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201 In General

15 U.S.C. § 1063(a) Any person who believes that he would be damaged by the registration of a mark upon the principal register, including as a result of dilution under section 43(c), may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 12 of this Act of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Director for good cause when requested prior to the expiration of an extension. The Director shall notify the applicant of each extension of the time for filing opposition. An opposition may be amended under such conditions as may be prescribed by the Director.

37 CFR § 2.101 Filing an opposition.

(a) An opposition proceeding is commenced by the filing of an opposition together with the required fee, in the Office.

(b) Any person who believes that he, she or it would be damaged by the registration of a mark on the Principal Register may file an opposition, addressed to the Trademark Trial and Appeal Board. The opposition need not be verified, but must be signed by the opposer or the opposer's attorney, as specified in § 10.1(c) of this chapter, or other authorized representative, as specified in § 10.14(b) of this chapter. Electronic signatures pursuant to § 2.193(c)(1)(iii) are required for oppositions submitted electronically under paragraphs (b)(1) or (2) of this section.

(1) An opposition to an application based on section 1 or 44 of the Act must be filed either on paper or through ESTTA.

(2) An opposition to an application based on section 55(a) of the Act must be filed through ESTTA.

(c) The opposition must be filed within thirty days after publication (§ 2.80) of the application being opposed or within an extension of time (§ 2.102) for filing an opposition.

* * * *

37 CFR § 2.102 Extension of time for filing an opposition.

(a) Any person who believes that he, she or it would be damaged by the registration of a mark on the Principal Register may file in the Office a written request addressed to the Trademark Trial and Appeal Board to extend the time for filing an opposition. The written request need not be verified, but must be signed by the potential opposer or by the potential opposer's attorney as specified in § 10.1(c) of this chapter, or authorized representative, as specified in § 10.14(b) of this chapter. Electronic signatures pursuant to § 2.193(c)(1)(iii) are required for electronically filed extension requests.

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(1) A written request to extend the time for filing an opposition to an application filed under section 1 or 44 of the Act must be filed either on paper or through ESTTA.

(2) A written request to extend the time for filing an opposition to an application filed under section 66(a) of the Act must be filed through ESTTA.

(b) The written request to extend the time for filing an opposition must identify the potential opposer with reasonable certainty. Any opposition filed during an extension of time should be in the name of the person to whom the extension was granted. An opposition may be accepted if the person in whose name the extension was requested was misidentified through mistake or if the opposition is filed in the name of a person in privity with the person who requested and was granted the extension of time.

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

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

(1) A person may file a first request for either a thirty-day extension of time, which will be granted upon request, or a ninety-day extension of time, which will be granted only for good cause shown.

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

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

Any person (whether natural or juristic--see TBMP § 303.02) who believes that he, she, or it would be damaged by the registration of a mark upon the Principal Register may, upon payment of the prescribed fee, file an opposition in the Office, stating the grounds therefor, within 30 days after the publication of the mark in the *Official Gazette* for purposes of opposition.¹

¹ See Section 13(a) of the Act, 15 U.S.C. § 1063(a), and 37 CFR § 2.101. For further information concerning the filing of an opposition, see TBMP chapter 300.

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Similarly, any person who believes that he, she, or it would be damaged by the registration of a mark upon the Principal Register may file a written request to extend the time for filing an opposition.² Requests for extensions of time to oppose are determined by the Board.³

The time for filing a request for an extension of time to oppose is governed by Section 13(a) of the Act, 15 U.S.C. § 1063(a), and 37 CFR § 2.102(c). Other requirements for a request for extension of time to oppose are set forth in 37 CFR § 2.102(a) and (b). Moreover, an extension of time to oppose must also meet the general requirements for submissions to the Board specified in 37 CFR § 2.126. Each of these requirements is discussed in the sections that follow.

202 Time for Filing Request

202.01 In General

U.S.C. § 1063(a) Any person who believes that he would be damaged by the registration of a mark upon the principal register, including as a result of dilution under section 43(c), may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 12 of this Act of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Director for good cause when requested prior to the expiration of an extension. The Director shall notify the applicant of each extension of the time for filing opposition. An opposition may be amended under such conditions as may be prescribed by the Director.

37 CFR § 2.102(c) The time for filing an opposition shall not be extended beyond 180 days from the date of publication. Any request to extend the time for filing an opposition must be filed before thirty days have expired from the date of publication or before the expiration of a previously granted extension of time, as appropriate. Requests to extend the time for filing an opposition must be filed as follows:

- (1) A person may file a first request for either a thirty-day extension of time, which will be granted upon request, or a ninety-day extension of time, which will be granted only for good cause shown.*
- (2) If a person was granted a thirty-day extension of time, that person may file a request for an additional sixty-day extension of time, which will be granted only for good cause shown.*

² See Section 13(a) of the Act, 15 U.S.C. § 1063(a), and 37 CFR § 2.102.

³ See 37 CFR § 2.102(a) and *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1075 n.2 (TTAB 1993) (Trademark Rule 2.102(c) delegates the authority to the Board to grant, ex parte, extensions of time to oppose).

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

A first request for an extension of time to oppose an application for registration of a mark must be filed prior to the expiration of the thirty-day period after publication of the mark in the *Official Gazette*, pursuant to Section 12(a) of the Act, 15 U.S.C. § 1062(a), for purposes of opposition. Any request for a further extension of time to oppose must be filed prior to the expiration of an extension granted to the requesting party or its privy.⁴

The timely filing of documents in the Office requires that the documents actually be received in the Office within the set time period unless such documents are filed in accordance with 37 CFR §§ 2.197 and 2.198 that provide for filing of papers by certificate of mailing and Express Mail, respectively. Documents filed in accordance with these rules are considered as having been filed on the date of deposit as first class mail or Express Mail even though the mailed correspondence will not be received in the Office until after the due date.⁵ The Express Mail filing procedure applies only to the “Express Mail” of the United States Postal Service, not any third-party carrier that offers overnight delivery.⁶ For extension requests filed electronically through ESTTA, all time periods are calculated electronically and the filer is immediately informed of the timeliness of the filing.⁷

In the event that a particular extension request submitted on paper is timely filed with an appropriate certificate of mailing, pursuant to 37 CFR § 2.197, but is not received in the Office, the correspondence will be considered timely if the party that submitted it supplies an additional copy of the previously mailed extension request and certificate, and includes a statement attesting to the previous timely mailing. The statement must be verified if it is made by a person other than a practitioner, as defined in § 37 CFR 10.1(r).⁸ The only evidence accepted by the

⁴ See Section 13(a) of the Act, 15 U.S.C. § 1063(a), and 37 CFR § 2.102(c). See also *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980) (timeliness of extension requests is statutory and cannot be waived).

⁵ See *In re Pacemaker Group, Inc.*, 45 USPQ2d 1703, 1704 (Comm'r 1994) and TBMP § 110.01 (Certificate of Mailing or Transmission Procedure).

⁶ See *In re Pacemaker Group, Inc.*, *supra*.

⁷ See TBMP § 109 (Filing Date).

⁸ See 37 CFR § 2.197(b) and TBMP § 110.01 (Certificate of Mailing or Transmission Procedure – In General).

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Office to prove deposit of the missing extension request is an exact copy of the disputed document including a copy of the executed original certificate of mailing.⁹ A reconstructed request and certificate of mailing will not suffice.

A potential opposer that has filed an extension request on paper should not wait until it has received notification from the Board of the grant or denial of the request before filing an opposition or a request for a further extension of time to oppose. If a request for an extension of time to oppose is granted, the length of the granted extension may be less than that sought in the extension request. The extension will run from the expiration of the thirty-day opposition period after publication. In the case of a subsequent extension, it will run from the date of expiration of the previously granted extension.¹⁰ While the Board attempts to notify a potential opposer of the grant of an extension request filed on paper before a granted extension expires, particularly when the length of the granted extension is less than that requested, the Board is under no obligation to do so, and in many cases cannot.¹¹

No more than three requests to extend the time for filing an opposition, totaling 180 days from the date of publication, may be filed.¹² A potential opposer may file a request for a thirty-day extension without a showing of cause, followed by a request for a sixty-day extension for good cause.¹³ Alternatively, the potential opposer may file a single request for a ninety-day extension of time for good cause. After one or two granted requests totaling 120 days from the date of publication, the potential opposer may request one final extension of time for an additional sixty days, but only with the written consent of the applicant or a showing of extraordinary circumstances.¹⁴

⁹ See *In re Sasson Licensing Corp.*, 35 USPQ2d 1510, 1512 (Comm'r 1995) (a declaration attesting to the filing and to the certificate of mailing is not acceptable as evidence of timely filing).

¹⁰ See *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093, 1094 (Comm'r 1990).

¹¹ See *Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310, 1312 (Comm'r 1991) (where misdirection of initial extension prevented Board from addressing calculation error in the request) and *In re Societe Des Produits Nestle S.A.*, *supra* (potential opposer was not notified of partial grant of extension request until after date had passed). Cf. *In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273, 275 (Fed. Cir. 1984) (no statute or regulation imposes obligation on Office to notify parties of defects in sufficient time to allow correction); *In re L.R. Sport Inc.*, 25 USPQ2d 1533, 1534 (Comm'r 1992) (no obligation to notify of defective statement of use); and *In re Application Papers Filed November 12, 1965*, 152 USPQ 194, 195 (Comm'r 1966) (no obligation to discover deficiencies within a specified time).

¹² 37 CFR § 2.102(c)(3).

¹³ See 37 CFR § 2.102(c)(2).

¹⁴ See 37 CFR § 2.102(c)(3).

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202.02 Date of Publication of Mark

The date of publication of a mark is the issue date of the *Official Gazette* in which the mark appears, pursuant to Section 12(a) of the Act, 15 U.S.C. § 1062(a), for purposes of opposition.

202.03 Premature Request

Section 13(a) of the Act, 15 U.S.C. § 1063(a), provides that an opposition to the registration of a mark upon the Principal Register may be filed "within thirty days after" the publication of the mark in the *Official Gazette*, pursuant to Section 12(a) of the Act, 15 U.S.C. § 1062(a), for opposition. Section 13(a) also provides for extensions of this time for filing an opposition under certain conditions. Thus, any opposition, and any request for an extension of time to oppose, filed before the publication of the mark sought to be opposed, is premature, and the Board will reject the opposition even if the mark has been published by the time of the Board's action.¹⁵

202.04 Late Request

A request for an extension of time to oppose must be filed prior to the expiration of the thirty-day period after publication (for opposition) of the mark which is the subject of the request, in the case of a first request, or prior to the expiration of an extension granted to the requesting party or its privy, in the case of a request for a further extension.¹⁶ Because these timeliness requirements are statutory, they cannot be waived by stipulation of the parties, nor can the Director upon petition waive them.¹⁷ Accordingly, a first request filed after the expiration of the thirty-day period following publication of the subject mark, or a request for a further extension filed after the expiration of the previous extension granted to the requesting party or its privy, must be denied by the Board as late, even if the applicant has consented to the granting of the late filed request.

