

# Chapter 1700 Petitions, Requests for Reinstatement, and Other Matters Submitted to Director

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## **1701 Statutory Authority of Director**

The United States Patent and Trademark Office (USPTO) is led by the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (Director). The Commissioner for Trademarks oversees the staff and operations of the USPTO with regard to trademark matters. [35 U.S.C. §3\(b\)\(2\)](#).

The Patent and Trademark Office Efficiency Act, Subtitle G of the American Inventors Protection Act of 1999, Pub. L. 106-113, 113 Stat. 1501A-572, amended Title 35 of the United States Code to reorganize the USPTO as a performance-based organization within the Department of Commerce. *See Reestablishment of the Patent and Trademark Office as the United States Patent and Trademark Office*, 1234 TMOG 41 (May 9, 2000). Section 4732(b)(1)(B) of the Patent and Trademark Office Efficiency Act, 113 Stat. 1501A-583, amended the Trademark Act of 1946, [15 U.S.C. 1051](#) *et seq.* (except for §17) to strike “Commissioner” in each place that it appears and substitute “Director.” Section 4741(b) of the Patent and Trademark Office Efficiency Act, 113 Stat. 1501A-586, provides that:

Any reference in any other Federal law, Executive order, rule, regulation, or delegation of authority, or any document of or pertaining to the Patent and Trademark Office-

- (1) to the Commissioner of Patents and Trademarks is deemed to refer to the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office; [and]

\* \* \*

- (3) to the Assistant Commissioner for Trademarks is deemed to refer to the Commissioner for Trademarks.

Under [15 U.S.C. §1123](#) and [35 U.S.C. §2\(b\)\(2\)](#), the Director may establish regulations for the conduct of proceedings in the USPTO.

Citation to decisions issued by the Director on petition on or after March 29, 2000 must include a parenthetical reference to “(Dir USPTO <specify year>).” Citation to decisions issued by the Commissioner for Patents and Trademarks prior to March 29, 2000 will reference “(Comm’r Pats. <specify year>).”

### *Delegation of Director’s Authority*

Pursuant to [35 U.S.C. §3\(a\) and \(b\)](#), the Director has delegated the authority to the Commissioner for Trademarks to decide trademark-related petitions filed under [37 C.F.R. §§2.66, 2.146](#), and [2.147](#) and to exercise supervisory authority in trademark-related matters pursuant to [35 U.S.C. §2](#).

Under [35 U.S.C. §3\(b\)\(3\)\(B\)](#) and [37 C.F.R. §2.146\(h\)](#), the Commissioner for Trademarks may delegate this authority to the Deputy Commissioner for Trademark Examination Policy or the Deputy Commissioner for Trademark Operations, who may further delegate the authority.

Authority to decide trademark-related petitions filed under [37 C.F.R. §§2.146](#) and [2.147](#) has been delegated to the Deputy Commissioner for Trademark Examination Policy, who has further delegated authority to appropriate officials within the Office of Petitions.

Further, pursuant to [35 U.S.C. §3\(a\)-\(b\)](#), the Director has delegated to the Commissioner for Trademarks the authority to impose sanctions or actions permitted under [37 C.F.R. §11.18\(c\)](#), as deemed appropriate in trademark matters. The Director has also provided that such authority may be further delegated by the Commissioner.

## **1702 Petitions to the Director Under 37 C.F.R. §2.146 - In General**

### ***37 CFR §2.146 Petitions to the Director.***

(a) Petition may be taken to the Director in a trademark case: (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, Title 35 of the United States Code, or parts 2, 3, 6, and 7 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 parts 2, 3, 6, and 7 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, or expungement or reexamination of registrations, including, but not limited to, questions arising under sections 2, 3, 4, 5, 6, 16A, 16B, and 23 of the Act of 1946, are not appropriate subject matter for petitions to the Director.

(c)(1) 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.

(2) A petition requesting reinstatement of a registration cancelled in whole or in part for failure to timely respond to an Office action issued in an expungement and/or reexamination proceeding must include a response to the Office action, signed in accordance with § 2.193, or an appeal.

(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/expiry of a registration and not later than six months after the date the trademark electronic records system indicates that the registration is cancelled/expired;

(iii) Two months after the date of actual knowledge of the denial of certification of an international application under § 7.13 of this chapter and not later than six months after the trademark electronic records system indicates that certification is denied; or

(iv) Where an expungement or reexamination proceeding has been instituted under § 2.92, two months after the date of actual knowledge of the cancellation of goods and/or services in a registration and not later than six months after the date the trademark electronic record system indicates that the goods and/or services are cancelled.

(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 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.

Applicants, registrants, and parties to inter partes proceedings before the Trademark Trial and Appeal Board (Board) who believe they have been injured by certain adverse actions of the USPTO, or who believe that they cannot comply with the requirements of the Trademark Rules of Practice (37 C.F.R. Parts 2, 3, 6, and 7) because of an extraordinary situation, may seek equitable relief by filing a petition to the Director under [37 C.F.R. §2.146](#).

Under [37 C.F.R. §2.146\(a\)\(1\)](#), an applicant may file a petition to review an examining attorney's formal requirement if permitted by [37 C.F.R. §2.63\(a\)](#) and (b). Under [37 C.F.R. §2.63\(a\)\(2\)](#), a petition from a requirement that is repeated but not made final is permitted if a non-final action contains no substantive refusals and the subject matter of the requirement is appropriate for petition. Under [37 C.F.R. §2.63\(b\)\(2\)](#), a petition from a final requirement is permitted if a final action contains no substantive refusals and the subject matter of the requirement is procedural, and therefore appropriate for petition. See [TMEP §1704](#) regarding petitionable subject matter. If a petition under [37 C.F.R. §2.146\(a\)\(1\)](#) is denied, the applicant has until the time remaining in the response period for the Office action that repeated the requirement or made it final (see [TMEP §711](#)), or thirty days from the date of the decision on the petition, whichever is later, to comply with the requirement. [37 C.F.R. §2.63\(c\)](#).

Under [37 C.F.R. §2.146\(a\)\(2\)](#), a petition may be filed in any case for which the Trademark Act, Trademark Rules of Practice, or Title 35 of the United States Code specifies that the matter is to be determined directly or reviewed by the Director. This includes petitions to review the actions of the Post Registration staff under [15 U.S.C. §§1057, 1058, 1059, and 1141k](#).

Under [35 U.S.C. §2](#) and [37 C.F.R. §2.146\(a\)\(3\)](#), the Director may invoke supervisory authority in appropriate circumstances. See [TMEP §1707](#).

Under [37 C.F.R. §2.146\(a\)\(5\)](#), a party may petition the Director to suspend or waive any requirement of the rules that is not a requirement of the statute, in an extraordinary situation, where justice requires and no other party is injured thereby. See [TMEP §1708](#).

See [TMEP §1703](#) for a list of issues that often arise on petition, and [TMEP §§1705–1705.09](#) regarding petition procedure.

## 1703 Specific Types of Petitions

A variety of issues may be reviewed on petition. The following is a list of issues that commonly arise:

*Petitions to Restore an Application Filing Date.* See [TMEP §1711](#).

*Petitions to Accept Paper Submissions* in trademark matters are reviewed under [37 C.F.R. §§2.146\(a\)\(5\), 2.147, 2.148](#). See [TMEP §1709](#). Petitions to accept paper submissions in Trademark Trial and Appeal Board (Board) proceedings due to an outage of the Board's electronic filing system are reviewed under [37 C.F.R. §§2.146\(a\)\(5\), 2.147\(b\)\(1\)\(vi\), 2.147\(d\), 2.148](#).

*Petitions to Make Special.* See [TMEP §1710](#).

*Petitions to Reverse an Examining Attorney's Holding of Abandonment for Failure to File a Complete Response to an Office Action* are reviewed under [37 C.F.R. §2.146\(a\)\(3\)](#). See [TMEP §1713](#).

*Petitions to Revive an Application Abandoned Due to Unintentional Delay in Responding to an Office Action or Notice of Allowance* are reviewed under [37 C.F.R. §2.66](#). See [TMEP §§1714–1714.01\(g\)](#).

*Petitions to Restore Jurisdiction to the Examining Attorney* may be filed by the applicant under [37 C.F.R. §2.84](#), when the examining attorney does not have jurisdiction to review an amendment to the application. See [TMEP §§1504–1504.05](#).

*Petitions to Review the Action of an Examining Attorney*. A petition to review an examining attorney's formal requirement may be filed under [37 C.F.R. §2.63\(a\)](#) and [\(b\)](#) and [§2.146\(a\)\(1\)](#), if the requirement is repeated or made final and the subject matter is procedural in nature and therefore appropriate for petition. See [TMEP §1704](#) regarding petitionable subject matter and [TMEP §1706](#) regarding the standard of review.

*Petitions to Review the Requirement for a Qualified U.S. Attorney and/or for Information or Declarations Related to Such Requirement* under [37 C.F.R. §2.11\(f\)](#). If the USPTO issues an Office action that (1) maintains only a requirement for U.S. counsel and/or additional information under Rule 2.11 (a), (b), and/or (c), or (2) maintains only the requirement for the insufficient information fee under [37 C.F.R. §2.22\(b\)](#) in addition to one or all of those requirements, an applicant's or registrant's recourse for seeking review is limited to a petition to the Director under Rule 2.146. [37 C.F.R. §§2.11\(f\), 2.146, 2.165, 2.186, 7.40](#).

*Petitions to Reinstate a Cancelled Registration and Accept a Late Response to an Office Action Issued in Connection with a Section 8 or 71 declaration of use or excusable nonuse* are reviewed under [37 C.F.R. §2.146\(a\)\(5\)](#) and [§2.148](#). See [TMEP §§1604.16, 1606.12, 1613.16, 1708, 1712.02\(b\)](#).

*Petitions to Reinstate a Cancelled Registration and Accept a Late Response to an Office action Issued in Connection with an Expungement or Reexamination Proceeding Under Section 16a or 16b* are reviewed under [37 C.F.R. §2.146\(a\)\(5\)](#) and [§2.148](#). See [TMEP §1716.04\(f\)](#).

*Petitions to Review the Action of the Post Registration Staff* may be filed if an affidavit of use or excusable nonuse is refused under [15 U.S.C. §1058](#) or [§1141k](#), a renewal application is refused under [15 U.S.C. §1059](#), or a proposed amendment or correction is refused under [15 U.S.C. §1057](#). See [37 C.F.R. §§2.165, 2.176, 2.186; TMEP §§1604.18, 1606.14, 1613.18](#).

*Petitions to Review the Refusal of the Madrid Processing Unit to Certify an Application for International Registration* are reviewed under [37 C.F.R. §2.146\(a\)\(3\)](#). See [TMEP §1902.03\(a\)](#).

*Petitions to the Director Regarding an International Application or Registration* are reviewed under [37 C.F.R. §2.146\(a\)\(3\)](#).

*Petitions to Reverse a Nonfinal Interlocutory Order of the Trademark Trial and Appeal Board* ([37 C.F.R. §2.146\(e\)\(2\)](#)) are reviewed under the standard of clear error or abuse of discretion, if the subject matter is procedural in nature and therefore appropriate for consideration on petition. *Riko Enters., Inc. v. Lindsley*, 198 USPQ 480 (Comm’r Pats. 1977); see Trademark Trial and Appeal Board Manual of Procedure (TBMP) [§§901.02\(a\)](#), [905](#).

*Petitions to Review a Decision to Deny or Grant a Request for an Extension of Time to Oppose* ([37 C.F.R. §2.146\(e\)\(1\)](#)) are reviewed to determine whether the Board correctly applied [37 C.F.R. §2.101](#) and [§2.102](#).

*Petitions to Add or Substitute a Basis After Publication* are reviewed under [37 C.F.R. §2.146\(a\)\(2\)](#). See [37 C.F.R. §2.35\(b\)\(2\)](#); [TMEP §§806.03\(j\)-806.03\(j\)\(iii\)](#).

*Petitions to Abandon an Affidavit or Declaration of Incontestability* Under §15 of the Trademark Act, [15 U.S.C. §1065](#), are reviewed under [37 C.F.R. §2.146\(a\)\(3\)](#). See [37 C.F.R. §2.167\(j\)](#); [TMEP §§1605, 1605.03, 1704, 1707](#).

See [TMEP §1607](#) and [TBMP §§303, 307, 308](#), and [309](#) regarding petitions to cancel registrations under [15 U.S.C. §1064](#), which are handled by the Board.

## 1704 Petitionable Subject Matter

### *Ex Parte Examination*

Under [37 C.F.R. §§2.63\(a\)](#) and [\(b\)](#), an applicant may petition the Director to review an examining attorney’s repeated or final requirement if the subject matter of the requirement is appropriate for petition. However, under [37 C.F.R. §2.146\(b\)](#), “[q]uestions of substance arising during the ex parte prosecution of applications, or expungement or reexamination of registrations, including, but not limited to, questions arising under sections 2, 3, 4, 5, 6, 16A, 16B, and 23 of the Act of 1946, are not appropriate subject matter for petitions to the Director.”

Procedural issues reviewable on petition include: whether a disclaimer was properly printed in standardized format; whether an examining attorney acted properly in suspending an application; whether an examining attorney acted properly in holding an application abandoned for failure to file a complete response to an Office action (see [TMEP §1713](#)); and whether it was premature for an examining attorney to issue a final action.

Substantive issues that arise in ex parte examination are not proper subject matter for petition, and may be reviewed only by the Trademark Trial and Appeal Board on appeal. See [TMEP §§1501–1501.07](#) regarding appeal procedure. For example, an examining attorney’s requirement for a special form drawing that agrees with the mark shown on the specimen(s) of record may not be reviewed on petition, because it requires an analysis of the commercial impression of the mark. *In re Hart*, 199 USPQ 585, 587 (Comm’r Pats. 1978). An examining attorney’s requirement for a disclaimer of a feature of a mark is also improper subject matter for petition. *Ex parte Fla. Citrus Canners Coop.*, 37 USPQ 463 (Comm’r Pats. 1938); *Ex parte Kleen-O-Dent Labs., Inc.*, 37 USPQ 232 (Comm’r Pats. 1938). The question of whether an amendment to a drawing is a material alteration of the mark is not petitionable, but the question of whether USPTO practice permits an applicant to correct an allegedly obvious typographical error on a drawing was found to be reviewable on petition. *In re Tetrafluor Inc.*, 17 USPQ2d 1160 (Comm’r Pats. 1990). The determination of what is appealable and what is petitionable is made on a case-by-case basis.



Some issues that arise in ex parte examination may be reviewed by either petition or appeal. For example, the question of who is a proper signatory of a statement of use or other verification of facts on behalf of an applicant may be reviewed by either petition or appeal. *In re Dermahose Inc.*, 82 USPQ2d 1793, 1795, n.5 (TTAB 2007).

A requirement for amendment of an identification of goods/services may also be reviewed by either petition or appeal. *In re Stenographic Machs., Inc.*, 199 USPQ 313, 316 (Comm'r Pats. 1978). On the other hand, a requirement for amendment of the classification is a procedural matter that may only be reviewed on petition. *In re Tee-Pak, Inc.*, 164 USPQ 88, 89 (TTAB 1969).

If an applicant files a petition from an examining attorney's formal requirement, the applicant subsequently may not appeal the requirement to the Board. [37 C.F.R. §2.63\(c\)](#).

See [TBMP §1201.05](#) for further information about appealable versus petitionable subject matter in examination.

### *Post Registration*

Trademark Rule 2.146(b) applies only to questions of substance that arise during ex parte examination of applications for registration. The Director considers questions of substance, such as whether a proposed amendment materially alters a registered mark or whether a specimen supports use of a registered mark, when reviewing the action of the Post Registration staff in connection with a proposed amendment filed under [15 U.S.C. §1057](#) (§7 amendment), or an affidavit of use under [15 U.S.C. §1058](#) or [§1141k](#) (§8 affidavit or §71 affidavit). The decisions of Post Registration staff under [15 U.S.C. §§1057, 1058, 1059](#), and [1141k](#) may not be appealed to the Board.

An owner may petition the Director under Trademark Rule 2.146(a)(3), [37 C.F.R. §2.146\(a\)\(3\)](#), to request that an affidavit or declaration of incontestability under §15 of the Trademark Act, [15 U.S.C. §1065](#), be abandoned if the owner determines, after timely filing the affidavit or declaration, that the affidavit or declaration contained an inaccuracy. [37 C.F.R. §2.167\(j\)](#); see [TMEP §§1605, 1605.03, 1707](#).

Cancellation of a registration for failure to file an affidavit or declaration under §8 or §71 of the Trademark Act ([15 U.S.C. §§1058, 1141k](#)), or expiration of a registration for failure to file a renewal application under §9 ([15 U.S.C. §1059](#)), does not constitute petitionable subject matter under the "unintentional delay" standard of [37 C.F.R. §2.66](#). See [TMEP §1714.01\(f\)\(ii\)\(D\)](#). Furthermore, a petition under [37 C.F.R. §2.146](#) requesting that the Director accept a late-filed §8 or §71 affidavit or declaration, or a §9 renewal application, will not be granted because the Director has no authority to waive the deadline for filing these documents. See [TMEP §§1604.04, 1606.03, 1613.04, 1707](#). Such petitions will be denied since the Director lacks authority to grant them.

### *Inter Partes Proceedings Before Trademark Trial and Appeal Board*

In an inter partes proceeding before the Trademark Trial and Appeal Board, a party may petition the Director to review an interlocutory order of the Board that concerns a matter of procedure and does not put an end to the litigation before the Board. See [TBMP §§901.02\(a\), 905](#).



## 1705 Petition Procedure

A petition should include a verified statement of the relevant facts, the points to be reviewed, the requested action or relief, and the fee required by [37 C.F.R. §2.6](#), [37 C.F.R. §2.146\(c\)](#). The petition should be accompanied by a supporting brief and any evidence to be considered.

### 1705.01 Standing

A person must have standing to file a petition to the Director under [37 C.F.R. §2.146](#). See *Ex parte Lasek*, 115 USPQ 145 (Comm'r Pats. 1957).

There is no provision in the Trademark Act or Rules of Practice for intercession by a third party in an ex parte matter. Accordingly, petitions by third parties to review actions taken in ex parte matters will generally be dismissed for a lack of standing.

See [TMEP §1715](#) regarding letters of protest filed by third parties to bring to the attention of the USPTO evidence bearing on the registrability of a mark in pending applications.

### 1705.02 Petition Fee

A petition must be accompanied by the fee required by [37 C.F.R. §2.6](#), [37 C.F.R. §§2.66\(b\)\(1\)](#), [2.146\(c\)](#), [2.147\(a\)\(2\)\(iv\)](#), [\(b\)\(2\)\(v\)](#).

Any petition that is not accompanied by the required fee is incomplete. A staff attorney or paralegal in the Office of the Deputy Commissioner for Trademark Examination Policy will notify the petitioner in writing that the petition is incomplete and grant the petitioner 30 days to submit the fee. If the fee is not submitted within the time allowed, the petition is denied without consideration on the merits, because the petitioner has not met the requirements for filing a petition.

If a petition is permitted to be filed on paper, and a check submitted as a petition fee is returned to the USPTO unpaid, or an electronic funds transfer or credit card is refused or charged back by a financial institution, the petitioner must resubmit the petition fee, along with a fee for processing the payment that was refused or charged back, before the petition will be considered on the merits. See [37 C.F.R. §2.6\(b\)\(10\)](#). See [TMEP §405.06](#) regarding payments refused or charged back by financial institutions.

### 1705.03 Evidence and Proof of Facts

A petition must include a statement of the relevant facts and be accompanied by any evidence to be considered. [37 C.F.R. §§2.146\(c\)](#), [2.147\(a\)\(2\)\(ii\)-\(iii\)](#), [\(b\)\(2\)\(i\)-\(iii\)](#). When facts are to be proved, the petitioner must submit proof in the form of an affidavit or declaration under [37 C.F.R. §2.20](#), [37 C.F.R. §§2.146\(c\)](#), [2.147\(a\)\(2\)\(iii\)](#), [\(b\)\(2\)\(i\)](#). See [TMEP §611.03\(a\)](#) regarding who can sign a verification.

Petitioners should not submit as evidence any documents that are already part of the record for the subject application or registration, or any USPTO records that are not relevant to the petition. For example, in most circumstances, submitting the entire record of a Trademark Trial and Appeal Board (Board) proceeding or the entire record of an application or registration would not be necessary to support a petition; only relevant documents from such records should be submitted. Further, it is inappropriate for the petitioner to “dump” evidence and leave it to the Office to determine its possible relevance. Therefore, a petition accompanied by more than 75 pages of evidence must include a separate itemized index listing the supporting evidence

and identifying what fact(s) it supports, along with an explanation of why it is necessary to include more than 75 pages of evidence, or the petition may be considered incomplete. In such a case, a staff attorney or paralegal in the Office of the Deputy Commissioner for Trademark Examination Policy will notify the petitioner that an index and explanation are required, and grant the petitioner 30 days to submit these items. If the petitioner does not submit the index and explanation within the time allowed, the petition will be denied, or, in appropriate cases, a decision on petition will be rendered based on the first 75 pages of evidence.

An affidavit or declaration supporting a petition should be based on firsthand knowledge. See [37 C.F.R. §2.146\(c\)](#).

When a petition includes an unverified assertion that is not supported by evidence, a staff attorney or paralegal in the Office of the Deputy Commissioner for Trademark Examination Policy will notify the petitioner that an affidavit or declaration is required, and grant the petitioner 30 days to submit the necessary verification.

If the petitioner does not submit a verification within the time allowed, the petition will be denied, or, in appropriate cases, a decision on petition will be rendered based on the information in the record, without consideration of the unverified assertion.

If physical evidence is available, such as a printout of the trademark electronic filing system submission confirmation page that shows the date of actual receipt of a document by the USPTO (see [TMEP §303.02\(a\)](#)), the petitioner should include the evidence with the initial petition. Evidence consisting only of a verified statement without supporting evidence may not be sufficient.

