

# Chapter 700 Procedure for Examining Applications

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## **701 Statutory Authority for Examination**

### **15 U.S.C. §1062 Publication.**

(a) Upon the filing of an application for registration and payment of the prescribed fee, the Director shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made....

(b)(1) If the applicant is found not entitled to registration, the examiner shall notify the applicant thereof and of the reasons therefor. The applicant may reply or amend the application, which shall then be reexamined. This procedure may be repeated until the examiner finally refuses registration of the mark or the application is abandoned as described in paragraph (2).

## **702 Order of Work**

### **702.01 Order of Examination**

In general, applications are assigned for examination in the order in which they are received in the U.S. Patent and Trademark Office (USPTO), unless the application is made “special.” See [TMEP §702.02](#) regarding “special” applications.

Generally, amended applications (i.e., applications that contain a response from the applicant), remands from the Trademark Trial and Appeal Board (Board), and statements of use are also reviewed in the order in which they are received in the USPTO.

If a voluntary amendment is submitted before the application is assigned for examination, it is placed in the record when filed and will be considered by the assigned examining attorney during initial examination of the application. Voluntary amendments, including those submitted immediately after the filing of an application and prior to examination, are subject to the same examination standards as amendments made in response to a refusal or requirement. Thus, if a voluntary amendment proposes changing the identification of goods or services, the permissible scope of the amendment is based on the original identification (assuming there is no previously acceptable amendment of the identification). See [TMEP §§1402.07\(d\), \(e\)](#). Likewise, a pre-examination voluntary amendment of the mark drawing or mark description will be compared to the original drawing or description to determine whether the amendment is a material alteration. See [TMEP §807.14](#). See [TMEP §807.17](#) regarding the processing of unacceptable amendments to drawings and [TMEP §1402.15](#) regarding the processing of unacceptable amendments to identifications.

Examining attorneys should act on applications that have been suspended as soon as they are removed from suspension. See [TMEP §§716–716.06](#) regarding suspension.

Examining attorneys should immediately act on inquiries regarding applications approved for publication or issue that are returned to the examining attorney to take action or provide information.

Where appropriate, the managing attorney may direct that a particular case be given special handling.

When an examining attorney resigns, the examining attorney should spend any remaining time in the Office getting their amended cases (including statements of use under [15 U.S.C. §1051\(d\)](#) and appeal briefs), especially those with involved records, ready for final disposition.

## **702.02 “Special” Applications**

While the USPTO normally processes applications in the order in which they are received, there are two procedures whereby an application can be made “special,” so that initial examination will be expedited.

*Request to Make Special - Registration Inadvertently Cancelled or Expired Under [15 U.S.C. §1058](#), [§1059](#), or [§1141k](#).* A new 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 the request of the applicant if the applicant is the prior registrant or the assignee of the prior registrant. No petition fee 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.*

A request to make an application special because a registration was inadvertently cancelled is reviewed in the Office of the Deputy Commissioner for Trademark Examination Policy. The applicant must first file the application via the trademark electronic filing system, except in limited circumstances. See [37 C.F.R. §2.21\(a\)](#); [TMEP §§301.01, 301.01\(a\)](#). The applicant should then submit a request to make special that includes the newly assigned serial number and the number of the cancelled registration. Generally, the request must be filed electronically, using the Request to Make Special form, available in the trademark electronic filing system. See [37 C.F.R. §2.23\(a\)](#); [TMEP §§301.01, 301.01\(a\)](#).

*Petition to Make Special.* 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 §§1710–1710.02](#) regarding the petition requirements and filing procedure.

The examining attorney must promptly examine any application that has been made “special.”

## **702.03 Related Applications**

### **702.03(a) Companion Applications**

The term “companion applications” refers to pending applications filed by the same applicant. An application is pending until it registers or abandons. Pending applications include applications that have been approved for publication or for registration on the Supplemental Register, applications in the Intent-to-Use (ITU)/Divisional Unit, and revived or reinstated applications.

#### **702.03(a)(i) Companion Applications Not Previously Assigned for the Same or Similar Marks**

If an applicant has multiple pending applications, the issues in the applications are likely to be similar. When assigned a new application, an examining attorney will be assigned the companion applications filed within three months of the filing date of the first assigned application. If an applicant files more than ten applications within a three-month period, only the first ten will be assigned to one examining attorney. Examining attorneys are encouraged to assign all unassigned companion applications for the same or similar marks to

themselves, even if the applications were filed outside the three-month period. However, any companion applications may only be self-assigned by the examining attorney at the time of initial examination of the new application.

The assignment of companion applications is done electronically, based upon the owner's name as set forth in the application. Therefore, the owner's name should be set forth consistently in all applications.

See [TMEP §702.03\(a\)\(iv\)](#) regarding classification and identification in companion applications that have been published for opposition.

### **702.03(a)(ii) Companion Applications Previously Assigned**

If the Trademark database indicates that a companion application has been assigned to a different examining attorney, the examining attorney should **not** transfer their application to the other examining attorney.

However, the examining attorney must review the electronic record of the earlier companion application before taking action in a later companion case, and should act consistently, unless it would be clear error (see [TMEP §706.01](#)) to do so. If the examining attorney believes that acting consistently with the prior action(s) would be erroneous, the examining attorney should bring the issue to the attention of the managing attorney or senior attorney.

See [TMEP §702.03\(a\)\(iv\)](#) regarding classification and identification in companion applications that have been published for opposition.

### **702.03(a)(iii) Companion Registrations**

If the applicant previously filed a companion application that has matured into a registration, the examining attorney should **not** transfer their application to the prior examining attorney. Generally, in the later application, the examining attorney should act consistently with the registration, unless it would be clear error ( see [TMEP §706.01](#)) to act consistently. However, the USPTO is not bound by the decisions of the examining attorneys who examined the applications for the applicant's previously registered marks, based on different records. Eligibility for registration must be determined on the basis of the facts that exist at the time registration is sought. See [TMEP §1216.01](#) and cases cited therein.

See [TMEP §702.03\(a\)\(iv\)](#) regarding classification and identification in companion registrations.

### **702.03(a)(iv) Classification and Identification in Companion Applications that Have Registered or Been Published for Opposition**

If a companion application has been published for opposition or has registered, the examining attorney may presume that the classification and identification of goods or services in the companion application or registration are acceptable, unless the identification or classification is clearly wrong. If the examining attorney accepts the classification and identification of goods or services because they were accepted in a companion application or registration, the examining attorney must note the companion application serial number or registration number in a Note to the File (also referred to as a Public Note or Notation to File).

Sometimes, the classification and identification of goods and/or services in the prior companion application or registration is clearly wrong. For example, identifications and class assignments that were acceptable in the past may no longer be in accord with the current Nice Agreement classification system ( see [TMEP §§1401.02–1401.02\(c\)](#) ) or with USPTO policy on acceptable identifications, which change periodically.

In these cases, the examining attorney cannot adopt the classification and identification listed in the companion application or registration. See [TMEP §§1402.14, 1904.02\(c\)\(v\)](#).

### 702.03(b) Conflicting Applications

The term “conflicting applications” refers to two or more pending applications that are filed by different applicants and may ultimately require a refusal of registration under §2(d) of the Trademark Act, [15 U.S.C. §1052\(d\)](#), due to a likelihood of confusion between the marks. When assigned a new application, the examining attorney must search the USPTO’s automated records to determine whether there are any conflicting applications. If there are conflicting applications, the examining attorney should **not** transfer the conflicting application to the examining attorney who acted on the first conflicting application. Instead, the examining attorney should examine the assigned application and issue an Office action that includes a notice to the applicant that there is a prior-filed application to register a mark that may be likely to cause confusion with the applicant’s mark. See [TMEP §§1208–1208.03\(c\)](#). The examining attorney handling the later-filed application should act consistently with the examining attorney who handled the earlier-filed application, unless it would be clear error ( see [TMEP §706.01](#) ) to act consistently. If necessary, the examining attorney should review the electronic record of the earlier-filed application before taking an action in the later-filed conflicting application.

### 703 USPTO Does Not Issue Duplicate Registrations

The USPTO will not issue two or more identical registrations on the same register. If two applications on the same register would result in registrations that are exact duplicates, the USPTO will permit only one application to mature into registration, and will refuse registration in the other application. [37 C.F.R. §2.48](#). For instance, if two identical applications are filed by an applicant, and the USPTO has not taken action in either application, then the USPTO will refuse registration in both applications. However, if the USPTO has already taken action in one of the applications but not the other, then the USPTO will refuse registration in the second application.

The applicant may overcome the refusal(s) by abandoning one of the applications. If practicable, the USPTO will permit the applicant to choose which application should mature into registration. If one of the applications has matured into registration, the applicant may choose to either surrender the registration and allow the application to proceed to registration, or retain the registration and abandon the application.

*Basis.* Applications filed under or amended to §1 of the Trademark Act would result in duplicate registrations if the only difference between them is that one is based on use in commerce under §1(a) and the other is based on intent-to-use under §1(b). However, an application filed under §1 and an application filed under §44 that are otherwise identical would not result in duplicate registrations, nor would an application under §66(a) of the Trademark Act that is otherwise identical to an application filed under §1 or §44.

*Classification Change.* Where the international classification of goods/services has changed, a new application for registration of the same mark for the same goods/services in a different class will not result in a duplicate registration. For example, if applicant owns a registration of a mark for legal services in Class 42, and files a new application after January 1, 2007, for registration of the same mark for legal services in Class 45, this is not a duplicate.

*Standard Character/Typed Drawing.* An application for registration of a mark depicted in standard characters would result in a duplicate registration of an application of the same mark in “typed” format ( see [TMEP §807.03\(g\)](#) ) for the same goods/services.



*Standard Character/Special Form.* A standard character drawing and a special form drawing of the same mark would not result in duplicate registrations.

*Overlapping Goods/Services.* Applications/registrations with identifications that include some of the same goods/services, but also different goods/services, would not result in duplicate registrations.

*Color.* A drawing in which the entire mark is lined for color ( *see* [TMEP §808.01\(b\)](#)), would result in a duplicate registration of a color drawing of the mark, if the colors are identical. See [TMEP §§807.07–807.07\(g\)](#) regarding color drawings.

If the applicant claims different shades of a color (e.g., purple in one and lavender in the other), any resulting registrations are not duplicates.

Where one application/registration is not completely lined for color (i.e., if the mark on the drawing includes color(s) in addition to unclaimed or unexplained black, white, and/or gray), this would not result in a duplicate registration of an application seeking registration that includes a claim of the same color(s) in addition to a claim of color for, or an explanation of the presence of, the black/white/gray in the drawing. See [TMEP §§807.07\(d\)–807.07\(d\)\(iii\)](#) regarding drawings that include black/white/gray.

*Principal/Supplemental Register.* An application for registration of a mark on the Principal Register would not result in a duplicate of an application for registration of the same mark on the Supplemental Register.

*Registrations Issued Under Prior Acts.* If eligible, marks registered under the Acts of 1881, 1905, and 1920 may also be registered under the Act of 1946 ( *see* §46(b) of the Trademark Act of 1946). Even if the mark and the goods/services in a registration issued under the 1946 Act are identical to the mark and goods/services in a registration issued under a prior Act, the registrations are not considered duplicates. See [TMEP §§ 1601.04, 1601.05, 1602.02, and 1602.03](#) regarding registrations issued under prior Acts.

*Section 66(a) Application Based on Different Int’l Registration.* A §66(a) application would not result in a duplicate registration of another §66(a) application or registered extension of protection based on a different international registration.

When an application is a duplicate of a registration owned by the applicant, and USPTO records show that the registration is still active, the examining attorney must refuse registration. If the registration is subject to cancellation for failure to file an affidavit of continued use or excusable nonuse under [15 U.S.C. §1058](#) or [§1141k](#), or due to expire for failure to file a renewal application under [15 U.S.C. §1059](#) (i.e., because the grace period has passed and no affidavit or renewal application has been filed), and the application is otherwise in condition for approval or final refusal, the examining attorney must suspend the application until the Trademark database is updated to show that the registration is cancelled or expired. See [TMEP §1611](#) for information about how the owner of a registration who has not timely filed a §8 or §71 affidavit or declaration or §9 renewal application may expedite the cancellation or expiration of its own registration.

## 704 Initial Examination

### 704.01 Initial Examination Must Be Complete

#### *37 CFR §2.61(a)*

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



The initial examination of an application by the examining attorney must be a *complete* examination. A complete examination includes a search for conflicting marks and an examination of the written application, any voluntary amendment(s) or other documents filed by applicant before an initial Office action is issued (see [TMEP §702.01](#)), the drawing, and any specimen(s) or foreign registration(s), to determine whether the mark is eligible for the type of registration requested, whether amendment is necessary, and whether all required fees have been paid.

If, on initial examination, the examining attorney finds the mark in an application for registration on the Principal Register to be in condition for publication for opposition, the examining attorney will approve the application for publication. Similarly, if the examining attorney finds the mark in an application for registration on the Supplemental Register to be in condition for registration, the examining attorney will approve the application for registration. The USPTO will send a notice of publication or certificate of registration to the applicant in due course.

If the application is not in condition to be approved for publication or issue, the examining attorney will write, telephone, or email the applicant, as appropriate, informing the applicant of the reason(s) why the mark may not be registered and of the defect(s) that can be corrected or amended to make the application acceptable.

The examining attorney's first Office action must be complete, so the applicant will be advised of all requirements for amendment and all grounds for refusal, with the exception of use-related issues that are considered for the first time in the examination of an amendment to allege use under [15 U.S.C. §1051\(c\)](#) or a statement of use under [15 U.S.C. §1051\(d\)](#) in an intent-to-use application. See [TMEP §§1102.01](#) and [1202–1202.19\(k\)](#) regarding use-related issues that may be considered for the first time in the examination of an amendment to allege use or a statement of use. Every effort should be made to avoid piecemeal prosecution, because it prolongs the time needed to dispose of an application. See [TMEP §705.01](#) about including wording in an Office action to indicate the status of the application and acknowledge documents received and [TMEP §706](#) regarding new issues raised by the examining attorney after the first Office action.

Examining attorneys must also clearly explain all refusals and requirements. For example, if the identification of goods/services is indefinite, the examining attorney must explain why the identification is not acceptable and, if possible, suggest an acceptable identification. See [TMEP §§705–705.08](#) for further information about examining attorneys' Office actions.

## **704.02 Examining Attorney's Search**

If the examining attorney finds no conflicting marks, but must write to the applicant about other matters, the examining attorney must inform the applicant that no conflicting marks have been found. This is commonly called the "search clause."

In an application filed under §1 or §44 of the Trademark Act, if the examining attorney cannot make a proper search or cannot examine the application properly due to a lack of adequate information, the examining attorney must specifically indicate what information is needed, request that it be furnished, and state that further action on the matter will be taken as soon as the information is received. See [37 C.F.R. §2.61\(b\)](#) and [TMEP §814](#) regarding requirements for additional information.

If some but not all of the goods/services in a §66(a) application are so indefinite that the examining attorney cannot make a proper search, the examining attorney may defer the search in part. The examining attorney must specifically indicate the good/services for which a search has been conducted by listing the

goods/services for which no conflicting marks have been found, and, if relevant, issuing a §2(d) refusal that is specifically limited to certain goods/services. See [TMEP §718.02\(a\)](#) regarding partial refusals.

If all the goods/services in a §66(a) application are so indefinite that the examining attorney cannot make a proper search, the examining attorney may defer the search. The examining attorney must issue a full refusal, require the necessary amendments to the goods/services, and state that further action on the merits with respect to likelihood of confusion will be considered as soon as a sufficiently definite identification of goods/services is received.

Before issuing a letter deferring action, the examining attorney should consult with the managing attorney or senior attorney.

### **704.03 Supervisory Examining Attorney May Indicate Action for Non-Signatory Examining Attorney**

When a non-signatory examining attorney examines an application, a supervisory examining attorney must thoroughly review the action. The usual procedure is for the non-signatory examining attorney to explain relevant information to the supervisory examining attorney, discussing any potential refusals or requirements. The supervisory examining attorney may indicate the action to be taken.

## **705 The Examining Attorney's Letter or Action**

If an examining attorney determines that a mark is not entitled to registration, or that amendment is required, the examining attorney will notify the applicant in a written Office action, or by email or telephone communication, which is typically followed by a written action. This constitutes the examining attorney's official action.

Written Office actions may be of a variety of styles, including: (1) an "examiner's amendment" (*see* [TMEP §§707–707.03](#)), in which the examining attorney formally makes amendments to the application; (2) a "priority action" (*see* [TMEP §§708–708.05](#)), setting forth and explaining the requirements discussed by telephone with the individual applicant, someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner of a partnership), or with a practitioner authorized to practice before the USPTO pursuant to [37 C.F.R. §11.14](#) ("qualified practitioner") designated by the applicant; (3) a letter explaining the bases for refusal(s) or requirement(s); (4) an examiner's amendment combined with a priority action (*see* [TMEP §708.05](#)); or (5) a suspension notice (*see* [TMEP §§716–716.06](#)). Office actions may be prepared through the use of standardized form paragraphs, in combination with language written to address the particular facts relevant to the refusal(s) or requirement(s).

The USPTO encourages the use of examiner's amendments and priority actions whenever appropriate.

### **705.01 Language in Examining Attorney's Letter**

The examining attorney must indicate the status of the application at the beginning of each letter.

In first actions, this may be done by stating that the examining attorney has reviewed the application and made the determinations that follow, or by using language such as "Upon examination of this application...."

The examining attorney must acknowledge any voluntary amendment or other document received before the first action by identifying the document and the date of its receipt.

In subsequent actions, examining attorneys should begin letters with a sentence such as, “This Office action is in response to applicant’s communication filed on [date].” Other documents received, such as supplemental amendments, affidavits, and new drawings, should also be acknowledged. See [TMEP §§713–713.03](#) regarding examination of amendments and responses to Office actions, [TMEP §807.17](#) regarding the processing of unacceptable amendments to drawings, and [TMEP §1402.15](#) regarding the processing of unacceptable amendments to identifications.

Refusals to register should be couched in the statutory language of the section of the Trademark Act that is the basis of the refusal, and the examining attorney must cite the appropriate section of the Act. For example, registration of a trademark should not be refused “because it is a surname,” but “because it *consists of matter that is primarily merely a surname under §2(e)(4) of the Trademark Act.*”

Registration must be refused only as to the specific register (i.e., Principal or Supplemental) for which registration is requested. However, when refusing registration on the Principal Register, the examining attorney should also state, to the extent possible, whether the record indicates that an amendment to the Supplemental Register or to seek registration on the Principal Register under §2(f) may be appropriate.

Examining attorneys are encouraged to use form paragraphs to accelerate the preparation of Office actions and increase the uniformity of the substance and appearance of these actions. However, examining attorneys should use the form paragraphs only if they apply to a particular situation, and should expand on the form paragraphs when necessary to explain and support the relevant requirements or refusals.

## **705.02 Examining Attorneys Should Not Volunteer Statements**

In Office actions, and email and telephone communications, examining attorneys should not volunteer statements about applicants’ rights that are gratuitous and unnecessary to the examination of the matters presented in applications. The examining attorney’s responsibility is limited to evaluating the registrability of the mark presented in the application. *See In re Am. Physical Fitness Research Inst. Inc.*, 181 USPQ 127, 127–28 (TTAB 1974) . *See also* [TMEP §1801](#).

## **705.03 Citation of Conflicting Marks**

When refusing registration under §2(d) of the Trademark Act, [15 U.S.C. §1052\(d\)](#), based on a likelihood of confusion with a previously registered mark, the examining attorney must give the registration number(s) and attach to the Office action a copy of each cited registration, which will become part of the record. The examining attorney should explain the reasons that the mark in each cited registration is a basis for refusal under §2(d).

If an applicant notifies the USPTO that the USPTO failed to attach a cited registration, or that the USPTO attached a registration but did not cite the registration as a bar to registration in the Office action, the USPTO will reissue the Office action citing and attaching the relevant registration(s) and provide the applicant with a new response period.

## **705.04 Reference to Matter in Printed or Online Publications**

When the examining attorney refers to matter in a printed publication, the examining attorney must provide the citation for the publication, and include the relevant material with the Office action. It is not necessary to attach a published legal decision to an Office action. A citation is sufficient. See [TMEP §705.05](#) regarding citation of decisions.

When the examining attorney refers to an online publication, such as an article downloaded from the Internet, the examining attorney must provide information that would aid a party in locating the document, including the complete URL address of the website, the time and date the search was conducted, and the terms searched, and include the relevant material with the Office action. See [TMEP §710.01\(a\)](#) regarding evidence from a research database and [TMEP §710.01\(b\)](#) regarding Internet evidence.

## 705.05 Citation of Decisions and USPTO Publications

In addition to the Trademark Act of 1946, as amended, and the Trademark Rules of Practice, examination is also governed by precedential decisions in prior cases. See [TBMP §§101.01, 101.03](#). These decisions include those from the U.S. Supreme Court (Supreme Court) and precedential decisions from the Court of Appeals for the Federal Circuit (Federal Circuit) (which determines appeals from decisions of the Trademark Trial and Appeal Board (Board)), the Court of Customs and Patent Appeals (the predecessor of the Federal Circuit), the Board, and the Director of The United States Patent and Trademark Office (formerly the Commissioner of Patents and Trademarks) (Director) (who determines petitions on examination procedural matters, among other things). See [TBMP §101.03](#).

Decisions of the Supreme Court, the Federal Circuit, the Board, and the Director appear in the Bloomberg Law database as the United States Patent Quarterly (USPQ) and may also be found in LexisNexis Corporation's LEXIS/NEXIS legal database and in the Intellectual Property Library of ThomsonReuters Corporation's WESTLAW database. Recent, and a certain number of older, final Board decisions are available by accessing the TTAB Reading Room electronic database at <https://ttab-reading-room.uspto.gov/efoia/efoia-ui/#/search/decisions> on the USPTO website. In addition, docket information and images of Board files may be viewed by accessing TTABVUE at <https://ttabvue.uspto.gov/ttabvue/>.

*Precedential Court Decisions.* When citing to court decisions, citation should be to the appropriate reporter, such as the Federal Reporter or the Federal Supplement, preferably with the pinpoint cite. Parallel citations are permitted.

*Precedential Board Decisions.* Decisions designated by the Board as "Citable as Precedent," "Precedent of the Board," "Precedent of the TTAB," or "for publication in full" are citable as precedent. [TBMP §101.03](#).

Citation to precedential Board decisions may be to the USPQ, LEXIS/NEXIS, or Westlaw. The serial number or registration number for appeal cases and the proceeding number for trial cases should be included. If the submitting party does not have any access to legal research databases, citation may be made to a USPTO public electronic database containing the decision (e.g., TTABVUE), indicating the relevant docket entry and page. The citation should include the serial number or registration number for appeal cases and the proceeding number for trial cases.

*Non-precedential Board Decisions.* Prior to January 23, 2007, it was the Board's policy that its opinions not designated as precedential should not be cited and, if cited, were to be disregarded. See, e.g., *In re La Vieille Russie Inc.*, Ser. No. 75609153, 2001 TTAB LEXIS 541, at \*3 n.2 (2001); *In re Polo Int'l Inc.*, Ser. No. 74729974, 1999 TTAB LEXIS 59, at \*6 n.3 (1999); *Gen. Mills Inc. v. Health Valley Foods*, Opp. No. 76303, 1992 TTAB LEXIS 37, at \*13 n.9 (1992). Since that date, the Board has permitted citation to any Board decision. [TBMP §§101.03, 1203.02\(f\)](#); see generally *Citation of Ops. to the Trademark Trial & Appeal Bd.*, OG Notice (Jan. 23, 2007). Although Board decisions designated as not precedential are not binding upon the Board, they may be cited and considered for whatever persuasive value they might have.

*DC Comics v. Cellular Nerd LLC*, Opp. No. 91246950, 2022 TTAB LEXIS 453, at \*8-9 (2022) (citing [TBMP §101.03](#)); *In re UST Glob. (Sing.) Pte. Ltd.*, 2020 USPQ2d 10435, at \*7 n.23 (TTAB 2020) (citing

*In re Soc’y of Health & Physical Educators*, Ser. No. 87657822, 2020 TTAB LEXIS 19, at \*21 n.23 (2018)); [TBMP §§101.03, 1203.02\(f\)](#). However, the Board does not encourage the practice of citing non-precedential decisions; citing such decisions should be done judiciously and rarely. *DC Comics v. Cellular Nerd LLC*, 2022 TTAB LEXIS 453, at \*9, \*11; *see* [TBMP §§101.03, 1203.02\(f\)](#).

[A] Board opinion or decision not designated as precedent involves application by a panel of existing law and policy to only the factual record and issues presented in an individual case, and is not controlling legal authority for Board attorneys and judges. Such opinions or decisions do not announce new interpretations of law or agency policy, and the public may not rely upon them as controlling legal authority in other cases.

*DC Comics v. Cellular Nerd LLC*, 2022 TTAB LEXIS 453, at \*10. “Unless an opinion or decision is marked as a precedent, it is not a precedent of the Board.” *Id.* (citing *Ex parte Holt*, No. 90-1311, 1991 Pat. App. LEXIS 2, at \*6-7 (B.P.A.I.) (“[Unpublished Board] opinions . . . are often fact driven by the specific facts present in the appeal before the Board. Unless the facts in a succeeding case are 'on all fours' with or substantially the same as the facts in the preceding appeal, generally, the opinion in the preceding unpublished appeal decision may not be controlling in a succeeding appeal.”)).

When citing to an unpublished decision of the Board in an Office action, if the decision does not appear in the USPTO’s public electronic databases, the examining attorney should append the decision to the Office action; otherwise, citation may be to TTABVue by docket entry and page number. When citing to an unpublished decision of the Board in a brief, the examining attorney should append the decision to the brief, if it is not already in the record. [TBMP §§101.03, 1203.02\(f\)](#). Any nonprecedential cases referenced must be clearly identified as nonprecedential.

*USPTO Publications*. The examining attorney may cite sections of the *Trademark Manual of Examining Procedure* (TMEP) or [Trademark Trial and Appeal Board Manual of Procedure](#) (TBMP). The abbreviations TMEP and TBMP are usually sufficient. However, if the person prosecuting the application appears to be unfamiliar with USPTO practice, the examining attorney may identify the manuals by their full names in the first citation to the manuals. It is not necessary to provide a copy of the relevant section(s) of the manuals.

When the examining attorney cites a Director’s order or notice, the examining attorney should provide the title and date of the notice, and the specific issue of the *Trademark Official Gazette* in which it may be found.

## 705.06 Reviewing and Signing of Letters

Examining attorneys must review and sign every Office action using an electronic signature. The signature block should include the name, title, law office, telephone number, and email address of the examining attorney. Thus, the signature block for an Office action issued by an examining attorney should be set forth as follows:

/Examining attorney’s full name/  
Trademark Examining Attorney  
Law Office xxx  
(571) xxx-xxxx  
\_\_\_\_\_@uspto.gov

If an examining attorney does not have signatory authority, the examining attorney must sign the action and refer it to an authorized signatory examining attorney, who will review and approve the action. Review by a reviewer should ordinarily be done within two working days after receipt from the non-signatory examining attorney.

## 705.07 Processing Outgoing Office Actions

Except for first Office actions in a §66(a) application, a date is placed on Office actions when they are issued. See [TMEP §1904.02\(h\)](#). For outgoing email communications, including electronically issued Office actions, the date is applied automatically when the communication is released to the USPTO's electronic mail system.

The Office action signed by the examining attorney, along with any supporting evidence and/or copies of registered marks or pending applications cited as a bar to registration, is available for review by the public through the Trademark Status and Document Retrieval (TSDR) portal on the USPTO website at <https://tsdr.uspto.gov/>.

When an Office action issues, the USPTO will email a notice to the applicant with a link or web address to access the Office action using TSDR. The Office action will not be attached to the email notice. Upon receipt of the email notice, the applicant may use the link or web address to view and print the actual Office action and any evidentiary attachments. In the rare case of a treaty-exempt applicant who is not required to provide an email address for correspondence with the USPTO, the USPTO will mail a copy of the Office action to the applicant.

## 705.08 Response Clause

Each Office action must set forth the deadline for response, if applicable. [37 C.F.R. §2.62\(a\)](#).

Generally, the examining attorney's letter or Office action will include a "response clause" notifying the applicant that the applicant must respond to the action within the following time period, as applicable, to avoid abandonment under [15 U.S.C. §1062\(b\)\(2\)](#): (1) for Office actions issued for §1 and/or §44 applications, within three months of the issuance date ("three-month response clause"); or (2) for Office actions issued for §66(a) applications, within six months of the issuance date ("six-month response clause"). See [TMEP §§711–711.03](#) regarding the deadline for response to an Office action.

An Office action with a three-month response clause also includes information regarding the option to request one three-month extension of the time to respond. See [TMEP §711.01](#) regarding requests for an extension of time to respond to an Office action with a three-month response period.