Moreover, once the time for opposing the registration of a mark has expired, the Office will not withhold issuance of the registration while applicant negotiates for settlement with a party that failed to timely oppose. This is so even if the applicant itself requests that issuance be withheld.

¹⁵ Cf. TBMP §§ 119.03 (Papers and Fees Generally Not Returnable) and 306.03 (Premature Opposition).

¹⁶ See Section 13(a) of the Act, 15 U.S.C. § 1063(a), and 37 CFR § 2.102(c). See also *In re Cooper*, 209 USPQ 670 (Comm'r Pats 1980) and TBMP § 206.02 (regarding further extension requests filed by privy).

¹⁷ See *In re Sasson Licensing Corp.*, 35 USPQ2d 1510, 1512 (Comm'r 1995) (waiver of Rule 1.8 [2.197] would effectively waive Section 13 and, in any event, fact that potential opposer did not retain executed hard copies of documents filed with Office and cannot prove document was timely is not an extraordinary circumstance justifying a waiver of Rule 1.8 [now 2.197]); *In re Kabushiki Kaisha Hitachi Seisakusho*, 33 USPQ2d 1477, 1478 (Comm'r 1994); and *In re Cooper*, *supra* at 671.

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203 Form of Request

203.01 In General

37 CFR § 2.102(a) Any person who believes that he, she or it would be damaged by the registration of a mark on the Principal Register may file in the Office a written request addressed to the Trademark Trial and Appeal Board to extend the time for filing an opposition. The written request need not be verified, but must be signed by the potential opposer or by the potential opposer's attorney as specified in § 10.1(c) of this chapter, or authorized representative, as specified in § 10.14(b) of this chapter. Electronic signatures pursuant to § 2.193(c)(1)(iii) are required for electronically filed extension requests.

(1) A written request to extend the time for filing an opposition to an application filed under section 1 or 44 of the Act must be filed either on paper or through ESTTA.

(2) A written request to extend the time for filing an opposition to an application filed under section 66(a) of the Act must be filed through ESTTA.

(b) The written request to extend the time for filing an opposition must identify the potential opposer with reasonable certainty. Any opposition filed during an extension of time should be in the name of the person to whom the extension was granted. An opposition may be accepted if the person in whose name the extension was requested was misidentified through mistake or if the opposition is filed in the name of a person in privity with the person who requested and was granted the extension of time.

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

(1) A person may file a first request for either a thirty-day extension of time, which will be granted upon request, or a ninety-day extension of time, which will be granted only for good cause shown.

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

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

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37 CFR § 2.126 Form of submissions to the Trademark Trial and Appeal Board.

(a) Submissions may be made to the Trademark Trial and Appeal Board on paper where Board practice or the rules in this part permit. A paper submission, including exhibits and depositions, must meet the following requirements:

- (1) A paper submission must be printed in at least 11-point type and double-spaced, with text on one side only of each sheet;*
- (2) A paper submission must be 8 to 8.5 inches (20.3 to 21.6 cm.) wide and 11 to 11.69 inches (27.9 to 29.7 cm.) long, and contain no tabs or other such devices extending beyond the edges of the paper;*
- (3) If a paper submission contains dividers, the dividers must not have any extruding tabs or other devices, and must be on the same size and weight paper as the submission;*
- (4) A paper submission must not be stapled or bound;*
- (5) All pages of a paper submission must be numbered and exhibits shall be identified in the manner prescribed in §2.123(g)(2);*
- (6) Exhibits pertaining to a paper submission must be filed on paper or CD-ROM concurrently with the paper submission, and comply with the requirements for a paper or CD-ROM submission.*

* * * *

(c) Submissions may be made to the Trademark Trial and Appeal Board electronically via the Internet where the rules in this part or Board practice permit, according to the parameters established by the Board and published on the web site of the Office. Text in an electronic submission must be in at least 11-point type and double-spaced. Exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission.

* * * *

A request for an extension of time to oppose must be made in writing and must specify the period of extension desired.¹⁸

A request for extension of time to oppose a Section 1 or 44 application may either be filed on paper or through ESTTA.¹⁹ However, a request for extension of time to oppose a 66(a) application must be filed through ESTTA.²⁰ The requirements for paper and electronic submissions to the Board are specified in 37 CFR § 2.126(a) and (c), respectively. Available forms and instructions for electronic filing can be found at www.uspto.gov.

¹⁸ See 37 CFR § 2.102.

¹⁹ See 37 CFR § 2.102(a)(1). See also TBMP §§ 106.03 (Form of Submissions) and 107 (How and Where to File Papers).

²⁰ See 37 CFR § 2.102(a)(2). See also TBMP § 106.03 (Form of Submissions).

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No more than three requests to extend the time for filing an opposition, totaling 180 days from the date of publication, may be filed.²¹ A potential opposer may file a request for a thirty-day extension without a showing of cause, followed by a request for a sixty-day extension for good cause, if the first request was granted.²² Alternatively, the potential opposer may file a single request for a ninety-day extension of time for good cause.²³ After one or two granted requests totaling 120 days from the date of publication, the potential opposer may request one final extension of time for an additional sixty days only with the written consent of the applicant or a showing of extraordinary circumstances.²⁴

203.02 Identifying Information

203.02(a) In General

An extension request filed on paper should bear at its top the heading "IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD," followed by information identifying the application to which the request pertains, namely, the name of the applicant, and the application serial number, filing date, mark, and date of publication in the *Official Gazette*.²⁵ The request should also bear an appropriate title describing its nature, such as "Request for Extension of Time to Oppose" or "Request for Further Extension of Time to Oppose."

203.02(b) Requirement for Identification of Potential Opposer

A request for an extension of time to oppose must identify the potential opposer with reasonable certainty.²⁶ If a request for extension of time to oppose fails to identify the potential opposer with reasonable certainty, the Board can allow the defect to be corrected only if the correction is made prior to the expiration of the time for filing the request, that is, before the expiration of the thirty-day opposition period following

²¹ 37 CFR § 2.102(c)(3).

²² See 37 CFR § 2.102(c).

²³ See 37 CFR § 2.102(c)(1).

²⁴ See 37 CFR § 2.102(c)(3).

²⁵ Cf. 37 CFR § 2.191, and *In re Merck & Co.*, 24 USPQ2d 1317, 1318 (Comm'r 1992) (Board's refusal to institute opposition as untimely was proper where potential opposer had misidentified applicant and serial number in its extension request).

²⁶ 37 CFR § 2.102(b).

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publication of the subject mark in the case of a first request, or of the previous extension in the case of a request for a further extension.²⁷

If a request for a further extension of time to oppose does not specifically name the potential opposer, but it is clear from the circumstances that the request is being submitted on behalf of the same potential opposer which obtained an earlier extension, the request may be construed by the Board as identifying the potential opposer with reasonable certainty. However, the better, and safer, practice is to specifically name the potential opposer in each request for an extension of time to oppose.

203.03 Signature

37 CFR § 2.102(a) Any person who believes that he, she or it would be damaged by the registration of a mark on the Principal Register may file in the Office a written request addressed to the Trademark Trial and Appeal Board to extend the time for filing an opposition. The written request need not be verified, but must be signed by the potential opposer or by the potential opposer's attorney as specified in § 10.1(c) of this chapter, or authorized representative, as specified in § 10.14(b) of this chapter. Electronic signatures pursuant to § 2.193(c)(1)(iii) are required for electronically filed extension requests.

* * * *

A request for an extension of time to oppose must be signed either by the potential opposer or by its attorney, as specified in 37 CFR § 10.1(c) or other authorized representative, as specified in 37 CFR § 10.14(b).²⁸ A paper request should bear, under the written signature, the name, in typed or printed form, of the person signing; a description of the capacity in which he or she signs (e.g., as the individual who is the potential opposer, if the potential opposer is an individual; as a corporate officer, specifying the particular office held, if the potential opposer is a corporation; as potential opposer's attorney; etc.); and his or her business address (to which

²⁷ See *In re Spang Industries, Inc.*, 225 USPQ 888, 888 (Comm'r 1985) (since extension request failed to identify any party except attorney filing request, and since privity does not include attorney/client relationship, subsequent notice of opposition was untimely).

Cf. In re Su Wung Chong, 20 USPQ2d 1399, 1400 (Comm'r 1991) (inadvertence is not extraordinary circumstance to waive rule requiring that statement indicating consent or showing extraordinary circumstances for extension over 120 days must be submitted at time extension request is filed, not after the fact); *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093, 1094 (Comm'r 1990) (subsequently obtained consent is not sufficient and omission, in itself, is not extraordinary circumstance to waive requirement that consent accompany extension request); and *In re Software Development Systems, Inc.*, 17 USPQ2d 1094, 1095 (Comm'r 1989) (inadvertent oversight does not constitute extraordinary circumstance to waive [former] requirement for proof of service).

²⁸ See 37 CFR § 2.102(a). See also *La Maur, Inc. v. Andis Clipper Co.*, 181 USPQ 783, 784 (Comm'r 1974) (petition filed by applicant denied; extension requests were filed on behalf of potential opposer by its attorney as its representative not as another party).

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correspondence relating to the request will be sent) and telephone number. This information is required on the electronic form as well.

An extension request filed electronically through ESTTA, does not require a conventional signature. Instead the party or its representative enters a “symbol” that has been adopted as a signature. The Board will accept any combination of letters, numbers, space and/or punctuation marks as a valid signature if it is placed between two forward slash (“/”) symbols.²⁹

While a request for an extension of time to oppose must be signed, an unsigned paper request will not be refused consideration if a signed copy is submitted to the Office within the time limit set in the written notification of this defect by the Board.³⁰ A extension request filed through ESTTA cannot be electronically transmitted to the Office unless all required fields, including the signature field, are completed.