## 1705.04 Timeliness

To avoid prejudicing the rights of third parties, petitions must be filed within a reasonable time after the disputed event. In many cases, deadlines for filing petitions are expressly stated in the rules. The following petition deadlines run from the issue date of the action or order of which the petitioner seeks review:

- *Petition to revive an abandoned application* – by not later than two months after the issue date of the notice of abandonment or 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 [37 C.F.R. §2.20](#) or [28 U.S.C. §1746](#) that it did not receive the notice of abandonment ([37 C.F.R. §2.66\(a\)](#); see [TMEP §§1705.05, 1714–1714.01\(g\)](#));
- *Petition to revive goods/services/classes deleted for failure to respond to a partial refusal or requirement* – by not later than two months after the issue date of the examiner’s amendment deleting (abandoning) the goods/services/classes to which the refusal or requirement pertained or two months after the date of actual knowledge of the issuance of the examiner’s amendment deleting (abandoning) the goods/services/classes to which the refusal or requirement pertained and not later than six months after the date the trademark electronic records system indicates that the application is abandoned in part by examiner’s amendment, where the applicant declares under [37 C.F.R. §2.20](#) or [28 U.S.C. §1746](#) that it did not receive the examiner’s amendment ([37 C.F.R. §2.66\(a\)](#); see [TMEP §§718.02\(a\), 1705.05, 1714–1714.01\(g\)](#));
- *Petition to reverse an examining attorney’s holding of abandonment for failure to file a complete response to an Office action* – by not later than two months after the issue date of the notice of abandonment or 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 [37 C.F.R. §2.20](#) or [28 U.S.C. §1746](#) that it did not receive the notice of abandonment (see [37 C.F.R. §2.146\(d\)\(2\)\(i\)](#));

- *Petition to review an examining attorney's formal requirement* – by not later than the end of the response period for the Office action maintaining the requirement ([15 U.S.C. §1062\(b\)](#); [37 C.F.R. §§2.62, 2.63\(a\), \(b\)](#)) (see [TMEP §711](#) regarding the deadline for response to an Office action and [§711.01](#) regarding requests for an extension of time to respond to an Office action with a three-month response period);
- *Petition to reinstate a registration and accept a late response to an Office action issued in connection with a timely filed 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* – by not later than two months after the issue date of the cancellation notice or two months of actual knowledge of the cancellation and not later than six months after the date the trademark electronic records system indicates that the registration is cancelled/expired (see [37 C.F.R. §2.146\(d\)](#); see [TMEP §1712.02\(b\)](#));
- *Petition to review a Section 8 or 71 rejection* – by not later than six months after the issue date of the Office action maintaining a refusal of the affidavit ([37 C.F.R. §2.165\(b\)](#); see [TMEP §§1604.18–1604.18\(a\), 1613.18–1613.18\(a\)](#));
- *Petition to review a Section 7 rejection* – by not later than six months after the issue date of the Office action refusing to enter an amendment or correction ([37 C.F.R. §2.176](#));
- *Petition to review the denial of a request for an extension of time to file a notice of opposition* – by not later than 15 days after the issue date of the grant or denial of the request ([37 C.F.R. §2.146\(e\)\(1\)](#));
- *Petition to review an interlocutory order of the Trademark Trial and Appeal Board* – by not later than 30 days after the issue date of the order from which relief is requested ([37 C.F.R. §2.146\(e\)\(2\)](#));
- *Petition to review the denial of certain timely filed paper submissions with statutory deadlines* – by not later than two months after the issue date of the notice denying acceptance of the paper filing ([37 C.F.R. §2.147\(b\)\(2\)](#));
- *Request for reconsideration of decision on petition* – by not later than two months after the issue date of the decision denying the petition or 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 [37 C.F.R. §2.20](#) or [28 U.S.C. §1746](#) that it did not receive the decision ([37 C.F.R. §§2.66\(e\)\(1\), 2.146\(i\)\(1\)](#));
- *Petition to review the denial of certification of an international application* – by not later than 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 where the applicant or registrant declares under [37 C.F.R. §2.20](#) or [28 U.S.C. §1746](#) that it did not receive the action, or no action was issued ([37 C.F.R. §2.146\(d\)\(2\)\(iii\)](#)).

If the rules do not provide an express deadline, the petition must be filed by not later than two months after the issue date of the action from which relief is requested. [37 C.F.R. §2.146\(d\)\(1\)](#).

The time limits set forth in the rules are strictly enforced. Petitions filed after the expiration of the deadlines are denied as untimely. If the petitioner can show that extraordinary circumstances caused the delay in filing the petition, the petitioner may request waiver of these time limits, pursuant to [37 C.F.R. §2.146\(a\)\(5\)](#) and [§2.148](#). See [TMEP §1708](#) regarding waiver of rules.

On the rare occasions when filing on paper is permitted, petitions mailed to the USPTO by the due date in accordance with [37 C.F.R. §2.197](#) or [§2.198](#) will be considered timely. See [37 C.F.R. §2.195\(b\)\(1\)-\(2\)](#). See [TMEP §§301.02-301.02\(e\)](#) regarding the limited exceptions for paper submissions, [§§305.02-305.02\(h\)](#) regarding certificate of mailing procedures, and [§§305.03-305.03\(e\)](#) regarding Priority Mail Express® procedures.

See [TMEP §1705.05](#) regarding the duty to exercise due diligence in monitoring the status of pending trademark matters.

## 1705.05 Due Diligence

*37 CFR 2.23 (Extract) Requirement to correspond electronically with the Office and duty to monitor status.*

...

(d) Notices issued or actions taken by the USPTO are displayed in the USPTO's publicly available electronic systems. Applicants and registrants are responsible for monitoring the status of their applications and registrations in the USPTO's electronic systems during the following time periods:

(1) At least every six months between the filing date of the application and issuance of a registration;

(2) After filing an affidavit of use or excusable nonuse under section 8 or section 71 of the Act, or a renewal application under section 9 of the Act, at least every six months until the registrant receives notice that the affidavit or renewal application has been accepted; and

(3) After notice of the institution of an expungement or reexamination proceeding under § 2.92, at least every three months until the registrant receives a notice of termination under § 2.94.

Applicants and registrants are responsible for tracking the status of matters pending before the USPTO. [37 C.F.R. §2.23\(d\)](#); [TMEP §108.03](#). It is reasonable to expect some notice from or action by the USPTO within six months of submitting a document in an application or registration. A party who has not received a notice or action from the USPTO within that time frame is responsible for checking the matter's status and requesting corrective action, if necessary. [37 C.F.R. §2.23\(d\)](#).

Applicants and registrants can check the status of an application or registration through the TSDR database on the USPTO website at <https://tsdr.uspto.gov/>, which is generally available 24 hours a day, seven days a week. The party should print the TSDR screen and place it in the party's own file, in order to have a record of the status inquiry and the information learned.

A party who does not have access to the Internet can call the Trademark Assistance Center (TAC) at (571) 272-9250 or (800) 786-9199 to determine the status or to obtain clarification about the status. After making a telephone status inquiry, a party should make a note in the party's own file as to the date of the status inquiry and the information learned. No further documentation is required to establish that the status inquiry was made.

If a status inquiry reveals that a document submitted to the USPTO is not in the electronic record or was not received in the USPTO, that an Office action or notice was issued but not received by the applicant or registrant, that an application has been abandoned or a registration cancelled or expired, or that some other problem exists, then the applicant or registrant is responsible for promptly requesting corrective action in writing.

If an application has been abandoned, a petition to revive under [37 C.F.R. §2.66](#) (if not due to USPTO error) or request for reinstatement under [37 C.F.R. §2.64\(a\)](#) (if due to USPTO error) must be filed through the trademark electronic filing system. See [TMEP §§1702–1708](#), [1713](#), [1714](#). If a registration has been cancelled or expired, a request for reinstatement under [37 C.F.R. §2.64\(b\)](#) (if due to USPTO error) or formal petition under [37 C.F.R. §2.146](#) (if not due to USPTO error) should generally be filed through the trademark electronic filing system. See [TMEP §1712](#). See [TMEP §301.02](#) regarding the limited exceptions for paper submissions.

In all cases, petitions and requests for reinstatement will be denied if filed more than six months after the electronic record is updated to reflect that an application is abandoned or that a registration is cancelled or expired. [37 C.F.R. §§2.64\(a\)\(1\)\(ii\)](#), [\(b\)\(1\)\(ii\)](#), [2.66\(a\)\(2\)](#), [2.146\(d\)\(2\)](#).

These deadlines protect third parties who rely on the Trademark electronic record to determine whether a chosen mark is available for use or registration. For example, a third party may search USPTO records and understand that an earlier-filed potentially conflicting mark will not be revived or reinstated more than six months after the date the electronic record indicates that it was abandoned.

## **1705.06 Stay or Suspension of Pending Matters**

### ***37 CFR §2.146(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 when §§ 2.63(a) and (b) and 2.65(a) are applicable to an ex parte application.

Filing a petition does not stay the period for replying to an Office action, except when a stay is specifically requested and granted under [37 C.F.R. §2.146\(g\)](#), or when [37 C.F.R. §§2.63\(a\)](#) and [\(b\)](#) and 2.65(a) are applicable. Any request to stay a deadline for filing a response to an Office action or notice of appeal should be submitted using the Response to Office action form, explaining that a petition on the outstanding issue(s) is currently pending. The examining attorney should then request permission from the Petitions Office, which is part of the Office of the Deputy Commissioner for Trademark Examination Policy, to suspend action on the case pending a decision on the petition. The examining attorney must *not* suspend action on an application pending a decision on petition to the Director except upon permission from the Petitions Office or when expressly permitted. [37 C.F.R. §2.146\(g\)](#). See [TMEP §716.02\(i\)](#) for circumstances when an examining attorney may suspend action pending a decision on a petition to the Director requesting waiver of the domicile address requirement.

A request to suspend a proceeding before the Board pending a decision on petition should be directed to the Board. [37 C.F.R. §2.117\(c\)](#); [TBMP §510.03\(a\)](#). See TBMP §§[510–510.03\(b\)](#), [1213](#) regarding suspension of Board proceedings.

Filing a petition to revive an application abandoned for failure to file a proper statement of use or request for an extension of time to file a statement of use does not stay the time for filing a statement of use or further extension request(s). See [TMEP §1714.01\(b\)\(i\)](#).

## **1705.07 Requirement for Representation and Signature**

### **1705.07(a) Requirement for Representation of Non-U.S.-domiciled Petitioner**

A petitioner's domicile will determine whether the petitioner is required to be represented before the USPTO by an attorney who is an active member in good standing of the bar of the highest court of a U.S. state, Commonwealth, or territory or the District of Columbia (a qualified U.S. attorney). [37 C.F.R. §§2.11\(a\), 11.1, 11.14\(e\)](#); [TMEP §601](#). A petitioner whose domicile is not located within the United States or its territories must be represented by a qualified U.S. attorney. [37 C.F.R. §2.11\(a\)](#); [TMEP §601](#). See [TMEP §601.01](#) regarding determining domicile and [§602](#) regarding persons authorized to practice before the USPTO in trademark matters.

If the USPTO receives a petition filed by an unrepresented foreign domiciliary, an attorney or paralegal in the Office of the Deputy Commissioner for Trademark Examination Policy will follow the procedures in [TMEP §601.01\(a\)](#) and grant the petitioner additional time to appoint a qualified U.S. attorney and to supplement the petition, as appropriate. If the petitioner does not appoint a qualified U.S. attorney and submit any additional necessary information within the time allowed, the petition will be denied.

## 1705.07(b) Signature of Petition

Regardless of the type of petition, if it appears that a petition (or a response accompanying a petition) was signed by an improper or excluded party, the staff attorney or paralegal reviewing the petition will follow the procedures in [TMEP §611.05](#) for processing documents signed by unauthorized parties.

*Petitions to the Director under Trademark Rule 2.146 and/or 2.147.* See [37 C.F.R. §2.193\(e\)\(5\)](#) and [TMEP §611.03\(e\)](#) regarding persons who may sign petitions to the Director and [TMEP §§611.06–611.06\(h\)](#) for guidelines on persons with legal authority to bind various types of legal entities.

Petitions to the Director under Trademark Rule [2.146](#) and/or [2.147](#) are often accompanied by separate verifications. See [TMEP §611.03\(a\)](#) regarding who may sign verifications.

*Petitions to Revive under Trademark Rule 2.66.* See [TMEP §611.03\(d\)](#) and [§1714.01\(e\)](#) regarding who may sign petitions to revive and [§611.03\(b\)](#) regarding who may sign a response to an Office action, if one is provided with the petition.

See also [TMEP §611.01\(c\)](#) regarding signature of documents filed electronically.

## 1705.08 Request for Reconsideration of Denial of Petition

Under [37 C.F.R. §2.146\(i\)](#), if a petition is denied, the petitioner may request reconsideration by: (1) filing the request for reconsideration within two months after the issue date of the decision denying the petition; and (2) paying a second petition fee under [37 C.F.R. §2.6](#). The petitioner must use the trademark electronic filing system's Petition to Director form to file the request for reconsideration.

If the petitioner presents new facts that warrant equitable relief, the request for reconsideration may be granted. Any request for reconsideration that merely reiterates or expands on arguments previously presented will be denied.

Since contested matters must be brought to a conclusion within a reasonable time, a second request for reconsideration of a decision on petition will be granted only in rare situations, when the petitioner presents significant facts or evidence not previously available. *In re Am. Nat'l Bank & Trust Co. of Chi.*, 33 USPQ2d 1535, 1537 (Comm'r Pats. 1993).

## 1705.09 Appeal to Federal Court

A registrant who is adversely affected by the Director's decision regarding a filed §8 affidavit, filed §71 affidavit, or filed §9 renewal application may appeal to the United States Court of Appeals for the Federal Circuit or commence a civil action for review of the decision on petition. [15 U.S.C. §§1071\(a\)\(1\), \(b\)\(1\)](#); [37 C.F.R. §§2.145\(a\), \(c\)](#).

Other types of Director's decisions are not subject to appeal. See *In re Marriott-Hot Shoppes, Inc.*, 411 F.2d 1025, 1028, 162 USPQ 106, 109–110 (C.C.P.A. 1969).

The deadline for filing an appeal or commencing a civil action is 63 days from the issuance date of the decision. [15 U.S.C. §1071\(a\)\(2\), \(b\)\(1\)](#); [37 C.F.R. §2.145\(d\)\(1\), \(d\)\(3\)](#).



## 1706 Standard of Review on Petition

The standard of review on petition depends on the particular section of the rules under which the petition is filed.

In review of an examining attorney's formal requirement under [37 C.F.R. §§2.63\(a\)](#) and [\(b\)](#) and [2.146\(a\)\(1\)](#), the standard of review is whether the examining attorney's judgment was correct, the same standard that the Trademark Trial and Appeal Board would use if it were considering the requirement on appeal. *In re Du Pont Merck Pharm. Co.*, 34 USPQ2d 1778, 1781 (Comm'r Pats. 1995); *In re Stenographic Machs., Inc.*, 199 USPQ 313, 316 (Comm'r Pats. 1978). However, in review of an examining attorney's action under [37 C.F.R. §2.146\(a\)\(3\)](#), the Director will reverse the examining attorney only where there has been clear error or an abuse of discretion. *In re GTE Educ. Servs.*, 34 USPQ2d 1478, 1479–1480 (Comm'r Pats. 1994); *In re Direct Access Commc'ns (M.C.G.) Inc.*, 30 USPQ2d 1393, 1394 (Comm'r Pats. 1993). See [37 C.F.R. §2.146\(b\)](#) and [TMEP §1704](#) regarding petitionable subject matter.

The Director reviews the actions and decisions of the Post Registration staff on §8 affidavits, §71 affidavits, §9 renewal applications, and §7 amendments, to determine whether they were correctly made. See *In re Umax Data Sys., Inc.*, 40 USPQ2d 1539, 1541 (Comm'r Pats. 1996) (announcing change in standard of review of petitions to review Post Registration decisions on §7 amendments).

The Director will reverse an action of the Board on petition under [37 C.F.R. §2.146\(a\)\(3\)](#) only for clear error or abuse of discretion. *Riko Enterprises, Inc. v. Lindsley*, 198 USPQ 480, 482 (Comm'r Pats. 1977).

The Director reviews the denial of an application filing date to determine whether the denial was correct. See [TMEP §204.02](#).

## 1707 Director's Supervisory Authority Under 37 C.F.R. §2.146(a)(3)

Under [35 U.S.C. §2](#) and [37 C.F.R. §2.146\(a\)\(3\)](#), the Director may exercise supervisory authority on petition in appropriate circumstances. As noted in [TMEP §1706](#), the Director may review the actions of an examiner or paralegal under [37 C.F.R. §2.146\(a\)\(3\)](#) to determine whether there has been clear error or an abuse of discretion.

In some cases, the Director will exercise supervisory authority under [37 C.F.R. §2.146\(a\)\(3\)](#) even where there has been no clear error or abuse of discretion, if a petitioner can show that it has substantially complied with the requirements of the statute or rules. See *In re P.T. Polymindo Permata*, 109 USPQ2d 1256, 1257 (Dir USPTO 2013); *In re Carnicon Dev. Co.*, 34 USPQ2d 1541, 1543 (Comm'r Pats. 1992) (holding that an assertion of verified date of first use, coupled with statement of current method of use, interpreted as substantially in compliance with the minimum filing requirement for a statement of use for a verified statement that the “mark is in use in commerce.”); [TMEP §1713.01](#).

The Director may also exercise supervisory authority under [37 C.F.R. §2.146\(a\)\(3\)](#) to make changes to USPTO practice. See, e.g., *In re L.G. Lavorazioni Grafite S.r.l.*, 61 USPQ2d 1063, 1064 (Dir USPTO 2001); *In re Slack*, 54 USPQ2d 1504, 1506 (Comm'r Pats. 2000); *In re Moisture Jamzz, Inc.*, 47 USPQ2d 1762, 1763–1764 (Comm'r Pats. 1997); *In re El Taurino Rest., Inc.*, 41 USPQ2d 1220, 1222 (Comm'r Pats. 1996); *In re Monte Dei Maschi Di Siena*, 34 USPQ2d 1415, 1416 (Comm'r Pats. 1995).



## 1708 Waiver of Rules

Under [37 C.F.R. §2.146\(a\)\(5\)](#) and [§2.148](#), the Director may waive any provision of the rules that is not a provision of the statute, when: (1) an extraordinary situation exists; (2) justice requires; and (3) no other party is injured.

All three of the above conditions must be satisfied before a waiver will be granted, and the burden is on the petitioner to show that the situation is extraordinary. Disasters like fires, hurricanes, and snowstorms are considered to be extraordinary situations.

On the other hand, oversights and inadvertent errors that could have been avoided with the exercise of reasonable care are not considered to be extraordinary situations. *In re Universal Card Grp., Inc.*, 25 USPQ2d 1157, 1158 (Comm'r Pats. 1992) (finding that a docketing error not extraordinary situation); *In re Merck & Co.*, 24 USPQ2d 1317, 1318 (Comm'r Pats. 1992) (holding that inadvertent misidentification of serial number in request for extension of time to oppose not extraordinary situation); *In re Tetrafluor Inc.*, 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990) (finding that a typographical error not extraordinary situation).

A change of attorneys is not considered to be an extraordinary situation, *In re Unistar Radio Networks, Inc.*, 30 USPQ2d 1390, 1392 (Comm'r Pats. 1993), nor is a misunderstanding or lack of awareness of the requirements of the Trademark Rules of Practice considered extraordinary. *In re Buckhead Mktg. & Distribution, Inc.*, 71 USPQ2d 1620, 1622–23 (Dir USPTO 2004) (holding that an applicant's lack of knowledge of application filing fee increase not extraordinary situation); *B & E Sales Co. v. Andrew Jergens Co.*, 7 USPQ2d 1906, 1907–08 (Comm'r Pats. 1988); *Gustafson v. Strange*, 227 USPQ 174 (Comm'r Pats. 1985). Errors by attorneys are imputed to the client and the client is bound by the consequences. *In re Sotheby's Inc.*, 18 USPQ2d 1969, 1970 (Comm'r Pats. 1989).

A party will not be excused from compliance with the rules because the results in a particular case may be harsh. *See Buckhead*, 71 USPQ2d at 1623 (rejecting petitioner's argument that "justice requires" waiver of the filing date requirements of [37 C.F.R. §2.21](#) to prevent the loss of priority relative to a conflicting application).

The Director has no authority to waive or suspend the requirement of a rule that is also a requirement of the statute, such as the deadline for filing an affidavit or declaration under §8 or §71 ([15 U.S.C. §§1058, 1141k](#)), or a renewal application under §9 (15 U.S.C. §1059). *See Checkers Drive-In Rest., Inc. v. Comm'r of Patents & Trademarks*, 51 F.3d 1078, 1085, 34 USPQ2d 1574, 1581 (D.C. Cir. 1995), *cert. denied*, 516 U.S. 866 (1995) ("[I]n establishing cancellation as the penalty for failure to file the required affidavit, Congress made no exception for the innocent or the negligent. Thus, the Commissioner had no discretion to do other than cancel Checkers's service mark registration in this case."); *In re Holland Am. Wafer Co.*, 737 F.2d 1015, 1018, 222 USPQ 273, 275 (Fed. Cir. 1984) ("Timeliness set by statute is not a minor technical defect which can be waived by the Commissioner."). Therefore, a petition that requests a waiver of a statutory requirement will be denied, as the Director lacks authority to grant such a petition. *See, e.g., In re Precious Diamonds, Inc.*, 635 F.2d 845, 847 (C.C.P.A. 1980).

### 1708.01 Petition to Waive Domicile Address Requirement

An applicant or registrant ("party") may petition the Director to waive the domicile address requirement of Trademark Rule [2.189](#). The party must assert an extraordinary situation exists that would justify waiving the rule. [37 C.F.R. §2.146\(a\)\(5\)](#), [2.148](#), [2.189](#); *see* [TMEP §1708](#).

Even if the party can establish an extraordinary situation, the party must provide the state, or foreign equivalent, and country of their domicile. When an extraordinary situation is established, the Director will waive only the requirement for the street address of the party's domicile.

Filing a petition to waive the domicile address requirement does not constitute a proper response to an outstanding Office action and will not stay the period for responding to an Office action, even if the only issue therein is a requirement for the party to specify its domicile address. *See* [37 C.F.R. §2.146\(g\)](#); [TMEP §1705.06](#). Therefore, if there is an outstanding Office action in the relevant application or registration, the party must file a separate response to the Office action to avoid abandonment of the application or cancellation of the registration for failure to respond. The response should indicate that a petition has been filed, specify the reason for filing the petition (i.e., to request a waiver of the domicile address requirement), and request that the application be suspended or the post registration filing be held pending disposition of the petition. *See* [TMEP §§716.02](#), [716.02\(I\)](#), [1705.06](#).

*One petition will cover a limited number of simultaneously pending applications or pending post-registration filings.* If, at the time the petition is filed, a party has more than one application pending and/or more than one registration for which there are post-registration maintenance documents (e.g., Section 8 or Section 71 affidavits or declarations, or Section 7 requests) pending, they may file one petition that identifies up to nine additional pending applications and/or registrations that have pending post-registration submissions. If the petition is granted, the decision will apply to each of the identified applications and/or registrations and will be uploaded into each identified application and/or registration record. If the party has more than nine additional pending applications and/or registrations with pending post-registration maintenance documents for which the party seeks a waiver of the domicile address requirement, the party must file additional petitions, along with the appropriate fees, each of which may cover up to ten total applications and/or registrations.

*Petition may not be amended to identify additional pending applications or post-registration filings.* Once a petition is filed, a party may not amend the petition to identify additional applications and/or registrations. Therefore, if the party files new applications or post-registration maintenance documents for additional registrations while the petition is pending, or after the petition is decided, the party must file a new petition or petitions, as appropriate, to request a waiver of the domicile address requirement for the newly filed applications and additional registrations.

