant may amend the description or drawing of the mark only if:

(1) The description or drawing of the mark in the foreign registration certificate supports the amendment; and

(2) The proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application.

[64 FR 48922, Sept. 8, 1999]

§ 2.73 Amendment to recite concurrent use.

An application that includes section 1(a) of the Trademark Act as a filing basis, or for which an acceptable allegation of use under § 2.76 or § 2.88 has

been filed, may be amended to an application for concurrent use registration, provided that the application as amended meets the requirements of § 2.42. The trademark examining attorney will determine whether the application, as amended, is acceptable.

[73 FR 67770, Nov. 17, 2008]

§ 2.74 Form and signature of amendment.

(a) *Form of Amendment.* Amendments should be set forth clearly and completely. Applicant should either set forth the entire wording, including the proposed changes, or, if it would be more efficient, indicate which words should be added and which words should be deleted. The examining attorney may require the applicant to rewrite the entire amendment, if necessary for clarification of the record.

(b) *Signature.* A request for amendment of an application must be signed by the applicant, someone with legal authority to bind the applicant (*e.g.*, a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(2). If the amendment requires verification, see § 2.2(n).

[73 FR 67770, Nov. 17, 2008, as amended at 74 FR 54908, Oct. 26, 2009; 80 FR 33184, June 11, 2015]

§ 2.75 Amendment to change application to different register.

(a) An application for registration on the Principal Register under section 1(a) or 44 of the Act may be changed to an application for registration on the Supplemental Register and vice versa by amending the application to comply with the rules relating to the appropriate register, as the case may be.

(b) An application under section 1(b) of the Act may be amended to change the application to a different register only after submission of an acceptable amendment to allege use under § 2.76 or statement of use under § 2.88. When such an application is changed from the Principal Register to the Supplemental Register, the effective filing date of the application is the date of the filing of the allegation of use under section 1(c) or 1(d) of the Act.

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(c) In an application under section 66(a) of the Act, the applicant may not amend the application to the Supplemental Register.

[54 FR 37593, Sept. 11, 1989, as amended at 68 FR 55765, Sept. 26, 2003]

§ 2.76 Amendment to allege use.

(a) *When to file an amendment to allege use.* (1) An application under section 1(b) of the Act may be amended to allege use of the mark in commerce under section 1(c) of the Act at any time between the filing of the application and the date the examiner approves the mark for publication. Thereafter, an allegation of use may be submitted only as a statement of use under § 2.88 after the issuance of a notice of allowance under section 13(b)(2) of the Act. An amendment to allege use filed outside the time period specified in this paragraph will not be reviewed.

(2)(i) For a trademark, service mark, collective trademark, collective service mark, and certification mark, an amendment to allege use may be filed only when the mark has been in use in commerce on or in connection with all the goods or services specified in the application for which the applicant will seek registration. For a collective membership mark, an amendment to allege use may be filed only when the mark has been in use in commerce to indicate membership in the collective organization specified in the application for which the applicant will seek registration.

(ii) An amendment to allege use may be accompanied by a request in accordance with § 2.87 to divide out from the application the goods, services, or classes not yet in use in commerce.

(b) *A complete amendment to allege use.* A complete amendment to allege use must include the following:

(1) A verified statement alleging:

(i) The applicant believes the applicant is the owner of the mark;

(ii) The mark is in use in commerce;

(iii) The date of first use of the mark anywhere on or in connection with the goods or services, and/or to indicate membership in the collective organization specified in the application, and the date of first use of the mark in commerce. If the amendment to allege use specifies more than one item of

goods or services in a class, the dates of use are required for only one item of goods or services specified in that class;

(iv) The goods, services, and/or nature of the collective membership organization specified in the application; and

(v) For a collective mark and certification mark, the applicant is exercising legitimate control over the use in commerce of the mark.

(2) One specimen showing how the applicant, member, or authorized user uses the mark in commerce. See § 2.56 for the requirements for specimens;

(3) The fee per class required by § 2.6;

(4) For a collective mark, the requirements of § 2.44(a)(4)(i)(A);

(5) For a certification mark, the requirements of § 2.45(a)(4)(i)(A)–(C); and

(6) The title “Amendment to Allege Use” should appear at the top of the first page of the document, if not filed through TEAS.

(c) *Minimum filing requirements for a timely filed amendment to allege use.* The Office will review a timely filed amendment to allege use to determine whether it meets the following minimum requirements:

(1) The fee required by § 2.6 for at least one class;

(2) One specimen of the mark as used in commerce; and

(3) The verified statement in paragraph (b)(1)(ii) of this section.

(d) *Deficiency notification.* If the amendment to allege use is filed within the permitted time period but does not meet the minimum requirements specified in paragraph (c) of this section, the Office will notify the applicant of the deficiency. The deficiency may be corrected provided the mark has not been approved for publication. If an acceptable amendment to correct the deficiency is not filed prior to approval of the mark for publication, the amendment will not be examined, and the applicant must instead file a statement of use after the notice of allowance issues.

(e) *Notification of refusals and requirements.* A timely filed amendment to allege use that meets the minimum requirements specified in paragraph (c) of this section will be examined in accordance with §§ 2.61 through 2.69. If, as

a result of the examination of the amendment to allege use, the applicant is found not entitled to registration for any reason not previously stated, the applicant will be notified and advised of the reasons and of any formal requirements or refusals. The notification shall restate or incorporate by reference all unresolved refusals or requirements previously stated. The amendment to allege use may be amended in accordance with §§ 2.59 and 2.71 through 2.75.

(f) *Withdrawal.* An amendment to allege use may be withdrawn for any reason prior to approval of a mark for publication.

(g) *Verification not filed within reasonable time.* If the verified statements in paragraphs (b)(1)(ii) and, if applicable, (b)(1)(v) of this section are not filed within a reasonable time after they are signed, the Office may require the applicant to submit substitute verified statements attesting that the mark is in use in commerce, and, if applicable, the applicant is exercising legitimate control over the use of the mark in commerce.

(h) *An amendment to allege use is not a response but may include amendments.* The filing of an amendment to allege use does not constitute a response to any outstanding action by the examiner. See § 2.62. The amendment to allege use may include amendments in accordance with §§ 2.59 and 2.71 through 2.75.

(i) *If the application is amended to concurrent use under § 2.73,* the amendment to allege use must include a verified statement modified in accordance with § 2.33(f), § 2.44(d), or § 2.45(d).

(j) *Multiple-class application.* For the requirements of a multiple-class application, see § 2.86.

[80 FR 33184, June 11, 2015]

§ 2.77 Amendments between notice of allowance and statement of use.

(a) The only amendments that may be entered in an application between the issuance of the notice of allowance and the submission of a statement of use are:

(1) The deletion of specified goods or services, or the entire description of the nature of the collective member-

ship organization, from the identification;

(2) The deletion of a basis in a multiple-basis application; and

(3) A change of attorney or change of address.

(b) Other amendments may be entered during this period only with the express permission of the Director, after consideration on petition under § 2.146. If the Director determines that the amendment requires review by the examining attorney, the petition will be denied and the amendment may be resubmitted with the statement of use in order for the applicant to preserve its right to review.

[73 FR 67770, Nov. 17, 2008, as amended at 80 FR 2311, Jan. 16, 2015; 80 FR 33185, June 11, 2015]

PUBLICATION AND POST PUBLICATION

§ 2.80 Publication for opposition.

If, on examination or reexamination of an application for registration on the Principal Register, it appears that the applicant is entitled to have his mark registered, the mark will be published in the *Official Gazette* for opposition. The mark will also be published in the case of an application to be placed in interference or concurrent use proceedings, if otherwise registrable.

[41 FR 758, Jan. 5, 1976]

§ 2.81 Post publication.

(a) Except in an application under section 1(b) of the Act for which no amendment to allege use under § 2.76 has been submitted and accepted, if no opposition is filed within the time permitted or all oppositions filed are dismissed, and if no interference is declared and no concurrent use proceeding is instituted, the application will be prepared for issuance of the certificate of registration as provided in § 2.151.

(b) In an application under section 1(b) of the Act for which no amendment to allege use under § 2.76 has been submitted and accepted, if no opposition is filed within the time permitted or all oppositions filed are dismissed, and if no interference is declared, a notice of allowance will issue. Thereafter, the

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applicant must submit a statement of use as provided in § 2.88.

[54 FR 37594, Sept. 11, 1989, as amended at 73 FR 67770, Nov. 17, 2008; 80 FR 2311, Jan. 16, 2015]

§ 2.82 Marks on Supplemental Register published only upon registration.

In the case of an application for registration on the Supplemental Register the mark will not be published for opposition but if it appears, after examination or reexamination, that the applicant is entitled to have the mark registered, a certificate of registration will issue as provided in § 2.151. The mark will be published in the *Official Gazette* when registered.

[54 FR 37594, Sept. 11, 1989]

§ 2.83 Conflicting marks.

(a) Whenever an application is made for registration of a mark which so resembles another mark or marks pending registration as to be likely to cause confusion or mistake or to deceive, the mark with the earliest effective filing date will be published in the *Official Gazette* for opposition if eligible for the Principal Register, or issued a certificate of registration if eligible for the Supplemental Register.

(b) In situations in which conflicting applications have the same effective filing date, the application with the earliest date of execution will be published in the *Official Gazette* for opposition or issued on the Supplemental Register.

(c) Action on the conflicting application which is not published in the *Official Gazette* for opposition or not issued on the Supplemental Register will be suspended by the Examiner of Trademarks until the published or issued application is registered or abandoned.

[37 FR 2880, Feb. 9, 1972, as amended at 54 FR 37594, Sept. 11, 1989]

§ 2.84 Jurisdiction over published applications.

(a) The trademark examining attorney may exercise jurisdiction over an application up to the date the mark is published in the *Official Gazette*. After publication of an application under section 1(a), 44 or 66(a) of the Act, the trademark examining attorney may,

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with the permission of the Director, exercise jurisdiction over the application. After publication of an application under section 1(b) of the Act, the trademark examining attorney may exercise jurisdiction over the application after the issuance of the notice of allowance under section 13(b)(2) of the Act. After publication, and prior to issuance of a notice of allowance in an application under section 1(b), the trademark examining attorney may, with the permission of the Director, exercise jurisdiction over the application.

(b) After publication, but before the certificate of registration is issued in an application under section 1(a), 44, or 66(a) of the Act, or before the notice of allowance is issued in an application under section 1(b) of the Act, an application that is not the subject of an *inter partes* proceeding before the Trademark Trial and Appeal Board may be amended if the amendment meets the requirements of §§ 2.71, 2.72, and 2.74. Otherwise, an amendment to such an application may be submitted only upon petition to the Director to restore jurisdiction over the application to the examining attorney for consideration of the amendment and further examination. The amendment of an application that is the subject of an *inter partes* proceeding before the Trademark Trial and Appeal Board is governed by § 2.133.

[68 FR 55765, Sept. 26, 2003, as amended at 73 FR 67770, Nov. 17, 2008; 80 FR 2311, Jan. 16, 2015]

CLASSIFICATION

§ 2.85 Classification schedules.

(a) *International classification system.* Section 6.1 of this chapter sets forth the international system of classification for goods and services, which applies for all statutory purposes to:

(1) Applications filed in the Office on or after September 1, 1973, and resulting registrations; and

(2) Registrations resulting from applications filed on or before August 31, 1973, that have been amended to adopt international classification pursuant to § 2.85(e)(3).

(b) *Prior United States classification system.* Section 6.2 of this chapter sets forth the prior United States system of

classification for goods and services, which applies for all statutory purposes to registrations resulting from applications filed on or before August 31, 1973, unless:

(1) The registration has been amended to adopt international classification pursuant to § 2.85(e)(3); or

(2) The registration was issued under a classification system prior to that set forth in § 6.2.

(c) *Certification marks and collective membership marks.* Sections 6.3 and 6.4 specify the system of classification which applies to certification marks and collective membership marks in applications based on sections 1 and 44 of the Act, and to registrations resulting from applications based on sections 1 and 44. These sections do not apply to applications under section 66(a) or to registered extensions of protection.

(d) *Section 66(a) applications and registered extensions of protection.* In an application under section 66(a) of the Act or registered extension of protection, the classification cannot be changed from the classification assigned by the International Bureau of the World Intellectual Property Organization, unless the International Bureau corrects the classification. Classes cannot be added, and goods or services cannot be transferred from one class to another in a multiple-class application.

(e) *Changes to Nice Agreement.* The international classification system changes periodically, pursuant to the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks. These changes are listed in the *International Classification of Goods and Services for the Purposes of the Registration of Marks*, which is published by the World Intellectual Property Organization.

(1) If international classification changes pursuant to the Nice Agreement, the new classification applies only to applications filed on or after the effective date of the change.

(2) In a section 1 or section 44 application filed before the effective date of a change to the Nice Agreement, the applicant may amend the application to comply with the requirements of the current edition. The applicant must comply with the current edition for all

goods or services identified in the application. The applicant must pay the fees for any added class(es).

(3) In a registration resulting from a section 1 or section 44 application that was filed before the effective date of a change to the Nice Agreement, the owner may amend the registration to comply with the requirements of the current edition. The owner must reclassify all goods or services identified in the registration to the current edition. The owner must pay the fee required by § 2.6 for amendments under section 7 of the Act. The owner may reclassify registrations from multiple United States classes (§ 2.85(b)) into a single international classification, where appropriate.

(f) Classification schedules shall not limit or extend the applicant's rights, except that in a section 66(a) application, the scope of the identification of goods or services for purposes of permissible amendments (*see* § 2.71(a)) is limited by the class, pursuant to § 2.85(d).

[73 FR 67770, Nov. 17, 2008]

§ 2.86 Multiple-class applications.

(a) *In a single application for a trademark, service mark, and/or collective mark*, an applicant may apply to register the same mark for goods, services, and/or a collective membership organization in multiple classes. In a multiple-class application, the applicant must satisfy the following, in addition to the application requirements of § 2.32 for a trademark or service mark, and § 2.44 for collective marks:

(1) For an application filed under section 1 or 44 of the Act, identify the goods or services in each international class and/or the nature of the collective membership organization in U.S. Class 200; for applications filed under section 66(a) of the Act, identify the goods, services, and/or the nature of the collective membership organization in each international class assigned by the International Bureau in the corresponding international registration;

(2) Submit the application filing fee required by § 2.6 for each class; and

(3) Include either dates of use and one specimen for each class based on section 1(a) of the Act; or a statement

that the applicant has a bona fide intention to use the mark in commerce, for a trademark or service mark, or a statement that the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce, for collective marks, for each class based on section 1(b), 44, or 66(a) of the Act. When requested by the Office, additional specimens must be provided.

(b) *In a single application for a certification mark*, an applicant may apply to register the same certification mark for goods and services. In such case, the applicant must satisfy the following, in addition to the application requirements of §2.45:

(1) For an application filed under section 1 or 44 of the Act, identify the goods in U.S. Class A and the services in U.S. Class B; for applications filed under section 66(a) of the Act, identify the goods and services in each international class assigned by the International Bureau in the corresponding international registration;

(2) Submit the application filing fee required by §2.6 for both classes; and

(3) Include either dates of use and one specimen for each class based on section 1(a) of the Act; or a statement that the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce for each class based on section 1(b), 44, or 66(a) of the Act. When requested by the Office, additional specimens must be provided.

(c) In a single application, both section 1(a) and 1(b) of the Act may not be claimed for identical goods or services.

(d) In a single application based on section 1 or 44 of the Act, goods or services in U.S. Classes A and/or B may not be combined with either goods or services in any international class or with a collective membership organization in U.S. Class 200; and in a single application based on section 66(a) of the Act, a certification mark application may not be combined with goods, services, or a collective membership organization in any international class. *See* §2.45(f).

(e) An amendment to allege use under §2.76 or a statement of use under §2.88 for multiple classes must include, for each class, the required fee, dates of

use, and one specimen. When requested by the Office, additional specimens must be provided. The applicant may not file an amendment to allege use or a statement of use until the applicant has used the mark on or in connection with all the goods, services, or classes, unless the applicant also files a request to divide under §2.87.

(f) The Office will issue a single certificate of registration for the mark, unless the applicant files a request to divide under §2.87.

[80 FR 33185, June 11, 2015]

§2.87 Dividing an application.

(a) *Application may be divided.* An application may be divided into two or more separate applications upon the payment of a fee for each new application created and submission by the applicant of a request in accordance with paragraph (d) of this section.

(b) *Fee.* In the case of a request to divide out one or more entire classes from an application, only the fee for dividing an application as set forth in §2.6(a)(19) will be required. However, in the case of a request to divide out some, but not all, of the goods or services in a class, the applicant must submit the application filing fee as set forth in §2.6(a)(1) for each new separate application to be created by the division, in addition to the fee for dividing an application.

(c) *Time for filing.* (1) A request to divide an application may be filed at any time between the application filing date and the date on which the trademark examining attorney approves the mark for publication; or during an opposition, concurrent use, or interference proceeding, upon motion granted by the Trademark Trial and Appeal Board.

(2) In an application under section 1(b) of the Act, a request to divide may also be filed with a statement of use under §2.88 or at any time between the filing of a statement of use and the date on which the trademark examining attorney approves the mark for registration.

(3) In a multiple-basis application, a request to divide out goods or services having a particular basis may also be filed during the period between the issuance of the notice of allowance

under section 13(b)(2) of the Act and the filing of a statement of use under § 2.88.

(d) *Form.* A request to divide an application should be made in a separate document from any other amendment or response in the application. The title “Request to Divide Application” should appear at the top of the first page of the document.

(e) *Outstanding time periods apply to newly created applications.* Any time period for action by the applicant which is outstanding in the original application at the time of the division will apply to each separate new application created by the division, except as follows:

(1) If an Office action pertaining to less than all the classes in a multiple-class application is outstanding, and the applicant files a request to divide out the goods, services, and/or class(es) to which the Office action does not pertain before the response deadline, a response to the Office action is not due in the new (child) application(s) created by the division of the application;

(2) If an Office action pertaining to less than all the bases in a multiple-basis application is outstanding, and the applicant files a request to divide out the goods/services having the basis or bases to which the Office action does not pertain before the response deadline, a response to the Office action is not due in the new (child) application(s) created by the division of the application; or

(3) In a multiple-basis application in which a notice of allowance has issued, if the applicant files a request to divide out the goods/services having the basis or bases to which the notice of allowance does not pertain before the deadline for filing the statement of use, the new (child) applications created by the division are not affected by the notice of allowance.

(f) *Signature.* The request to divide must be signed by the applicant, someone with legal authority to bind the applicant (e.g., a corporate officer or general partner of a partnership), or a practitioner who meets the requirements of § 11.14, in accordance with the requirements of § 2.193(e)(2).

(g) *Section 66(a) applications—change of ownership with respect to some but not*

all of the goods or services. (1) When the International Bureau of the World Intellectual Property Organization notifies the Office that an international registration has been divided as the result of a change of ownership with respect to some but not all of the goods or services, the Office will construe the International Bureau’s notice as a request to divide. The Office will record the partial change of ownership in the Assignment Services Branch, and divide out the assigned goods/services from the original (parent) application. The Office will create a new (child) application serial number, and enter the information about the new application in its automated records.

(2) To obtain a certificate of registration in the name of the new owner for the goods/services that have been divided out, the new owner must pay the fee(s) for the request to divide, as required by § 2.6 and paragraph (b) of this section. The examining attorney will issue an Office action in the child application requiring the new owner to pay the required fee(s). If the owner of the child application fails to respond, the child application will be abandoned. It is not necessary for the new owner to file a separate request to divide.

(3) The Office will not divide a section 66(a) application based upon a change of ownership unless the International Bureau notifies the Office that the international registration has been divided.

[73 FR 67771, Nov. 17, 2008, as amended at 74 FR 54908, Oct. 26, 2009]

POST NOTICE OF ALLOWANCE

§ 2.88 Statement of use after notice of allowance.

(a) *When to file a statement of use.* (1) In an application under section 1(b) of the Act, a statement of use, required under section 1(d) of the Act, must be filed within six months after issuance of a notice of allowance under section 13(b)(2) of the Act, or within an extension of time granted under § 2.89. A statement of use filed prior to issuance of a notice of allowance is premature and will not be reviewed.

(2)(i) For a trademark, service mark, collective trademark, collective service mark, and certification mark, a statement of use may be filed only when the mark has been in use in commerce on or in connection with all the goods or services specified in the notice of allowance for which the applicant will seek registration in that application. For a collective membership mark, a statement of use may be filed only when the mark has been in use in commerce to indicate membership in the collective membership organization specified in the notice of allowance for which the applicant will seek registration in that application.

(ii) A statement of use may be accompanied by a request in accordance with § 2.87 to divide out from the application the goods, services, or classes not yet in use in commerce.

(b) *A complete statement of use.* A complete statement of use must include the following:

(1) A verified statement alleging:

(i) The applicant believes the applicant is the owner of the mark;

(ii) The mark is in use in commerce;

(iii) The date of first use of the mark anywhere on or in connection with the goods, services, and/or to indicate membership in the collective organization specified in the application, and the date of first use of the mark in commerce. If the statement of use specifies more than one item of goods or services in a class, the dates of use are required for only one item of goods or services specified in that class;

(iv) The goods, services, and/or nature of the collective membership organization specified in the notice of allowance. The goods or services specified in a statement of use must conform to those goods or services specified in the notice of allowance for trademark, service mark, collective trademark, collective service mark, or certification mark applications. Any goods or services specified in the notice of allowance that are omitted from the identification of goods or services in the statement of use will be presumed to be deleted and the deleted goods or services may not be reinserted in the application. For collective membership mark applications, the description of the nature of the collective member-

ship organization in the statement of use must conform to that specified in the notice of allowance; and

(v) For a collective mark and certification mark, the applicant is exercising legitimate control over the use in commerce of the mark;

(2) One specimen showing how the applicant, member, or authorized user uses the mark in commerce. See § 2.56 for the requirements for specimens;

(3) *Fee(s).* The fee required by § 2.6 per class. The applicant must pay a filing fee sufficient to cover at least one class within the statutory time for filing the statement of use, or the application will be abandoned. If the applicant submits a fee insufficient to cover all the classes in a multiple-class application, the applicant should specify the classes to be abandoned. If the applicant timely submits a fee sufficient to pay for at least one class, but insufficient to cover all the classes, and the applicant has not specified the class(es) to be abandoned, the Office will issue a notice granting the applicant additional time to submit the fee(s) for the remaining class(es) or to specify the class(es) to be abandoned. If the applicant does not submit the required fee(s) or specify the class(es) to be abandoned within the set time period, the Office will apply the fees paid, beginning with the lowest numbered class, in ascending order. The Office will delete the class(es) not covered by the fees submitted;

(4) For a collective mark, the requirements of § 2.44(a)(4)(i)(A);

(5) For a certification mark, the requirements of § 2.45(a)(4)(i)(A) through (C); and

(6) The title "Statement of Use" should appear at the top of the first page of the document, if not filed through TEAS.

(c) *Minimum filing requirements for a timely filed statement of use.* The Office will review a timely filed statement of use to determine whether it meets the following minimum requirements:

(1) The fee required by § 2.6 for at least one class;

(2) One specimen of the mark as used in commerce; and

(3) The verified statement in paragraph (b)(1)(ii) of this section. If this verified statement is unsigned or

signed by the wrong party, the applicant must submit a substitute verified statement on or before the statutory deadline for filing the statement of use.

(d) *Deficiency notification.* If the statement of use is filed within the permitted time period but does not meet the minimum requirements specified in paragraph (c) of this section, the Office will notify the applicant of the deficiency. If the time permitted for the applicant to file a statement of use has not expired, the applicant may correct the deficiency.

(e) *Notification of refusals and requirements.* A timely filed statement of use that meets the minimum requirements specified in paragraph (c) of this section will be examined in accordance with §§ 2.61 through 2.69. If, as a result of the examination of the statement of use, the applicant is found not entitled to registration, the applicant will be notified and advised of the reasons and of any formal requirements or refusals. The statement of use may be amended in accordance with §§ 2.59 and 2.71 through 2.75.