A potential opposer that has submitted an unsigned paper request should not wait until it has submitted a signed copy of the request (in response to the Board's written notification of the defect), and the Board has acted on the request, before filing an opposition or a request for a further extension of time to oppose. If the extension request is ultimately granted, the length of the granted extension may be less than that sought in the extension request, and it will run from the expiration of the thirty-day opposition period after publication, in the case of a first request, or from the date of expiration of the previously granted extension, in the case of a subsequent request. If no opposition or request for further extension of time to oppose is filed prior to the expiration of any extension ultimately granted (after submission of a signed copy of the request) to the potential opposer, the time for opposing will be deemed to have expired, and the application that was the subject of the request will be sent to issue.³¹

203.04 Service

Trademark Rule 2.119(a), 37 CFR § 2.119(a), requires, in part, that with certain stated exceptions, every paper filed in the USPTO in inter partes cases must be served upon the other parties, and that proof of such service must be made before the Board will consider the paper. Trademark Rule 2.101(a), 37 CFR § 2.101(a), provides that the filing of an opposition in the Office commences an opposition proceeding. Inasmuch as a request for an extension of time to oppose is a paper filed prior to the commencement of the opposition, it is ex parte, rather than inter partes, in nature. Accordingly, the request need not include proof of service upon the

²⁹ 37 CFR § 2.193(c)(1)(iii). *See also* TMEP § 804.05.

³⁰ *See* 37 CFR § 2.119(e) and TBMP § 106.02 (Signature of Submissions).

³¹ *Cf.* TBMP § 202.01 (Time for Filing Request).

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applicant.³² Once the Board has acted upon a request for an extension of time to oppose, the Board will send the applicant a copy of the extension request together with the Board's action thereon.³³

203.05 Duplicate Requests

It sometimes happens that duplicate requests for an extension of time to oppose are filed on behalf of the same party by two attorneys from the same firm, or from differing firms, or by an attorney from a firm and in-house counsel. Attorneys should make every effort to avoid the filing of such duplicate requests, which waste the time and resources, both of the Board and the attorneys.

When duplicate requests have been filed and the first request has been granted, the second request is given no consideration, and the attorneys are notified in writing of the duplicate filings and are requested to take appropriate action to avoid filing duplicate requests in the future. If requests filed by different attorneys on behalf of the same party are duplicates but for the fact that the second request seeks a longer extension than the first, the second request will be granted, if otherwise appropriate, but the attorneys will be requested in writing to avoid the filing of further duplicate requests.

204 Fee

There is no fee for filing a request for an extension of time to oppose.³⁴

205 Mark on Supplemental Register Not Subject to Opposition

Although the mark in an application for registration on the Principal Register is published for, and subject to, opposition, the mark in an application for registration on the Supplemental Register is not.³⁵ If it appears after examination of an application to register a mark on the Supplemental Register, that applicant is entitled to the registration; a certificate of registration is

³² See 37 CFR § 2.102(c) and, for example, *In re Docrite Inc.*, 40 USPQ2d 1636, 1638 (Comm'r 1996) (request for extension of time aggregating more than 120 days does not have to include proof of service on applicant or applicant's attorney when the request includes a statement that applicant has consented to the extension); and *La Maur, Inc. v. Andis Clipper Co.*, *supra*.

³³ See Section 13 of the Act, 15 U.S.C. § 1063.

³⁴ Cf. 37 CFR § 2.6.

³⁵ See Sections 12(a), 13(a), and 24 of the Act, 15 U.S.C. §§ 1062(a), 1063(a), and 1092, and 37 CFR § 2.82.

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issued without any publication for opposition.³⁶ Upon issuance of the registration, the mark appears in the *Official Gazette*, not for opposition, but rather to give notice of the registration's issuance.³⁷

Accordingly, the Board must deny any request for an extension of time to oppose the mark in an application for registration on the Supplemental Register. The remedy of the would-be opposer lies in the filing of a petition to cancel the registration of the mark, once the registration has issued.³⁸

206 Who May File an Extension of Time to Oppose

37 CFR § 2.102 Extension of time for filing an opposition.

(a) Any person who believes that he, she or it would be damaged by the registration of a mark on the Principal Register may file in the Office a written request addressed to the Trademark Trial and Appeal Board to extend the time for filing an opposition.

* * * *

(b) The written request to extend the time for filing an opposition must identify the potential opposer with reasonable certainty. Any opposition filed during an extension of time should be in the name of the person to whom the extension was granted. An opposition may be accepted if the person in whose name the extension was requested was misidentified through mistake or if the opposition is filed in the name of a person in privity with the person who requested and was granted the extension of time.

206.01 General Rule

Any person (whether natural or juristic--see TBMP § 303.02) who believes that he, she, or it would will be damaged by the registration of a mark upon the Principal Register may, upon payment of the prescribed fee, file an opposition in the Office, stating the grounds therefor, within 30 days after the publication of the mark in the *Official Gazette* for purposes of opposition.³⁹

³⁶ See Sections 23(b) and 24 of the Act, 15 U.S.C. §§ 1091(b) and 1092, and 37 CFR § 2.82.

³⁷ See Section 24 of the Act, 15 U.S.C. § 1092; 37 CFR § 2.82; and TMEP § 1502.

³⁸ See Section 24 of the Act, 15 U.S.C. § 1092.

³⁹ See Section 13(a) of the Act, 15 U.S.C. § 1063(a), and 37 CFR § 2.101. For further information concerning the filing of an opposition, see TBMP chapter 300, generally, and § 303 regarding who may file an opposition.

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Similarly, any person who believes that he, she, or it would be damaged by the registration of a mark upon the Principal Register may file a written request to extend the time for filing an opposition.⁴⁰ Moreover, a request for an extension of time to oppose must identify the potential opposer with reasonable certainty.⁴¹

An extension of time to oppose is a personal privilege which inures only to the benefit of the party to which it was granted and those in privity with that party.⁴² For this reason, a request for a further extension of time to oppose, or an opposition filed during an extension of time, ordinarily must be filed in the name of the party to which the extension was granted.⁴³ A request for a further extension, or an opposition, filed in a different name will be accepted if a person in privity with the person granted the previous extension files it, or if the person that requested the extension was misidentified through mistake.⁴⁴

206.02 Request for Further Extension Filed by Privy

A request for a further extension, or an opposition, filed by a different party will not be rejected on that ground if it is shown to the satisfaction of the Board that the different party is in privity with the party granted the previous extension.⁴⁵ The "showing" should be in the form of a recitation of the facts upon which the claim of privity is based, and must be submitted either with the request or opposition, or during the time allowed by the Board in its action requesting an explanation of the discrepancy. If the request for a further extension, or the opposition, is filed both in the name of the party granted the previous extension and in the name of one or more different parties, an explanation will be requested as to each different party, and the request will not be granted, or the opposition accepted, as to any different party which fails to make a satisfactory showing of privity.

⁴⁰ See Section 13(a) of the Act, 15 U.S.C. § 1063(a), and 37 CFR § 2.102. See also TBMP § 203 (Form of Request).

⁴¹ 37 CFR § 2.102(b). For a discussion of this matter, see TBMP § 203.02.

⁴² See *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1077 (TTAB 1993) (a party cannot claim the benefit of an extension granted to another, unrelated party).

⁴³ See 37 CFR § 2.102(b); TMEP § 1503.04; *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994); and *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980). Cf. TBMP § 206.02 (Request by Privy)

⁴⁴ See *Custom Computer Services, Inc. v. Paychex Properties, Inc.*, 337 F.3d 1334, 67 USPQ2d 1638, 1640 (Fed. Cir. 2003) (privity and misidentification by mistake "are two disjunctive conditions under which an opposer may claim the benefit of an extension granted to another named entity").

⁴⁵ See 37 CFR § 2.102(b); TMEP § 1503.04; *SDT Inc. v. Patterson Dental Co.*, *supra* (licensee, as party in privity with opposer, could have joined opposer in filing opposition during extension of time to oppose); and *In re Cooper*, *supra* (two unrelated entities that merely share same objection to registration are not in privity).

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In the field of trademarks, the concept of privity generally includes, *inter alia*, the relationship of successive ownership of a mark (e.g., assignor, assignee) and the relationship of "related companies" within the meaning of Sections 5 and 45 of the Act, 15 U.S.C. §§ 1055 and 1127.⁴⁶ It does not, however, include the attorney/client relationship.⁴⁷

If, at the time when a first request for an extension of time to oppose is being prepared, it is not clear which of two or more entities will ultimately be the opposer(s), the better practice is to name each of them, in that and any subsequent extension request, as a potential opposer, thereby avoiding any need for a showing of privity when an opposition or subsequent extension request is later filed by one or more of them.

206.03 Misidentification of Potential Opposer

A request for a further extension, or an opposition, filed in a different name will not be rejected on that ground if it is shown to the satisfaction of the Board that the party in whose name the extension was requested was misidentified through mistake.⁴⁸ The phrase "misidentification by mistake," as used in 37 CFR § 2.102(b), means a mistake in the form of the potential opposer's name or its entity type, not the naming of a different existing legal entity that is not in privity with the party that should have been named.⁴⁹

⁴⁶ See *International Nutrition Co. v. Horphag Research Ltd.*, 220 F.3d 1325, 55 USPQ2d 1492, 1495 (Fed. Cir. 2000) (discussion of various 'privity' relationships). Cf. *Rolex Watch U.S.A., Inc. v. Madison Watch Co., Inc.*, 211 USPQ 352, 358 (TTAB 1981) (regarding right of owner, or one in privity with owner, to maintain opposition or cancellation based on Section 2(d)); *In re Cooper*, *supra* (two unrelated entities that merely share same objection to registration are not in privity); *Argo & Co. v. Carpetsheen Manufacturing, Inc.*, 187 USPQ 366, 367 (TTAB 1975) (motion to suspend granted in view of privity of applicant with parties in civil action); and *F. Jacobson & Sons, Inc. v. Excelled Sheepskin & Leather Coat Co.*, 140 USPQ 281, 282 (Comm'r 1963) (parent in privity). But see *Tokaido v. Honda Associates Inc.*, 179 USPQ 861, 862 (TTAB 1973) (respondent's motion to suspend for civil action between respondent and third party denied where petitioner as nonexclusive licensee of third party was not in privity with third party).

⁴⁷ See *In re Spang Industries, Inc.*, 225 USPQ 888 (Comm'r 1985).

⁴⁸ See 37 CFR § 2.102(b), *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075 (TTAB 1993).

⁴⁹ See *Custom Computer Services, Inc. v. Paychex Properties, Inc.*, 337 F.3d 1334, 67 USPQ2d 1638, 1640 (Fed. Cir. 2003) (entity named in extensions was not a "different existing legal entity" from entity that filed opposition); and *Cass Logistics Inc. v. McKesson Corp.*, *supra* (word processing error resulting in identification of different legal entity was not a "mistake" within the meaning of the rule). See also TMEP § 1503.04.