The examining attorney must *not* include a response clause in an examiner's amendment (see [TMEP §§707–707.03](#)) or suspension notice (see [TMEP §§716–716.06](#)), in a situation where the time for response runs from the issuance date of a previous Office action (see [TMEP §§711.02, 715.03\(c\)](#)), or in a subsequent final action where a notice of appeal has previously been filed (see [TMEP §715.04\(b\)](#)).

## 706 New Matter Raised by Examining Attorney After First Action

If in the first Office action an examining attorney inadvertently failed to refuse registration on a clearly applicable ground or to make a necessary requirement, the examining attorney must take appropriate action to correct the inadvertent error in a subsequent action. Examining attorneys should exercise great care to avoid these situations, and should take this step only when the failure to do so would result in clear error



(see [TMEP §706.01](#)). After the first action, supervisors (e.g., supervisors reviewing the quality of the examining attorney's work) should not introduce any new reason for refusal that is not clearly justified under the Act or rules.

Since it is unusual to make a new refusal or requirement that could have been raised in the first action, an examining attorney who does make a new refusal or requirement must clearly explain why the refusal or requirement is necessary, and apologize for the delay in raising the issue, if appropriate. See [TMEP §711.03](#) regarding supplemental Office actions.

Sometimes, the examining attorney must issue a new refusal or requirement because the applicant submits information that raises a new issue.

In a §66(a) application, the examining attorney cannot issue a new refusal more than 18 months after the date on which the International Bureau of the World Intellectual Property Organization ("IB") forwards the request for extension of protection to the USPTO. Thus, if the examining attorney determines that a new ground of refusal exists that should have been raised in the first Office action, a second Office action raising this new ground may be issued only if time remains in the 18-month period. In such a case, the examining attorney must ensure that a notification of the new ground of refusal is sent to the IB. See [TMEP §1904.03\(a\)](#).

## 706.01 Clear Error

The term "clear error" refers to an administrative internal guideline used by the USPTO to determine whether an examining attorney should issue a refusal or requirement that could or should have been raised in a previous action.

It is the policy of the USPTO to conduct a complete examination upon initial review of an application by an examining attorney and to issue all possible refusals and requirements in the first Office action. See [TMEP §704.01](#). The USPTO will not issue a new refusal or requirement unless it is necessary to do so to prevent the issuance of a registration that would violate the Trademark Act or applicable rules. See, e.g., [TMEP §706](#). For example, upon discovery of evidence, after publication, that demonstrates the proposed mark is a generic identifier for the goods, registration on either the Principal or Supplemental Register would be in violation of the Trademark Act and the Director will restore jurisdiction to the examining attorney to issue a new refusal of registration. See [TMEP §1504.04](#). See also [TMEP §1109.08](#) regarding the issuance of refusals and requirements during examination of a statement of use that could or should have been issued during initial examination of the application.

The internal clear-error standard is merely an administrative guideline. It does not confer on an applicant any entitlement to a showing of clear error, nor does it impose a higher standard of proof on the examining attorney than is otherwise required to establish a prima facie case for the refusal or requirement.

Except as provided in [15 U.S.C. §1141h\(c\)\(4\)](#), there is no restriction in the Trademark Act or Trademark Rules of Practice as to the period of time prior to registration when the USPTO may issue a new requirement or new refusal. Moreover, an applicant may not directly challenge the Office's determination under the clear-error standard that a new requirement or refusal must issue. *In re Driven Innovations, Inc.*, 115 USPQ2d 1261, 1264 (TTAB 2015), *overruled on other grounds*, 2017 U.S. App. LEXIS 241, 2017 WL 33574 (Fed. Cir. Jan. 4, 2017). The only way an applicant may challenge a refusal that was issued under the clear-error standard is by appealing the merits of the final refusal to the Board, which will review only the correctness of the underlying substantive refusal of registration. *Id.* See also *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1373-74 (TTAB 2006); *In re Sambado & Son, Inc.*, 45 USPQ2d 1312, 1314-15 (TTAB 1997).



The USPTO has a duty to issue valid registrations and has broad authority to correct errors made by examining attorneys and other USPTO employees. See *Last Best Beef LLC v. Dudas*, 506 F.3d 333, 340, 84 USPQ2d 1699, 1704 (4th Cir. 2007) (“[F]ederal agencies, including the USPTO, have broad authority to correct their prior errors.”); see also *BlackLight Power Inc. v. Rogan*, 295 F.3d 1269, 63 USPQ2d 1534 (Fed. Cir. 2002) (affirming that USPTO officials acted within their authority in a reasonable manner when withdrawing a patent from issuance in order to fulfill the USPTO’s mission to issue valid patents, even after Notice of Allowance, payment of the issue fee, and notification of the issue date, and with publication of the drawing and claim in the *Official Gazette*). Thus, if the USPTO discovers that a mistake made during examination would result in issuance of a registration in violation of the Trademark Act or applicable rules, the USPTO must issue any necessary requirements or refusals, even if they could or should have been previously raised.

The question of whether a refusal or requirement was procedurally proper is reviewable on petition under [37 C.F.R. §2.146](#). However, “[q]uestions of substance arising during the ex parte prosecution of applications, . . . including, but not limited to, questions arising under sections 2, 3, 4, 5, 6, . . . and 23 of the Act of 1946, are not appropriate subject matter for petitions to the Director.” [37 C.F.R. §2.146\(b\)](#). Thus, the Director cannot consider on petition whether the issuance of or failure to issue a substantive refusal was a “clear error.” See [TMEP §1704](#) regarding petitionable subject matter, and [TMEP §1706](#) regarding the standard of review on petition.

## 707 Examiner’s Amendment

An examiner’s amendment should be used whenever appropriate to expedite prosecution of an application. An examiner’s amendment is a communication to the applicant in which the examining attorney states that the application has been amended in a specified way. Except in the situations listed in [TMEP §707.02](#), the amendment must be specifically authorized by the individual applicant, someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner of a partnership), or the applicant’s qualified practitioner. Cf. [37 C.F.R. §§2.62\(b\), 2.74\(b\)](#). See [TMEP §707.01](#) regarding the authorization of an examiner’s amendment. Authorization is usually given in a telephone conversation, email communication, or interview between the examining attorney and the applicant or the applicant’s qualified practitioner. See [TMEP §§304–304.09](#) regarding email.

The examining attorney may issue an examiner’s amendment whenever the required amendment does not have to be verified by the applicant, unless an examiner’s amendment is specifically not permitted. For example, in appropriate circumstances, an examiner’s amendment may be used to amend the identification of goods/services, enter a disclaimer, add the state of incorporation, or amend from the Principal to the Supplemental Register.

The following are examples of amendments that may **not** be made by examiner’s amendment: the dates of use, if verification would be required (see [TMEP §903.04](#)); the mark on a special-form drawing (see [TMEP §§807.04–807.04\(b\)](#)), if the changes would require the filing of a substitute special form drawing; amendments that require the submission of substitute specimen(s) (see [TMEP §904.05](#)); and the applicant’s domicile address (see [TMEP §601.01\(c\)\(i\)](#)). An application cannot be expressly abandoned by examiner’s amendment (see [TMEP §718.01](#)).

An authorization to charge a fee to a deposit account cannot be entered by examiner’s amendment, unless the record already contains a written authorization, signed and submitted by someone authorized to charge fees to the account. See [TMEP §405.03](#) regarding deposit accounts.

Examiner's amendments generally are not used when there are statutory refusals. However, if there is a potential statutory refusal, and an amendment will obviate the refusal, the examining attorney may attempt to resolve the issues through an examiner's amendment.

*Example:* If the applicant could overcome a surname refusal for a mark that is in use in commerce by amending to the Supplemental Register, the examining attorney may initiate telephone or email contact and suggest the amendment. If the applicant authorizes the amendment, the examining attorney may issue an examiner's amendment amending the application to the Supplemental Register.

*Example:* If the mark contains the term "organic" and the applicant could overcome a potential deceptiveness refusal by amending the identification to state that the goods are organic, the examining attorney may initiate telephone or email contact and suggest the amendment. If the applicant authorizes the amendment, the examining attorney may issue an examiner's amendment amending the identification.

*Example:* If the applicant could overcome a likelihood-of-confusion refusal as to several registrations by amending a vague or indefinite identification of goods/services, the examining attorney may initiate telephone or email contact and suggest the amendment only if it would obviate the refusals as to all the registrations that would be cited. If the applicant agrees to the proposed amendment clarifying the identification, the examining attorney may issue an examiner's amendment. If the applicant does not agree with the examining attorney's suggested identification and proposes an amendment that would obviate the refusal as to some, but not all, of registrations, the examining attorney may issue a combined examiner's amendment and priority action. See [TMEP §708.05](#). However, when it is clear from the outset that amending the identification would not obviate the refusal as to one or more of the registrations, the examining attorney must not initiate telephone or email contact, because it is not possible to offer the applicant a specific action to place the application in condition for publication, suspension, or registration.

*Example:* If the identification is vague or indefinite, the examining attorney may seek authorization to amend the identification by examiner's amendment, even when the amendment would not overcome a potential likelihood-of-confusion refusal. The examining attorney would then issue a notice of suspension. To ensure that the applicant understands that amending the identification will only put the application in condition for suspension, during the telephone or email discussion, the examining attorney must notify the applicant of the prior pending application and the forthcoming suspension. The resulting examiner's amendment should also include this information.

See [TMEP §708.04](#) regarding priority actions involving statutory refusals.

An examining attorney without partial signatory authority must have proper authorization from the managing attorney, senior attorney, or a reviewing examining attorney before initiating an examiner's amendment.

See [TMEP §707.03](#) regarding the form of an examiner's amendment.

An applicant should **not** file correspondence confirming an examiner's amendment, because this will delay processing of the application. A written response to an examiner's amendment is not required.

If an applicant wishes to object to the examiner's amendment, this should be done immediately (preferably by telephone or email), so that the objection can be considered before publication or issue. See [TMEP §1402.07\(e\)](#) regarding an applicant's objection to an examiner's amendment of the identification of goods/services on the ground that the examiner's amendment does not reflect the agreement between the applicant and the examining attorney.

Often an applicant will seek to respond to an outstanding Office action with an amendment or other response by telephone. The examining attorney is encouraged to enter an examiner's amendment if this amendment will immediately place the application in condition for publication for opposition, issuance of a registration, or suspension. See [TMEP §§716–716.06](#) regarding suspension. However, an applicant does not have an unlimited right to the entry of an examiner's amendment in response to an Office action. If the applicant does not agree to an amendment that the examining attorney believes will immediately place the application

in condition for publication for opposition or issuance of a registration, the applicant must file a complete written response to the outstanding Office action.

See [TMEP §708.05](#) regarding combined examiner's amendment and priority actions.

*NOTE:* In a §66(a) application, an examiner's amendment may *not* be issued on first action because the IB will not accept such amendments. Examiner's amendments may be issued on second and subsequent actions. See [TMEP §1904.02\(h\)](#) regarding Office actions in §66(a) applications.

### **707.01 Approval of Examiner's Amendment by Applicant or Applicant's Attorney**

Except in the situations set forth in [TMEP §707.02](#) in which an examiner's amendment is permitted without prior authorization by the applicant, an examining attorney may amend an application by examiner's amendment only after securing approval of the amendment from the proper person by telephone, email, or in person during an interview. Cf. [37 C.F.R. §§2.62\(b\), 2.74\(b\)](#); see [TMEP §§304.01, 304.02, 602, 611.03-611.03\(i\), 709.01-709.05](#).

If the applicant is represented by a qualified U.S. attorney, the examining attorney must communicate directly with the attorney by phone or email. If a qualified U.S. attorney from the same firm as the qualified attorney of record claims to be authorized by the attorney of record to conduct business and approve amendments with respect to a specific application, the examining attorney will permit the attorney to conduct business, and will note this fact in the examiner's amendment.

A Canadian trademark attorney or agent who has been appointed in addition to a qualified U.S. attorney may not authorize an examiner's amendment. Paralegals and legal assistants cannot authorize examiner's amendments, even if only conveying the appointed qualified attorney's approval by indicating that the attorney has approved the amendment.

If the applicant is pro se and not required to be represented under [37 C.F.R. §2.11\(a\)](#), the examining attorney must communicate directly with the individual applicant or with someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner of a partnership). Cf. [37 C.F.R. §11.14\(e\)](#). For joint applicants who are not represented by a qualified U.S. attorney and not required to be represented under [37 C.F.R. §2.11\(a\)](#), each joint applicant must authorize the examiner's amendment. See [TMEP §§611.06-611.06\(h\)](#) for guidelines on persons who have legal authority to bind various types of applicants.

A non-attorney who is authorized to verify facts on behalf of an applicant under [37 C.F.R. §2.193\(e\)\(1\)](#) (see [TMEP §611.03\(a\)](#)) is *not* entitled to authorize an examiner's amendment on behalf of a pro se applicant who is not required to be represented under [37 C.F.R. §2.11\(a\)](#), unless the person also has legal authority to bind the applicant.

The applicant or the applicant's qualified attorney must actually authorize the examiner's amendment. The examining attorney may not leave an email or voicemail message for the applicant or the qualified attorney indicating that an amendment shall be entered if the applicant or attorney does not respond to the message.

If the applicant is required to be represented under [37 C.F.R. §2.11\(a\)](#) but has not appointed a qualified U.S. attorney, the examining attorney may not contact the applicant to authorize an examiner's amendment. See [TMEP §§712-712.03](#).

If an examining attorney contacts a pro se applicant who is not required to be represented and reaches agreement to issue an examiner's amendment, but later determines that an Office action must be issued instead to state a refusal or requirement, the examining attorney should telephone or email the applicant immediately to advise the applicant of the change of position.

Examining attorneys without partial signatory authority must advise applicants that issuance of the examiner's amendment is subject to review by a supervisory attorney.

## **707.02 Examiner's Amendment Without Prior Authorization by Applicant or Applicant's Attorney**

Examining attorneys have the discretion to amend applications by examiner's amendment without prior approval by the applicant or the applicant's qualified U.S. attorney (sometimes referred to as a "no-call" examiner's amendment) in the following situations:

- (1) In applications under §1 or §44, changes to international classification, either before or after publication ( *see Groening v. Mo. Botanical Garden*, 59 USPQ2d 1601, 1603 (Comm'r Pats. 1999));
- (2) Deletion of "TM," "SM," "©," or "®" from the drawing;
- (3) Addition of a description of the mark where an Office action or regular examiner's amendment is otherwise unnecessary *and* one of the following conditions applies:
  - (a) The record already contains an informal indication of what the mark comprises (*see* [TMEP §808.03\(b\)](#));  
*Example* – The cover letter accompanying a permitted paper application (*see* [TMEP §301.01](#)) refers to the mark as a stylized golf ball design. If appropriate, the examining attorney could enter an amendment that "the mark consists of the stylized design of a golf ball." *Example* – The application refers to the mark as a blue, red, and yellow ball and includes an accurate and properly worded color claim listing all colors in the mark, but the color yellow is omitted from the formal description of the colors in the mark (*see* [TMEP §807.07\(a\)\(ii\)](#)). The examining attorney may enter an amendment of the formal color description to accurately reflect all colors in the mark;
  - (b) The mark consists only of wording in stylized font, with no color claim and with no design element, and the applicant did not provide the "literal element" of the mark in the appropriate field (*see* [TMEP §808.03\(b\)](#)); or
  - (c) The mark includes no color claim and consists only of wording in combination with underlining or a common geometric shape used as a vehicle for the display of the wording (*see* [TMEP §808.03\(b\)](#)).
- (4) If the examining attorney determines that a description of the mark will not be published in the *Trademark Official Gazette* or included on the registration certificate, and it is not necessary to issue an Office action or a regular examiner's amendment regarding other matters, the examining attorney may enter a Note to the File (also referred to as a Public Note or Notation to File) in the record or issue a "no-call" amendment to that effect. *See* [TMEP §808.03](#);
- (5) In applications under §1, amendment of the application to enter a standard character claim when the record clearly indicates that the drawing is intended to be in standard character form. *See* [TMEP § 807.03\(g\)](#);
- (6) Correction of obvious misspellings, typographical errors, and redundancies in the identification of goods/services, or in an otherwise accurate and complete description of the mark. *See* [TMEP §§808.03\(a\), 1402.01\(a\)](#); *Example* - The goods are identified as "T-shurtz." The examining attorney may amend to "T-shirts." However, "shurtz" may not be amended to "shirts" without calling the applicant, because "shurtz" (without the "T-" prefix) might also be a misspelling of "shorts."
- (7) When an applicant fails to respond to a refusal or requirement that is expressly limited to only certain goods, services, and/or class(es), the examining attorney may issue an examiner's amendment deleting the

goods/services/classes to which the refusal or requirement pertained. Similarly, when an applicant fails to respond to a requirement to amend some terminology in an otherwise acceptable identification of goods/services, the examining attorney may issue an examiner's amendment deleting the unacceptable terminology from the identification. See [TMEP §§718.02\(a\), 1402.13](#);

(8) In applications under § 1 or § 44, deletion of bracketed material from an entry taken from the USPTO's [Acceptable Identification of Goods and Services Manual](#). Bracketed material sometimes appears in the Manual for informational purposes but should not be included in an identification of goods/services. See [TMEP §1402.12](#). If this material is entered in an identification in an application submitted through the trademark electronic filing system, it will be automatically deleted in all electronic applications. If submitted in a permitted paper application (see [TMEP §301.01](#)) or in an amendment or response submitted through the trademark electronic filing system, the examining attorney may delete the bracketed material with a "no-call" examiner's amendment;

(9) If, in response to a general or specific inquiry about translation and/or transliteration of non-English wording in the mark, the applicant does not directly state that the term has no meaning in a foreign language but instead responds to the effect that "the mark has only trademark significance," the examining attorney may enter a statement that "the term has no meaning in a foreign language" into the record. See [TMEP §809.01\(a\)](#);

(10) When an applicant provides a translation statement that has the proper translation but is in a format that is not suitable for printing, the examining attorney may "reformat" the statement, without changing the substance, into a simple, clear statement as to meaning. See [TMEP §809.03](#).

(11) When an application includes foreign wording that is not translated, and a translation of the same foreign wording appears in a prior registration for which the applicant has claimed ownership, and the translation is acceptable to the examining attorney, the examining attorney may enter the identical translation into the record. Note: If the application was filed using the TEAS Plus form and the translation was omitted, the examining attorney may not issue an examiner's amendment without prior authorization. The examining attorney must take appropriate action requiring the translation and the additional TEAS Plus processing fee. [37 C.F.R. §§2.6\(a\)\(1\)\(v\), 2.22\(a\)\(15\), \(c\)](#); [TMEP §§ 819.01, 819.01\(m\)](#).

(12) If the examining attorney determines that a translation statement will not be published in the *Trademark Official Gazette* or included on the registration certificate, and it is not necessary to issue an Office action or a regular examiner's amendment regarding other matters, the examining attorney may enter a Note to the File in the record or issue a "no-call" amendment to that effect. See [TMEP §809.03](#);

(13) When an application under § 1 or § 44 includes a disclaimer of the entire mark, and the application would otherwise be in condition for approval for publication or registration without the need to contact the applicant or issue an Office action, the examining attorney may issue an examiner's amendment noting that the entire mark may not be disclaimed and that the disclaimer will be deleted from the record. See [TMEP §1213.01\(c\)](#) regarding unnecessary disclaimers in applications under §66(a). The examining attorney must ensure that the disclaimer is removed.

(14) When a response to an Office action includes a disclaimer of the entire mark, and the application would otherwise be in condition for approval for publication or registration, the examining attorney may issue an examiner's amendment noting that the entire mark may not be disclaimed and that the disclaimer will be deleted from the record. The examining attorney must ensure that the disclaimer is removed.

If the examining attorney must contact the applicant or the applicant's qualified U.S. attorney about other matters, or if the record contains any ambiguity as to the applicant's intent, the examining attorney should advise the applicant or the applicant's attorney that the above changes have been made.

The USPTO will issue an email notification when an examiner's amendment is issued. The applicant or applicant's attorney may then view and/or print the examiner's amendment from the USPTO website. In

the rare case of a treaty-exempt applicant who is not required to provide an email address for correspondence with the USPTO, the USPTO will mail the examiner's amendment to the applicant. If an applicant or qualified attorney disagrees with any changes in the examiner's amendment, they should contact the examining attorney immediately after reviewing or receipt of the examiner's amendment, preferably by telephone or email.

*Note:* In a §66(a) application, an examiner's amendment may not be issued on first action because the IB will not accept such amendments. Examiner's amendments may be issued on second and subsequent actions. See [TMEP §1904.02\(h\)](#) regarding Office actions in §66(a) applications.

### **707.03 Form of the Examiner's Amendment**

An examiner's amendment should include the following information: the name, law office, telephone number, and email address of the examining attorney; the name of the person interviewed; the date of the interview; the actual amendment; and, if applicable, a statement to the effect that the amendment has been authorized by the applicant or the applicant's qualified U.S. attorney.

The examiner's amendment must not include a response clause, because a written response by the applicant is not required for an examiner's amendment.

The examiner's amendment must include a search clause (*see* [TMEP §704.02](#)) if it is a first action.

The examining attorney must not state in the examiner's amendment that the application is ready for publication or issue, because some unforeseen circumstance might require that further action be taken in the application.

The examiner's amendment must indicate any refusals or requirements that are withdrawn and/or continued by the examining attorney.

## **708 Priority Action**

### **708.01 Priority Action Defined**

A "priority action" is an Office action that is issued following a telephone conversation, personal interview, or email communication in which the examining attorney and the individual applicant, someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner of a partnership), or the applicant's qualified U.S. attorney discuss the various issues raised in an application and what actions the applicant must take to put the application in condition for publication or registration. A priority action is generally used when the action requires verification by the applicant. The use of priority actions is encouraged to expedite examination.

A priority action should be issued according to the following procedure: (1) the examining attorney telephones or emails the applicant or applicant's qualified U.S. attorney and requests that the applicant take some specific action, explaining the reasons; (2) the applicant or applicant's qualified attorney specifically discusses the merits of the application with the examining attorney; (3) the examining attorney prepares and signs a priority action that fully discusses all refusals or requirements, includes evidence to support the refusals and/or requirements, if necessary, and specifically describes what action the applicant may take in order to put the application in condition for publication or registration; and (4) the USPTO will usually issue an



email notification when a priority action issues, which the applicant or applicant's attorney may then view and/or print from the USPTO website.

If the evidence of record supports a statutory refusal of registration, a priority action may be issued only if the examining attorney believes that an amendment or explanation will obviate the refusal. See [TMEP §708.04](#).

See [TMEP §708.03](#) regarding the form of a priority action.

*Note:* In a §66(a) application, an examining attorney may issue a priority action as a first action. See [TMEP §1904.02\(h\)](#) regarding Office actions in §66(a) applications.

## 708.02 Discussion of Issues and Agreements

An examining attorney must discuss the issues with the proper person.

*If the applicant is represented by a qualified U.S. attorney*, the examining attorney must speak directly to the attorney. See [TMEP §§602–602.03\(e\)](#) for guidelines on persons authorized to practice before the USPTO in trademark matters.

If a qualified attorney from the same firm as the qualified attorney of record claims to be authorized by the attorney of record to conduct business and approve amendments with respect to a specific application, the examining attorney will permit the attorney to authorize issuance of the priority action, and will note this fact in the priority action.

A Canadian trademark attorney or agent who has been appointed in addition to a qualified U.S. attorney may not authorize issuance of a priority action. Paralegals and legal assistants cannot authorize issuance of a priority action, even if only conveying the qualified attorney's approval by indicating that the attorney has agreed to the priority action.

*If the applicant is pro se and not required to be represented under 37 C.F.R. §2.11(a)*, the examining attorney must speak directly to the individual applicant or to someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner of a partnership). Cf. [37 C.F.R. §11.14\(e\)](#). See [TMEP §§611.06–611.06\(h\)](#) for guidelines on persons who have legal authority to bind various types of applicants.

A non-attorney who is authorized to verify facts on behalf of an applicant under [37 C.F.R. §2.193\(e\)\(1\)](#) (see [TMEP §611.03\(a\)](#)) may not authorize issuance of a priority action on behalf of a pro se applicant who is not required to be represented under [37 C.F.R. §2.11\(a\)](#), unless the person also has legal authority to bind the applicant.

*If the applicant is required to be represented under 37 C.F.R. §2.11(a) but has not appointed a qualified U.S. attorney*, the examining attorney may not contact the applicant to authorize issuance of a priority action. See [TMEP §§712–712.03](#).

During the telephone conversation, email discussion, or in-person communication, the examining attorney must fully discuss all refusals and requirements relating to the application, and explain the reason(s) for each refusal or requirement. Whenever possible, the examining attorney should suggest appropriate language for amendments. A priority action is *not* appropriate when:



1. the examining attorney leaves a voicemail or email message for the applicant or applicant's qualified attorney, but the applicant or attorney does not call back or respond to the message;
2. the examining attorney telephones the applicant or applicant's attorney but the attorney does not have time to discuss the application and requests that the examining attorney send a letter; or
3. the examining attorney emails the applicant or applicant's attorney and merely states that there are problems with the application (e.g., indefinite identification, a disclaimer requirement, and clarification of entity type) and that a letter will be sent.

All the issues in the priority action must be discussed on the merits with the proper person in a good-faith attempt to resolve any issues and place the application in condition for publication or registration, as appropriate. However, an agreement as to precisely how all issues will be resolved is not necessary.

*Example:* If the goods are identified as “computer equipment,” the examining attorney may seek authorization to amend the identification to list the types of computer equipment. If the applicant or applicant's attorney does not agree to the suggested amendment, the examining attorney may issue a priority action that fully explains the identification requirement. It may also state that “the applicant will submit an acceptable identification of goods that specifies the common commercial names of the types of computer equipment.” It is not necessary that there be an agreement that “the applicant will amend the identification of goods to, for example, computer keyboards, computer monitors, and computer printers for printing documents.”

The priority action may state that the applicant will follow one of two alternative courses of action, for example, providing either an amended drawing or a new specimen.

### **708.03 Form of the Priority Action**

The priority action should reference the date of the telephone call, email message, or other communication, and the name and title (where appropriate) of the person who authorized the priority action. See [TMEP §708.02](#) for information about who may authorize issuance of a priority action.

A priority action must include a response clause (*see* [TMEP §705.08](#)) so that it is clear that the applicant must timely respond to the priority action to avoid abandonment of the application.

The priority action must include a search clause (*see* [TMEP §704.02](#)) if it is a first action.

The priority action must also: (1) fully discuss all refusals and/or requirements; (2) include sufficient evidence to support all refusals and/or requirements, if necessary; and (3) specifically describe what action the applicant may take in order to put the application into condition for publication or registration. See [TMEP §708.02](#) regarding discussion of issues on the merits.

The examining attorney should discuss each issue separately, stating the reason for the refusal and/or requirement and/or citing the relevant sections of the statute, rules, and/or TMEP. The essential nature of the refusal or requirement, and any pertinent advisories relating thereto, must be clearly stated in the priority action, and fully supported by appropriate evidence (if applicable), because the action of the USPTO is based exclusively on the written record. [37 C.F.R. §2.191](#).

A priority action may be used for a final or nonfinal refusal or requirement. See [TMEP §708.04](#) regarding refusal of registration in a priority action, and [§§714–714.06](#) regarding final actions.

## 708.04 Refusal of Registration in Priority Action

Priority actions are generally used when there are no statutory refusals. However, if there is sufficient evidence to support a statutory refusal, and the examining attorney believes that an amendment or explanation will obviate the refusal, the examining attorney may attempt to resolve the issues through a priority action.

*Example :* If the applicant could overcome a surname refusal by submitting a claim of acquired distinctiveness under §2(f) of the Trademark Act for a mark that has been used in commerce for more than five years, the examining attorney may initiate telephone or email contact and discuss the refusal and the requirements for submitting a claim of acquired distinctiveness. See [TMEP §§1212–1212.10](#) regarding §2(f). Because the claim of five years of use is generally required to be supported by a properly signed affidavit or declaration under [37 C.F.R. §2.20](#), the examining attorney may issue a priority action that fully discusses the refusal, includes sufficient evidence to support the refusal, and reiterates the suggested amendment and requirement.

*Example:* If the applicant could overcome a likelihood-of-confusion refusal limited to a particular class or classes in a multiple-class application by deleting the class(es), the examining attorney may initiate telephone or email contact and suggest the amendment. If the applicant or applicant's attorney does not authorize an examiner's amendment, the examining attorney may issue a priority action that fully discusses the refusal, includes sufficient evidence to support the refusal, and expressly states that the refusal is limited to only certain class(es). See [TMEP §718.02\(a\)](#).

*Example:* If the applicant could overcome a likelihood-of-confusion refusal as to several registrations by amending a vague or indefinite identification of goods/services, the examining attorney may initiate telephone or email contact and suggest the amendment. If the applicant or applicant's attorney does not authorize an examiner's amendment, the examining attorney may issue a priority action that fully discusses the refusal, includes sufficient evidence to support the refusal, and reiterates the suggested amendment to the identification. However, if amending the identification would obviate the refusal as to fewer than all of the registrations, the examining attorney must not initiate telephone or email communication, and, therefore, may not issue a priority action.