*Granted petition will cover an application or registration throughout its term.* A party who filed a petition to waive the domicile address requirement of Rule [2.189](#) that was granted during the pendency of the application need not file a new petition to waive Rule [2.189](#) when a post-registration filing is submitted if all of the relevant facts asserted in the initial petition remain unchanged. Similarly, a new petition to waive Rule [2.189](#) in a registration is not needed if a waiver was previously granted in connection with a post-registration filing. In these cases, the owner must declare in subsequent post-registration filings that all relevant facts asserted in the petition to waive the domicile address requirement, including the state and country of domicile, and the extraordinary situation presented, remain unchanged. This statement must be supported by a declaration under [37 C.F.R. §2.20](#) or [28 U.S.C. §1746](#). If any relevant fact has changed since the petition was granted, the owner must file a new petition to the Director to waive the domicile address requirement of Rule [2.189](#).

*Petition requirements.* The petition must include a statement of the facts relevant to the petition identifying the extraordinary situation that would justify waiving Rule [2.189](#) supported by a declaration under [37 C.F.R. §2.20](#) or [28 U.S.C. §1746](#), the state and country of the applicant's or registrant's domicile and the appropriate petition filing fee. [37 C.F.R. §2.146\(c\)](#). If more than one application and/or registration is identified in the petition, only one petition filing fee is required. Please note that all information included in the petition will be uploaded into the application or registration record and publicly viewable.

*Petition requirements if the party has no fixed physical address.* An applicant or registrant may petition the Director to request a waiver of the domicile address requirement if an individual applicant or registrant cannot provide their domicile address because they do not have a fixed permanent legal place of residence or a juristic entity applicant or registrant cannot provide a domicile address because it does not have a fixed physical address for its principal place of business. In such cases, the petition must include a verified statement of facts explaining that the applicant or registrant does not have a fixed physical address for their permanent legal place of residence or principal place of business, as appropriate. The applicant or registrant must still provide the state, or foreign equivalent, and country of their domicile (if an individual), or the state, or foreign equivalent, and country of the domicile of a person with legal authority to bind the applicant or registrant (if a juristic entity), to determine whether the applicant or registrant must be represented by a qualified U.S. attorney.

## **1709 Petitions to the Director Under 37 C.F.R. §2.147 to Accept Paper Submissions**

An applicant or registrant may file a petition to the Director to request acceptance of a paper submission in three situations as follows:

- (1) when the trademark electronic filing system is unavailable on the date of a filing deadline (*see* [TMEP §§1709.01-1709.01\(b\)](#));
- (2) when a timely filed paper submission with a statutory filing deadline is not processed or examined and it cannot be resubmitted electronically before the deadline (*see* [TMEP §1709.02](#)); or
- (3) in an extraordinary situation under [37 C.F.R. §2.146\(a\)\(5\)](#) (*see* [TMEP §1709.03](#)).

*See* [37 C.F.R. §2.147](#).

Submission of a petition does not extend the filing deadline for any response or submission. [TMEP §§1705.06, 1712.02\(b\)\(iii\)](#).

The requirement for representation of a non-U.S. domiciled petitioner applies to petitions under [§2.147](#). See [TMEP §1705.07\(a\)](#) for more information.

### **1709.01 Trademark Electronic Filing System Unavailable on the Date of Filing Deadline**

If the trademark electronic filing system is unavailable, users should check the “USPTO Systems Status and Availability” page on the USPTO website to see if the USPTO has issued a notice regarding an outage. See [TMEP §301.01\(b\)](#) for more information regarding trademark electronic filing system availability.

#### **1709.01(a) Trademark Electronic Filing System Unavailable Due to Widespread or Lengthy USPTO System Outage**

In the event the trademark electronic filing system is unavailable to the general public due to a widespread or lengthy USPTO system outage, the USPTO will continue its practice of issuing a notice on the “USPTO Systems Status and Availability” page, specifying temporary procedures for filing documents with the USPTO. If the USPTO website is inaccessible, the filer should call the Trademark Assistance Center at (571) 272-9250 or 800-786-9199 or email [TEAS@uspto.gov](mailto:TEAS@uspto.gov) for information on the temporary procedures.

If the outage falls on the date of the deadline for a submission, the requirement to file electronically will be waived, and filings submitted in accordance with such temporary procedures will be accepted without a petition or petition fee.

Documents submitted via facsimile when not expressly authorized by posted USPTO notice or at the written direction of USPTO staff will not be accorded a date of receipt. See [37 C.F.R. §2.195](#); see also [TMEP §301.01\(b\)](#) for more information regarding trademark electronic filing system availability.

*Submission requirements during widespread or lengthy USPTO system outage.* The submission must include a statement verified with a declaration under [37 C.F.R. §2.20](#) explaining the problem encountered when attempting to file via the trademark electronic filing system; proof that the trademark electronic filing system was unavailable (e.g., a screenshot of the trademark electronic filing system error message); a copy of the document the filer is attempting to submit; and any required fees. Information about the submission requirements may be found on the “[Filing trademark documents when unable to file electronically](#)” webpage.

If the document that is due requires a fee, the filer must submit the fee in accordance with the posted USPTO notice or at the written direction of USPTO staff. The amount of the fee required in such circumstances is the same as the fee for submitting the document via the trademark electronic filing system, not the fee for filing documents on paper.

### **1709.01(b) Trademark Electronic Filing System Unavailable Due to Limited or Short-term USPTO System Outage or User’s System Outage**

If the trademark electronic filing system is unavailable due to either a limited or short-term USPTO system outage or a user’s system outage on the date of the deadline for submission of a document, a petition to the Director to accept a paper submission may be submitted. [37 C.F.R. §2.147\(a\)](#). This petition option is not available to filers who attempt to use the trademark electronic filing system during a regularly scheduled system maintenance event, when it is not the day of a deadline, or when the failure to file the relevant submission through the trademark electronic filing system was because of user error.

Because filers would not have access to the petition form in the trademark electronic filing system in such circumstances, the USPTO will provide a “Petition to Director” form along with other electronic form previews in PDF and Word format on the “Submitting documents to the USPTO when unable to file electronically” webpage that may be downloaded and submitted with the other required documents.

*Petition requirements.* To be timely, the petition must be filed on the date of the deadline with a certificate of mailing attesting to that date. [37 C.F.R. §§2.147\(a\)\(1\)\(ii\)](#), [2.197\(a\)\(2\)](#). The filer also must submit proof with the petition that the trademark electronic filing system was unavailable on the date of the deadline. [37 C.F.R. §2.147\(a\)\(2\)\(ii\)](#). In addition to proof of the trademark electronic filing system’s unavailability (such as screenshots) and the paper submission to be filed, the petition must include a statement of the facts relevant to the petition supported by a declaration under [37 C.F.R. §2.20](#) or 28 U.S.C. §1746, the fee for the petition, and any other required fees. [37 C.F.R. §2.147\(a\)\(2\)](#).

### **1709.02 Certain Paper Submissions with Statutory Deadlines**

A petition to the Director to accept a paper submission may be filed for specific submissions with statutory deadlines if: (1) the submission was timely submitted on paper and not processed by the USPTO because

it was not submitted electronically; and (2) the applicant, registrant, or petitioner is unable to timely resubmit the document electronically by the statutory deadline. [37 C.F.R. §2.147\(b\)](#).

This petition option applies to the following documents with a statutory deadline under the Trademark Act:

An initial application seeking a priority filing date with a deadline under Section 44(d)(1) ([15 U.S.C. §1126\(d\)\(1\)](#));

A statement of use submitted within the last six months of the period specified in Section 1(d)(2) ([15 U.S.C. §1051\(d\)\(2\)](#));

An affidavit or declaration of continued use or excusable nonuse with a grace period deadline under Section 8(a)(3) ([15 U.S.C. §1058\(a\)\(3\)](#)) or Section 71(a)(3) ([15 U.S.C. §1141k\(a\)\(3\)](#));

A request for renewal of a registration with a deadline under Section 9(a) ([15 U.S.C. §1059\(a\)](#));

An application for transformation of an extension of protection into a U.S. application with a deadline under Section 70(c) ([15 U.S.C. §1141j\(c\)](#)); or

A petition to cancel a registration under Section 14 ([15 U.S.C. §1064](#)) on the fifth year anniversary of the date of the registration of the mark.

[37 C.F.R. §2.147\(b\)\(1\)-\(b\)\(1\)\(vi\)](#).

For these documents, following notification from the USPTO that a paper submission was not processed for failure to electronically file, when there is no time remaining in the statutory period, the filer may submit a petition to the Director electronically after the deadline requesting acceptance of the previously filed paper submission. If the petition is granted, the paper submission will be considered timely filed.

Filers should keep copies of any papers submitted to the USPTO, including confirmation of payment submissions, to submit as proof with the petition. If a check or money order was included with the original submission, it would have been returned with the USPTO notice indicating that the submission would not be processed and would be destroyed in accordance with the relevant record-retention schedule.

*Petition requirements.* The petition must be filed within two months of the issue date of the notice that the paper submission was not processed by the USPTO. [37 C.F.R. §2.147\(b\)\(2\)](#). The petition must include a statement of the facts relevant to the petition supported by a declaration under [37 C.F.R. §2.20](#) or 28 U.S.C. §1746, a copy of the relevant paper submission with proof that it was timely filed, proof that the required fee was submitted with the original paper submission, and the relevant paper fees for both the submission and the petition. [37 C.F.R. §2.147\(b\)\(2\)\(i\)-\(v\)](#).

### 1709.03 Extraordinary Situation

If a filer does not meet the petition requirements of [37 C.F.R. §2.147\(a\) or \(b\)](#) for requesting acceptance of a paper submission, the filer may petition the Director based on an extraordinary situation. See [37 C.F.R. §2.147\(c\)](#) (citing [37 C.F.R. §2.146\(a\)\(5\)](#)). In such a case, the filer would request a waiver of [37 C.F.R. §2.21\(a\)](#) or [§2.23\(a\)](#), and include a statement and/or evidence establishing the extraordinary situation that prevented the filer from filing using the trademark electronic filing system. See [37 C.F.R. §2.146\(c\)](#).

The USPTO decides these petitions on a case-by-case basis; assessing what would qualify as an extraordinary situation depends on the unique facts and evidence presented. The inability to file electronically due to USPTO regularly scheduled system maintenance generally does not qualify for relief as an extraordinary situation under [37 C.F.R. §2.146\(c\)](#). See [TMEP §1708](#) for more information.



*Petition requirements.* The petition must include the paper submission, a statement of the facts relevant to the petition supported by a declaration under [37 C.F.R. §2.20](#) or 28 U.S.C. §1746, the fee for a petition submitted on paper, and any other required fee for the relevant document submitted on paper. See [37 C.F.R. §2.146\(c\)](#).

## **1710 Petition to Make Special**

The USPTO generally examines applications in the order in which they are received. A Petition to Make Special is a request to the Director under [37 C.F.R. §2.146](#) to advance the initial examination of an application out of its regular order. See [TMEP §702.02](#).

A Petition to Make Special must be accompanied by: (1) the fee required by [37 C.F.R. §2.6](#); (2) an explanation of why special action is requested; and (3) a statement of facts and supporting evidence that shows special action is justified. See [37 C.F.R. §2.146](#). The statement of facts should be supported by a properly signed affidavit or declaration under [37 C.F.R. §2.20](#). See [37 C.F.R. §2.146\(c\)](#); [TMEP §611.03\(e\)](#).

The requirement for representation of a non-U.S. domiciled petitioner applies to a Petition to Make Special. See [TMEP §1705.07\(a\)](#) for more information.

The petition is reviewed in the Office of the Deputy Commissioner for Trademark Examination Policy. After first filing the application via the trademark electronic filing system, the applicant should then file a Petition to Make Special form via the trademark electronic filing system that specifies the newly assigned serial number.

*Request to Make Special – Registration Inadvertently Cancelled or Expired Under 15 U.S.C. §1058, §1059, or §1141k.* An application for registration of a mark that was the subject of a previous registration that was inadvertently cancelled or expired under [15 U.S.C. §1058](#), [§1059](#), or [§1141k](#) will be made special upon applicant's request. No petition is required in this situation. However, the mark in the new application must be identical to the mark in the cancelled or expired registration, and the goods/services in the new application must be identical to or narrower than the goods/services in the cancelled or expired registration. See [TMEP §702.02](#) regarding the requirements and filing procedure for a Request to Make Special.

### **1710.01 Basis for Granting or Denying Petition**

Invoking supervisory authority under [37 C.F.R. §2.146](#) to make an application “special” is an extraordinary remedy that is granted only when very special circumstances exist, such as a *demonstrable* possibility of the loss of substantial rights. These petitions are denied when the circumstances would apply equally to a large number of other applicants.

The fact that the applicant is about to embark on an advertising campaign is *not* considered a circumstance that justifies advancement of an application out of the normal order of examination, because this situation applies to a substantial number of applicants. Similarly, the applicant's desire to register a trademark to qualify to sell goods or offer services on a particular website does not justify making an application “special” since this situation also applies to a substantial number of applicants.

Commonly accepted types of evidence for granting Petitions to Make Special are copies of civil court complaints demonstrating the existence of pending litigation involving the mark, copies of cease-and-desist letters showing threatened litigation involving the mark, or copies of government regulations showing that a trademark registration is required to secure government approval for the goods or services.

## 1710.02 Processing Petition

Each Petition to Make Special, together with the petition decision, is made part of the record. If the petition is granted, the prosecution history of the application in the Trademark database will reflect that the petition for special handling has been granted.

### 1711 Review of Denial of Filing Dates

If an application is denied a filing date and the applicant wants the filing date restored, the usual procedure is to file a petition to the Director under [37 C.F.R. §2.146](#).

However, the applicant may request restoration of the filing date without a formal petition in either of the following situations:

*USPTO has no record of receiving the application, but trademark electronic filing system submission confirmation page printout shows receipt of application.* Although the USPTO has no record of receipt of the application, the applicant can present proof that a complete application was filed through the trademark electronic filing system in the form of a copy of the trademark electronic filing system submission confirmation page confirming receipt of the application (*see* [TMEP §303.02\(a\)](#)) or a copy of an email confirmation issued by the USPTO that includes the date of receipt and a summary of the electronic submission. Trademark records must show receipt of at least one filing fee on the requested filing date.

*Application on its face met filing date requirements under [37 C.F.R. §2.21](#) even though the application was initially denied a filing date.*

In these situations, a staff attorney or paralegal in the Office of the Deputy Commissioner for Trademark Examination Policy may restore the original filing date without a formal petition or a petition fee. In all other circumstances, the applicant must file a formal petition to the Director, including the petition fee required by [37 C.F.R. §2.6](#).

*Procedure for Filing Request to Restore a Filing Date .* In any request to restore an application filing date, the applicant should first refile the application using the trademark electronic filing system and pay the application filing fee required by [37 C.F.R. §2.6\(a\)\(1\)](#). After the applicant receives a new serial number, the applicant should file a Request to Restore Filing Date form in the trademark electronic filing system. The request must be filing using the new serial number and: (1) include the cancelled serial number; (2) state the reason(s) why the applicant believes the filing date was denied in error; and (3) include a copy of any Notice of Incomplete Trademark Application received from the USPTO. *See* [TMEP §204.02](#).

*Time Limit for Filing Request to Restore a Filing Date .* All requests to restore filing dates, whether made by formal petition or informal request, must be filed promptly. If the USPTO issues a notice advising the applicant of the denial or cancellation of the filing date, the request to restore the filing date must be filed within two months of the issue date of the action, or it will be denied as untimely. [37 C.F.R. §2.146\(d\)](#). Although applicants have two months from the issue date of this notice to file a request to restore the original filing date, it is recommended that an applicant promptly refile the application, and file the request to restore the filing date immediately upon receipt of the new serial number, to minimize the delay in receiving a filing date, and to reduce the impact on third parties who may rely on the current filing date information in the Trademark database.



Furthermore, applicants must exercise due diligence in monitoring the status of applications. [37 C.F.R. §2.23\(d\)\(1\)](#); [TMEP §§108.03, 1705.05](#). That is, an applicant must check the status of a pending application every six months between the filing date of the application and issuance of a registration. [37 C.F.R. §2.23\(d\)\(1\)](#).

*Evidence of Missing Element Required* . If the USPTO denies a filing date due to the omission of an element required by [37 C.F.R. §2.21](#), and the applicant declares that the missing element was in fact included with the application as filed, the Director will not grant a petition to restore or reinstate the filing date unless: (1) the applicant provides evidence that the element was received in the USPTO on the requested filing date; or (2) there is an image of the element in the USPTO's Trademark database.

## 1712 Reinstatement of Applications and Registrations

### 1712.01 Reinstatement of Applications Abandoned Due to USPTO Error

#### *37 CFR 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.\* \* \*

(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.

If an applicant has proof that an application was inadvertently abandoned due to a USPTO error, an applicant may file a request to reinstate the application, instead of a formal petition to revive. [37 C.F.R. §2.64\(a\)](#). There is no fee for a request for reinstatement. *Id* . The Request for Reinstatement form can be accessed at <https://www.uspto.gov/trademarks/apply/filing-petition-form>.

When an application is reinstated, a computer-generated notice of reinstatement is emailed to the correspondence email address of record and the Trademark electronic records system is updated accordingly.

If the applicant is not entitled to reinstatement, a request for reinstatement may be considered as a petition to revive or a petition to the Director and must meet all the requirements of [37 C.F.R. §2.66](#), [§2.146](#), or [§2.147](#). See [TMEP §§1702-1708, 1709-1709.03, 1714-1714.01\(g\)](#).

The following are examples of situations where the USPTO may reinstate an application that was held abandoned for failure to timely file a statement of use or response to an Office action or that was held abandoned in total after a partial refusal or requirement (see [37 C.F.R. §2.64\(a\)\(2\)](#)):

- (1) *Trademark electronic filing system submission confirmation page printout shows receipt of the applicant's submission.* The applicant presents proof that a response to an Office action, statement of use, or request for extension of time to file a statement of use was timely filed through the trademark electronic filing system, in the form of a copy of a submission confirmation page confirming receipt of the submission (see [TMEP §303.02\(a\)](#)) or a copy of an email confirmation issued by the USPTO that includes the date of receipt and a summary of the trademark electronic filing system submission. Trademark records must show receipt of any required filing fees.
- (2) *Trademark database shows the applicant's submission.* There is an image of the timely filed response, statement of use, or request for extension of time to file a statement of use in the Trademark database.
- (3) *USPTO systems show the fee was processed.* The request for reinstatement must include an affidavit or declaration under [37 C.F.R. §2.20](#) that attests to the contents of the original filing.
- (4) *USPTO sent an Office action or notice of allowance to the wrong address* due to a USPTO error, i.e., the USPTO either entered the correspondence address incorrectly or failed to enter a proper notice of change of address filed *before* the issue date of the action or notice. See [TMEP §609.03](#) regarding the applicant's duty to notify the USPTO when the correspondence address changes.
- (5) *Office action shows refusal/requirement applies to only certain goods, services, or classes (partial abandonment),* but the entire application was abandoned for failure to respond to the Office action. See [TMEP §718.02\(a\)](#).
- (6) *Appeal shows refusal/requirement applies to only certain goods, services, or classes (partial abandonment),* but the entire application was abandoned after (a) appeal is upheld or (b) the applicant withdraws or fails to prosecute the appeal – and the subject of the appeal was a refusal/requirement that applies to only certain goods, services, and/or classes. See *id.*

*Time Limit for Filing Request.* The applicant must file a request for reinstatement by not later than two months after the issue date of the notice of abandonment. [37 C.F.R. §2.64\(a\)\(1\)\(i\)](#). If the applicant did not receive the notice of abandonment, the applicant must file the request by not later than 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. [37 C.F.R. §2.64\(a\)\(1\)\(ii\)](#). The request must also include a properly signed declaration under [37 C.F.R. §2.20](#) or [28 U.S.C. §1746](#) stating that the applicant did not receive the notice of abandonment. [37 C.F.R. §2.64\(a\)\(1\)\(ii\)](#).

*Requirement for Representation of Non-U.S.-domiciled Applicant.* An applicant's domicile will determine whether the applicant is required to be represented before the USPTO by an attorney who is an active member in good standing of the bar of the highest court of a U.S. state, Commonwealth, or territory or the District of Columbia (a qualified U.S. attorney). [37 C.F.R. §§2.11\(a\), 11.1, 11.14\(e\)](#); [TMEP §601](#). An applicant whose domicile is not located within the United States or its territories must be represented by a qualified U.S. attorney. [37 C.F.R. §2.11\(a\)](#); [TMEP §601](#). See [TMEP §601.01](#) regarding determining domicile and [§602](#) regarding persons authorized to practice before the USPTO in trademark matters.

If the USPTO receives a request for reinstatement filed by an unrepresented foreign domiciliary, an attorney or paralegal in the Office of the Deputy Commissioner for Trademark Examination Policy will follow the procedures in [TMEP §601.01\(a\)](#) and grant the applicant additional time to appoint a qualified U.S. attorney and to supplement the request, as appropriate. If the applicant does not appoint a qualified U.S. attorney and submit any additional necessary information within the time allowed, the request will be denied.

## 1712.02 Reinstatement of Registrations Cancelled or Expired

### *37 CFR 2.64 Reinstatement of applications and registrations abandoned, cancelled, or expired due to Office error.*

(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/expiry; 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/expiry 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/expiry 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 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.

### **1712.02(a) Request for Reinstatement Due to USPTO Error**

A registrant may file a request to reinstate a cancelled or expired registration if the registrant has proof that a USPTO error caused the registration to be cancelled or expired. [37 C.F.R. §2.64\(b\)](#). The request must be filed using the trademark electronic filing system's Petition to Director form. Although a petition fee is required to file the form, it will be refunded if USPTO error is found.

The following are examples of situations where the USPTO may reinstate a cancelled or expired registration (see [37 C.F.R. §2.64\(b\)\(2\)](#)):

- (1) *Trademark electronic filing system submission confirmation page printout shows receipt of the registrant's submission.* The registrant presents proof that a proper affidavit or renewal application was timely filed through the trademark electronic filing system, in the form of a copy of a submission confirmation page confirming receipt of the document (see [TMEP §303.02\(a\)](#)) or a copy of an email confirmation issued by the USPTO that includes the date of receipt and a summary of the electronic submission. Trademark records must show receipt of any required filing fees.
- (2) *Trademark database shows the registrant's submission.* There is an image of a timely filed affidavit, renewal application, or response to Office action in the Trademark database.
- (3) *USPTO systems show the fee was processed.* The registrant must submit an affidavit or declaration under [37 C.F.R. §2.20](#) attesting to the contents of the original filing.

- (4) *USPTO sent an Office action to the wrong address* due to a USPTO error, i.e., the USPTO either entered the correspondence address incorrectly or failed to enter a proper notice of change of address filed *before* the issue date of the action. See [TMEP §609.03](#) regarding the registrant's duty to notify the USPTO when the correspondence address changes.