Cf. *Arbrook, Inc. v. La Citrique Belge, Naamloze Vennootschap*, 184 USPQ 505, 506 (TTAB 1974) (motion to substitute granted where opposition was mistakenly filed in name of original owner); *Davidson v. Instantype, Inc.*, 165 USPQ 269, 271 (TTAB 1970) (leave to amend to substitute proper party granted where opposition was filed in name of the individual rather than in the name of the corporation); *Pyco, Inc. v. Pico Corp.*, 165 USPQ 221, 222 (TTAB 1969) (where succession occurred prior to filing of opposition, erroneous identification of opposer as a partner in a firm which no longer existed was not fatal); and *Raker Paint Factory v. United Lacquer Mfg. Corp.*, 141 USPQ 407, 409 (TTAB 1964) (sole owner substituted for partnership where original plaintiff identified as

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The "showing" submitted in support of a claim of misidentification by mistake should be in the form of a recitation of the facts upon which the claim of misidentification by mistake is based, and must be submitted either with the request or opposition, or during the time allowed by the Board in its letter requesting an explanation of the discrepancy.

207 Requirements for Showing of Cause; Extraordinary Circumstances

37 CFR § 2.102(c) *The time for filing an opposition shall not be extended beyond 180 days from the date of publication. Any request to extend the time for filing an opposition must be filed before thirty days have expired from the date of publication or before the expiration of a previously granted extension of time, as appropriate. Requests to extend the time for filing an opposition must be filed as follows:*

- (1) A person may file a first request for either a thirty-day extension of time, which will be granted upon request, or a ninety-day extension of time, which will be granted only for good cause shown.*
- (2) If a person was granted a thirty-day extension of time, that person may file a request for an additional sixty-day extension of time, which will be granted only for good cause shown.*
- (3) After receiving one or two extensions of time totaling ninety days, a person may file one final request for an extension of time for an additional sixty days. The Board will grant this request only upon written consent or stipulation signed by the applicant or its authorized representative, or a written request by the potential opposer or its authorized representative stating that the applicant or its authorized representative has consented to the request, or a showing of extraordinary circumstances. No further extensions of time to file an opposition will be granted under any circumstances.*

partnership composed of that individual since originally named plaintiff was not actually in existence when opposition was filed and even it were, as a partner, he is a successor to the partnership).

Cf. also TMEP § 803.06; *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689, 1690 (TTAB 1991) (correction not permitted where joint venture owned the mark but the application was filed by a corporation which was one member of the joint venture); *In re Atlanta Blue Print Co.*, 19 USPQ2d 1078, 1079 (Comm'r 1990) (permitted to amend name of registrant in Sections 8 and 15 declaration where trade name was inadvertently substituted for corporate name); *In re Techsonic Industries, Inc.*, 216 USPQ 619, 620 (TTAB 1982) (allowed to correct application where applicant was identified by only a portion of its earlier used name and earlier name had already been supplanted by new name at time application was filed, but at all times was one single entity); *Argo & Company v. Springer, et al.*, 198 USPQ 626, 634 (TTAB 1978) (Board granted applicant's motion to change its name from corporation which was defectively incorporated to individuals who were true owners of mark at time of filing); *In re Eucryl, Ltd.*, 193 USPQ 377, 378 (TTAB 1976) (exclusive U.S. distributor is owner only if it has agreement providing for right to apply; since distributor had no right to apply, subsequent assignment to proper applicant did not cure defect); *Argo & Co. v. Springer*, 189 USPQ 581, 582 (TTAB 1976) (defendant can be substituted when originally named party was not in existence at time of filing complaint); and *U.S. Pioneer Electronics Corp. v. Evans Marketing, Inc.*, 183 USPQ 613, 614 (Comm'r 1974) (deletion of "company" permissible).

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207.01 In General

The time for filing an opposition will not be extended beyond 180 days from the date of publication.⁵⁰ No more than three requests to extend the time to oppose may be filed. A potential opposer may file a first request for a thirty-day extension without a showing of cause,⁵¹ followed by a request for a sixty-day extension for good cause.⁵² Alternatively, the potential opposer may file a single request for a ninety-day extension of time for good cause.⁵³ After one or two granted requests totaling 120 days from the date of publication,⁵⁴ the potential opposer may request one final extension of time for an additional sixty days with the consent of applicant or a showing of extraordinary circumstances.⁵⁵ No further extensions of time to oppose will be permitted.

207.02 Extensions Up to 120 Days From the Date of Publication

A first extension of time to oppose for not more than thirty days will be granted upon written request, if the request is otherwise appropriate (*e.g.*, is timely filed, identifies the potential opposer with reasonable certainty).⁵⁶ No showing of cause is required for the first thirty-day extension.⁵⁷

Following the first thirty-day extension of time to oppose, the Board may grant a further extension of time for sixty days provided good cause is shown for the further extension and the request is otherwise appropriate (*e.g.*, is timely filed before the first thirty-day extension expires, includes a showing of privity, if necessary).⁵⁸

⁵⁰ 37 CFR § 2.102(c)(3).

⁵¹ See TBMP § 207.02 (Extensions Up to 120 Days from Date of Publication).

⁵² See 37 CFR § 2.102(c). See also TBMP § 202 regarding the timing of notification by the Board as to the grant or denial of an extension request.

⁵³ See 37 CFR § 2.102(c)(1).

⁵⁴ See TBMP § 207.02 (Extensions Up to 120 Days From Date of Publication).

⁵⁵ See 37 CFR § 2.102(c)(3).

⁵⁶ See, *e.g.*, TBMP §§ 202 (Time for Filing Request) and 206 (Who May File an Extension of Time to Oppose).

⁵⁷ See Section 13(a) of the Act, 15 U.S.C. § 1063(a); 37 CFR § 2.102(c); and *Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310, 1312 (Comm'r 1991).

⁵⁸ See 37 CFR § 2.102(c), and, *e.g.*, TBMP §§ 202 (Time for Filing Request) and 206 (Who May File an Extension of Time to Oppose). See also *Lotus Development Corp. v. Narada Productions, Inc.*, *supra*.

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Alternatively, a potential opposer may request a ninety-day extension of time in the first request, provided good cause for the extension is shown. If an otherwise proper first extension request seeks an extension of ninety days, but does not include a showing of good cause for the time in excess of thirty days, the potential opposer will be granted an extension of only thirty days.⁵⁹

A showing of good cause for an extension of time to oppose over thirty days must set forth the reasons why additional time is needed for filing an opposition. Circumstances that may constitute good cause include, applicant's consent to the extension, settlement negotiations between the parties, the filing of a letter of protest by the potential opposer,⁶⁰ an amendment of the subject application,⁶¹ the filing of a petition to the Director from the grant or denial of a previous extension,⁶² and civil litigation between the parties. The merits of the potential opposition are not relevant to the issue of whether good cause exists for the requested extension.

207.03 Extensions Beyond 120 Days From the Date of Publication

The time for filing an opposition will not be extended beyond 180 days from the date of publication. After one or two granted requests totaling 120 days from the date of publication,⁶³ and prior to the expiration of the previous request, the potential opposer may request one final extension of time for an additional sixty days.⁶⁴ No further extensions of time to file an opposition will be granted under any circumstances.⁶⁵

The Board will grant this request if the potential opposer submits one of the following: (1) a written consent or stipulation signed by the applicant or its authorized representative, or (2) a written request by the potential opposer or its authorized representative stating that the applicant or its authorized representative has consented to the request,⁶⁶ or (3) a showing of extraordinary

⁵⁹ See *Lotus Development Corp. v. Narada Productions, Inc.*, *supra* (potential opposer only entitled to extension of 30 days where initial request exceeded thirty days by two days and potential opposer did not assert good cause for additional days); *Kimberly-Clark Corp. v. Paper Converting Industry, Inc.*, 21 USPQ2d 1875, 1877 (Comm'r 1991) (initial request for 60 days with showing of good cause in compliance with the rules).

⁶⁰ See TBMP § 215.

⁶¹ See TBMP § 212.

⁶² See TBMP § 211.03.

⁶³ See TBMP § 207.02 (Extensions Up to 120 Days From Date of Publication).

⁶⁴ See 37 CFR § 2.102(c)(3).

⁶⁵ 37 CFR § 2.102(c)(3).

⁶⁶ NOTE: Proof of service of the request on applicant is no longer required. See 37 CFR § 2.102(c), as amended. See also *In re Docrate Inc.*, 40 USPQ2d 1636, 1638 (Comm'r 1996).

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circumstances.⁶⁷ Consent must be express, though it may be provided orally, and the extension request must state that such consent has been provided. It is not sufficient to indicate in the request that the parties are discussing settlement; the request must expressly state that applicant has consented to the extension.⁶⁸ In addition, the statement of consent should appear in the body of the request, not merely in the title (e.g. "Consented Request to Extend") of the filing.

If one of these elements (*i.e.*, the showing of extraordinary circumstances, or applicant's written consent, or the statement that applicant has consented) is omitted from an extension request based in whole or in part upon the omitted element, the Board can allow the defect to be corrected only if the correction is made prior to the expiration of the time for filing the request, that is, prior to the expiration of the previous extension.⁶⁹

NOTE: *The remaining portion of this section applies only to cases where a first request for extension of time was filed before November 2, 2003. The rules and Board practice governing extensions of time to oppose that were in effect at that time (that is, prior to the November 2, 2003 rule amendments) will continue to apply to all extension requests filed in that case.*

In cases where the first extension request was filed prior to November 2, 2003, the time for filing an opposition may be extended beyond 180 days. However, the time to oppose generally will not be extended beyond 360 days from the date of publication pending, for example, the final determination of another proceeding between the potential opposer and the applicant, or the conclusion of unduly prolonged settlement negotiations, or the filing of a new application, and its prosecution to publication or registration by the potential opposer or applicant.

Moreover, in addition to the requirement for consent or a showing of extraordinary circumstances, the Board will not grant an extension of time over 120 days from the date of publication unless the potential opposer submits a showing of good cause required for extensions of time beyond the first thirty-day extension period.

⁶⁷ See 37 CFR § 2.102(c)(3).

⁶⁸ See *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093, 1094 (Comm'r 1990) (mere existence of settlement discussions does not constitute extraordinary circumstances).

⁶⁹ See *In re Su Wung Chong*, 20 USPQ2d 1399, 1400 (Comm'r 1991) (since potential opposer failed to submit required showing of extraordinary circumstances with extension request as required by Rule 2.102(c)(3), question on petition was not whether any such extraordinary circumstances existed at time of request but instead whether potential opposer showed extraordinary circumstances existed that prevented compliance with that rule); *In re Software Development Systems, Inc.*, 17 USPQ2d 1094, 1095 (Comm'r 1989) (inadvertent failure to provide proof of service not extraordinary circumstance to waive [former] rule requiring proof of service); and *In re Societe Des Produits Nestle S.A.*, *supra* at 1094 (extraordinary circumstances not shown to waive requirement that showing of extraordinary circumstances be submitted with extension request and subsequently obtained consent insufficient). Cf. *In re Spang Industries, Inc.*, 225 USPQ 888, 888 (Comm'r 1985) (identification of potential opposer omitted).