*Example:* If there are multiple companion applications, and a likelihood-of-confusion refusal could be obviated as to some of the applications by amending the identification, the examining attorney may initiate telephone or email contact and suggest the amendment only as to those applications. If the applicant or applicant's attorney does not authorize an examiner's amendment, the examining attorney may issue priority actions that fully discuss the refusal, include sufficient evidence to support the refusal, and reiterate the suggested amendment to the identification. The examining attorney may not issue a priority action for any companion applications where an amendment to the identification would not obviate the refusal.

*Example:* If the applicant could overcome a descriptiveness refusal for a mark that is in use in commerce by amending to the Supplemental Register, the examining attorney may initiate telephone or email contact to discuss the refusal and suggest the amendment. If the applicant's attorney agrees that the mark is descriptive, but needs to consult with the applicant about amending to the Supplemental Register, the examining attorney may issue a priority action that fully discusses the refusal, includes sufficient evidence to support the refusal, and offers the option of amending to the Supplemental Register.

*Example:* If the applicant could overcome a geographically descriptive refusal for a mark that is in use in commerce by amending to the Supplemental Register, the examining attorney may initiate telephone or email contact to discuss the refusal and suggest the amendment. Even if the applicant disagrees as to the merits of the underlying refusal, the examining attorney may issue a priority action that fully discusses the refusal, includes sufficient evidence to support the refusal, and reiterates the option of amending to the Supplemental Register.

In the priority action, the examining attorney must clearly state the basis for the refusal that was discussed, citing the relevant sections of the statute and rules, attaching evidence to support the refusal, if necessary, and indicating the resolutions agreed upon or the options offered.

If the priority action includes a final refusal, the priority action must clearly indicate that the refusal is FINAL, and should contain any additional supporting evidence necessary for a complete record on appeal. See [TMEP §§714–714.06](#) regarding final actions.

## 708.05 Combined Examiner's Amendment and Priority Action

An examining attorney may issue an Office action that combines an examiner's amendment and priority action, if the requirements for both have been met. The examiner's-amendment portion reflects the authorized amendments, and the priority-action section addresses the refusals and requirements that remain outstanding and to which the applicant must still respond. An examining attorney may not issue a "no-call" combined examiner's amendment and priority action, because the issues in the priority action portion of the action have not been discussed with the applicant or applicant's qualified practitioner.

The action must include a response clause (*see* [TMEP §705.08](#)) so that it is clear that the applicant must timely respond to the issues raised in the priority action to avoid abandonment of the application. The action must also include the subheadings "Priority Action" and "Examiner's Amendment" to facilitate processing.

*Example:* After determining that an application requires a disclaimer and clarification of the entity type and color claim, and that the specimen shows ornamental use of the mark, if the examining attorney obtains authorization from the applicant or applicant's attorney only to amend the entity type and color claim, a combined examiner's amendment and priority action may be issued. The examiner's-amendment section memorializes the amendments to the entity type and color claim. The priority action portion fully addresses the ornamental refusal and disclaimer requirement, includes sufficient evidence to support each, and reiterates the action that would put the application in condition for publication or registration.

*Example:* If the examining attorney determines that an application lacks the necessary translation statement and that the specimen is unacceptable, and during a discussion of these issues the applicant agrees to entry of a suggested translation statement, but states that the applicant needs to consider what to do about the specimen, the examining attorney may issue a combined examiner's amendment and priority action. The examiner's-amendment section memorializes the agreed-upon translation statement. The priority-action portion fully addresses the specimen refusal and includes all actions that would put the application in condition for publication or registration.

*Example:* If the application contains the "SM" symbol on the drawing, an indefinite identification, and an unclear entity type, the examining attorney may not issue a no-call combined examiner's amendment and priority action to delete by examiner's amendment the "SM" symbol and address by priority action the identification and entity requirements. Since no discussion occurred, the requirements for a priority action have not been met. However, the examining attorney may telephone or email the applicant or applicant's attorney, discuss the requirements, and issue a combined examiner's amendment and priority action, if appropriate.

**NOTE:** In a §66(a) application, an examining attorney may not issue a combined examiner's amendment and priority action as a first action. See [TMEP §1904.02\(h\)](#) regarding Office actions in §66(a) applications.

## 709 Interviews

### 709.01 Interviews with Examining Attorneys

A discussion between the applicant or applicant's qualified U.S. attorney and the examining attorney in which the applicant presents matters for the examining attorney's consideration is considered an interview. An interview may be conducted by telephone, email, or video conference. See [TMEP §304](#) regarding email.

An interview should be conducted only when it could serve to develop and clarify specific issues and lead to a mutual understanding between the examining attorney and the applicant. Interviews should not extend beyond a reasonable time. *See also* [37 C.F.R. §2.192](#). The examining attorney should not hesitate to state that matter presented for consideration during the interview requires further research, if this is the case. Furthermore, the examining attorney may conclude an interview when it appears that no common ground can be reached.

When an agreement is reached during an interview but it is not possible to resolve all issues through an examiner's amendment, the examining attorney should enter a Note to the File (also referred to as a Public Note or Notation to File) in the record concerning the agreement, and the applicant should incorporate the agreement in its response.

Sometimes, the examining attorney who conducted the interview is transferred, resigns, or retires, and examination of the application is taken over by another examining attorney. If there is an indication in the record that an interview was held, the new examining attorney should endeavor to ascertain whether any agreements were reached during the interview. The new examining attorney should take a position consistent with agreements previously reached, unless doing so would be a clear error (*see* [TMEP §706.01](#)).

The application will not normally be processed out of turn as a result of the interview, and the interview does not extend the deadline for response to an outstanding Office action.

The examining attorney may not discuss inter partes questions with any of the interested parties. *See* [TMEP §1801](#). Except in unusual situations, no interview on the merits is permitted after the brief on appeal is filed, or after an application has been forwarded for publication or issue.

## **709.02 Persons With Whom the Examining Attorney May Discuss the Application in an Interview**

In general, interviews are not granted to persons who lack proper authority from the applicant. *See* [TMEP §§602–602.03\(c\)](#) regarding persons who may represent an applicant before the USPTO in a trademark matter, and [TMEP §§611.06–611.06\(h\)](#) for information on persons with legal authority to bind various types of juristic applicants.

If the applicant is represented by a U.S. qualified attorney, the examining attorney may only discuss the application with the attorney. *See* [TMEP §601.02](#). An examining attorney may also discuss the application of a Canadian applicant with a recognized Canadian trademark attorney or agent if one has been designated as an additional appointed attorney. If the applicant is neither required to be represented by an attorney nor is represented by one, the examining attorney may only speak with the applicant or someone with legal authority to bind the applicant. *See* [TMEP §611.06-611.06\(h\)](#) for information on persons with legal authority to bind various types of juristic applicants. If the applicant is required to be represented under [37 C.F.R. §2.11\(a\)](#) but has not appointed a qualified U.S. attorney, the examining attorney may not discuss the application with the applicant. *See* [TMEP §707.01](#) regarding who can authorize an examiner's amendment and [§708.02](#) regarding who can authorize a priority action.

The examining attorney may request proof of a person's authority if there is any reason to suspect that the person is not, in fact, a qualified U.S. attorney who is authorized to represent the applicant. [37 C.F.R. §2.17\(b\)\(2\)](#).

For an interview with an examining attorney who does not have signatory authority, arrangements should be made for the presence of an examining attorney who does have such authority and who is familiar with the application, so that an authoritative agreement may be reached, if possible, at the time of the interview.

USPTO employees are forbidden to engage in oral or written communication with a disbarred, suspended, or excluded practitioner (*see* [TMEP §608.02](#)), unless the attorney is the applicant.

Requests for interviews from third parties are inappropriate and should be directed to the Office of the Deputy Commissioner for Trademark Examination Policy. *See* [TMEP §1801](#).

### **709.03 Making Substance of Interview of Record**

The substance of an interview must always be made of record in the application, since the action of the USPTO is based exclusively on the written record. [37 C.F.R. §2.191](#). This should be done promptly after the interview while the matters discussed are fresh in the minds of the parties.

If possible, agreements reached in the interview should be incorporated in an examiner's amendment or priority action. Otherwise, to ensure that any agreements reached at an interview will be implemented, and to avoid subsequent misunderstanding, the examining attorney should include, in a Note to the File (also referred to as a Public Note or Notation to File), a list of the issues discussed and indicate whether any agreement was reached. *See* [TMEP §709.04](#) for further information about Notes to the File.

The applicant or the applicant's qualified practitioner may also make the substance of an interview part of the record by incorporating a summary of the interview in the applicant's response to the Office action. If there is any disagreement between the examining attorney and the applicant as to the substance of the interview, the written record governs. [37 C.F.R. §2.191](#).

### **709.04 Telephone and Email Communications**

Examining attorneys should initiate telephone or email communications (i.e., informal communications) whenever possible to expedite prosecution of an application. Similarly, applicants, qualified U.S. attorneys, and recognized Canadian trademark attorneys or agents designated as other appointed attorneys may telephone or email examining attorneys, if they feel that a telephone call or email will advance prosecution of an application. *See* [TMEP §709.05](#) regarding guidelines for informal communications. Therefore, all documents filed in connection with the application should include the telephone number of the applicant or the applicant's qualified U.S. attorney. *See* [TMEP §709.02](#) regarding persons with whom the examining attorney may discuss an application.

The examining attorney must respond to telephone calls and email messages within a reasonable time, normally within the same working day and not later than the next working day.

Generally, the examining attorney who prepared the action, and not the supervisory or reviewing examining attorney, should be the person contacted by telephone or email. However, a non-signatory examining attorney must secure proper authorization from the managing attorney, senior attorney, or reviewing examining attorney before approving an amendment.

The action of the USPTO is based exclusively on the written record and all relevant communications, including informal communications, must be made part of the record. [37 C.F.R. §2.191](#). Therefore, the examining attorney must use an examiner's amendment (*see* [TMEP §§707–707.03](#)) or priority action (*see* [TMEP §708](#)), upload all relevant email communications, and enter a Note to the File (also referred to as a Public Note or Notation to File) regarding issues discussed by telephone. *See* [TMEP §709.03](#).

Notes to the File must not summarize arguments or legal conclusions. Rather, the Note to the File must merely list the issues discussed and indicate any agreement that may have been reached. If no agreement was reached, that should be noted also.

If an examining attorney does not respond to a telephone or email message within two business days, the applicant may telephone the law office manager or supervisor. Contact information is available on the U S P T O w e b s i t e a t <https://www.uspto.gov/trademark/contact-trademarks/other-trademark-contact-information>.

## 709.05 Informal Communications

An applicant may conduct informal communications with an examining attorney regarding a particular application by telephone or email (*see* [TMEP §§304.01–304.02](#), [709.04](#)). Informal communications should be conducted only if they serve to develop and clarify specific issues and lead to a mutual understanding between the examining attorney and the applicant. For example, an applicant may telephone or send an email regarding:

- Questions regarding an outstanding Office action that do not constitute a response;
- Authorization to issue an examiner's amendment or priority action (*see* [TMEP §§707.01](#), [708.01](#));
- Objection to an examiner's amendment (*see* [TMEP §§707](#), [707.02](#));
- Notification of termination of a cancellation proceeding that is the basis for suspension (*see* [TMEP §716.02\(a\)](#)); or
- A request to arrange a convenient time to speak by telephone.

Informal communications may not be used to request advisory opinions as to the likelihood of overcoming a substantive refusal. The examining attorney should advise the applicant to file a formal response for consideration of arguments regarding any substantive refusal. For a legal opinion about any trademark matter, a party must consult a private trademark attorney. [TMEP §1805](#).

If the examining attorney determines that continuing (or prolonged) informal communications by telephone or email will not serve to further develop and clarify specific issues and lead to a mutual understanding between the examining attorney and the applicant, the examining attorney must advise the applicant to file a formal response.

An informal communication does not extend the deadline for response and does not constitute a response to an outstanding Office action except as specified elsewhere. *See, e.g.*, [TMEP §§716.02\(a\)](#), [716.02\(j\)](#).

Relevant email and phone communications must be made part of the record, because the USPTO uses them in decision making, and anything used in decision making must be made of record. [37 C.F.R. §2.191](#).

Therefore, the examining attorney must upload all relevant email communications and must enter a Note to the File (also referred to as a Public Note or Notation to File) regarding issues discussed by telephone. *See* [TMEP §709.04](#) for further information about Notes to the File.

The applicant should monitor the status of an application after an informal communication to avoid abandonment. For example, if the applicant expects an examiner's amendment or priority action to be issued and the status does not show that it has been sent, the applicant should promptly contact the examining attorney to inquire. Reviewing the status may be done through the Trademark Status and Document Retrieval (TSDR) database at <http://tsdr.uspto.gov/>, or by calling the Trademark Assistance Center (TAC) at (571) 272-9250 or (800) 786-9199. *See* [TMEP §108.03](#) and [§1705.05](#) regarding the duty to monitor the status of an application in cases where a notice or action from the USPTO is expected.



## 709.06 Interviews Prior to Filing Application

No interviews are permitted before the filing of an application. If a party has general questions about how to file an application, the party can call the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199. *See* [TMEP §108.02](#).

USPTO employees cannot give advice on trademark law. It is inappropriate for USPTO personnel to give legal advice, to act as a counselor for individuals, or to recommend a qualified practitioner. [37 C.F.R. §2.11](#).

## 709.07 Decorum Required in Communications with the Office

An applicant, registrant, attorney, or party is required to conduct their business before the Office with decorum and courtesy. *See* [37 C.F.R. §2.192](#). The Office will review all oral or written communications received, but may decline to consider or respond to any communication containing abusive, offensive, threatening, or otherwise discourteous remarks directed to the Office or any of its staff. Similarly, Office staff may terminate any communication or other interaction if the person makes abusive, offensive, or threatening statements or engages in threatening or otherwise inappropriate behavior. *See* [37 C.F.R. §2.192](#). In addition, documents may not be submitted to the Office for any improper purpose, such as for harassment or to delay or burden prosecution. [37 C.F.R. §11.18\(b\)\(2\)\(i\)](#).

If a document submitted in a trademark matter contains discourteous remarks, the examining attorney may refer it to the Deputy Commissioner for Trademark Examination Policy for review. If it is determined that the document violates [37 C.F.R. §2.192](#), the Office will send notice that the document will not be considered and remove the document from the application or registration file. If it is further determined that the document was submitted in violation of [37 C.F.R. §11.18\(b\)\(2\)\(i\)](#), the Office may take such other actions or sanctions as deemed appropriate. *See* [37 C.F.R. §11.18\(c\)](#). In addition, any threatening communications may be reported to the Federal Protective Service for further investigation.

## 710 Evidence

### 710.01 Evidence Supporting Refusal or Requirement

In general, the examining attorney's refusal or requirement must ultimately be supported with relevant evidence. The examining attorney must ensure that an Office action makes proper citations to any supporting evidence.

All evidence that the examining attorney relies on in making a requirement or refusal must be placed in the record and copies must be sent to the applicant.

In appropriate cases, the examining attorney may also present evidence that may appear contrary to the USPTO's position, with an appropriate explanation as to why this evidence was not considered controlling.

In some cases, this may foreclose objections from an applicant and present a more complete picture if there is an appeal. *Cf. In re Federated Dep't Stores Inc.*, 3 USPQ2d 1541, 1542 n.2 (TTAB 1987) (noting that the examining attorney is not obligated to provide every story found in a LexisNexis® search though it may present a more complete picture).



## 710.01(a) Evidence from Research Database

If evidence is obtained from a research database, the record should include an indication of the specific search that was conducted. The record should indicate the libraries and/or files that were searched and the results. If the examining attorney does not review all of the documents located in a search, the record should indicate the number of documents that were reviewed. The search summary should be made a part of the record and will provide most of this information. Information not indicated on the search summary, such as the number of documents viewed, should be stated in narrative in the Office action. The Office action should include a citation to the research service, indicating the service, the library and the file searched, and the date of the search (e.g., "LEXIS®, News and Business, All News (Sept. 25, 2009)").

When evidence is obtained from a research database, the examining attorney does not have to make all stories of record. It is sufficient to include only a portion of the search results, as long as that portion is a representative sample of what the entire search revealed. *In re Vaughan Furniture Co.*, 24 USPQ2d 1068, 1069 n.2 (TTAB 1992). See also *In re Federated Dep't Stores Inc.*, 3 USPQ2d 1541, 1542 n.2 (TTAB 1987).

However, for evidence obtained from the LexisNexis® surname database, the evidence must show the total number of occurrences of a particular surname that were found in the database. This database is a regularly updated nationwide directory of mobile phone numbers and other numbers (such as VOIP numbers) and the names with which they are associated. See [TMEP §1211.02\(b\)\(i\)](#) regarding telephone directory listings, [§1211.02\(b\)\(ii\)](#) regarding LexisNexis® research databases, and [TMEP §1211.02\(b\)\(iii\)](#) regarding the U.S. Census's surname database as evidence of the surname significance of a term.

See [TMEP §710.01\(b\)](#) regarding evidence originating in foreign publications.

## 710.01(b) Internet Evidence

Articles obtained from the Internet, websites, and blog posts are "admissible as evidence of information available to the consuming public and of the way in which a term is being used or would be understood by the relevant public." *In re Wal-Mart Stores, Inc.*, 129 USPQ2d 1148, 1157 (TTAB 2019) (citing *In re Bayer AG*, 488 F.3d 960, 966, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007)); see also *In re Geller*, 751 F.3d 1355, 1360, 110 USPQ2d 1867, 1870 (Fed. Cir. 2014); *In re Reed Elsevier Props. Inc.*, 482 F.3d 1376, 1380, 82 USPQ2d 1378, 1381 (Fed. Cir. 2007). Examining attorneys are not required to establish that evidence from online sources or websites have significant web traffic. *In re Wal-Mart Stores, Inc.*, 129 USPQ2d at 1156-57. However, the probative value of certain Internet evidence may warrant additional scrutiny and be challenged with evidence that may impact the probative value the Trademark Trial and Appeal Board (Board) accords the source. *Id.* at 1157 (citing *In re Country Music Ass'n Inc.*, 100 USPQ2d 1824, 1829-30 (TTAB 2011)).

Providing only a website address or hyperlink to Internet materials is insufficient to make such materials of record. *In re Weiss*, Ser. No. 88621608, 2024 TTAB LEXIS 277, at \*3-4 (2024); *In re ADCO Indus.-Techs., L.P.*, Ser. No. 87545258, 2020 TTAB LEXIS 7, at \*4 (2020) (citing *In re Olin Corp.*, Ser. No. 86651083, 2017 TTAB LEXIS 337, at \*15 n.15 (2017); *In re HSB Solomon Assocs., LLC*, Ser. No. 77136242, 2012 TTAB LEXIS 79, at \*9 (2012); [TBMP §1208.03](#)); *In re Powermat Inc.*, Ser. No. 77715011, 2013 TTAB LEXIS 5, at \*5 (2013). Because of the transitory nature of Internet postings, websites referenced only by address or hyperlinks may be modified or deleted at a later date without notification. See *Safer v. OMS Invs. Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010). Thus, information identified only by website address or hyperlink

would not be subject to verification by the applicant to corroborate or refute. *See In re HSB Solomon Assocs., LLC*, 2012 TTAB LEXIS 79, at \*9.

Therefore, when making Internet evidence part of the record, the examining attorney or applicant must provide (1) an image of the webpage, (2) the date the evidence was downloaded or accessed from the Internet, and (3) the complete URL address. *See In re ADCO Indus.-Techs., L.P.*, 2020 TTAB LEXIS, at \*4 (citing *In re I-Coat Co.*, 126 USPQ2d 1730, 1733 (TTAB 2018)); *In re Mueller Sports Med., Inc.*, 126 USPQ2d 1584, 1587 (TTAB 2018); *see also Safer Inc.* 94 USPQ2d at 1039. If either party fails to satisfy the requirements for submission of Internet evidence, and the other party objects, the Internet material will not be considered. *See In re Mueller Sports Med., Inc.*, 126 USPQ2d at 1587. If, on the other hand, a party fails to satisfy these requirements, and the other party fails to object, the Board may consider the Internet evidence for whatever probative value it may have. *See id.* at 1586.

The examining attorney must object to improperly submitted Internet evidence in the first Office action following the submission of the evidence and advise the applicant how to properly make the Internet evidence of record. *See In re Mueller Sports Med., Inc.*, 126 USPQ2d at 1587. Otherwise, the Board may consider the objection to be waived. *Id.*; *cf. In re ActiveVideo Networks, Inc.*, 111 USPQ2d 1581, 1594 n.40 (TTAB 2014) (objection waived where examining attorney, in a continuing refusal, failed to advise applicant that mere listing of third-party registrations was insufficient to make them of record). In addition, if the applicant appeals, the examining attorney's appeal brief must indicate that the objection to the improperly submitted evidence is continued, or else the Board has the discretion to consider it. *See In re I-Coat Co.*, 126 USPQ2d at 1733 (citing *In re Mueller Sports Med., Inc.*, 126 USPQ2d at 1587).

Evidence from a "cached" or stored website may be admissible if properly made of record and there is no evidence indicating that the website is inactive. *See In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1593-95 (TTAB 2018) (finding cached website evidence was not probative in view of applicant's evidence that the website was no longer active).

A list of Internet search results generally has little probative value, because such a list does not show the context in which the term is used on the listed web pages. *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1715 (TTAB 2011); *see In re Bayer AG*, 488 F.3d at 967, 82 USPQ2d at 1833 (deeming Google® search results that provided very little context of the use of ASPIRINA to be "of little value in assessing the consumer public perception of the ASPIRINA mark"); *In re Tea & Sympathy, Inc.*, 88 USPQ2d 1062, 1064 n.3 (TTAB 2008) (finding truncated Google® search results entitled to little probative weight without additional evidence of how the searched term is used); *In re Thomas*, 79 USPQ2d 1021, 1026 (TTAB 2006) (rejecting an applicant's attempt to show weakness of a term in a mark through citation to a large number of Google® "hits" because the "hits" lacked sufficient context); *In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1050 (TTAB 2006) (noting that web page links "do little to show the context within which a term is used on the web page that could be accessed by the link"); *In re Remacle*, 66 USPQ2d 1222, 1223 n.2 (TTAB 2002) (finding the print-out of Internet search results to be of little probative value due to insufficient text to determine the nature of the information or its relevance); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060 (TTAB 2002) (noting that "[e]vidence of actual use of a phrase by a website has far greater probative value" than a search summary). The examining attorney should attach copies of the website pages that show how the term is actually used.

Information originating on foreign websites or in foreign news publications that are accessible to the U.S. public (i.e., written in the English language or have an optional English-language version) may be relevant to discern U.S. consumer impression of a proposed mark. *In re Bayer AG*, 488 F.3d at 969, 82 USPQ2d at 1835; *In re Jasmin Larian, LLC*, 2022 USPQ2d 290, at \*33-34 (TTAB 2022); *In re Odd Sox LLC*, 2019 USPQ2d 370879, at \*5 (TTAB 2019); *In re Well Living Lab Inc.*, 122 USPQ2d 1777, 1781 n.10 (TTAB 2017).

. The probative value of such evidence will vary depending upon the context and the manner in which the term is used. *See In re Canine Caviar Pet Foods*, 126 USPQ2d at 1596.

In *Bayer*, NEXIS® evidence that originated in foreign publications was deemed to be of “some probative value with respect to prospective consumer perception in the United States,” the Court noting “the growing availability and use of the internet as a resource for news, medical research results, and general medical information.” 488 F.3d at 969, 82 USPQ2d at 1835. In *Remacle*, the Board held evidence from a website in Great Britain admissible, noting that:

[I]t is reasonable to assume that professionals in medicine, engineering, computers, telecommunications and many other fields are likely to utilize all available resources, regardless of country of origin or medium. Further, the Internet is a resource that is widely available to these same professionals and to the general public in the United States. Particularly in the case before us, involving sophisticated medical technology, it is reasonable to consider a relevant article from an Internet web site, in English, about medical research in another country, Great Britain in this case, because that research is likely to be of interest worldwide regardless of its country of origin.

66 USPQ2d at 1224 n.5.

In *King Koil*, the Board gave only “limited probative value” to the contents of websites of commercial entities outside the United States showing use of the term “breathable” in relation to mattresses and bedding, stating that:

[C]onsumers may visit foreign web sites for informational purposes, even if they are more likely to focus on internet retailers that can easily ship items or make items available for pick up in a store in a location convenient to the purchaser. That would appear especially likely in a case such as this, where the item in question, a mattress, is large and potentially more expensive to ship than a smaller item. Accordingly, while we do not discount entirely the impact of foreign web sites in this case, we find them of much more limited probative value than in the *Remacle* case.

79 USPQ2d at 1050; *see also In re Nieves & Nieves LLC*, 113 USPQ2d 1639, 1642 (TTAB 2015) (finding that articles from non-U.S. publications have some probative value because the case concerns the perception of the relevant consumers, i.e., the general U.S. public, regarding the identity of a celebrity who lives and travels outside of the United States); *In re Cell Therapeutics, Inc.*, 67 USPQ2d 1795, 1797–98 (TTAB 2003) (relying on NEXIS® items from foreign wire services to support a refusal and distinguishing earlier decisions that accorded such evidence little probative value given the sophisticated public and the widespread use of personal computers that increase access to such sources).

With respect to evidence taken from the online Wikipedia® encyclopedia, at [www.wikipedia.org](http://www.wikipedia.org), the Board has noted that “[t]here are inherent problems regarding the reliability of Wikipedia entries because Wikipedia is a collaborative website that permits anyone to edit the entries,” and has stated as follows:

[T]he Board will consider evidence taken from Wikipedia so long as the non-offering party has an opportunity to rebut that evidence by submitting other evidence that may call into question the accuracy of the particular Wikipedia information. Our consideration of Wikipedia evidence is with the recognition of the limitations inherent with Wikipedia (e.g., that anyone can edit it and submit intentionally false or erroneous information) . . .

As a collaborative online encyclopedia, Wikipedia is a secondary source of information or a compilation based on other sources. As recommended by the editors of Wikipedia, the information in a particular article should be corroborated. The better practice with respect to Wikipedia evidence is to corroborate the information with other reliable sources, including Wikipedia's sources.

*In re IP Carrier Consulting Grp.*, 84 USPQ2d 1028, 1032–33 (TTAB 2007); *see also In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1633 n.6 (TTAB 2018) (stating that the Board will consider Wikipedia® excerpts submitted with a denial of a request for reconsideration because an applicant has an opportunity to rebut entry of the excerpts by requesting remand to submit rebutting evidence).

Similarly, with respect to evidence taken from the online dictionary of slang terms, Urban Dictionary®, the Board has noted that Urban Dictionary® entries suffer from the same potential reliability problems as Wikipedia because it is “a collaborative website that permits anyone to submit or edit a definition.” *In re Lizzo LLC*, 2023 USPQ2d 139, at \*4 (TTAB 2023) (quoting *In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059, 2061 n.3 (TTAB 2013)). The Board has stated that it “will consider dictionary definitions taken from Urban Dictionary so long as the non-offering party has an opportunity to rebut that evidence by submitting other definitions that may call into question the accuracy of the particular Urban Dictionary definitions.” *Id.*

Given its inherent limitations, any information obtained from Wikipedia® or Urban Dictionary® should be treated as having limited probative value. If the examining attorney relies upon Wikipedia® or Urban Dictionary® evidence and makes it of record, then additional supportive and corroborative evidence from other sources should also be made of record, especially when issuing final actions.

The examining attorney should check applicant's own website for information about the goods or services. Material obtained from applicant's website is “generally acceptable as competent evidence.” *In re NextGen Mgmt., LLC*, Ser. No. 88098031, 2023 TTAB LEXIS 1, at \*2-3 (2023). In *In re Promo Ink*, 78 USPQ2d 1301, 1303 (TTAB 2006), the Board rejected applicant's argument that it was improper for the examining attorney to rely on evidence obtained from applicant's website when the application was based on intent to use and no specimens were yet required. According to the Board, “[T]he fact that applicant has filed an intent-to-use application does not limit the examining attorney's evidentiary options, nor does it shield an applicant from producing evidence that it may have in its possession.” *Id.*; *see also In re Reed Elsevier Props. Inc.*, 482 F.3d 1376, 1379, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007); *In re Ameritox Ltd.*, 101 USPQ2d 1081, 1084–85 (TTAB 2011) .

Electronic-only documents are considered to be original publications, and scanned images are considered to be copies of original publications. Internet Usage Policy Notice, 64 Fed. Reg. 33056, 33063 (June 21, 1999).

See [TBMP §1208.03](#) for further information regarding the use of material obtained through the Internet in ex parte proceedings.