(f) *Statement of use may not be withdrawn.* The applicant may not withdraw a timely filed statement of use to return to the previous status of awaiting submission of a statement of use, regardless of whether it is in compliance with paragraph (c) of this section.

(g) *Verification not filed within reasonable time.* If the verified statements in paragraphs (b)(1)(ii) and, if applicable, (b)(1)(v) of this section are not filed within a reasonable time after they are signed, the Office may require the applicant to submit substitute verified statements attesting that the mark is in use in commerce, and, if applicable, the applicant is exercising legitimate control over the use of the mark in commerce.

(h) *Amending the application.* The statement of use may include amendments in accordance with §§ 2.51, 2.59, and 2.71 through 2.75.

(i) *Concurrent use.* If the application is amended to concurrent use under § 2.73, the statement of use must include a verified statement modified in accordance with § 2.33(f), § 2.44(d), or § 2.45(d).

(j) *Multiple-class application.* For the requirements of a multiple-class application, see § 2.86.

(k) *Abandonment.* The failure to timely file a statement of use which meets the minimum requirements specified in paragraph (c) of this section shall result in the abandonment of the application.

[80 FR 33185, June 11, 2015]

§ 2.89 Extensions of time for filing a statement of use.

(a) *First extension request after issuance of notice of allowance.* The applicant may request a six-month extension of time to file the statement of use required by § 2.88. The extension request must be filed within six months of the date of issuance of the notice of allowance under section 13(b)(2) of the Act and must include the following:

(1) A written request for an extension of time to file the statement of use;

(2) The fee required by § 2.6 per class. The applicant must pay a filing fee sufficient to cover at least one class within the statutory time for filing the extension request, or the request will be denied. If the applicant submits a fee insufficient to cover all the classes in a multiple-class application, the applicant should specify the classes to be abandoned. If the applicant timely submits a fee sufficient to pay for at least one class, but insufficient to cover all the classes, and the applicant has not specified the class(es) to be abandoned, the Office will issue a notice granting the applicant additional time to submit the fee(s) for the remaining classes, or specify the class(es) to be abandoned. If the applicant does not submit the required fee(s) or specify the class(es) to be abandoned within the set time period, the Office will apply the fees paid, beginning with the lowest numbered class, in ascending order. The Office will delete the class(es) not covered by the fees submitted; and

(3) A verified statement that the applicant has a continued bona fide intention to use the mark in commerce, specifying the relevant goods or services, for trademarks or service marks; or that the applicant has a continued bona fide intention, and is entitled, to exercise legitimate control over the

use of the mark in commerce, specifying the relevant goods, services, or collective membership organization, for collective marks or certification marks. If this verified statement is unsigned or signed by the wrong party, the applicant must submit a substitute verified statement within six months of the date of issuance of the notice of allowance.

(b) *Subsequent extension requests.* Before the expiration of the previously granted extension of time, the applicant may request further six-month extensions of time to file the statement of use by submitting the following:

(1) A written request for an extension of time to file the statement of use;

(2) The requirements of paragraph (a)(2) of this section for a fee;

(3) A verified statement that the applicant has a continued bona fide intention to use the mark in commerce, specifying the relevant goods or services, for trademarks or service marks; or that the applicant has a continued bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce, specifying the relevant goods, services, or collective membership organization, for collective marks or certification marks. If this verified statement is unsigned or signed by the wrong party, the applicant must submit a substitute verified statement before the expiration of the previously granted extension; and

(4) A showing of good cause, as specified in paragraph (d) of this section.

(c) *Four subsequent extension requests permitted.* Extension requests specified in paragraph (b) of this section will be granted only in six-month increments and may not aggregate more than 24 months total.

(d) *Good cause.* A showing of good cause must include:

(1) For a trademark or service mark, a statement of the applicant's ongoing efforts to make use of the mark in commerce on or in connection with each of the relevant goods or services. Those efforts may include product or service research or development, market research, manufacturing activities, promotional activities, steps to acquire distributors, steps to obtain governmental approval, or other similar ac-

tivities. In the alternative, the applicant must submit a satisfactory explanation for the failure to make efforts to use the mark in commerce.

(2) For a collective mark, a statement of ongoing efforts to make use of the mark in commerce by members on or in connection with each of the relevant goods or services or in connection with the applicant's collective membership organization. Those efforts may include the development of standards, the steps taken to acquire members such as marketing and promotional activities targeted to potential members, training members regarding the standards, or other similar activities. In the alternative, the applicant must submit a satisfactory explanation for the failure to make efforts for applicant's members to use the mark in commerce.

(3) For a certification mark, a statement of ongoing efforts to make use of the mark in commerce by authorized users on or in connection with each of the relevant goods or services. Those efforts may include the development of certification standards, steps taken to obtain governmental approval or acquire authorized users, marketing and promoting the recognition of the certification program or of the goods or services that meet the certification standards of the applicant, training authorized users regarding the standards, or other similar activities. In the alternative, the applicant must submit a satisfactory explanation for the failure to make efforts for applicant's authorized users to use the mark in commerce.

(e) *Extension request filed in conjunction with or after a statement of use.* (1) An applicant may file one request for a six-month extension of time for filing a statement of use when filing a statement of use or after filing a statement of use if time remains in the existing six-month period in which the statement of use was filed, provided that the time requested would not extend beyond 36 months from the date of issuance of the notice of allowance. Thereafter, applicant may not request any further extensions of time.

(2) A request for an extension of time that is filed under paragraph (e)(1) of this section, must comply with all the

requirements of paragraph (a) of this section, if it is an applicant's first extension request, or paragraph (b) of this section, if it is a second or subsequent extension request. However, in a request under paragraph (b) of this section, an applicant may satisfy the requirement for a showing of good cause by asserting the applicant believes the applicant has made valid use of the mark in commerce, as evidenced by the submitted statement of use, but that if the statement of use is found by the Office to be fatally defective, the applicant will need additional time in which to file a new statement of use.

(f) *Goods or services.* For trademark, service mark, collective trademark, collective service mark, or certification mark applications, the goods or services specified in a request for an extension of time for filing a statement of use must conform to those goods or services specified in the notice of allowance. Any goods or services specified in the notice of allowance that are omitted from the identification of goods or services in the request for extension of time will be presumed to be deleted and the deleted goods or services may not thereafter be reinserted in the application. For collective membership mark applications, the description of the nature of the collective membership organization in the request for extension of time must conform to that set forth in the notice of allowance.

(g) *Notice of grant or denial.* The applicant will be notified of the grant or denial of a request for an extension of time, and of the reasons for a denial. Failure to notify the applicant of the grant or denial of the request prior to the expiration of the existing period or requested extension does not relieve the applicant of the responsibility of timely filing a statement of use under § 2.88. If, after denial of an extension request, there is time remaining in the existing six-month period for filing a statement of use, applicant may submit a substitute request for extension of time to correct the defects of the prior request. Otherwise, the only recourse available after denial of a request for an extension of time is to file a petition to the Director in accordance with § 2.66 or § 2.146. A petition

from the denial of an extension request must be filed within two months of the date of issuance of the denial of the request. If the petition is granted, the term of the requested six-month extension that was the subject of the petition will run from the date of expiration of the previously existing six-month period for filing a statement of use.

(h) *Verification not filed within reasonable time.* If the verified statement in paragraph (a)(3) or (b)(3) of this section is not filed within a reasonable time after it is signed, the Office may require the applicant to submit a substitute verified statement attesting that the applicant has a continued bona fide intention to use the mark in commerce, for trademarks or service marks; or that the applicant has a continued bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce, for collective marks or certification marks.

[80 FR 33186, June 11, 2015]

INTERFERENCES AND CONCURRENT USE PROCEEDINGS

AUTHORITY: Secs. 2.91 to 2.99 also issued under secs. 16, 17, 60 Stat. 434; 15 U.S.C. 1066, 1067.

§ 2.91 Declaration of interference.

(a) An interference will not be declared between two applications or between an application and a registration except upon petition to the Director. Interferences will be declared by the Director only upon a showing of extraordinary circumstances which would result in a party being unduly prejudiced without an interference. In ordinary circumstances, the availability of an opposition or cancellation proceeding to the party will be deemed to remove any undue prejudice.

(b) Registrations and applications to register on the Supplemental Register, registrations under the Act of 1920, and registrations of marks the right to use of which has become incontestable are not subject to interference.

[37 FR 2881, Feb. 9, 1972, as amended at 54 FR 34897, Aug. 22, 1989]

§ 2.92

§ 2.92 Preliminary to interference.

An interference which has been declared by the Director will not be instituted by the Trademark Trial and Appeal Board until the examining attorney has determined that the marks which are to form the subject matter of the controversy are registrable, and all of the marks have been published in the Official Gazette for opposition.

[81 FR 69971, Oct. 7, 2016]

§ 2.93 Institution of interference.

An interference is instituted by the issuance of a notice of interference to the parties. The notice shall be sent to each applicant, in care of the applicant's attorney or other representative of record, if any, and if one of the parties is a registrant, the notice shall be sent to the registrant or the registrant's assignee of record. The notice shall give the name and address of every adverse party and of the adverse party's attorney or other authorized representative, if any, together with the serial number and date of filing and publication of each of the applications, or the registration number and date of issuance of each of the registrations, involved.

[73 FR 67772, Nov. 17, 2008]

§§ 2.94–2.95 [Reserved]

§ 2.96 Issue; burden of proof.

The issue in an interference between applications is normally priority of use, but the rights of the parties to registration may also be determined. The party whose application involved in the interference has the latest filing date is the junior party and has the burden of proof. When there are more than two parties to an interference, a party shall be a junior party to and shall have the burden of proof as against every other party whose application involved in the interference has an earlier filing date. If the involved applications of any parties have the same filing date, the application with the latest date of execution will be deemed to have the latest filing date and that applicant will be the junior party. The issue in an interference between an application and a registration shall be the same, but in the event the

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final decision is adverse to the registrant, a registration to the applicant will not be authorized so long as the interfering registration remains on the register.

[48 FR 23135, May 23, 1983; 48 FR 27225, June 14, 1983]

§ 2.97 [Reserved]

§ 2.98 Adding party to interference.

A party may be added to an interference only upon petition to the Director by that party. If an application which is or might be the subject of a petition for addition to an interference is not added, the examining attorney may suspend action on the application pending termination of the interference proceeding.

[48 FR 23135, May 23, 1983, as amended at 81 FR 69971, Oct. 7, 2016]

§ 2.99 Application to register as concurrent user.

(a) An application for registration as a lawful concurrent user will be examined in the same manner as other applications for registration.

(b) If it appears that the applicant is entitled to have the mark registered, subject to a concurrent use proceeding, the mark will be published in the Official Gazette as provided by § 2.80.

(c) If no opposition is filed, or if all oppositions that are filed are dismissed or withdrawn, the Trademark Trial and Appeal Board will send a notice of institution to the applicant for concurrent use registration (plaintiff) and to each applicant, registrant or user specified as a concurrent user in the application (defendants). The notice for each defendant shall state the name and address of the plaintiff and of the plaintiff's attorney or other authorized representative, if any, together with the serial number and filing date of the application. If a party has provided the Office with an email address, the notice may be transmitted via email.

(d)(1) The Board's notice of institution will include a web link or web address to access the concurrent use application proceeding contained in Office records.

(2) An answer to the notice is not required in the case of an applicant or

registrant whose application or registration is acknowledged by the concurrent use applicant in the concurrent use application, but a statement, if desired, may be filed within forty days after the issuance of the notice; in the case of any other party specified as a concurrent user in the application, an answer must be filed within forty days after the issuance of the notice.

(3) If an answer, when required, is not filed, judgment will be entered precluding the defaulting user from claiming any right more extensive than that acknowledged in the application(s) for concurrent use registration, but the burden of proving entitlement to registration(s) will remain with the concurrent use applicant(s).

(e) The applicant for a concurrent use registration has the burden of proving entitlement thereto. If there are two or more applications for concurrent use registration involved in a proceeding, the party whose application has the latest filing date is the junior party. A party whose application has a filing date between the filing dates of the earliest involved application and the latest involved application is a junior party to every party whose involved application has an earlier filing date. If any applications have the same filing date, the application with the latest date of execution will be deemed to have the latest filing date and that applicant will be the junior party. A person specified as an excepted user in a concurrent use application but who has not filed an application shall be considered a party senior to every party that has an application involved in the proceeding.

(f) When a concurrent use registration is sought on the basis that a court of competent jurisdiction has finally determined that the parties are entitled to use the same or similar marks in commerce, a concurrent use registration proceeding will not be instituted if all of the following conditions are fulfilled:

(1) The applicant is entitled to registration subject only to the concurrent lawful use of a party to the court proceeding; and

(2) The court decree specifies the rights of the parties; and

(3) A true copy of the court decree is submitted to the examining attorney; and

(4) The concurrent use application complies fully and exactly with the court decree; and

(5) The excepted use specified in the concurrent use application does not involve a registration, or any involved registration has been restricted by the Director in accordance with the court decree.

If any of the conditions specified in this paragraph is not satisfied, a concurrent use registration proceeding shall be prepared and instituted as provided in paragraphs (a) through (e) of this section.

(g) Registrations and applications to register on the Supplemental Register and registrations under the Act of 1920 are not subject to concurrent use registration proceedings. Applications under section 1(b) of the Act of 1946 are subject to concurrent use registration proceedings only after the applicant files an acceptable allegation of use under §2.76 or §2.88. Applications based solely on section 44 or section 66(a) of the Act are not subject to concurrent use registration proceedings.

(h) The Trademark Trial and Appeal Board will consider and determine concurrent use rights only in the context of a concurrent use registration proceeding.

[48 FR 23135, May 23, 1983; 48 FR 27225, 27226, June 14, 1983, as amended at 54 FR 37596, Sept. 11, 1989; 72 FR 42258, Aug. 1, 2007; 73 FR 67772, Nov. 17, 2008; 81 FR 69971, Oct. 7, 2016]

OPPOSITION

AUTHORITY: Secs. 2.101 to 2.106 also issued under secs. 13, 17, 60 Stat. 433, 434; 15 U.S.C. 1063, 1067.

§2.101 Filing an opposition.

(a) An opposition proceeding is commenced by filing in the Office a timely notice of opposition with the required fee.

(b) Any person who believes that he, she or it would be damaged by the registration of a mark on the Principal Register may file an opposition addressed to the Trademark Trial and Appeal Board. The opposition need not be verified, but must be signed by the

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opposer or the opposer's attorney, as specified in § 11.1 of this chapter, or other authorized representative, as specified in § 11.14(b) of this chapter. Electronic signatures pursuant to § 2.193(c) are required for oppositions filed through ESTTA under paragraph (b)(1) or (2) of this section.

(1) An opposition to an application must be filed by the due date set forth in paragraph (c) of this section through ESTTA.

(2) In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, an opposition against an application based on Section 1 or 44 of the Act may be filed in paper form. A paper opposition to an application based on Section 1 or 44 of the Act must be filed by the due date set forth in paragraph (c) of this section and be accompanied by a Petition to the Director under § 2.146, with the fees therefor and the showing required under this paragraph. Timeliness of the paper submission will be determined in accordance with §§ 2.195 through 2.198.

(3) An opposition to an application based on Section 66(a) of the Act must be filed through ESTTA and may not under any circumstances be filed in paper form.

(c) The opposition must be filed within thirty days after publication (§ 2.80) of the application being opposed or within an extension of time (§ 2.102) for filing an opposition. The opposition must be accompanied by the required fee for each party joined as opposer for each class in the application for which registration is opposed (see § 2.6).

(d) An otherwise timely opposition cannot be filed via ESTTA unless the opposition is accompanied by a fee that is sufficient to pay in full for each named party opposer to oppose the registration of a mark in each class specified in the opposition. A paper opposition that is not accompanied by the required fee sufficient to pay in full for each named party opposer for each class in the application for which registration is opposed may not be instituted. If time remains in the opposition period as originally set or as extended by the Board, the potential opposer may resubmit the opposition with the required fee.

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(e) The filing date of an opposition is the date of electronic receipt in the Office of the notice of opposition, and required fee. In the rare instances that filing by paper is permitted under these rules, the filing date will be determined in accordance with §§ 2.195 through 2.198.

[81 FR 69971, Oct. 7, 2016]

§ 2.102 Extension of time for filing an opposition.

(a) Any person who believes that he, she or it would be damaged by the registration of a mark on the Principal Register may file a request with the Trademark Trial and Appeal Board to extend the time for filing an opposition. The request need not be verified, but must be signed by the potential opposer or by the potential opposer's attorney, as specified in § 11.1 of this chapter, or authorized representative, as specified in § 11.14(b) of this chapter. Electronic signatures pursuant to § 2.193(c) are required for electronically filed extension requests.

(1) A request to extend the time for filing an opposition to an application must be filed through ESTTA by the opposition due date set forth in § 2.101(c). In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, a request to extend the opposition period for an application based on Section 1 or 44 of the Act may be filed in paper form by the opposition due date set forth in § 2.101(c). A request to extend the opposition period for an application based on Section 66(a) of the Act must be filed through ESTTA and may not under any circumstances be filed in paper form.

(2) A paper request to extend the opposition period for an application based on Section 1 or 44 of the Act must be filed by the due date set forth in § 2.101(c) and be accompanied by a Petition to the Director under § 2.146, with the fees therefor and the showing required under paragraph (a)(1) of this section. Timeliness of the paper submission will be determined in accordance with §§ 2.195 through 2.198.

(b) A request to extend the time for filing an opposition must identify the potential opposer with reasonable certainty. Any opposition filed during an

extension of time must be in the name of the person to whom the extension was granted, except that an opposition may be accepted if the person in whose name the extension was requested was misidentified through mistake or if the opposition is filed in the name of a person in privity with the person who requested and was granted the extension of time.

(c) The time for filing an opposition shall not be extended beyond 180 days from the date of publication. Any request to extend the time for filing an opposition must be filed before thirty days have expired from the date of publication or before the expiration of a previously granted extension of time, as appropriate. Requests to extend the time for filing an opposition must be filed as follows:

(1) A person may file a first request for:

(i) Either a thirty-day extension of time, which will be granted upon request; or

(ii) A ninety-day extension of time, which will be granted only for good cause shown. A sixty-day extension is not available as a first extension of time to oppose.

(2) If a person was granted an initial thirty-day extension of time, that person may file a request for an additional sixty-day extension of time, which will be granted only for good cause shown.

(3) After receiving one or two extensions of time totaling ninety days, a person may file one final request for an extension of time for an additional sixty days. No other time period will be allowed for a final extension of the opposition period. The Board will grant this request only upon written consent or stipulation signed by the applicant or its authorized representative, or a written request by the potential opposer or its authorized representative stating that the applicant or its authorized representative has consented to the request, or a showing of extraordinary circumstances. No further extensions of time to file an opposition will be granted under any circumstances.

(d) The filing date of a request to extend the time for filing an opposition is the date of electronic receipt in the Office of the request. In the rare instance

that filing by paper is permitted under these rules, the filing date will be determined in accordance with §§ 2.195 through 2.198.

(e) [Reserved]

[68 FR 55765, Sept. 26, 2003, as amended at 73 FR 47685, Aug. 14, 2008; 74 FR 54909, Oct. 26, 2009; 81 FR 69972, Oct. 7, 2016]

§ 2.103 [Reserved]

§ 2.104 Contents of opposition.

(a) The opposition must set forth a short and plain statement showing why the opposer believes he, she or it would be damaged by the registration of the opposed mark and state the grounds for opposition. ESTTA requires the opposer to select relevant grounds for opposition. The required accompanying statement supports and explains the grounds.

(b) Oppositions to different applications owned by the same party may be joined in a consolidated opposition when appropriate, but the required fee must be included for each party joined as opposer for each class in which registration is opposed in each application against which the opposition is filed.

(c) Oppositions to applications filed under Section 66(a) of the Act are limited to the goods, services and grounds set forth in the ESTTA cover sheet.

[54 FR 34897, Aug. 22, 1989, as amended at 68 FR 55766, Sept. 26, 2003; 81 FR 69972, Oct. 7, 2016]

§ 2.105 Notification to parties of opposition proceeding(s).

(a) When an opposition in proper form (see §§ 2.101 and 2.104) has been filed with the correct fee(s), and the opposition has been determined to be timely and complete, the Trademark Trial and Appeal Board shall prepare a notice of institution, which shall identify the proceeding as an opposition, number of the proceeding, and the application(s) involved; and the notice shall designate a time, not less than thirty days from the mailing date of the notice, within which an answer must be filed. The notice, which will include a Web link or Web address to access the electronic proceeding record, constitutes service of the notice of opposition to the applicant.

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(b) The Board shall forward a copy of the notice to opposer, as follows:

(1) If the opposition is transmitted by an attorney, or a written power of attorney is filed, the Board will send the notice to the attorney transmitting the opposition or to the attorney designated in the power of attorney, provided that the person is an “attorney” as defined in § 11.1 of this chapter, at the email or correspondence address for the attorney.

(2) If opposer is not represented by an attorney in the opposition, but opposer has appointed a domestic representative, the Board will send the notice to the domestic representative, at the email or correspondence address of record for the domestic representative, unless opposer designates in writing another correspondence address.

(3) If opposer is not represented by an attorney in the opposition, and no domestic representative has been appointed, the Board will send the notice directly to opposer at the email or correspondence address of record for opposer, unless opposer designates in writing another correspondence address.

(c) The Board shall forward a copy of the notice to applicant, as follows:

(1) If the opposed application contains a clear indication that the application is being prosecuted by an attorney, as defined in § 11.1 of this chapter, the Board shall send the notice described in this section to applicant’s attorney at the email or correspondence address of record for the attorney.

(2) If the opposed application is not being prosecuted by an attorney but a domestic representative has been appointed, the Board will send the notice described in this section to the domestic representative, at the email or correspondence address of record for the domestic representative, unless applicant designates in writing another correspondence address.

(3) If the opposed application is not being prosecuted by an attorney, and no domestic representative has been appointed, the Board will send the notice described in this section directly to applicant, at the email or correspondence address of record for the applicant, unless applicant designates

in writing another correspondence address.

[81 FR 69972, Oct. 7, 2016]

§ 2.106 Answer.

(a) If no answer is filed within the time initially set, or as may later be reset by the Board, the opposition may be decided as in case of default. The failure to file a timely answer tolls all deadlines, including the discovery conference, until the issue of default is resolved.

(b)(1) An answer must be filed through ESTTA. In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, an answer may be filed in paper form. An answer filed in paper form must be accompanied by a Petition to the Director under § 2.146, with the fees therefor and the showing required under this paragraph (b).

(2) An answer shall state in short and plain terms the applicant’s defenses to each claim asserted and shall admit or deny the averments upon which the opposer relies. If the applicant is without knowledge or information sufficient to form a belief as to the truth of an averment, applicant shall so state and this will have the effect of a denial. Denials may take any of the forms specified in Rule 8(b) of the Federal Rules of Civil Procedure. An answer may contain any defense, including the affirmative defenses of unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior judgment, or any other matter constituting an avoidance or affirmative defense. When pleading special matters, the Federal Rules of Civil Procedure shall be followed. A reply to an affirmative defense shall not be filed. When a defense attacks the validity of a registration pleaded in the opposition, paragraph (b)(3) of this section shall govern. A pleaded registration is a registration identified by number by the party in the position of plaintiff in an original notice of opposition or in any amendment thereto made under Rule 15 of the Federal Rules of Civil Procedure.

(3)(i) A defense attacking the validity of any one or more of the registrations pleaded in the opposition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time

when the answer is filed. If grounds for a counterclaim are known to the applicant when the answer to the opposition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the opposition proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned. A counterclaim need not be filed if the claim is the subject of another proceeding between the same parties or anyone in privity therewith; but the applicant must promptly inform the Board, in the context of the opposition proceeding, of the filing of the other proceeding.

(ii) An attack on the validity of a registration pleaded by an opposer will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration.

(iii) The provisions of §§2.111 through 2.115, inclusive, shall be applicable to counterclaims. A time, not less than thirty days, will be designated by the Board within which an answer to the counterclaim must be filed.