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If an acceptable showing of extraordinary circumstances is submitted in support of a request for an extension running beyond 120 days from the date of publication, the requirement for a showing of good cause is satisfied. If a request for an extension running beyond 120 days from publication is based upon applicant's consent, but includes no recitation of other facts relating to good cause, applicant's consent will be construed as good cause for that request, but the potential opposer will be advised by the Board, in writing, that any further extension request based upon applicant's consent must include also a recitation of circumstances showing good cause for the request.

When a potential opposer files repeated extension requests based upon applicant's consent coupled with an assertion that the parties are negotiating for settlement, the Board ordinarily will require, for extensions aggregating more than 180 days from the date of publication of applicant's mark, that the extension request include also a report on the status of their settlement negotiations. In such a case, the Board, in writing, will advise potential opposer that any further extension requests made on the basis of consent and settlement negotiations should include a summary of the progress of the negotiations. If the subsequent request fails to include this summary, the request may be denied.

As a general rule, the Board will not grant extensions of time to oppose beyond 360 days from the date of publication, unless settlement has been reached and only needs to be executed. The general rule, however, will be applied flexibly and reasonably, depending upon the circumstances in a given case. For example, if a foreign party is involved, or if parties are trying to settle several cases at once, or if numerous parties are involved, more time may be allowed.

208 Essential Element Omitted

If any element (*e.g.*, identification of potential opposer, showing of good cause, showing of extraordinary circumstances, applicant's written consent, statement that applicant has consented) essential to a particular request for extension of time to oppose is omitted from the request, the Board can allow the defect to be corrected only if the correction is made prior to the expiration of the time for filing the request, that is, prior to the expiration of the thirty-day opposition period following publication of the subject mark, in the case of a first request, or prior to the expiration of the previous extension, in the case of a request for a further extension.⁷⁰

While a request for an extension of time to oppose must be signed, an unsigned paper request will not be refused consideration if a signed copy is submitted to the Office within the time limit

⁷⁰ See *In re Su Wung Chong, supra*; (showing of extraordinary circumstances omitted); *In re Societe Des Produits Nestle S.A., supra*; (extraordinary circumstances not shown and subsequently obtained consent untimely); and *In re Spang Industries, Inc., supra* (identification of potential opposer omitted).

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set in the written notification of this defect by the Board.⁷¹ Extension requests filed through ESTTA cannot be electronically transmitted to the Office unless all required fields, including the signature field, are completed.

209 Action by Board on Request

209.01 Suspension Policy

The Board will not suspend the running of an extension of time to oppose for any reason. A potential opposer must either continue to file timely requests for extensions of time, if it wishes to preserve its right to oppose, or file the notice of opposition. Once the notice of opposition is filed, however, the Board will suspend the opposition under appropriate circumstances.⁷²

209.02 Determination of Extension Expiration Date

The extension expiration date stated in an action granting an extension, is the date upon which the extension actually expires, even if that date is a Saturday, Sunday, or a Federal holiday within the District of Columbia. If the expiration date falls on a Saturday, Sunday, or a Federal holiday within the District of Columbia, an opposition, or a request for a further extension, filed by the potential opposer on the next succeeding day which is not a Saturday, Sunday, or a Federal holiday will be considered timely.⁷³ However, the beginning date for calculating the further extension is the actual expiration date of the previous extension, regardless of whether the expiration date fell on a weekend or Federal holiday.⁷⁴

A potential opposer may file a first request for a thirty-day extension without a showing of cause,⁷⁵ followed by a request for a sixty-day extension for good cause that is filed prior to the expiration of the first thirty-day period.⁷⁶ Alternatively, the potential opposer may file a single

⁷¹ See 37 CFR § 2.119(e) and TBMP § 106.02 (Signature of Submissions).

⁷² See, for example, TBMP §§ 211.03, 212.05, 215, 216 and 510.

⁷³ See 37 CFR § 2.195; *Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310, 1312 (Comm'r 1991) (potential opposer miscalculated first 30-day extension request and threw off all subsequent periods); and TBMP § 112 (Time for Taking Action).

⁷⁴ See *Lotus Development Corp. v. Narada Productions, Inc.*, *supra* at 1312.

⁷⁵ See TBMP 207.02 (Extensions Up to 120 Days From Date of Publication).

⁷⁶ See 37 CFR § 2.102(c). See also TBMP § 202 regarding the timing of notification by the Board as to the grant or denial of a request.

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request for a ninety-day extension of time for good cause.⁷⁷ After one or two granted requests totaling 120 days from the date of publication,⁷⁸ and prior to the expiration of the previous extension, the potential opposer may file one final extension request for an additional sixty days with the consent of applicant or a showing of extraordinary circumstances.⁷⁹

If a first request for an extension of time to oppose asks for a time which is longer than thirty days (or seeks an extension of "thirty days," but specifies an extension expiration date which is later than the expiration date of the requested "thirty days"), and good cause is shown, the extension, if granted, will be set to expire in ninety days.⁸⁰ If good cause for the time beyond thirty days has not been shown, the time will be set to expire on the thirtieth day.⁸¹

If a further request for extension of time to oppose (that is, beyond the first thirty-day request) asks for a time which is longer or shorter than sixty days (or asks for certain number of days, but specifies an extension expiration date which is longer or shorter than the expiration date of the requested number of days), and shows good cause, the extension, if granted, will be set to expire in sixty days.

If a further request seeks an extension of time to oppose beyond 120 days from the date of publication, but specifies a date which is longer or shorter than the prescribed additional sixty day period, the extension, if granted, will be set to expire in sixty days .

210 Objections to Request

Since a request for an extension of time to oppose is ex parte in nature, there is no requirement that a copy has to be served upon the applicant.⁸² For the same reason, an applicant is not notified of the filing of an extension request before the Board has acted on it. Not until after the Board has acted on an extension request does the Board send the applicant a copy of the request

⁷⁷ See 37 CFR § 2.102(c)(1).

⁷⁸ See TBMP § 207.02 (Extensions Up to 120 Days From Date of Publication).

⁷⁹ See 37 CFR § 2.102(c)(3).

⁸⁰ See 37 CFR § 2.102(c); *Kimberly-Clark Corp. v. Paper Converting Industry, Inc.*, 21 USPQ2d 1875, 1877 (Comm'r 1991) (initial request extending beyond thirty days with required showing granted); and TBMP § 207.02 (Extensions Up to 120 Days From Date of Publication).

⁸¹ Cf. 37 CFR § 2.102(c), and TBMP § 207.02 (Extensions Up to 120 Days From Date of Publication).

⁸² See TBMP § 203.04 (Service).

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(if there is no proof of service by potential opposer), together with notification of the Board's action.

An applicant may learn of the filing of an extension request, and file objections thereto, before applicant receives anything from the Board about the request. This may happen, for example, when potential opposer serves a courtesy copy of the request upon applicant. If the Board receives objections before it acts upon the request, the Board will consider them. If the objections are received after action on the request, and the request has been granted, the objections will be treated as a request for reconsideration.

An applicant that receives notification from the Board that an extension request has been filed and granted may submit objections in the form of a request for reconsideration.⁸³

Further, an applicant who receives notification from the Board that a request for extension of time to oppose has been granted may submit objections to the granting of any further extensions of time to the potential opposer. In such a case, the objections will be considered by the Board in determining any subsequent request, filed by the potential opposer, for an extension of time to oppose. If the Board does not receive objections until after it has granted a subsequent extension request, they will be treated as a request for reconsideration of the Board's action.

Any document objecting to a request for an extension of time to oppose, or to the granting of any further extensions of time to oppose, should state clearly the reasons for objection. There is no requirement that the document be served upon the potential opposer. If there is no indication that service has been made, the Board will send potential opposer a copy of the document together with the Board's action on the extension request, or, if the document is treated by the Board as a request for reconsideration, with the Board's action on the request for reconsideration.

211 Relief From Action of Board

211.01 Request for Reconsideration

If an applicant or potential opposer is dissatisfied with an action of the Board on a request for an extension of time to oppose, it may file a request for reconsideration of the action, stating the reasons. The request should be filed promptly after the filing party receives the Board's action.

A request for reconsideration of a Board action relating to a request for an extension of time to oppose is examined by one of the Board's administrative staff members, who will prepare an

⁸³ *For information concerning a request for reconsideration of an action of the Board relating to a request for extension of time to oppose, see TBMP § 211.01.*

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action granting or denying the request. One copy of the action is entered in the file of the subject application, one copy is sent to the applicant, and one copy is sent to the potential opposer.

There is no requirement that a request for reconsideration be served upon the nonfiling party. If there is no indication that service has been made, the Board will send the nonfiling party a copy of the request together with that party's copy of the Board's action granting or denying the request.

The filing of a request for reconsideration of the denial, or the granting, of a request for an extension of time to oppose does not relieve the potential opposer of the responsibility of filing an opposition, or a request for a further extension of time to oppose, before the expiration of the relevant extension.⁸⁴

211.02 Relief after Institution of Opposition

If an applicant is dissatisfied with an action of the Board on a request for an extension of time to oppose and the opposition has been filed and instituted, the applicant may raise the issue by means of a motion to dismiss the opposition for lack of jurisdiction.⁸⁵

211.03 Petition to the Director

If an applicant or potential opposer is dissatisfied with an action of the Board on a request for an extension of time to oppose, it may file a petition to the Director, pursuant to 37 CFR § 2.146, for review of the action in question.⁸⁶

The petition to the Director must include a statement of the facts relevant to the petition; the points to be reviewed; the action or relief requested; and the requisite fee, as specified in 37 CFR § 2.6. Any brief in support of the petition must be embodied in or accompany the petition. If facts are to be proved, the proof must be in the form of affidavits or declarations in accordance with 37 CFR § 2.20, and these affidavits or declarations, with any exhibits thereto, must accompany the petition.⁸⁷

⁸⁴ Cf. 37 CFR § 2.89(g).

⁸⁵ See *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1075 n.2 and, generally, TBMP § 502 (regarding motions). See also *Central Manufacturing Inc. v. Third Millennium Technology Inc.*, 61 USPQ2d 1210, 1215 (TTAB 2001) (motion to dismiss granted where it was found that opposer's allegations of consent and good cause [i.e., that the parties were engaged in settlement discussions] to extend beyond 120 days were untrue).

⁸⁶ See also TMEP § 1704.

⁸⁷ See 37 CFR § 2.146(c).