*Time Limit for Filing Request* . The registrant must file a request for reinstatement by not later than two months after the issue date of the notice of cancellation/expiration. [37 C.F.R. §2.64\(b\)\(1\)\(i\)](#). If the registrant did not receive a notice of cancellation/expiration or the Office did not issue a notice, the registrant must file the request by not later than 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. [37 C.F.R. §2.64\(b\)\(1\)\(ii\)](#). The request must also include a properly signed declaration under [37 C.F.R. §2.20](#) or [28 U.S.C. §1746](#) stating that the registrant did not receive the notice of cancellation/expiration if one was issued. *Id.*

*Statutory requirements cannot be waived upon request.* The Director has no authority to waive a statutory requirement, such as the deadline for filing a renewal application under [15 U.S.C. §1059](#) and/or an affidavit of use of a registered mark under [15 U.S.C. §1058](#) or [§1141k](#). See [TMEP §1708](#) and [§1712.02\(b\)\(iii\)](#) and cases cited therein for more about the Director's authority. Therefore, if the registrant did not timely file a §8 or §71 affidavit, or §9 renewal application, a request to reinstate a cancelled or expired registration will be denied, regardless of the reason for the delay, as the Director lacks authority to grant such a request.

*Requirement for Representation of Non-U.S.-domiciled Registrant* . A registrant's domicile will determine whether the registrant is required to be represented before the USPTO by an attorney who is an active member in good standing of the bar of the highest court of a U.S. state, Commonwealth, or territory or the District of Columbia (a qualified U.S. attorney). [37 C.F.R. §§2.11\(a\), 11.1, 11.14\(e\)](#); [TMEP §601](#). A registrant whose domicile is not located within the United States or its territories must be represented by a qualified U.S. attorney. [37 C.F.R. §2.11\(a\)](#); [TMEP §601](#). See [TMEP §601.01](#) regarding determining domicile and [§602](#) regarding persons authorized to practice before the USPTO in trademark matters.

If the USPTO receives a request for reinstatement filed by an unrepresented foreign domiciliary, an attorney or paralegal in the Office of the Deputy Commissioner for Trademark Examination Policy will follow the procedures in [TMEP §601.01\(a\)](#) and grant the registrant additional time to appoint a qualified U.S. attorney and to supplement the request, as appropriate. If the registrant does not appoint a qualified U.S. attorney and submit any additional necessary information within the time allowed, the request will be denied.

If a registrant is not entitled to reinstatement due to Office error, a request for reinstatement may be construed as a petition to the Director under [37 C.F.R. §2.146](#), if appropriate. [37 C.F.R. §2.64\(c\)](#); see [TMEP §1712.02\(b\)](#).

### **1712.02(b) Petition to Reinstate a Cancelled Registration and Accept a Late Response to a Post Registration Office Action**

If a registrant failed to timely respond to an Office action refusing to accept a §8 or §71 affidavit or §9 renewal application due to an extraordinary situation, the registrant may file a petition under [37 C.F.R. §2.146\(a\)\(5\)](#) and [§2.148](#) requesting the Office to reinstate the registration, if it is cancelled, and accept a late response to the Office action.

See [TMEP §§1705-1705.09](#) regarding the procedure for petitions to the Director.

### **1712.02(b)(i) Time for Filing Petition**

The petition must be filed no later than two months after the date of actual knowledge of the cancellation of the registration, and may not be filed later than six months after the date the trademark electronic records system indicates that the registration is cancelled/expired. [37 C.F.R. §2.146\(d\)\(2\)\(ii\)](#). In addition, the petition must include a response to the Office action.

### **1712.02(b)(ii) Standard of Review**

Under [37 C.F.R. §2.146\(a\)\(5\)](#) and [§2.148](#), the Director may waive any provision of the rules that is not a provision of the statute, only when an extraordinary situation exists, justice requires, and no other party is injured. See [TMEP §1708](#) for further discussion of conditions for waiver of rules. The unintentional delay standard of [37 C.F.R. §2.66](#) does not apply to registrations; it applies only to pending applications. [TMEP §1714.01\(f\)\(ii\)\(D\)](#).

### **1712.02(b)(iii) No Authority to Waive Statutory Requirements**

As noted in [TMEP §1708](#), the Director has no authority to waive a statutory requirement, such as the deadline for filing a proper renewal application under [15 U.S.C. §1059](#) or affidavit of use of a registered mark under [15 U.S.C. §1058](#). Therefore, if the registrant did not timely file a §8 or §71 affidavit or a §9 renewal application, a petition to extend or waive the statutory deadline will be denied, regardless of the reason for the delay.

If a registrant contends that a proper affidavit or renewal application was timely filed, but the registrant does not have proof that the affidavit or renewal application was received in the USPTO on or before the due date, the Director will not grant a petition to accept the affidavit or renewal application.

Similarly, if a registrant files a premature affidavit or renewal application, and does not file a newly executed affidavit or renewal application within the statutory filing period (which includes the grace period), the Director will not grant a petition to accept the premature affidavit or renewal application. See [TMEP §§1604.04\(a\)](#), [1606.03\(a\)](#), [1613.04](#).

## **1713 Petition to Reverse Holding of Abandonment of Application for Incomplete Response**

### **1713.01 Standard of Review**

Under [37 C.F.R. §2.65\(a\)](#), an application may become abandoned when an applicant's response, although received within the response period, is incomplete. See [TMEP §§718.03–718.03\(b\)](#) regarding incomplete responses.

When an examining attorney holds an application abandoned because the applicant's response is incomplete, the applicant may petition the Director to reverse the holding under [37 C.F.R. §2.146](#). See [TMEP §718.02\(a\)](#) regarding partial abandonment for failure to respond completely to a final refusal or final requirement that is expressly limited to only certain goods/services/class(es) and [§718.03\(a\)](#) for failure to respond completely in all other situations. See [TMEP §1705.07\(a\)](#) regarding the requirement for representation of a non-U.S. domiciled petitioner.

However, the Director will reverse the examining attorney's holding of abandonment only (1) if there has been clear error or an abuse of discretion, (2) where a petitioner can show that it has substantially complied

with the requirements of the statute or rules, or (3) when an application was abandoned due to an improperly signed response to Office action and the petitioner submits evidence that the response was properly signed. *See In re P.T. Polymindo Permata*, 109 USPQ2d 1256, 1257 (Dir USPTO 2013); *In re GTE Educ. Servs.*, 34 USPQ2d 1478, 1479-80 (Comm'r Pats. 1994); *In re Legendary, Inc.*, 26 USPQ2d 1478, 1479 (Comm'r Pats. 1992); *see also* [TMEP §1713.02](#).

Questions of substance arising during the ex parte prosecution of applications, or expungement or reexamination of registrations, including, but not limited to, questions arising under Sections 2, 3, 4, 5, 6, 16A, 16B, and 23 of the Trademark Act, are not appropriate subject matter for petitions to the Director. [37 C.F.R. §2.146\(b\)](#). For example, petitions requesting the following will generally be denied:

consideration of additional arguments against substantive refusals; the proper venue to present arguments against a substantive refusal is an appeal to the Trademark Trial and Appeal Board (Board), not a petition to the Director. [37 C.F.R. §§2.63\(b\)\(1\)\(i\)-\(ii\)](#), [2.146\(b\)](#);  
amendments to the application, such as filing-basis amendments;  
amendments to the Supplemental Register; and  
consideration of new evidence in the nature of consent agreements or substitute specimens.

A petition to the Director is also not a means for submitting an additional request for reconsideration, or a request to extend the deadline to file a notice of appeal to the Board, after the application has been abandoned for incomplete response.

The “unintentional delay” standard for reviving abandoned applications pursuant to [37 C.F.R. §2.66](#) does not apply to applications held abandoned because a response was deemed incomplete under [37 C.F.R. §2.65\(a\)](#). *See* [TMEP §1714.01\(f\)\(ii\)\(A\)](#).

### **1713.02 Failure to Respond to Notice of Incomplete Response or Denial of Request for Reconsideration with No Appeal Filed**

If an examining attorney issues (1) a notice of incomplete response using the “Notice of Non-Responsive Amendment,” (2) a “Continuing Final Action,” or (3) a “Request for Reconsideration Denied” when no notice of appeal has been filed, and the applicant does not respond in the time provided, the application will be abandoned due to incomplete response. The applicant's recourse is to file a petition to the Director under [37 C.F.R. §2.146](#) to reverse the examining attorney's holding of abandonment. *See* [TMEP §1713.01](#) for situations when this type of petition may be granted. An applicant may not file a petition to revive under [37 C.F.R. §2.66](#) based on unintentional delay or on the basis of failure to receive the Office action or failure to timely respond due to an extraordinary situation.

When it appears that a response is signed by an improper or excluded party and an examining attorney issues an Office action granting an applicant additional time (30 days or the time remaining in the response period) to complete a response, if the applicant fails to respond or to complete the response within the time granted or remaining, the examining attorney must issue an action abandoning the application for incomplete response. *See* [TMEP §§715.03\(a\)\(ii\)\(E\)](#), [718.03](#), [718.03\(b\)](#). If the applicant wishes to submit evidence that a proper party signed the original response, the applicant may petition the Director to exercise supervisory authority and reverse the holding and reinstate the application under [37 C.F.R. §2.146\(a\)\(3\)](#). If the evidence establishes that a proper party signed the response, the Director will grant the petition and instruct the examining attorney to review the response.



If the evidence submitted on petition or the application record itself establishes that the response was signed by an improper party, the Director will find that: (1) the application should have been abandoned for failure to respond, (2) the petition will be construed as a petition to revive under [37 C.F.R. §2.66](#), (3) revival based on unintentional delay is proper, and (4) a response signed by a proper party must be submitted. To expedite revival in these circumstances, the petition should include 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 a properly signed response to the Office action. In this situation, if evidence is provided in response to a final Office action, the response will be treated as a request for reconsideration under [37 C.F.R. §2.63\(b\)\(3\)](#) and the applicant must also file a notice of appeal to the Trademark Trial and Appeal Board under [37 C.F.R. §2.141](#) or a statement that no appeal is being filed from the final refusal(s) or requirement(s). [37 C.F.R. §2.66\(b\)\(3\)](#). If a revocation of a previous power of attorney or a new power of attorney properly signed by the individual applicant or someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner of a partnership) has been submitted, a response signed by the newly appointed attorney after the date of the revocation or appointment must be provided in order for the petition to be considered.

The granting of the petition does *not* extend the time for filing a notice of appeal or filing a petition to review the examining attorney's action under [37 C.F.R. §2.63\(a\)](#) and [\(b\)](#), [15 U.S.C. §1062\(b\)](#); [37 C.F.R. §2.142\(a\)](#). Therefore, in most circumstances, if the response does not overcome all outstanding refusals or satisfy all outstanding requirements, the application will again be abandoned and a notice will issue abandoning the application for incomplete response (but see [TMEP §1714.01\(a\)\(ii\)](#) regarding a petition to revive for failure to respond to a final action).

## 1714 Petition to Revive Abandoned Application

### *37 CFR §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(a)(15);

(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.

(4) If the Office action was subject to a three-month response period under § 2.62(a)(1), and the applicant does not assert non-receipt of the Office action or notification, the petition must also include the fee under § 2.6(a)(28) for a request for extension of time to respond under § 2.62(a)(2).

(5) If the abandonment was 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 any final refusal or requirement.

(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.

Upon submission of a petition to revive, an abandoned application may be revived under [37 C.F.R. §2.66](#) if the delay in responding to an Office action or notice of allowance was unintentional. [15 U.S.C. §§1051\(d\)\(4\), 1062\(b\)](#). Petitions filed under [37 C.F.R. §2.66](#) are handled by the paralegals in the Office of the Deputy Commissioner for Trademark Examination Policy. See [TMEP §1701](#) regarding the delegation of authority to decide petitions.

Petitions to revive must be filed through the trademark electronic filing system. See [TMEP §301.01](#) regarding mandatory electronic filing of trademark documents and [§301.02](#) regarding the limited exceptions for paper submissions.

## 1714.01 Procedural Requirements for Filing Petition to Revive

The procedural requirements for filing a petition to revive an application abandoned for failure to respond to an examining attorney's Office action are set forth in [37 C.F.R. §2.66\(b\)](#). See [TMEP §1714.01\(a\)–\(a\)\(ii\)](#) for more information.

The procedural requirements for filing a petition to revive an application abandoned for failure to timely file a statement of use or request for extension of time to file a statement of use are set forth in [37 C.F.R. §2.66\(c\)](#). See [TMEP §1714.01\(b\)–\(c\)](#) for more information.

*When Petition Does Not Meet Procedural Requirements* . When a petition does not meet the procedural requirements of [37 C.F.R. §2.66](#), a paralegal in the Office of the Deputy Commissioner for Trademark Examination Policy will notify the petitioner that the petition does not meet the requirements of the rule,

and grant the petitioner 30 days to supplement the petition by submitting the missing element(s). If the petitioner does not submit the necessary information or fees within the time allowed, the petition will be denied.

Generally, a petition to revive is automatically granted by the electronic system. However, if it is subsequently determined that the petition does not meet the procedural requirements of [37 C.F.R. §2.66](#), a paralegal in the Office of the Deputy Commissioner for Trademark Examination Policy will notify the petitioner that the granting of the petition has been rescinded because the petition does not meet the requirements of the rule. The petitioner will then be granted 30 days to perfect the petition by submitting the missing element(s).

If the petitioner does not submit the necessary information or fee(s) within the time allowed, the petition will be denied.

## **1714.01(a) Failure to Timely Respond to an Examining Attorney's Office Action**

### **1714.01(a)(i) Response to Nonfinal Office Action**

The procedural requirements for filing a petition to revive an application abandoned for failure to respond to an examining attorney's *nonfinal* Office action are listed in [37 C.F.R. §2.66\(b\)](#). The petition must include all of the following:

- (1) The petition fee required by [37 C.F.R. §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. The statement does not have to be verified; and
- (3) A properly signed response to the Office action or a statement that the applicant did not receive the Office action or the notification that an Office action issued.

*Office Actions With a Three-month Response Period and No Request for an Extension of Time to Respond Was Granted.* If the applicant does not assert non-receipt of the Office action or notification, in addition to the requirements set forth above, the petition must also include the fee under [37 C.F.R. §2.6\(a\)\(28\)](#) for a request for extension of time to respond. However, payment of this fee with the petition to revive does not provide additional time to file a further response. A response is due at the time of filing the petition to revive.

If applicant asserts non-receipt of the Office action or notification, the fee under [37 C.F.R. §2.6\(a\)\(28\)](#) is not required.

*Office Actions With an Extended Response Period.* The filing of an extension of time to respond under [37 C.F.R. §2.62\(a\)\(2\)](#) (see [TMEP §711.01](#)) presumes knowledge of the issuance of the Office action. Accordingly, in the limited circumstance in which an applicant has been granted an extension of the response period to six months and does not file a response within the extended time period, the applicant may not claim non-receipt of the Office action in any petition to revive under [37 C.F.R. §2.66](#). In such case, the applicant must provide a response to the outstanding Office action with the petition to revive. In the rare circumstance in which the applicant alleges that an extraordinary situation resulted in non-receipt of the Office action, even though a request for an extension of time to respond was filed, the applicant may provide proof of such alleged extraordinary situation in a petition to the Director under [37 C.F.R. §2.146\(a\)\(5\)](#).

*Assertion of Non-Receipt of the Office Action.* An applicant may not assert again that it did not receive the same Office action or notification in a subsequent petition. [37 C.F.R. §2.66\(b\)\(3\)](#).

If the petition states that applicant did not receive the Office action, and the petition is granted, the examining attorney will conduct a new search and issue a new Office action and provide the applicant with a new response period, or, if all issues previously raised remain the same, after reviving the application, the USPTO will issue a notice to the applicant directing the applicant to view the previously issued Office action on the TSDR portal on the USPTO website at <https://tsdr.uspto.gov/>, and provide the applicant with a new response period in which to file a response. See [TMEP §711](#) regarding the deadline for response to an Office action.

See [TMEP §718.02\(a\)](#) regarding a petition to revive a portion of an application that was partially abandoned and [§1714.01](#) regarding situations in which a petition to revive fails to meet the procedural requirements of [37 C.F.R. §2.66\(b\)](#) (e.g., when there is no allegation that the applicant did not receive the Office action, but the petition does not include a proposed response).

### **1714.01(a)(ii) Response to Final Office Action**

The procedural requirements for filing a petition to revive an application abandoned for failure to respond to an examining attorney's *final* Office action are listed in [37 C.F.R. §2.66\(b\)](#). The petition must include all of the following:

- (1) The petition fee required by [37 C.F.R. §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. The statement does not have to be verified; and
- (3) A properly signed response to the Office action or a statement that the applicant did not receive the Office action or the notification that an Office action issued. Receipt is presumed in cases where the applicant filed an extension of time to respond under [37 C.F.R. §2.62\(a\)\(2\)](#) (*see* [TMEP §711.01](#)).
- (4) If the applicant asserts unintentional delay in failing to timely respond to the Office action or notification and does not assert non-receipt of the Office action or notification, the applicant must also file:  
(a) 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 (b) a statement that no appeal or petition is being filed from the final refusal(s) or requirement(s). Any response filed with the petition, or subsequently filed in response to a notice of deficiency issued by a paralegal in the Office of the Deputy Commissioner for Trademark Examination Policy, will be treated as a request for reconsideration under [37 C.F.R. §2.66\(b\)\(3\)](#).

In some cases, an amendment requesting registration on the Supplemental Register or registration under [15 U.S.C. §1052\(f\)](#) may also be an appropriate response to a final refusal of registration on the Principal Register. *See* [TMEP §§714.05\(a\)\(i\)](#), [816.04](#), [1212.02\(h\)](#).

Generally, if the petition does not include the requirements set out in [37 C.F.R. §2.66\(b\)](#), the petition will be treated as incomplete. The applicant will be given an opportunity to perfect the petition by submitting the required items or claim of non-receipt. If the applicant does not submit a proper response, including a notice of appeal filed with the Board or a statement that no appeal is being filed, or claim of non-receipt within the time allowed, the petition will be denied. However, if the applicant previously filed a timely request for reconsideration that did not overcome all outstanding refusals and satisfy all outstanding requirements, a late appeal will not be accepted on petition to the Director under Rule 2.146. That is because the filing of a request for reconsideration does not stay or extend the time for filing an appeal. [37 C.F.R. §2.63\(b\)\(3\)](#); [TMEP §715.03](#).

*Office Actions With a Three-month Response Period and No Request for an Extension of Time to Respond Was Granted.* If the applicant does not assert non-receipt of the Office action or notification, in addition to the requirements set forth above, the petition must also include the fee under [37 C.F.R. §2.6\(a\)\(28\)](#) for a

request for extension of time to respond. However, payment of this fee with the petition to revive does not provide additional time to file a further response, including a further request for reconsideration, or extend the time for filing a notice of appeal. A response, including filing a notice of appeal to the Board, is due at the time of filing the petition to revive.

If applicant asserts non-receipt of the Office action or notification, the fee under [37 C.F.R. §2.6\(a\)\(28\)](#) is not required.

*Assertion of Non-Receipt of the Office Action.* If the petition states that applicant did not receive the final action, and the petition is granted, the USPTO will issue a new final action and provide the applicant with a new response period. If all issues previously raised remain the same, the USPTO will issue a notice to the applicant directing the applicant to view the previously issued final action on the TSDR portal on the USPTO website and provide the applicant with a new response period in which to file a response. See [TMEP §711](#) regarding the deadline for response to an Office action.

*Office Actions With an Extended Response Period.* The filing of an extension of time to respond under [37 C.F.R. §2.62\(a\)\(2\)](#) (see [TMEP §711.01](#)) presumes knowledge of the issuance of the Office action. Accordingly, in the limited circumstance in which an applicant has been granted an extension of the response period to six months and does not file a response within the extended time period, the applicant may not claim non-receipt of the final Office action in any petition to revive under [37 C.F.R. §2.66](#). In such case, the applicant must provide a response to the outstanding final Office action with the petition to revive. In the rare circumstance in which the applicant alleges that an extraordinary situation resulted in non-receipt of the Office action, even though a request for an extension of time to respond was filed, the applicant may provide proof of such alleged extraordinary situation in a petition to the Director under [37 C.F.R. §2.146\(a\)\(5\)](#).

The applicant may not assert again that it did not receive the final Office action or notification in a subsequent petition. [37 C.F.R. §2.66\(b\)\(3\)](#).

See [TMEP §1705.04](#) and [§1714.01\(d\)](#) regarding petition timeliness and [§1705.05](#) regarding due diligence in monitoring the status of an application.

### **1714.01(b) Failure to File a Statement of Use or Extension Request - Notice of Allowance Received**

The procedural requirements for filing a petition to revive an application abandoned for failure to respond to a notice of allowance are listed in [37 C.F.R. §2.66\(c\)](#). *If the applicant received the notice of allowance, the petition must include all of the following:*

- (1) The petition fee required by [37 C.F.R. §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. The statement does not have to be verified;
- (3) Either a statement of use under [37 C.F.R. §2.88](#) or a request for an extension of time to file a statement of use under [37 C.F.R. §2.89](#); and
- (4) The required fees for the number of extension requests that the applicant should have filed if the application had never been abandoned.

*Example 1:* If a notice of allowance was issued January 14, 2009, and the applicant did not file a statement of use or extension request by July 14, 2009, the application becomes abandoned. If a petition to revive is filed July 23, 2009, with a statement of use,

the petition must include: (1) the fee for the statement of use; (2) the fee for the extension request that was due July 14, 2009; and (3) the petition fee.

*Example 2:* If a notice of allowance was issued January 14, 2009, and the applicant did not file a statement of use or extension request by July 14, 2009, the application becomes abandoned. If a petition to revive is filed January 23, 2010, without a statement of use, the petition must be accompanied by: (1) the second extension request that was due January 14, 2010, with the filing fee therefor; (2) the fee for the first extension request that was due July 14, 2009; and (3) the petition fee. If the petition is granted, a statement of use or third extension request will be due July 14, 2010.

Unless a statement of use is filed with or before the petition, the applicant must file any further requests for extension of time to file a statement of use that become due while the petition is pending, or file a statement of use ([37 C.F.R. §2.66\(c\)\(3\)](#)). See [TMEP §1714.01\(b\)\(i\)](#).

*Example:* If a notice of allowance was issued January 14, 2009, and the applicant did not file a statement of use or extension request by July 14, 2009, the application becomes abandoned. If a petition to revive is filed January 2, 2010, without a statement of use, the petition must include: (1) the first extension request that was due July 14, 2009, with the filing fee therefor; and (2) the petition fee. In addition, if the petition is pending, the applicant must submit by January 14, 2010 either: (1) a statement of use (with the required fee), or (2) a second extension request (with the required fee) before the petition can be granted.

The USPTO will *not* grant a petition to revive an intent-to-use application if granting the petition would extend the period for filing the statement of use beyond thirty-six months after the issue date of the notice of allowance. [15 U.S.C. §§1051\(d\)\(1\), \(2\)](#); [37 C.F.R. §2.66\(d\)](#).

*Multiple Basis Applications.* In a multiple-basis application, if in response to a notice of abandonment the applicant elects to delete the intent-to-use basis and only keep the basis or bases to which the notice of allowance does not pertain, then the applicant does not have to file a statement of use or extension request with the petition, or file any further extension requests while the petition is pending. Instead, applicant may submit with the petition a request to delete the intent-to-use basis or the goods/services/classes to which the intent-to-use basis applies and proceed to registration on the alternative basis or bases for registration for those goods/services/classes supported by such alternative bases.