(iv) The times for pleading, discovery, testimony, briefs or oral argument may be reset or extended when necessary, upon motion by a party, or as the Board may deem necessary, to enable a party fully to present or meet a counterclaim or separate petition for cancellation of a registration.

(c) The opposition may be withdrawn without prejudice before the answer is filed. After the answer is filed, the opposition may not be withdrawn without prejudice except with the written consent of the applicant or the applicant's attorney or other authorized representative.

[30 FR 13193, Oct. 16, 1965, as amended at 46 FR 6940, Jan. 22, 1981; 48 FR 23136, May 23, 1983; 54 FR 34897, Aug. 22, 1989; 81 FR 69973, Oct. 7, 2016]

§2.107 Amendment of pleadings in an opposition proceeding.

(a) Pleadings in an opposition proceeding against an application filed under section 1 or 44 of the Act may be amended in the same manner and to the same extent as in a civil action in a United States district court, except that, after the close of the time period for filing an opposition including any

extension of time for filing an opposition, an opposition may not be amended to add to the goods or services opposed, or to add a joint opposer.

(b) Pleadings in an opposition proceeding against an application filed under section 66(a) of the Act may be amended in the same manner and to the same extent as in a civil action in a United States district court, except that, once filed, the opposition may not be amended to add grounds for opposition or goods or services beyond those identified in the notice of opposition, or to add a joint opposer. The grounds for opposition, the goods or services opposed, and the named opposers are limited to those identified in the ESTTA cover sheet regardless of what is contained in any attached statement.

[81 FR 69973, Oct. 7, 2016]

CANCELLATION

AUTHORITY: Secs. 2.111 to 2.114 also issued under secs. 14, 17, 24, 60 Stat. 433, 434, 436; 15 U.S.C. 1064, 1067, 1092.

§2.111 Filing petition for cancellation.

(a) A cancellation proceeding is commenced by filing in the Office a timely petition for cancellation with the required fee.

(b) Any person who believes that he, she or it is or will be damaged by a registration may file a petition, addressed to the Trademark Trial and Appeal Board, for cancellation of the registration in whole or in part. The petition for cancellation need not be verified, but must be signed by the petitioner or the petitioner's attorney, as specified in §11.1 of this chapter, or other authorized representative, as specified in §11.14(b) of this chapter. Electronic signatures pursuant to §2.193(c) are required for petitions submitted electronically via ESTTA. The petition for cancellation may be filed at any time in the case of registrations on the Supplemental Register or under the Act of 1920, or registrations under the Act of 1881 or the Act of 1905 which have not been published under section 12(c) of the Act, or on any ground specified in section 14(3) or (5) of the Act. In all other cases, the petition for cancellation and the required fee must be filed

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within five years from the date of registration of the mark under the Act or from the date of publication under section 12(c) of the Act.

(c)(1) A petition to cancel a registration must be filed through ESTTA.

(2) In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, a petition to cancel may be filed in paper form. A paper petition to cancel a registration must be accompanied by a Petition to the Director under § 2.146, with the fees therefor and the showing required under this paragraph (c). Timeliness of the paper submission, if relevant to a ground asserted in the petition to cancel, will be determined in accordance with §§ 2.195 through 2.198.

(d) The petition for cancellation must be accompanied by the required fee for each party joined as petitioner for each class in the registration(s) for which cancellation is sought (see § 2.6). A petition cannot be filed via ESTTA unless the petition is accompanied by a fee that is sufficient to pay in full for each named petitioner to seek cancellation of the registration(s) in each class specified in the petition. A petition filed in paper form that is not accompanied by a fee sufficient to pay in full for each named petitioner for each class in the registration(s) for which cancellation is sought may not be instituted.

(e) The filing date of a petition for cancellation is the date of electronic receipt in the Office of the petition and required fee. In the rare instances that filing by paper is permitted under these rules, the filing date of a petition for cancellation will be determined in accordance with §§ 2.195 through 2.198.

[81 FR 69973, Oct. 7, 2016]

§ 2.112 Contents of petition for cancellation.

(a) The petition for cancellation must set forth a short and plain statement showing why the petitioner believes he, she or it is or will be damaged by the registration, state the ground for cancellation, and indicate, to the best of petitioner's knowledge, the name and address, and a current email address(es), of the current owner of the registration. ESTTA requires

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the petitioner to select relevant grounds for petition to cancel. The required accompanying statement supports and explains the grounds.

(b) When appropriate, petitions for cancellation of different registrations owned by the same party may be joined in a consolidated petition for cancellation. The required fee must be included for each party joined as a petitioner for each class sought to be cancelled in each registration against which the petition for cancellation has been filed.

[81 FR 69974, Oct. 7, 2016]

§ 2.113 Notification of cancellation proceeding.

(a) When a petition for cancellation in proper form (see §§ 2.111 and 2.112) has been filed and the correct fee has been submitted, the Trademark Trial and Appeal Board shall prepare a notice of institution which shall identify the proceeding as a cancellation, number of the proceeding and the registration(s) involved; and shall designate a time, not less than thirty days from the mailing date of the notice, within which an answer must be filed. The notice, which will include a Web link or Web address to access the electronic proceeding record, constitutes service to the registrant of the petition to cancel.

(b) The Board shall forward a copy of the notice to petitioner, as follows:

(1) If the petition for cancellation is transmitted by an attorney, or a written power of attorney is filed, the Board will send the notice to the attorney transmitting the petition for cancellation or to the attorney designated in the power of attorney, provided that person is an "attorney" as defined in § 11.1 of this chapter, to the attorney's email or correspondence address of record for the attorney.

(2) If petitioner is not represented by an attorney in the cancellation proceeding, but petitioner has appointed a domestic representative, the Board will send the notice to the domestic representative, at the email or correspondence address of record for the domestic representative, unless petitioner designates in writing another correspondence address.

(3) If petitioner is not represented by an attorney in the cancellation proceeding, and no domestic representative has been appointed, the Board will send the notice directly to petitioner, at the email or correspondence address of record for petitioner, unless petitioner designates in writing another correspondence address.

(c)(1) The Board shall forward a copy of the notice to the party shown by the records of the Office to be the current owner of the registration(s) sought to be cancelled at the email or address of record for the current owner, except that the Board, in its discretion, may join or substitute as respondent a party who makes a showing of a current ownership interest in such registration(s).

(2) If the respondent has appointed a domestic representative, and such appointment is reflected in the Office's records, the Board will send the notice only to the domestic representative at the email or correspondence address of record for the domestic representative.

(d) When the party alleged by the petitioner, pursuant to §2.112(a), as the current owner of the registration(s) is not the record owner, a courtesy copy of the notice with a Web link or Web address to access the electronic proceeding record shall be forwarded to the alleged current owner. The alleged current owner may file a motion to be joined or substituted as respondent.

[81 FR 69974, Oct. 7, 2016]

§2.114 Answer.

(a) If no answer is filed within the time initially set, or as may later be reset by the Board, the petition may be decided as in case of default. The failure to file a timely answer tolls all deadlines, including the discovery conference, until the issue of default is resolved.

(b)(1) An answer must be filed through ESTTA. In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, an answer may be filed in paper form. An answer filed in paper form must be accompanied by a Petition to the Director under §2.146, with the fees therefor and the showing required under this paragraph (b).

(2) An answer shall state in short and plain terms the respondent's defenses to each claim asserted and shall admit or deny the averments upon which the petitioner relies. If the respondent is without knowledge or information sufficient to form a belief as to the truth of an averment, respondent shall so state and this will have the effect of a denial. Denials may take any of the forms specified in Rule 8(b) of the Federal Rules of Civil Procedure. An answer may contain any defense, including the affirmative defenses of unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior judgment, or any other matter constituting an avoidance or affirmative defense. When pleading special matters, the Federal Rules of Civil Procedure shall be followed. A reply to an affirmative defense shall not be filed. When a defense attacks the validity of a registration pleaded in the petition, paragraph (b)(3) of this section shall govern. A pleaded registration is a registration identified by number by the party in position of plaintiff in an original petition for cancellation, or a counterclaim petition for cancellation, or in any amendment thereto made under Rule 15 of the Federal Rules of Civil Procedure.

(3)(i) A defense attacking the validity of any one or more of the registrations pleaded in the petition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to respondent when the answer to the petition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the cancellation proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned. A counterclaim need not be filed if the claim is the subject of another proceeding between the same parties or anyone in privity therewith; but the party in position of respondent and counterclaim plaintiff must promptly inform the Board, in the context of the primary cancellation proceeding, of the filing of the other proceeding.

(ii) An attack on the validity of a registration pleaded by a petitioner for cancellation will not be heard unless a

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counterclaim or separate petition is filed to seek the cancellation of such registration.

(iii) The provisions of §§ 2.111 through 2.115, inclusive, shall be applicable to counterclaims. A time, not less than thirty days, will be designated by the Board within which an answer to the counterclaim must be filed. Such response period may be reset as necessary by the Board, for a time period to be determined by the Board.

(iv) The times for pleading, discovery, testimony, briefs, or oral argument may be reset or extended when necessary, upon motion by a party, or as the Board may deem necessary, to enable a party fully to present or meet a counterclaim or separate petition for cancellation of a registration.

(c) The petition for cancellation or counterclaim petition for cancellation may be withdrawn without prejudice before the answer is filed. After the answer is filed, such petition or counterclaim petition may not be withdrawn without prejudice except with the written consent of the registrant or the registrant's attorney or other authorized representative.

[81 FR 69974, Oct. 7, 2016]

§ 2.115 Amendment of pleadings in a cancellation proceeding.

Pleadings in a cancellation proceeding may be amended in the same manner and to the same extent as in a civil action in a United States district court.

[48 FR 23136, May 23, 1983]

PROCEDURE IN *Inter Partes* PROCEEDINGS

AUTHORITY: Secs. 2.116 to 2.136 also issued under sec. 17, 60 Stat. 434; 15 U.S.C. 1067.

§ 2.116 Federal Rules of Civil Procedure.

(a) Except as otherwise provided, and wherever applicable and appropriate, procedure and practice in *inter partes* proceedings shall be governed by the Federal Rules of Civil Procedure.

(b) The opposer in an opposition proceeding or the petitioner in a cancellation proceeding shall be in the position of plaintiff, and the applicant in an opposition proceeding or the respondent in a cancellation proceeding shall be in

the position of defendant. A party that is a junior party in an interference proceeding or in a concurrent use registration proceeding shall be in the position of plaintiff against every party that is senior, and the party that is a senior party in an interference proceeding or in a concurrent use registration proceeding shall be a defendant against every party that is junior.

(c) The notice of opposition or the petition for cancellation and the answer correspond to the complaint and answer in a court proceeding.

(d) The assignment of testimony periods corresponds to setting a case for trial in court proceedings.

(e) The submission of notices of reliance, declarations and affidavits, as well as the taking of depositions, during the assigned testimony periods correspond to the trial in court proceedings.

(f) Oral hearing, if requested, of arguments on the record and merits corresponds to oral summation in court proceedings.

(g) The Trademark Trial and Appeal Board's standard protective order is automatically imposed in all *inter partes* proceedings unless the parties, by stipulation approved by the Board, agree to an alternative order, or a motion by a party to use an alternative order is granted by the Board. The standard protective order is available at the Office's Web site. No material disclosed or produced by a party, presented at trial, or filed with the Board, including motions or briefs which discuss such material, shall be treated as confidential or shielded from public view unless designated as protected under the Board's standard protective order, or under an alternative order stipulated to by the parties and approved by the Board, or under an order submitted by motion of a party granted by the Board. The Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.

[30 FR 13193, Oct. 16, 1965. Redesignated and amended at 37 FR 7606, Apr. 18, 1972; 48 FR 23136, May 23, 1983; 72 FR 42259, Aug. 1, 2007; 81 FR 69975, Oct. 7, 2016]

§2.117 Suspension of proceedings.

(a) Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

(b) Whenever there is pending before the Board both a motion to suspend and a motion which is potentially dispositive of the case, the potentially dispositive motion may be decided before the question of suspension is considered regardless of the order in which the motions were filed.

(c) Proceedings may also be suspended sua sponte by the Board, or, for good cause, upon motion or a stipulation of the parties approved by the Board. Many consented or stipulated motions to suspend are suitable for automatic approval by ESTTA, but the Board retains discretion to condition approval on the party or parties providing necessary information about the status of settlement talks, discovery activities, or trial activities, as may be appropriate.

[48 FR 23136, May 23, 1983, as amended at 63 FR 48097, Sept. 9, 1998; 81 FR 69975, Oct. 7, 2016]

§2.118 Undelivered Office notices.

When a notice sent by the Office to any registrant or applicant is returned to the Office undelivered, including notification to the Office of non-delivery in paper or electronic form, additional notice may be given by publication in the Official Gazette.

[81 FR 69975, Oct. 7, 2016]

§2.119 Service and signing.

(a) Except for the notice of opposition or the petition to cancel, every submission filed in the Office in inter partes cases, including notices of appeal to the courts, must be served upon the other party or parties. Proof of such service must be made before the submission will be considered by the Office. A statement signed by the attorney or other authorized representative, attached to or appearing on the

original submission when filed, clearly stating the date and manner in which service was made will be accepted as prima facie proof of service.

(b) Service of submissions filed with the Board and any other papers served on a party not required to be filed with the Board, must be on the attorney or other authorized representative of the party if there be such or on the party if there is no attorney or other authorized representative, and must be made by email, unless otherwise stipulated, or if the serving party can show by written explanation accompanying the submission or paper, or in a subsequent amended certificate of service, that service by email was attempted but could not be made due to technical problems or extraordinary circumstances, then service may be made in any of the following ways:

(1) By delivering a copy of the submission or paper to the person served;

(2) By leaving a copy at the usual place of business of the person served, with someone in the person's employment;

(3) When the person served has no usual place of business, by leaving a copy at the person's residence, with some person of suitable age and discretion who resides there;

(4) Transmission by the Priority Mail Express® Post Office to Addressee service of the United States Postal Service or by first-class mail, which may also be certified or registered;

(5) Transmission by overnight courier; or

(6) Other forms of electronic transmission.

(c) When service is made by first-class mail, Priority Mail Express®, or overnight courier, the date of mailing or of delivery to the overnight courier will be considered the date of service.

(d) If a party to an inter partes proceeding is not domiciled in the United States and is not represented by an attorney or other authorized representative located in the United States, none of the parties to the proceeding is eligible to use the service option under paragraph (b)(4) of this section. The party not domiciled in the United States may designate by submission filed in the Office the name and address of a person residing in the United

States on whom may be served notices or process in the proceeding. If the party has appointed a domestic representative, official communications of the Office will be addressed to the domestic representative unless the proceeding is being prosecuted by an attorney at law or other qualified person duly authorized under § 11.14(c) of this chapter. If the party has not appointed a domestic representative and the proceeding is not being prosecuted by an attorney at law or other qualified person, the Office will send correspondence directly to the party, unless the party designates in writing another address to which correspondence is to be sent. The mere designation of a domestic representative does not authorize the person designated to prosecute the proceeding unless qualified under § 11.14(a) of this chapter, or qualified under § 11.14(b) of this chapter and authorized under § 2.17(f).

(e) Every submission filed in an inter partes proceeding, and every request for an extension of time to file an opposition, must be signed by the party filing it, or by the party's attorney or other authorized representative, but an unsigned submission will not be refused consideration if a signed copy is submitted to the Office within the time limit set in the notification of this defect by the Office.

[81 FR 69975, Oct. 7, 2016]

§ 2.120 Discovery.

(a) *In general.* (1) Except as otherwise provided in this section, and wherever appropriate, the provisions of the Federal Rules of Civil Procedure relating to disclosure and discovery shall apply in opposition, cancellation, interference and concurrent use registration proceedings. The provisions of Rule 26 of the Federal Rules of Civil Procedure relating to required disclosures, the conference of the parties to discuss settlement and to develop a disclosure and discovery plan, the scope, proportionality, timing and sequence of discovery, protective orders, signing of disclosures and discovery responses, and supplementation of disclosures and discovery responses, are applicable to Board proceedings in modified form, as noted in these rules and as may be detailed in any order instituting an inter

partes proceeding or subsequent scheduling order. The Board will specify the deadline for a discovery conference, the opening and closing dates for the taking of discovery, and the deadlines within the discovery period for making initial disclosures and expert disclosure. The trial order setting these deadlines and dates will be included within the notice of institution of the proceeding.

(2)(i) The discovery conference shall occur no later than the opening of the discovery period, and the parties must discuss the subjects set forth in Rule 26(f) of the Federal Rules of Civil Procedure and any subjects set forth in the Board's institution order. A Board Interlocutory Attorney or Administrative Trademark Judge will participate in the conference upon request of any party made after answer but no later than ten days prior to the deadline for the conference, or when the Board deems it useful for the parties to have Board involvement. The participating attorney or judge may expand or reduce the number or nature of subjects to be discussed in the conference as may be deemed appropriate. The discovery period will be set for a period of 180 days.

(ii) Initial disclosures must be made no later than thirty days after the opening of the discovery period.

(iii) Disclosure of expert testimony must occur in the manner and sequence provided in Rule 26(a)(2) of the Federal Rules of Civil Procedure, unless alternate directions have been provided by the Board in an institution order or any subsequent order resetting disclosure, discovery or trial dates. If the expert is retained after the deadline for disclosure of expert testimony, the party must promptly file a motion for leave to use expert testimony. Upon disclosure by any party of plans to use expert testimony, whether before or after the deadline for disclosing expert testimony, the Board, either on its own initiative or on notice from either party of the disclosure of expert testimony, may issue an order regarding expert discovery and/or set a deadline for any other party to disclose plans to use a rebuttal expert.

(iv) The parties may stipulate to a shortening of the discovery period,

that there will be no discovery, that the number of discovery requests or depositions be limited, or that reciprocal disclosures be used in place of discovery. Limited extensions of the discovery period may be granted upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a motion for an extension is denied, the discovery period may remain as originally set or as reset. Disclosure deadlines and obligations may be modified upon written stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board, but the expert disclosure deadline must always be scheduled prior to the close of discovery. If a stipulation or motion for modification is denied, discovery disclosure deadlines may remain as originally set or reset and obligations may remain unaltered.

(v) The parties are not required to prepare or transmit to the Board a written report outlining their discovery conference discussions, unless the parties have agreed to alter disclosure or discovery obligations set forth by these rules or applicable Federal Rules of Civil Procedure, or unless directed to file such a report by a participating Board Interlocutory Attorney or Administrative Trademark Judge.

(3) A party must make its initial disclosures prior to seeking discovery, absent modification of this requirement by a stipulation of the parties approved by the Board, or a motion granted by the Board, or by order of the Board. Discovery depositions must be properly noticed and taken during the discovery period. Interrogatories, requests for production of documents and things, and requests for admission must be served early enough in the discovery period, as originally set or as may have been reset by the Board, so that responses will be due no later than the close of discovery. Responses to interrogatories, requests for production of documents and things, and requests for admission must be served within thirty days from the date of service of such discovery requests. The time to respond may be extended upon stipulation of the parties, or upon motion granted by the Board, or by order of the Board, but the response may not be

due later than the close of discovery. The resetting of a party's time to respond to an outstanding request for discovery will not result in the automatic rescheduling of the discovery and/or testimony periods; such dates will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board.

(b) *Discovery deposition within the United States.* The deposition of a natural person shall be taken in the Federal judicial district where the person resides or is regularly employed or at any place on which the parties agree in writing. The responsibility rests wholly with the party taking discovery to secure the attendance of a proposed deponent other than a party or anyone who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure. (See 35 U.S.C. 24.)

(c) *Discovery deposition in foreign countries; or of foreign party within jurisdiction of the United States.* (1) The discovery deposition of a natural person residing in a foreign country who is a party or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, shall, if taken in a foreign country, be taken in the manner prescribed by §2.124 unless the Trademark Trial and Appeal Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate.

(2) Whenever a foreign party is or will be, during a time set for discovery, present within the United States or any territory which is under the control and jurisdiction of the United States, such party may be deposed by oral examination upon notice by the party seeking discovery. Whenever a foreign party has or will have, during a time set for discovery, an officer, director, managing agent, or other person who consents to testify on its behalf, present within the United States or any territory which is under the control and jurisdiction of the United

States, such officer, director, managing agent, or other person who consents to testify in its behalf may be deposed by oral examination upon notice by the party seeking discovery. The party seeking discovery may have one or more officers, directors, managing agents, or other persons who consent to testify on behalf of the adverse party, designated under Rule 30(b)(6) of the Federal Rules of Civil Procedure. The deposition of a person under this paragraph shall be taken in the Federal judicial district where the witness resides or is regularly employed, or, if the witness neither resides nor is regularly employed in a Federal judicial district, where the witness is at the time of the deposition. This paragraph (c)(2) does not preclude the taking of a discovery deposition of a foreign party by any other procedure provided by paragraph (c)(1) of this section.

(d) *Interrogatories.* The total number of written interrogatories which a party may serve upon another party pursuant to Rule 33 of the Federal Rules of Civil Procedure, in a proceeding, shall not exceed seventy-five, counting subparts, except that the Trademark Trial and Appeal Board, in its discretion, may allow additional interrogatories upon motion therefor showing good cause, or upon stipulation of the parties, approved by the Board. A motion for leave to serve additional interrogatories must be filed and granted prior to the service of the proposed additional interrogatories and must be accompanied by a copy of the interrogatories, if any, which have already been served by the moving party, and by a copy of the interrogatories proposed to be served. If a party upon which interrogatories have been served believes that the number of interrogatories exceeds the limitation specified in this paragraph (d), and is not willing to waive this basis for objection, the party shall, within the time for (and instead of) serving answers and specific objections to the interrogatories, serve a general objection on the ground of their excessive number. If the inquiring party, in turn, files a motion to compel discovery, the motion must be accompanied by a copy of the set(s) of the interrogatories which together are said to exceed the limitation, and must oth-

erwise comply with the requirements of paragraph (f) of this section.

(e) *Requests for production.* The total number of requests for production which a party may serve upon another party pursuant to Rule 34 of the Federal Rules of Civil Procedure, in a proceeding, shall not exceed seventy-five, counting subparts, except that the Trademark Trial and Appeal Board, in its discretion, may allow additional requests upon motion therefor showing good cause, or upon stipulation of the parties, approved by the Board. A motion for leave to serve additional requests must be filed and granted prior to the service of the proposed additional requests and must be accompanied by a copy of the requests, if any, which have already been served by the moving party, and by a copy of the requests proposed to be served. If a party upon which requests have been served believes that the number of requests exceeds the limitation specified in this paragraph, and is not willing to waive this basis for objection, the party shall, within the time for (and instead of) serving responses and specific objections to the requests, serve a general objection on the ground of their excessive number. If the inquiring party, in turn, files a motion to compel discovery, the motion must be accompanied by a copy of the set(s) of the requests which together are said to exceed the limitation, and must otherwise comply with the requirements of paragraph (f) of this section. The time, place, and manner for production of documents, electronically stored information, and tangible things shall comport with the provisions of Rule 34 of the Federal Rules of Civil Procedure, or be made pursuant to agreement of the parties, or where and in the manner which the Trademark Trial and Appeal Board, upon motion, orders.

(f) *Motion for an order to compel disclosure or discovery.* (1) If a party fails to make required initial disclosures or expert testimony disclosure, or fails to designate a person pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, or if a party, or such designated person, or an officer, director or managing agent of a party fails to attend a deposition or

fails to answer any question propounded in a discovery deposition, or any interrogatory, or fails to produce and permit the inspection and copying of any document, electronically stored information, or tangible thing, the party entitled to disclosure or seeking discovery may file a motion to compel disclosure, a designation, or attendance at a deposition, or an answer, or production and an opportunity to inspect and copy. A motion to compel initial disclosures must be filed within thirty days after the deadline therefor and include a copy of the disclosure(s), if any, and a motion to compel an expert testimony disclosure must be filed prior to the close of the discovery period. A motion to compel discovery must be filed before the day of the deadline for pretrial disclosures for the first testimony period as originally set or as reset. A motion to compel discovery shall include a copy of the request for designation of a witness or of the relevant portion of the discovery deposition; or a copy of the interrogatory with any answer or objection that was made; or a copy of the request for production, any proffer of production or objection to production in response to the request, and a list and brief description of the documents, electronically stored information, or tangible things that were not produced for inspection and copying. A motion to compel initial disclosures, expert testimony disclosure, or discovery must be supported by a showing from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion but the parties were unable to resolve their differences. If issues raised in the motion are subsequently resolved by agreement of the parties, the moving party should inform the Board in writing of the issues in the motion which no longer require adjudication.