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A petition from the grant or denial of a request for an extension of time to oppose must be filed within 15 days from the mailing date of the grant or denial of the request.⁸⁸ A petition from the denial of a request must be served on the attorney or other authorized representative of the applicant, if any, or on the applicant.⁸⁹ A petition from the grant of a request must be served on the attorney or other authorized representative of the opposer, if any, or on the opposer.⁹⁰ Proof of service of the petition must be made as provided in 37 CFR § 2.119(a).⁹¹ The potential opposer or the applicant, as the case may be, may file a response within 15 days from the date of service of the petition.⁹² A copy of the response must be served upon the petitioner, with proof of service as provided by 37 CFR § 2.119(a). No further document relating to the petition may be filed.⁹³

The filing of a petition by the potential opposer from the denial, or by the applicant from the granting, of a request for an extension of time to oppose, does not relieve the potential opposer of the responsibility of filing an opposition, or a request for a further extension of time to oppose, prior to the expiration of the extension which is the subject of the petition.⁹⁴ The filing of a petition will constitute good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark, but will not constitute extraordinary circumstances justifying an extension of time beyond 120 days from publication.

If the petition is resolved unfavorably to opposer during the running of an extension of time, any opposition or request for further extension of time to oppose filed during or after the extension period in question will be rejected as untimely.

If opposer files a timely opposition during the pendency of its petition to the Director, the Board will institute the opposition. At the same time, the Board will normally suspend the opposition pending resolution of the petition. If, along with the notice of opposition, the opposer files a motion to suspend the opposition, citing the pending petition as the reason for suspension, the Board will institute the opposition, grant the motion to suspend, and state that the opposition is

⁸⁸ See 37 CFR § 2.146(e)(1).

⁸⁹ See 37 CFR § 2.146(e)(1).

⁹⁰ See 37 CFR § 2.146(e)(1).

⁹¹ See also TBMP §§ 113.03 (Elements of Certificate) and 113.04 (Manner of Service).

⁹² See 37 CFR § 2.146(e)(1).

⁹³ See 37 CFR § 2.146(e)(1).

⁹⁴ See, e.g., *In re Docrite Inc.*, 40 USPQ2d 1636, 1637 n.1 (Comm'r 1996) (citing Trademark Rule 2.146(g) and stating that filing petition to review denial of request to extend time to oppose does not stay time to file opposition or further extensions of time to oppose).

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suspended pending resolution of the petition to the Director. A copy of the Board's action will be sent to both parties and a copy of the notice, along with a copy of the motion to suspend, will be sent to the applicant.

If the decision on the petition is unfavorable to opposer, the opposition will be dismissed as a nullity, and the fee will be refunded.

212 Amendment of Application During or After Extension

212.01 Jurisdiction to Consider Amendment

The Board has no jurisdiction over an application unless and until the application becomes involved in a Board inter partes proceeding.⁹⁵ In the absence of an inter partes proceeding, the Board has jurisdiction only over matters relating to any requested extension(s) of time to oppose.

Thus, if, in an application which is the subject of a request for an extension of time to oppose, an amendment or other paper (such as a request for republication, a request for reconsideration of a refusal to approve an amendment) relating to the application is filed by the applicant, and the application is not involved in any Board inter partes proceeding, it is the examining attorney who must determine the propriety of the amendment or other paper.⁹⁶

However, the Board does determine the propriety of a request filed by an attorney or other authorized representative to withdraw as applicant's representative, in an application which is the subject of a request for an extension of time to oppose. The Board has jurisdiction to consider the request to withdraw as representative in such a case, because applicant's representative of record acts in applicant's behalf in matters relating to the requested extension(s) of time to oppose.

Any amendment proposed by an applicant, whether of its own volition or to accommodate a concern of a potential opposer must be sent to the Board's attention, not to the examining attorney who approved the mark for publication. The Board will note the amendment and transfer the file to the examining attorney. Because the examining attorney eventually will consider the amendment, any phone inquiry for discussion of the content of the amendment should be directed to the examining attorney.

⁹⁵ Compare Trademark Rules 2.84 and 2.133.

⁹⁶ See 37 CFR § 2.84, and *In re MCI Communications Corp.*, 21 USPQ2d 1534 (Comm'r 1991). Cf. *Groening v. Missouri Botanical Garden*, 59 USPQ2d 1601, 1603 (Comm'r 1999) (mark originally published in wrong class may be amended by examining attorney to the correct class and republished in the correct class without either applicant's approval or a restoration of jurisdiction).

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212.02 Conditions for Examining Attorney Approval of Amendment

During the time between the publication of a mark in the *Official Gazette* for opposition, and the printing of a certificate of registration or notice of allowance, an application not involved in an inter partes proceeding before the Board may be amended upon request by the applicant, provided that the amendment does not necessitate issuance of a refusal or requirement by the Examining Attorney. If a refusal or requirement by the Examining Attorney would be needed, the amendment cannot be made unless applicant (1) successfully petitions the Director to restore jurisdiction over the application to the Examining Attorney for consideration of the amendment and further examination, and (2) is able to satisfy any requirement or overcome any refusal asserted in any Office action issued after the restoration of jurisdiction.⁹⁷

Examples of the types of amendments which may be made under the conditions described above include acceptable amendments to the identification of goods, to the drawing, to add a disclaimer, and (in the case of an application under Section 1(a) of the Act, or an application under Section 1(b) of the Act in which an acceptable amendment to allege use has been filed, or an application under Section 44 or 66(a) of the Act in which an appropriate allegation of use has been made), to convert an application for an unrestricted registration to one for concurrent use registration.⁹⁸

An applicant who files an amendment to its application during an extension of time to oppose need not have potential opposer's consent thereto.

212.03 Form of Amendment

An amendment or other paper relating to an application which is the subject of a request for an extension of time to oppose should be in the normal form for an amendment or other document relating to an application, except that it should be directed to the attention of the Trademark Trial and Appeal Board (*i.e.*, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514).

⁹⁷ See 37 CFR § 2.84(b) and TMEP §§ 1504.01 and 1505 *et seq.*

⁹⁸ See *In re MCI Communications Corp.*, 21 USPQ2d 1534, 1539 (Comm'r 1991) (disclaimer). Cf. *In re Little Caesar Enterprises, Inc.*, 48 USPQ2d 1222 (Comm'r 1998) (regarding request to divide certain items out of a class of goods during extension of time to oppose, and petition to waive rule requiring that request to divide be filed before application is approved for publication) and TMEP § 1505.01 regarding approval of amendments after publication.

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212.04 Action by Board -- Upon Receipt of Amendment

When an amendment relating to an application which is the subject of a request for an extension of time to oppose is received by the Board, a Board administrative staff member will issue an action acknowledging receipt of the amendment, transferring the application file to the examining attorney for consideration of the amendment, and explaining the effect the filing of the amendment has on the extension of time to oppose.⁹⁹

If an amendment is filed during the running of a well taken request for an extension of time, the action will acknowledge receipt of the amendment; note that the amendment requires consideration by the examining attorney; approve the extension (or if already approved, note that potential opposer has been granted an extension of time to oppose until a specified date); indicate the application is transferred to the examining attorney for consideration of the amendment; instruct the examining attorney to act on the amendment (either by approving it for entry or by telephoning the applicant, explaining why the amendment cannot be approved, and placing a record of the telephone call in the file), and then return the application to the Board; and indicate that after the application has been returned to the Board, further appropriate action will be taken with respect to the potential opposition. The action will also advise potential opposer that the filing of the amendment does not relieve the potential opposer of the responsibility of filing an opposition, or, if appropriate, a further request for extension of time to oppose, prior to the expiration of the previous request.

If an amendment is filed after the expiration of potential opposer's extension of time to oppose, and no opposition or request for a further extension of time to oppose has been timely filed, the Board's action will acknowledge receipt of the amendment; note that the amendment requires consideration by the examining attorney; indicate that potential opposer's extension of time to oppose has expired, and that no opposition or request for a further extension of time to oppose has been timely filed; forward the application to the examining attorney for consideration of the amendment; and state that the examining attorney may treat the amendment in the same manner as any amendment after publication¹⁰⁰ and need not return the application to the Board after consideration of the amendment.

If an amendment is filed prior to action by the Board on a request for an extension of time to oppose, and the request is not granted, the action will acknowledge receipt of the request and the amendment; note that the amendment requires consideration by the examining attorney; deny the request; forward the application to the examining attorney for consideration of the amendment; and state that the examining attorney may treat the amendment in the same manner as any

⁹⁹ See, for example, *In re MCI Communications Corp.*, *supra* (entry of disclaimer as means of settling potential opposition).

¹⁰⁰ TMEP §§ 1504.01 and 1505 *et seq.*

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amendment after publication¹⁰¹ and need not return the application to the Board after consideration of the amendment.

If an amendment is filed after a request for an extension of time to oppose has been denied by the Board, but before the Board has forwarded the application to issue, the action will acknowledge receipt of the amendment; note that the amendment requires consideration by the examining attorney; indicate that potential opposer's request for an extension of time to oppose has been denied; forward the application to the examining attorney for consideration of the amendment; and state that the examining attorney may treat the amendment in the same manner as any amendment after publication¹⁰² and need not return the application to the Board after consideration of the amendment.

When the Board's action is complete, one copy is entered in the file of the subject application, one copy is sent to the applicant, and one copy each of the amendment and letter is sent to the potential opposer. The application is then forwarded to the examining attorney for consideration of the amendment.

If an amendment is filed prior to the Board's institution of a timely opposition, the Board will institute the opposition, and at the same time suspend the opposition pending consideration of the amendment by the examining attorney.

212.05 Action by Board -- During Consideration of Amendment by Examining Attorney

The filing of the amendment will be considered good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark, but it will not constitute extraordinary circumstances justifying an extension of time beyond 120 days from publication.

If a timely opposition is filed while the amendment is still pending before the examining attorney, the Board will institute the opposition, and at the same time the Board will normally suspend the opposition pending consideration of the amendment by the examining attorney. If, along with the notice of opposition, the opposer files a motion to suspend the opposition, citing the pending amendment as the reason for suspension, the Board will institute the opposition, grant the motion to suspend, and state that the opposition is suspended pending consideration of the amendment by the examining attorney. A copy of the institution order will be sent to both parties, and a copy of the notice of opposition and any motion to suspend will be sent to the applicant.

¹⁰¹ TMEP §§1504.01 and 1505 *et seq.*

¹⁰² TMEP §§ 1504.01 and 1505 *et seq.*

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212.06 Action by Board -- After Consideration of Amendment by Examining Attorney

When an amendment in an application which is the subject of an extension of time to oppose is forwarded to the examining attorney for consideration, the examining attorney acts on the amendment, either by approving it for entry or by telephoning the applicant, explaining why the amendment cannot be approved and placing a record of the telephone call in the file.¹⁰³ The examining attorney then returns the application to the Board (unless the time for opposing expired prior to the filing of the amendment).