### **710.01(c) Record Must Be Complete Prior to Appeal**

The record in any application should be complete prior to appeal. [37 C.F.R. §2.142\(d\)](#); *In re Weiss*, Ser. No. 88621608, 2024 TTAB LEXIS 277, at \*4 (2024); [TMEP §1501.02\(b\)](#); *see In re ADCO Indus.-Techs., L.P.*, Ser. No. 87545258, 2020 TTAB LEXIS 7, at \*4 (2020). Accordingly, if an examining attorney or applicant attempts to introduce new evidence at the time of the appeal, the new evidence will generally be excluded from the record. [TBMP §1207.01](#); *see, e.g., In re tapio GmbH*, 2020 USPQ2d 11387, at \*3-4

(TTAB 2020); *In re Medline Indus., Inc.*, 2020 USPQ2d 10237, at \*2 (TTAB 2020). However, the Trademark Trial and Appeal Board may consider evidence submitted after appeal, despite its untimeliness, if the non-offering party: (1) does not object to the evidence; *and* (2) discusses the evidence or otherwise treats it as being of record. See [TBMP §1207.03](#) and cases cited therein. Therefore, examining attorneys and applicants should, as appropriate: (a) object to the new evidence but not substantively discuss it; (b) object to the new evidence and, while preserving the objection, discuss why it in any event does not support the offeror's position; or (c) consider the new evidence.

Whenever an examining attorney objects to evidence submitted by an applicant, the objection should be raised as soon as possible and continued in the examining attorney's brief, or the Board may consider the objection to be waived. See *In re City of Hous.*, 101 USPQ2d 1534, 1536 (TTAB (2012) (citing *In re Broyhill Furniture Indus., Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001)), *aff'd*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013) .

If the applicant or examining attorney wishes to introduce new evidence at the time of or during appeal, the party seeking to introduce the new evidence may request the Board to suspend the appeal and remand the case. [37 C.F.R. §2.142\(d\)](#); *In re Weiss*, 2024 TTAB LEXIS 277, at \*3. See [TBMP §1207.02](#) and [TMEP §1504.05](#) regarding requests for remand.

The Board may take judicial notice of dictionary definitions, including “online dictionaries that exist in printed format or regular fixed editions,” which were not made of record prior to appeal, and may do so either sua sponte or upon request of the applicant or examining attorney. *In re NextGen Mgmt., LLC*, Ser. No. 88098031, 2023 TTAB LEXIS 1, at \*2-3 (2023); *Pierce-Arrow Soc’y v. Spintek Filtration, Inc.*, 2019 USPQ2d 471774, at \*4 n.23 (TTAB 2019) (citing *Univ. of Notre Dame du Lac v. J.C. Goumet Food Imp. Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006)); See [TBMP §1208.04](#). However, the better practice is to ensure that the relevant material is included in the record prior to appeal. When requesting that the Board take judicial notice of a dictionary definition, the examining attorney must provide sufficient information regarding the source of the definition (e.g., a copy of the title page of the dictionary). See *In re Gregory*, 70 USPQ2d 1792, 1793 (TTAB 2004) (declining to take judicial notice of dictionary definitions submitted with examining attorney's appeal brief, because neither the photocopied pages nor the examining attorney's brief specified the dictionaries from which the copies were made); [TBMP §1208.04](#).

The Board will generally not take judicial notice of online dictionaries not available in a printed format unless the online dictionary is the equivalent of a print reference work, has regular fixed editions, or is otherwise readily available and verifiable. [TBMP §1208.04](#); see *In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1768 (TTAB2016) (taking judicial notice of definitions from an online dictionary that was also available in printed form, but refusing to take judicial notice of definitions from commercial websites, Wikipedia, and other unidentified online sources); *In re Red Bull GmbH*, 78 USPQ2d at 1378 (taking judicial notice of an *Encarta Dictionary* definition, because the dictionary was a widely known reference, readily available in specifically denoted editions via the Internet and CD-ROM and thus was “the electronic equivalent of a print publication,” which could be easily verified; refusing to take judicial notice of a definition from [www.wordsmyth.net](#), because the source of the definition was not identified on the submitted website excerpt or by the examining attorney and thus could not be verified); *In re CyberFinancial.Net, Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB2002) (taking judicial notice of online dictionary that was also available in printed form); *In re Total Quality Grp., Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999) (declining to take judicial notice of online dictionary that did not exist in printed format, because the source was unknown and the Board was unsure whether the dictionary was readily available or reliable, stating that the evidence should have been made of record prior to appeal, so applicant would have the opportunity to check the reliability of the evidence and offer rebuttal evidence).



## 710.02 Search for Evidence Indicating No Refusal or Requirement Necessary

USPTO practice is to indicate the results of a search for evidence when the examining attorney considers an issue and determines that no action will be taken on it. This information is helpful for internal review. A Note to the File (also referred to as a Public Note or Notation to File) should be entered in the record to reflect that a search for evidence was conducted in any case in which the examining attorney determines that a search would be useful for review of the application, but that no further action is required.

The examining attorney should simply note the parameters of the search conducted *without stating any opinions or conclusions*.

For instance, in the case of a search of telephone directories for surnames, the record should indicate only the directories investigated and the number of occurrences of the surname. Or, in the case of a search for the meaning of a term, the record should show the sources checked and whether the term was found.

The Note to the File should **not** provide any of the examining attorney's analysis, opinions, or conclusions regarding the evidence when the examining attorney determines that a refusal or requirement is not appropriate. Nor should the examining attorney place in the record copies of email messages or other communications between the examining attorney and other USPTO personnel concerning the application. And the examining attorney should not refer to, or place copies of, any registration or pending application that was considered in a §2(d) search, unless the examining attorney determines that there is a conflict and issues an Office action based on the application or registration.

## 710.03 Evidence of Third-Party Registrations

The Trademark Trial and Appeal Board (Board) does not take judicial notice of registrations or the contents of application and registration files, and the submission of a list of registrations does not make these registrations part of the record. *In re Seminole Tribe of Fla.*, 2023 USPQ2d 631, at \*2 (TTAB 2023) (quoting [TBMP §1208.04](#)); *In re House Beer, LLC*, 114 USPQ2d 1073, 1075 (TTAB 2015) (citing *Edom Lab'ys, Inc. v. Lichter*, 102 USPQ2d 1546, 1550 (TTAB 2012) (the Board does not take judicial notice of records residing in the USPTO)). Furthermore, the submission of a copy of a commercial search report is not proper evidence of third-party registrations. *In re Hub Distrib., Inc.*, 218 USPQ 284, 285 (TTAB 1983).

To make a third-party registration of record, or a registration owned by the applicant or registrant not the subject of the appeal, a copy of the registration (from either the electronic records of the Office or the paper USPTO record) must be submitted. *In re Ruffin Gaming LLC*, 66 USPQ2d 1924, 1925 n.3 (TTAB 2002) ; *In re Volvo Cars of N. Am. Inc.*, 46 USPQ2d 1455, 1456 n.2 (TTAB 1998) ; *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1561 n.6 (TTAB 1996) ; *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994) . See [TBMP §1208.02](#).

If the applicant's response includes improper evidence of third-party registrations, the examining attorney must object to the evidence in the first Office action following the response. Otherwise the Board may consider the objection to be waived. See *In re City of Hous.*, 101 USPQ2d 1534, 1536 (TTAB 2012) (finding that the examining attorney's failure to advise applicant of the insufficiency of the list of registrations when it was proffered during examination constituted a waiver of any objection to consideration of that list); *In re 1st USA Realty Pros., Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007) (allowing evidence of a list of third-party registrations because the examining attorney did not advise applicant of the insufficiency of the list while there was still time to correct the mistake); *In re Broyhill Furniture Indus., Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001) (finding examining attorney's objection to a listing of third-party registrations waived

because it was not raised in the Office action immediately following applicant's response in which applicant's reliance on the listing as evidence was indicated). If the applicant files an appeal, the examining attorney should continue the objection to the evidence in their appeal brief.

Note that third-party applications have no probative value other than as evidence that the applications were filed. *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1270 n.8 (TTAB 2009) ; *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1366 n.7 (TTAB 2007) ; *In re 1st USA Realty Pros., Inc.*, 84 USPQ2d at 1583; *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1049 n.4 (TTAB 2002) ; [TBMP §1208.02](#).

## 711 Deadline for Response to Office Action

*Section 1 and/or 44 Applications – Three-month Response Period, With an Option to Extend the Time to Respond*. For §1 and/or §44 applications, the response period for an examining attorney's Office action is three months from the Office action issue date. [15 U.S.C §1062\(b\)\(2\)](#); [37 C.F.R §2.62\(a\)\(1\)\(i\)](#). An applicant may, before filing any response, make one request for a three-month extension of the deadline. See [15 U.S.C §1062\(b\)\(3\)](#); [37 C.F.R §2.62\(a\)\(2\)](#). See [TMEP §711.01](#) regarding requests for an extension of time to respond. If granted, the response period will be extended to six months from the Office action issue date

*Section 66(a) Applications – Six-month Response Period*. For §66(a) applications, the response period for an examining attorney's Office action is six months from the Office action issue date. [15 U.S.C. §1062\(b\)\(2\)](#); [37 C.F.R. §2.62\(a\)\(1\)\(ii\)](#). In a §66(a) application, a response to an Office action must be sent to the USPTO, not the IB, and is due in the USPTO within six months of the date on which the USPTO sends the action to the IB, not the date on which the IB processes the refusal. See [TMEP §1904.02\(h\)](#) for further information about Office actions and responses in §66(a) applications.

An applicant may not request an extension of time to respond to any Office action for a §66(a) application. The maximum time period for response to an Office action is six months from the Office action issue date. [15 U.S.C §1062\(b\)\(2\)-\(3\)](#).

The examining attorney has no discretion to extend the response period. Thus, the applicant must file a response within the applicable time period unless the examining attorney has issued a supplemental action resetting the period for response. See [TMEP §711.03](#) regarding supplemental Office actions.

Generally, responses to Office actions must be filed through the trademark electronic filing system. See [37 C.F.R §§2.23\(a\), 2.62\(c\), 7.25](#); [TMEP §§301.01, TMEP §301.01\(a\)](#).

Filing an amendment to allege use does not stay or extend the deadline for filing a response to an outstanding Office action, appeal to the Board, or petition to the Director. [37 C.F.R. §2.63\(d\)](#); [TMEP §1104](#). Filing an assignment or other ownership document is not considered a response to an outstanding Office action. [TMEP §503.01\(d\)](#).

See [TMEP §310](#) for information about computing the response period, and [§718.02](#) and [§§718.03–718.03\(a\)](#) regarding abandonment for failure to respond or incomplete response to an Office action.

### 711.01 Request for Extension of Time to Respond

Under [37 C.F.R §2.62\(a\)\(2\)](#), an applicant may request one three-month extension of the time to respond, subject to payment of the applicable fee. If granted, the response deadline, including the deadline to file a notice of appeal, if applicable, will be extended to six months from the Office action issue date.



Only one request for an extension of time to respond may be filed for each Office action with a three-month response period. The total time period for response may not be extended beyond six months from the Office action issue date. See [15 U.S.C §1062\(b\)\(3\)](#); [37 C.F.R §2.62\(a\)\(2\)](#).

No extensions of time to respond are available for Office actions for a §66(a) application. See [TMEP §711](#).

### **711.01(a) Requirements for Request for Extension of Time to Respond**

A complete request for an extension of time to respond must include: (1) a written request for an extension from the applicant, filed before the expiration of the three-month response period; and (2) payment of the fee required by [37 C.F.R §2.6\(a\)\(28\)](#).

Applicants must file the request for an extension of time to respond through the trademark electronic filing system, unless an exception to the requirement to file electronically applies. See [37 C.F.R §§2.23\(a\)](#), [2.62\(c\)](#); [TMEP §301.01](#). See [TMEP §301.02](#) regarding the limited exceptions for paper submissions.

The Request for Extension of Time to File a Response form must be used for this purpose. The submission must be properly signed by someone with firsthand knowledge of the facts pertaining to the request for an extension of time to respond. See [TMEP §611.03\(a\)](#) regarding who can sign a verification.

Any request for an extension of time to respond that is not accompanied by the applicable fee, or any request filed using a form other than the Request for Extension of Time to File a Response form in the trademark electronic filing system, will be treated as a non-responsive communication and given no effect. See [TMEP §301.01\(b\)](#) regarding trademark electronic filing system availability and [§719](#) for information about non-responsive communications.

### **711.01(b) Time for Filing a Request for Extension of Time to Respond**

To be considered timely, a complete request for an extension of time to respond must be received by the USPTO on or before the end of the three-month response period. [37 C.F.R §2.62\(a\)\(2\)](#).

In addition, the request for an extension of time to respond must be filed *before* filing any response. In the context of a request for an extension of time to respond, a response includes a notice of appeal to the Trademark Trial and Appeal Board. Therefore, no extension of time to respond will be granted following the filing of a notice of appeal as to the preceding final Office action. However, the filing of an amendment to allege use (see [TMEP §1104](#)), a request to divide (see [TMEP §1110.08](#)), or a Change Address or Representation (CAR) form does not generally constitute a response to an outstanding Office action. See also [TMEP §719](#) regarding communications that are treated as “non-responsive communications.”

Furthermore, a request for an extension of time to respond only extends the response deadline for the particular Office action to which it applies. Each Office action that issues with a new three-month response period sets a new time for filing an extension of time to respond as to that Office action. For example, a supplemental Office action (see [TMEP §711.03](#)) or a subsequent final action in which an appeal has not previously been filed (see [TMEP §715.03\(b\)](#)) are Office actions that begin a new three-month response period and therefore set a new time for filing a request for an extension of time to respond. See [TMEP §711.02](#) regarding Office actions that do not begin a new response period and where the response period runs from the date of a previous Office action and [§715.04\(b\)](#) regarding subsequent final actions that do not begin a new response period.

Consider the following examples:

Example: If an Office action was issued on December 6, 2022, and the applicant timely files a complete request for an extension of time to respond on or before March 6, 2023, prior to filing a response, the applicant has until June 6, 2023, to file a response. If the applicant later files a response within the extended response period and a notice of incomplete response must issue, the relevant deadline is 30 days from the issuance of the notice of incomplete response or June 6, 2023, whichever is longer.

Example: An Office action was issued on December 6, 2022, and the applicant filed a response on December 13, 2022. No timely request for an extension of time to respond was filed prior to the response. If the examining attorney issues a 30-day letter following review of the response, the relevant deadline is 30 days from the issuance of the 30-day letter or the remainder of the original three-month response period (March 6, 2023), whichever is longer. No request for an extension of time to respond may be filed because the applicant has already submitted a response.

Example: If a final Office action was issued on December 6, 2022, and the applicant files a request for reconsideration on March 6, 2023, but did not file a request for an extension of time to respond prior to filing the request for reconsideration, the end of the response period and time for filing an appeal is March 6, 2023. No request for an extension of time to respond may be filed because the applicant has already filed a response.

Similarly, if the applicant filed a notice of appeal on or before March 6, 2023, the notice of appeal constitutes a response, and no request for an extension of time to respond may be filed.

If the examining attorney later issues a nonfinal Office action, the nonfinal Office action begins a new three-month response period. The applicant may file a request for an extension of time to respond as to that Office action, provided it is filed before the applicant submits a response.

## 711.02 Time May Run from Previous Action

In most cases, the period to respond to an Office action runs from the issuance date of the Office action. In some situations, the examining attorney's Office action does not re-start the beginning of a new response period. For example, a notice that an applicant's response was incomplete (*see* [TMEP §718.03](#)), or a notice that an applicant's request for reconsideration of a final action fails to overcome a refusal or satisfy an outstanding requirement (*see* [TMEP §715.03\(c\)](#)), does not begin a new response period. In all cases in which the response period runs from the date of a previous Office action, the examining attorney must include a statement to that effect in the Office action, and must omit the response clause.

## 711.03 Supplemental Office Action Resetting Response Period

Sometimes the examining attorney must issue a supplemental Office action that resets the period for response.

If the examining attorney discovers after issuing an action that a refusal or requirement that should have been raised was overlooked, the examining attorney must issue a supplemental Office action addressing the issue and resetting the period for response. *See* [TMEP §706](#). The examining attorney must also issue a supplemental Office action if a new issue arises after the issuance date of a previous Office action (e.g., during examination of an amendment to allege use).

If the examining attorney issues a supplemental Office action, a new response period will begin running from the issuance date of the supplemental action. *See* [15 U.S.C. §1062\(b\)](#). In a supplemental Office action, the examining attorney should: (1) indicate that the action is supplemental to and supersedes the previous action; (2) specifically identify all of the outstanding refusals and/or requirements; and (3) include a response clause (*see* [TMEP §705.08](#)).

When the examining attorney must issue a supplemental Office action in a §1 and/or §44 application to address a refusal or requirement that should have been raised in the previous Office action, and the applicant was granted an extension of time to respond to the previous Office action, the USPTO will refund the fee for the extension of time to respond if the response period for the supplemental Office action is earlier than the extended response period for the previous Office action. The examining attorney will submit the request

to TM Finance with the information necessary for processing the refund. See [TMEP §405.04](#) regarding refunds and [§711.01](#) regarding requests for an extension of time to respond to an Office action.

In a §66(a) application, the examining attorney cannot issue a new refusal more than 18 months after the date on which the IB forwards the request for extension of protection to the USPTO. [15 U.S.C. §1141h\(c\)](#); [TMEP §1904.03\(a\)](#).

See [TMEP §717](#) regarding reissuing of Office actions.

## **712 Signature on Response to Office Action**

A response to an Office action must be personally signed by the proper party; that is, a qualified U.S. attorney or, if the applicant is neither represented by a qualified attorney nor required to be represented by one, by the individual applicant or someone with legal authority to bind a juristic applicant (e.g., a corporate officer, or a general partner of a partnership). [37 C.F.R. §§2.62\(b\), 2.193\(e\)\(2\), 11.18\(a\)](#).

The examining attorney must review the application record to determine whether the applicant is represented by a qualified U.S. attorney (*see* [37 C.F.R. §11.14](#)), and must ensure that all responses and amendments are properly signed. See [TMEP §611.03\(b\)](#) and [§712](#) regarding the proper person to sign a response, and [§§611.06-611.06\(h\)](#) as to persons who have legal authority to bind various types of juristic entities.

For a handwritten signature, the signatory must personally sign their name. See [37 C.F.R. §2.193\(a\)\(1\)](#); [TMEP §611.01\(b\)](#). For an electronic signature, the signatory must personally enter the elements of their electronic signature. See [37 C.F.R. §2.193\(a\)\(2\), \(c\)\(1\)](#); [TMEP §611.01\(b\), \(c\)](#).

The first and last name and the title or position of the person who signs the response must be set forth immediately below or adjacent to the signature. [37 C.F.R. §2.193\(d\)](#); [TMEP §611.01\(b\)](#).

### **712.01 Persons Who May Sign Response**

The response must be properly signed in accordance with the guidelines in [TMEP §611.03\(b\)](#). See [TMEP §§611.06-611.06\(h\)](#) for persons with legal authority to bind various types of juristic entities and [§§602-602.03\(c\)](#) regarding persons qualified to represent others before the USPTO in trademark matters.

When it appears that a response to an Office action is signed by an improper party, the examining attorney must follow the procedures in [TMEP §§611.05-611.05\(c\)](#). See [TMEP §611.04](#) for examples of authorized and potentially unauthorized signatories.

### **712.02 Unsigned Response**

The examining attorney should treat an unsigned response as an incomplete response, and should either call the applicant to obtain permission to enter an examiner's amendment from an authorized party (if appropriate), or issue a notice of incomplete response granting the 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\(a\)\(2\)](#). See [TMEP §718.03\(b\)](#). To issue a notice of incomplete response, the examining attorney should use the "Notice of Non-Responsive Amendment" selection for a response to a nonfinal action or the "Continuing Final Action" selection if the response is to a final action. In either instance, the notice of incomplete response must not include a response clause.

If the applicant is neither required to be represented nor is represented by a qualified U.S. attorney and the response does not require a signed verification (*see* [TMEP §§804–804.05](#)), the applicant or a person with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner of a partnership) may either request that the amendment(s) be entered through an examiner's amendment or submit a properly signed copy of the response. However, if the applicant is required to be represented but has not appointed a qualified U.S. attorney, the applicant may not request the amendment be entered through an examiner's amendment. *See* [TMEP §§712-712.03](#). If the applicant is represented by a qualified U.S. attorney, that attorney must submit the response or request entry of an examiner's amendment. The examining attorney must defer action on the merits of the response until the applicant files a properly signed response.

The substitute response must be personally signed by a qualified U.S. attorney or, if the applicant is not represented by a qualified attorney, 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). [37 C.F.R. §§2.62\(b\), 2.193\(e\)\(2\), 11.18\(a\)](#); *see* [TMEP §611.03\(b\)](#).

If an applicant fails to submit a properly signed response within the time granted under [37 C.F.R. §2.65\(a\)\(2\)](#), the examining attorney must hold the application abandoned for failure to file a complete response. *See* [TMEP §718.03](#). In this situation, the applicant cannot file a petition to revive under [37 C.F.R. §2.66](#). The applicant's recourse is to file a petition to the Director to reverse the examining attorney's holding of abandonment under [37 C.F.R. §2.146](#). *See* [TMEP §1713.02](#).

### **712.03 Response Signed by an Improper Person**

*Notice of Incomplete Response.* When it appears that a response to an Office action was signed by an improper party (e.g., a foreign attorney who is not authorized to practice before the USPTO, a corporate employee who does not have legal authority to bind the applicant, or, when the applicant is represented by a qualified U.S. attorney, someone other than the attorney or another qualified attorney from the same firm), the examining attorney must treat the response as incomplete. The examining attorney must issue a notice of incomplete response granting the 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\(a\)\(2\)](#) (*see* [TMEP §§611.05\(a\), 718.03\(b\)](#)). Note that if the correspondence address was changed as the result of a submission by an unauthorized party, the examining attorney must ensure that the new address is removed from the Trademark electronic record and that the notice of incomplete response is sent to the last previous correct correspondence address. The examining attorney must defer action on the merits of the response until a properly signed response is filed.

*Applicant's Reply to Notice of Incomplete Response.* If the person who signed the response was authorized to sign, the applicant's reply to the notice of incomplete response should state the nature of the relationship of the signer to the applicant. If the signer has legal authority to bind the applicant, the person should so state, and should set forth the person's title or position, if not already provided. If the signer is an attorney authorized to practice before the USPTO pursuant to [37 C.F.R. §11.14\(a\)](#), the attorney should identify themselves as an attorney provide the attorney bar information required in [37 C.F.R. §2.17\(b\)\(3\)](#) (*see* [TMEP §602.01\(a\)](#)). If the signer meets the requirements of either [37 C.F.R. §11.14\(b\)](#) or [\(c\)](#), the person should explain how the signer meets these requirements. *See* [TMEP §611.05\(b\)](#) for further information.

If the person who signed the response is not an authorized signer, the applicant is unrepresented and not required to be represented, and all proposed amendments in the improperly signed response can be resolved by an examiner's amendment, the individual applicant or a person with legal authority to bind a juristic applicant may telephone or email the examining attorney to authorize such an amendment. *See* [TMEP §707.01](#). If the applicant is represented by a qualified U.S. attorney, the attorney must authorize an examiner's

amendment. *See id.* Otherwise, the applicant must submit a response signed by the applicant or someone with legal authority to bind the applicant (*see* [TMEP §712.01](#)), or by a qualified U.S. attorney. *See* [TMEP §611.01\(c\)](#) regarding signature of documents submitted through the trademark electronic filing system. When a response is signed by an unauthorized party, it is not acceptable for the applicant to ratify the response through an examiner's amendment.

*Unsatisfactory Response or No Response* . If no acceptable response is received within the time granted under [37 C.F.R. §2.65\(a\)\(2\)](#), the examining attorney must hold the application abandoned for failure to file a complete response. *See* [TMEP §718.03](#). In this situation, the applicant cannot file a petition to revive under [37 C.F.R. §2.66](#). The applicant's recourse is to file a petition to the Director to reverse the examining attorney's holding of abandonment under [37 C.F.R. §2.146](#). *See* [TMEP §1713.01](#) regarding the standard of review for reversing an examining attorney's holding of abandonment due to incomplete response.

## 713 Examination of Amendments and Responses to Office Actions

### *37 CFR §2.63(a) Repeated non-final refusal or requirement.*

After response by the applicant, the examining attorney will review all statutory refusals and/or requirement(s) in light of the response.

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

(2) If, after review of the applicant's response, the examining attorney issues a non-final action that contains no substantive refusals to register, but maintains any requirement(s), the applicant may respond to such repeated requirement(s) by filing a timely petition to the Director for relief from the repeated requirement(s) if the subject matter of the repeated requirement(s) is appropriate for petition to the Director (*see* § 2.146(b)).

The examining attorney will review all statutory refusals and/or requirements in light of the applicant's response and determine whether the mark may be approved for publication or registration. The examining attorney must carefully consider all arguments, comments, and amendments made or proposed by the applicant. *See* [TMEP §705.01](#) about including wording in an Office action to indicate the status of the application and acknowledge documents received, [TMEP §807.17](#) regarding the processing of unacceptable amendments to drawings, and [TMEP §1402.15](#) regarding the unacceptable amendments to identifications.

If the applicant's response has put the application in condition for approval for publication for opposition or registration on the Supplemental Register, the examining attorney will approve the application for publication or registration, as appropriate.

If the applicant's response has not put the application in condition for publication or registration, the examining attorney will issue an Office action, or telephone or email the applicant, depending on the circumstances.

If the applicant's response neither resolves all of the outstanding issues nor raises any new issues, and the applicant has had an opportunity to reply to all points raised by the examining attorney, the examining attorney's next action should be stated to be final. *See* [TMEP §§714–714.05\(f\)](#).

If the examining attorney has cited an earlier-filed conflicting application, and the applicant responds by arguing that there is no likelihood of confusion, the examining attorney should suspend the application pending disposition of the conflicting application, if applicant's arguments are not persuasive. *See* [TMEP §716.02\(c\)](#) regarding suspension pending disposition of an earlier-filed conflicting application, [TMEP §716.03](#) regarding the applicant's request to remove an application from suspension, and [TMEP §§1208–1208.02\(f\)](#) regarding conflicting marks in pending applications.

### **713.01 Previous Action by Different Examining Attorney**

When assigned to act on an application that was previously handled by a different examining attorney, the examining attorney should act consistently with the prior examining attorney, unless it would be clear error (*see* [TMEP §706.01](#)) to do so.

### **713.02 Noting All Outstanding Refusals or Requirements**

Every refusal or requirement made in a prior Office action that is still outstanding must be referenced in any subsequent action, including Notices of Suspension. In addition, when a particular refusal or requirement has been withdrawn, obviated, or satisfied because of applicant's response or otherwise, the examining attorney should notify the applicant in any action that immediately follows.

Noting all outstanding refusals and requirements is done only as a courtesy to prevent any misunderstanding. A refusal or requirement issued in a previous action remains in effect unless the examining attorney specifically indicates that it has been withdrawn, obviated, or satisfied. Thus, if an examining attorney issues an Office action that does not mention an outstanding refusal or requirement that was raised in a previous action, the refusal or requirement may nonetheless be made final in a subsequent action, if the application is otherwise in condition to be made final.

### **713.03 Response to Applicant's Arguments in Nonfinal Actions**

When the applicant submits arguments attempting to overcome a refusal or requirement, the examining attorney must respond to the applicant's arguments. See [TMEP §718.02\(a\)](#) for an examining attorney's response to an applicant's incomplete response to a partial nonfinal refusal or requirement and [§715.03](#) and [§715.04](#) for an examining attorney's response to an applicant's arguments in a request for reconsideration after final action.

In response to a refusal under §2(d) of the Trademark Act, [15 U.S.C. §1052\(d\)](#), the applicant may respond that the cited registration should be cancelled because the registrant has not filed the required maintenance documents.

The examining attorney must not withdraw a refusal of registration under §2(d) until the Trademark database shows that the registration is cancelled or expired. To allow ample time for processing of timely filed post-registration maintenance documents, the USPTO waits until 10 days *after* the expiration of the grace period before updating its records to show that the registration is cancelled or expired.

If the examining attorney determines that 10 days have passed since the expiration of the grace period, but the Trademark database does not indicate that the registration is cancelled or expired, the examining attorney should contact the Supervisor of the Post Registration Section and request that the database be updated to show that the registration is cancelled or expired. *See* [TMEP §1611](#). If a party other than the examining attorney determines that 10 days have passed since the expiration of the grace period, but the Trademark database does not indicate that the registration is cancelled or expired, the party should contact the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199 and request that the database be updated to show that the registration is cancelled or expired.

See [TMEP §716.02\(e\)](#) regarding when suspension is proper for awaiting cancellation/expiration of a cited registration for failure to file required maintenance documents.



## 714 Final Action

### *37 CFR §2.63(b) Final refusal or requirement.*

Upon review of a response, the examining attorney may state that any refusal to register or requirement is final.

(1) If the examining attorney issues a final action that maintains any substantive refusal to register, the applicant may respond by timely filing: (i) A request for reconsideration under paragraph (b)(3) of this section that seeks to overcome any substantive refusal to register, and comply with any outstanding requirement, maintained in the final action; (ii) An appeal to the Trademark Trial and Appeal Board under §§ 2.141 and 2.142; or (iii) A request for extension of time to respond or appeal under § 2.62(a)(2).