(2) When a party files a motion for an order to compel initial disclosures, expert testimony disclosure, or discovery, the case will be suspended by the Board with respect to all matters not germane to the motion. After the motion to compel is filed and served,

no party should file any paper that is not germane to the motion, except as otherwise specified in the Board's suspension order. Nor may any party serve any additional discovery until the period of suspension is lifted or expires by or under order of the Board. The filing of a motion to compel any disclosure or discovery shall not toll the time for a party to comply with any disclosure requirement or to respond to any outstanding discovery requests or to appear for any noticed discovery deposition. If discovery has closed, however, the parties need not make pretrial disclosures until directed to do so by the Board.

(g) *Motion for a protective order.* Upon motion by a party obligated to make initial disclosures or expert testimony disclosure or from whom discovery is sought, and for good cause, the Trademark Trial and Appeal Board may make any order which justice requires to protect a party from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the types of orders provided by clauses (A) through (H), inclusive, of Rule 26(c)(1) of the Federal Rules of Civil Procedure. If the motion for a protective order is denied in whole or in part, the Board may, on such conditions (other than an award of expenses to the party prevailing on the motion) as are just, order that any party comply with disclosure obligations or provide or permit discovery.

(h) *Sanctions.* (1) If a party fails to participate in the required discovery conference, or if a party fails to comply with an order of the Trademark Trial and Appeal Board relating to disclosure or discovery, including a protective order, the Board may make any appropriate order, including those provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure, except that the Board will not hold any person in contempt or award expenses to any party. The Board may impose against a party any of the sanctions provided in Rule 37(b)(2) in the event that said party or any attorney, agent, or designated witness of that party fails to comply with a protective order made pursuant to Rule 26(c) of the Federal Rules of Civil Procedure. A motion for sanctions

against a party for its failure to participate in the required discovery conference must be filed prior to the deadline for any party to make initial disclosures.

(2) If a party fails to make required initial disclosures or expert testimony disclosure, and such party or the party's attorney or other authorized representative informs the party or parties entitled to receive disclosures that required disclosures will not be made, the Board may make any appropriate order, as specified in paragraph (h)(1) of this section. If a party, or an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or 31(a) of the Federal Rules of Civil Procedure to testify on behalf of a party, fails to attend the party's or person's discovery deposition, after being served with proper notice, or fails to provide any response to a set of interrogatories or to a set of requests for production of documents and things, and such party or the party's attorney or other authorized representative informs the party seeking discovery that no response will be made thereto, the Board may make any appropriate order, as specified in paragraph (h)(1) of this section.

(1) *Requests for admission.* The total number of requests for admission which a party may serve upon another party pursuant to Rule 36 of the Federal Rules of Civil Procedure, in a proceeding, shall not exceed seventy-five, counting subparts, except that the Trademark Trial and Appeal Board, in its discretion, may allow additional requests upon motion therefor showing good cause, or upon stipulation of the parties, approved by the Board. A motion for leave to serve additional requests must be filed and granted prior to the service of the proposed additional requests and must be accompanied by a copy of the requests, if any, which have already been served by the moving party, and by a copy of the requests proposed to be served. If a party upon which requests for admission have been served believes that the number of requests for admission exceeds the limitation specified in this paragraph, and is not willing to waive this basis for objection, the party shall, within the time for (and instead of)

serving answers and specific objections to the requests for admission, serve a general objection on the ground of their excessive number. However, independent of this limit, a party may make one comprehensive request for admission of any adverse party that has produced documents for an admission authenticating specific documents, or specifying which of those documents cannot be authenticated.

(1) Any motion by a party to determine the sufficiency of an answer or objection, including testing the sufficiency of a general objection on the ground of excessive number, to a request made by that party for an admission must be filed before the day of the deadline for pretrial disclosures for the first testimony period, as originally set or as reset. The motion shall include a copy of the request for admission and any exhibits thereto and of the answer or objection. The motion must be supported by a written statement from the moving party showing that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion and has been unable to reach agreement. If issues raised in the motion are subsequently resolved by agreement of the parties, the moving party should inform the Board in writing of the issues in the motion which no longer require adjudication.

(2) When a party files a motion to determine the sufficiency of an answer or objection to a request for an admission, the case will be suspended by the Board with respect to all matters not germane to the motion. After the motion is filed and served, no party should file any paper that is not germane to the motion, except as otherwise specified in the Board's suspension order. Nor may any party serve any additional discovery until the period of suspension is lifted or expires by or under order of the Board. The filing of a motion to determine the sufficiency of an answer or objection to a request for admission shall not toll the time for a

party to comply with any disclosure requirement or to respond to any outstanding discovery requests or to appear for any noticed discovery deposition. If discovery has closed, however, the parties need not make pretrial disclosures until directed to do so by the Board.

(j) *Telephone and pretrial conferences.*

(1) Whenever it appears to the Trademark Trial and Appeal Board that a stipulation or motion filed in an inter partes proceeding is of such nature that a telephone conference would be beneficial, the Board may, upon its own initiative or upon request made by one or both of the parties, schedule a telephone conference.

(2) Whenever it appears to the Trademark Trial and Appeal Board that questions or issues arising during the interlocutory phase of an inter partes proceeding have become so complex that their resolution by correspondence or telephone conference is not practical and that resolution would likely be facilitated by a conference in person of the parties or their attorneys with an Administrative Trademark Judge or an Interlocutory Attorney of the Board, the Board may, upon its own initiative, direct that the parties and/or their attorneys meet with the Board for a disclosure, discovery or pretrial conference on such terms as the Board may order.

(3) Parties may not make a recording of the conferences referenced in paragraphs (j)(1) and (2) of this section.

(k) *Use of discovery deposition, answer to interrogatory, admission or written disclosure.* (1) The discovery deposition of a party or of anyone who at the time of taking the deposition was an officer, director or managing agent of a party, or a person designated by a party pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, may be offered in evidence by an adverse party.

(2) Except as provided in paragraph (k)(1) of this section, the discovery deposition of a witness, whether or not a party, shall not be offered in evidence unless the person whose deposition was taken is, during the testimony period of the party offering the deposition, dead; or out of the United States (unless it appears that the absence of the

witness was procured by the party offering the deposition); or unable to testify because of age, illness, infirmity, or imprisonment; or cannot be served with a subpoena to compel attendance at a testimonial deposition; or there is a stipulation by the parties; or upon a showing that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used. The use of a discovery deposition by any party under this paragraph will be allowed only by stipulation of the parties approved by the Trademark Trial and Appeal Board, or by order of the Board on motion, which shall be filed when the party makes its pretrial disclosures, unless the motion is based upon a claim that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used, even though such deadline has passed, in which case the motion shall be filed promptly after the circumstances claimed to justify use of the deposition became known.

(3)(i) A discovery deposition, an answer to an interrogatory, an admission to a request for admission, or a written initial disclosure, which may be offered in evidence under the provisions of paragraph (k) of this section, may be made of record in the case by filing the deposition or any part thereof with any exhibit to the part that is filed, or a copy of the interrogatory and answer thereto with any exhibit made part of the answer, or a copy of the request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto), or a copy of the written initial disclosure, together with a notice of reliance in accordance with § 2.122(g). The notice of reliance and the material submitted thereunder should be filed during the testimony period of the party that files the notice of reliance. An objection made at a discovery deposition by a party answering a question subject to the objection will be considered at final hearing.

(ii) A party that has obtained documents from another party through disclosure or under Rule 34 of the Federal Rules of Civil Procedure may not make

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the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of § 2.122(e), or the party has obtained an admission or stipulation from the producing party that authenticates the documents.

(4) If only part of a discovery deposition is submitted and made part of the record by a party, an adverse party may introduce under a notice of reliance any other part of the deposition which should in fairness be considered so as to make not misleading what was offered by the submitting party. A notice of reliance filed by an adverse party must be supported by a written statement explaining why the adverse party needs to rely upon each additional part listed in the adverse party's notice, failing which the Board, in its discretion, may refuse to consider the additional parts.

(5) Written disclosures, an answer to an interrogatory, or an admission to a request for admission, may be submitted and made part of the record only by the receiving or inquiring party except that, if fewer than all of the written disclosures, answers to interrogatories, or fewer than all of the admissions, are offered in evidence by the receiving or inquiring party, the disclosing or responding party may introduce under a notice of reliance any other written disclosures, answers to interrogatories, or any other admissions, which should in fairness be considered so as to make not misleading what was offered by the receiving or inquiring party. The notice of reliance filed by the disclosing or responding party must be supported by a written statement explaining why the disclosing or responding party needs to rely upon each of the additional written disclosures or discovery responses listed in the disclosing or responding party's notice, and absent such statement, the Board, in its discretion, may refuse to consider the additional written disclosures or responses.

(6) Paragraph (k) of this section will not be interpreted to preclude reading or use of written disclosures or documents, a discovery deposition, or answer to an interrogatory, or admission as part of the examination or cross-ex-

amination of any witness during the testimony period of any party.

(7) When a written disclosure, a discovery deposition, or a part thereof, or an answer to an interrogatory, or an admission, or an authenticated produced document has been made of record by one party in accordance with the provisions of paragraph (k)(3) of this section, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.

(8) Written disclosures or disclosed documents, requests for discovery, responses thereto, and materials or depositions obtained through the disclosure or discovery process should not be filed with the Board, except when submitted with a motion relating to disclosure or discovery, or in support of or in response to a motion for summary judgment, or under a notice of reliance, when permitted, during a party's testimony period.

[81 FR 69976, Oct. 7, 2016, as amended at 82 FR 33805, July 21, 2017]

§ 2.121 Assignment of times for taking testimony and presenting evidence.

(a) The Trademark Trial and Appeal Board will issue a trial order setting a deadline for each party's required pretrial disclosures and assigning to each party its time for taking testimony and presenting evidence ("testimony period"). No testimony shall be taken or evidence presented except during the times assigned, unless by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. The deadlines for pretrial disclosures and the testimony periods may be rescheduled by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a motion to reschedule any pretrial disclosure deadline and/or testimony period is denied, the pretrial disclosure deadline or testimony period and any subsequent remaining periods may remain as set. The resetting of the closing date for discovery will result in the rescheduling of pretrial disclosure deadlines and testimony periods without action by any party. The resetting

of a party's testimony period will result in the rescheduling of the remaining pretrial disclosure deadlines without action by any party.

(b)(1) The Trademark Trial and Appeal Board will schedule a testimony period for the plaintiff to present its case in chief, a testimony period for the defendant to present its case and to meet the case of the plaintiff, and a testimony period for the plaintiff to present evidence in rebuttal.

(2) When there is a counterclaim, or when proceedings have been consolidated and one party is in the position of plaintiff in one of the involved proceedings and in the position of defendant in another of the involved proceedings, or when there is an interference or a concurrent use registration proceeding involving more than two parties, the Board will schedule testimony periods so that each party in the position of plaintiff will have a period for presenting its case in chief against each party in the position of defendant, each party in the position of defendant will have a period for presenting its case and meeting the case of each plaintiff, and each party in the position of plaintiff will have a period for presenting evidence in rebuttal.

(c) A testimony period which is solely for rebuttal will be set for fifteen days. All other testimony periods will be set for thirty days. The periods may be shortened or extended by stipulation of the parties approved by the Trademark Trial and Appeal Board, or may be extended upon motion granted by the Board, or by order of the Board. If a motion for an extension is denied, the testimony periods and their associated pretrial disclosure deadlines may remain as set.

(d) When parties stipulate to the rescheduling of a deadline for pretrial disclosures and subsequent testimony periods or to the rescheduling of the closing date for discovery and the rescheduling of subsequent deadlines for pretrial disclosures and testimony periods, a stipulation presented in the form used in a trial order, signed by the parties, or a motion in said form signed by one party and including a statement that every other party has agreed thereto, shall be submitted to the Board through ESTTA, with the rel-

evant dates set forth and an express statement that all parties agree to the new dates.

(e) A party need not disclose, prior to its testimony period, any notices of reliance it intends to file during its testimony period. However, no later than fifteen days prior to the opening of each testimony period, or on such alternate schedule as may be provided by order of the Board, the party scheduled to present evidence must disclose the name and, if not previously provided, the telephone number and address of each witness from whom it intends to take testimony, or may take testimony if the need arises, general identifying information about the witness, such as relationship to any party, including job title if employed by a party, or, if neither a party nor related to a party, occupation and job title, a general summary or list of subjects on which the witness is expected to testify, and a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness. The testimony of a witness may be taken upon oral examination and transcribed, or presented in the form of an affidavit or declaration, as provided in §2.123. Pretrial disclosure of a witness under this paragraph (e) does not substitute for issuance of a proper notice of examination under §2.123(c) or §2.124(b). If a party does not plan to take testimony from any witnesses, it must so state in its pretrial disclosure. When a party fails to make required pretrial disclosures, any adverse party or parties may have remedy by way of a motion to the Board to delay or reset any subsequent pretrial disclosure deadlines and/or testimony periods. A party may move to quash a noticed testimony deposition of a witness not identified or improperly identified in pretrial disclosures before the deposition. When testimony has been presented by affidavit or declaration, but was not covered by an earlier pretrial disclosure, the remedy for any adverse party is the prompt filing of a motion

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to strike, as provided in §§ 2.123 and 2.124.

[48 FR 23138, May 23, 1983; 48 FR 27226, June 14, 1983, as amended at 54 FR 34899, Aug. 22, 1989; 63 FR 48099, Sept. 9, 1998; 68 FR 55767, Sept. 26, 2003; 72 FR 42262, Aug. 1, 2007; 81 FR 69979, Oct. 7, 2016]

§ 2.122 Matters in evidence.

(a) *Applicable rules.* Unless the parties otherwise stipulate, the rules of evidence for proceedings before the Trademark Trial and Appeal Board are the Federal Rules of Evidence, the relevant provisions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the provisions of this part. When evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.

(b) *Application and registration files.*
(1) The file of each application or registration specified in a notice of interference, of each application or registration specified in the notice of a concurrent use registration proceeding, of the application against which a notice of opposition is filed, or of each registration against which a petition or counterclaim for cancellation is filed forms part of the record of the proceeding without any action by the parties and reference may be made to the file for any relevant and competent purpose in accordance with paragraph (b)(2) of this section.

(2) The allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence. Specimens in the file of an application for registration, or in the file of a registration, are not evidence on behalf of the applicant or registrant unless identified and introduced in evidence as exhibits during the period for the taking of testimony. Statements made in an affidavit or declaration in the file of an application for registration, or in the file of a registration, are not testimony on behalf of the applicant or registrant. Establishing the truth of these or any other matters asserted in the files of these applications and registrations shall be

governed by the Federal Rules of Evidence, the relevant provisions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the provisions of this part.

(c) *Exhibits to pleadings.* Except as provided in paragraph (d)(1) of this section, an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached, and must be identified and introduced in evidence as an exhibit during the period for the taking of testimony.

(d) *Registrations.* (1) A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by an original or photocopy of the registration prepared and issued by the Office showing both the current status of and current title to the registration, or by a current copy of information from the electronic database records of the Office showing the current status and title of the registration. For the cost of a copy of a registration showing status and title, see § 2.6(b)(4).

(2) A registration owned by any party to a proceeding may be made of record in the proceeding by that party by appropriate identification and introduction during the taking of testimony or by filing a notice of reliance in accordance with paragraph (g) of this section, which shall be accompanied by a copy (original or photocopy) of the registration prepared and issued by the Office showing both the current status of and current title to the registration, or by a current copy of information from the electronic database records of the Office showing the current status and title of the registration. The notice of reliance shall be filed during the testimony period of the party that files the notice.

(e) *Printed publications and official records.* (1) Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant in a particular proceeding, and official records, if the

publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered in accordance with paragraph (g) of this section. The notice of reliance shall specify the printed publication (including information sufficient to identify the source and the date of the publication) or the official record and the pages to be read; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official record of the Office need not be certified to be offered in evidence.

(2) Internet materials may be admitted into evidence under a notice of reliance in accordance with paragraph (g) of this section, in the same manner as a printed publication in general circulation, so long as the date the internet materials were accessed and their source (*e.g.*, URL) are provided.

(f) *Testimony from other proceedings.* By order of the Trademark Trial and Appeal Board, on motion, testimony taken in another proceeding, or testimony taken in a suit or action in a court, between the same parties or those in privity may be used in a proceeding, so far as relevant and material, subject, however, to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony.

(g) *Notices of reliance.* The types of evidence admissible by notice of reliance are identified in paragraphs (d)(2) and (e)(1) and (2) of this section and § 2.120(k). A notice of reliance shall be filed during the testimony period of the party that files the notice. For all evidence offered by notice of reliance, the notice must indicate generally the relevance of the evidence and associate it with one or more issues in the proceeding. Failure to identify the relevance of the evidence, or associate it with issues in the proceeding, with sufficient specificity is a procedural defect that can be cured by the offering

party within the time set by Board order.

[48 FR 23138, May 23, 1983, as amended at 54 FR 34899, Aug. 22, 1989; 54 FR 38041, Sept. 14, 1989; 63 FR 48099, Sept. 9, 1998; 72 FR 42262, Aug. 1, 2007; 81 FR 69980, Oct. 7, 2016]

§ 2.123 Trial testimony in *inter partes* cases.

(a)(1) The testimony of witnesses in *inter partes* cases may be submitted in the form of an affidavit or a declaration pursuant to § 2.20 and in conformance with the Federal Rules of Evidence, filed during the proffering party's testimony period, subject to the right of any adverse party to elect to take and bear the expense of oral cross-examination of that witness as provided under paragraph (c) of this section if such witness is within the jurisdiction of the United States, or conduct cross-examination by written questions as provided in § 2.124 if such witness is outside the jurisdiction of the United States, and the offering party must make that witness available; or taken by deposition upon oral examination as provided by this section; or by deposition upon written questions as provided by § 2.124.

(2) Testimony taken in a foreign country shall be taken: by deposition upon written questions as provided by § 2.124, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate; or by affidavit or declaration, subject to the right of any adverse party to elect to take and bear the expense of cross-examination by written questions of that witness. If a party serves notice of the taking of a testimonial deposition upon written questions of a witness who is, or will be at the time of the deposition, present within the United States or any territory which is under the control and jurisdiction of the United States, any adverse party may, within twenty days from the date of service of the notice, file a motion with the Trademark Trial and Appeal Board, for good cause, for an order that the deposition be taken by oral examination.

(b) *Stipulations.* If the parties so stipulate in writing, depositions may be taken before any person authorized to administer oaths, at any place, upon

any notice, and in any manner, and when so taken may be used like other depositions. The parties may stipulate in writing what a particular witness would testify to if called; or any relevant facts in the case may be stipulated in writing.

(c) *Notice of examination of witnesses.* Before the oral depositions of witnesses shall be taken by a party, due notice in writing shall be given to the adverse party or parties, as provided in § 2.119(b), of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and the name and address of each witness to be examined. Depositions may be noticed for any reasonable time and place in the United States. A deposition may not be noticed for a place in a foreign country except as provided in paragraph (a)(2) of this section. No party shall take depositions in more than one place at the same time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other is not available. When a party elects to take oral cross-examination of an affiant or declarant, the notice of such election must be served on the adverse party and a copy filed with the Board within 20 days from the date of service of the affidavit or declaration and completed within 30 days from the date of service of the notice of election. Upon motion for good cause by any party, or upon its own initiative, the Board may extend the periods for electing and taking oral cross-examination. When such election has been made but cannot be completed within that testimony period, the Board, after the close of that testimony period, shall suspend or reschedule other proceedings in the matter to allow for the orderly completion of the oral cross-examination(s).

(d) *Persons before whom depositions may be taken.* Depositions may be taken before persons designated by Rule 28 of the Federal Rules of Civil Procedure.

(e) *Examination of witnesses.* (1) Each witness before providing oral testimony shall be duly sworn according to law by the officer before whom the deposition is to be taken. Where oral depositions are taken, every adverse party shall have a full opportunity to cross-

examine each witness. When testimony is proffered by affidavit or declaration, every adverse party will have the right to elect oral cross-examination of any witness within the jurisdiction of the United States. For examination of witnesses outside the jurisdiction of the United States, see § 2.124.

(2) The deposition shall be taken in answer to questions, with the questions and answers recorded in their regular order by the officer, or by some other person (who shall be subject to the provisions of Rule 28 of the Federal Rules of Civil Procedure) in the presence of the officer except when the officer's presence is waived on the record by agreement of the parties. The testimony shall be recorded and transcribed, unless the parties present agree otherwise. Exhibits which are marked and identified at the deposition will be deemed to have been offered into evidence, without any formal offer thereof, unless the intention of the party marking the exhibits is clearly expressed to the contrary.

(3) If pretrial disclosures or the notice of examination of witnesses served pursuant to paragraph (c) of this section are improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances.

(i) A motion to strike the testimony of a witness for lack of proper or adequate pretrial disclosure may seek exclusion of the entire testimony, when there was no pretrial disclosure, or may seek exclusion of that portion of the testimony that was not adequately disclosed in accordance with § 2.121(e).

(ii) A motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.

(4) All objections made at the time of an oral examination to the qualifications of the officer taking the deposition, or to the manner of taking it, or to the evidence presented, or to the conduct of any party, and any other objection to the proceedings, shall be noted by the officer upon the deposition. Evidence objected to shall be taken subject to the objections.

(5) When the oral deposition has been transcribed, the deposition transcript shall be carefully read over by the witness or by the officer to the witness, and shall then be signed by the witness in the presence of any officer authorized to administer oaths unless the reading and the signature be waived on the record by agreement of all parties.

(f) *Certification and filing of deposition.*

(1) The officer shall annex to the deposition his or her certificate showing:

(i) Due administration of the oath by the officer to the witness before the commencement of his or her deposition;

(ii) The name of the person by whom the deposition was taken down, and whether, if not taken down by the officer, it was taken down in his or her presence;

(iii) The presence or absence of the adverse party;

(iv) The place, day, and hour of commencing and taking the deposition;

(v) The fact that the officer was not disqualified as specified in Rule 28 of the Federal Rules of Civil Procedure.

(2) If any of the foregoing requirements in paragraph (f)(1) of this section are waived, the certificate shall so state. The officer shall sign the certificate and affix thereto his or her seal of office, if he or she has such a seal. The party taking the deposition, or its attorney or other authorized representative, shall then promptly file the transcript and exhibits in electronic form using ESTTA. If the nature of an exhibit precludes electronic transmission via ESTTA, it shall be submitted by mail by the party taking the deposition, or its attorney or other authorized representative.

(g) *Form of deposition.* (1) The pages of each deposition must be numbered consecutively, and the name of the witness plainly and conspicuously written at the top of each page. A deposition must

be in written form. The questions propounded to each witness must be consecutively numbered unless the pages have numbered lines. Each question must be followed by its answer. The deposition transcript must be submitted in full-sized format (one page per sheet), not condensed (multiple pages per sheet).

(2) Exhibits must be numbered or lettered consecutively and each must be marked with the number and title of the case and the name of the party offering the exhibit. Entry and consideration may be refused to improperly marked exhibits.

(3) Each deposition must contain a word index and an index of the names of the witnesses, giving the pages where the words appear in the deposition and where witness examination and cross-examination begin, and an index of the exhibits, briefly describing their nature and giving the pages at which they are introduced and offered in evidence.

(h) *Depositions must be filed.* All depositions which are taken must be duly filed in the Office. On refusal to file, the Office at its discretion will not further hear or consider the contestant with whom the refusal lies; and the Office may, at its discretion, receive and consider a copy of the withheld deposition, attested by such evidence as is procurable.