See [TMEP §1705.04](#) and [§1714.01\(d\)](#) regarding petition timeliness and [§1705.05](#) regarding due diligence in monitoring the status of an application.

### **1714.01(b)(i) Applicant Must File Statement of Use or Further Extension Requests During Pendency of a Petition**

Filing a petition to revive does not stay the time for filing a statement of use or further request(s) for extension of time to file a statement of use. When a petition is granted, the term of the six-month extension that was the subject of the petition runs from the date of the expiration of the previously existing deadline for filing a statement of use. [37 C.F.R. §2.89\(g\)](#). Thus, a petitioner must either file a statement of use or file additional extension requests as they become due during the pendency of a petition.

If the applicant fails to file a statement of use or further request(s) for extension of time to file the statement of use while the petition is pending, the USPTO will give the applicant an opportunity to perfect the petition by paying the fees for each missed extension request and filing a copy of the last extension request, or statement of use, that should have been filed. *In re Moisture Jamzz, Inc.*, 47 USPQ2d 1762, 1764 (Comm'r Pats. 1997).

See [TMEP §§1108–1108.05](#) regarding extension requests, and [§§1109–1109.18](#) regarding statements of use.

### 1714.01(c) Notice of Allowance Not Received

The procedural requirements for filing a petition to revive an application abandoned for failure to respond to a notice of allowance are listed in [37 C.F.R. §2.66\(c\)](#). *If the applicant did not receive the notice of allowance*, the petition must include the following:

- (1) The petition fee required by [37 C.F.R. §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. The statement does not have to be verified; and
- (3) 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 again assert non-receipt of the notice of allowance in a subsequent petition.

If the applicant did not receive the notice of allowance, it is not necessary to file a statement of use or request for an extension of time to file a statement of use, or the fees for the number of extension requests that would have been due if the application had never been abandoned. *See* [37 C.F.R. §2.66\(c\)\(2\)\(iii\)](#). If the petition is granted, the USPTO will cancel the original notice of allowance and issue a new notice, giving the applicant a new six-month period in which to file a statement of use or extension request.

The applicant may not assert again that it did not receive the notice of allowance in a subsequent petition. *Id.*

If the petitioner files an extension request with a petition that alleges nonreceipt of the notice of allowance, the USPTO will presume that the applicant wants to maintain the issue date of the original notice of allowance and will process the extension request. Similarly, if the petitioner files a statement of use and the required fees for any missing extension requests with a petition that alleges nonreceipt of the notice of allowance, the USPTO will presume that the applicant intends to maintain the issue date of the original notice of allowance and will process the statement of use.

### 1714.01(d) Timeliness

Under [37 C.F.R. §2.66\(a\)](#), a petition to revive an abandoned application must be filed by not later than: (1) two months after the issue date of the notice of abandonment; 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, where the applicant declares under [37 C.F.R. §2.20](#) or [28 U.S.C. §1746](#) that it did not receive the notice of abandonment.

A petition to revive an application as to goods/services/classes deleted (abandoned) for failure to respond to a partial refusal or requirement must be filed by not later than: (1) two months after the issue date of the examiner's amendment setting forth the changes that will be made in the identification of goods/services; or (2) two months after the date of actual knowledge of the issuance of the examiner's amendment and not later than six months after the date the trademark electronic records system indicates that the application is abandoned in part by examiner's amendment, where the applicant declares under [37 C.F.R. §2.20](#) or [28 U.S.C. §1746](#) that it did not receive the examiner's amendment, provided the application has not registered. *See* [37 C.F.R. §2.66\(a\)](#).

If a petition is untimely, the USPTO will deny the petition and the petition fee will not be refunded.



The applicant may file a petition to revive before the applicant receives the notice of abandonment or the examiner's amendment abandoning in part.

See [TMEP §718.02\(a\)](#) regarding partial abandonment, [§1705.04](#) regarding petition timeliness, and [§1705.05](#) regarding an applicant's duty to exercise due diligence in monitoring the status of an application.

### **1714.01(e) Signed Statement that Delay Was Unintentional**

A petition to revive must include a statement, signed by someone with firsthand knowledge of the facts, that the delay in responding to the Office action or notice of allowance was unintentional. [37 C.F.R. §2.66\(b\)\(2\)](#), [\(c\)\(2\)](#). Generally, it is not necessary to explain the circumstances that caused the unintentional delay and the statement does not have to be verified.

However, if the applicant is alleging that non-receipt of an Office action or notice of allowance caused the unintentional delay, this should be stated; no further explanation is necessary. Note, however, that an applicant may not assert again non-receipt of the same Office action, notification, or notice of abandonment in a subsequent petition.

The USPTO will generally not question the applicant's assertion that the delay in responding to an Office action or notice of allowance was unintentional unless there is information in the record indicating that the delay was in fact intentional. An example of an intentional delay is when an applicant intentionally decides not to file a response or intent-to-use document because it no longer wishes to pursue registration of the mark, but later changes its mind and decides that it does wish to pursue registration.

The person signing the statement must have firsthand knowledge of the facts, but it is not necessary to specifically state in the petition that the signatory has firsthand knowledge. See [TMEP §611.03\(a\)](#). Generally, the USPTO will not question the signatory's authority to sign the statement. However, any response to an Office action accompanying the petition (see [TMEP §1714.01\(a\)\(i\)-\(ii\)](#)) must be signed by a qualified U.S. attorney, or by the individual applicant or someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner of a partnership) if the applicant is not represented by a qualified U.S. attorney. [37 C.F.R. §§2.62\(b\)](#), [2.193\(e\)\(2\)](#), [11.18\(a\)](#). See [TMEP §611.03\(b\)](#) and [§§712–712.03](#) regarding signature of responses to Office actions, [§602](#) regarding persons authorized to represent a party before the USPTO, and [§§611.06–611.06\(h\)](#) for guidelines on persons with legal authority to bind various types of legal entities.

See also [TMEP §1705.07\(b\)](#) regarding signature of petitions, and [§611.01\(c\)](#) regarding signature of documents filed through the trademark electronic filing system.

### **1714.01(f) Applicability of Unintentional Delay Standard**

#### **1714.01(f)(i) Situations Where the Unintentional Delay Standard Applies**

The unintentional delay standard of Trademark Rule 2.66 applies only to the "failure" to respond to an examining attorney's Office action or a notice of allowance. See [15 U.S.C. §§1051\(d\)\(4\)](#), [1062\(b\)](#). This includes the failure to meet minimum filing requirements for a statement of use or request for an extension of time to file a statement of use.

The minimum filing requirements for a statement of use are listed in [37 C.F.R. §2.88\(c\)](#): (1) the fee for at least a single class; (2) at least one specimen of the mark as used in commerce; and (3) a verification or



declaration signed by the applicant or a person properly authorized to sign on behalf of the applicant stating that the mark is in use in commerce.

For a trademark or service mark, the minimum filing requirements for a request for extension of time to file a statement of use are: (1) a verified statement, signed by the applicant or a person properly authorized to sign on behalf of the applicant, that the applicant has a continued bona fide intention to use the mark in commerce; (2) an identification of the goods/services on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce; and (3) payment of the prescribed fee for at least one class of goods or services. *In re El Taurino Rest., Inc.*, 41 USPQ2d 1220, 1222 (Comm'r Pats. 1996); [TMEP §1108.04](#). See [TMEP §1108.04](#) for the minimum filing requirements for an extension request for a collective mark or certification mark.

An applicant who fails to meet the minimum filing requirements for a statement of use or request for an extension of time to file a statement of use has, in effect, not filed the statement of use or extension request. Therefore, if the failure to meet the minimum filing requirements was unintentional, the applicant may file a petition to revive under [37 C.F.R. §2.66](#).

An applicant may also file a petition to revive under [37 C.F.R. §2.66](#) if the applicant timely files a notice of appeal from an examining attorney's final refusal, but unintentionally fails to include the appeal fee required by [15 U.S.C. §1070](#).

## **1714.01(f)(ii) Situations Where the Unintentional Delay Standard Does Not Apply**

### **1714.01(f)(ii)(A) Holding of Abandonment of an Application for Incomplete Response**

The unintentional delay standard of [37 C.F.R. §2.66](#) does *not* apply to an application that is abandoned for filing an incomplete response to an examining attorney's Office action. Incomplete responses to examining attorneys' Office actions are governed by [37 C.F.R. §2.65\(a\)-\(a\)\(2\)](#), which gives the examining attorney discretion to grant an applicant 30 days, or to the end of the response period for the previous Office action, whichever is longer, to perfect the response pursuant to [37 C.F.R. §2.65\(a\)\(2\)](#). If the examining attorney holds the application abandoned for failure to file a complete response to an Office action, the applicant may file a petition to the Director to review the examining attorney's action under [37 C.F.R. §2.146](#). The Director will reverse the examining attorney's action only if there is clear error or an abuse of discretion, the petitioner establishes substantial compliance, or, where the application was abandoned due to an improperly signed response, the petitioner provides a properly signed response to Office action. See [TMEP §§1713.01, 1713.02](#).

A request for reconsideration of a final refusal (*see* [TMEP §§715.03–715.03\(c\)](#)) that does not meet all legal requirements and is not accompanied by a proper notice of appeal will be treated as an incomplete response to the final Office action. If the examining attorney denies the request for reconsideration, the time for filing a notice of appeal runs from the issuance date of the final action. [TMEP §715.03\(c\)](#). If the time for appeal has expired and the application is abandoned for an incomplete response, the applicant may not file a petition to revive under [37 C.F.R. §2.66](#). The applicant may file a petition to the Director to review the examining attorney's action under [37 C.F.R. §2.146](#). See [TMEP §1713](#) regarding petitions to reverse a holding of abandonment for an incomplete response.

### **1714.01(f)(ii)(B) Examining Attorney’s Refusal of Registration on Ground That Applicant Did Not Meet Statutory Requirements Before Expiration of Deadline for Filing Statement of Use**

If the applicant unintentionally fails to meet the minimum requirements for *filing* a statement of use, as set forth in [37 C.F.R. §2.88\(c\)](#), the applicant may file a petition to revive under [37 C.F.R. §2.66](#). However, the applicant may not file a petition to revive under [37 C.F.R. §2.66](#) if the applicant met the minimum filing requirements of [37 C.F.R. §2.88\(c\)](#), but the examining attorney later refuses registration on the ground that the applicant failed to satisfy the statutory requirements for a *complete* statement of use ([15 U.S.C. §1051\(d\)](#); [37 C.F.R. §2.88\(b\)](#)) on or before the statutory deadline (e.g., because the specimen is unacceptable or the dates of use are subsequent to the deadline for filing the statement of use). The applicant may appeal the examining attorney’s refusal of registration to the Trademark Trial and Appeal Board. See [TMEP §1109.16\(a\)](#) regarding the requirements that must be met within the statutory period for filing the statement of use.

### **1714.01(f)(ii)(C) Goods/Services Omitted from Statement of Use or Request for Extension of Time to File a Statement of Use**

If the applicant lists the goods/services/classes in a statement of use or request for an extension of time to file a statement of use, and omits any goods or services that were listed in the notice of allowance, the USPTO will presume these goods/services to be deleted. The applicant may not thereafter request that the goods/services be reinserted in the application. [37 C.F.R. §§2.88\(b\)\(1\)\(iv\)](#), [2.89\(f\)](#); [TMEP §§1108.02\(d\)](#), [1109.13](#). In these situations, the applicant may not file a petition under [37 C.F.R. §2.66](#) claiming unintentional delay in filing a statement of use or extension request for the omitted goods/services.

### **1714.01(f)(ii)(D) Registered Marks**

Trademark Rule 2.66 does not apply to registrations; it only applies to applications.

*Registrants must file petition to Director, not petition to revive.* If a registrant fails to timely respond to an Office action regarding a §8 affidavit, §71 affidavit, or §9 renewal application, even if the electronic record does not indicate the registration is cancelled or expired, the registrant may file a petition to the Director under [37 C.F.R. §2.146\(a\)\(5\)](#) and [§2.148](#) to waive a rule and accept a late response. The petition must be filed by not later than two months after the issue date of the notice of cancellation/expiry. [37 C.F.R. §2.146\(d\)\(1\)](#). Where the registrant declares under [37 C.F.R. §2.20](#) or [28 U.S.C. §1746](#) that it did not receive the action, the petition must be filed by not later than two months of actual knowledge of the cancellation/expiry and not later than six months after the date the trademark electronic records system indicates that the registration is cancelled/expired. [37 C.F.R. §2.146\(d\)\(2\)\(ii\)](#).

The Director will waive a rule only in an extraordinary situation, where justice requires, and no other party is injured. The Director has no authority to waive a statutory requirement. See [TMEP §1708](#) regarding the waiver of rules.

See [TMEP §§1712.02–1712.02\(b\)](#) regarding requests to reinstate cancelled or expired registrations.

### **1714.01(f)(ii)(E) Dismissal of Appeal for Failure to File a Brief**

An applicant cannot file a petition to revive under [37 C.F.R. §2.66](#) if an application is abandoned because the Board dismisses an appeal for failure to file a brief. In this situation, the applicant may file a motion with the Board to set aside the dismissal and accept a late-filed brief. See [TBMP §1203.02\(a\)](#). If the Board

denies this motion, the applicant may file a petition to the Director under [37 C.F.R. §2.146](#), asking the Director to reverse the Board's order. The petition must be filed by not later than thirty days after the issue date of the Board's order. [37 C.F.R. §2.146\(e\)\(2\)](#). The Director will reverse the Board's action only if the Board clearly erred or abused its discretion.

### **1714.01(g) Request for Reconsideration of Denial of Petition to Revive**

Under [37 C.F.R. §2.66\(e\)](#), if a petition to revive is denied, the applicant may request reconsideration by: (1) filing the request for reconsideration by not later than two months after the issue date of the decision denying the petition or 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 [37 C.F.R. §2.20](#) or [28 U.S.C. §1746](#) that it did not receive the decision; and (2) paying a second petition fee under [37 C.F.R. §2.6](#). *See* [TMEP §1705.08](#). Petitioners should use the trademark electronic filing system's Petition to Director form to request reconsideration.

## **1715 Letters of Protest Against Pending Applications**

### ***37 CFR 2.149 Letters of protest against pending applications.***

(a) A third party may submit, for consideration and inclusion in the record of a trademark application, objective evidence relevant to the examination of the application for a ground for refusal of registration if the submission is made in accordance with this section.

(b) A party protesting multiple applications must file a separate submission under this section for each application.

(c) Any submission under this section must be filed no later than 30 days after the date the application is published for opposition under section 12(a) of the Act and § 2.80 of this part. If the subject application cannot be withdrawn from issuance of a registration while consideration of the protest is pending, the protest may be considered untimely.

(d)

(1) If the letter of protest is filed before publication of the subject application, the evidence must be relevant to the identified ground(s) for refusal, such that it is appropriate for the examining attorney to consider whether to issue a refusal or make a requirement under the Act or this part.

(2) If the letter of protest is filed on or within 30 days after the date of publication of the subject application, the evidence must establish a prima facie case for refusal on the identified ground(s), such that failure to issue a refusal or to make a requirement would likely result in issuance of a registration in violation of the Act or parts 2 or 7 of this section.

(e) Filing a submission under this section does not stay or extend the time for filing a notice of opposition.

(f) Any submission under this section must be made in writing, filed through TEAS, and include:

(1) The fee required by § 2.6(a)(25);

(2) The serial number of the pending application that is the subject of the protest;

(3) An itemized evidence index that does not identify the protestor or its representatives, does not contain legal argument, and includes:

(i) An identification of the documents, or portions of documents, being submitted as evidence. The submission may not total more than 10 items of evidence in support of a specified ground of refusal and more than 75 total pages of evidence without a detailed and sufficient explanation that establishes the special circumstances that necessitate providing more than 10 items of evidence per refusal ground or more than 75 total pages of evidence; and

(ii) A concise factual statement of the relevant ground(s) for refusal of registration appropriate in ex parte examination that each item identified supports; and

(4) A clear and legible copy of each item identified in the evidence index where:

(i) Copies of third-party registrations come from the electronic records of the Office and show the current status and title of the registration;

(ii) Evidence from the internet includes the date the evidence was published or accessed and the complete URL address of the website; and

(iii) Copies of printed publications identify the publication name and date of publication.

(g) Any submission under this section may not be entered or considered by the Office if:

- (1) Any part of the submission is not in compliance with this section;
- (2) The application record shows that the examining attorney already considered the refusal ground(s) specified in the submission; or
- (3) A provision of the Act or parts 2 or 7 of this chapter precludes acceptance of the submission.

(h) If a submission is determined to be in compliance with this section, only the specified ground(s) for refusal and the provided evidence relevant to the ground(s) for refusal will be included in the application record for consideration by the examining attorney. An applicant should not reply to the entry into the application record of evidence entered under this section.

(i) Any determination whether to include evidence submitted under this section in the record of an application is final and non-reviewable, and a determination to include or not include evidence in the application record shall not prejudice any party's right to raise any issue and rely on any evidence in any other proceeding.

(j) A third party filing a submission under this section will not receive any communication from the Office relating to the submission other than acknowledgement that it has been received by the Office and notification of whether the submission is found to be compliant or non-compliant with this section. Communications with the third party will not be made of record in the application. The Office will not accept amendments to a non-compliant submission that was previously filed. Instead, a third party who previously filed a non-compliant submission may file another submission that meets the requirements of paragraph (f) of this section, provided the time period for filing a submission in paragraph (c) of this section has not closed.

(k) The limited involvement of the third party ends with the filing of the submission under this section. The third party may not directly contact the examining attorney assigned to the application.

A letter of protest is a procedure whereby third parties may submit, for consideration and entry in the record of a trademark application, objective evidence bearing on the registrability of a mark. [37 C.F.R. §2.149\(a\)](#). The letter of protest procedure applies only to pending applications and is intended to aid in examination without causing undue delay and without compromising the integrity and objectivity of the ex parte examination process. See *In re BPJ Enters., Ltd.*, 7 USPQ2d 1375 (Comm'r Pats. 1988); *In re Pohn*, 3 USPQ2d 1700 (Comm'r Pats. 1987).

Letters of protest are reviewed in the Office of the Deputy Commissioner for Trademark Examination Policy (Deputy Commissioner). To preserve the integrity and objectivity of the ex parte examination process, the letter of protest is not entered into the application file. The Deputy Commissioner will determine if the letter of protest complies with the requirements of Rule 2.149 and whether any submitted evidence should be included in the application record without consulting with the examining attorney. The Deputy Commissioner considers only the record in the application and the evidence submitted by the protestor. *In re BPJ Enters., Ltd.*, 7 USPQ2d 1375, 1378 (Comm'r Pats. 1988).

If a third party attempts to contact an examining attorney regarding a letter of protest, the examining attorney will refer the third party to the Deputy Commissioner's Office. [37 C.F.R. §2.149\(k\)](#). If an examining attorney receives a letter of protest, the letter will be referred to the Deputy Commissioner's Office.

A letter of protest may not be entered or considered by the Office if: (1) any part of the submission does not comply with the requirements of Rule 2.149; (2) the application record shows that the examining attorney already considered the refusal ground(s) specified in the submission; or (3) acceptance of the submission is precluded by a provision of the Trademark Act or applicable rules. [37 C.F.R. §2.149\(g\)](#).

However, when a letter of protest complies with the requirements of Rule 2.149, the Deputy Commissioner may determine that the evidence should be included in the application record even if the examining attorney already considered the refusal ground(s) when: (1) the evidence provided by the protestor is significant additional evidence not currently of record in the application; or (2) the examining attorney clearly erred in their consideration of the issue and such error would result in the issuance of a registration in violation of the Trademark Act or applicable rules. See [TMEP §706.01](#) regarding clear error.

If it is determined that evidence submitted with a letter of protest should be included in the application record, only the evidence and the ground for refusal to which the evidence relates will be so included. [37 C.F.R. §2.149\(h\)](#). Any determination whether or not to include evidence in the record of an application is not petitionable. [37 C.F.R. §2.149\(i\)](#).

## **1715.01 Appropriate and Inappropriate Subjects to Be Raised in Letter of Protest**

Only issues and evidence relevant to a ground for refusing registration during the ex parte examination of an application are appropriate subjects for a letter of protest. [37 C.F.R. §2.149\(a\)](#). It is inappropriate to use the letter-of-protest procedure to delay registration or to present purely adversarial arguments. Adversarial arguments objecting to registration must be made in an opposition proceeding after publication or, in the case of the Supplemental Register, a cancellation proceeding after registration. The letter-of-protest procedure may not be used to circumvent the requirements for filing an opposition.

### **1715.01(a) Issues Appropriate as Subjects of Letters of Protest**

Appropriate subjects for letters of protest concern issues that the examining attorney has the authority and resources to pursue to a legal conclusion without further intervention by third parties. The following are examples of the most common areas of protest:

- (1) A third party files an objection to the registration of a term because it is allegedly generic or descriptive. The objection must be accompanied by *evidence* of genericness or descriptiveness and an index listing each item of evidence. The evidence should be objective, independent, and factual evidence that the examining attorney may use to support the suggested refusal.
- (2) A third party notifies the USPTO of the existence of a federally registered mark or prior-pending application and alleges that there is a likelihood of confusion between this mark and the mark in the application that is the subject of the letter of protest. If the goods or services are not identical, the letter of protest must be accompanied by evidence showing the relatedness of the goods or services and an index listing each item of evidence.
- (3) A third party files a request that prosecution of an application be suspended because of pending litigation claiming infringement based on the applicant's use of the applied-for mark. The litigation must be specifically identified and a copy of the relevant pleadings must be enclosed. The litigation must involve a federally registered mark or prior-pending application of the protestor, and the protestor must allege that there is a likelihood of confusion between this mark and the mark in the application that is the subject of the letter of protest. Normally, a court proceeding is not considered relevant to the registrability of a mark unless the remedy requested in the proceeding is cancellation, abandonment, or amendment of the application that is the subject of the letter of protest, or enjoinder from using the protested mark in commerce.
- (4) A third party notifies the USPTO that registered marks are being used inappropriately in identifications of goods and services, mark descriptions, or other application data fields for particular applications. (See [TMEP §1402.09](#).)
- (5) A third party notifies the USPTO that the specimens of use in the protested application are not in use in commerce, for example, they have been digitally altered or feature an image that is used by third parties without the mark in question or an image that appears in multiple prior registrations or applications all bearing different marks.
- (6) A third party notifies the USPTO of the existence of a subsequently filed U.S. application and alleges that the application contains a proper claim of priority under §44(d) to which the third party is entitled and that there is a likelihood of confusion between its mark and the mark in a prior-filed application that is the subject of the letter of protest. See [TMEP §§1003.05](#) and [1904.01\(e\)](#).