If the application is returned to the Board during the running of a well taken request for an extension of time, a Board administrative staff member will issue an action approving the extension (or, if already approved, noting that potential opposer has been granted an extension of time to oppose until a specified date); indicating whether or not the amendment was approved; and taking further appropriate action relating thereto.

For example, sometimes a potential opposer, in a request for an extension of time to oppose or in a separate document, states that it has agreed not to oppose if applicant's application is amended in a certain manner. If the amendment submitted by applicant conforms to the agreement and the examining attorney approves it, the Board's action will indicate that the amendment has been approved; that potential opposer has agreed not to oppose if the amendment is approved; and that the application is accordingly being forwarded to issue. If the amendment was not approved, the action will so state, and potential opposer will be advised that it will need to continue to file timely requests for extensions of time or file its notice of opposition.

If there is no statement by potential opposer that it will not oppose if the amendment submitted by applicant is approved, the Board's action will state whether the amendment was approved, and will advise the potential opposer that it will need to continue to file timely requests for extensions of time, or file its notice of opposition.

Sometimes an examining attorney considering an amendment to an application that is the subject of an extension of time to oppose, does not approve the amendment submitted by the applicant, but instead makes a different amendment by Examiner's Amendment.¹⁰⁴ In such a case, the Board, in its action, will so state; specify the amendment made by Examiner's Amendment; and advise potential opposer that it will need to continue to file timely requests for extensions of time, or file its notice of opposition.

¹⁰³ See *In re MCI Communications Corp.*, 21 USPQ2d 1534, 1539 (Comm'r 1991) (entry of voluntary disclaimer).

¹⁰⁴ See TMEP § 707.

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When the Board's action is complete, one copy is entered in the file of the subject application, one copy is sent to the applicant, and one copy is sent to the potential opposer.

If an opposition was instituted prior to the examining attorney's action on the amendment, and the amendment is subsequently approved, the Board will prepare an action notifying the parties that the amendment was approved; advising the parties that the opposition will go forward on the basis of the application as amended; allowing opposer time to indicate whether it wishes to proceed with the opposition on that basis, or to have the opposition dismissed as a nullity and the fee refunded; and suspending the opposition (or continuing suspension) pending opposer's response to the Board's action. If opposer chooses to go forward, proceedings in the opposition will be resumed and appropriate dates will be set. If the amendment is not approved, the parties will be so advised, and proceedings will be resumed with appropriate dates set.

212.07 Amendment During Opposition

If an amendment is filed in an application that is the subject of an opposition, the Board has jurisdiction over the application and will determine the propriety of the amendment. Once an opposition has commenced, the application that is the subject of the opposition may not be amended in substance, except with the consent of the other party or parties and the approval of the Board, or except upon motion granted by the Board.¹⁰⁵

213 Effect of Restoration of Jurisdiction

If the Examining Attorney wishes to refuse registration or make a requirement in an application that is the subject of a request for an extension of time to oppose, the examining attorney must request the Director to restore jurisdiction over the application to the examining attorney for that purpose.¹⁰⁶ If the application is also the subject of an opposition, the examining attorney's request for jurisdiction must be directed to the Board.¹⁰⁷ It should be noted that because an application under Section 66(a) of the Act, 15 U.S.C. § 1141f, is time-sensitive, the granting of a request to return a 66(a) application to the examination process is unlikely.¹⁰⁸

A request for jurisdiction that is granted during an unexpired extension of time to oppose, does not relieve the potential opposer of the responsibility of filing an opposition, or a request for a further extension of time to oppose, before the expiration of the previous request. After the

¹⁰⁵ See 37 CFR § 2.133, and TBMP § 514 (Motion to Amend Application or Registration).

¹⁰⁶ See 37 CFR § 2.84(a); TMEP §§ 1504.01 and 1504.02 and *In re Hershey*, 6 USPQ2d 1470, 1471 n.2 (TTAB 1988) (restoration of jurisdiction to examining attorney by [Director] is not subject to review by the Board).

¹⁰⁷ See 37 CFR § 2.130 and TMEP § 1504.02.

¹⁰⁸ Should such a request be granted, the time to file a timely opposition continues to run.

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Board learns that the examining attorney's jurisdiction has been restored, a Board administrative staff member will prepare an action advising potential opposer and applicant thereof and taking further appropriate action. Examples are described below.

If the restoration of jurisdiction occurs during the running of an extension of time to oppose, the action will inform the potential opposer and applicant that jurisdiction over the application has been restored to the examining attorney; approve the extension of time, if appropriate (or, if already approved, note that potential opposer has been granted an extension of time to oppose until a specified date); instruct the examining attorney that if the application is subsequently approved, and the mark is not republished, the application must be returned to the Board; and advise potential opposer that the restoration of jurisdiction does not relieve the potential opposer of the responsibility of filing an opposition, or a further request for extension of time to oppose, prior to the expiration of the previous request.

The restoration of jurisdiction (or the filing of a request for jurisdiction) will constitute good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark, but will not constitute extraordinary circumstances justifying an extension of time beyond 120 days from publication.

One copy of the Board's action will be entered in the file of the subject application, one copy will be sent to the applicant, and one copy each of the Board's action and of the examining attorney's office action will be mailed to the potential opposer.

If, during the running of an extension of time, the examining attorney approves the application, and the mark is not republished, the Board administrative staff member will issue an action so advising the potential opposer and applicant. The action will also approve the extension of time, if appropriate (or, if already approved, note that potential opposer has been granted an extension of time to oppose until a specified date). If the mark is republished, or if registration is ultimately denied, the extension request, if not yet approved, will be moot. No further extension of the original opposition period will be granted. Rather, a potential opposer's time for opposing will recommence on the date of republication.

If a timely opposition is filed while the question of registrability is still before the examining attorney, the Board will institute the opposition. At the same time, the Board will normally suspend proceedings until the registrability of the mark has been finally determined. If, along with the notice of opposition, the opposer files a motion to suspend the opposition, citing the restoration of jurisdiction as the reason for suspension, the Board will institute the opposition, grant the motion to suspend, and indicate that the opposition is suspended pending final determination of the registrability of the mark. A copy of the Board's action will be sent to both parties and a copy of the notice of opposition, along with a copy of any motion to suspend, will be sent to the applicant.

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If the examining attorney subsequently approves the application, and the mark is republished, and if the change reflected in the republication is one that might have an effect upon the opposition, the Board will issue an action notifying opposer and applicant of the republication, and of the reason therefor; explain that the opposition will be determined on the basis of applicant's correct (or amended) mark, goods or services, disclaimer status, etc.; and allow opposer time to indicate whether it wishes to proceed with the opposition on that basis, or to have its opposition fee refunded, and the opposition dismissed as a nullity. If opposer chooses to go forward, proceedings in the opposition will be resumed and appropriate dates will be set.

If registration is ultimately denied, the opposition will not be instituted, or if already instituted, will be dismissed as a nullity and the fee refunded.

214 Effect of Republication

The examining attorney may determine that an application filed under Section 1 or 44 of the Act, 15 U.S.C. §§ 1051 or 1126, that is the subject of a request for an extension of time to oppose must be republished. This may happen, for example, when the mark was originally published in the wrong class; when the goods or services, although properly identified in the application itself, were published incorrectly; when a disclaimer was mistakenly included in the original publication; or when the application has been amended after publication (but before the filing of an opposition), and the amendment is of such nature as to require republication.¹⁰⁹ Republication may not be available to applications filed under Section 66(a) of the Act, 15 U.S.C. § 1141f, due to the time requirements of the Madrid Protocol.¹¹⁰

If a mark is republished by order of the examining attorney, any opposition filed during the original thirty-day opposition period, or within a granted extension thereof, is considered by the Board to be timely. If the change reflected in the republication is one that might have an effect upon the opposition, the Board will issue an action notifying opposer and applicant of the republication, and of the reason therefor; explain that the opposition will be determined on the basis of applicant's correct (or amended) mark, goods or services, disclaimer status, etc.; and allow opposer time to indicate whether it wishes to proceed with the opposition on that basis, or to have its opposition fee refunded, and the opposition not instituted.

However, once the Board learns that a mark that is the subject of a request for an extension of time to oppose has been or will be republished by order of the examining attorney, no further extension of the original opposition period will be granted. Rather, a potential opposer's time for

¹⁰⁹ See TMEP § 1505.01. See also, for example, *Groening v. Missouri Botanical Garden*, 59 USPQ2d 1601, 1603 (Comm'r 1999) (mark originally published in wrong class may be amended by examining attorney to the correct class and republished in the correct class without either applicant's approval or a restoration of jurisdiction).

¹¹⁰ See Sections 68 and 69 of the Act, 15 U.S.C. §§ 1141h and 1141i.

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opposing will recommence with the republication of applicant's mark. Thus, if there is a pending request for an extension of time to oppose, a Board administrative staff member will issue an action notifying potential opposer and applicant of the republication and taking appropriate action with respect to the extension request. Normally, the extension request will be deemed moot. However, if the extension request was filed within thirty days after the date of republication, it may be treated as a request for an extension of the new opposition period.

If there has been an error in the first publication, or the application has been amended thereafter, republication is often necessary in order to give potential opposers fair notice of the registration sought by applicant. Sometimes, however, a mark that has been published correctly, and has not been amended thereafter, is republished not because there is any need for republication, but by inadvertence. When there is no need for republication, and a mark is republished solely by mistake (as, for example, when an application has survived an opposition, and is ready to go to issue, but is inadvertently sent to publication rather than to issue), the application may not properly be subjected to another opposition period.

Accordingly, when it comes to the attention of the Board that an application has been republished by mistake, the Board will not entertain any opposition or request for an extension of time to oppose filed in response to the republication. An opposition filed in response to the inadvertent republication will be returned to the opposer, and the opposition fee will be refunded. The remedy of a would-be opposer or potential opposer in such a case lies in the filing of a petition for cancellation, under Section 14 of the Act, 15 U.S.C. § 1064, after applicant's registration has been issued.

215 Effect of Letter of Protest

A third party that has knowledge of facts bearing upon the registrability of a mark in a pending application may bring such information to the attention of the Office by filing, with the Office of the Commissioner for Trademarks, a "letter of protest," that is, a letter that recites the facts and is accompanied by supporting evidence.¹¹¹ The Administrator for Trademark Identifications, Classifications and Practice (Administrator) will determine whether the letter of protest should be "granted," that is, whether the information should be given to the examining attorney for consideration.¹¹²

¹¹¹ See TMEP § 1715; *In re Urbano*, 57 USPQ2d 1776, 1778 n.5 (TTAB 1999) (letter of protest provided additional information to the examining attorney to maintain a refusal); *In re BPJ Enterprises Ltd.*, 7 USPQ2d 1375, 1379 (Comm'r 1988) (Director committed clear error by allowing examining attorney to be involved in deciding whether the letter of protest was to be granted); and *In re Pohn*, 3 USPQ2d 1700, 1703 (Comm'r 1987) (guidelines for timeliness of letter of protest).