(i) *Effect of errors and irregularities in depositions.* Rule 32(d)(1), (2), and (3)(A) and (B) of the Federal Rules of Civil Procedure shall apply to errors and irregularities in depositions. Notice will not be taken of merely formal or technical objections which shall not appear to have wrought a substantial injury to the party raising them; and in case of such injury it must be made to appear that the objection was raised at the time specified in said rule.

(j) *Objections to admissibility.* Subject to the provisions of paragraph (i) of this section, objection may be made to receiving in evidence any declaration, affidavit, or deposition, or part thereof, or any other evidence, for any reason which would require the exclusion of the evidence from consideration. Objections to the competency of a witness or to the competency, relevancy, or materiality of testimony must be raised at

the time specified in Rule 32(d)(3)(A) of the Federal Rules of Civil Procedure. Such objections may not be considered until final hearing.

(k) *Evidence not considered.* Evidence not obtained and filed in compliance with these sections will not be considered.

[37 FR 7607, Apr. 18, 1972, as amended at 41 FR 760, Jan. 5, 1976; 48 FR 23139, May 23, 1983; 54 FR 34899, Aug. 22, 1989; 54 FR 38041, Sept. 14, 1989; 63 FR 48099, Sept. 9, 1998; 68 FR 14337, Mar. 25, 2003; 68 FR 48289, Aug. 13, 2003; 68 FR 55767, Sept. 26, 2003; 72 FR 42262, Aug. 1, 2007; 81 FR 69981, Oct. 7, 2016; 81 FR 89383, Dec. 12, 2016]

§ 2.124 Depositions upon written questions.

(a) A deposition upon written questions may be taken before any person before whom depositions may be taken as provided by Rule 28 of the Federal Rules of Civil Procedure.

(b)(1) A party desiring to take a testimonial deposition upon written questions shall serve notice thereof upon each adverse party within ten days from the opening date of the testimony period of the party who serves the notice. The notice shall state the name and address of the witness. A copy of the notice, but not copies of the questions, shall be filed with the Trademark Trial and Appeal Board.

(2) A party desiring to take a discovery deposition upon written questions shall serve notice thereof upon each adverse party and shall file a copy of the notice, but not copies of the questions, with the Board. The notice shall state the name and address, if known, of the person whose deposition is to be taken. If the name of the person is not known, a general description sufficient to identify the witness or the particular class or group to which he or she belongs shall be stated in the notice, and the party from whom the discovery deposition is to be taken shall designate one or more persons to be deposed in the same manner as is provided by Rule 30(b)(6) of the Federal Rules of Civil Procedure.

(3) A party desiring to take cross-examination, by written questions, of a witness who has provided testimony by affidavit or declaration shall serve notice thereof upon each adverse party and shall file a copy of the notice, but

not copies of the questions, with the Board.

(c) Every notice given under the provisions of paragraph (b) of this section shall be accompanied by the name or descriptive title of the officer before whom the deposition is to be taken.

(d)(1) Every notice served on any adverse party under the provisions of paragraphs (b)(1) and (2) of this section, for the taking of direct examination, shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the deposition. Every notice served on any adverse party under the provisions of paragraph (b)(3) of this section, for the taking of cross-examination, shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the cross-examination. Within twenty days from the date of service of the notice of taking direct examination, or service of a testimony affidavit or declaration, any adverse party may serve cross questions upon the party who proposes to take the deposition. Any party who serves cross questions, whether in response to direct examination questions or under paragraph (b)(3) of this section, shall also serve every other adverse party. Within ten days from the date of service of the cross questions, the party who proposes to take the deposition, or who earlier offered testimony of the witness by affidavit or declaration, may serve redirect questions on every adverse party. Within ten days from the date of service of the redirect questions, any party who served cross questions may serve recross questions upon the party who proposes to take the deposition or who earlier offered testimony of the witness by affidavit or declaration; any party who serves recross questions shall also serve every other adverse party. Written objections to questions may be served on a party propounding questions; any party who objects shall serve a copy of the objections on every other adverse party. In response to objections, substitute questions may be served on the objecting party within ten days of the date of service of the objections; substitute questions shall be served on every other adverse party.

(2) Upon motion for good cause by any party, or upon its own initiative, the Trademark Trial and Appeal Board may extend any of the time periods provided by paragraph (d)(1) of this section. Upon receipt of written notice that one or more testimonial depositions are to be taken upon written questions, the Trademark Trial and Appeal Board shall suspend or reschedule other proceedings in the matter to allow for the orderly completion of the depositions upon written questions.

(3) Service of written questions, responses, and cross-examination questions shall be in accordance with § 2.119(b).

(e) Within ten days after the last date when questions, objections, or substitute questions may be served, the party who proposes to take the deposition shall mail a copy of the notice and copies of all the questions to the officer designated in the notice; a copy of the notice and of all the questions mailed to the officer shall be served on every adverse party. The officer designated in the notice shall take the testimony of the witness in response to the questions and shall record each answer immediately after the corresponding question. The officer shall then certify the transcript and mail the transcript and exhibits to the party who took the deposition.

(f) The party who took the deposition shall promptly serve a copy of the transcript, copies of documentary exhibits, and duplicates or photographs of physical exhibits on every adverse party. It is the responsibility of the party who takes the deposition to assure that the transcript is correct (see § 2.125(c)). If the deposition is a discovery deposition, it may be made of record as provided by § 2.120(k). If the deposition is a testimonial deposition, the original, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be filed promptly with the Trademark Trial and Appeal Board.

(g) Objections to questions and answers in depositions upon written questions may be considered at final hearing.

[48 FR 23139, May 23, 1983, as amended at 81 FR 69982, Oct. 7, 2016; 81 FR 89383, Dec. 12, 2016]

§ 2.125 Filing and service of testimony.

(a) One copy of the declaration or affidavit prepared in accordance with § 2.123, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be served on each adverse party at the time the declaration or affidavit is submitted to the Trademark Trial and Appeal Board during the assigned testimony period.

(b) One copy of the transcript of each testimony deposition taken in accordance with § 2.123 or § 2.124, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be served on each adverse party within thirty days after completion of the taking of that testimony. If the transcript with exhibits is not served on each adverse party within thirty days or within an extension of time for the purpose, any adverse party which was not served may have remedy by way of a motion to the Trademark Trial and Appeal Board to reset such adverse party's testimony and/or briefing periods, as may be appropriate. If the deposing party fails to serve a copy of the transcript with exhibits on an adverse party after having been ordered to do so by the Board, the Board, in its discretion, may strike the deposition, or enter judgment as by default against the deposing party, or take any such other action as may be deemed appropriate.

(c) The party who takes testimony is responsible for having all typographical errors in the transcript and all errors of arrangement, indexing and form of the transcript corrected, on notice to each adverse party, prior to the filing of one certified transcript with the Trademark Trial and Appeal Board. The party who takes testimony is responsible for serving on each adverse party one copy of the corrected transcript or, if reasonably feasible, corrected pages to be inserted into the transcript previously served.

(d) One certified transcript and exhibits shall be filed with the Trademark Trial and Appeal Board. Notice of such filing shall be served on each adverse party and a copy of each notice shall be filed with the Board.

(e) Each transcript shall comply with § 2.123(g) with respect to arrangement, indexing and form.

(f) Upon motion by any party, for good cause, the Trademark Trial and Appeal Board may order that any part of an affidavit or declaration or a deposition transcript or any exhibits that directly disclose any trade secret or other confidential research, development, or commercial information may be filed under seal and kept confidential under the provisions of § 2.27(e). If any party or any attorney or agent of a party fails to comply with an order made under this paragraph, the Board may impose any of the sanctions authorized by § 2.120(h).

[81 FR 69983, Oct. 7, 2016]

§ 2.126 Form of submissions to the Trademark Trial and Appeal Board.

(a) Submissions must be made to the Trademark Trial and Appeal Board via ESTTA.

(1) Text in an electronic submission must be filed in at least 11-point type and double-spaced.

(2) Exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission and must be clear and legible.

(b) In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, submissions may be filed in paper form. All submissions in paper form, except the extensions of time to file a notice of opposition, the notice of opposition, the petition to cancel, or answers thereto (*see* §§ 2.101(b)(2), 2.102(a)(2), 2.106(b)(1), 2.111(c)(2), and 2.114(b)(1)), must include a written explanation of such technical problems or extraordinary circumstances. Paper submissions that do not meet the showing required under this paragraph (b) will not be considered. A paper submission, including exhibits and depositions, must meet the following requirements:

(1) A paper submission must be printed in at least 11-point type and double-spaced, with text on one side only of each sheet;

(2) A paper submission must be 8 to 8.5 inches (20.3 to 21.6 cm.) wide and 11 to 11.69 inches (27.9 to 29.7 cm.) long, and contain no tabs or other such de-

vices extending beyond the edges of the paper;

(3) If a paper submission contains dividers, the dividers must not have any extruding tabs or other devices, and must be on the same size and weight paper as the submission;

(4) A paper submission must not be stapled or bound;

(5) All pages of a paper submission must be numbered and exhibits shall be identified in the manner prescribed in § 2.123(g)(2);

(6) Exhibits pertaining to a paper submission must be filed on paper and comply with the requirements for a paper submission.

(c) To be handled as confidential, submissions to the Trademark Trial and Appeal Board that are confidential in whole or part pursuant to § 2.125(f) must be submitted using the “Confidential” selection available in ESTTA or, where appropriate, under a separate paper cover. Both the submission and its cover must be marked confidential and must identify the case number and the parties. A copy of the submission for public viewing with the confidential portions redacted must be submitted concurrently.

[81 FR 69983, Oct. 7, 2016, as amended at 81 FR 89383, Dec. 12, 2016]

§ 2.127 Motions.

(a) Every motion must be submitted in written form and must meet the requirements prescribed in § 2.126. It shall contain a full statement of the grounds, and shall embody or be accompanied by a brief. Except as provided in paragraph (e)(1) of this section, a brief in response to a motion shall be filed within twenty days from the date of service of the motion unless another time is specified by the Trademark Trial and Appeal Board, or the time is extended by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board. If a motion for an extension is denied, the time for responding to the motion remains as specified under this section, unless otherwise ordered. Except as provided in paragraph (e)(1) of this section, a reply brief, if filed, shall be filed within twenty days from the date of service of the brief in response to the motion.

The time for filing a reply brief will not be extended or reopened. The Board will consider no further papers in support of or in opposition to a motion. Neither the brief in support of a motion nor the brief in response to a motion shall exceed twenty-five pages in length in its entirety, including table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary. A reply brief shall not exceed ten pages in length in its entirety. Exhibits submitted in support of or in opposition to a motion are not considered part of the brief for purposes of determining the length of the brief. When a party fails to file a brief in response to a motion, the Board may treat the motion as conceded. An oral hearing will not be held on a motion except on order by the Board.

(b) Any request for reconsideration or modification of an order or decision issued on a motion must be filed within one month from the date thereof. A brief in response must be filed within twenty days from the date of service of the request.

(c) Interlocutory motions, requests, conceded matters, and other matters not actually or potentially dispositive of a proceeding may be acted upon by a single Administrative Trademark Judge of the Trademark Trial and Appeal Board, or by an Interlocutory Attorney or Paralegal of the Board to whom authority to act has been delegated, or by ESTTA. Motions disposed of by orders entitled "By the Trademark Trial and Appeal Board" have the same legal effect as orders by a panel of three Administrative Trademark Judges of the Board.

(d) When any party timely files a potentially dispositive motion, including, but not limited to, a motion to dismiss, a motion for judgment on the pleadings, or a motion for summary judgment, the case is suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion and no party should file any paper which is not germane to the motion except as otherwise may be specified in a Board order. If the case is not disposed of as a result of the motion, proceedings will be re-

sumed pursuant to an order of the Board when the motion is decided.

(e)(1) A party may not file a motion for summary judgment until the party has made its initial disclosures, except for a motion asserting claim or issue preclusion or lack of jurisdiction by the Trademark Trial and Appeal Board. A motion for summary judgment must be filed before the day of the deadline for pretrial disclosures for the first testimony period, as originally set or as reset. A motion under Rule 56(d) of the Federal Rules of Civil Procedure, if filed in response to a motion for summary judgment, shall be filed within thirty days from the date of service of the summary judgment motion. The time for filing a motion under Rule 56(d) will not be extended or reopened. If no motion under Rule 56(d) is filed, a brief in response to the motion for summary judgment shall be filed within thirty days from the date of service of the motion unless the time is extended by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board. If a motion for an extension is denied, the time for responding to the motion for summary judgment may remain as specified under this section. A reply brief, if filed, shall be filed within twenty days from the date of service of the brief in response to the motion. The time for filing a reply brief will not be extended or reopened. The Board will consider no further papers in support of or in opposition to a motion for summary judgment.

(2) For purposes of summary judgment only, the Board will consider any of the following, if a copy is provided with the party's brief on the summary judgment motion: Written disclosures or disclosed documents, a discovery deposition or any part thereof with any exhibit to the part that is filed, an interrogatory and answer thereto with any exhibit made part of the answer, a request for production and the documents or things produced in response thereto, or a request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto). If a motion for summary judgment is denied,

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the parties may stipulate that the materials submitted with briefs on the motion be considered at trial as trial evidence, which may be supplemented by additional evidence during trial.

(f) The Board will not hold any person in contempt, or award attorneys' fees or other expenses to any party.

[48 FR 23140, May 23, 1983, as amended at 54 FR 34900, Aug. 22, 1989; 63 FR 48099, Sept. 9, 1998; 63 FR 52159, Sept. 30, 1998; 68 FR 55768, Sept. 26, 2003; 72 FR 42262, Aug. 1, 2007; 81 FR 69983, Oct. 7, 2016; 82 FR 33806, July 21, 2017]

§ 2.128 Briefs at final hearing.

(a)(1) The brief of the party in the position of plaintiff shall be due not later than sixty days after the date set for the close of rebuttal testimony. The brief of the party in the position of defendant, if filed, shall be due not later than thirty days after the due date of the first brief. A reply brief by the party in the position of plaintiff, if filed, shall be due not later than fifteen days after the due date of the defendant's brief.

(2) When there is a counterclaim, or when proceedings have been consolidated and one party is in the position of plaintiff in one of the involved proceedings and in the position of defendant in another of the involved proceedings, or when there is an interference or a concurrent use registration proceeding involving more than two parties, the Trademark Trial and Appeal Board will set the due dates for the filing of the main brief, and the answering brief, and the rebuttal brief by the parties.

(3) When a party in the position of plaintiff fails to file a main brief, an order may be issued allowing plaintiff until a set time, not less than fifteen days, in which to show cause why the Board should not treat such failure as a concession of the case. If plaintiff fails to file a response to the order, or files a response indicating that plaintiff has lost interest in the case, judgment may be entered against plaintiff. If a plaintiff files a response to the order showing good cause, but does not have any evidence of record and does not move to reopen its testimony period and make a showing of excusable neglect sufficient to support such reopening, judgment may be entered

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against plaintiff for failure to take testimony or submit any other evidence.

(b) Briefs must be submitted in written form and must meet the requirements prescribed in § 2.126. Each brief shall contain an alphabetical index of cited cases. Without prior leave of the Trademark Trial and Appeal Board, a main brief on the case shall not exceed fifty-five pages in length in its entirety, including the table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary; and a reply brief shall not exceed twenty-five pages in its entirety. Evidentiary objections that may properly be raised in a party's brief on the case may instead be raised in an appendix or by way of a separate statement of objections. The appendix or separate statement is not included within the page limit. Any brief beyond the page limits and any brief with attachments outside the stated requirements may not be considered by the Board.

[48 FR 23140, May 23, 1983; 48 FR 27226, June 14, 1983, as amended at 54 FR 34900, Aug. 22, 1989; 68 FR 55768, Sept. 26, 2003; 81 FR 69984, Oct. 7, 2016]

§ 2.129 Oral argument; reconsideration.

(a) If a party desires to have an oral argument at final hearing, the party shall request such argument by a separate notice filed not later than ten days after the due date for the filing of the last reply brief in the proceeding. Oral arguments will be heard by at least three Administrative Trademark Judges or other statutory members of the Trademark Trial and Appeal Board at the time specified in the notice of hearing. If any party appears at the specified time, that party will be heard. Parties and members of the Board may attend in person or, at the discretion of the Board, remotely. If the Board is prevented from hearing the case at the specified time, a new hearing date will be set. Unless otherwise permitted, oral arguments in an inter partes case will be limited to thirty minutes for each party. A party in the position of plaintiff may reserve part of the time allowed for oral argument to present a rebuttal argument.

(b) The date or time of a hearing may be reset, so far as is convenient and proper, to meet the wishes of the parties and their attorneys or other authorized representatives. The Board may, however, deny a request to reset a hearing date for lack of good cause or if multiple requests for rescheduling have been filed.

(c) Any request for rehearing or reconsideration or modification of a decision issued after final hearing must be filed within one month from the date of the decision. A brief in response must be filed within twenty days from the date of service of the request. The times specified may be extended by order of the Trademark Trial and Appeal Board on motion for good cause.

(d) When a party to an *inter partes* proceeding before the Trademark Trial and Appeal Board cannot prevail without establishing constructive use pursuant to section 7(c) of the Act in an application under section 1(b) of the Act, the Trademark Trial and Appeal Board will enter a judgment in favor of that party, subject to the party's establishment of constructive use. The time for filing an appeal or for commencing a civil action under section 21 of the Act shall run from the date of the entry of the judgment.

[48 FR 23141, May 23, 1983, as amended at 54 FR 29554, July 13, 1989; 54 FR 34900, Aug. 22, 1989; 54 FR 37597, Sept. 11, 1989; 72 FR 42263, Aug. 1, 2007; 81 FR 69984, Oct. 7, 2016]

§ 2.130 New matter suggested by the trademark examining attorney.

If, while an *inter partes* proceeding involving an application under section 1 or 44 of the Act is pending, facts appear which, in the opinion of the examining attorney, render the mark in the application unregistrable, the examining attorney should request that the Board remand the application. The Board may suspend the proceeding and remand the application to the trademark examining attorney for an *ex parte* determination of the question of registrability. A copy of the trademark examining attorney's final action will be furnished to the parties to the *inter partes* proceeding following the final determination of registrability by the trademark examining attorney or the Board on appeal. The Board will con-

sider the application for such further *inter partes* action as may be appropriate.

[81 FR 69985, Oct. 7, 2016]

§ 2.131 Remand after decision in *inter partes* proceeding.

If, during an *inter partes* proceeding involving an application under section 1 or 44 of the Act, facts are disclosed which appear to render the mark unregistrable, but such matter has not been tried under the pleadings as filed by the parties or as they might be deemed to be amended under Rule 15(b) of the Federal Rules of Civil Procedure to conform to the evidence, the Trademark Trial and Appeal Board, in lieu of determining the matter in the decision on the proceeding, may remand the application to the trademark examining attorney for reexamination in the event the applicant ultimately prevails in the *inter partes* proceeding. Upon remand, the trademark examining attorney shall reexamine the application in light of the matter referenced by the Board. If, upon reexamination, the trademark examining attorney finally refuses registration to the applicant, an appeal may be taken as provided by §§ 2.141 and 2.142.

[81 FR 69985, Oct. 7, 2016]

§ 2.132 Involuntary dismissal for failure to take testimony.

(a) If the time for taking testimony by any party in the position of plaintiff has expired and it is clear to the Board from the proceeding record that such party has not taken testimony or offered any other evidence, the Board may grant judgment for the defendant. Also, any party in the position of defendant may, without waiving the right to offer evidence in the event the motion is denied, move for dismissal on the ground of the failure of the plaintiff to prosecute. The party in the position of plaintiff shall have twenty days from the date of service of the motion to show cause why judgment should not be rendered dismissing the case. In the absence of a showing of excusable neglect, judgment may be rendered against the party in the position of plaintiff. If the motion is denied, testimony periods will be reset for the

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party in the position of defendant and for rebuttal.

(b) If no evidence other than Office records showing the current status and title of plaintiff's pleaded registration(s) is offered by any party in the position of plaintiff, any party in the position of defendant may, without waiving the right to offer evidence in the event the motion is denied, move for dismissal on the ground that upon the law and the facts the party in the position of plaintiff has shown no right to relief. The party in the position of plaintiff shall have twenty days from the date of service of the motion to file a brief in response to the motion. The Trademark Trial and Appeal Board may render judgment against the party in the position of plaintiff, or the Board may decline to render judgment until all testimony periods have passed. If judgment is not rendered on the motion to dismiss, testimony periods will be reset for the party in the position of defendant and for rebuttal.

(c) A motion filed under paragraph (a) or (b) of this section must be filed before the opening of the testimony period of the moving party, except that the Trademark Trial and Appeal Board may in its discretion grant a motion under paragraph (a) even if the motion was filed after the opening of the testimony period of the moving party.

[48 FR 23141, May 23, 1983, as amended at 51 FR 28710, Aug. 11, 1986; 81 FR 69985, Oct. 7, 2016]

§ 2.133 Amendment of application or registration during proceedings.

(a) An application subject to an opposition may not be amended in substance nor may a registration subject to a cancellation be amended or disclaimed in part, except with the consent of the other party or parties and the approval of the Trademark Trial and Appeal Board, or upon motion granted by the Board.

(b) If, in an *inter partes* proceeding, the Trademark Trial and Appeal Board finds that a party whose application or registration is the subject of the proceeding is not entitled to registration in the absence of a specified restriction to the application or registration, the Board will allow the party time in which to file a motion that the applica-

tion or registration be amended to conform to the findings of the Board, failing which judgment will be entered against the party.

(c) Geographic limitations will be considered and determined by the Trademark Trial and Appeal Board only in the context of a concurrent use registration proceeding.

(d) A plaintiff's pleaded registration will not be restricted in the absence of a counterclaim to cancel the registration in whole or in part, except that a counterclaim need not be filed if the registration is the subject of another proceeding between the same parties or anyone in privity therewith.

[54 FR 37597, Sept. 11, 1989, as amended at 72 FR 42263, Aug. 1, 2007]

§ 2.134 Surrender or voluntary cancellation of registration.

(a) After the commencement of a cancellation proceeding, if the respondent applies for cancellation of the involved registration under section 7(e) of the Act of 1946 without the written consent of every adverse party to the proceeding, judgment shall be entered against the respondent. The written consent of an adverse party may be signed by the adverse party or by the adverse party's attorney or other authorized representative.

(b) After the commencement of a cancellation proceeding, if it comes to the attention of the Trademark Trial and Appeal Board that the respondent has permitted its involved registration to be cancelled under section 8 or section 71 of the Act of 1946, or has failed to renew its involved registration under section 9 of the Act of 1946, or has allowed its registered extension of protection to expire under section 70(b) of the Act of 1946, an order may be issued allowing respondent until a set time, not less than fifteen days, in which to show cause why such cancellation, failure to renew, or expiration should not be deemed to be the equivalent of a cancellation by request of respondent without the consent of the adverse party and should not result in entry of judgment against respondent as provided by paragraph (a) of this section. In the absence of a showing of good and sufficient cause, judgment may be entered against respondent as

provided by paragraph (a) of this section.

[48 FR 23141, May 23, 1983, as amended at 54 FR 34900, Aug. 22, 1989; 63 FR 48100, Sept. 9, 1998; 81 FR 69985, Oct. 7, 2016]

§2.135 Abandonment of application or mark.

After the commencement of an opposition, concurrent use, or interference proceeding, if the applicant files a written abandonment of the application or of the mark without the written consent of every adverse party to the proceeding, judgment shall be entered against the applicant. The written consent of an adverse party may be signed by the adverse party or by the adverse party's attorney or other authorized representative.

[54 FR 34900, Aug. 22, 1989]

§2.136 Status of application or registration on termination of proceeding.

After the Board has issued its decision in an opposition, cancellation or concurrent use proceeding, and after the time for filing any appeal of the decision has expired, or any appeal that was filed has been decided and the Board's decision affirmed, the proceeding will be terminated by the Board. On termination of an opposition, cancellation or concurrent use proceeding, if the judgment is not adverse to the applicant or registrant, the subject application returns to the status it had before the institution of the proceeding and the otherwise appropriate status of the subject registration is unaffected by the proceeding. If the judgment is adverse to the applicant or registrant, the application stands refused or the registration will be cancelled in whole or in part without further action and all proceedings thereon are considered terminated.