- (7) A third party notifies the USPTO of the serial number of an application filed under §66(a) with an earlier filing date or a priority claim to which the third party is entitled and that there is a likelihood of confusion between its mark and the mark in the application that is the subject of the letter of protest, even if the §66(a) application was not entered into the Trademark database at the time the application that is the subject of the letter of protest was examined. See [TMEP §§1904.01\(b\)](#) and [1904.01\(e\)](#).
- (8) A third party notifies the USPTO that the foreign application relied upon as the basis for a claim of priority under §44(d) is not the first application filed in a treaty country and provides evidence of the existence of an earlier-filed foreign registration or pending foreign application. See [TMEP §1003.01](#).

### **1715.01(b) Issues Inappropriate as Subjects of Letters of Protest**

The following are examples of issues that are *not* appropriate to raise in letters of protest:

- A third party claims earlier common-law use of a trademark but does not have a federal registration or previously filed pending application for that mark. The examining attorney can only consider registrations and prior-pending applications when determining likelihood of confusion. Earlier common-law use, state registrations, and other claims based on evidence other than federal registrations and prior-pending applications for federal registration are not appropriate for presentation to examining attorneys during ex parte examination.
- A third party claims that the applicant is not the proper owner of the mark. This issue requires proof that is beyond the scope of authority of an examining attorney to require during ex parte examination. *In re Apple Computer, Inc.*, 57 USPQ2d 1823 (Comm'r Pats. 1998).
- A third party requests that prosecution of an application be suspended or refused because of pending litigation, but does not provide proof that the pending litigation includes grounds upon which the Office can suspend or refuse registration (e.g., the litigation does not involve a federally registered mark or prior-pending application of the protestor).
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### **1715.02 Timely Filing of Letter of Protest**

The most appropriate time for filing a letter of protest is before publication of a mark, because the purpose of the letter of protest is to assist the USPTO in the examination of an application for registration by bringing to its attention evidence that may support a refusal of registration. Because applications that will issue on the Supplemental Register are not published for opposition, letters of protest regarding such applications must be submitted as soon as possible after the filing of the application.

Letters of protest filed more than 30 days after publication are untimely. [37 C.F.R. §2.149\(c\)](#). See also *In re BPJ Enter's. Ltd.*, 7 USPQ2d 1375, 1378 (Comm'r Pats. 1988). This applies to all applications, including intent-to-use applications under [15 U.S.C. §1051\(b\)](#). *In re G. Heileman Brewing Co., Inc.*, 34 USPQ2d 1476, 1478 (Comm'r Pats. 1994).

If a letter of protest is filed against an application that is the subject of a request for extension of protection of an international registration under Trademark Act §66(a), in addition to meeting the timeliness standards set forth above for all letters of protest, it must also satisfy the timeliness requirements for refusals under Trademark Act §68(c) and Article 5 of the Madrid Protocol. In essence, a letter of protest against a §66(a) application must be filed before the 18-month deadline after the application was transmitted to the USPTO from the IB. A letter of protest is untimely and will not be considered if it is more than 18 months from the



date the IB transmitted the protested application to the USPTO. [37 C.F.R. §2.149\(g\)\(3\)](#). See [TMEP §1904.03\(a\)](#).

Filing a request for extension of time to oppose does not extend the 30-day deadline for filing a letter of protest.

A protestor may file a petition to the Director under [37 C.F.R. §§2.146\(a\)\(5\)](#) and [2.148](#) to waive [37 C.F.R. §2.149\(c\)](#) so that an untimely letter of protest may be considered. However, the Director will waive a rule only in an extraordinary situation, where justice requires, and no other party is injured. See [TMEP §1708](#). For example, an extraordinary situation that would warrant waiver of the timeliness requirement for a letter of protest filed more than 30 days after publication may be established upon a showing that all of the evidence provided in the letter of protest was not in existence prior to publication. However, the evidence must establish a prima facie case for refusal.

The letter of protest procedure applies *only* to pending applications. A letter of protest will be moot if the mark registers before a determination on the letter is made. Once the mark has registered, the protestor's remedy is to file a petition to cancel with the Board.

### **1715.03 Letter of Protest Filed Before Publication**

#### **1715.03(a) Standard of Review for Letter of Protest Filed Before Publication**

When a letter of protest filed before publication complies with the requirements of Rule 2.149, the Deputy Commissioner will determine whether the submitted evidence is relevant and supports the identified ground(s) for refusal. [37 C.F.R. §2.149\(d\)\(1\)](#). The letter of protest will be reviewed and a determination will be made even if the examining attorney has not yet taken a first action in the application that is the subject of the letter of protest. If the evidence is relevant to the identified ground(s) for refusal, the Deputy Commissioner will include the evidence (but not the letter of protest itself) in the application record for consideration by the examining attorney. [37 C.F.R. §2.149\(h\)](#).

A letter of protest filed before publication but reviewed by the Deputy Commissioner after publication will be reviewed under the pre-publication standard. [TMEP §1715.02\(b\)](#).

#### **1715.03(b) Action by Examining Attorney Before Publication**

The examining attorney is *not* required to issue a refusal as a result of a pre-publication letter of protest where it is determined that the submitted evidence should be included in the application record. The examining attorney is required only to consider the evidence and make an independent determination whether to issue the requirement or refusal requested to which the evidence relates. The examining attorney need not inform the applicant that evidence submitted with a letter of protest was included in the record unless the examining attorney is issuing a refusal based upon the information provided with the letter of protest. The prosecution history of the application will reflect the entry of the evidence submitted with a letter of protest, and a memorandum attaching all relevant evidence and identifying the grounds for refusal and/or requirements to which the evidence relates will be added to the application record. If the examining attorney decides against issuing the refusal or requirement, the prosecution history of the application in the Trademark database will be updated to indicate "LETTER OF PROTEST EVIDENCE REVIEWED - NO FURTHER ACTION TAKEN."

*Letters of Protest Filed Before Publication but Determined to be Compliant After Publication*

In certain circumstances, a letter of protest filed before publication may not be reviewed by the Deputy Commissioner until after publication or during the period when the USPTO cannot withdraw the mark from publication. Such letters are reviewed under the pre-publication standard. In such cases, if the Deputy Commissioner determines that the evidence submitted with the letter of protest should be included in the application record, the examining attorney is not required to issue a refusal or requirement as a result of the inclusion of the submitted evidence in the record. However, the examining attorney must consult with their managing attorney to determine whether a refusal or requirement is warranted.

If the examining attorney determines that a refusal or requirement must be made after publication and prior to the filing of a notice of opposition or issuance of a notice of allowance, the Commissioner for Trademarks will restore jurisdiction, pursuant to the authority delegated by the Director, so that the examining attorney may take action on the application. See [TMEP §1504.04](#). If an opposition proceeding has been instituted, the Board will restore jurisdiction to the examining attorney so that the examining attorney may take the specified action. See [TMEP §1504.05](#).

If the letter of protest concerns a mark in an intent-to-use application where a notice of allowance has issued, the examining attorney has jurisdiction over the application. [37 C.F.R. §2.84\(a\)](#). If the examining attorney determines, after consulting with their managing attorney, that a refusal or requirement must be made, and a statement of use has not been filed, before issuing an Office action, the examining attorney must contact the ITU/Divisional Unit to cancel the notice of allowance and refund any fees paid for requests for an extension of time to file a statement of use. See [TMEP §1106.03](#).

If the letter of protest concerns a mark for which a statement of use has been filed, the examining attorney has jurisdiction over the application. If the examining attorney determines, after consulting with their managing attorney, that a refusal or requirement must be made, and no action has been taken on the statement of use, the examining attorney must review the statement of use and include any issues relevant to the statement of use in the Office action resulting from the letter of protest. If an Office action regarding the statement of use has already issued, the examining attorney must issue a supplemental action regarding the refusal(s) or requirement(s) resulting from the letter of protest and incorporating by reference or restating any other outstanding refusal(s) or requirement(s).

## **1715.04 Letters of Protest Filed on the Date of Publication or After Publication**

### **1715.04(a) Standard of Review for Letters of Protest Filed on the Date of Publication or After Publication**

When a letter of protest filed on the date of publication or within 30 days after the date of publication complies with the requirements of Rule 2.149, the Deputy Commissioner will determine whether the evidence establishes a prima facie case for refusal of registration on the identified ground(s), such that failure to issue a refusal or to make a requirement would likely result in issuance of a registration in violation of the Trademark Act or applicable rules. [37 C.F.R. §2.149\(d\)\(2\)](#). *In re BPJ Enters. Ltd.*, 7 USPQ2d 1375, 1379 (Comm'r Pats. 1988). See [TMEP §1715.05](#) regarding the nature of relevant evidence.

### **1715.04(b) Jurisdiction of Application After Publication**

As a general rule, after publication, the examining attorney does not have jurisdiction to act on an application. [TMEP §1504.04](#). Therefore, if a letter of protest filed after publication and before issuance of the registration or notice of allowance complies with the requirements of Rule 2.149 and the Deputy Commissioner determines that the submitted evidence will be included in the application record for consideration by the examining

attorney, the Commissioner for Trademarks will restore jurisdiction of the application to the examining attorney pursuant to the authority delegated by the Director. The Commissioner will also restore jurisdiction under such circumstances when an extension of time to file an opposition has been filed. However, if an opposition has been instituted, the Board has jurisdiction over the application and the Commissioner will request that the Board restore jurisdiction to the examining attorney. [TMEP §1504.02](#).

If the letter of protest concerns a mark in an intent-to-use application where a notice of allowance has issued, the examining attorney has jurisdiction. [37 C.F.R. §2.84\(a\)](#). If the Deputy Commissioner determines that the evidence submitted with the letter of protest should be included in the application record and a statement of use has not been filed, the USPTO will cancel the notice of allowance and refund any fees paid for requests for an extension of time to file a statement of use. [TMEP §1106.03](#). Furthermore, if a statement of use has been filed, the examining attorney has jurisdiction and must review the statement of use and include any issues relevant to the statement of use in the Office action resulting from the letter of protest. If an Office action regarding the statement of use has already issued, the examining attorney must issue a supplemental action regarding the refusals or requirements resulting from the evidence included in the record and incorporating by reference or restating any other outstanding refusals or requirements.

### **1715.04(c) Action by Examining Attorney After Publication**

If the Deputy Commissioner determines that evidence submitted with a letter of protest filed on the date of publication or after publication establishes a prima facie case for refusal on the identified ground(s) and should be included in the record of the protested application, the examining attorney generally must issue the refusal or requirement. If the refusal is made, the examining attorney must inform the applicant that such evidence was entered after submission of a letter of protest. If the application was withdrawn from issuance of a notice of allowance or registration, the examining attorney must so inform the applicant. Before issuing the Office action with the refusal or requirement, the examining attorney must have the action reviewed by their managing attorney.

However, the inclusion of evidence submitted with the letter of protest into the application record is not a final determination by the USPTO that registration must be refused. In some circumstances, the examining attorney may discover additional evidence that would justify approval of the application for registration after acceptance of a letter of protest, or the applicant may overcome the refusal or satisfy the requirement. In such a case, if the examining attorney determines that the mark should be approved for issuance of a registration or notice of allowance, the managing attorney must obtain permission from the Office of the Deputy Commissioner for Trademark Examination Policy to approve the application for issue. If permission is granted, Examination Policy staff will enter an appropriate Note to the File (also referred to as a Public Note or Notation to File).

### **1715.04(d) Letter of Protest Does Not Stay or Extend Opposition Period**

Filing a letter of protest does not stay or extend the opposition period. [37 C.F.R. §2.149\(e\)](#). Therefore, a party who files a letter of protest after publication should also file a timely request(s) for extension of time to oppose under [15 U.S.C. §1063](#) with the Trademark Trial and Appeal Board. See [TBMP §215](#) for further information. The Board will not suspend a potential opposer's time to file a notice of opposition because a letter of protest has been filed. See notice at [68 Fed. Reg. 55748, 55760](#) (Sept. 26, 2003).

## 1715.05 Information for Parties Filing Letter of Protest

Third parties who object to the registration of a mark in a pending application must never directly contact an examining attorney in any way. Instead, they may submit evidence for consideration for inclusion in the record via the letter-of-protest procedure.

Letters of protest must be filed electronically via the trademark electronic filing system and must be accompanied by the fee required under [37 C.F.R. §2.6](#), [37 C.F.R. §2.149\(f\)](#). Letters of protest filed on paper will not be considered. A separate letter of protest, including relevant grounds and evidence, must be filed for each individual application that is being protested. [37 C.F.R. §2.149\(b\)](#). See [TMEP §§1715.05\(a\)](#) and [\(b\)](#) regarding the nature and format of evidence to be included with a letter of protest.

The letter of protest must include an email address for receiving an acknowledgment of the submission and notification of whether the submission was determined to be compliant or noncompliant with the requirements of Rule 2.149. [37 C.F.R. §2.149\(j\)](#). If the letter of protest does not comply with the requirements of Trademark Rule 2.149, the protestor may not amend the non-compliant submission. *Id.* Instead, the party may file another letter of protest that meets the requirements, provided the time period for filing has not closed. *Id.*

Generally, the protestor should expect to receive the notification within 60 days of filing the letter. The protestor should monitor the application status by checking the TSDR database at <https://tsdr.uspto.gov> to determine whether an action concerning the letter of protest has been taken. This information will be in the public record only if the letter of protest submission is compliant and evidence is entered into the application record. If a protestor has not received a response within two months of submitting a letter of protest, the protestor should contact the Petitions Office to confirm receipt of the letter of protest.

Protestors should continue to monitor the status of the application being protested because the application may be approved for publication, republication, or issuance of a registration even when the evidence submitted with a compliant letter of protest is included in the application record. Ongoing monitoring will ensure protestors the opportunity to take other action such as filing a notice of opposition.

### 1715.05(a) Types of Evidence Appropriate for Letter of Protest

If the letter of protest complies with the requirements of Rule 2.149, only the specified ground(s) for refusal and the provided evidence relevant to the ground(s) for refusal will be included in the application record for consideration by the examining attorney. [37 C.F.R. §2.149\(h\)](#). See [37 C.F.R. §§2.149\(f\)](#), [\(g\)](#), and [TMEP §1715.05\(b\)](#) regarding the amount and format of evidence for letters of protest.

Note that a letter of protest should not include information or evidence concerning prior use, actual confusion, or ownership disputes. These are not appropriate grounds for refusing registration during ex parte examination and must be addressed in an inter partes proceeding before the Trademark Trial and Appeal Board or a civil court.

The type of evidence relevant to the examination of the mark depends upon the nature of the objection raised. For example, if an objection is filed on the basis that a mark, or portion of a mark, is descriptive or generic, the protestor must submit factual, objective evidence, such as descriptive or generic use by others or excerpts from the dictionary showing the meaning of the mark. Merely submitting a list of web sites is not sufficient. If third-party registrations are offered to show that the mark or a portion of the mark is descriptive, generic, or so commonly used that the public will look to other elements to distinguish the source of the goods or services, a mere list of the registrations or copy of a search report is not proper evidence of such registrations.

Rather, copies of the registrations or the electronic equivalent thereof showing the current status and title (i.e., printouts or electronic copies taken from the trademark search system or TSDR database of the USPTO) must be submitted. See [TMEP §1207.01\(d\)\(iii\)](#).

If an objection is based on a likelihood of confusion with existing federally registered marks or prior-pending applications, and the goods and/or services are not identical, evidence of the relatedness of the goods and/or services must be included. Such evidence may include advertisements showing that the relevant goods/services are advertised together or sold by the same manufacturer or copies of registrations showing that such goods/services emanate from the same source. Note that a list of registration numbers, a chart containing the registration numbers and identified goods/services, or a copy of a search report is not proper evidence to show the relatedness of the goods or services in the registrations. Rather, copies of the registrations or the electronic equivalent thereof showing current status and title (i.e., printouts or electronic copies taken from the trademark search system or TSDR database of the USPTO) must be submitted. However, third-party registrations not based on use in commerce have little, if any, persuasive value and generally will not be included in the application record for consideration of the relatedness of the goods and services. See [TMEP §1207.01\(d\)\(iii\)](#). In addition, where a protestor wants to establish that its goods or services are related to those in the application(s) for which it is submitting the letter of protest, such evidence must pertain to the goods or services identified in the application. Evidence regarding how the protestor is using its mark for goods or services not identified in the registration or prior-pending application that form the basis for the letter of protest is inappropriate and will not be included in the application record.

If an objection is that the specimen in the protested application does not show actual use of the mark in commerce, the protest must contain objective third-party evidence. Such evidence may include: (1) third parties using the same specimen image without the trademark in question; (2) the specimen image appearing in multiple prior registrations or applications all bearing different marks; (3) evidence demonstrating that the specimen was digitally created or altered, for example, the image appears identical to a stock image from sources such as Getty Images®; or (4) evidence demonstrating that the specimen was not in use on or prior to the date it was submitted, for example, cached webpages from sources such as the Wayback Machine® that do not show past usage of the mark or webpage evidence showing the business is “coming soon.” See [TMEP §710.01\(b\)](#) for further guidance on internet evidence. Evidence merely showing that a product cannot currently be found on retail websites will not be considered, unless there is other evidence of nonuse.

If an objection is based on the ground that the public would not perceive the matter in the protested application as a trademark indicating a single source of the good or services and instead would perceive it merely as a widely used message or common phrase, the submitted evidence must show that various sources use the phrase in the marketplace. Screenshots of webpages showing a variety of products bearing the phrase, such as t-shirts, mugs, and keychains, along with evidence showing that the phrase is commonly used in everyday speech, such as in news articles, webpages, and blogs, must be provided. See [TMEP §710.01\(b\)](#) for further guidance on internet evidence and [§1202.04\(b\)](#) for information about widely used messages.

### **1715.05(b) Amount and Format of Evidence for Letter of Protest**

The letter of protest should include only a simple statement of the proposed legal ground(s) for refusing registration or issuing a requirement, together with succinct, factual, objective evidence to support the refusal or requirement. It should not include arguments. The letter of protest process is intended to provide an opportunity for the protestor to efficiently and effectively provide relevant evidence in support of the proposed legal grounds for refusing registration identified in the letter of protest. It is inappropriate for the protestor to “dump” evidence and leave it to the USPTO to determine its possible relevance. Therefore, evidence submitted with the letter of protest should be succinct, not duplicative, and be limited to the most relevant evidence. A separate itemized index that does not identify the protestor or its representatives or contain legal



argument is required for all evidentiary submissions. [37 C.F.R. §2.149\(f\)\(3\)](#). See *infra*, this section, for the requirements of an evidentiary index.

When the basis of the letter of protest is the existence of federally registered marks, or prior-pending applications, with which the protestor alleges that there is, or would be, a likelihood of confusion with the mark in the protested application, the protestor should not identify more than the five most relevant registrations or applications that could form a basis for refusal. If the protestor identifies more than five registrations or applications, only the first five identified registrations or applications will be considered.

Where numerous examples of third-party registrations or web pages exist regarding the relatedness of the goods and/or services, or to support any other refusal, it is not necessary to provide them all. The evidence of third-party registrations and/or use submitted with the letter of protest should be limited to the most relevant examples. Copies of third-party registrations must come from the electronic records of the USPTO and show the current status and title of the registration. [37 C.F.R. §2.149\(f\)\(4\)\(i\)](#). When submitting web pages from the Internet as evidence, the web page must include the date the web page was published or accessed and the complete URL address of the web page. [37 C.F.R. §2.149\(f\)\(4\)\(ii\)](#). See *In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1593 (TTAB 2018); *In re Mueller Sports Med., Inc.*, 126 USPQ2d 1584, 1586 (TTAB 2018); *Safer Inc. v. OMS Inv. Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010). Similarly, scanned copies of pages from printed books or articles must identify the publication name and the date of publication. [37 C.F.R. §2.149\(f\)\(4\)\(iii\)](#). The URL address and date of URL access, or publication name and date of publication, must be on the evidence itself or on a separate page attached to the letter of protest. This information should not be contained in the letter of protest submission form since the form itself is not forwarded to the examining attorney. It is preferable for each piece of evidence to appear on its own page. If a page contains multiple items of evidence and some of the information on the page is irrelevant, the page will not be forwarded to the examining attorney.

It should be a rare situation in which more than 10 items of evidence in support of a specified ground of refusal and more than 75 total pages of evidence is necessary to support the proposed legal grounds for refusal. Therefore, a letter of protest accompanied by more than 10 items of evidence in support of a specified ground of refusal or more than 75 total pages of evidence will not be considered unless it includes a detailed and sufficient explanation establishing the special circumstances that necessitate providing the additional evidence. [37 C.F.R. §2.149\(f\)\(3\)\(i\)](#).

The index must be provided as a separate electronic attachment to the trademark electronic filing system's Letter of Protest form, and contain a concise factual description of each category or form of evidence included. *Id.* If any item of evidence attached to the letter of protest consists of multiple pages, the index must specifically identify the page on which the relevant information appears within the item of evidence. To maintain the integrity of the ex parte examination process, the index must not identify the protestor or its representatives or contain any arguments or use subjective terms to identify or describe the evidence. [37 C.F.R. §2.149\(f\)\(3\)](#).

### **1715.05(c) Letter-of-Protest Evidence – Trademark Trial and Appeal Board Proceedings**

As discussed above, if a letter of protest filed before publication is determined to be compliant, only the relevant evidence and grounds for refusal to which the evidence relates is included in the application record. However, the examining attorney is not required to issue a refusal or requirement as a result of the entry of the evidence in the record. See [TMEP §1715.02\(b\)](#).

In an ex parte proceeding regarding an application in which the record includes evidence submitted in a letter of protest filed before publication, if the examining attorney did not issue a refusal or requirement



based on the evidence, the Trademark Trial and Appeal Board will not rely on the evidence in the Board proceeding because the applicant would not have the opportunity to rebut the evidence.

In an inter partes proceeding, a party may not rely on such evidence unless it introduces the evidence during the assigned testimony period, either through testimony or by a notice of reliance, as appropriate. *See, e.g.,* [37 C.F.R. §2.122\(b\)\(2\)](#) and [TBMP §704.03\(a\)](#).

### **1715.06 Requests for Copy of Letter of Protest**

Any party who wishes to request a copy of a letter of protest may do so by sending an email to [FOIARequests@uspto.gov](mailto:FOIARequests@uspto.gov).

Upon review of the request, the Deputy Commissioner will usually forward a copy of the letter of protest and its attachment to the requester, subject to any exemptions from the Freedom of Information Act (FOIA) or other applicable regulations. If, in the opinion of the Deputy Commissioner, any part of the letter of protest or its attachments should be exempt from disclosure under FOIA, the matter will be forwarded to the Office of General Counsel of the USPTO for further review.

### **1715.07 Recourse if Letter of Protest Submission is Determined to be Noncompliant**

If the Deputy Commissioner determines that a letter of protest submission does not comply with the requirements of Rule 2.149, such that the evidenced submitted is not included in the application record, the protestor may pursue remedies otherwise available, such as an opposition proceeding, if the protestor complies with all relevant requirements and deadlines. Filing a letter of protest does not stay or extend the time for filing a notice of opposition. [37 C.F.R. §2.149\(e\)](#); [TMEP §1715.03\(b\)](#).