(2) If the examining attorney issues a final action that contains no substantive refusals to register, but maintains any requirement, the applicant may respond by timely filing: (i) A request for reconsideration under paragraph (b)(3) of this section that seeks to comply with any outstanding requirement maintained in the final action; (ii) An appeal of any requirement to the Trademark Trial and Appeal Board under §§ 2.141 and 2.142; (iii) A petition to the Director under § 2.146 to review any requirement, if the subject matter of the requirement is procedural, and therefore appropriate for petition; or (iv) A request for extension of time to respond or appeal under § 2.62(a)(2).

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

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

### **714.01 Not Permissible on First Action**

A first action by an examining attorney may not be a final action. An applicant is entitled to at least one opportunity to reply to any refusal(s) or requirement(s) raised by the examining attorney.

### **714.02 Not Permissible on Suspension**

A letter of suspension cannot be made final. See [TMEP §§716–716.06](#) regarding suspension.

### **714.03 When Final Action is Appropriate**

Final action is appropriate when a clear issue has been developed between the examining attorney and the applicant, i.e., the examining attorney has previously raised all outstanding issues and the applicant has had an opportunity to respond to them.

For a second action to be made final, all substantive refusals or requirements must have been made in the first action. No refusal or requirement may be made final, even if it is a repeated refusal or requirement, unless the entire action is made final. Thus, if the examining attorney makes a new refusal or requirement in a second or subsequent action, any previously issued refusals or repeated requirements may not be made final, but instead should be maintained.

If in a previous action the applicant was required to be represented by a qualified U.S. attorney and the response was not filed by, nor is the applicant represented by, such an attorney, the examining attorney must issue a final action on all previously raised issues, including the requirement for counsel, if all issues are in condition for final. See [TMEP §601.01\(a\)](#) and [\(b\)](#) regarding when an applicant or registrant must be represented by a qualified U.S. attorney.

In an application with a claim of priority based on §44(d) in which the applicant has indicated an intent to rely on §44(e) as a basis for registration, the examining attorney may not issue a final action until the applicant

submits a copy of the foreign registration. When the application is otherwise in condition for final refusal, the examining attorney must suspend action on the application pending receipt of a copy of the foreign registration. The notice of suspension must indicate all outstanding refusals or requirements that will be made final upon receipt of the foreign registration if no new issues are raised. See [TMEP §§716.02\(b\), 1003.04\(a\), \(b\)](#).

Second actions should be final actions whenever possible. While an applicant is entitled to a full and fair hearing, it is in the public interest that prosecution be limited to as few actions as is consistent with proper examination. Neither the Act nor the rules of practice give an applicant the right to an extended prosecution.

See [TMEP §§714.05–714.05\(f\)](#) for further discussion of when an examining attorney should issue a nonfinal action rather than a final action, and [TMEP §714.06](#) regarding final actions that are premature.

#### **714.04 Form of the Final Action**

When making an action final, the examining attorney must restate any substantive refusals or requirements that remain outstanding, and must cite the rule(s) and/or statute(s) that provide the basis for these refusals or requirements. The examining attorney should place all evidence in support of their refusal in the record at the time the final action is issued.

The final action should include a clear and unequivocal statement that the refusal or requirement is final. When there is more than one ground set out as the basis for the final action, the action may begin or conclude with a paragraph containing wording such as “This action is made FINAL” or “This is a FINAL action,” which covers all grounds.

The final action must also mention any refusals or requirements that have been obviated, withdrawn, or satisfied. See [TMEP §713.02](#).

The examining attorney must also inform the applicant that a proper response to a final action is to file a timely appeal to the Trademark Trial and Appeal Board, a request for reconsideration, or a petition to the Director (if permitted under [37 C.F.R. §2.63\(b\)\(2\)](#)). [37 C.F.R. §2.63\(b\)\(1\)–\(2\)](#).

A final action must include a response clause (see [TMEP §705.08](#)) so that it is clear that the applicant must file a timely response to avoid abandonment of the application.

#### **714.05 Delineating New Issues Requiring Issuance of Nonfinal Action**

It is sometimes difficult to determine what constitutes a new issue requiring a new nonfinal action, rather than a final action, after receipt of a response. See [TMEP §§714.05\(a\)–714.05\(f\)](#) regarding the propriety of issuing a final action in specific situations, and [§715.03\(b\)](#) and [§715.04\(b\)](#) regarding new issues presented in a request for reconsideration of an examining attorney’s final action.

In a §66(a) application, the Madrid Processing Unit should be notified if a new issue is raised. See [TMEP §1904.03\(a\)](#). However, the examining attorney cannot issue a new refusal more than 18 months after the date on which the IB forwards the request for an extension of protection to the USPTO. See [TMEP §1904.03\(a\)](#).

### **714.05(a) When an Amendment Proposed By Applicant Requires a New Nonfinal Action**

If an applicant submits an unacceptable amendment in response to a refusal or requirement issued by the examining attorney, the amendment generally does not raise a new issue that requires a nonfinal action.

However, if the applicant submits an unacceptable amendment that is not offered in response to a refusal or requirement, the examining attorney generally must issue a new nonfinal action with a response clause (*see* [TMEP §705.08](#)), addressing the issues raised by the amendment and continuing all other refusals and requirements.

The following are examples of amendments that require a new nonfinal action:

- (1) Unacceptable drawing amendments, unless the examining attorney had previously made a requirement for an acceptable drawing (e.g., a requirement to remove matter that is not part of the mark or to provide a clear drawing of the mark);
- (2) Acceptable drawing amendments that necessitate other requirements that were not previously made by the examining attorney, such as a requirement to amend a mark description or disclaimer statement;
- (3) Amendments to the drawing that materially alter the mark, unless the examining attorney had previously rejected a drawing amendment because it was a material alteration (*see* [TMEP §714.05\(c\)](#) regarding advisory statements);
- (4) Amendments to the Supplemental Register and amendments to assert acquired distinctiveness under [15 U.S.C. §1052\(f\)](#), unless the amendment overcomes an outstanding refusal or requirement or is irrelevant to an outstanding refusal (*see* [TMEP §714.05\(a\)\(i\)](#)).

The following are examples of amendments that do not require a new nonfinal action:

- (1) An amendment to disclaim the entire mark, which never raises a new issue because an entire mark may not be disclaimed. *See* [TMEP §1213.06](#).
- (2) An amendment withdrawing a prior amendment that was submitted in response to a refusal or requirement made by the examining attorney in an Office action (e.g., an amendment to the Supplemental Register or disclaimer) does not raise a new issue.
- (3) Further amendment to the identification of goods and/or services is required as to wording previously identified as indefinite in a non-final Office action (e.g., applicant responds to an identification requirement by submitting amended wording that is unacceptable).

Moreover, evidence or amendments that are merely cumulative and are not significantly different from material previously submitted do *not* raise a new issue that requires the examining attorney to issue a nonfinal action. *See In re GTE Educ. Servs.*, 34 USPQ2d 1478, 1480 (Comm'r Pats. 1994) (finding examining attorney properly determined that no new issue had been raised in request for reconsideration of final refusal based on inadequate specimens, because the substitute specimens submitted with the request were deficient for same reason as the original specimens).

### **714.05(a)(i) Amendment to Supplemental Register or Submission of Claim of Acquired Distinctiveness**

If registration is refused under §2(e)(1), §2(e)(2), or §2(e)(4), of the Trademark Act, [15 U.S.C. §§1052\(e\)\(1\), 1052\(e\)\(2\), 1052\(e\)\(4\)](#), or on grounds pertaining to other non-inherently distinctive subject matter (e.g., product or container configurations (*see* [TMEP §1202.02\(b\)\(i\), \(ii\)](#)), color marks (*see* [TMEP §1202.05\(a\)](#)), or marks that comprise matter that is purely ornamental (*see* [TMEP §1202.03](#)), an amendment to the

Supplemental Register or to claim acquired distinctiveness under [15 U.S.C. §1052\(f\)](#) generally presents a new issue. This is true even if the examining attorney previously issued an advisory statement indicating that the examining attorney believed the mark to be unregistrable on the Supplemental Register or under §2(f). If the examining attorney determines that the amendment does not overcome the refusal, the examining attorney should issue a new nonfinal refusal of registration. See [TMEP §705.08](#).

In an application based on §1(b), the applicant may respond to one of the refusals listed above by filing an allegation of use that complies with the minimum requirements of [37 C.F.R. §2.76\(c\)](#) or [37 C.F.R. §2.88\(c\)](#), together with an amendment to the Supplemental Register or an amendment seeking registration under §2(f). If such an amendment could overcome the refusal, but the allegation of use fails to establish use of the mark in commerce or, in combination with other evidence of record, fails to demonstrate use of the subject matter as a mark, the examining attorney must issue a new nonfinal action refusing registration. See [TMEP §904.07\(a\), \(b\)](#). The examining attorney must also advise the applicant as follows:

If the applicant submitted an amendment to the Supplemental Register, the examining attorney must advise the applicant that: (1) the amendment to the Supplemental Register is acceptable; (2) the refusal is moot; and (3) if the applicant amends the application back to §1(b) in response to the new refusal, the amendment to the Supplemental Register must also be withdrawn and the original refusal will be reinstated or made final, as appropriate. See [TMEP §816.04](#) regarding responses requesting registration on the Supplemental Register in the alternative. See [TMEP §§714.05\(a\), 715.03\(a\)\(ii\)\(A\)](#), and [715.04\(a\)](#) regarding withdrawal of a prior amendment submitted in a request for reconsideration.

If the applicant submitted an amendment seeking registration under §2(f), the examining attorney must advise the applicant that: (1) the amendment to §2(f) is acceptable, (2) the refusal is moot, and (3) if the §2(f) amendment is based solely on five years' use and the applicant amends the application back to §1(b) in response to the new refusal, the §2(f) amendment must also be withdrawn and the original refusal will be reinstated or made final, as appropriate. See [TMEP §1212.02\(c\)](#) regarding responses seeking registration under §2(f) in the alternative. See [TMEP §§714.05\(a\), 715.03\(a\)\(ii\)\(A\)](#), and [715.04\(a\)](#) regarding withdrawal of a prior amendment submitted in a request for reconsideration.

However, if the applicant responds to one of the refusals listed above by submitting an amendment to the Supplemental Register, but does not concurrently file an allegation of use that complies with the minimum requirements of [37 C.F.R. §2.76\(c\)](#) or [37 C.F.R. §2.88\(c\)](#), the examining attorney must refuse registration under §23 of the Trademark Act, [15 U.S.C. §1091](#), on the ground that the mark is not in lawful use in commerce. See [37 C.F.R. §2.75\(b\)](#); [TMEP §1102.03](#). If the applicant responds to the refusal by filing a proper allegation of use, the examining attorney will proceed as noted above.

See [TMEP §816.04](#) regarding refusal of registration after an amendment to the Supplemental Register, [§1212.02\(h\)](#) regarding refusal of registration after an applicant submits a claim of acquired distinctiveness under §2(f), and [§1212.09\(a\)](#) regarding a §2(f) claim in a §1(b) application based on prior use.

If an amendment to the Supplemental Register or to claim acquired distinctiveness under §2(f) is irrelevant to the outstanding refusal(s), and there are otherwise no new issues, the examining attorney may issue a final action. For example, if registration is refused under Trademark Act §2(a), §2(b), §2(c), §2(d), §2(e)(3), or §2(e)(5), an amendment to the Supplemental Register or a claim of distinctiveness under §2(f) does *not* raise a new issue and does not preclude the examining attorney from issuing a final refusal. See *In re Juleigh Jeans Sportswear, Inc.*, 24 USPQ2d 1694, 1696 (TTAB 1992) (noting that an amendment to the Supplemental Register in response to a §2(a) refusal does not raise a new issue). Note, however, that if an applicant responds to a functionality refusal under §2(e)(5) by submitting an amendment seeking registration on the Supplemental Register that is not made in the alternative, the associated nondistinctiveness refusal must be withdrawn and the functionality refusal must be maintained and made final, if appropriate, under §23(c).

*See In re Heatcon, Inc.*, 116 USPQ2d 1366, 1370 (TTAB 2015) (noting that § 23(c) is the statutory authority governing a functionality refusal on the Supplemental Register).

In a §66(a) application, an amendment to the Supplemental Register does not raise a new issue, because a mark in a §66(a) application is not eligible for registration on the Supplemental Register. *See* [15 U.S.C. §1141h\(a\)\(4\)](#). Thus, an amendment to the Supplemental Register cannot overcome the refusal.

See [TMEP §715.03\(b\)](#) and [§715.04\(b\)](#) regarding new issues presented in a request for reconsideration of an examining attorney's final action.

### **714.05(a)(ii) Amendment of Identification of Goods/Services**

If the applicant responds to a nonfinal Office action requiring an amendment to the identification of goods/services, and the examining attorney determines that the identification is still unacceptable, generally the examining attorney must issue a final requirement to amend the identification of goods/services. There are only three exceptions to this rule:

- (1) If the amended identification is broader in scope than the original identification, *and* the prior Office action failed to advise the applicant that amendments broadening the identification are prohibited under [37 C.F.R. §2.71\(a\)](#), the examining attorney may not issue a final Office action.
- (2) If the amended identification sets forth goods/services in multiple classes, but the applicant has not submitted all the requirements for a multiple-class application (e.g., specimens and fees for all classes), *and* the prior Office action failed to advise the applicant that the missing elements were required, the examining attorney may not issue a final Office action. See [TMEP §§1403–1403.01](#) regarding the requirements for multiple-class applications.
- (3) If further amendment to the identification of goods and/or services is required as to issues not previously raised by the examining attorney (i.e., applicant properly responds to an identification requirement in a first non-final Office action and the examining attorney subsequently requires that other goods and/or services in the original identification be amended), the examining attorney may not issue a final Office action.

If the examining attorney issues a *nonfinal* action requiring amendment of the identification because it is indefinite, and the applicant responds with an amended identification that is definite, but is otherwise unacceptable (e.g., because it includes a registered trademark or service mark (*see* [TMEP §1402.09](#))), this is not considered a new issue, and the examining attorney must issue a final Office action requiring amendment of the identification.

However, if the examining attorney issues a *final* action requiring amendment of the identification because it is indefinite, and the applicant responds with an amended identification that is definite but is otherwise unacceptable (e.g., because it includes a registered mark), the examining attorney should treat the response as incomplete, and grant the applicant additional time to cure this deficiency, pursuant to [37 C.F.R. §2.65\(a\)\(2\)](#). See [TMEP §718.03\(b\)](#) for further information about granting an applicant additional time to perfect an incomplete response. *Examining attorneys are encouraged to try to resolve these issues by examiner's amendment.*

## **714.05(b) Section 2(d) Refusal Based on Earlier-Filed Application that Has Matured Into Registration**

The examining attorney must issue a new nonfinal action when first refusing registration under §2(d) of the Trademark Act, [15 U.S.C. §1052\(d\)](#), as to an earlier-filed application that has registered, even if the applicant had been advised of the existence of the earlier-filed application in a prior Office action. See [TMEP §716.02\(c\)](#) regarding procedure when application is suspended pending the disposition of more than one earlier-filed conflicting application.

In a §66(a) application, a new nonfinal refusal under §2(d) may be issued more than 18 months after the date on which the IB forwards the request for extension of protection to the USPTO, provided that the USPTO had notified the IB of the conflicting application prior to expiration of the 18-month period. See [TMEP §1904.03\(b\)](#).

## **714.05(c) Advisory Statement Cannot Serve as Foundation for Final Refusal or Requirement**

Except as provided in [TMEP §714.05\(a\)\(ii\)](#), an advisory statement in an Office action indicating that a refusal or requirement will be issued if specified circumstances arise cannot serve as the foundation for issuing a final requirement or refusal in the next action. To establish the foundation for issuing a final refusal or requirement in the next Office action, an initial requirement or refusal must relate to matter that is of record at the time of the action.

In addition, a mere advisory statement made in an Office action is not subject to appeal to the Trademark Trial and Appeal Board by the applicant. *In re Harley*, 119 USPQ2d 1755, 1757 (TTAB 2016) (“An advisory statement made by an examining attorney indicating that a refusal or requirement may issue if specified circumstances arise is not a refusal to register, let alone a *final* refusal to register, and is therefore not subject to appeal.”); *see also In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1403-04 (TTAB 2018) (limiting review to a failure-to-function refusal based on mere ornamentation and refusing to consider the “merely informational” rationale included in the examining attorney’s appeal brief because it was raised only in an advisory manner during examination and it was not clear that applicant had a full opportunity to address the rationale prior to appeal).

## **714.05(d) Submission of Consent Agreement or Assertion of Unity of Control in Response to §2(d) Refusal**

*Consent Agreement.* If an applicant files a consent agreement in response to a *nonfinal* refusal under §2(d) of the Trademark Act, and the examining attorney finds the consent agreement insufficient to overcome the refusal, the examining attorney should issue a final refusal, assuming the application is otherwise in condition for final refusal.

If an applicant files an executed consent agreement for the first time in response to a *final* refusal under §2(d) of the Trademark Act, no appeal has been filed, and the examining attorney finds the consent agreement insufficient to overcome the refusal, the examining attorney should issue a *new final* refusal, i.e., a “Subsequent Final Action,” with a response clause. See [TMEP §705.08](#). However, the examining attorney should not issue a subsequent final action if the applicant merely states that it is negotiating a consent agreement.

*Assertion of Unity of Control.* If an applicant asserts unity of control (see [TMEP §1201.07](#)) in response to a *nonfinal* refusal under §2(d), and the examining attorney determines that unity of control has not been



established, the examining attorney should issue a final refusal, assuming that the application is otherwise in condition for final refusal.

If an applicant asserts unity of control for the first time in response to a *final* refusal under §2(d), no appeal has been filed, and the examining attorney determines that unity of control has not been established, the examining attorney should issue a "Subsequent Final Action," with a response clause. See [TMEP §705.08](#).

See [TMEP §715.04\(b\)](#) regarding the proper action when a request for consideration presents a new issue or new evidence and a notice of appeal has been filed.

#### **714.05(e) Submission of Substitute Specimen in Response to Refusal for Failure to Show Use of the Mark in Commerce**

If the applicant responds to an Office action refusing registration by submitting a substitute specimen that does not show use of the mark in commerce for the same or a different “use-in-commerce” reason, the examining attorney must issue a final refusal because the substitute specimen does not present a new issue. See [TMEP §904.07\(b\)](#).

If an applicant submits a substitute specimen in response to a *nonfinal* refusal for failure to show use of the mark in commerce, and unlike in the original specimen, the mark on the substitute specimen now does not agree with the mark on the drawing (see [TMEP §807.12](#)), but the specimen would otherwise be acceptable to show use in commerce in connection with the goods/services, the examining attorney may allow the applicant to amend the drawing if such an amendment would not constitute a material alteration of the mark.

If any remaining issues can be handled by examiner’s amendment, and the mark is a standard character mark, the examining attorney may give the applicant the option to amend the drawing by examiner’s amendment. If not, the examining attorney must issue a final refusal that also gives the applicant the option to overcome the refusal by submitting a substitute drawing.

If an amendment of the drawing would be a material alteration, the examining attorney must issue a final refusal, assuming the application is otherwise in condition for final refusal, because the substitute specimen does not present a new issue.

See [TMEP §904.07\(a\)](#) for further information about refusal of registration because the specimen does not show the mark used in commerce.

#### **714.05(f) Submission of Substitute Specimen in Response to Refusal for Failure to Show the Applied-For Mark Functioning as a Mark**

Because the examining attorney has advised the applicant of the appropriate response options, which may include the general requirements for a substitute specimen, if the applicant responds to a failure-to-function refusal by submitting a specimen that does not show the mark in commerce for a reason such as those set out in [TMEP §904.07\(a\)](#), the examining attorney must issue a final refusal, as no new issue is presented. By contrast, if the applicant responds to the Office action refusing registration by submitting a substitute specimen that reflects failure to function as a mark for a different substantive reason, such as the examples listed in [TMEP §904.07\(b\)](#), the examining attorney must issue a new nonfinal Office action because the substitute specimen presents a new issue.

If an applicant submits a substitute specimen in response to a *nonfinal* refusal for failure to show the applied-for mark functioning as a mark, and unlike in the original specimen, the mark on the substitute

specimen now does not agree with the mark on the drawing (*see* [TMEP §807.12](#)), but the specimen would otherwise be acceptable to identify the goods/services of the applicant and indicate the source of those goods/services, the examining attorney may allow the applicant to amend the drawing if such an amendment would not constitute a material alteration of the mark. If any remaining issues can be handled by examiner's amendment, and the mark is a standard character mark, the examining attorney may give the applicant the option to amend the drawing by examiner's amendment. If not, the examining attorney must issue a final refusal that also gives the applicant the option to overcome the refusal by submitting a substitute drawing.

If an amendment of the drawing would be a material alteration, the examining attorney must issue a final refusal, assuming the application is otherwise in condition for final refusal, because the substitute specimen does not present a new issue.

See [TMEP §904.07\(b\)](#) for further information about refusal of registration because the specimen does not show the applied-for mark functioning as a mark.

## **714.06 Applicant's Recourse When Final Action is Premature**

If an applicant believes that a refusal to register or a requirement has been made final prematurely, the applicant must raise the issue while the application is still pending before the examining attorney. It is not a ground for appeal to the Trademark Trial and Appeal Board. [TBMP §1201.02](#). The applicant may raise the matter by filing a request for reconsideration with the examining attorney, or by contacting the managing attorney or senior attorney in the examining attorney's law office. If the examining attorney does not withdraw the final action, the applicant may file a petition to the Director under [37 C.F.R. §2.146](#). See [TMEP Chapter 1700](#) regarding petitions.

If, on request for reconsideration, the examining attorney finds the final action to have been premature, the examining attorney should issue a new nonfinal action with a response clause. See [TMEP §705.08](#).

## **715 Action After Issuance of Final Action**

### **715.01 Proper Response to Final Action**

An applicant must timely respond to a final action to avoid abandonment. [15 U.S.C. §1062\(b\)](#); [37 C.F.R. §2.62\(a\)](#). See [TMEP §711](#) for 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.

An applicant may respond to a final action by timely filing (1) a notice of appeal to the Trademark Trial and Appeal Board (*see* [TMEP §§1501–1501.07](#)); (2) a request for reconsideration that seeks to overcome any substantive refusals to register and comply with any outstanding requirements; or (3) a petition to the Director under Trademark Rule 2.146 to review a requirement, if the subject matter of the requirement is procedural and thus appropriate for petition. [37 C.F.R. §2.63\(b\)\(1\)–\(2\)](#). Filing a request for reconsideration does *not* stay or extend the deadline for filing a notice of appeal or petition to the Director under [37 C.F.R. §2.63\(b\)\(2\)](#). [37 C.F.R. §2.63\(b\)\(3\)](#); [TMEP §715.03](#).

For an application filed under Section 1(b) in which the applicant has filed a timely “insurance” extension request (i.e., in conjunction with the statement of use or within the same six-month period that the statement of use is filed; *see* [TMEP §§1108.03–1108.03\(a\)](#), [1109.16\(c\)](#)), when the response period to a final Office action will expire before the expiration of the extension period, the applicant may respond to the final action by requesting suspension until the end of the extension period for the statement of use in order to overcome

any substantive refusals and/or comply with any outstanding requirements maintained in the action. *See* [TMEP §§716.02\(f\), 716.06, 1109.16\(d\)](#).

After a final refusal to register on the Principal Register, an amendment requesting registration on the Supplemental Register or registration on the Principal Register under §2(f) of the Trademark Act may be a proper response in some circumstances. *See* [TMEP §§714.05\(a\)\(i\), 816.04, 1212.02\(h\)](#).

## **715.02 Action After Final Action**

Once an action has been properly made final, the examining attorney normally should not change their position. However, this does not mean that an applicant's amendment or argument will not be considered after final action. An amendment may be accepted and entered if it places the application in condition for publication or registration, or will put the application in better form for appeal (i.e., reduce the issues on appeal). For example, an amendment requesting registration on the Supplemental Register or on the Principal Register under §2(f) may be a proper response to a final refusal of registration on the Principal Register in some circumstances. *See* [TMEP §§714.05\(a\)\(i\), 816.04, 1212.02\(h\)](#).

The examining attorney should issue an examiner's amendment (*see* [TMEP §707.03](#)) if it will immediately put the application in condition for publication or registration or reduce the issues on appeal.

If the applicant files a response that complies with all outstanding requirements and overcomes all outstanding refusals, the examining attorney should approve the application for publication or registration, as appropriate.

In the rare circumstance where the examining attorney determines that a final refusal should be withdrawn, even though the applicant has not submitted any further amendments or arguments after issuance of the final action, the examining attorney must withdraw the requirement or refusal and approve the application for publication or registration, if it is otherwise in condition for such action. The examining attorney must also promptly attempt to notify the applicant by telephone or email that the requirement or refusal is withdrawn, so that the applicant knows that filing an appeal is unnecessary, and must enter an appropriate Note to the File (also referred to as a Public Note or Notation to File) in the record.

The applicant may file a request for reconsideration of the final action that seeks to overcome any substantive refusals and/or comply with any outstanding requirements within the time period for responding to the final action. However, filing a request for reconsideration does *not* stay or extend the time for filing a notice of appeal to the Board or petition to the Director under [37 C.F.R. §2.63\(b\)\(2\)](#). [37 C.F.R. §2.63\(b\)\(3\)](#).

*See* [TMEP §716.06](#) regarding suspension after final action.

## **715.03 Request for Reconsideration After Final Action**

Under [37 C.F.R. §2.63\(b\)\(3\)](#), the applicant may file a request for reconsideration before the deadline for filing an appeal to the Board or petition to the Director.

However, filing a request for reconsideration does *not* stay or extend the deadline for filing a notice of appeal or petition to the Director under [37 C.F.R. §2.63\(b\)\(2\)](#). [37 C.F.R. §2.63\(b\)\(3\)](#); [TMEP §715.03\(c\)](#).

The USPTO cannot extend the deadline for filing an appeal, except as set forth in [37 C.F.R. §2.62\(a\)\(2\)](#). *See* [15 U.S.C. §1062\(b\)\(3\)](#); [37 C.F.R. §2.142\(a\)](#); [TMEP §711](#). *But see* [TMEP §1714.01\(a\)\(ii\)](#) (concerning filing a petition to revive an abandoned application with a notice of appeal when an applicant fails to respond to a final action). Therefore, if an applicant files a request for reconsideration of a final action and wants

to preserve the right to appeal if the request is unsuccessful, the applicant must file a notice of appeal (with the fee required by 37 C.F.R. §2.6) before the expiration of the period for response to the final action, or the application will be abandoned. If the request for reconsideration is unsuccessful, and the applicant has not timely filed a notice of appeal, the application will be abandoned for incomplete response after the expiration of the response period. See [15 U.S.C. §1062\(b\)](#); [37 C.F.R. §2.65\(a\)](#). See [TMEP §718.02\(a\)](#) for information about processing an incomplete response to a partial final refusal or requirement and [§§715.04–715.04\(b\)](#) for information about processing a request for reconsideration filed with a notice of appeal.

The examining attorney should construe any document filed after final action that responds to the outstanding refusals or requirements as a request for reconsideration. If the request for reconsideration does not overcome or resolve all outstanding refusals and requirements, the examining attorney must follow the procedures outlined in [TMEP §§715.03\(a\)\(ii\), \(b\)](#), and [715.04\(a\), \(b\)](#). An Office action issued in connection with those procedures should discuss any new evidence submitted with the request for reconsideration, regardless of whether it is significantly different from evidence previously submitted. If the evidence in the request for reconsideration is significantly different from the evidence currently of record, the examining attorney must issue a new final refusal (i.e., a “Subsequent Final Action”). See [TMEP §715.03\(b\)](#).

Regardless of whether an applicant submits new evidence with a request for reconsideration, the examining attorney may introduce additional evidence directed to the issue(s) for which reconsideration is sought. [TBMP §1207.04](#); see *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1200–01 (TTAB 2009); *In re Giger*, 78 USPQ2d 1405, 1406–07 (TTAB 2006) .

To determine the appropriate action to take upon receipt of a request for reconsideration, the examining attorney must consider whether: (1) the applicant has timely filed a notice of appeal; (2) time remains in the period to respond to the final action; and (3) the request for reconsideration presents a new issue or new evidence significantly different from that previously submitted. See [TMEP §715.03\(a\)](#), [§715.03\(b\)](#), and [§§715.04–715.04\(b\)](#) for further information as to how examining attorneys should handle requests for reconsideration.

### **715.03(a) Examining Attorney’s Action When No New Issue or No Significantly Different Evidence Is Presented in Request for Reconsideration and No Notice of Appeal Has Been Filed**

If a request for reconsideration presents no new issues or no new evidence significantly different from that previously submitted and the applicant has not filed a notice of appeal, the examining attorney must consider whether to: (1) approve the application for publication or registration; (2) deem the application abandoned in whole or in part for an incomplete response; or (3) issue an Office action. See [TMEP §718.02\(a\)](#) for information about processing an incomplete response to a partial final refusal or requirement.

#### **715.03(a)(i) Request for Reconsideration Resolves All Outstanding Issues and No Notice of Appeal Has Been Filed**

If the request for reconsideration convinces the examining attorney that a refusal or requirement should be withdrawn, and no other issues remain, the examining attorney may approve the application for publication or registration.