[81 FR 69985, Oct. 7, 2016]

APPEALS

§2.141 Ex parte appeals from action of trademark examining attorney.

(a) An applicant may, upon final refusal by the trademark examining attorney, appeal to the Trademark Trial and Appeal Board upon payment of the

prescribed fee for each class in the application for which an appeal is taken, within six months of the date of issuance of the final action. A second refusal on the same grounds may be considered as final by the applicant for purpose of appeal.

(b) The applicant must pay an appeal fee for each class from which the appeal is taken. If the applicant does not pay an appeal fee for at least one class of goods or services before expiration of the six-month statutory filing period, the application will be abandoned. In a multiple-class application, if an appeal fee is submitted for fewer than all classes, the applicant must specify the class(es) in which the appeal is taken. If the applicant timely submits a fee sufficient to pay for an appeal in at least one class, but insufficient to cover all the classes, and the applicant has not specified the class(es) to which the fee applies, the Board will issue a written notice setting a time limit in which the applicant may either pay the additional fees or specify the class(es) being appealed. If the applicant does not submit the required fee or specify the class(es) being appealed within the set time period, the Board will apply the fee(s) to the class(es) in ascending order, beginning with the lowest numbered class.

[73 FR 67772, Nov. 17, 2008]

§2.142 Time and manner of ex parte appeals.

(a) Any appeal filed under the provisions of §2.141 must be filed within six months from the date of the final refusal or the date of the action from which the appeal is taken. An appeal is taken by filing a notice of appeal in written form, as prescribed in §2.126, and paying the appeal fee.

(b)(1) The brief of appellant shall be filed within sixty days from the date of appeal. If the brief is not filed within the time allowed, the appeal may be dismissed. The examining attorney shall, within sixty days after the brief of appellant is sent to the examining attorney, file with the Trademark Trial and Appeal Board a written brief answering the brief of appellant and shall email or mail a copy of the brief to the appellant. The appellant may file a reply brief within twenty days

from the date of mailing of the brief of the examining attorney.

(2) Briefs must meet the requirements prescribed in § 2.126, except examining attorney submissions need not be filed through ESTTA. Without prior leave of the Trademark Trial and Appeal Board, a brief shall not exceed twenty-five pages in length in its entirety, including the table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary. A reply brief from the appellant, if any, shall not exceed ten pages in length in its entirety. Unless authorized by the Board, no further briefs are permitted.

(3) Citation to evidence in briefs should be to the documents in the electronic application record by date, the name of the paper under which the evidence was submitted, and the page number in the electronic record.

(c) All requirements made by the examining attorney and not the subject of appeal shall be complied with prior to the filing of an appeal, and the statement of issues in the brief should note such compliance.

(d) The record in the application should be complete prior to the filing of an appeal. Evidence should not be filed with the Board after the filing of a notice of appeal. If the appellant or the examining attorney desires to introduce additional evidence after an appeal is filed, the appellant or the examining attorney should submit a request to the Board to suspend the appeal and to remand the application for further examination.

(e)(1) If the appellant desires an oral hearing, a request should be made by a separate notice filed not later than ten days after the due date for a reply brief. Oral argument will be heard by at least three Administrative Trademark Judges or other statutory members of the Trademark Trial and Appeal Board at the time specified in the notice of hearing, which may be reset if the Board is prevented from hearing the argument at the specified time or, so far as is convenient and proper, to meet the wish of the appellant or the appellant's attorney or other authorized representative. Appellants, examining attorneys, and members of the

Board may attend in person or, at the discretion of the Board, remotely.

(2) If the appellant requests an oral argument, the examining attorney who issued the refusal of registration or the requirement from which the appeal is taken, or in lieu thereof another examining attorney as designated by a supervisory or managing attorney, shall present an oral argument. If no request for an oral hearing is made by the appellant, the appeal will be decided on the record and briefs.

(3) Oral argument will be limited to twenty minutes by the appellant and ten minutes by the examining attorney. The appellant may reserve part of the time allowed for oral argument to present a rebuttal argument.

(f)(1) If, during an appeal from a refusal of registration, it appears to the Trademark Trial and Appeal Board that an issue not previously raised may render the mark of the appellant unregistrable, the Board may suspend the appeal and remand the application to the examining attorney for further examination to be completed within the time set by the Board.

(2) If the further examination does not result in an additional ground for refusal of registration, the examining attorney shall promptly return the application to the Board, for resumption of the appeal, with a written statement that further examination did not result in an additional ground for refusal of registration.

(3) If the further examination does result in an additional ground for refusal of registration, the examining attorney and appellant shall proceed as provided by §§ 2.61, 2.62, and 2.63. If the ground for refusal is made final, the examining attorney shall return the application to the Board, which shall thereupon issue an order allowing the appellant sixty days from the date of the order to file a supplemental brief limited to the additional ground for the refusal of registration. If the supplemental brief is not filed by the appellant within the time allowed, the appeal may be dismissed.

(4) If the supplemental brief of the appellant is filed, the examining attorney shall, within sixty days after the supplemental brief of the appellant is sent to the examining attorney, file

with the Board a written brief answering the supplemental brief of appellant and shall email or mail a copy of the brief to the appellant. The appellant may file a reply brief within twenty days from the date of mailing of the brief of the examining attorney.

(5) If an oral hearing on the appeal had been requested prior to the remand of the application but not yet held, an oral hearing will be set and heard as provided in paragraph (e) of this section. If an oral hearing had been held prior to the remand or had not been previously requested by the appellant, an oral hearing may be requested by the appellant by a separate notice filed not later than ten days after the due date for a reply brief on the additional ground for refusal of registration. If the appellant files a request for an oral hearing, one will be set and heard as provided in paragraph (e) of this section.

(6) If, during an appeal from a refusal of registration, it appears to the examining attorney that an issue not involved in the appeal may render the mark of the appellant unregistrable, the examining attorney may, by written request, ask the Board to suspend the appeal and to remand the application to the examining attorney for further examination. If the request is granted, the examining attorney and appellant shall proceed as provided by §§ 2.61, 2.62, and 2.63. After the additional ground for refusal of registration has been withdrawn or made final, the examining attorney shall return the application to the Board, which shall resume proceedings in the appeal and take further appropriate action with respect thereto.

(g) An application which has been considered and decided on appeal will not be reopened except for the entry of a disclaimer under section 6 of the Act of 1946 or upon order of the Director, but a petition to the Director to reopen an application will be considered only upon a showing of sufficient cause for consideration of any matter not already adjudicated.

[48 FR 23141, May 23, 1983, as amended at 54 FR 34901, Aug. 22, 1989; 68 FR 55768, Sept. 26, 2003; 72 FR 42263, Aug. 1, 2007; 80 FR 2312, Jan. 16, 2015; 81 FR 69985, Oct. 7, 2016]

§ 2.143 [Reserved]

§ 2.144 Reconsideration of decision on *ex parte* appeal.

Any request for rehearing or reconsideration, or modification of the decision, must be filed within one month from the date of the decision. Such time may be extended by the Trademark Trial and Appeal Board upon a showing of sufficient cause.

[54 FR 29554, July 13, 1989]

§ 2.145 Appeal to court and civil action.

(a) *For an Appeal to the United States Court of Appeals for the Federal Circuit under section 21(a) of the Act.* (1) An applicant for registration, or any party to an interference, opposition, or cancellation proceeding or any party to an application to register as a concurrent user, hereinafter referred to as inter partes proceedings, who is dissatisfied with the decision of the Trademark Trial and Appeal Board, and any registrant who has filed an affidavit or declaration under section 8 or section 71 of the Act or who has filed an application for renewal and is dissatisfied with the decision of the Director (§§ 2.165, 2.184), may appeal to the United States Court of Appeals for the Federal Circuit. It is unnecessary to request reconsideration by the Board before filing any such appeal; however, a party requesting reconsideration must do so before filing a notice of appeal.

(2) In all appeals under section 21(a), the appellant must take the following steps:

(i) File the notice of appeal with the Director, addressed to the Office of the General Counsel, as provided in § 104.2 of this chapter;

(ii) File a copy of the notice of appeal with the Trademark Trial and Appeal Board via ESTTA; and

(iii) Comply with the requirements of the Federal Rules of Appellate Procedure and Rules for the United States Court of Appeals for the Federal Circuit, including serving the requisite number of copies on the Court and paying the requisite fee for the appeal.

(3) *Additional requirements.* (i) The notice of appeal shall specify the party or

parties taking the appeal and shall designate the decision or part thereof appealed from.

(ii) In inter partes proceedings, the notice of appeal must be served as provided in § 2.119.

(b) *For a notice of election under section 21(a)(1) to proceed under section 21(b) of the Act.* (1) Any applicant or registrant in an ex parte case who takes an appeal to the United States Court of Appeals for the Federal Circuit waives any right to proceed under section 21(b) of the Act.

(2) If an adverse party to an appeal taken to the United States Court of Appeals for the Federal Circuit by a defeated party in an inter partes proceeding elects to have all further review proceedings conducted under section 21(b) of the Act, that party must take the following steps:

(i) File a notice of election with the Director, addressed to the Office of the General Counsel, as provided in § 104.2 of this chapter;

(ii) File a copy of the notice of election with the Trademark Trial and Appeal Board via ESTTA; and

(iii) Serve the notice of election as provided in § 2.119.

(c) *For a civil action under section 21(b) of the Act.* (1) Any person who may appeal to the United States Court of Appeals for the Federal Circuit (paragraph (a) of this section), may have remedy by civil action under section 21(b) of the Act. It is unnecessary to request reconsideration by the Board before filing any such civil action; however, a party requesting reconsideration must do so before filing a civil action.

(2) Any applicant or registrant in an ex parte case who seeks remedy by civil action under section 21(b) of the Act must serve the summons and complaint pursuant to Rule 4(i) of the Federal Rules of Civil Procedure with the copy to the Director addressed to the Office of the General Counsel as provided in § 104.2 of this chapter. A copy of the complaint must also be filed with the Trademark Trial and Appeal Board via ESTTA.

(3) The party initiating an action for review of a Board decision in an inter partes case under section 21(b) of the Act must file notice thereof with the

Trademark Trial and Appeal Board via ESTTA no later than five business days after filing the complaint in the district court. The notice must identify the civil action with particularity by providing the case name, case number, and court in which it was filed. A copy of the complaint may be filed with the notice. Failure to file the required notice can result in termination of the Board proceeding and further action within the United States Patent and Trademark Office consistent with the final Board decision.

(d) *Time for appeal or civil action—(1) For an appeal under section 21(a).* The notice of appeal filed pursuant to section 21(a) of the Act must be filed with the Director no later than sixty-three (63) days from the date of the final decision of the Trademark Trial and Appeal Board or the Director. In inter partes cases, the time for filing a notice of cross-appeal expires 14 days after service of the notice of appeal or 63 days from the date of the decision of the Trademark Trial and Appeal Board or the Director, whichever is later.

(2) *For a notice of election under 21(a)(1) and a civil action pursuant to such notice of election.* The times for filing a notice of election under section 21(a)(1) and for commencing a civil action pursuant to a notice of election are governed by section 21(a)(1) of the Act.

(3) *For a civil action under section 21(b).* A civil action must be commenced no later than sixty-three (63) days after the date of the final decision of the Trademark Trial and Appeal Board or Director. In inter partes cases, the time for filing a cross-action expires 14 days after service of the summons and complaint or 63 days from the date of the decision of the Trademark Trial and Appeal Board or the Director, whichever is later.

(4) *Time computation.* (i) If a request for rehearing or reconsideration or modification of the Board decision is filed within the time specified in § 2.127(b), § 2.129(c), or § 2.144, or within any extension of time granted thereunder, the time for filing an appeal or commencing a civil action shall expire no later than sixty-three (63) days after action on the request.

(ii) *Holidays*. The times specified in this section in days are calendar days. If the last day of time specified for an appeal, notice of election, or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday in the District of Columbia pursuant to §2.196.

(e) *Extension of time*. (1) The Director, or the Director's designee, may extend the time for filing an appeal, or commencing a civil action, upon written request if:

(i) Requested before the expiration of the period for filing an appeal or commencing a civil action, and upon a showing of good cause; or

(ii) Requested after the expiration of the period for filing an appeal or commencing a civil action, and upon a showing that the failure to act was the result of excusable neglect.

(2) The request must be filed as provided in §104.2 of this chapter and addressed to the attention of the Office of the Solicitor. A copy of the request should also be filed with the Trademark Trial and Appeal Board via ESTTA.

[81 FR 69986, Oct. 7, 2016, as amended at 81 FR 89383, Dec. 12, 2016]

PETITIONS AND ACTION BY THE DIRECTOR

§2.146 Petitions to the Director.

(a) Petition may be taken to the Director:

(1) From any repeated or final formal requirement of the examiner in the ex parte prosecution of an application if permitted by §2.63(a) and (b);

(2) In any case for which the Act of 1946, or Title 35 of the United States Code, or this Part of Title 37 of the Code of Federal Regulations specifies that the matter is to be determined directly or reviewed by the Director;

(3) To invoke the supervisory authority of the Director in appropriate circumstances;

(4) In any case not specifically defined and provided for by this Part of Title 37 of the Code of Federal Regulations; or

(5) In an extraordinary situation, when justice requires and no other

party is injured thereby, to request a suspension or waiver of any requirement of the rules not being a requirement of the Act of 1946.

(b) Questions of substance arising during the ex parte prosecution of applications, including, but not limited to, questions arising under sections 2, 3, 4, 5, 6, and 23 of the Act of 1946, are not appropriate subject matter for petitions to the Director.

(c) Every petition to the Director shall include a statement of the facts relevant to the petition, the points to be reviewed, the action or relief requested, and the fee required by §2.6. Any brief in support of the petition shall be embodied in or accompany the petition. The petition must be signed by the petitioner, someone with legal authority to bind the petitioner (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under §11.14 of this chapter, in accordance with the requirements of §2.193(e)(5). When facts are to be proved on petition, the petitioner must submit proof in the form of verified statements signed by someone with firsthand knowledge of the facts to be proved, and any exhibits.

(d) Unless a different deadline is specified elsewhere in this chapter, a petition under this section must be filed by not later than:

(1) Two months after the issue date of the action, or date of receipt of the filing, from which relief is requested; or

(2) Where the applicant or registrant declares under §2.20 or 28 U.S.C. 1746 that it did not receive the action, or where no action was issued, the petition must be filed by not later than:

(i) Two months of actual knowledge of the abandonment of an application and not later than six months after the date the trademark electronic records system indicates that the application is abandoned in full or in part;

(ii) Where the registrant has timely filed an affidavit of use or excusable non-use under Section 8 or 71 of the Act, or a renewal application under Section 9 of the Act, two months after the date of actual knowledge of the cancellation/expiration of a registration and not later than six months after the date the trademark electronic

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records system indicates that the registration is cancelled/expired; or

(iii) Two months after the date of actual knowledge of the denial of certification of an international application under § 7.13(b) and not later than six months after the trademark electronic records system indicates that certification is denied.

(e)(1) A petition from the grant or denial of a request for an extension of time to file a notice of opposition must be filed by not later than fifteen days after the issue date of the grant or denial of the request. A petition from the grant of a request must be served on the attorney or other authorized representative of the potential opposer, if any, or on the potential opposer. A petition from the denial of a request must be served on the attorney or other authorized representative of the applicant, if any, or on the applicant. Proof of service of the petition must be made as provided by § 2.119. The potential opposer or the applicant, as the case may be, may file a response by not later than fifteen days after the date of service of the petition and must serve a copy of the response on the petitioner, with proof of service as provided by § 2.119. No further document relating to the petition may be filed.

(2) A petition from an interlocutory order of the Trademark Trial and Appeal Board must be filed by not later than thirty days after the issue date of the order from which relief is requested. Any brief in response to the petition must be filed, with any supporting exhibits, by not later than fifteen days after the date of service of the petition. Petitions and responses to petitions, and any documents accompanying a petition or response under this subsection, must be served on every adverse party pursuant to § 2.119.

(f) An oral hearing will not be held on a petition except when considered necessary by the Director.

(g) The mere filing of a petition to the Director will not act as a stay in any appeal or inter partes proceeding that is pending before the Trademark Trial and Appeal Board, nor stay the period for replying to an Office action in an application, except when a stay is specifically requested and is granted or

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when §§ 2.63(a) and (b) and 2.65(a) are applicable to an ex parte application.

(h) Authority to act on petitions, or on any petition, may be delegated by the Director.

(i) If the Director denies a petition, the petitioner may request reconsideration, if:

(1) The petitioner files the request by not later than:

(i) Two months after the issue date of the decision denying the petition; or

(ii) Two months after the date of actual knowledge of the decision denying the petition and not later than six months after the issue date of the decision where the petitioner declares under § 2.20 or 28 U.S.C. 1746 that it did not receive the decision; and

(2) The petitioner pays a second petition fee under § 2.6.

[82 FR 29409, June 29, 2017]

§ 2.147 [Reserved]

§ 2.148 Director may suspend certain rules.

In an extraordinary situation, when justice requires and no other party is injured thereby, any requirement of the rules in this part not being a requirement of the statute may be suspended or waived by the Director.

CERTIFICATE

§ 2.151 Certificate.

When the Office determines that a mark is registrable, the Office will issue a certificate stating that the applicant is entitled to registration on the Principal Register or on the Supplemental Register. The certificate will state the application filing date, the act under which the mark is registered, the date of issue, and the number of the registration. A reproduction of the mark and pertinent data from the application will be sent with the certificate. A notice of the requirements of sections 8 and 71 of the Act will accompany the certificate.

[68 FR 55769, Sept. 26, 2003]

PUBLICATION OF MARKS REGISTERED UNDER 1905 ACT

AUTHORITY: Secs. 2.153 to 2.156 also issued under sec. 12, 60 Stat. 432; 15 U.S.C. 1062.

§2.153 Publication requirements.

The owner of a mark registered under the provisions of the Trademark Act of 1881 or 1905 may at any time prior to the expiration of the period for which the registration was issued or renewed, upon the payment of the prescribed fee, file an affidavit or declaration in accordance with §2.20 setting forth those goods or services in the registration on or in connection with which said mark is in use in commerce, and stating that the owner claims the benefits of the Act of 1946. The affidavit or declaration must be signed by a person properly authorized to sign on behalf of the owner under §2.193(e)(1).

[74 FR 54909, Oct. 26, 2009]

§2.154 Publication in *Official Gazette*.

A notice of the claim of benefits under the Act of 1946 and a reproduction of the mark will then be published in the *Official Gazette* as soon as practicable. The published mark will retain its original registration number.

§2.155 Notice of publication.

The Office will send the registrant a notice of publication of the mark and of the requirement for filing the affidavit or declaration required by section 8 of the Act.

[64 FR 48924, Sept. 8, 1999]

§2.156 Not subject to opposition; subject to cancellation.

The published mark is not subject to opposition, but is subject to petitions to cancel as specified in §2.111 and to cancellation for failure to file the affidavit or declaration required by section 8 of the Act.

[64 FR 48924, Sept. 8, 1999]

REREGISTRATION OF MARKS REGISTERED
UNDER PRIOR ACTS**§2.158 Reregistration of marks registered under Acts of 1881, 1905, and 1920.**

Trademarks registered under the Act of 1881, the Act of 1905 or the Act of 1920 may be reregistered under the Act of 1946, either on the Principal Register, if eligible, or on the Supplemental Register, but a new complete application for registration must be

filed complying with the rules relating thereto, and such application will be subject to examination and other proceedings in the same manner as other applications filed under the Act of 1946. See §2.26 for use of old drawing.

CANCELLATION FOR FAILURE TO FILE
AFFIDAVIT OR DECLARATION

AUTHORITY: Secs. 2.161 to 2.165 also issued under sec. 8, 60 Stat. 431; 15 U.S.C. 1058.

§2.160 Affidavit or declaration of continued use or excusable nonuse required to avoid cancellation of registration.

(a) During the following time periods, the owner of the registration must file an affidavit or declaration of continued use or excusable nonuse, or the registration will be cancelled:

(1)(i) For registrations issued under the Trademark Act of 1946, on or after the fifth anniversary and no later than the sixth anniversary after the date of registration; or

(ii) For registrations issued under prior Acts, on or after the fifth anniversary and no later than the sixth anniversary after the date of publication under section 12(c) of the Act; and

(2) For all registrations, within the year before the end of every ten-year period after the date of registration.

(3) The affidavit or declaration may be filed within a grace period of six months after the end of the deadline set forth in paragraphs (a)(1) and (a)(2) of this section, with payment of the grace period surcharge per class required by section 8(a)(3) of the Act and §2.6.

(b) For the requirements for the affidavit or declaration, see §2.161.

[64 FR 48924, Sept. 8, 1999, as amended at 75 FR 35976, June 24, 2010]

§2.161 Requirements for a complete affidavit or declaration of continued use or excusable nonuse.

A complete affidavit or declaration under section 8 of the Act must:

(a) Be filed by the owner within the period set forth in §2.160(a);

(b) Include a verified statement attesting to the use in commerce or excusable nonuse of the mark within the period set forth in section 8 of the Act.

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This verified statement must be executed on or after the beginning of the filing period specified in §2.160(a);

(c) Include the U.S. registration number;

(d)(1) Include the fee required by §2.6 for each class that the affidavit or declaration covers;

(2) If the affidavit or declaration is filed during the grace period under section 8(a)(3) of the Act, include the grace period surcharge per class required by §2.6;

(3) If at least one fee is submitted for a multiple-class registration, but the fee is insufficient to cover all the classes, and the class(es) to which the fee(s) should be applied are not specified, the Office will issue a notice requiring either submission of the additional fee(s) or specification of the class(es) to which the initial fee(s) should be applied. Additional fee(s) may be submitted if the requirements of §2.164 are met. If the additional fee(s) are not submitted within the time period set out in the Office action and the class(es) to which the original fee(s) should be applied are not specified, the Office will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class;

(e)(1) Specify the goods, services, or nature of the collective membership organization for which the mark is in use in commerce, and/or the goods, services, or nature of the collective membership organization for which excusable nonuse is claimed under paragraph (f)(2) of this section; and

(2) Specify the goods, services, or classes being deleted from the registration, if the affidavit or declaration covers fewer than all the goods, services, or classes in the registration;

(f)(1) State that the registered mark is in use in commerce; or

(2) If the registered mark is not in use in commerce on or in connection with all the goods, services, or classes specified in the registration, set forth the date when such use of the mark in commerce stopped and the approximate date when such use is expected to resume; and recite facts to show that nonuse as to those goods, services, or classes is due to special circumstances that excuse the nonuse and is not due

to an intention to abandon the mark; and

(g) Include one specimen showing how the mark is in use in commerce for each class in the registration, unless excusable nonuse is claimed under paragraph (f)(2) of this section. When requested by the Office, additional specimens must be provided. The specimen must meet the requirements of §2.56.

(h) The Office may require the owner to furnish such information, exhibits, affidavits or declarations, and such additional specimens as may be reasonably necessary to the proper examination of the affidavit or declaration under section 8 of the Act or for the Office to assess and promote the accuracy and integrity of the register.

(i) Additional requirements for a collective mark: In addition to the above requirements, a complete affidavit or declaration pertaining to a collective mark must:

(1) State that the owner is exercising legitimate control over the use of the mark in commerce; and

(2) If the registration issued from an application based solely on section 44 of the Act, state the nature of the owner's control over the use of the mark by the members in the first affidavit or declaration filed under paragraph (a) of this section.