The protestor may not amend or file a request for reconsideration of the determination whether to include in the application record the ground(s) or evidence for a refusal identified in a letter of protest with the Deputy Commissioner. [37 C.F.R. §2.149\(i\),\(j\)](#); *see also In re BPJ Enter's. Ltd.*, 7 USPQ2d 1375, 1378 (Comm'r Pats. 1988). Nor may the protester petition the Director to review the Deputy Commissioner's determination. [37 C.F.R. §2.149\(i\)](#). Instead, a party who previously filed a non-compliant submission may file another letter of protest submission that meets the requirements of [37 C.F.R. §2.149\(f\)](#), provided the time period for filing a submission has not closed.

## **1716 Petitions for Expungement or Reexamination**

### ***37 CFR § 2.91 Petition for expungement or reexamination.***

(a) Petition basis. Any person may file a petition requesting institution of an ex parte proceeding to cancel a registration of a mark, in whole or in part, on one of the following bases:

(1) Expungement, if the mark is registered under sections 1, 44, or 66 of the Act and has never been used in commerce on or in connection with some or all of the goods and/or services recited in the registration; or

(2) Reexamination, if the mark is registered under section 1 of the Act and was not in use in commerce on or in connection with some or all of the goods and/or services recited in the registration on or before the relevant date, which for any particular goods and/or services is determined as follows:

(i) In an application for registration of a mark with an initial filing basis of section 1(a) of the Act for the goods and/or services listed in the petition, and not amended at any point to be filed pursuant to section 1(b) of the Act, the relevant date is the filing date of the application; or

(ii) In an application for registration of a mark with an initial filing basis or amended basis of section 1(b) of the Act for the goods and/or services listed in the petition, the relevant date is the later of the filing date of an amendment to allege use identifying the goods and/or services listed in the petition, pursuant to section 1(c) of the Act, or the expiration of the deadline for

filing a statement of use for the goods and/or services listed in the petition, pursuant to section 1(d), including all approved extensions thereof.

Sections 16A and 16B of the Trademark Act, 15 U.S.C. §§1066a-1066b, allow the USPTO to cancel a registration, in whole or in part, for nonuse of a registered mark via ex parte expungement and reexamination proceedings.

In an expungement proceeding, the USPTO may cancel a registration if the evidence of record shows that the registered mark has never been used in commerce on or in connection with some or all of the goods and/or services recited in the registration. [15 U.S.C. §1066a](#); [37 C.F.R. §2.91\(a\)\(1\)](#).

In a reexamination proceeding, the USPTO may cancel a registration if the evidence of record shows that the registered mark was not in use in commerce on or in connection with some or all of the goods and/or services as of the filing date of the application or amendment to allege use, or before the deadline for filing a statement of use, as applicable. [15 U.S.C. §1066b](#); [37 C.F.R. §2.91\(a\)\(2\)](#).

A petition requesting institution of an expungement proceeding may be filed in connection with a mark registered under Trademark Act Section 1, 44, or 66(a), [15 U.S.C. §§1051, 1126, 1141f](#); [37 C.F.R. §2.91\(a\)\(1\)](#). However, a petition requesting institution of a reexamination proceeding may be filed only in connection with a mark registered under §1 of the Trademark Act.

These proceedings may be requested and instituted, within specific time periods, based on a third-party petition, or on the Director's own initiative, if a prima facie case of nonuse of a registered mark is established. See [TMEP §1716.01](#) regarding the timing for requesting and instituting expungement or reexamination proceedings and [§1716.03\(a\)](#) regarding establishing a prima facie case of nonuse.

If the USPTO institutes an expungement or reexamination proceeding, whether based on a petition or on the Director's own initiative, the registrant will have the opportunity to present evidence of use rebutting the prima facie case or voluntarily delete the relevant goods and/or services from the registration. See [TMEP §§1716.04\(b\)-\(d\)](#) regarding registrant's response options. If the registrant does not delete the relevant goods and/or services and cannot rebut the prima facie case of nonuse, or otherwise fails to respond to an Office action issued as part of the proceeding, the proceeding will ultimately terminate with a determination of nonuse. See [TMEP §1716.04\(e\)](#) regarding termination of proceedings. After termination, the registration will be cancelled in whole or in part, as appropriate, when (1) the deadline for filing an appeal lapses without an appeal being filed, or (2) a determination subject to an appeal is not overturned on review and the appeal process has ended.

### **1716.01 Timing for Requesting and Instituting Expungement or Reexamination Proceedings**

A petitioner may request an ex parte expungement proceeding in connection with a registration at any time between 3 and 10 years after the date of registration. [15 U.S.C. §1066a\(i\)](#); [37 C.F.R. §2.91\(b\)\(1\)](#). In addition, until December 27, 2023, a petitioner may request an expungement proceeding for a registration that is at least 3 years old, regardless of the 10-year limit. *Id.*

A petitioner may request a reexamination proceeding in connection with a mark registered under §1 of the Trademark Act during the first five years following the date of registration. [15 U.S.C. §1066b\(i\)](#); [37 C.F.R. §2.91\(b\)\(2\)](#).

The Director may institute an ex parte expungement or reexamination proceeding on the Director's own initiative within these same time periods, if otherwise appropriate. See [15 U.S.C. §§1066a\(i\)-1066b\(i\)](#); [37 C.F.R. §2.92\(b\)](#).

## 1716.02 Petitions to Request Expungement or Reexamination

Any person may file a petition requesting institution of an expungement or reexamination proceeding. [37 C.F.R. §2.91\(a\)](#). Only one registration may be specified per petition, and a petitioner who wishes to request both expungement and reexamination proceedings for the same registration must file separate petitions for each type of proceeding. See [37 C.F.R. §§2.91\(a\), \(c\)\(2\)](#).

Reexamination and expungement petitions are intended to allow third parties to bring nonuse of registered marks to the attention of the USPTO. Therefore, a registrant whose mark was not used in commerce, or is no longer used in commerce, should not file a petition against its own registration, but instead should voluntarily surrender the registration for cancellation in its entirety or amend the registration to delete the relevant goods and/or services, as appropriate. See [TMEP §1608](#) regarding surrendering a registration for cancellation and [§1609.03](#) regarding deletion of goods and/or services in a registration. There is a \$0 fee for voluntary deletions of goods and/or services from a registration prior to submission of a post-registration maintenance document. See [37 C.F.R. §2.6\(a\)\(11\)\(iii\)](#). There is no fee for voluntarily surrendering a registration for cancellation. [TMEP §1608](#).

### 1716.02(a) Basis for the Petition

A petition for expungement must allege that the mark “has never been used in commerce on or in connection with some or all of the goods and/or services recited in the registration.” [37 C.F.R. §2.91\(a\)\(1\)](#).

A petition for reexamination must allege that the trademark “was not in use in commerce on or in connection with some or all of the goods and/or services recited in the registration on or before the relevant date,” which, for any particular goods and/or services, is determined as follows:

In a use-based application for registration of a mark with an initial filing basis under §1(a) for the goods and/or services listed in the petition, and not amended at any point to be filed pursuant to §1(b), the relevant date is the filing date of the application; or  
In an intent-to-use application for registration of a mark with an initial filing basis or amended basis of §1(b) for the goods and/or services listed in the petition, the relevant date is the later of the filing date of an amendment to allege use identifying the goods and/or services listed in the petition, pursuant to §1(c), or the expiration of the deadline for filing a statement of use for the goods and/or services listed in the petition, pursuant to §1(d), including all approved extensions thereof.

[37 C.F.R. §2.91\(a\)\(2\)](#).

### 1716.02(b) Requirements for a Complete Petition

*37 CFR §2.91 Petition for expungement or reexamination.*

...

(c) Requirements for complete submission. Petitions under this section must be timely filed through TEAS. Only complete petitions under this section will be considered by the Director under § 2.92, and, once complete, may not be amended by the petitioner. A complete petition must be made in writing and must include the following:

- (1) (1) The fee required by § 2.6(a)(26);

- (2) The U.S. trademark registration number of the registration subject to the petition;
- (3) The basis for petition under paragraph (a) of this section;
- (4) The name, domicile address, and email address of the petitioner;
- (5) If the domicile of the petitioner is not located within the United States or its territories, a designation of an attorney, as defined in § 11.1 of this chapter, who is qualified to practice under § 11.14 of this chapter;
- (6) If the petitioner is, or must be, represented by an attorney, as defined in § 11.1 of this chapter, who is qualified to practice under § 11.14 of this chapter, the attorney's name, postal address, email address, and bar information under § 2.17(b)(3);
- (7) Identification of each good and/or service recited in the registration for which the petitioner requests that the proceeding be instituted on the basis identified in the petition;
- (8) A verified statement signed by someone with firsthand knowledge of the facts to be proved that sets forth in numbered paragraphs:
  - (i) The elements of the reasonable investigation of nonuse conducted, as defined under paragraph (d) of this section, where for each source of information relied upon, the statement includes a description of how and when the searches were conducted and what the searches disclosed; and
  - (ii) A concise factual statement of the relevant basis for the petition, including any additional facts that support the allegation of nonuse of the mark in commerce on or in connection with the goods and services as specified in paragraph (a) of this section; and
- (9) A clear and legible copy of all documentary evidence supporting a prima facie case of nonuse of the mark in commerce and an itemized index of such evidence. Evidence that supports a prima facie case of nonuse may include, but is not limited to:
  - (i) Verified statements;
  - (ii) Excerpts from USPTO electronic records in applications or registrations;
  - (iii) Screenshots from relevant web pages, including the uniform resource locator (URL) and access or print date;
  - (iv) Excerpts from press releases, news articles, journals, magazines, or other publications, identifying the publication name and date of publication; and
  - (v) Evidence suggesting that the verification accompanying a relevant allegation of use was improperly signed.

Under [37 C.F.R. §2.91\(c\)](#), only a complete petition for expungement or reexamination will be considered.

A complete petition must be made in writing, filed through the trademark electronic filing system and include:

- (1) The fee required by [37 C.F.R. §2.6\(a\)\(26\)](#);
- (2) The U.S. trademark registration number of the registration subject to the petition;
- (3) The basis for the petition under [37 C.F.R. §2.91\(a\)](#) (see [TMEP §1716.02\(a\)](#));
- (4) The name, domicile address, and email address of the petitioner;
- (5) If the domicile of the petitioner is not located within the United States or its territories, a designation of an attorney, as defined in [37 C.F.R. §11.1](#), who is qualified to practice under [37 C.F.R. §11.14](#) (see [TMEP §601](#) regarding the requirement for representation based on the owner's domicile and [§602](#) regarding persons authorized to practice before the USPTO in trademark matters);
- (6) If the petitioner is, or must be, represented by an attorney, the attorney's name, postal address, email address, and bar information under [37 C.F.R. §2.17\(b\)\(3\)](#) (see [TMEP §602.01\(a\)](#) regarding required attorney identification information);
- (7) Identification of each good and/or service recited in the registration for which the petitioner requests that the proceeding be instituted on the basis identified in the petition;
- (8) A verified statement signed by someone with firsthand knowledge of the facts to be proved that sets forth in numbered paragraphs:

(i) The elements of the reasonable investigation of nonuse conducted, as defined under [37 C.F.R. §2.91\(d\)](#), where for each source of information relied upon, the statement includes a description of how and when the searches were conducted and what the searches disclosed (see [TMEP §§1716.02\(c\)-\(c\)\(ii\)](#) regarding the requirements for a reasonable investigation); and

(ii) A concise factual statement of the relevant basis for the petition, including any additional facts that support the allegation of nonuse of the mark in commerce on or in connection with the goods and services as specified in [37 C.F.R. §2.91\(a\)](#); and

(9) A clear and legible copy of all documentary evidence supporting a prima facie case of nonuse of the mark in commerce and an itemized index of such evidence (see [TMEP §1716.02\(c\)\(ii\)](#) regarding evidence for a reasonable investigation).

[37 C.F.R. §2.91\(c\)](#).

Once complete, the petitioner may not amend the petition. *Id.*

If a petition fails to include all of the elements required by [37 C.F.R. §2.91\(c\)](#), the USPTO will issue a letter giving the petitioner 30 days to perfect the petition by complying with the outstanding requirements, if otherwise appropriate. The 30-day letter will not include a determination regarding whether the petition establishes a prima facie case, and the petitioner may not include additional evidence in its response. The petitioner may only provide evidence specifically requested in the 30-day letter. If the petitioner includes any other additional evidence in its response, the evidence will not be considered.

If petitioner does not comply with the outstanding requirements within the time allowed or does not timely respond to the 30-day letter, the petition will not be considered on the merits and the relevant proceeding will not be instituted. The determination of whether or not to institute an expungement or reexamination proceeding is final and non-reviewable. [15 U.S.C. §§1066a\(c\)\(3\), 1066b\(d\)\(3\)](#); [37 C.F.R. §2.92\(c\)\(1\)](#).

### **1716.02(c) Reasonable Investigation Requirement**

Under [37 C.F.R. §2.91\(d\)](#), a petitioner must demonstrate that a bona fide attempt has been made to determine if the relevant registered mark was never used in commerce (for expungement petitions) or was not in use in commerce as of the relevant date (for reexamination petitions) on or in connection with the goods and/or services identified in the petition by conducting a reasonable investigation. The petition must include a verified statement that specifies the elements of this reasonable investigation for each source of information relied upon. [37 C.F.R. §2.91\(c\)\(8\)](#). In particular, the statement must describe the sources searched, how and when the searches were conducted, and what information and evidence, if any, the searches produced. *Id.*

#### **1716.02(c)(i) Definition of Reasonable Investigation**

A reasonable investigation is an appropriately comprehensive search that is calculated to return information about the underlying inquiry from reasonably accessible sources where evidence concerning use of the mark during the relevant time period on or in connection with the relevant goods and/or services would normally be found. [37 C.F.R. §2.91\(d\)\(1\)](#). Thus, what constitutes a reasonable investigation is a case-by-case determination and may vary depending on the circumstances. However, any investigation should focus on the mark in the registration and its use in the relevant marketplace on the identified goods and/or services, keeping in mind their scope and applicable trade channels.

The petition should establish that the petitioner's investigation included a search covering the relevant channels of trade and advertising for the identified goods and/or services but did not reveal any relevant use

of the mark consistent with the definition of “use in commerce” set forth in Section 45 of the Trademark Act, [15 U.S.C. §1127](#), and in relevant case law. See [TMEP §§901-901.03](#) regarding use in commerce.

### **1716.02(c)(ii) Sources of Information and Evidence**

The sources of information and evidence provided in the petition should include reasonably accessible sources that can be publicly disclosed, because petitions requesting institution of expungement and reexamination proceedings will be entered in the registration record and be publicly viewable through the USPTO’s Trademark Status & Document Retrieval (TSDR) database. The number and nature of the sources a petitioner must check in order for its investigation to be considered reasonable, and the corresponding evidence that would support a prima facie case, will vary depending on the goods and/or services involved, their normal trade channels, and whether the petition is for expungement or reexamination.

For purposes of expungement and reexamination proceedings, nonuse is necessarily determined in reference to a time period that includes past activities, not just current activities. Accordingly, a petitioner’s investigation normally would include research into past usage of the mark for the goods and/or services at issue in the petition and thus may include a search for archival evidence, including cached web pages from sources such as Wayback Machine®.

A single search using an internet search engine likely would not be considered a reasonable investigation. See H.R. Rep. No. 116-645, at 15 (2020). However, a reasonable investigation does not require a showing that all of the potentially available sources of evidence were searched. Generally, an investigation that produces reliable and credible evidence of nonuse during the relevant time period may be considered sufficient.

Appropriate sources of evidence and information for a reasonable investigation may include, but are not limited to:

- State and Federal trademark records;
- Internet websites and other media likely to or believed to be owned or controlled by the registrant;
- Internet websites, other online media, and publications where the relevant goods and/or services likely would be advertised or offered for sale;
- Print sources and webpages likely to contain reviews or discussions of the relevant goods and/or services;
- Records of filings made with or of actions taken by any State or Federal business registration or regulatory agency;
- The registrant’s marketplace activities, including, for example, any attempts to contact the registrant or purchase the relevant goods and/or services;
- Records of litigation or administrative proceedings reasonably likely to contain evidence bearing on the registrant’s use or nonuse of the registered mark; and
- Any other reasonably accessible source with information establishing that the mark was never in use in commerce (expungement), or was not in use in commerce as of the relevant date (reexamination), on or in connection with the relevant goods and/or services.

### [37 C.F.R. §2.91\(d\)\(2\)](#).

Evidence supporting a prima facie case of nonuse may be in the form of verified statements, screenshots from web pages, and excerpts from press releases, news articles, journals, magazines, or other publications,



among other types of evidence. *See* [37 C.F.R. §2.91\(c\)\(9\)](#). Examples of documentary evidence to support negative search results include screenshots or website printouts capturing the null result.

Any evidence consisting of screenshots from web pages must include the URL and access or print date. [37 C.F.R. §2.91\(c\)\(9\)\(iii\)](#). Any evidence consisting of excerpts from press releases, news articles, journals, magazines, or other publications must identify the publication name and the date of publication. [37 C.F.R. §2.91\(c\)\(9\)\(iv\)](#).

Petitioner may also include evidence suggesting that the verification accompanying a relevant allegation of use was improperly signed. [37 C.F.R. §2.91\(c\)\(9\)\(v\)](#).

## **1716.02(d) Notice of Petition for Expungement or Reexamination**

When a petition requesting institution of expungement or reexamination proceedings is filed, the petition will be uploaded into the registration record and be publicly viewable through TSDR. The USPTO will send a courtesy email notice of the petition to the registrant and/or the registrant's attorney, as appropriate, if an email address is of record. The registrant may not respond to this courtesy notice, and no response from the registrant will be accepted except in response to an Office action issued after institution of a proceeding under [37 C.F.R. §2.92](#).

For purposes of correspondence related to these proceedings, the "registrant" is the owner/holder currently listed in USPTO records. If there has been a change of ownership, it is the registrant's or the new owner's responsibility to provide such information to the USPTO. *See* [TMEP §502.01](#). Therefore, it is in the best interests of both the prior and new owners to provide evidence of changes of title, either by recordation of an assignment or otherwise, in a timely manner.

## **1716.03 Instituting Expungement and Reexamination Proceedings**

### **15 U.S.C. §1066a**

#### **(c) Initial determination; institution**

(1) Prima facie case determination, institution, and notification The Director shall, for each good or service identified under subsection (b)(2), determine whether the petition sets forth a prima facie case of the mark having never been used in commerce on or in connection with each such good or service, institute an ex parte expungement proceeding for each good or service for which the Director determines that a prima facie case has been set forth, and provide a notice to the registrant and petitioner of the determination of whether or not the proceeding was instituted. Such notice shall include a copy of the petition and any supporting documents and evidence that were included with the petition.

### **15 U.S.C. §1066b**

#### **(d) Initial determination; institution**

(1) Prima facie case determination, institution, and notification The Director shall, for each good or service identified under subsection (c)(2), determine whether the petition sets forth a prima facie case of the mark having not been in use in commerce on or in connection with each such good or service, institute an ex parte reexamination proceeding for each good or service for which the Director determines that the prima facie case has been set forth, and provide a notice to the registrant and petitioner of the determination of whether or not the proceeding was instituted. Such notice shall include a copy of the petition and any supporting documents and evidence that were included with the petition.

#### ***37 CFR §2.92 Institution of ex parte expungement and reexamination proceedings.***

Notwithstanding section 7(b) of the Act, the Director may institute a proceeding for expungement or reexamination of a registration of a mark, either upon petition or upon the Director's initiative, upon determining that information and evidence supports a prima facie case of nonuse of the mark for some or all of the goods or services identified in the registration. The electronic record of the registration for which a proceeding has been instituted forms part of the record of the proceeding without any action by the Office, a petitioner, or a registrant.

(a) *Institution upon petition.* For each good and/or service identified in a complete petition under § 2.91, the Director will determine if the petition sets forth a prima facie case of nonuse to support the petition basis and, if so, will institute an ex parte expungement or reexamination proceeding.

(b) *Institution upon the Director's initiative.* The Director may institute an ex parte expungement or reexamination proceeding on the Director's own initiative, within the time periods set forth in § 2.91(b), and for the reasons set forth in § 2.91(a), based on information that supports a prima facie case for expungement or reexamination of a registration for some or all of the goods or services identified in the registration.

(c) *Director's authority.*

(1) Any determination by the Director whether to institute an expungement or reexamination proceeding shall be final and non-reviewable.

(2) The Director may institute an expungement and/or reexamination proceeding for fewer than all of the goods and/or services identified in a petition under § 2.91. The identification of particular goods and/or services in a petition does not limit the Director from instituting a proceeding that includes additional goods and/or services identified in the subject registration on the Director's own initiative, under paragraph (b) of this section.

...

(f) *Notice of Director's determination whether to institute proceedings.*

(1) In a determination based on a petition under § 2.91, if the Director determines that no prima facie case of nonuse has been made and thus no proceeding will be instituted, notice of this determination will be provided to the registrant and petitioner, including information to access the petition and supporting documents and evidence.

(2) If the Director determines that a proceeding should be instituted based on a prima facie case of nonuse of a registered mark as to any goods and/or services recited in the registration, or consolidates proceedings under paragraph (e) of this section, the Director's determination and notice of the institution of the proceeding will be set forth in an Office action under § 2.93(a). If a proceeding is instituted based in whole or in part on a petition under § 2.91, the Office action will include information to access any petition and the supporting documents and evidence that formed the basis for the Director's determination to institute. Notice of the Director's determination will also be provided to the petitioner.

The USPTO will only institute an expungement or reexamination proceeding, based either on a petition or on the Director's own initiative, in connection with the goods and/or services for which a prima facie case of nonuse for the relevant time frame has been established. See [15 U.S.C. §§1066a\(c\)\(1\), 1066b\(d\)\(1\)](#); [37 C.F.R. §2.92](#). See [TMEP §1716.03\(a\)](#) regarding establishing a prima facie case of nonuse.

If the USPTO determines that a petition does not establish a prima facie case of nonuse as to any or all of the goods and/or services identified in the petition, the relevant proceeding will not be instituted as to those particular goods and/or services. See [37 C.F.R. §2.92\(c\)\(2\)](#). Notice of this determination will be provided to the registrant and petitioner and will include information to access the petition and supporting documents and evidence. See [15 U.S.C. §§1066a\(c\)\(1\), 1066b\(d\)\(1\)](#); [37 C.F.R. §2.92\(f\)](#). The petition will remain in the record of the registration.

Any determination whether or not to institute an expungement or reexamination proceeding, based either on a petition or on the Director's own initiative, is final and non-reviewable. See [15 U.S.C. §§1066a\(c\)\(3\), 1066b\(d\)\(3\)](#); [37 C.F.R. §2.92\(c\)\(1\)](#).

### **1716.03(a) Prima Facie Case of Nonuse**

With respect to these proceedings, a prima facie case requires only that a reasonable predicate concerning such nonuse be established. See H.R. Rep. No. 116-645, at 8 (citing *In re Pacer Tech.*, 338 F.3d 1348, 1351 (Fed. Cir. 2003) and *In re Loew's Theatres, Inc.*, 769 F.2d 764, 768 (Fed. Cir. 1985)). Thus, a prima facie case includes sufficient notice of the claimed nonuse to allow the registrant to respond to and potentially rebut the claim with competent evidence, which the USPTO must then consider before making a determination as to whether the registration should be cancelled in whole or in part, as appropriate.