**715.03(a)(ii) Request for Reconsideration Does Not Resolve All Outstanding Issues and No Notice of Appeal Has Been Filed****715.03(a)(ii)(A) Prior Amendment Withdrawn**

If, in a request for reconsideration that does not overcome or resolve all outstanding issues, the applicant also withdraws a prior amendment submitted in response to a refusal or requirement made by the examining attorney in an Office action (e.g., an amendment to the Supplemental Register or disclaimer), this does not raise a new issue.

**715.03(a)(ii)(B) Outstanding Refusals and/or Requirements Must Be Continued, Time Remains in Response Period for Applicant to Appeal, and No Notice of Appeal Has Been Filed**

The examining attorney must issue a “Request for Reconsideration Denied” action if: (1) the request for reconsideration does not overcome or resolve all outstanding refusal(s) and/or requirement(s); (2) the applicant’s response does not meet the criteria under [37 C.F.R. §2.65\(a\)\(2\)](#) for granting additional time to complete the response, because such issues cannot be resolved with additional time granted; and (3) no notice of appeal has been filed. This action must (1) acknowledge receipt of the request for reconsideration, (2) indicate that the request is denied and explain why it does not overcome or resolve the final refusal(s) and/or requirements, (3) identify the final refusal(s) and/or requirements that are maintained and continued and any that are satisfied or withdrawn, (4) advise the applicant that the time for appeal runs from the issuance date of the final Office action, (5) advise that the applicant has the remainder of the response period to comply with any outstanding refusal(s) and/or requirement(s) and/or to file a notice of appeal to the Board, and (6) omit the response clause. See [TMEP §705.08](#).

Once the examining attorney has issued a “Request for Reconsideration Denied” action, the examining attorney must abandon the application for incomplete response if the applicant (1) does not submit within the time remaining a complete response or a request for reconsideration that presents a new issue or new evidence significantly different from that previously provided or (2) fails to respond. The application should be abandoned due to incomplete response, and *not* for failure to respond, because the applicant did in fact respond to the final Office action by filing a request for reconsideration.

See [TMEP §718.02\(a\)](#) for information about processing an incomplete response to a partial final refusal or requirement.

**715.03(a)(ii)(C) Outstanding Refusals and/or Requirements May Be Resolved if Applicant Is Given 30 Days or Time Remaining in Response Period to Comply with Issues**

The preferred action is to issue a “Continuing Final Action” if: (1) the request for reconsideration does not overcome or resolve all outstanding refusal(s) and/or requirement(s); (2) the applicant’s response complies with the criteria in [37 C.F.R. §2.65\(a\)\(2\)](#) for granting additional time to complete the response, regardless of whether time remains in the response period, because such issues can be resolved with additional time, including where the record indicates that the applicant can place the application in condition for approval for publication or registration by completing the response or all issues can be resolved by examiner’s amendment; and (3) no notice of appeal has been filed. See *In re P.T. Polymindo Permata*, 109 USPQ2d 1256, 1257 (Dir USPTO 2013). See [TMEP §715.03\(a\)\(ii\)\(E\)](#) regarding responses to final actions that comply with the criteria in [37 C.F.R. §2.65\(a\)\(2\)](#) (those signed by unauthorized persons, unsigned responses, and electronic responses consisting solely of a signature or missing significant data or attachments).

This Office action must: (1) include an appropriate explanation of the problem with the response; (2) give the applicant 30 days, or to the end of the response period for the previous Office action, whichever is longer, to submit a complete response; and (3) omit the response clause. See [TMEP §§705.08, 718.03\(b\)](#).

If the examining attorney determines that an examiner's amendment (see [TMEP §§707 707.03](#)) will immediately put the application in condition for publication or registration, the examining attorney should attempt to contact the applicant to obtain authorization to issue an examiner's amendment to resolve the matters that remain outstanding.

Once the examining attorney has issued a “Continuing Final Action,” the examining attorney must abandon the application for incomplete response if the applicant (1) does not submit within the time remaining a complete response or a request for reconsideration that presents a new issue or new evidence significantly different from that previously provided or (2) fails to respond. The application should be abandoned for incomplete response and *not* for failure to respond, because the applicant did in fact respond to the final Office action by filing a request for reconsideration.

Granting additional time to complete a response under [37 C.F.R. §2.65\(a\)\(2\)](#) does not stay or extend the deadline for filing an appeal to the Board (or petition to the Director under [37 C.F.R. §2.63\(b\)\(2\)](#), if appropriate). See [15 U.S.C. §1062\(b\)](#); [37 C.F.R. §2.142\(a\)](#). See [TMEP §718.02\(a\)](#) for information about processing an incomplete response to a partial final refusal or requirement.

#### **715.03(a)(ii)(D) Outstanding Refusals and/or Requirements Must Be Continued, Time for Appeal Has Expired, and No Notice of Appeal Has Been Filed – Abandon for Incomplete Response**

If (1) the examining attorney is not persuaded by the request for reconsideration, (2) the applicant's response does not meet the criteria in [37 C.F.R. §2.65\(a\)\(2\)](#) for granting additional time to complete the response, (3) there is no time remaining in the response period, and (4) no notice of appeal has been filed, the examining attorney must hold the application abandoned due to incomplete response. The examining attorney must deny the request for reconsideration by issuing an action abandoning the application for incomplete response. See [TMEP §718.02\(a\)](#) for information about processing an incomplete response to a partial final refusal or requirement.

If the examining attorney denies the request for reconsideration and holds the application abandoned for incomplete response, the applicant may file a petition to the Director under [37 C.F.R. §2.146](#) to reverse the examining attorney's holding of abandonment. However, the Director will reverse the examining attorney's action on petition only where there has been clear error or an abuse of discretion or where 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 GTE Educ. Servs.*, 34 USPQ2d 1478, 1479–80 (Comm'r Pats. 1994); *In re Legendary Inc.*, 26 USPQ2d 1478, 1479 (Comm'r Pats. 1992); [TMEP §1713.01](#). The unintentional delay standard of [37 C.F.R. §2.66](#) does not apply in this situation. See [TMEP §§1713.02, 1714.01\(f\)\(ii\)\(A\)](#).

#### **715.03(a)(ii)(E) Responses After Final Refusal Signed by Unauthorized Persons, Unsigned Responses, Electronic Responses Consisting Solely of a Signature, and TEAS Responses Missing Significant Data or Attachments**

If an examining attorney receives a response to a final action signed by an unauthorized person, an unsigned response to a final action, an electronic response to a final action that consists solely of a signature, or an



electronic response to a final action missing significant data or attachments, the examining attorney should not hold the application abandoned for failure to respond completely. The examining attorney must issue a “Continuing Final Action” that (1) includes an appropriate explanation of the problem with the response, (2) gives the applicant 30 days, or to the end of the response period for the previous Office action, whichever is longer, to submit a complete response, and (3) omits the response clause. *See* [TMEP § 705.08](#). Granting additional time to complete a response under [37 C.F.R. §2.65\(a\)\(2\)](#) does not extend the deadline for filing an appeal to the Board (or petition to the Director under [37 C.F.R. §2.63\(b\)\(2\)](#), if appropriate). *See* [15 U.S.C. §1062\(b\)](#); [37 C.F.R. §2.142\(a\)](#).

Once an examining attorney has issued a “Continuing Final Action,” the examining attorney must abandon the application for incomplete response if the applicant (1) does not submit within the time remaining a complete response or a request for reconsideration that presents a new issue or new evidence significantly different from that previously provided or (2) fails to respond. The application should be abandoned for incomplete response and *not* for failure to respond, because the applicant did in fact respond to the final Office action by filing a request for reconsideration. *See* [TMEP §718.03\(a\)](#).

### **715.03(b) Examining Attorney’s Action When New Issue or New Evidence Is Presented in Request for Reconsideration and No Notice of Appeal Has Been Filed**

If the request for reconsideration includes an amendment that presents a new issue, whether related to the final refusal or not, the examining attorney must issue a nonfinal action with a response clause that addresses the new issue and maintains the final refusal. *See* [TMEP §705.08](#). For example, if the applicant’s request for reconsideration contains a §2(f) claim of acquired distinctiveness in response to a final §2(e)(1) refusal, and the claim fails to place the application in condition for approval, the examining attorney must issue a nonfinal action. *See* [TMEP §714.05\(a\)\(i\)](#). However, if the applicant withdraws a prior amendment submitted in response to a refusal or requirement made by the examining attorney in an Office action (e.g., an amendment to the Supplemental Register or §2(f) claim of acquired distinctiveness submitted in response to a §2(e)(1) refusal or a disclaimer submitted in response to a requirement), this does not raise a new issue. *See* [TMEP §§715.03\(a\)\(ii\)\(A\)](#), [715.04\(a\)](#).

Whenever the examining attorney issues a new *nonfinal* action after review of an applicant’s request for reconsideration, the Office action must include a response clause (*see* [TMEP §705.08](#)) and should explain that the applicant must respond to all requirements or refusals, but that the applicant should not file an appeal to the Board because an appeal would be premature under [15 U.S.C. §1070](#) and [37 C.F.R. §2.141\(a\)](#). If the applicant’s response to the new nonfinal action does not resolve all outstanding requirements or refusals and put the application in condition for publication or registration, the examining attorney must issue a “Subsequent Final Action” with a response clause. This provides the applicant the opportunity to file an appeal. *See* [TMEP §715.04\(b\)](#) if a notice of appeal has been filed.

Evidence or amendments that are merely cumulative and are not significantly different from material previously submitted do *not* raise a new issue that requires the examining attorney to issue a new final or nonfinal action. *In re GTE Educ. Servs.*, 34 USPQ2d 1478, 1480 (Comm’r Pats. 1994) (finding examining attorney properly determined that no new issue had been raised in request for reconsideration of final refusal based on inadequate specimens, because the substitute specimens submitted with the request were deficient for the same reason as original specimens).

If the request for reconsideration does not raise a new issue, but presents new evidence that is significantly different from evidence previously submitted, the examining attorney must issue a “Subsequent Final Action” with a response clause. This provides applicant with the opportunity to respond before filing an appeal.

Any response to the subsequent final action will be treated as a new request for reconsideration and processed according to the guidelines set forth in [TMEP §§715.03–715.03\(b\)](#).

*Example:* If an applicant files an executed consent agreement in response to a final refusal under §2(d) of the Trademark Act, and the examining attorney finds the consent agreement insufficient to overcome the refusal, the examining attorney must issue a “Subsequent Final Action.” However, the examining attorney should not issue a subsequent final action if the applicant merely states that it is negotiating a consent agreement. See [TMEP §714.05\(d\)](#).

*Example:* The examining attorney must issue a “Subsequent Final Action” if the applicant asserts unity of control (see [TMEP §1201.07](#)) in response to a final refusal under §2(d), and the examining attorney determines that unity of control has not been established. See [TMEP §714.05\(d\)](#).

Submission of new arguments in response to the same refusal or requirement does not raise a new issue that requires the examining attorney to issue a subsequent final or nonfinal action. Generally, if the same refusal or requirement was made before, the examining attorney does not have to issue a subsequent final or nonfinal action.

See [TMEP §§714.05–714.05\(f\)](#) for further information about delineating new issues that require issuance of a nonfinal action.

Sometimes action on an application is suspended after a final refusal has issued. If the grounds for refusal remain operative after the application is removed from suspension and no new issues have been raised, the examining attorney must issue a “Subsequent Final Action” with a response clause. See [TMEP §716.06](#).

In a §66(a) application, the examining attorney cannot issue a new refusal more than 18 months after the date the IB forwards the request for extension of protection to the USPTO. See [TMEP §1904.03\(a\)](#).

### **715.03(c) Time for Appeal Runs from Issue Date of Final Action**

Filing a request for reconsideration does not stay or extend the time for responding to a final refusal. See [15 U.S.C. §1062\(b\)](#); [37 C.F.R. §§2.63\(b\)\(3\), 2.142\(a\)](#). If the examining attorney denies an applicant’s request for reconsideration, the deadline for filing a notice of appeal to the Board (or petition to the Director if permitted by [37 C.F.R. §2.63\(b\)\(2\)](#)) runs from the issuance date of the final action. If this deadline has expired and the applicant has not filed a timely appeal or petition, the application will be abandoned due to an incomplete response. [15 U.S.C. §1062\(b\)](#); [37 C.F.R. §§2.63\(b\)\(4\), 2.65\(a\)](#). The applicant may not file a petition to revive under [37 C.F.R. §2.66](#), based on unintentional delay. See [TMEP §1714.01\(f\)\(ii\)\(A\)](#). 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. However, the Director will reverse the examining attorney’s action on petition only where there has been clear error or an abuse of discretion or where a petitioner can show that it has substantially complied with the requirements of the statute or rules. See [TMEP §1713.01](#).

### **715.04 Request for Reconsideration Filed in Conjunction with Notice of Appeal**

The Board has jurisdiction over an application upon the filing of a notice of appeal. In response to a request from an applicant, the Board may remand an application to the examining attorney for consideration of specific facts or issues. [37 C.F.R. §2.142\(d\)](#). See [TBMP §1209](#) regarding remand during an ex parte appeal, [TBMP §515](#) regarding remand to the examining attorney during an inter partes proceeding, and [TMEP §1504.05](#) regarding requests for remand.

If an applicant files a notice of appeal with a request for reconsideration, the Trademark Trial and Appeal Board will acknowledge the appeal, suspend further proceedings with respect to the appeal, including the applicant's time to file an appeal brief, and remand the application to the examining attorney for review of the request for reconsideration. [TBMP §1204](#). See [TBMP Chapter 1200](#) and [TMEP §§1501–1501.07](#) for further information about ex parte appeals.

If, upon remand, the examining attorney determines that the outstanding refusal or requirement should be withdrawn, the examining attorney may approve the application for publication or registration. The examining attorney may issue an examiner's amendment if the examining attorney determines that an examiner's amendment (*see* [TMEP §§707–707.03](#)) will immediately put the application in condition for publication or registration. In these situations, the appeal is moot and no further action is needed after approving the application for publication or registration. If there are remaining unresolved refusals or requirements, the request for reconsideration must be denied. *See* [TMEP §715.04\(a\)](#). In some circumstances, the examining attorney may also issue an examiner's amendment to reduce the issues on appeal. See [TMEP §715.02](#) regarding action after issuance of a final action.

#### **715.04(a) Examining Attorney's Action When No New Issue Is Presented in Request for Reconsideration and Notice of Appeal Has Been Filed**

If the request for reconsideration does not overcome or resolve the issues on appeal, and no new issue, or no new evidence significantly different from that previously submitted, is presented therein, the examining attorney must issue a "Request for Reconsideration Denied" action that: (1) acknowledges the request for reconsideration; (2) indicates that it is denied and explains why it does not overcome all refusals or satisfy all requirements; (3) identifies the final refusal(s) and/or requirements that are maintained and any that are satisfied or withdrawn; and (4) advises the applicant that the Board will be notified to resume the appeal. An Office action denying reconsideration of the final action must *not* include a response clause.

If, in a request for reconsideration that does not overcome or resolve the issues on appeal, the applicant also withdraws a prior amendment submitted in response to a refusal or requirement made by the examining attorney in an Office action (e.g., an amendment to the Supplemental Register or disclaimer), this does not raise a new issue.

#### **715.04(b) Examining Attorney's Action When New Issue or New Evidence is Presented and Notice of Appeal Has Been Filed**

If the request for reconsideration includes an amendment that presents a new issue, the examining attorney must issue a new nonfinal Office action with a response clause that addresses the new issue and maintains the refusals or requirements previously made final. For example, if the applicant's request for reconsideration contains a §2(f) claim of acquired distinctiveness in response to a final §2(e)(1) refusal, and the claim fails to place the application in condition for approval, a nonfinal action may be appropriate. *See* [TMEP §714.05\(a\)\(i\)](#).

Whenever the examining attorney issues a new *nonfinal* action after remand of an application by the Trademark Trial and Appeal Board (Board), the Office action must include a response clause (*see* [TMEP §705.08](#)) and should explain that the applicant must respond to all refusals and/or requirements within the time period set forth in the Office action, but should not file another appeal to the Board. If the applicant does not respond to the new nonfinal action, the application will be abandoned for failure to respond. *See* [TMEP §718.02](#). If the applicant's response to the new nonfinal action does not resolve all outstanding refusals and/or requirements and put the application in condition for publication or registration on the

Supplemental Register, the examining attorney must issue a “Subsequent Final Action,” with the response clause omitted from the action. The subsequent final action should also notify the applicant that the appeal will be resumed. When proceedings with respect to the appeal are resumed, the Board will take further appropriate action with regard to any additional ground of refusal. *See Trademark Trial and Appeal Board Manual of Procedure (TBMP)* [§1209.01](#).

If the request for reconsideration does not raise a new issue, but presents new evidence that is significantly different from evidence previously submitted by the applicant, the examining attorney must issue a “Subsequent Final Action” that omits the response clause, specifies which issues are withdrawn and/or which amendments are accepted, and addresses the new evidence. The examining attorney may also introduce additional evidence directed to the new evidence submitted by the applicant. [TBMP §1207.04](#); [TMEP §715.03](#). For example, if an applicant files a consent agreement in response to a final refusal under §2(d) of the Trademark Act, and the examining attorney finds the consent agreement insufficient to overcome the refusal, the examining attorney must issue a “Subsequent Final Action” that discusses applicant’s consent agreement. However, the examining attorney should not issue a subsequent final action if the applicant merely states that it is negotiating a consent agreement. *See* [TMEP §714.05\(d\)](#). Further, because a subsequent final action issued after the filing of an appeal does not give the applicant a new response period, the subsequent final action must also inform the applicant that the Board will be notified to resume the appeal. When proceedings with respect to the appeal are resumed, any further request for reconsideration of the application must be made via a request for remand, for which good cause must be shown. *See* [TBMP §§1204, 1207.02](#).

Evidence or amendments that are merely cumulative and are not significantly different from material previously submitted do *not* raise a new issue that requires the examining attorney to issue a new nonfinal or subsequent final action. *In re GTE Educ. Servs.*, 34 USPQ2d 1478, 1480 (Comm’r Pats. 1994) (finding examining attorney properly determined that no new issue had been raised in request for reconsideration of final refusal based on inadequate specimens, because the substitute specimens submitted with the request were deficient for the same reason as the original specimens).

Submission of new arguments in response to the final refusal or requirement does not raise a new issue that requires the examining attorney to issue a new nonfinal or subsequent final action.

*See* [TMEP §§714.05–714.05\(f\)](#) for further information about delineating new issues that require issuance of a nonfinal action.

In a §66(a) application, the examining attorney cannot issue a new refusal more than 18 months after the date the IB forwards the request for extension of protection to the USPTO. *See* [TMEP §1904.03\(a\)](#).

## 716 Suspension of Action by USPTO

### *37 CFR §2.67 Suspension of action by the Patent and Trademark Office.*

Action by the Office may be suspended for a reasonable time for good and sufficient cause. The fact that a proceeding is pending before the Office or a court that is relevant to the issue of initial or continued registrability of a mark and that proceeding has not been finally determined, or the fact that the basis for registration is, under the provisions of section 44(e) of the Act, registration of the mark in a foreign country and the foreign application is still pending, will be considered *prima facie* good and sufficient cause. An Office or court proceeding is not considered finally determined until an order or ruling that ends the proceeding or litigation has been rendered and noticed, and the time for any appeal or other further review has expired with no further review sought. An applicant’s request for a suspension of action under this section, filed within the response period set forth in § 2.62(a), may be considered responsive to the previous Office action. The Office may require the applicant, registrant, or party to a proceeding to provide status updates and information relevant to the ground(s) for suspension, upon request.

The term “suspension of action” means suspending action *by the examining attorney*. It does not mean suspending or extending an applicant’s time to respond. The examining attorney has no discretion to suspend or extend the time for the applicant’s response. See [15 U.S.C. §1062\(b\)](#). See [TMEP §711.01](#) regarding requests for an extension of time to respond to an Office action with a three-month response period. However, an applicant’s timely filed request for suspension for good cause may constitute a proper response to an Office action.

When an acceptable ground for suspension is immediately apparent (e.g., prior-filed applications for conflicting marks are pending), the examining attorney will suspend an application only when the application is in condition for approval or final action, except for the matter on which suspension is based. Otherwise, the applicant must request suspension. See [TMEP §716.02](#) regarding the circumstances under which action may be suspended.

### **716.01 Form of Suspension Notice**

In a suspension notice, the examining attorney must specifically state that action is suspended and must omit any reference to a response period. If the application is in condition for a final action but for the matter necessitating suspension, the notice of suspension must clearly indicate which refusals or requirements have been resolved, if any, and which will be made final when the application is removed from suspension, assuming that no new issues have arisen. When the application is removed from suspension, the examining attorney must promptly issue a final action, if appropriate.

### **716.02 Circumstances Under Which Action May Be Suspended**

Under [37 C.F.R. §2.67](#), an examining attorney has the discretion to suspend an application “for good and sufficient cause.” The most common reasons for suspension of an application are discussed below.

As a general rule, the USPTO will not suspend an application to give an applicant time to secure a consent agreement. In addition, the USPTO will not suspend an application when a Section 2(d) refusal is issued and the record of the cited registration includes a show-cause order or an order for sanctions.

Any request to stay a deadline for responding to an Office action pending disposition of a petition to the Director should be directed to the Petitions Office, which is part of the Office of the Deputy Commissioner for Trademark Examination Policy. If such a request is sent to the examining attorney, the examining attorney should forward it to the Petitions Office. 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. See [37 C.F.R. §2.146\(g\)](#); [TMEP §1705.06](#). See [TMEP §716.02\(d\)](#) 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 without requesting permission.

#### **716.02(a) Applicant’s Petition to Cancel Cited Registration**

If the examining attorney refuses registration under §2(d) of the Trademark Act in view of the mark in a prior registration, the applicant may file a petition to cancel the registration under [15 U.S.C. §1064](#) and, within a proper response period, inform the examining attorney that the petition to cancel has been filed. This will constitute a proper response to the §2(d) refusal, and may be done by telephone, if there are no other outstanding issues that require a written response. The examining attorney will then suspend further action until the termination of the cancellation proceeding, if the application is otherwise in condition for approval or final refusal. The applicant should provide the number of the cancellation proceeding, if available;



however, if the applicant does not provide the cancellation number, the examining attorney may ascertain it from USPTO records.

The examining attorney should suspend further action only if the applicant states that the cancellation proceeding has already been filed or is being filed concurrently with the response to the Office action.

Although the examining attorney will determine the status of the cancellation proceeding through a routine status check (*see* [TMEP §716.04](#)), the applicant may call or email to advise the examining attorney when the registration has been cancelled, in order to avoid a delay in removing the application from suspension.

The examining attorney must not remove the application from suspension and withdraw the §2(d) refusal until the Trademark database shows that the registration is cancelled or expired.

When an application is suspended pending resolution of a cancellation proceeding, it is possible that a settlement agreement filed in the proceeding may be contingent upon the approval of an amendment or acceptance of a consent agreement filed in the suspended application, and the consequent approval of the application for publication. The Board has no jurisdiction over the application that is pending before the examining attorney. Thus, the applicant must file the amendment or consent agreement with the examining attorney, not with the Board. The examining attorney must consider the amendment or agreement and take appropriate action, including approving the application for publication, if appropriate. *See* [TBMP §605.03\(c\)](#).

In rare circumstances, the examining attorney may issue an Office action advising an applicant of a conflicting mark in an earlier-filed application and, during the response period, the mark registers and the applicant files a petition to cancel the registration. Although the applicant may respond to the Office action by informing the examining attorney that the petition to cancel has been filed, the examining attorney may not suspend under these circumstances because the application would not be in condition for final refusal if the registration is not cancelled. The examining attorney must first issue a non-final Office action refusing registration. The applicant may then respond by requesting suspension pending the outcome of the cancellation proceeding.

See [TMEP §716.02\(e\)](#) regarding suspension pending cancellation of a cited registration under §8 or §71 of the Act or expiration of a cited registration for failure to renew under §9 of the Act.

### **716.02(b) Submission of Copy of Foreign Registration in §44(d) Application**

When an applicant who claims the benefit of a prior foreign application under §44(d) of the Act, [15 U.S.C. §1126\(d\)](#), is required to submit a copy of a foreign registration, the applicant may respond to the requirement by stating that the foreign application is still pending. The examining attorney should then suspend further action pending receipt of a copy of the foreign registration, if the application is otherwise in condition for approval for publication, allowance for registration on the Supplemental Register, or final action. *See* [TMEP §1003.04\(a\)](#).

If an applicant asserts a claim of priority under §44(d) in addition to another basis, before suspending the application, the examining attorney must inquire whether the applicant wishes to retain §44(e) as a second basis for registration (based on the foreign registration that will issue from the foreign application on which the applicant relied for priority). However, if the application is filed via the trademark electronic filing system and indicates that the applicant is *not* relying on §44(e) as an additional basis for registration and is only asserting §44(d) to receive a priority filing date, the examining attorney will not inquire and will not suspend further action, but must ensure that the Trademark database is updated accordingly. *See* [TMEP §1003.04\(b\)](#) for further information.



If the applicant responds that it intends to assert a dual basis for registration and the application is otherwise in condition for approval for publication, allowance for registration on the Supplemental Register, or final action, the examining attorney should suspend further action pending receipt of the foreign registration.

During the suspension period, the examining attorney will issue an Office action approximately every six months after suspension to inquire as to the status of the foreign application. If the applicant does not respond to the inquiry, the application will be abandoned. See [TMEP §716.05](#).

The examining attorney may suspend the application pending receipt of the foreign registration only in a §44(d) application before issuance of the Notice of Allowance. In a §44(e) application, the examining attorney will not suspend the application pending submission of the foreign registration, unless the applicant establishes that it cannot obtain a copy of the foreign registration due to extraordinary circumstances (e.g., war or natural disaster). [TMEP §1004.01](#). However, the examining attorney may suspend a §44(e) application pending receipt of proof of renewal of the foreign registration. [TMEP §1004.01\(a\)](#).

### **716.02(c) Conflicting Marks in Pending Applications**

When there are conflicting marks in pending applications, action on the application with the later effective filing date will be suspended (if the application appears to be otherwise in condition for publication or issue or for a final action) until the mark in the conflicting application with the earlier effective filing date is either registered or abandoned. [37 C.F.R. §2.83\(c\)](#). See [TMEP §§1208–1208.02\(f\)](#) for more information about conflicting marks in pending applications.

If the examining attorney has cited an earlier-filed pending application, the applicant may respond by arguing that there is no likelihood of confusion between the marks. If the examining attorney is not persuaded by the applicant's arguments, the examining attorney should suspend the later-filed application pending disposition of the earlier-filed conflicting application. The suspension notice should include a statement that the applicant's arguments were not persuasive. It is not necessary to address the merits of the applicant's arguments prior to the initial suspension. See [TMEP §716.03](#) regarding the applicant's request to remove an application from suspension.

If the examining attorney discovers that an earlier-filed pending application was abandoned, but that a petition to revive is pending, the examining attorney should suspend the later-filed application pending disposition of the petition to revive. If the petition to revive is granted, the later-filed application will remain suspended until the mark in the earlier-filed application is registered or the earlier-filed application is again abandoned. See [TMEP §§718.07](#) and [1208.01\(d\)](#) for information on conducting a new search for conflicting marks when an abandoned application is revived or reinstated.

When an application is suspended pending the disposition of more than one earlier-filed conflicting application, and one of the conflicting applications matures into registration, the examining attorney will normally not issue a refusal of registration until all the remaining conflicting application(s) are registered or abandoned, in order to avoid issuing piecemeal refusals. However, if deemed appropriate, the examining attorney does have the discretion to issue a refusal of registration under §2(d) in this situation.

Sometimes, the applicant will file an opposition to the registration of the earlier-filed conflicting mark. In this situation, it is possible that a settlement agreement filed in the Board proceeding may be contingent upon the approval of an amendment or acceptance of a consent agreement filed in the suspended application, and the consequent approval of the application for publication. The Board has no jurisdiction over the application that is pending before the examining attorney. Thus, the applicant must file the amendment or

consent agreement with the examining attorney, not with the Board. The examining attorney must consider the amendment or agreement and take appropriate action. See [TBMP §605.03\(c\)](#).

### **716.02(d) Inter Partes or Court Proceeding**

If an examining attorney learns of a proceeding pending before the Trademark Trial and Appeal Board (Board) or a court that may result in a decision that supports a refusal of registration of an applicant's mark, the examining attorney must issue the refusal and give the applicant an opportunity to respond before suspending the application. If the applicant is not a party to the inter partes or court proceeding, the examining attorney must explain why the proceeding is relevant to the registrability of the applicant's mark.

When an applicant requests suspension because a proceeding relevant to the registrability of the applicant's mark is pending before the Board or a court, the applicant must submit a copy of the relevant pleadings, the docket number of the proceeding, and a written explanation of why the proceeding is relevant to the registrability of the mark. 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 a relevant application or registration. However, when resolution of the court action requires the court to consider questions of USPTO policy or procedure, the examining attorney should not assume that the court would prefer to decide such questions absent the USPTO's decision in the consideration of an application.