(j) Additional requirements for a certification mark: In addition to the above requirements, a complete affidavit or declaration pertaining to a certification mark must:

(1) Include a copy of the certification standards specified in §2.45(a)(4)(i)(B);

(i) *Submitting certification standards for the first time.* If the registration issued from an application based solely on section 44 of the Act, include a copy of the certification standards in the first affidavit or declaration filed under paragraph (a) of this section; or

(ii) *Certification standards submitted in prior filing.* If the certification standards in use at the time of filing the affidavit or declaration have not changed since the date they were previously submitted to the Office, include a statement to that effect; if the certification standards in use at the time of filing the affidavit or declaration have

changed since the date they were previously submitted to the Office, include a copy of the revised certification standards;

(2) State that the owner is exercising legitimate control over the use of the mark in commerce; and

(3) Satisfy the requirements of § 2.45(a)(4)(i)(A) and (C).

(k) For requirements of a complete affidavit or declaration of use in commerce or excusable nonuse for a registration that issued from a section 66(a) basis application, see § 7.37.

[64 FR 48924, Sept. 8, 1999, as amended at 67 FR 79522, Dec. 30, 2002; 68 FR 55769, Sept. 26, 2003; 73 FR 47686, Aug. 14, 2008; 73 FR 67773, Nov. 17, 2008; 74 FR 54910, Oct. 26, 2009; 75 FR 35976, June 24, 2010; 77 FR 30207, May 22, 2012; 80 FR 33188, June 11, 2015; 82 FR 6265, Jan. 19, 2017]

§ 2.162 Notice to registrant.

When a certificate of registration is originally issued, the Office includes a notice of the requirement for filing the affidavit or declaration of use or excusable nonuse under section 8 of the Act. However the affidavit or declaration must be filed within the time period required by section 8 of the Act even if this notice is not received.

[64 FR 48925, Sept. 8, 1999]

§ 2.163 Acknowledgment of receipt of affidavit or declaration.

The Office will issue a notice as to whether an affidavit or declaration is acceptable, or the reasons for refusal.

(a) If the affidavit or declaration is filed within the time periods set forth in section 8 of the Act, deficiencies may be corrected after notification from the Office if the requirements of § 2.164 are met.

(b) A response to the refusal must be filed within six months of the date of issuance of the Office action, or before the end of the filing period set forth in section 8(a) of the Act, whichever is later. The response must be signed by the owner, someone with legal authority to bind the owner (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(2).

(c) If no response is filed within this time period, the registration will be cancelled, unless time remains in the grace period under section 8(a)(3) of the Act. If time remains in the grace period, the owner may file a complete, new affidavit.

[75 FR 35976, June 24, 2010, as amended at 76 FR 69133, Nov. 8, 2011]

§ 2.164 Correcting deficiencies in affidavit or declaration.

(a) If the affidavit or declaration is filed within the time periods set forth in section 8 of the Act, deficiencies may be corrected after notification from the Office, as follows:

(1) *Correcting deficiencies in affidavits or declarations timely filed within the periods set forth in sections 8(a)(1) and 8(a)(2) of the Act.* If the affidavit or declaration is timely filed within the relevant filing period set forth in section 8(a)(1) or section 8(a)(2) of the Act, deficiencies may be corrected before the end of this filing period without paying a deficiency surcharge. Deficiencies may be corrected after the end of this filing period with payment of the deficiency surcharge required by section 8(c) of the Act and § 2.6.

(2) *Correcting deficiencies in affidavits or declarations filed during the grace period.* If the affidavit or declaration is filed during the six-month grace period provided by section 8(a)(3) of the Act, deficiencies may be corrected before the expiration of the grace period without paying a deficiency surcharge. Deficiencies may be corrected after the expiration of the grace period with payment of the deficiency surcharge required by section 8(c) of the Act and § 2.6.

(b) If the affidavit or declaration is not filed within the time periods set forth in section 8 of the Act, the registration will be cancelled.

[75 FR 35976, June 24, 2010, as amended at 76 FR 69133, Nov. 8, 2011]

§ 2.165 Petition to Director to review refusal.

(a) A response to the examiner's initial refusal to accept an affidavit or declaration is required before filing a petition to the Director, unless the examiner directs otherwise. See § 2.163(b)

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for the deadline for responding to an examiner's Office action.

(b) If the examiner maintains the refusal of the affidavit or declaration, the owner may file a petition to the Director to review the action. The petition must be filed within six months of the date of issuance of the action maintaining the refusal, or the Office will cancel the registration and issue a notice of the cancellation.

(c) A decision by the Director is necessary before filing an appeal or commencing a civil action in any court.

[64 FR 48925, Sept. 8, 1999, as amended at 73 FR 67773, Nov. 17, 2008]

§2.166 Affidavit of continued use or excusable nonuse combined with renewal application.

An affidavit or declaration under section 8 of the Act and a renewal application under section 9 of the Act may be combined into a single document, provided that the document meets the requirements of both sections 8 and 9 of the Act.

[64 FR 48925, Sept. 8, 1999]

AFFIDAVIT OR DECLARATION UNDER SECTION 15

§2.167 Affidavit or declaration under section 15.

The affidavit or declaration in accordance with §2.20 provided by section 15 of the Act for acquiring incontestability for a mark registered on the Principal Register or a mark registered under the Trademark Act of 1881 or 1905 and published under section 12(c) of the Act (see §2.153) must:

(a) Be verified;

(b) Identify the certificate of registration by the certificate number and date of registration;

(c) For a trademark, service mark, collective trademark, collective service mark, and certification mark, recite the goods or services stated in the registration on or in connection with which the mark has been in continuous use in commerce for a period of five years after the date of registration or date of publication under section 12(c) of the Act, and is still in use in commerce; for a collective membership mark, describe the nature of the owner's collective membership organiza-

tion specified in the registration in connection with which the mark has been in continuous use in commerce for a period of five years after the date of registration or date of publication under section 12(c) of the Act, and is still in use in commerce;

(d) Specify that there has been no final decision adverse to the owner's claim of ownership of such mark for such goods, services, or collective membership organization, or to the owner's right to register the same or to keep the same on the register;

(e) Specify that there is no proceeding involving said rights pending in the Office or in a court and not finally disposed of;

(f) Be filed within one year after the expiration of any five-year period of continuous use following registration or publication under section 12(c) of the Act; and

(g) Include the fee required by §2.6 for each class to which the affidavit or declaration pertains in the registration. If no fee, or a fee insufficient to cover at least one class, is filed at an appropriate time, the affidavit or declaration will not be refused if the required fee(s) (see §2.6) is filed in the Office within the time limit set forth in the notification of this defect by the Office. If the submitted fees are insufficient to cover all classes in the registration, the particular class or classes to which the affidavit or declaration pertains should be specified.

(h) If the affidavit or declaration fails to satisfy any of the requirements in paragraphs (a) through (g) of this section, the owner will be notified in an Office action that the affidavit or declaration cannot be acknowledged. If a response is not received within the time period provided or does not satisfy the requirements of the Office action, the affidavit or declaration will be abandoned.

(i) If the affidavit or declaration satisfies paragraphs (a) through (g) of this section, the Office will issue a notice of acknowledgement.

(j) An affidavit or declaration may be abandoned by the owner upon petition to the Director under §2.146 either before or after the notice of acknowledgement has issued.

(k) If an affidavit or declaration is abandoned, the owner may file a new affidavit or declaration with a new filing fee.

(Sec. 15, 60 Stat. 433; 15 U.S.C. 1065; 35 U.S.C. 6; 15 U.S.C. 1113, 1123)

[30 FR 13193, Oct. 16, 1965, as amended at 47 FR 41282, Sept. 17, 1982; 64 FR 48925, Sept. 8, 1999; 73 FR 67773, Nov. 17, 2008; 74 FR 54910, Oct. 26, 2009; 80 FR 33188, June 11, 2015]

§2.168 Affidavit or declaration under section 15 combined with affidavit or declaration under sections 8 or 71, or with renewal application.

(a) The affidavit or declaration filed under section 15 of the Act may also be used as the affidavit or declaration required by section 8, if the affidavit or declaration meets the requirements of both sections 8 and 15. The affidavit or declaration filed under section 15 of the Act may also be used as the affidavit or declaration required by section 71, if the affidavit or declaration meets the requirements of both sections 71 and 15.

(b) The affidavit or declaration filed under section 15 of the Act may be combined with an application for renewal of a registration under section 9 of the Act, if the requirements of both sections 9 and 15 are met.

[64 FR 48925, Sept. 8, 1999, as amended at 75 FR 35976, June 24, 2010]

CORRECTION, DISCLAIMER, SURRENDER,
ETC.

§2.171 New certificate on change of ownership.

(a) *Full change of ownership.* If the ownership of a registered mark changes, the new owner may request that a new certificate of registration be issued in the name of the new owner. The assignment or other document changing title must be recorded in the Office. The request for the new certificate must include the fee required by §2.6(a)(8) and be signed by the owner of the registration, someone with legal authority to bind the owner (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under §11.14 of this chapter. In a registered extension of protection, the assignment must be recorded with the International Bureau of the World Intellec-

tual Property Organization before it can be recorded in the Office (see §7.22).

(b) *Partial change of ownership.* (1) In a registration resulting from an application based on section 1 or section 44 of the Act, if ownership of a registration has changed with respect to some but not all of the goods and/or services, the owner(s) may file a request that the registration be divided into two or more separate registrations. The assignment or other document changing title must be recorded in the Office. The request to divide must include the fee required by §2.6(a)(8) for each new registration created by the division, and be signed by the owner of the registration, someone with legal authority to bind the owner (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under §11.14 of this chapter, in accordance with §2.193(e)(2) of this chapter.

(2)(i) When the International Bureau of the World Intellectual Property Organization notifies the Office that an international registration has been divided as the result of a change of ownership with respect to some but not all of the goods and/or services, the Office will construe the International Bureau's notice as a request to divide. The Office will update Office records to reflect the change in ownership, divide out the assigned goods and/or services from the registered extension of protection (parent registration), and publish notice of the parent registration in the *Official Gazette*.

(ii) The Office will create a new registration number for the child registration, and enter the information about the new registration in its automated records. The Office will notify the new owner that the new owner must pay the fee required by §2.6 to obtain a new registration certificate for the child registration. It is not necessary for the new owner to file a separate request to divide.

(iii) The Office will not divide a registered extension of protection unless the International Bureau notifies the Office that the international registration has been divided.

[73 FR 67774, Nov. 17, 2008, as amended at 74 FR 54910, Oct. 26, 2009; 80 FR 2312, Jan. 16, 2015]

§ 2.172 Surrender for cancellation.

Upon application by the owner, the Director may permit any registration to be surrendered for cancellation. The application for surrender must be signed by the owner of the registration, someone with legal authority to bind the owner (*e.g.*, a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter. When a registration has more than one class, one or more entire class(es) but fewer than the total number of classes may be surrendered. Deletion of fewer than all the goods or services in a single class constitutes amendment of the registration as to that class (*see* § 2.173), rather than surrender. A surrender for cancellation may not subsequently be withdrawn.

[80 FR 2312, Jan. 16, 2015]

§ 2.173 Amendment of registration.

(a) *Form of amendment.* The owner of a registration may apply to amend a registration or to disclaim part of the mark in the registration. The owner must submit a written request specifying the amendment or disclaimer. If the registration is involved in an *inter partes* proceeding before the Trademark Trial and Appeal Board, the request must be filed by appropriate motion to the Board.

(b) *Requirements for request.* A request for amendment or disclaimer must:

(1) Include the fee required by § 2.6;

(2) Be verified and signed in accordance with § 2.193(e)(6); and

(3) If the amendment involves a change in the mark: one new specimen per class showing the mark as used on or in connection with the goods, services, or collective membership organization; a verified statement that the specimen was in use in commerce at least as early as the filing date of the amendment; and a new drawing of the amended mark. When requested by the Office, additional specimens must be provided.

(4) The Office may require the owner to furnish such specimens, information, exhibits, and affidavits or declarations as may be reasonably necessary to the proper examination of the amendment.

(c) *Registration must still contain registrable matter.* The registration as amended must still contain registrable matter, and the mark as amended must be registrable as a whole.

(d) *Amendment may not materially alter the mark.* An amendment or disclaimer that materially alters the character of the mark will not be permitted, in accordance with section 7(e) of the Act.

(e) *Amendment of identification of goods, services, or collective membership organization.* No amendment in the identification of goods or services, or description of the nature of the collective membership organization, in a registration will be permitted except to restrict the identification or to change it in ways that would not require republication of the mark.

(f) *Amendment of certification statement for certification marks.* An amendment of the certification statement specified in § 2.45(a)(4)(i)(A) or (a)(4)(ii)(A) that would materially alter the certification statement will not be permitted, in accordance with section 7(e) of the Act.

(g) *Conforming amendments may be required.* If the registration includes a disclaimer, description of the mark, or other miscellaneous statement, any request to amend the registration must include a request to make any necessary conforming amendments to the disclaimer, description, or other statement.

(h) *Elimination of disclaimer.* No amendment seeking the elimination of a disclaimer will be permitted, unless deletion of the disclaimed portion of the mark is also sought.

(i) *No amendment to add or delete section 2(f) claim of acquired distinctiveness.* An amendment seeking the addition or deletion of a claim of acquired distinctiveness will not be permitted.

[73 FR 67774, Nov. 17, 2008, as amended at 77 FR 30207, May 22, 2012; 80 FR 33189, June 11, 2015]

§ 2.174 Correction of Office mistake.

Whenever Office records clearly disclose a material mistake in a registration, incurred through the fault of the Office, the Office will issue a certificate of correction stating the fact and nature of the mistake, signed by the Director or by an employee designated

by the Director, without charge. Thereafter, the corrected certificate shall have the same effect as if it had been originally issued in the corrected form. In the discretion of the Director, the Office may issue a new certificate of registration without charge.

[73 FR 67774, Nov. 17, 2008]

§ 2.175 Correction of mistake by owner.

(a) Whenever a mistake has been made in a registration and a showing has been made that the mistake occurred in good faith through the fault of the owner, the Director may issue a certificate of correction. In the discretion of the Director, the Office may issue a new certificate upon payment of the required fee, provided that the correction does not involve such changes in the registration as to require republication of the mark.

(b) An application for such action must:

(1) Include the following:

(i) Specification of the mistake for which correction is sought;

(ii) Description of the manner in which it arose; and

(iii) A showing that it occurred in good faith;

(2) Be verified; and

(3) Be accompanied by the required fee.

(Sec. 7, 60 Stat. 430, as amended; 15 U.S.C. 1057)

[30 FR 13193, Oct. 16, 1965, as amended at 31 FR 5262, Apr. 1, 1966; 69 FR 51364, Aug. 19, 2004; 73 FR 67774, Nov. 17, 2008; 80 FR 33189, June 11, 2015]

§ 2.176 Consideration of above matters.

The matters in §§ 2.171 to 2.175 will be considered in the first instance by the Post Registration examiners, except for requests to amend registrations involved in *inter partes* proceedings before the Trademark Trial and Appeal Board, as specified in § 2.173(a), which shall be considered by the Board. If an action of the examiner is adverse, the owner of the registration may petition the Director to review the action under § 2.146. If the owner does not respond to an adverse action of the examiner within six months of the date of

issuance, the matter will be considered abandoned.

[73 FR 67774, Nov. 17, 2008]

TERM AND RENEWAL

AUTHORITY: Secs. 2.181 to 2.184 also issued under sec. 9, 60 Stat. 431; 15 U.S.C. 1059.

§ 2.181 Term of original registrations and renewals.

(a)(1) Subject to the provisions of section 8 of the Act requiring an affidavit or declaration of continued use or excusable nonuse, registrations issued or renewed prior to November 16, 1989, whether on the Principal Register or on the Supplemental Register, remain in force for twenty years from their date of issue or the date of renewal, and may be further renewed for periods of ten years, unless previously cancelled or surrendered.

(2) Subject to the provisions of section 8 of the Act requiring an affidavit or declaration of continued use or excusable nonuse, registrations issued or renewed on or after November 16, 1989, whether on the Principal Register or on the Supplemental Register, remain in force for ten years from their date of issue or the date of renewal, and may be further renewed for periods of ten years, unless previously cancelled or surrendered.

(b) Registrations issued under the Acts of 1905 and 1881 remain in force for their unexpired terms and may be renewed in the same manner as registrations under the Act of 1946.

(c) Registrations issued under the Act of 1920 cannot be renewed unless renewal is required to support foreign registrations and in such case may be renewed on the Supplemental Register in the same manner as registrations under the Act of 1946.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37597, Sept. 11, 1989; 64 FR 48926, Sept. 8, 1999]

§ 2.182 Time for filing renewal application.

An application for renewal must be filed within one year before the expiration date of the registration, or within the six-month grace period after the expiration date of the registration. If no renewal application is filed within

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this period, the registration will expire.

[64 FR 48926, Sept. 8, 1999]

§2.183 Requirements for a complete renewal application.

A complete renewal application must include:

(a) A request for renewal of the registration, signed by the registrant or the registrant's representative;

(b) The fee required by §2.6 for each class;

(c) The additional fee required by §2.6 for each class if the renewal application is filed during the six-month grace period set forth in section 9(a) of the Act;

(d) If the renewal application covers less than all the goods, services, or classes in the registration, then a list specifying the particular goods, services, or classes to be renewed.

(e) If at least one fee is submitted for a multiple-class registration, but the fee is insufficient to cover all the classes and the class(es) to which the fee(s) should be applied are not specified, the Office will issue a notice requiring either the submission of additional fee(s) or an indication of the class(es) to which the original fee(s) should be applied. Additional fee(s) may be submitted if the requirements of §2.185 are met. If the required fee(s) are not submitted and the class(es) to which the original fee(s) should be applied are not specified, the Office will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class.

(f) Renewals of registrations issued under a prior classification system will be processed on the basis of that system, unless the registration has been amended to adopt international classification pursuant to §2.85(e)(3).

[64 FR 48926, Sept. 8, 1999, as amended at 67 FR 79523, Dec. 30, 2002; 73 FR 67775, Nov. 17, 2008; 80 FR 33189, June 11, 2015]

§2.184 Refusal of renewal.

(a) If the renewal application is not acceptable, the Office will issue a notice stating the reason(s) for refusal.

(b)(1) The registrant must file a response to the refusal of renewal within six months of the date of issuance of

the Office action, or before the expiration date of the registration, whichever is later. If no response is filed within this time period, the registration will expire, unless time remains in the grace period under section 9(a) of the Act. If time remains in the grace period, the registrant may file a complete new renewal application.

(2) The response must be signed by the registrant, someone with legal authority to bind the registrant (e.g., a corporate officer or general partner of a partnership), or a practitioner who meets the requirements of §11.14 of this chapter, in accordance with the requirements of §2.193(e)(2).

(c) If the renewal application is not filed within the time periods set forth in section 9(a) of the Act, the registration will expire.

[64 FR 48926, Sept. 8, 1999, as amended at 73 FR 67775, Nov. 17, 2008; 74 FR 54910, Oct. 26, 2009]

§2.185 Correcting deficiencies in renewal application.

(a) If the renewal application is filed within the time periods set forth in section 9(a) of the Act, deficiencies may be corrected after notification from the Office, as follows:

(1) *Correcting deficiencies in renewal applications filed within one year before the expiration date of the registration.* If the renewal application is filed within one year before the expiration date of the registration, deficiencies may be corrected before the expiration date of the registration without paying a deficiency surcharge. Deficiencies may be corrected after the expiration date of the registration with payment of the deficiency surcharge required by section 9(a) of the Act and §2.6.

(2) *Correcting deficiencies in renewal applications filed during the grace period.* If the renewal application is filed during the six-month grace period, deficiencies may be corrected before the expiration of the grace period without paying a deficiency surcharge. Deficiencies may be corrected after the expiration of the grace period with payment of the deficiency surcharge required by section 9(a) of the Act and §2.6.

(b) If the renewal application is not filed within the time periods set forth

in section 9(a) of the Act, the registration will expire. This deficiency cannot be cured.

[64 FR 48926, Sept. 8, 1999, as amended at 80 FR 2312, Jan. 16, 2015]

§ 2.186 Petition to Director to review refusal of renewal.

(a) A response to the examiner's initial refusal of the renewal application is required before filing a petition to the Director, unless the examiner directs otherwise. See § 2.184(b) for the deadline for responding to an examiner's Office action.

(b) If the examiner maintains the refusal of the renewal application, a petition to the Director to review the refusal may be filed. The petition must be filed within six months of the date of issuance of the Office action maintaining the refusal, or the renewal application will be abandoned and the registration will expire.

(c) A decision by the Director is necessary before filing an appeal or commencing a civil action in any court.

[64 FR 48926, Sept. 8, 1999, as amended at 73 FR 67775, Nov. 17, 2008]

GENERAL INFORMATION AND
CORRESPONDENCE IN TRADEMARK CASES

SOURCE: 68 FR 48289, Aug. 13, 2003, unless otherwise noted.

§§ 2.188–2.189 [Reserved]

§ 2.190 Addresses for trademark correspondence with the United States Patent and Trademark Office.

(a) *Trademark correspondence—in general.* All trademark-related documents filed on paper, except documents sent to the Assignment Recordation Branch for recordation; requests for copies of trademark documents; and certain documents filed under the Madrid Protocol as specified in paragraph (e) of this section, should be addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451. All trademark-related documents may be delivered by hand, during the hours the Office is open to receive correspondence, to the Trademark Assistance Center, James Madison Building—East Wing,

Concourse Level, 600 Dulany Street, Alexandria, Virginia 22314.

(b) *Electronic trademark documents.* An applicant may transmit a trademark document through TEAS, at <http://www.uspto.gov>. Documents that relate to proceedings before the Trademark Trial and Appeal Board shall be filed directly with the Board electronically through ESTTA, at <http://estta.uspto.gov>.

(c) *Trademark assignments.* Requests to record documents in the Assignment Recordation Branch may be filed through the Office's Web site, at <http://www.uspto.gov>. Paper documents and cover sheets to be recorded in the Assignment Recordation Branch should be addressed to: Mail Stop Assignment Recordation Branch, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450. See § 3.27 of this chapter.

(d) *Requests for copies of trademark documents.* Copies of trademark documents can be ordered through the Office's web site at www.uspto.gov. Paper requests for certified or uncertified copies of trademark documents should be addressed to: Mail Stop Document Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450.

(e) *Certain Documents Relating to International Applications and Registrations.* International applications under § 7.11, subsequent designations under § 7.21, responses to notices of irregularity under § 7.14, requests to record changes in the International Register under § 7.23 and § 7.24, requests to note replacements under § 7.28, requests for transformation under § 7.31, and petitions to the Director to review an action of the Office's Madrid Processing Unit, when filed by mail, must be mailed to: Madrid Processing Unit, 600 Dulany Street, MDE-7B87, Alexandria, VA 22314-5793.

[68 FR 48289, Aug. 13, 2003, as amended at 69 FR 57184, Sept. 24, 2004; 69 FR 63321, Nov. 1, 2004; 72 FR 18908, Apr. 16, 2007; 81 FR 69987, Oct. 7, 2016]

§ 2.191 Business to be transacted in writing.

All business with the Office should be transacted in writing. The personal appearance of applicants or their representatives at the Office is unnecessary. The action of the Office will be based exclusively on the written record. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt. The Office encourages parties to file documents through TEAS wherever possible, and mandates that documents in proceedings before the Trademark Trial and Appeal Board be filed through ESTTA.

[81 FR 69987, Oct. 7, 2016]

§ 2.192 Business to be conducted with decorum and courtesy.

Trademark applicants, registrants, and parties to proceedings before the Trademark Trial and Appeal Board and their attorneys or agents are required to conduct their business with decorum and courtesy. Documents presented in violation of this requirement will be submitted to the Director and will be returned by the Director's direct order. Complaints against trademark examining attorneys and other employees must be made in correspondence separate from other documents.

§ 2.193 Trademark correspondence and signature requirements.

(a) *Signature required.* Each piece of correspondence that requires a signature must bear:

(1) A handwritten signature personally signed in permanent ink by the person named as the signatory, or a true copy thereof; or

(2) An electronic signature that meets the requirements of paragraph (c) of this section, personally entered by the person named as the signatory. The Office will accept an electronic signature that meets the requirements of paragraph (c) of this section on correspondence filed on paper, by facsimile transmission (§ 2.195(c)), or through TEAS or ESTTA.