For expungement and reexamination proceedings based on a petition under [37 C.F.R. §2.91](#), the determination of whether a prima facie case has been made is based on the evidence and information that is collected as a result of the petitioner's reasonable investigation and set forth in the petition, along with the USPTO's electronic record of the involved registration. See [TMEP §1716.02\(c\)\(ii\)](#) regarding evidence of nonuse.

For Director-initiated expungement and reexamination proceedings, the information and evidence available to the USPTO must establish a prima facie case of nonuse. See [37 C.F.R. §2.92\(b\)](#). For these Director-initiated proceedings, the evidence and information that may be relied upon to establish a prima facie case may be from essentially the same sources as those in a petition-initiated proceeding.

If a petition-based proceeding is instituted, the petitioner will not have any further involvement. In a Director-initiated proceeding, there is no petitioner, and thus all relevant notices will be provided only to the registrant and the registrant's attorney, if any. See [TMEP §1716.04\(a\)](#) regarding providing notice of institution of a proceeding. In both types of proceedings, documents associated with the proceeding will be uploaded into the registration record and will be publicly viewable through TSDR. This includes any prima facie evidence that the USPTO relied upon to institute a Director-initiated proceeding.

### **1716.03(b) Consolidating Proceedings**

To ensure consistency and promote efficiency, the Director may consolidate proceedings involving the same registration, including a Director-initiated proceeding with a petition-initiated proceeding. See [37 C.F.R. §2.92\(e\)\(1\)](#). Consolidated proceedings are related parallel proceedings that may include both expungement and reexamination grounds. *Id.*

If two or more petitions under [37 C.F.R. §2.91](#) directed to the same registration have been submitted and no ex parte expungement or reexamination proceeding has been instituted as to either, or the Director wishes to institute an ex parte expungement or reexamination proceeding on the Director's own initiative under [37 C.F.R. §2.92\(b\)](#) concerning a registration for which one or more petitions under [37 C.F.R. §2.91](#) was submitted, the Director may elect to institute a single proceeding. [37 C.F.R. §2.92\(e\)\(2\)](#). For example, if two or more petitions directed to the same registration identify goods and/or services in different classes, but each petitioner provides the required evidence and complies with the requirements of [37 C.F.R. §2.91](#), the Director may institute a single proceeding for the convenience of both the USPTO and the registrant. Similarly, if two or more petitions directed to the same registration identify various goods and/or services with some overlap, the Director may institute a single proceeding that covers all of the goods and/or services for which a prima facie case concerning nonuse is established.

## **1716.04 Procedures for Expungement and Reexamination Proceedings**

### **1716.04(a) Notice of Institution and Office Action**

When a determination regarding institution of an expungement or reexamination proceeding has been made, the USPTO will provide notice of the determination, in accordance with the correspondence rules in [37 C.F.R. §2.18](#), [37 C.F.R. §2.92\(f\)\(2\)](#). See [TMEP §1716.02\(d\)](#) regarding the identity of the registrant for purposes of correspondence related to these proceedings. If the proceeding is petition-based, the petitioner will also be notified of the determination whether or not to institute the proceeding. [15 U.S.C. §§1066a\(c\)\(1\), 1066b\(d\)\(1\)](#); [37 C.F.R. §2.92\(f\)\(2\)](#).

If a proceeding is instituted, the notice of institution will include an Office action requiring the registrant to provide evidence of use. See [15 U.S.C. §§1066a\(e\), 1066b\(f\)](#); [37 C.F.R. §§2.92\(f\)\(2\), 2.93\(a\)](#). Office actions

in these proceedings are substantively limited in scope to the question of use in commerce, but the registrant remains subject to the requirements of [37 C.F.R. §2.11](#) (requirement for representation), [37 C.F.R. §2.23](#) (requirement to correspond electronically), and [37 C.F.R. §2.189](#) (requirement to provide a domicile address). Thus, the registrant may be required to furnish domicile information as necessary to determine if the registrant must be represented by a U.S.-licensed attorney. In addition, registrants will be required to provide a valid email address for correspondence, if one is not already in the record, and to update the email address as necessary to facilitate communication with the USPTO.

See [TMEP §301.01](#) regarding the mandatory electronic filing of trademark documents, [§§601-601.01\(c\)](#) regarding determining an owner's domicile, and [§1612](#) regarding the requirement for the correspondence email and domicile address of registrant.

### **1716.04(b) Responding to the Initial Office Action**

The registrant must respond to the initial Office action via the trademark electronic filing system within three months of the issue date, but, within that time period, may request a one-month extension of time to respond, which requires the payment of the fee set forth in [37 C.F.R. §2.6\(a\)\(27\)](#). [37 C.F.R. §2.93\(b\)\(1\)](#).

The response must contain documentary evidence of use supported by information, exhibits, affidavits, or declarations as may be reasonably necessary to rebut the prima facie case of nonuse by establishing that the required use in commerce has been made on or in connection with the goods and/or services at issue and be properly signed. See [37 C.F.R. §§2.92\(f\)\(2\)](#), [2.93\(a\)](#), [\(b\)\(3\)](#). See [TMEP §611.03\(b\)](#) regarding signature of responses to Office actions and [§1716.04\(d\)](#) regarding submitting a response that deletes some or all of the goods and/or services at issue in the proceeding or surrenders the entire registration for cancellation.

When a timely response by the registrant is a bona fide attempt to advance the proceeding and is a substantially complete response to the Office action, but consideration of some matter or compliance with a requirement has been omitted, the registrant may be granted 30 days, or to the end of the time period for response set forth in the Office action to which the substantially complete response was submitted, whichever is longer, to resolve the issue. See [37 C.F.R. §2.93\(b\)\(2\)](#). Granting the registrant additional time in such circumstances does not extend the time for filing an appeal to the Trademark Trial and Appeal Board (TTAB) or a petition to the Director.

If the registrant timely responds to the initial Office action in the expungement or reexamination proceeding, the USPTO will review the response to determine if use of the mark in commerce at the relevant time has been established for each of the goods and/or services at issue. If the USPTO finds, during the course of the proceeding, that the registrant has: (1) demonstrated relevant use of the mark in commerce sufficient to rebut the prima facie case, (2) demonstrated excusable nonuse in appropriate expungement cases, or (3) deleted goods and/or services, such that no goods and/or services remain at issue, the proceeding will be terminated, and the USPTO will issue a notice of termination under [37 C.F.R. §2.94](#). See [TMEP §1716.04\(e\)](#) regarding termination of expungement and reexamination proceedings.

If the registrant fails to timely respond to the initial Office action or timely submit a request for extension, the proceeding will terminate and the registration will be cancelled, in whole or in part, as appropriate. See [TMEP §1716.04\(f\)](#) regarding requesting reinstatement after cancellation for failure to respond to an Office action.

To ensure that registrants are aware of any correspondence or activity associated with any ex parte cancellation proceedings concerning their registered marks, registrants must monitor the status of their registrations in

the USPTO's electronic systems at least every three months after notice of the institution of an expungement or reexamination proceeding until the registrant receives a notice of termination under [37 C.F.R. §2.94](#). See [37 C.F.R. §2.23\(d\)\(3\)](#). See [TMEP §1705.05](#) regarding the duty to exercise due diligence in monitoring the status of pending trademark matters.

### **1716.04(c) Evidence of Use or Excusable Nonuse**

Documentary evidence of use provided by the registrant need not be the same as that required under the USPTO's rules of practice for specimens of use under §1(a), but must be consistent with the definition of "use in commerce" in Section 45 of the Trademark Act, [15 U.S.C. §1127](#), and in relevant case law. [15 U.S.C. §§1066a\(e\), 1066b\(f\)](#); [37 C.F.R. §2.93\(b\)\(7\)](#); See [TMEP §§901-901.03](#) regarding use in commerce.

*Evidence must be accompanied by a verified statement* . Any evidence of use must be accompanied by a verified statement signed by someone with firsthand knowledge of the facts to be proved, setting forth in numbered paragraphs factual information about the use of the mark in commerce, including a description of the supporting evidence and how the evidence demonstrates use of the mark in commerce as of any relevant date for the goods and/or services at issue. [37 C.F.R. §2.93\(b\)\(7\)](#). Evidence must be labeled, and an itemized index of the evidence must be provided such that the particular goods and/or services supported by each item submitted as evidence of use are clear. *Id.*

*Types of evidence*. Although testimonial evidence may be submitted, it should be supported by corroborating documentary evidence. In most cases, the documentary evidence of use will include specimens of use, but there may be situations where, for example, specimens for particular goods and/or services are no longer available, even if they may have been available at the time the registrant filed an allegation of use. In these cases, the registrant may provide additional evidence and explanations, supported by declaration, to demonstrate how the mark was used in commerce at the relevant time. Generally, because the registration file has already been considered in instituting the proceeding based on a prima facie case of nonuse, merely resubmitting the same specimen of use previously submitted in support of registration or maintenance thereof, or a verified statement alone, without additional supporting evidence, will likely be insufficient to rebut a prima facie case of nonuse.

*Evidence must demonstrate use during the relevant time period* . For reexamination proceedings, the registrant's evidence of use must demonstrate use of the registered mark in commerce on or in connection with the goods and/or services at issue on or before the relevant date established under [37 C.F.R. §2.91\(a\)\(2\)](#). See [37 C.F.R. §2.93\(b\)\(6\)\(i\)](#). Specifically, if registration of the mark was based on an application with an initial filing basis under §1(a) for the goods and/or services listed in the petition or subject to a Director-initiated proceeding, and not amended at any point to be filed pursuant to §1(b), the relevant date is the filing date of the application. [37 C.F.R. §2.91\(a\)\(2\)\(i\)](#). Or, if registration of the mark was based on an application with an initial filing basis or amended basis of §1(b) for the goods and/or services listed in the petition or subject to a Director-initiated proceeding, the relevant date is the later of the filing date of an amendment to allege use identifying the goods and/or services listed in the petition, pursuant to §1(c), or the expiration of the deadline for filing a statement of use for the goods and/or services listed in the petition, pursuant to §1(d), including all approved extensions thereof. [37 C.F.R. §2.91\(a\)\(2\)\(ii\)](#). The relevant dates set forth in [37 C.F.R. §2.91\(a\)\(2\)\(i\)-\(ii\)](#) are considered for each good and/or service identified in a petition for reexamination. Under [37 C.F.R. §2.92\(b\)](#), a Director-initiated proceeding may be instituted for the same reasons as those appropriate for a petition, and the relevant dates are therefore the same for a Director-initiated proceeding, even though there was no petition.



For expungement proceedings, the registrant's evidence of use must show that the use occurred before the filing date of the petition to expunge under [37 C.F.R. §2.91\(a\)](#), or before the date the proceeding was instituted by the Director under [37 C.F.R. §2.92\(b\)](#), as appropriate. [37 C.F.R. §2.93\(b\)\(5\)\(i\)](#).

*Evidence must demonstrate use in connection with the identified goods and/or services in the registration.* Evidence of use of the mark on or in connection with goods or services not at issue in the proceeding does not demonstrate relevant use of the mark in commerce. *See In re Locus Link USA*, No. 2022-100137E, 2024 TTAB LEXIS 225, at \*14-15 (2024) (finding nonuse where the registrant's evidence showed use of the mark in connection with components for evaporative coolers, but the identification as set forth in the registration covers evaporative coolers that are themselves component parts of air-cooling systems); *Look Cycle Int'l v. Kunshan Qiyue Outdoor Sports Goods Co.*, Can. No. 92079409, 2024 TTAB LEXIS 289, at \*28 (2024).

*Specimens of use accepted during prosecution of the application.* An examining attorney's acceptance of specimens of use during the prosecution of an application that matures into a registration does not preclude an evaluation of whether such mark was in use in commerce in an expungement or reexamination proceeding, nor does it control the ultimate question of use. *See In re Locus Link USA*, No. 2022-100137E, 2024 TTAB LEXIS 225, at \*17 (2024). The USPTO is not bound by prior decisions of an examining attorney in a subject application that matured into a registration. *See id.*

*Bona fide use in the ordinary course of trade.* Registrant's use of the mark on the goods and/or services must be bona fide use in the ordinary course of trade and not merely to reserve a right in a mark. [15 U.S.C. §1127](#). *See* [TMEP §901.02](#) regarding bona fide use in the ordinary course of trade. The examining attorney will consider whether the evidence of record shows bona fide use in the ordinary course of trade.

*False evidence of use.* Evidence of use that has been demonstrated to be false does not establish use in commerce. *Look Cycle Int'l v. Kunshan Qiyue Outdoor Sports Goods Co.*, Can. No. 92079409, 2024 TTAB LEXIS 289, at \*32-34 (2024). For example, when a petitioner or examiner provides evidence showing that an invoice submitted by the registrant includes a non-existent customer address and such evidence is un rebutted by the registrant, that invoice cannot be considered evidence of sales of the goods shown. *See id.*

*Evidence of excusable nonuse for registrations with a sole registration basis under §44(e) or §66(a).* A registrant in an expungement proceeding may respond by showing that any nonuse as to particular goods and/or services with a sole registration basis under §44(e) or §66(a) is due to special circumstances that excuse such nonuse, as set forth in [37 C.F.R. §2.161\(a\)\(6\)\(ii\)](#). *See* [15 U.S.C. §1066a\(f\)](#); [37 C.F.R. §2.93\(b\)\(5\)\(ii\)](#). The registrant must provide verified statements and evidence to support the claim of excusable nonuse. [37 C.F.R. §2.93\(b\)\(5\)\(ii\)](#).

Excusable nonuse may not be considered for any goods and/or services registered under §1 of the Trademark Act. *See* [37 C.F.R. §2.93\(b\)\(5\)\(ii\)](#).

*See* [TMEP §1604.11](#) for examples of special circumstances that may excuse nonuse.

## **1716.04(d) Deleting Goods and/or Services or Surrendering the Registration**

A registrant may respond to an Office action in an expungement or reexamination proceeding by submitting a response that deletes some or all of the goods and/or services at issue in the proceeding or surrenders the entire registration for cancellation. *See* [37 C.F.R. §2.93\(d\)](#). An acceptable deletion will be immediately effective, and the deleted goods and/or services may not be reinserted into the registration. [37 C.F.R.](#)



[§2.93\(d\)\(1\)](#). No other amendment to the identification of goods and/or services in a registration will be permitted as part of the proceeding. [37 C.F.R. §2.93\(d\)](#). If goods and/or services that are subject to an expungement or reexamination proceeding are deleted after the filing, and before the acceptance, of an affidavit or declaration under §8 or §71, the deletion will be subject to the fee under [37 C.F.R. §2.161\(c\)](#) or [37 C.F.R. §7.37\(c\)](#). [37 C.F.R. §2.93\(d\)\(1\)](#).

In addition, a registrant may submit a separate request to surrender the subject registration for cancellation under [37 C.F.R. §2.172](#) or a request to amend the registration under [37 C.F.R. §2.173](#). No amendment to the identification of goods or services will be permitted except to restrict the identification or to change it in ways that would not require republication of the mark. [37 C.F.R. §2.173\(e\)](#); *In re Locus Link USA*, No. 2022-100137E, 2024 TTAB LEXIS 225, at \*6 (2024). However, the mere filing of these requests will not constitute a sufficient response to an Office action requiring the registrant to provide evidence of use of the mark in the expungement or reexamination proceeding. The registrant must affirmatively notify the USPTO of the separate request in a timely response to the Office action. See [37 C.F.R. §2.93\(d\)\(2\)](#).

Any deletion of goods and/or services at issue in a pending proceeding requested in a response, a surrender for cancellation under [37 C.F.R. §2.172](#), or an amendment of the registration under [37 C.F.R. §2.173](#), shall render the proceeding moot as to those goods and/or services, and the USPTO will not make any further determination regarding the registrant's use of the mark in commerce as to those goods and/or services.

See [TMEP §1604.09\(b\)](#) regarding deletion of goods/services/classes from a registration after submission and prior to acceptance of a §8 affidavit or declaration, [§1608](#) regarding surrendering a registration for cancellation, [§1609.03](#) regarding deletion of goods and/or services in a registration where no fee is required, and [§1613.09\(b\)](#) regarding deletion of goods/services/classes from a registration after submission and prior to acceptance of a §71 affidavit or declaration.

### **1716.04(e) Final Action and Notice of Termination**

If the registrant's timely response to a nonfinal Office action in an expungement or reexamination proceeding fails to establish use of the mark in commerce at the relevant time (or to sufficiently establish excusable nonuse, if applicable) for all of the goods and/or services at issue, or otherwise fails to comply with all outstanding requirements, the USPTO will issue a final action. [37 C.F.R. §2.93\(c\)\(1\)](#).

In an expungement proceeding, the final action will include the examiner's decision that the registration should be cancelled for each good or service challenged in the petition and/or Director-initiated proceeding for which the mark was determined to have never been used in commerce or for which no excusable nonuse was established.

In a reexamination proceeding, the final action will include the examiner's decision that the registration should be cancelled for each good and/or service challenged in the petition and/or Director-initiated proceeding for which it was determined the mark was not in use in commerce on or before the relevant date.

As appropriate, in either an expungement or reexamination proceeding, the final action will include the examiner's decision that the registration should be cancelled for noncompliance with any requirement set forth in a previous Office action under [37 C.F.R. §§2.11](#), [2.23](#), or [2.189](#).

If a final action is issued, the registrant will have three months to file a request for reconsideration or an appeal to the TTAB, if appropriate. [37 C.F.R. §2.93\(c\)\(1\)](#). This deadline may not be extended. See [TBMP](#)

[Chapter 1300](#) for further information about ex parte appeals from expungement and reexamination proceedings.

If the registrant fails to timely appeal or file a request for reconsideration that rebuts the prima facie case of nonuse and establishes use of the mark in commerce at the relevant time for all goods and/or services that remain at issue in a final action (or that deletes the remaining goods and/or services at issue), the USPTO will issue a notice of termination of the proceeding and then cancel the registration in whole or in part as appropriate. [37 C.F.R. §2.94](#). The notice will set forth the goods and/or services for which relevant use was, or was not, established, and any requirements with which the registrant failed to comply. See [37 C.F.R. §2.93\(c\)\(3\)\(ii\)](#). The notice of termination is a statement intended to memorialize the ultimate outcome of the proceedings and is not itself reviewable on petition or appeal.

If the USPTO determines that the required use in commerce (or excusable nonuse, in appropriate cases) was not established, the notice of termination will indicate the goods and/or services for which the registration will be cancelled. See [37 C.F.R. §2.94](#). If the goods and/or services for which use (or excusable nonuse) was not demonstrated are the only goods and/or services in the registration, or there remain any additional outstanding requirements, the entire registration will be cancelled. However, if the determination of nonuse relates only to a portion of the goods and/or services in the registration, and there are no other outstanding requirements, the notice of termination will indicate that registration will be cancelled in part, as appropriate. A notice of termination will not issue until all outstanding issues are satisfactorily resolved (and thus no cancellation is necessary) or the time for appeal has expired or any appeal proceeding has terminated. Petitioners and other interested parties may monitor the progress of a proceeding by reviewing the status and associated documents through TSDR.

If a notice of termination issues in a proceeding where the USPTO determines that the registration should be cancelled for some or all of the goods and/or services, the USPTO will then cancel the registration, in whole or in part, as appropriate. See [15 U.S.C. §§1066a\(g\), 1066b\(g\)](#); [37 C.F.R. §2.94](#).

Registrations cancelled in whole or in part will be published in the electronic *Trademark Official Gazette*. In addition, the USPTO will issue an updated registration certificate for any registration cancelled in part.

### **1716.04(f) Requesting Reinstatement After Cancellation for Failure to Respond**

If a registration is cancelled, in whole or in part, because of a failure to respond to a nonfinal or final Office action in an expungement or reexamination proceeding, and that failure to respond is due to an extraordinary situation, the registrant may file a petition requesting reinstatement of the registration, in whole or in part, and resumption of the proceeding. See [37 C.F.R. §2.146\(a\)\(5\)](#). The petition must be filed no later than two months after the date of actual knowledge of the cancellation of the registration, in whole or in part, and may not be filed later than six months after the date of cancellation in TSDR. [37 C.F.R. §2.146\(d\)\(2\)\(iv\)](#). In addition, the petition must include a response to the Office action or an appeal to the TTAB (if the registrant failed to respond to a final action). [37 C.F.R. §2.146\(c\)\(2\)](#).

### **1716.04(g) Estoppel**

Upon termination of an expungement proceeding in which it was established that the registered mark was used in commerce on or in connection with any of the goods and/or services at issue in the proceeding prior to the date a petition to expunge was filed under [37 C.F.R. §2.91](#) or the Director-initiated proceedings were instituted under [37 C.F.R. §2.92](#), no further ex parte expungement proceedings may be instituted as to those particular goods and/or services. [15 U.S.C. §1066a\(j\)\(2\)](#); [37 C.F.R. §2.92\(d\)\(1\)](#). However, subsequent

reexamination proceedings for marks registered under Section 1 are not barred under these circumstances because reexamination proceedings involve a question of whether the mark was in use in commerce as of a particular relevant date, whereas earlier expungement proceedings would only have involved a determination of whether the mark was never used. Proof of use sufficient to rebut a prima facie case of nonuse in an expungement proceeding might not establish use in commerce as of a particular relevant date, as required in a reexamination proceeding.

Upon termination of a reexamination proceeding in which it was established that the registered mark was used in commerce on or in connection with any of the goods and/or services at issue, on or before the relevant date at issue in the proceedings, no further ex parte expungement or reexamination proceedings may be instituted as to those particular goods and/or services. See [15 U.S.C. §1066b\(j\)\(2\)](#); [37 C.F.R. §2.92\(d\)\(2\)](#).

### **1716.04(h) Co-pending Proceedings**

Once an expungement proceeding has been instituted for a particular registration and is pending, no later expungement proceeding may be instituted for that registration with respect to the same goods and/or services at issue in the pending proceeding. [15 U.S.C. §1066a\(j\)\(1\)](#); [37 C.F.R. §2.92\(d\)\(3\)](#). In addition, while a reexamination proceeding is pending against a particular registration, no later expungement or reexamination proceeding may be instituted for that registration with respect to the same goods and/or services at issue in the pending proceeding. See [15 U.S.C. §1066b\(j\)\(1\)](#); [37 C.F.R. §2.92\(d\)\(4\)](#).

For the purposes of these rules, the wording “same goods and/or services” refers to identical goods and/or services that are the subject of the pending proceeding or the prior determination. Thus, for example, if a subsequent petition for reexamination identifies goods that are already the subject of a pending reexamination proceeding and goods that are not, only the latter goods could potentially be the subject of a new proceeding. The fact that there is some overlap between the goods and/or services in the pending proceeding and those identified in a petition would not preclude the goods and/or services that are not the same from being the subject of a new proceeding, if otherwise appropriate. This situation is addressed in [37 C.F.R. §2.92\(c\)\(2\)](#), which permits the Director to institute a proceeding on petition for fewer than all of the goods and/or services identified in the petition.