In these instances, action on an application should generally not be suspended. It is important to review the relevant pleadings, including the complaint and answer, before determining whether suspension is appropriate. The Office of the Solicitor may be consulted if there is a question as to whether suspension of the application is appropriate.

A third party who wishes to request suspension of a pending application because a proceeding relevant to the registrability of the mark is pending before a court must do so by filing a letter of protest. See [TMEP §1715–1715.06](#). 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, 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 abandonment or amendment of the application that is the subject of the letter of protest. If the letter of protest is granted, the examining attorney is informed that a request for suspension has been received based on an alleged likelihood of confusion with a registered mark or prior pending application that is the subject of pending litigation.

Before an application is suspended, the applicant must respond to all outstanding issues raised in the examining attorney's Office action that are not related to the proceeding. The examining attorney should not suspend the application unless all matters not related to the proceeding are resolved or in condition for final action.

When an application has been suspended for a Board or court proceeding, the suspension normally will be maintained while the proceeding remains pending and until the proceeding has been finally determined. A Board or court proceeding is not considered to have been finally determined until an order or ruling that ends litigation has been rendered and the time for any review has expired with no further review sought. The expiration of any further review includes the time for appeal, petitioning for rehearing, or U.S. Supreme Court review. Thus, the suspension normally will not be lifted until after the time for seeking such review has expired, a decision denying or granting such review has been rendered, and any further review has been completed. The Office retains discretion to condition approval of continued suspension on the applicant providing information about the status of the Board or court proceeding.

See [TMEP §716.02\(a\)](#) regarding suspension pending disposition of an applicant's petition to cancel a cited registration under [15 U.S.C. §1064](#), [TMEP §716.02\(c\)](#) regarding suspension of later-filed conflicting marks, [TMEP §716.03](#) regarding the applicant's request to remove an application from suspension, and [TBMP §605.03\(c\)](#) regarding filing an amendment or consent agreement in a pending application owned by the plaintiff pursuant to a settlement agreement between the parties in an ex parte proceeding before the Board.

### **716.02(e) Pending Cancellation or Expiration of Cited Registration**

When the owner of a registration submits a timely affidavit or declaration of continued use or excusable nonuse under [15 U.S.C. §1058](#) (§8 affidavit) or [§1141k](#) (§71 affidavit) or an application for renewal under [15 U.S.C. §1059](#), the USPTO's automated records are updated to indicate receipt of the document and the action taken on the document. The USPTO waits until 10 days *after* the expiration of the grace period for filing the §8 or §71 affidavit or §9 renewal application before updating its records to show that the registration is cancelled or expired.

The USPTO's automated records are updated approximately 10 days after the grace period expires to indicate that a registration is cancelled or expired if:

- (1) No §8 or §71 affidavit has been filed before the end of the six-month grace period following the sixth year after the date of registration (or publication under §12(c) of the Trademark Act, [15 U.S.C. §1062\(c\)](#), for §8 affidavits);
- (2) No §8 or §71 affidavit has been filed before the end of the six-month grace period following the end of any ten-year period after the date of registration; or
- (3) No §9 renewal application has been filed before the end of the six-month grace period following the expiration of the previous term of registration.

See [TMEP §§1602–1602.04](#) regarding the duration of a registration, [§1604.04](#) regarding the due dates for §8 affidavits, [§1606.03](#) regarding the due dates for §9 renewal applications, and [§1613.04](#) regarding the due dates for §71 affidavits.

The examining attorney must confirm the status of the cited registration to ensure that it is still active before issuing any refusal of registration under Trademark Act §2(d) or filing a brief on appeal of a §2(d) refusal.

If the examining attorney is ready to issue a *nonfinal* refusal of registration under §2(d), and the Trademark database shows that the registration is still active, the examining attorney must issue the refusal even if the grace period for filing a §8 or §71 affidavit or §9 renewal application for the cited registration has passed and the Trademark database does not indicate that the owner has filed a §8 or §71 affidavit or §9 renewal application. The examining attorney must not suspend the application, but must advise the applicant that the grace period for filing the §8 or §71 affidavit or §9 renewal application has passed and that it appears that the registration may be subject to cancellation under §8 or §71 and/or expiration under §9.

If the examining attorney is ready to issue a *final* refusal of registration under §2(d), and the cited registration is in the grace period for filing a §8 or §71 affidavit or §9 renewal application, the examining attorney must suspend action pending a determination of whether the registrant timely files, and the USPTO accepts, the §8 or §71 affidavit and/or whether the registration is renewed. If the registrant timely files, and the USPTO accepts, the §8 or §71 affidavit and/or the cited registration is renewed, the examining attorney will remove the application from suspension and issue the final refusal.

Similarly, if the examining attorney is ready to issue a denial of a request for reconsideration of a final refusal of registration under §2(d), and the cited registration is in the grace period for filing a §8 or §71 affidavit or §9 renewal application, the examining attorney must suspend action. If the registrant timely files, and the USPTO accepts, the §8 or §71 affidavit and/or the cited registration is renewed, and the applicant has not filed an appeal, the examining attorney will remove the application from suspension and issue a "Subsequent Final Action," thereby giving the applicant a new response period in which to file an appeal. If the applicant filed the request for reconsideration in conjunction with a notice of appeal, the examining attorney will remove the application from suspension and issue a "Request for Reconsideration Denied" and the Trademark Trial and Appeal Board will be notified to resume the appeal.

If the grace period for filing a §8 or §71 affidavit or §9 renewal application for the cited registration has passed, and the examining attorney is ready to issue a *final* refusal of registration under §2(d), or a denial of a request for reconsideration of a final refusal of registration under §2(d), the examining attorney must not issue the action until the USPTO's automated records indicate that the owner has filed the §8 or §71 affidavit or §9 renewal application, and the USPTO has accepted the §8 or §71 affidavit or granted renewal. Instead, the examining attorney must suspend action for six months pending final disposition of the cited registration.

If the grace period for filing a §8 or §71 affidavit or §9 renewal application for the cited registration has passed, and the examining attorney is ready to write an appeal brief, the examining attorney must request a remand so that the application can be suspended pending final disposition of the cited registration. The Board will issue an order suspending the appeal and remanding the case to the examining attorney. If the cited registration is cancelled or expires, the examining attorney must withdraw the §2(d) refusal and notify the applicant that it has been withdrawn. If an appropriate affidavit or renewal application is filed for the cited registration, the examining attorney must notify the Board; the Board will resume proceedings and reset the time for filing the examining attorney's appeal brief. Similarly, if the cited registration is cancelled or expires, but the §2(d) refusal is only one of the issues on appeal, the examining attorney must notify the Board of the status of the cited registration. The Board will resume proceedings and reset the time for filing a brief. See [TBMP §1213](#) regarding the suspension of an ex parte appeal pending cancellation of the cited registration under §8, §9, or §71 of the Act.

The examining attorney cannot withdraw a refusal of registration under §2(d) until the Trademark database shows that the registration is cancelled or expired. If the examining attorney determines that 10 days have passed since the expiration of the grace period, but the Trademark database does not indicate that the registration has been cancelled or expired, the examining attorney should contact the Supervisor of the Post Registration Section and request that the database be updated to show that the registration is cancelled or expired.

See [TMEP §1611](#) for information about how the owner of a registration who has not timely filed a §8 or §71 affidavit or §9 renewal application may expedite the cancellation or expiration of its own registration.

### **716.02(f) Pending Expiration of "Insurance" Extension Request**

When the applicant files a timely "insurance" extension request (i.e., in conjunction with the statement of use or within the same six-month period that the statement of use is filed; see [TMEP §§1108.03–1108.03\(a\), 1109.16\(c\)](#)), there are rare instances when the period for response to a final Office action may expire before the statutory period for filing the statement of use. If the applicant can overcome any grounds for refusal and/or comply with any requirement raised in the final action before expiration of the time for filing the statement of use, but not within the time for responding to the final Office action, the applicant must still file a timely response to the Office action. The response must state that the applicant intends to comply with

the statutory requirements for filing the statement of use on or before the expiration of the statutory filing period and request suspension of the application. The examining attorney should then suspend the application for only the amount of time remaining in the statutory period for filing the statement of use. The applicant will then have until the end of the extension period to overcome any grounds for refusal and/or comply with any requirement.

*Example:* The notice of allowance issues on September 22, 2022 and a statement of use and/or extension of time to file a statement of use is due on or before March 22, 2023. The applicant files a statement of use on November 15, 2022. On December 5, 2022, the examining attorney issues an Office action regarding the acceptability of the specimen and the applicant responds on December 8, 2022 but does not correct the specimen deficiency. The examining attorney then issues a final Office action on December 29, 2022 regarding the specimen issue. If the applicant files a timely “insurance” extension request on or before March 22, 2023, this would extend the time to perfect the statement of use to September 22, 2023. However, the applicant must still respond to the final Office action or request extension of the response deadline by March 29, 2023. The response must include a request to suspend the application or the application will be abandoned for failure to respond. The examining attorney would then suspend the application until September 22, 2023, which is the date of expiration of the extension period and the deadline for complying with the statutory requirements for a statement of use.

If the applicant files a response to the final Office action prior to the expiration of the statutory period for filing a statement of use, and the response overcomes the grounds for refusal and/or complies with any requirement, the examining attorney will remove the application from suspension and withdraw the refusal.

If the applicant files a response to the final Office action prior to expiration of the deadline for filing the statement of use, but the response does not overcome the grounds for refusal and/or comply with any requirement, the examining attorney must issue a “Subsequent Final Action,” thereby reissuing the final refusal, and the applicant will have three months to respond. See [TMEP §§716.06, 1109.16\(d\)](#). See [TMEP §711.01](#) regarding requests for an extension of time to respond to an Office action with a three-month response period.

### **716.02(g) Pending Receipt of a Correction, Limitation, Assignment, or other Change to the International Record from the International Bureau**

All changes to the international registration (e.g., corrections to the international registration, assignments, cancellations, and changes to the holder’s name and mailing address) must be filed directly with the International Bureau (IB). See Regs Rules 25 and 28; [TMEP §1906.01](#). Moreover, the Madrid System provides an optional procedure for holders to file limitations to the listing of goods and services in a request for extension of protection and changes to a juristic entity’s entity type and citizenship through the IB.

In a §66(a) application, if the applicant states in a timely filed response to an Office action that it has filed a request with the IB that will affect the prosecution of the application, but the USPTO has not been notified by the IB of the change, the applicant should request suspension of the application pending receipt of the filing from the IB. The applicant must support the request to suspend the application with a copy of the filing submitted to the IB.

For example, if it appears that there is an error in the classification of the goods/services in the underlying international registration, the applicant may contact the International Bureau (IB) to request correction of the international registration or to request recordation of a limitation of the list of goods and services for the request for extension of protection. In such cases, the USPTO will suspend prosecution of the §66(a)



application if the applicant requests suspension in a timely response to an Office action requiring amendment of the identification, or any other matter, and supports the suspension request with a copy of the request for correction or request to record a limitation, a cancellation, a change of ownership, a change in the name or mailing address of the holder, a change to the entity information for a juristic entity, or any other relevant request filed with the IB. See [TMEP §1904.02\(c\)\(iv\)](#).

### **716.02(h) Pending Recordation of an Assignment Document**

During initial examination, the examining attorney should not suspend action or delay issuance of a final action to await recordation of a document. However, in an application under §1 or §44, if the applicant states that a request to record a change of ownership has been filed with the Assignment Recordation Branch but is not yet recorded, and the application is in condition to be approved for publication or registration on the Supplemental Register, the examining attorney should suspend the application until the document has been recorded and the information regarding the assignment or the change of name has been entered into the Trademark database. In an application under §66(a), if the applicant states that a request to record a change of ownership has been filed with the IB but is not yet recorded, and the application is in condition to be approved for publication, the examining attorney should suspend action pending recordation of the document and entry of the information into the Trademark database. See [TMEP §§502.02\(a\)-\(c\)](#).

Similarly, during examination of the statement of use in an application under §1(b), the examining attorney should withhold final approval for registration until the relevant document has been recorded and the information regarding the assignment or the applicant's new name has been entered in the Trademark database. See [TMEP §502.02\(c\)](#).

### **716.02(i) Pending Registry Agreement with ICANN for Marks Comprised Solely of gTLDs for Domain Registry Operator and Domain Name Registrar Services**

With regard to an application for a mark composed solely of a gTLD for domain registry operator and domain name registrar services, the examining attorney may issue an information request under Trademark Rule 2.61(b), [37 C.F.R. 2.61\(b\)](#), that requires the applicant to submit a verified statement indicating whether the applicant has in place, or has applied for, a Registry Agreement with the Internet Corporation for Assigned Names and Numbers (ICANN) designating the applicant as the Registry Operator for the gTLD identified by its mark. If, in response, the applicant indicates that it has a currently pending application before ICANN for a Registry Agreement for the gTLD identified by its mark, and the applicant has otherwise demonstrated that the mark consisting of the gTLD could function as a mark, the examining attorney may suspend the application until the resolution of the applicant's pending application with ICANN. See [TMEP §§1215.02\(d\) 1215.02\(d\)\(iv\)](#) regarding examination of marks comprised solely of gTLDs for domain registry operator and domain name registrar services.

### **716.02(j) Pending Disposition of Expungement or Reexamination Proceedings**

A pending trademark application may be suspended pending the disposition of an expungement or reexamination proceeding. See [37 C.F.R. §§2.67, 2.117\(a\)](#). The fact that an expungement or reexamination proceeding is pending before the USPTO that is relevant to the issue of initial or continued registrability of a mark, and that proceeding has not been finally determined, will be considered prima facie good and sufficient cause for suspension. [37 C.F.R. §2.67](#).



The following suspension guidelines apply when an examining attorney has cited, or will cite, a registration under §2(d) of the Trademark Act that is the subject of a petition for expungement or reexamination or an expungement or reexamination proceeding:

If the examining attorney is **ready to issue a *nonfinal* refusal** of registration under §2(d), and the Trademark database shows that a petition for expungement or reexamination was filed and has not been acted upon, or that an expungement or reexamination proceeding was instituted, the examining attorney must not suspend the application, but must issue the refusal under §2(d). The Office action may include an advisory that, after receipt of a timely response, the application may be suspended pending a determination of whether the expungement or reexamination proceeding will be instituted and/or upon a final determination regarding such a proceeding.

If the examining attorney is **ready to issue a *final* refusal** of registration under §2(d), and the Trademark database shows that a petition for expungement or reexamination was filed and has not been acted upon, or that an expungement or reexamination proceeding was instituted and has not been terminated, the examining attorney must suspend action pending a determination of whether the expungement or reexamination proceeding will be instituted and/or upon a final determination regarding such a proceeding. If a proceeding is not instituted at the petition stage, or the proceeding was instituted but has been terminated, the examining attorney will remove the application from suspension and issue a final refusal, as appropriate.

If the examining attorney is **ready to issue a *denial of a request for reconsideration*** of a final refusal of registration under §2(d), and the Trademark database shows that a petition for expungement or reexamination was filed and has not been acted upon, or that an expungement or reexamination proceeding was instituted and has not been terminated, the examining attorney must suspend action pending a determination of whether the expungement or reexamination proceeding will be instituted and/or upon a final determination regarding such a proceeding. If the petition to institute a proceeding is not granted, or the proceeding was instituted but has been terminated, and the applicant has not filed an appeal, the examining attorney will remove the application from suspension and issue a "Subsequent Final Action," as appropriate, thereby giving the applicant a new response period in which to file an appeal. If the applicant filed the request for reconsideration in conjunction with a notice of appeal, the examining attorney will remove the application from suspension and issue a "Request for Reconsideration Denied," as appropriate, and the Trademark Trial and Appeal Board will be notified to resume the appeal. See [TMEP §716.06](#) regarding removing an application from suspension after a final Office action is issued.

An applicant may, within the proper response period set forth in [37 C.F.R. §2.62\(a\)](#), inform the examining attorney of the filing of a petition for expungement or reexamination regarding a cited registration, or the institution of a proceeding resulting from such a petition, and request suspension of the pending application. See [37 C.F.R. §§2.67](#). This request will constitute a proper response to the §2(d) refusal and may also be done by telephone or email if there are no other issues that require a written response. The examining attorney must confirm that the petition or the notice of institution is in the record of the cited registration, and that the petition has not been acted upon or the proceeding is ongoing, prior to suspending the application, if appropriate. However, the mere filing of a petition to institute an expungement or reexamination proceeding with respect to a cited registration does not constitute a response to an outstanding Office action.

A USPTO or court proceeding is not considered finally determined until an order or ruling that ends the proceeding or litigation has been rendered and noticed, and the time for any appeal or other further review has expired with no further review sought. *Id.* Accordingly, an expungement or reexamination proceeding is considered to end when a notice of termination under [37 C.F.R. §2.94](#) has been issued. See [TMEP §1716.04\(e\)](#) regarding notice of termination. If a registration subject to an expungement or reexamination proceeding is cited in a refusal under §2(d) against a pending application, and is not withdrawn for other

reasons, the refusal cannot be withdrawn until the Trademark database shows that the proceeding is terminated and the registration is cancelled. *Cf.* [TMEP §1716.02\(e\)](#).

If the examining attorney is ready to write an appeal brief or has already submitted an appeal brief including a refusal of registration under §2(d), and the Trademark database shows that a petition for expungement or reexamination was filed and has not been acted upon, or that an expungement or reexamination proceeding was instituted and has not been terminated, the examining attorney may request suspension of the appeal pending the determination of the expungement or reexamination proceeding. *See* [TBMP §1213](#).

### 716.02(k) Pending Disposition of Post Registration Audit

The USPTO conducts random audits of §8 and §71 affidavits or declarations in which the mark is registered for more than one good or service per class under [37 C.F.R. §2.161\(b\)](#), [TMEP §1604.22](#) and [§1613.22](#). When a registration that is the subject of a post registration audit forms the basis for a §2(d) refusal as to a pending trademark application, the application may be suspended pending the disposition of the audit.

The following suspension guidelines apply when an examining attorney has cited, or will cite, a registration under §2(d) of the Trademark Act that is the subject of a post registration audit:

If the examining attorney is **ready to issue a *nonfinal* refusal** of registration under §2(d), the examining attorney must not suspend the application, but must issue the refusal under §2(d). The applicant may state in a timely filed response to the Office action that the cited registration is the subject of an ongoing post registration audit that may render the §2(d) refusal moot, and may request suspension of the application pending acceptance of the post registration maintenance document or cancellation of the registration in full or in part.

If the examining attorney is **ready to issue a *final* refusal** of registration under §2(d), and the Trademark database shows that the cited registration is the subject of an ongoing post registration audit, the examining attorney must suspend action pending acceptance of the post registration maintenance document or cancellation of the registration in full or in part.

If the examining attorney is **ready to issue a *denial of a request for reconsideration*** of a final refusal of registration under §2(d), and the Trademark database shows that the cited registration is the subject of an ongoing post registration audit, the examining attorney must suspend action pending acceptance of the post registration maintenance document or cancellation of the registration in full or in part. If the maintenance document is accepted and the grounds for refusal remain operative, the examining attorney will remove the application from suspension and issue a "Subsequent Final Action," as appropriate, thereby giving the applicant a new response period in which to file an appeal. If the applicant filed the request for reconsideration in conjunction with a notice of appeal, the examining attorney will remove the application from suspension and issue a "Request for Reconsideration Denied," as appropriate, and the Trademark Trial and Appeal Board will be notified to resume the appeal. *See* [TMEP §716.06](#) regarding removing an application from suspension after a final Office action is issued.

### 716.02(l) Pending Decision on a Petition to Waive the Domicile Address Requirement

An applicant may file a petition to the Director to waive the domicile address requirement of Trademark Rule 2.189 when an extraordinary situation exists that would justify waiving the rule. *See* [37 C.F.R. §§2.146\(a\)\(5\)](#), [2.148](#), [2.189](#); [TMEP §1708.01](#).

The following suspension guidelines apply when an applicant has filed a petition to the Director to waive the domicile address requirement:

*Petition pending prior to issuing a first Office action.* If the application appears to be otherwise in condition for publication (i.e., the domicile address is the only issue), the examining attorney must suspend the application pending a decision on the petition to waive the domicile address requirement. The examining attorney may not approve the application for publication. Permission to suspend is not required from the Petitions Office. However, the application must not be suspended if the application is not otherwise in condition for publication. In this situation, the examining attorney must issue all applicable refusals and/or requirements, including the domicile address requirement, in the first Office action.

*Petition pending prior to issuing a final Office action.* If a petition to the Director to waive the domicile address requirement is pending after a domicile address requirement has been issued, and the application is otherwise in condition for issuance of a final Office action, the examining attorney may suspend the application only if: (1) the applicant has requested suspension, and (2) the Petitions Office has provided permission to suspend. The mere filing of a petition does not constitute a response to an outstanding Office action. The applicant must file a timely response to avoid abandonment of the application. In this situation, the examining attorney must use the “Request to Suspend Action Pending Petition Decision” to request permission to suspend action pending a decision on a petition to waive the domicile address requirement. If permission is granted, the Petitions Office staff will add a Note to the File (also referred to as a Public Note or Notation to File) granting permission to suspend and inform the examining attorney via email that they may issue a suspension action noting the pending petition as a reason for suspension. Once the petition decision is issued, a petitions attorney or paralegal will notify the examining attorney via email.

*Petition pending after issuing a final Office action.* If a petition to the Director is pending after a final domicile address requirement has been issued, and the application appears to be otherwise in condition for publication (i.e., the domicile address is the only issue), the examining attorney may suspend the application pending a decision on the petition. Permission to suspend is not required from the Petitions Office.

### **716.03 Applicant’s Arguments Against Suspension**

If an examining attorney suspends action on an application, and the applicant believes the suspension is improper, the applicant may file a request to remove the application from suspension. The applicant should state the reasons for the belief that the suspension is improper and attach any relevant evidence.

If persuaded by the request, the examining attorney should remove the application from suspension, resume examination of the application, and take appropriate action.

If not persuaded by the request, the examining attorney must issue a new suspension action *that addresses the applicant’s arguments and explains the reasons why the request is not granted*. The applicant’s recourse is to file a petition to the Director to review the examining attorney’s action continuing the suspension. The Director will reverse the examining attorney’s action only where there has been clear error or an abuse of discretion. See [TMEP Chapter 1700](#) for information about petitions.

If an applicant argues preemptively against suspension based on a conflicting mark in a prior-filed application, and the examining attorney finds the arguments unpersuasive, the examining attorney must include a statement to that effect in the suspension notice. The recommended practice is to briefly address the merits of the unpersuasive arguments prior to an initial suspension.

## 716.04 Suspended Docket Checked

The suspended docket is reviewed at least every six months to determine whether continued suspension is appropriate. If the application should remain suspended, the suspension check is reported in the Trademark database. If suspension is no longer necessary, the examining attorney is notified and will take the appropriate action.

## 716.05 Inquiry by Examining Attorney Regarding Suspended Application

In certain circumstances, if the application has been suspended for six months or more, the examining attorney will issue an Office action inquiring as to the status of the matter on which suspension was based. For example, if action is suspended pending the receipt of a copy of a foreign registration or proof of renewal of a foreign registration, the examining attorney will inquire every six months during the suspension period as to the status of the foreign application or registration. Similarly, for applications that are suspended pending the outcome of a civil action, the examining attorney will inquire every six months as to the status of the proceeding. If the foreign application or the civil action is still pending, a statement by the applicant to this effect is a proper response. Upon receipt of such a proper response to such a suspension inquiry, the examining attorney must issue a new suspension letter.

If the applicant does not respond to the suspension inquiry, the application will be abandoned for failure to respond.

The examining attorney should *not* issue any inquiry if the relevant information is available in the USPTO databases, including information regarding the status of a proceeding pending in the USPTO (e.g., an inter partes proceeding).

## 716.06 Suspension After Final Action

If the examining attorney determines that action on an application should be suspended after issuance of a final refusal, the examining attorney must issue a suspension notice. This may occur, for example, when the applicant files a petition to cancel a cited registration or in the limited circumstance in a Section 1(b) application when the applicant files a timely “insurance” extension request but the time period for responding to the Office action may expire before the end of the extension period for the statement of use. See [TMEP §§716.02\(a\) and \(f\)](#), [1109.16\(d\)](#). The examining attorney should not “withdraw the finality” of the refusal in order to suspend; however, in the suspension notice, the examining attorney should inform the applicant that the refusal of registration is continued but that it is not necessary to respond to the final refusal until the application is removed from suspension.

If the application is eventually removed from suspension and the grounds for refusal remain operative, the examining attorney should issue a “Subsequent Final Action,” thereby reissuing the final refusal. See [TMEP §711](#) regarding the deadline for response to an Office action. It is inappropriate to remove the case from suspension and immediately declare the application abandoned.

## 717 Reissuing an Office Action

*USPTO error*. If the USPTO issued an Office action to the wrong email address (e.g., if the USPTO entered the correspondence address of record incorrectly or did not enter a proper previously filed request to change the correspondence address), the USPTO may reissue the Office action with a new response period if the applicant notifies the USPTO prior to the expiration of any deadline for response. The USPTO will reissue

the Office action by notifying the applicant that it may view and print the Office action via the TSDR portal at <https://tsdr.uspto.gov>. If there is no time remaining in the response period, the applicant may request reinstatement. See [TMEP §1712](#).

*No USPTO error.* If the USPTO issued an Office action to the correct email address, the Office action will not be reissued. If there is no time remaining in the response period, the applicant may file a petition to revive the application. See [TMEP §1714](#).

An applicant must maintain a valid email address for correspondence for itself and its attorney, if one is appointed, and periodically monitor the status of the application to ensure that deadlines are met. [37 C.F.R. §§2.18\(c\), 2.23\(d\)](#); see [TMEP §§108.03, 609.03](#). See [TMEP §§609.02–609.02\(f\)](#) regarding changing the correspondence address.

See [TMEP §608.02](#) regarding Office actions sent to individuals who are subsequently excluded from practice before the USPTO, [§717.01](#) regarding Office actions returned as undeliverable, and [§717.02](#) regarding non-receipt of mailed Office actions.

### **717.01 Email Notice of Office Action Undeliverable**

If an email transmission fails for any reason, the USPTO will not attempt to contact the correspondent by any other means. Thus, if an emailed notification of an issued Office action is returned as undeliverable, the USPTO will not reissue the email or mail a paper copy of the Office action. See [TMEP §304](#) regarding email and [TMEP §403](#) for more information about returned correspondence. Trademark applicants are required to monitor the status of their applications by checking the status every six months between the filing date of the application and the issuance of a registration to ensure that crucial deadlines are met. [37 C.F.R. §2.23\(d\)\(1\)](#). See [TMEP §108.03](#) and [§1705.05](#) regarding due diligence and the duty to monitor status.

See [TMEP §717](#) regarding the applicable procedure if an Office action is sent to the wrong address due to a USPTO error. If no communication from the applicant is received within the period for response, the application will be abandoned.

See [TMEP §1712](#) regarding requesting reinstatement of applications abandoned due to USPTO error and [§1714](#) concerning filing a petition to revive an application abandoned due to unintentional delay.

### **717.02 Permitted Paper Filings: Non-Receipt of Mailed Office Action**

If an applicant notifies the USPTO that the applicant did not receive a mailed Office action, either before or after the expiration of the response period, the examining attorney must check to determine whether the action was sent to the correct correspondence address. See [TMEP §§609–609.03](#). See [TMEP §301.01](#) regarding the limited exceptions when paper submissions may be submitted.

*No USPTO error.* If the Office action was sent to the correspondence address of record, and there is time remaining in the response period, the examining attorney should direct the applicant to view the full record on the TSDR portal on the USPTO website at <https://tsdr.uspto.gov/>, and advise the applicant that the deadline for response runs from the original issue date and that a response must be received in the USPTO before this deadline to avoid abandonment.

If the response period has expired, the examining attorney should advise the applicant that the application is abandoned, and that the applicant may file a petition to revive if the applicant can meet the timeliness

requirements in [37 C.F.R. §2.66\(a\)](#). See [TMEP §§1714–1714.01\(g\)](#) regarding petitions to revive. In either situation, the examining attorney should enter an appropriate Note to the File (also referred to as a Public Note or Notation to File) in the application record documenting the discussion.

*USPTO error.* If there is evidence in the record that the USPTO sent the Office action to the wrong address due to a USPTO error (*see* [TMEP §717](#)), and the application has not been abandoned, the USPTO will reissue the action and provide the applicant with a new response period. The examining attorney should first ensure that the correspondence address has been corrected, and then email the internal TM Clerical Support mailbox, stating that the Office action was sent to the wrong address, and requesting that the Office action be reissued with a new response period. The deadline for response will run from the new issue date. If the application had been abandoned, it will be reinstated and the Office action reissued. See [TMEP §1712.01](#) regarding reinstatement of applications that are abandoned due to USPTO error.

## 718 Abandonment

An abandoned application is an application for registration that is removed from the USPTO docket of pending applications because of express abandonment or because the applicant failed to take appropriate action within the specified response period.