(b) *Copy of original signature.* If a copy, such as a photocopy or facsimile copy of an original signature is filed,

the filer should retain the original as evidence of authenticity. If a question of authenticity arises, the Office may require submission of the original.

(c) *Requirements for electronic signature.* A person signing a document electronically must:

(1) Personally enter any combination of letters, numbers, spaces and/or punctuation marks that he or she has adopted as a signature, placed between two forward slash (“/”) symbols in the signature block on the electronic submission; or

(2) Sign the document using some other form of electronic signature specified by the Director.

(d) *Signatory must be identified.* The name of the person who signs a document in connection with a trademark application, registration, or proceeding before the Trademark Trial and Appeal Board must be set forth in printed or typed form immediately below or adjacent to the signature, or identified elsewhere in the filing (e.g., in a cover letter or other document that accompanies the filing).

(e) *Proper person to sign.* Documents filed in connection with a trademark application or registration must be signed by a proper person. Unless otherwise specified by law, the following requirements apply:

(1) *Verified statement of facts.* A verified statement in support of an application for registration, amendment to an application for registration, allegation of use under § 2.76 or § 2.88, request for extension of time to file a statement of use under § 2.89, or an affidavit under section 8, 12(c), 15, or 71 of the Act must satisfy the requirements of § 2.2(n), and be signed by the owner or a person properly authorized to sign on behalf of the owner. A person who is properly authorized to verify facts on behalf of an owner is:

(i) A person with legal authority to bind the owner (e.g., a corporate officer or general partner of a partnership);

(ii) A person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or

(iii) An attorney as defined in § 11.1 of this chapter who has an actual written

or verbal power of attorney or an implied power of attorney from the owner.

(2) *Responses, amendments to applications, requests for express abandonment, requests for reconsideration of final actions, and requests to divide.* Responses to Office actions, amendments to applications, requests for express abandonment, requests for reconsideration of final actions, and requests to divide must be signed by the owner of the application or registration, someone with legal authority to bind the owner (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under §11.14 of this chapter, in accordance with the following guidelines:

(i) If the owner is represented by a practitioner qualified to practice before the Office under §11.14 of this chapter, the practitioner must sign, except where the owner is required to sign the correspondence; or

(ii) If the owner is not represented by a practitioner qualified to practice under §11.14 of this chapter, the individual owner or someone with legal authority to bind the owner (e.g., a corporate officer or general partner of a partnership) must sign. In the case of joint owners who are not represented by a qualified practitioner, all must sign.

(3) *Powers of attorney and revocations of powers of attorney.* Powers of attorney and revocations of powers of attorney must be signed by the individual applicant, registrant or party to a proceeding pending before the Office, or by someone with legal authority to bind the applicant, registrant, or party (e.g., a corporate officer or general partner of a partnership). In the case of joint applicants, registrants, or parties, all must sign. Once the applicant, registrant or party has designated a qualified practitioner(s), the named practitioner may sign an associate power of attorney appointing another qualified practitioner(s) as an additional person(s) authorized to prosecute the application or registration. If the applicant, registrant, or party revokes the original power of attorney, the revocation discharges any associate power signed by the practitioner whose power has been revoked. If the practitioner

who signed an associate power withdraws, the withdrawal discharges any associate power signed by the withdrawing practitioner upon acceptance of the request for withdrawal by the Office.

(4) *Petitions to revive under §2.66.* A petition to revive under §2.66 must be signed by someone with firsthand knowledge of the facts regarding unintentional delay.

(5) *Petitions to Director under §2.146.* A petition to the Director under §2.146 must be signed by the petitioner, someone with legal authority to bind the petitioner (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under §11.14 of this chapter, in accordance with the following guidelines:

(i) If the petitioner is represented by a practitioner qualified to practice before the Office under §11.14 of this chapter, the practitioner must sign; or

(ii) If the petitioner is not represented by a practitioner authorized to practice before the Office under §11.14 of this chapter, the individual petitioner or someone with legal authority to bind the petitioner (e.g., a corporate officer or general partner of a partnership) must sign. In the case of joint petitioners, all must sign.

(6) *Requests for correction, amendment or surrender of registrations.* A request for correction, amendment or surrender of a registration must be signed by the owner of the registration, someone with legal authority to bind the owner (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice before the Office under §11.14 of this chapter. In the case of joint owners who are not represented by a qualified practitioner, all must sign.

(7) *Renewal applications.* A renewal application must be signed by the registrant or the registrant's representative.

(8) *Designations and revocations of domestic representative.* A designation or revocation of a domestic representative must be signed by the applicant or registrant, someone with legal authority to bind the applicant or registrant (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under §11.14

of this chapter. In the case of joint applicants or registrants, all must sign.

(9) *Requests to change correspondence address in an application or registration.* A notice of change of correspondence address in an application or registration must be signed by the applicant or registrant, someone with legal authority to bind the applicant or registrant (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the following guidelines:

(i) If the applicant or registrant is represented by a practitioner qualified to practice before the Office under § 11.14 of this chapter, the practitioner must sign; or

(ii) If the applicant or registrant is not represented by a practitioner qualified to practice before the Office under § 11.14, the individual applicant or registrant or someone with legal authority to bind the applicant or registrant (e.g., a corporate officer or general partner of a partnership) must sign. In the case of joint applicants or joint registrants, all must sign.

(10) *Cover letters.* A person transmitting paper documents to the Office may sign a cover letter or transmittal letter. The Office neither requires cover letters nor questions the authority of a person who signs a communication that merely transmits paper documents.

(f) *Signature as certification.* The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any document by any person, whether a practitioner or non-practitioner, constitutes a certification under § 11.18(b) of this chapter. Violations of § 11.18(b) of this chapter may jeopardize the validity of the application or registration, and may result in the imposition of sanctions under § 11.18(c) of this chapter. Any practitioner violating § 11.18(b) of this chapter may also be subject to disciplinary action. See § 11.18(d) and § 11.804 of this chapter.

(g) *Separate copies for separate files.* (1) Since each file must be complete in itself, a separate copy of every document to be filed in connection with a trademark application, registration, or *inter partes* proceeding must be fur-

nished for each file to which the document pertains, even though the contents of the documents filed in multiple files may be identical.

(2) Parties should not file duplicate copies of correspondence in a single application, registration, or proceeding file, unless the Office requires the filing of duplicate copies. The Office may dispose of duplicate copies of correspondence.

(h) *Separate documents for separate branches of the Office.* Since different branches or sections of the Office may consider different matters, each distinct subject, inquiry or order must be contained in a separate document to avoid confusion and delay in answering correspondence.

(i) *Certified documents required by statute.* When a statute requires that a document be certified, a copy or facsimile transmission of the certification is not acceptable.

[74 FR 54910, Oct. 26, 2009, as amended at 80 FR 33189, June 11, 2015; 83 FR 1559, Jan. 12, 2018]

§ 2.194 Identification of trademark application or registration.

(a) No correspondence relating to a trademark application should be filed prior to receipt of the application serial number.

(b) (1) A letter about a trademark application should identify the serial number, the name of the applicant, and the mark.

(2) A letter about a registered trademark should identify the registration number, the name of the registrant, and the mark.

§ 2.195 Receipt of trademark correspondence.

(a) *Date of receipt and Priority Mail Express® date of deposit.* Trademark correspondence received in the Office is given a filing date as of the date of receipt except as follows:

(1) The Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for correspondence transmitted electronically under paragraph (a)(2) of this section or transmitted by facsimile under paragraph (a)(3) of this section, no correspondence is received

in the Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.

(2) Trademark-related correspondence transmitted electronically will be given a filing date as of the date on which the Office receives the transmission.

(3) Correspondence transmitted by facsimile will be given a filing date as of the date on which the complete transmission is received in the Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the filing date will be the next succeeding day that is not a Saturday, Sunday, or Federal holiday within the District of Columbia.

(4) Correspondence filed in accordance with § 2.198 will be given a filing date as of the date of deposit as Priority Mail Express® with the United States Postal Service.

(b) *Correspondence delivered by hand.* Correspondence may be delivered by hand during hours the Office is open to receive correspondence.

(c) *Facsimile transmission.* Except in the cases enumerated in paragraph (d) of this section, correspondence, including authorizations to charge a deposit account, may be transmitted by facsimile. The receipt date accorded to the correspondence will be the date on which the complete transmission is received in the Office, unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. See § 2.196. To facilitate proper processing, each transmission session should be limited to correspondence to be filed in a single application, registration or proceeding before the Office. The application serial number, registration number, or proceeding number should be entered as a part of the sender's identification on a facsimile cover sheet.

(d) Facsimile transmissions are not permitted and if submitted, will not be accorded a date of receipt, in the following situations:

(1) Applications for registration of marks;

(2) Drawings submitted under § 2.51, § 2.52, § 2.72, or § 2.173;

(3) Correspondence to be filed with the Trademark Trial and Appeal Board;

(4) Requests for cancellation or amendment of a registration under section 7(e) of the Trademark Act; and certificates of registration surrendered for cancellation or amendment under section 7(e) of the Trademark Act; and

(5) Madrid-related correspondence submitted under § 7.11, § 7.21, § 7.14, § 7.23, § 7.24, or § 7.31.

(e) *Interruptions in U.S. Postal Service.*

(1) If the Director designates a postal service interruption or emergency within the meaning of 35 U.S.C. 21(a), any person attempting to file correspondence by Priority Mail Express® Post Office to Addressee service who was unable to deposit the correspondence with the United States Postal Service due to the interruption or emergency may petition the Director to consider such correspondence as filed on a particular date in the Office.

(2) The petition must:

(i) Be filed promptly after the ending of the designated interruption or emergency;

(ii) Include the original correspondence or a copy of the original correspondence; and

(iii) Include a statement that the correspondence would have been deposited with the United States Postal Service on the requested filing date but for the designated interruption or emergency in Priority Mail Express® service; and that the correspondence attached to the petition is the original correspondence or a true copy of the correspondence originally attempted to be deposited as Priority Mail Express® on the requested filing date.

(3) Paragraphs (e)(1) and (e)(2) of this section do not apply to correspondence that is excluded from the Priority Mail Express® procedure pursuant to § 2.198(a)(1).

[79 FR 63041, Oct. 22, 2014, as amended at 81 FR 69988, Oct. 7, 2016]

§ 2.196 Times for taking action: Expiration on Saturday, Sunday or Federal holiday.

Whenever periods of time are specified in this part in days, calendar days are intended. When the day, or the last day fixed by statute or by regulation under this part for taking any action or paying any fee in the Office falls on a Saturday, Sunday, or Federal holiday

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within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding day that is not a Saturday, Sunday, or a Federal holiday.

§ 2.197 Certificate of mailing or transmission.

(a) Except in the cases enumerated in paragraph (a)(2) of this section, correspondence required to be filed in the Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

(1) Correspondence will be considered as being timely filed if:

(i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:

(A) Addressed as set out in § 2.190 and deposited with the U.S. Postal Service with sufficient postage as first class mail; or

(B) Transmitted by facsimile to the Office in accordance with § 2.195(c); and

(ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have a reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

(2) The procedure described in paragraph (a)(1) of this section does not apply to:

(i) Applications for the registration of marks under 15 U.S.C. 1051 or 1126; and

(ii) Madrid-related correspondence filed under § 7.11, § 7.21, § 7.14, § 7.23, § 7.24 or § 7.31 of this title.

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Office, and an application is abandoned, a registration is cancelled or expired, or a proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence within two months after becoming aware that the Office has no

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evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and

(3) Includes a statement that attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

(c) The Office may require additional evidence to determine whether the correspondence was timely filed.

[68 FR 48289, Aug. 13, 2003, as amended at 69 FR 57185, Sept. 24, 2004]

§ 2.198 Filing of correspondence by Priority Mail Express®.

(a)(1) Except for documents listed in paragraphs (a)(1)(i) through (vii) of this section, any correspondence received by the Office that was delivered by the Priority Mail Express® Post Office to Addressee service of the United States Postal Service (USPS) will be considered filed with the Office on the date of deposit with the USPS. The Priority Mail Express® procedure does not apply to:

(i) Applications for registration of marks;

(ii) Amendments to allege use under section 1(c) of the Act;

(iii) Statements of use under section 1(d) of the Act;

(iv) Requests for extension of time to file a statement of use under section 1(d) of the Act;

(v) Affidavits of continued use under section 8 of the Act;

(vi) Renewal requests under section 9 of the Act;

(vii) Requests to change or correct addresses; and

(viii) Affidavits of use under section 71 of the Act.

(2) The date of deposit with USPS is shown by the "date accepted" on the Priority Mail Express® label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the date of receipt in the Office as the filing date.

(b) Correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the Priority Mail Express® mailing label with the “date accepted” clearly marked. Persons dealing indirectly with the employees of the USPS (such as by deposit in a Priority Mail Express® drop box) do so at the risk of not receiving a copy of the Priority Mail Express® mailing label with the desired “date accepted” clearly marked. The paper(s) or fee(s) that constitute the correspondence should also include the Priority Mail Express® mailing label number thereon. See paragraphs (c), (d) and (e) of this section.

(c) Any person filing correspondence under this section that was received by the Office and delivered by the Priority Mail Express® Post Office to Addressee service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the “date accepted” on the Priority Mail Express® mailing label or other official USPS notation, may petition the Director to accord the correspondence a filing date as of the “date accepted” on the Priority Mail Express® mailing label or other official USPS notation, provided that:

(1) The petition is filed within two months after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;

(2) The number of the Priority Mail Express® mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing; and

(3) The petition includes a true copy of the Priority Mail Express® mailing label showing the “date accepted,” and of any other official notation by the USPS relied upon to show the date of deposit.

(d) Any person filing correspondence under this section that was received by the Office and delivered by the Priority Mail Express® Post Office to Addressee service of the USPS, who can show that the “date accepted” on the Priority Mail Express® mailing label or other official notation entered by the

USPS was incorrectly entered or omitted by the USPS, may petition the Director to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:

(1) The petition is filed within two months after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;

(2) The number of the Priority Mail Express® mailing label was placed on the paper(s) or fee(s) prior to the original mailing; and

(3) The petition includes a showing that establishes, to the satisfaction of the Director, that the correspondence was deposited in the Priority Mail Express® Post Office to Addressee service prior to the last scheduled pickup on the requested filing date. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or evidence that came into being within one business day after the deposit of the correspondence in the Priority Mail Express® Post Office to Addressee service of the USPS.

(e) If correspondence is properly addressed to the Office pursuant to §2.190 and deposited with sufficient postage in the Priority Mail Express® Post Office to Addressee service of the USPS, but not received by the Office, the party who mailed the correspondence may petition the Director to consider such correspondence filed in the Office on the USPS deposit date, provided that:

(1) The petition is filed within two months after the person becomes aware that the Office has no evidence of receipt of the correspondence;

(2) The number of the Priority Mail Express® mailing label was placed on the paper(s) or fee(s) prior to the original mailing;

(3) The petition includes a copy of the originally deposited paper(s) or fee(s) showing the number of the Priority Mail Express® mailing label thereon, a copy of any returned postcard receipt, a copy of the Priority Mail Express® mailing label showing the “date accepted,” a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a

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date other than the “date accepted” on the Priority Mail Express® mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section that the correspondence was deposited in the Priority Mail Express® Post Office to Addressee service prior to the last scheduled pickup on the requested filing date; and

(4) The petition includes a statement that establishes, to the satisfaction of the Director, the original deposit of the correspondence and that the copies of the correspondence, the copy of the Priority Mail Express® mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence, original Priority Mail Express® mailing label, returned postcard receipt, and official notation entered by the USPS.

(f) The Office may require additional evidence to determine whether the correspondence was deposited as Priority Mail Express® with the USPS on the date in question.

[79 FR 63041, Oct. 22, 2014, as amended at 80 FR 2312, Jan. 16, 2015]

TRADEMARK RECORDS AND FILES OF THE PATENT AND TRADEMARK OFFICE

SOURCE: 68 FR 48292, Aug. 13, 2003, unless otherwise noted.

§ 2.200 Assignment records open to public inspection.

(a)(1) Separate assignment records are maintained in the Office for patents and trademarks. The assignment records relating to trademark applications and registrations (for assignments recorded on or after January 1, 1955) are open to public inspection at the Office, and copies of those assignment records may be obtained upon request and payment of the fee set forth in § 2.6 of this chapter.

(2) All records of trademark assignments recorded before January 1, 1955, are maintained by the National Archives and Records Administration (NARA). The records are open to public inspection. Certified and uncertified copies of those assignment records are

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provided by NARA upon request and payment of the fees required by NARA.

(b) An order for a copy of an assignment or other document should identify the reel and frame number where the assignment or document is recorded.

[68 FR 48292, Aug. 13, 2003, as amended at 81 FR 72707, Oct. 21, 2016]

§ 2.201 Copies and certified copies.

(a) Non-certified copies of trademark registrations and of any trademark records or trademark documents within the jurisdiction of the Office and open to the public, will be furnished by the Office to any person entitled thereto, upon payment of the appropriate fee required by § 2.6.

(b) Certified copies of trademark registrations and of any trademark records or trademark documents within the jurisdiction of the Office and open to the public will be authenticated by the seal of the Office and certified by the Director, or in his or her name attested by an officer of the Office authorized by the Director, upon payment of the fee required by § 2.6.

FEES AND PAYMENT OF MONEY IN TRADEMARK CASES

SOURCE: 68 FR 48292, Aug. 13, 2003, unless otherwise noted.

§ 2.206 Trademark fees payable in advance.

(a) Trademark fees and charges payable to the Office are required to be paid in advance; that is, at the time of requesting any action by the Office for which a fee or charge is payable.

(b) All fees paid to the Office must be itemized in each individual trademark application or registration file, or trademark proceeding, so that the purpose for which the fees are paid is clear. The Office may return fees that are not itemized as required by this paragraph.

§ 2.207 Methods of payment.

(a) All payments of money required in trademark cases, including fees for the processing of international trademark applications and registrations that are paid through the Office, shall be made in U.S. dollars and in the form

of a cashier's or certified check, Treasury note, national bank note, or United States Postal Service money order. If sent in any other form, the Office may delay or cancel the credit until collection is made. Checks and money orders must be made payable to the Director of the United States Patent and Trademark Office. (Checks made payable to the Commissioner of Patents and Trademarks will continue to be accepted.) Payments from foreign countries must be payable and immediately negotiable in the United States for the full amount of the fee required. Money sent to the Office by mail will be at the risk of the sender, and letters containing money should be registered with the United States Postal Service.

(b) Payments of money required for trademark fees may also be made by credit card, except for replenishing a deposit account. Payment of a fee by credit card must specify the amount to be charged to the credit card and such other information as is necessary to process the charge, and is subject to collection of the fee. The Office will not accept a general authorization to charge fees to a credit card. If credit card information is provided on a form or document other than a form provided by the Office for the payment of fees by credit card, the Office will not be liable if the credit card number becomes public knowledge.

[68 FR 48292, Aug. 13, 2003, as amended at 69 FR 43752, July 22, 2004]

§ 2.208 Deposit accounts.

(a) For the convenience of attorneys, and the general public in paying any fees due, in ordering copies of records, or services offered by the Office, deposit accounts may be established in the Office. A minimum deposit of \$1,000 is required for paying any fees due or in ordering any services offered by the Office. The Office will issue a deposit account statement at the end of each month. A remittance must be made promptly upon receipt of the statement to cover the value of items or services charged to the account and thus restore the account to its established normal deposit. An amount sufficient to cover all fees, copies, or services requested must always be on deposit. Charges to accounts with insufficient

funds will not be accepted. A service charge (§ 2.6(b)(11)) will be assessed for each month that the balance at the end of the month is below \$1,000.

(b) A general authorization to charge all fees, or only certain fees to a deposit account containing sufficient funds may be filed in an individual application, either for the entire pendency of the application or with respect to a particular document filed. An authorization to charge a fee to a deposit account will not be considered payment of the fee on the date the authorization to charge the fee is effective as to the particular fee to be charged unless sufficient funds are present in the account to cover the fee.

(c) A deposit account holder may replenish the deposit account by submitting a payment to the Office. A payment to replenish a deposit account must be submitted by one of the methods set forth in paragraphs (c)(1), (c)(2), (c)(3), or (c)(4) of this section.

(1) A payment to replenish a deposit account may be submitted by electronic funds transfer through the Federal Reserve Fedwire System, which requires that the following information be provided to the deposit account holder's bank or financial institution:

(i) Name of the Bank, which is Treas NYC (Treasury New York City);

(ii) Bank Routing Code, which is 021030004;

(iii) United States Patent and Trademark Office account number with the Department of the Treasury, which is 13100001; and

(iv) The deposit account holder's company name and deposit account number.

(2) A payment to replenish a deposit account may be submitted by electronic funds transfer over the Office's Internet Web site (*www.uspto.gov*).

(3) A payment to replenish a deposit account may be addressed to: Director of the United States Patent and Trademark Office, Attn: Deposit Accounts, 2051 Jamieson Avenue, Suite 300, Alexandria, Virginia 22314.

[68 FR 48292, Aug. 13, 2003, as amended at 69 FR 43752, July 22, 2004; 70 FR 56128, Sept. 26, 2005; 73 FR 67775, Nov. 17, 2008; 81 FR 72707, Oct. 21, 2016]

§ 2.209

§ 2.209 Refunds.

(a) The Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a trademark application, appeal or other trademark filing for which a fee was paid, will not entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested, and will not notify the payor of such amounts. If a party paying a fee or requesting a refund does not provide the banking information necessary for making refunds by electronic funds transfer (31 U.S.C. 3332 and 31 CFR part 208), or instruct the Office that refunds are to be credited to a deposit account, the Director may require such information, or use the banking information on the payment instrument to make a refund. Any refund of a fee paid by credit card will be by a credit to the credit card account to which the fee was charged.

(b) Any request for refund must be filed within two years from the date the fee was paid, except as otherwise provided in this paragraph. If the Office charges a deposit account by an amount other than an amount specifically indicated in an authorization (§ 2.208(b)), any request for refund based upon such charge must be filed within two years from the date of the deposit account statement indicating such charge, and include a copy of that deposit account statement. The time periods set forth in this paragraph are not extendable.

PART 3—ASSIGNMENT, RECORDING AND RIGHTS OF ASSIGNEE

EDITORIAL NOTE: Part 3 pertaining to both patents and trademarks is placed in the grouping pertaining to patents regulations.

PART 4—COMPLAINTS REGARDING INVENTION PROMOTERS

EDITORIAL NOTE: Part 4 is placed in the separate grouping of parts pertaining to patents regulations.

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PART 5—SECURITY OF CERTAIN INVENTIONS AND LICENSES TO EXPORT AND FILE APPLICATIONS IN FOREIGN COUNTRIES

EDITORIAL NOTE: Part 5 is placed in the separate grouping of parts pertaining to patents regulations.

PART 6—CLASSIFICATION OF GOODS AND SERVICES UNDER THE TRADEMARK ACT

Sec.

- 6.1 International schedule of classes of goods and services.
- 6.2 Prior U.S. schedule of classes of goods and services.
- 6.3 Schedule for certification marks.
- 6.4 Schedule for collective membership marks.

AUTHORITY: Secs. 30, 41, 60 Stat. 436, 440; 15 U.S.C. 1112, 1123; 35 U.S.C. 2, unless otherwise noted.

§ 6.1 International schedule of classes of goods and services.

GOODS

1. Chemicals for use in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; fire extinguishing and fire prevention compositions; tempering and soldering preparations; substances for tanning animal skins and hides; adhesives for use in industry; putties and other paste fillers; compost, manures, fertilizers; biological preparations for use in industry and science.

2. Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants, dyes; inks for printing, marking and engraving; raw natural resins; metals in foil and powder form for use in painting, decorating, printing and art.

3. Non-medicated cosmetics and toiletry preparations; non-medicated dentifrices; perfumery, essential oils; bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations.

4. Industrial oils and greases, wax; lubricants; dust absorbing, wetting and binding compositions; fuels and illuminants; candles and wicks for lighting.

5. Pharmaceuticals, medical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical use or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for dressings; material for stopping