### 718.01 Express Abandonment by Applicant or Applicant's Attorney

#### *37 CFR 2.65(b)*

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

#### *37 CFR §2.68 Express abandonment (withdrawal) of application.*

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

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

#### *37 CFR §2.135 Abandonment of application or mark.*

After the commencement of an opposition, concurrent use, or interference proceeding, if the applicant files a written abandonment of the application or of the mark without the written consent of every adverse party to the proceeding, judgment shall be entered against the applicant. The written consent of an adverse party may be signed by the adverse party or by the adverse party's attorney or other authorized representative.

Generally, all express abandonments filed via the trademark electronic filing system are processed electronically and the Trademark database is automatically updated to indicate that the application has been expressly abandoned and generates a notice to the applicant that the application is abandoned. However, in the later stages after the application has been approved for publication, the trademark electronic filing system will not automatically process an incoming express abandonment, and the express abandonment must be reviewed manually. The USPTO is generally unable to withdraw a mark from publication or issue unless the express abandonment is received and processed at least twenty days before the scheduled publication date or registration issuance date.

Paper letters of express abandonment, if permitted, are reviewed by examining attorneys. See [TMEP §301.01](#) regarding the limited exceptions when paper submissions may be submitted.



All letters of express abandonment must be signed by the individual applicant, someone with legal authority to bind a juristic applicant (e.g., an officer of a corporation or general partner of a partnership), or a qualified U.S. attorney. [37 C.F.R. §2.68\(a\)](#); *see* , [TMEP §611.02](#). The same principles that govern the signature of responses to Office actions (*see* [TMEP §§712, 712.01](#)) apply to the signature of express abandonments. For express abandonments permitted to be filed on paper (*see* [TMEP §301.01](#)), the examining attorney must ensure that the letter of express abandonment is signed by a proper party. If the applicant is represented by a qualified U.S. attorney, the attorney must personally sign the letter of express abandonment. [37 C.F.R. §§2.193\(e\)\(2\)\(i\), 11.18\(a\)](#). If the applicant is pro se, the letter of express abandonment must be personally signed by the individual applicant or someone with legal authority to bind a juristic applicant. [37 C.F.R. §§2.193\(e\)\(2\)\(ii\), 11.14\(e\)](#). *See* [TMEP §§611.06-611.06\(h\)](#) for more information about persons who have legal authority to bind various types of juristic applicants, and [TMEP §611.05](#) and [§712.03](#) regarding documents signed by unauthorized parties.

An application cannot be expressly abandoned by examiner's amendment.

When an applicant files a permitted paper letter of express abandonment (*see* [TMEP §301.01](#)) that meets the requirements of [37 C.F.R. §2.68\(a\)](#), the examining attorney should perform a database transaction expressly abandoning the application, effective as of the filing date of the letter of express abandonment, which will generate a letter notifying the applicant that the application is abandoned.

If it is unclear whether a document is a letter of abandonment, the examining attorney should contact the applicant to inquire about the applicant's intention before abandoning the application.

If an applicant files an express abandonment of an application that is not the subject of an inter partes proceeding before the Trademark Trial and Appeal Board (Board), and wants to withdraw the abandonment to resume prosecution of the application, the applicant must petition the Director under [37 C.F.R. §§2.146\(a\)\(5\)](#) and [2.148](#) to waive [37 C.F.R. §2.68\(a\)](#) to permit withdrawal of the express abandonment, within two months of the effective date of abandonment. *See* [37 C.F.R. §2.146\(d\)](#). However, such a petition will be granted only in an extraordinary situation, where justice requires, and no other party is injured. *See In re Glaxo Grp. Ltd.*, 33 USPQ2d 1535 (Comm'r Pats. 1993); *cf. Christiane E, LLC v. Int'l Expeditions, Inc.*, 106 USPQ2d 2042 (TTAB 2013).

If the applicant files a written request to abandon the application after the commencement of an opposition proceeding, the request for abandonment must be filed with the Board, and must include the written consent of every adverse party to the proceeding. If the applicant files a request for abandonment without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant. [37 C.F.R. §2.135](#). If an applicant whose application is the subject of an opposition proceeding files an express abandonment of the application after the commencement of the opposition proceeding, but before receipt of the Board's notice of the filing of the opposition, the Board will allow the applicant an opportunity to obtain and submit the written consent of every adverse party or to withdraw the abandonment because an unconsented abandonment, if not withdrawn, may result in entry of judgment against the applicant in the opposition. [TBMP §602.01](#). It is not necessary to obtain consent of a potential opposer during an extension of time to oppose. [TBMP §218](#).

In a §66(a) application, an applicant may file a letter of express abandonment either with the USPTO or with the IB.

## 718.02 Failure by Applicant to Take Required Action During the Relevant Response Period

### 15 U.S.C. §1062(b)

(1) If the applicant is found not entitled to registration, the examiner shall notify the applicant thereof and of the reasons therefor. The applicant may reply or amend the application, which shall then be reexamined. This procedure may be repeated until the examiner finally refuses registration of the mark or the application is abandoned as described in paragraph (2).

(2) After notification under paragraph (1), the applicant shall have a period of 6 months in which to reply or amend the application, or such shorter time that is not less than 60 days, as prescribed by the Director by regulation. If the applicant fails to reply or amend or appeal within the relevant time period, including any extension under paragraph (3), the application shall be deemed to have been abandoned, unless it can be shown to the satisfaction of the Director that the delay in responding was unintentional, in which case the application may be revived and such time may be extended. The Director may prescribe a fee to accompany any request to revive.

(3) The Director shall provide, by regulation, for extensions of time to respond to the examiner for any time period under paragraph (2) that is less than 6 months. The Director shall allow the applicant to obtain extensions of time to reply or amend aggregating 6 months from the date of notification under paragraph (1) when the applicant so requests. However, the Director may set by regulation the time for individual periods of extension, and prescribe a fee, by regulation, for any extension request. Any request for extension shall be filed on or before the date on which a reply or amendment is due under paragraph (1).

Under [15 U.S.C. §1062\(b\)](#) and [37 C.F.R. §2.65\(a\)](#), an application becomes abandoned if the applicant fails to respond, or fails to respond completely, within the relevant response period. See [TMEP §§711-711.03](#) regarding the deadline for response to an Office action and [TMEP §§718.03–718.03\(b\)](#) regarding incomplete responses.

When an applicant is granted additional time to perfect its response under [37 C.F.R. §2.65\(a\)\(2\)](#) ([TMEP §718.03\(b\)](#)), but fails to respond or responds late, the date of abandonment is not affected. It remains the day after the date on which the response period ends, since the grant of additional time to *perfect* a response does not extend the statutory response period.

The examining attorney has no authority to accept a late response. If an applicant files a late response, the examining attorney must immediately send a notice to the applicant stating that the response was untimely; that the application is abandoned; and that the applicant may file a petition to revive under [37 C.F.R. §2.66](#) if the failure to timely respond was unintentional. See [TMEP §§1714–1714.01\(g\)](#) regarding petitions to revive.

See [TMEP §718.02\(a\)](#) regarding partial abandonment.

### 718.02(a) Partial Abandonment

*General Rule* . Trademark Rule 2.65(a)(1), [37 C.F.R. §2.65\(a\)\(1\)](#), provides that if all refusals and/or requirements are expressly limited to certain goods/services, and the applicant fails to respond, or to respond completely, to an Office action, the application will be abandoned only as to those particular goods/services.

*Exception - Requirements for Fees to Cover All Classes in a Multiple-Class Application.* If the fees paid in a multiple-class application are sufficient to cover one class but insufficient to cover all the classes, the examining attorney will require that the applicant submit the additional fees or specify the classes to which the original fee(s) should be applied. Under such circumstances, it is not appropriate to give a partial-abandonment advisory. If the applicant does not respond to the Office action, the entire application will be abandoned.

*Office Action Must State That Refusal Applies Only to Certain Goods, Services or Classes.* If the examining attorney issues a refusal or requirement that applies only to certain goods/services/class(es) in any Office action (i.e., a first or subsequent nonfinal Office action, final action, or denial of a request for reconsideration), this must be expressly stated in the Office action. Partial abandonment applies only if the Office action expressly states that a refusal or requirement is limited to only certain goods/services/class(es). Unless the action includes a **clear and explicit** statement that the refusal or requirement applies to only certain goods/services/class(es), the refusal or requirement will apply to all the goods/services/class(es), and failure to respond to the action will result in abandonment of the entire application.

*Incomplete Response to Partial Refusal or Requirement .* Partial abandonment may also occur when an applicant fails to file a complete response to a final refusal or final requirement that is expressly limited to only certain goods/services/class(es). If an applicant files an incomplete response to a nonfinal action that is limited to only certain goods/services/class(es), the examining attorney should generally issue an action making all outstanding requirements and refusals final rather than partially abandoning the application. See [TMEP §§718.03–718.03\(b\)](#) regarding incomplete responses. When an examining attorney holds an application abandoned for failure to file a complete response, the applicant’s recourse is to file a petition to the Director under [37 C.F.R. §2.146](#) to reverse the holding. See [TMEP §1713.01](#). If an applicant files an incomplete response to a final action that is limited to only certain goods/services/class(es) and there is time remaining in the response period to file a notice of appeal, the examining attorney must treat it as a request for reconsideration and deny the request, but must wait to issue the partial abandonment until all time to respond has expired. If there is no time remaining to appeal, the examining attorney must issue an examiner’s amendment deleting (abandoning) the goods/services/classes to which the refusal or requirement pertained. The examiner’s amendment must clearly set forth the changes that will be made to the identification of goods/services. No prior authorization from the applicant or its attorney is needed to issue an examiner’s amendment in this situation.

*Failure to Respond to Partial Refusal or Requirement.* When an applicant fails to respond to a refusal or requirement that is expressly limited to only certain goods/services/class(es), the examining attorney should issue an examiner’s amendment deleting (abandoning) the goods/services/classes to which the refusal or requirement pertained. The examiner’s amendment should clearly set forth the changes that will be made to the identification of goods/services in the application. No prior authorization from the applicant or the applicant’s qualified practitioner is needed to issue an examiner’s amendment in this situation. [TMEP §707.02](#). If the failure to respond to the partial refusal or requirement was unintentional, the applicant may file a petition to the Director to revive the deleted goods/services/classes within two months of the issuance date of the examiner’s amendment. When seeking to revive a portion of an application that was partially abandoned, the applicant must use the Petition to the Director under Trademark Rule 2.146 form in the trademark electronic filing system. See [TMEP §301](#) regarding the requirement to file electronically and [§§1714-1714.01\(g\)](#) regarding petitions to revive.

*Failure to Perfect Appeal of Partial Refusal or Requirement.* Partial abandonment can also occur when a partial refusal or requirement is upheld on appeal, and the applicant fails to perfect an appeal to, or an appeal is dismissed by, the Court of Appeals for the Federal Circuit or civil court, or when an applicant withdraws or fails to prosecute an appeal of a partial refusal to the Board. In these situations, the examining attorney should issue an examiner’s amendment deleting (abandoning) the goods/services/class(es) to which the appeal pertained. No prior authorization from the applicant or the applicant’s qualified practitioner is needed to issue an examiner’s amendment in this situation.

*Use of Headings in Office Actions Encouraged.* When issuing a partial refusal or requirement, the examining attorney is encouraged to use the heading “Partial Refusal” or “Partial Requirement,” so the record is clear that the refusal or requirement applies only to certain goods/services/class(es).

*Use of Abandonment Advisory in Office Actions.* When issuing a partial refusal or requirement, the examining attorney should advise the applicant that if the applicant does not respond to the Office action within the response period, certain goods/services/class(es) will be deleted from the application (abandoned) and the application will proceed forward with only the remaining goods/services/class(es).

*Requirements for Amendment of Identification of Goods/Services.* See [TMEP §1402.13](#) regarding an examining attorney's requirement for amendment of an identification of goods/services that includes some terminology that is indefinite and some terminology that is acceptable, and the processing of applications in which an applicant fails to respond to such a requirement.

## 718.03 Incomplete Response

### 37 CFR §2.65(a)

An application will be abandoned if an applicant fails to respond to an Office action, or to respond completely, within the relevant time period for response under § 2.62(a)(1), including any granted extension of time to respond under § 2.62(a)(2). A timely petition to the Director pursuant to §§ 2.63(a) and (b) and 2.146 or notice of appeal to the Trademark Trial and Appeal Board pursuant to § 2.142, if appropriate, is a response that avoids abandonment (*see* § 2.63(b)(4)).

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

(2) When a timely response by the applicant is a bona fide attempt to advance the examination of the application and is a substantially complete response to the examining attorney's action, but consideration of some matter or compliance with a requirement has been omitted, the examining attorney may grant the applicant 30 days, or to the end of the time period for response to the action to which the substantially complete response was submitted, whichever is longer, to explain and supply the omission before the examining attorney considers the question of abandonment.

Under [15 U.S.C. §1062\(b\)](#) and [37 C.F.R. §2.65\(a\)](#), an applicant must respond completely to each issue raised in the examining attorney's Office action to avoid abandonment. Generally, a response is incomplete if it: (1) does not address one or more of the requirements or refusals made in the Office action; (2) is unsigned; (3) is signed by an unauthorized person; or (4) is a response to a final action that does not overcome all refusals or satisfy all requirements, when the response period has expired, and the applicant has not timely filed a notice of appeal. *See* [TMEP §§715.03\(a\) 715.03\(a\)\(ii\)\(E\)](#).

*Exception - Electronic Responses Consisting Solely of a Signature or Missing Significant Data or Attachments.* Occasionally, the USPTO receives a response to an Office action filed through the trademark electronic filing system that consists solely of a signature or is missing significant data or attachments. This is generally due to user error. If an examining attorney receives an electronic response to a nonfinal action that consists solely of a signature or is missing significant data or attachments, the examining attorney should not treat the response as non-responsive or issue a notice of incomplete response granting the applicant additional time to complete the response. Instead, the examining attorney must issue a final action, and include sufficient evidence and arguments for all refusals and requirements in preparation for a possible appeal, if the application is in condition for final action. If the application is not in condition for final action (e.g., because a prior pending application has matured into a registration), the examining attorney should issue another nonfinal action, with a response clause, explaining why the response was incomplete, continuing all outstanding refusals and requirements, and addressing any new issues. *See* [TMEP §715.03\(a\)\(ii\)\(E\)](#) regarding electronic responses to final actions that consist only of a signature or are missing significant data or attachments.

*Unsigned Responses.* If a response is unsigned, the examining attorney must obtain a properly signed copy before acting on the merits of the response, regardless of whether the Office action was final or nonfinal. The examining attorney must issue a notice of incomplete response, granting the 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\(a\)\(2\)](#). See [TMEP §§715.03\(a\)\(ii\)\(E\)](#), [718.03\(b\)](#). The applicant must submit a properly signed copy of the response, or, if all issues raised are proper subject matter for an examiner's amendment, the individual applicant, someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner of a partnership), or the applicant's previously recognized qualified practitioner may authorize the examining attorney to enter an examiner's amendment. A new qualified practitioner who has not yet appeared may not authorize an examiner's amendment, because a telephone call from a qualified practitioner does not satisfy the "appearance" requirements of [37 C.F.R. §2.17\(b\)](#). See [TMEP §604.01](#). If all issues raised are not proper subject matter for an examiner's amendment, the applicant may *not* ratify the unsigned response through an examiner's amendment. See [TMEP §712.02](#). If the applicant fails to submit a properly signed response within the time granted under [37 C.F.R. §2.65\(a\)\(2\)](#), the examining attorney must hold the application abandoned for failure to file a complete response. See [TMEP §718.03\(a\)](#).

*Responses Signed by Unauthorized Persons*. If a response is signed by an unauthorized party (e.g., a foreign attorney who is not a member in good standing of the bar of the highest court of a state in the United States, which includes the District of Columbia and any Commonwealth or territory of the United States) or a corporate employee who does not have legal authority to bind the applicant), the examining attorney must obtain a properly signed copy before acting on the merits of the response, regardless of whether the Office action was final or nonfinal. The examining attorney must issue a notice of incomplete response, granting the 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\(a\)\(2\)](#). See [TMEP §§715.03\(a\)\(ii\)\(E\)](#), [718.03\(b\)](#). The applicant must submit a response signed by the individual applicant, someone with legal authority to bind a juristic applicant (see [TMEP §§611.06](#), [712.01](#)), or by a qualified practitioner (see [TMEP §§602–602.03\(e\)](#)). [37 C.F.R. §2.62\(b\)](#). If a response was signed by an unauthorized party, it is not acceptable for the applicant to ratify the response through an examiner's amendment. See [TMEP §§611.05–611.05\(b\)](#) and [712.03](#) for further information. If the applicant fails to submit a properly signed response within the time granted under [37 C.F.R. §2.65\(a\)\(2\)](#), the examining attorney must hold the application abandoned for failure to file a complete response. See [TMEP §718.03\(a\)](#) regarding holdings of abandonment for failure to respond completely.

*Properly Signed but Incomplete Responses to Nonfinal Actions*. When an applicant files an incomplete response to a nonfinal action (i.e., does not address one or more of the requirements or refusals made in the Office action), the examining attorney must not hold the application abandoned. Instead, the examining attorney should generally issue a final action, if the application is in condition for final action. In limited circumstances, the examining attorney has discretion to issue a notice of incomplete response granting the applicant additional time to complete the response if the response meets the requirements of [37 C.F.R. §2.65\(a\)\(2\)](#). See [TMEP §718.03\(b\)](#). If the application is not in condition for final action, and the response does not meet the requirements of [37 C.F.R. §2.65\(a\)\(2\)](#), the examining attorney should issue another nonfinal action, explaining why the response was incomplete, and continuing all outstanding refusals and requirements.

A written disagreement with the examining attorney's refusal or requirement may be a complete response to a nonfinal action with respect to that refusal or requirement.

See [TMEP §718.02\(a\)](#) for more information about processing an incomplete response to a partial nonfinal refusal or requirement.

*Properly Signed but Incomplete Responses to Final Actions*. If the applicant files a properly signed but incomplete response that does not meet the criteria in [37 C.F.R. §2.65\(a\)\(2\)](#) for granting additional time to



complete the response, there is no time remaining in the response period, and no notice of appeal has been filed, the examining attorney must hold the application abandoned due to incomplete response. See [TMEP §§715.03\(a\)\(ii\)\(D\)](#), [718.03\(a\)](#).

See [TMEP § 718.02\(a\)](#) for more information about processing an incomplete response to a partial final refusal or requirement.

*Non-Responsive Communications.* An inquiry, a request to extend the response period using any form other than the Request for Extension of Time to File a Response form in the trademark electronic filing system, or a communication on a matter unrelated to the preceding Office action should be treated as a non-responsive communication, not as an incomplete response. See [TMEP §719](#) for further information.

*Failure to Respond to Notice of Incomplete Response .* If the examining attorney issues a notice of incomplete response, and the applicant fails to respond or submits an unsatisfactory response to the notice within the time granted under [37 C.F.R. §2.65\(a\)\(2\)](#), the examining attorney must issue an action abandoning the application for incomplete response. See [TMEP §§715.03\(a\)\(ii\)\(D\)](#), [715.03\(a\)\(ii\)\(E\)](#), [718.03\(b\)](#).

See [TMEP §717.02](#) regarding the procedure for handling an applicant's claim that the applicant did not receive the Office action.

### **718.03(a) Holding of Abandonment for Failure to Respond Completely**

Generally, an examining attorney must not hold an application abandoned when an applicant timely files a properly signed but incomplete response to a **nonfinal** action (i.e., the response does not address one or more of the requirements or refusals made in the Office action) or a response to a nonfinal action in the trademark electronic filing system consisting of only a signature or missing significant data or attachments. See [TMEP §718.03](#).

The examining attorney may hold an application abandoned after **final** action if (1) the applicant files a properly signed but incomplete response that does not meet the criteria in [37 C.F.R. §2.65\(a\)\(2\)](#) for granting additional time to comply and the time for responding to the final action has expired (see [TMEP §715.03\(a\)\(ii\)\(D\)](#)) or (2) the applicant fails to respond to a notice of incomplete response within the time granted under [37 C.F.R. §2.65\(a\)\(2\)](#). In such cases, the examining attorney should issue an action stating that the application is abandoned due to an incomplete response and explaining why.

See [TMEP §718.02\(a\)](#) for more information about processing an incomplete response to a partial nonfinal or final refusal or requirement.

The applicant may contact the managing attorney or senior attorney and request review of the examining attorney's action. If the managing attorney or senior attorney believes that the holding of abandonment was improper, they will direct the examining attorney to reverse the holding of abandonment. Otherwise, the applicant's recourse is to file a petition requesting that the Director exercise supervisory authority under [37 C.F.R. §2.146\(a\)\(3\)](#) and reverse the holding of abandonment. See [TMEP §1713.01](#).

See [TMEP §715.03\(a\)\(2\)](#) regarding action on an incomplete response to a final action before the response period has expired when no notice of appeal has been filed.



## 718.03(b) Granting Additional Time to Perfect Response

Under [37 C.F.R. §2.65\(a\)\(2\)](#), the examining attorney has 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 if:

- (1) the response was filed within the relevant response period (*see* [TMEP §711](#));
- (2) the response was a bona fide attempt to advance the examination;
- (3) the response was a substantially complete response to the examining attorney's action; and
- (4) consideration of some matter or compliance with some requirement was omitted.

*Nonfinal Action* : If an applicant's attempt to comply with an examining attorney's nonfinal action is incomplete, the examining attorney generally should issue a "Final Action" when the application is otherwise in condition for final action, and not grant a 30-day extension of time under [37 C.F.R. §2.65\(a\)\(2\)](#). See [TMEP §718.02\(a\)](#) regarding processing an incomplete response to a partial nonfinal refusal or requirement and [TMEP §718.03](#) regarding processing electronic responses to nonfinal actions that consist only of a signature or are missing significant data or attachments.

*Final Action* : The discretion to give an applicant extra time to perfect a response under [37 C.F.R. §2.65\(a\)\(2\)](#) should generally be exercised in connection with a response to a final action. See [TMEP §§715.03 715.03\(c\)](#) regarding processing requests for reconsideration after final action and [TMEP §718.02\(a\)](#) regarding processing an incomplete response to a partial final refusal or requirement. To grant additional time after a response to a final action, the examining attorney must issue a "Continuing Final Action." *See* [TMEP §§715.03\(a\)\(ii\)\(C\), \(a\)\(ii\)\(E\)](#).

Granting the applicant additional time to complete a response under [37 C.F.R. §2.65\(a\)\(2\)](#) after final action does not extend the time for filing an appeal to the Trademark Trial and Appeal Board (or a petition to the Director under [37 C.F.R. §2.63\(b\)\(2\)](#)). The applicant must file a notice of appeal (or petition) within the response period for the final action. [15 U.S.C. §1062\(b\)](#); [37 C.F.R. §2.142\(a\)](#); *see* [37 C.F.R. §2.63\(b\)\(1\)–\(2\)](#). 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.

*Unsigned Response or Response Signed by Unauthorized Person*: If the response to a nonfinal or final action is unsigned or signed by an unauthorized person, the examining attorney must issue a notice of incomplete response explaining why the response is incomplete and granting the applicant 30 days, or to the end of the response period for the previous Office action, whichever is longer, to perfect the response. To issue a notice after a nonfinal action, the examining attorney must use the "Notice of Non-Responsive Amendment" action. To issue a notice after a final action, the examining attorney must use the "Continuing Final Action" and omit the response clause. See [TMEP §§715.03\(a\)\(ii\)\(E\)](#) and [718.03](#) regarding processing responses to actions that are not signed or not properly signed.

*Failure to Respond or Respond Completely to Notice of Incomplete Response* : If the applicant fails to respond to a notice or to complete the response within the time granted under [37 C.F.R. §2.65\(a\)\(2\)](#), the examining attorney must abandon the application for incomplete response. *See* [TMEP §718.03\(a\)](#). In this situation, the applicant cannot file a petition to revive due to unintentional delay pursuant to [37 C.F.R. §2.66](#). The applicant's only recourse is to file a petition to the Director to exercise supervisory authority under [37 C.F.R. §2.146\(a\)\(3\)](#) to reverse the examining attorney's holding of abandonment. However, the Director will reverse an examining attorney's action on petition only (1) where 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 [TMEP §1713.01](#).

### **718.04 Failure to File Statement of Use**

Under [15 U.S.C. §1051\(d\)\(4\)](#), an application under §1(b) of the Act is abandoned if the applicant fails to timely file a statement of use or request for an extension of time to file a statement of use. [37 C.F.R. §§2.65\(c\), 2.88\(k\); TMEP §§1108.01, 1109.04](#).

The ITU/Divisional Unit will abandon the application if the applicant fails to file a statement of use or request for an extension of time to file a statement of use within six months of the issuance date of the notice of allowance, or within a previously granted extension period. The USPTO will send a computer-generated notice of abandonment to the applicant.

If the failure to timely file the statement of use or extension request was unintentional, the applicant may file a petition to revive under [15 U.S.C. §1051\(d\)\(4\)](#) and [37 C.F.R. §2.66](#). See [TMEP §§1714–1714.01\(g\)](#).

### **718.05 Failure to Perfect Appeal**

An application may become abandoned because of withdrawal of, or failure to prosecute, an appeal to the Trademark Trial and Appeal Board. See [15 U.S.C. §1062\(b\); TBMP §1203.02\(a\); TMEP §1501](#).

An application may also become abandoned because of failure to perfect an appeal, or dismissal of an appeal, to the Court of Appeals for the Federal Circuit or civil court.

See [TMEP §718.02\(a\)](#) regarding partial abandonment due to failure to perfect an appeal.

### **718.06 Notice of Abandonment for Failure to Respond**

If no response is received by the USPTO within the relevant response period (see [TMEP §711](#)), including an extended response period after the grant of an extension of time to respond under [37 C.F.R. §2.62\(a\)\(2\)](#) (see [TMEP §711.01](#)), the application is sent to the examining attorney to be abandoned or partially abandoned, as appropriate.

The examining attorney must check the record to ensure that there is no response and that the Office action was sent to the correspondence address of record. See [TMEP §717](#) regarding reissuing an Office action that was sent to the wrong address due to a USPTO error. The examining attorney must also check to see whether the Office action contained a partial refusal or requirement. See [TMEP §718.02\(a\)](#) regarding partial abandonment.

An application is considered to be abandoned as of the day after the date on which a response was due, even though the examining attorney performs the Trademark database transaction that reports the abandonment at a later date. The USPTO sends a computer-generated notice of abandonment to the correspondence address listed in the application.

Applications that are abandoned after ex parte appeals or inter partes proceedings are considered abandoned as of the date of the action by the Board that caused the application to abandon (e.g., affirming the examining attorney's refusal or sustaining an opposition). However, the Trademark database transaction reporting the

abandonment is not performed until a month after expiration of the period for appeal from the Board's decision.

### **718.07 Revival or Reinstatement of Abandoned Application - New Search Required**

When an application listed as abandoned in the USPTO's Trademark database is revived or reinstated, the examining attorney must conduct a new search of USPTO records for conflicting marks. If the new search shows that a later-filed application for a conflicting mark has been approved, or if a §2(d) search for a later-filed application for a conflicting mark was performed when the earlier-filed application was in abandoned status, the examining attorney with the earlier-filed application must inform the examining attorney with the later-filed application that the earlier-filed application has been revived or reinstated so that appropriate action may be taken. If the later-filed application has been published, the examining attorney handling that application should request jurisdiction (*see* [TMEP §1504.04\(a\)](#)) before suspending the application pending disposition of the earlier-filed application. [37 C.F.R. §2.83\(c\)](#); [TMEP §1208.02\(c\)](#).

However, if a later-filed conflicting application is registered, the examining attorney must refuse registration of the earlier-filed (revived or reinstated) application under [15 U.S.C. §1052\(d\)](#). In this situation, an applicant may file a petition to cancel the registration under Section 14 of the Trademark Act, [15 U.S.C. §1064](#).

### **719 Non-Responsive Communications**

An inquiry or a communication on a matter unrelated to the outstanding Office action should be treated as a “non-responsive communication,” not as an incomplete response to an outstanding Office action. In addition, a request for an extension of time to respond under [37 C.F.R. §2.62\(a\)\(2\)](#) that is not accompanied by the applicable fee or that is filed using any form other than the Request for Extension of Time to File a Response form in the trademark electronic filing system should also be treated as a “non-responsive communication” and given no effect.

If the applicant files a non-responsive communication while an Office action is outstanding, the examining attorney should send the applicant a letter (i.e., "Notice of Non-Responsive Amendment") acknowledging receipt of the communication, noting that the communication is non-responsive, and advising the applicant that, to avoid abandonment, a response to the outstanding Office action must be received within the time period for responding to the outstanding Office action. If no response to the Office action is received within the response period, the application must be abandoned for failure to respond.

### **720 Fraudulent Filings**

Matters involving fraudulent filings fall under the authority of the Trademark Register Protection Office (RPO).

Under no circumstances should any USPTO communication pertaining to suspected fraud be made, either orally or in writing, by anyone in the Trademark Examining Operation, unless directed to do so by the RPO.