¹¹² See TMEP § 1715. For information concerning the standard applied by the Administrator in determining whether a letter of protest should be granted, see TMEP § 1715 *et seq.*

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A letter of protest may be filed either before or after publication of the subject mark for opposition. However, a letter of protest filed after publication ordinarily must be filed within thirty days after publication in order to be considered timely.¹¹³ Moreover, even if the Director decides to grant a post-publication letter of protest, the examining attorney cannot consider the submitted information unless the Commissioner for Trademarks, upon written request by the Administrator, concurs in the decision to grant the letter of protest and restores jurisdiction over the application to the examining attorney.¹¹⁴ If the application is the subject of an opposition, the request for jurisdiction should be directed to the Board.¹¹⁵

The filing of a letter of protest does not stay the time for filing an opposition to the subject mark, regardless of when the letter of protest was filed.¹¹⁶ If a party that files a letter of protest after publication wishes to preserve its right to oppose in the event that the letter of protest is denied, it must file a timely request for an extension of time to oppose.¹¹⁷

If a potential opposer indicates, in a first or a subsequent request for an extension of time to oppose, that it has filed a letter of protest (not yet determined by the Administrator) with respect to the subject mark (even if filed more than thirty days after publication) such filing will constitute good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark. However, the filing will not constitute extraordinary circumstances justifying an extension of time beyond 120 days from publication.

The filing by a third party of a letter of protest (not yet determined by the Administrator), with respect to a mark that is the subject of a request for an extension of time to oppose, will not be considered by the Board to constitute good cause for the granting of an extension to the potential opposer.

Following determination of a letter of protest filed with respect to an application that is the subject of a request for an extension of time to oppose, the Board will take further appropriate action. Examples are described below.

¹¹³ See *In re G. Heileman Brewing Co., Inc.*, 34 USPQ2d 1476, 1478 (Comm'r 1994) (letter of protest, filed more than a year after publication and accompanied by evidence of descriptiveness which was available 2 months prior to publication, was untimely); *In re BPJ Enterprises Ltd.*, *supra* (filed 44 days after publication but before timeliness standard enunciated); *In re Pohn*, *supra*; and TMEP § 1715.03.

¹¹⁴ See TMEP § 1715.03.

¹¹⁵ See 37 CFR § 2.130 and TMEP § 1504.02.

¹¹⁶ Cf. TMEP § 1715.03(b).

¹¹⁷ Cf. *In re BPJ Enterprises Ltd.*, *supra*.

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Often, when the application comes to the Board for further appropriate action, the letter of protest has been granted; jurisdiction over the application has been restored to the examining attorney; and the examining attorney has issued an Office action asserting a refusal or a requirement. If a well-taken request for an extension of time to oppose is running at this time, a Board administrative staff member will prepare an action notifying the potential opposer and applicant that the letter of protest has been granted; that jurisdiction over the application has been restored to the examining attorney; that an Office action has been issued by the examining attorney; that the extension request is approved (or, if already approved, that potential opposer has been granted an extension of time to oppose until a specified date); that if the application is subsequently approved, and the mark is not republished, that the application must be returned to the Board; and that the filing of the amendment does not relieve the potential opposer of the responsibility of filing an opposition, or a further request for extension of time to oppose, prior to the expiration of the previous request.

If, during the running of a well taken request for an extension of time, the examining attorney ultimately approves the application, and the mark is not republished, the Board administrative staff member will issue an action so advising potential opposer and applicant and approving the extension of time (or, if already approved, noting that potential opposer has been granted an extension of time to oppose until a specified date). If the mark is republished, or if registration is ultimately denied, the extension request, if not yet granted, will be moot. No further extension of the original opposition period will be granted. Rather a potential opposer's time for opposing will recommence on the date of republication.

If, during the running of an extension of time, the letter of protest is denied, the Board will so advise potential opposer and applicant and take appropriate action on the extension request.

One copy of the Board's action will be entered in the file of the subject application, one copy will be sent to the applicant, and one copy each of the Board's action and of the examining attorney's Office action will be sent to the potential opposer.

If opposer files a timely opposition while its letter of protest is pending (or if the letter of protest is granted, while the question of registrability is still before the examining attorney), the Board will institute the opposition. At the same time, however, the Board will normally suspend the opposition until the letter of protest is decided (or, if the letter of protest has already been granted, until the registrability of the mark has been finally determined). If, along with the notice of opposition, the opposer files a motion to suspend the opposition, citing the filing of its letter of protest (or the restoration of jurisdiction) as the reason for suspension, the Board will institute the opposition, grant the motion to suspend, and state that the opposition is suspended pending a decision on the letter of protest (or if the letter of protest has already been granted, pending final determination of the application before the examining attorney). A copy of the Board's letter will be sent to both parties, and a copy of the notice of opposition along with a copy of any motion to suspend will be sent to the applicant.

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If the examining attorney subsequently approves the application, and the mark is republished, and if the change reflected in the republication is one that might have an effect upon the opposition, the Board will issue an action notifying opposer and applicant of the republication. The Board will inform them of the reason for republication; explain that the opposition will be determined on the basis of applicant's correct (or amended) mark, goods or services, disclaimer status, etc.; and allow the opposer time to indicate whether it wishes to proceed with the opposition on that basis, or to have its opposition fee refunded and the opposition dismissed as a nullity. If opposer chooses to go forward, proceedings in the opposition will be resumed, and appropriate dates will be set.

If registration is ultimately denied, the opposition will not be instituted, or if already instituted, will be dismissed as a nullity and the fee refunded.

216 Inadvertently Issued Registration

Sometimes a registration is issued, mistakenly, from an application that, at the time of such issuance, is the subject of an unexpired extension of time to oppose, or a timely opposition. Such a registration is called an "inadvertently issued" registration.

The Board is without authority, within the context of either an extension of time to oppose, or an opposition proceeding, to cancel an inadvertently issued registration and restore it to application status. Rather, it is the Director who has such authority, and the Director exercises this authority with caution.¹¹⁸ A registration will ordinarily be deemed to have been issued inadvertently if a notice of opposition or a request for extension of time to oppose was timely and properly filed but inadvertently overlooked by the Board.¹¹⁹ The Director will not find that a registration issued inadvertently if (1) the notice of opposition was defective in some manner, and (2) that defect prevented the Office from identifying the application in question, and from withholding the issuance of a registration.¹²⁰

Accordingly, when it comes to the attention of the Board that a registration has issued inadvertently from an application that is the subject of an unexpired extension of time to oppose, the Board will issue an action approving the extension of time, if appropriate (or, if already approved, noting that potential opposer has been granted an extension of time to oppose until a specified date), and advising potential opposer that if it wishes to preserve its right to oppose

¹¹⁸ See *In re Trademark Registration of Mc Lachlan Touch Inc.*, 6 USPQ2d 1395, 1396 (Comm'r 1987).

¹¹⁹ See *Quality S. Manufacturing Inc. v. Tork Lift Central Welding of Kent, Inc.*, 60 USPQ2d 1703, 1704 (Comm'r 2000).

¹²⁰ See *Quality S. Manufacturing Inc. v. Tork Lift Central Welding of Kent, Inc.*, *supra* at 1704 (where notice of opposition misidentified the serial number of opposed application, Director declined to cancel registration finding that error which caused the registration to issue was made by opposer not as result of inadvertent act by the Office).

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should the registration be cancelled as inadvertently issued, potential opposer must continue to file further timely requests for extensions of time to oppose, or it must file the notice of opposition. The Board will then forward the registration file to the Director for such action, as the Director deems appropriate. The Director, in turn, may either cancel the registration as inadvertently issued, and restore it to application status, or decline to do so.

The inadvertent issuance of the registration will be considered good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark, but it will not constitute extraordinary circumstances justifying an extension of time beyond 120 days from publication.

If, during the running of an extension of time, the Director cancels and restores to application status a registration that issued inadvertently during an extension of time to oppose, the potential opposer and applicant will be informed of the inadvertent issuance of the registration, its cancellation by the Director, and the status of the extension request in an action prepared by a Board administrative staff member.

If a registration that issued inadvertently during an extension of time to oppose is not cancelled by the Director and restored to application status, any opposition that may have been filed by the potential opposer will be returned, and any submitted opposition fee will be refunded. The potential opposer's substantive remedy will, under the statute, be through a petition to cancel the registration.

If a timely opposition is filed while the matter of the registration is pending before the Director, the Board will institute the opposition. At the same time, however, the Board will normally suspend the opposition until the matter is resolved. If, along with the notice of opposition, the opposer files a motion to suspend the opposition, citing the inadvertently issued registration as the reason for suspension, the Board will institute the opposition, grant the motion to suspend, and state that the opposition is suspended pending a decision on the matter of the registration. A copy of the Board's action will be sent to both parties, and a copy of the notice of opposition, will be sent to the applicant with a copy of any motion to suspend.

If the Director cancels and restores the registration to application status, the opposition will be resumed and appropriate dates will be set. If the Director declines to cancel the registration, the opposition will be dismissed as a nullity and the fee will be refunded.

If a registration issues inadvertently during a timely opposition, the Director normally will cancel the registration as inadvertently issued, and restore it to application status. However, if the opposition has already been finally determined in applicant's favor when the inadvertent issuance is discovered, applicant may either keep the registration, or request that it be cancelled as inadvertently issued, restored to application status, and then reissued.

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217 Relinquishment of Extension

If a potential opposer whose request for an extension of time to oppose is pending, or whose granted extension has not yet expired, files a letter notifying the Board that it will not oppose, the Board will immediately forward to issue the application that was the subject of the request or extension.

If a potential opposer that has requested or obtained an extension of time to oppose thereafter agrees unconditionally in writing not to oppose, applicant may submit a copy of the agreement to the Board, with an appropriate cover letter bearing proof of service upon potential opposer, and the Board will immediately forward the subject application to issue.¹²¹

218 Abandonment of Application

If an applicant files an express abandonment of an application that is the subject of a pending or granted request for extension of time to oppose, or if a 66(a) application that is the subject of a pending or granted request for extension of time to oppose is abandoned by the Office as the result of cancellation of the underlying international registration,¹²² the application stands abandoned and any pending request for an extension of time to oppose is moot. An application that has been abandoned is no longer subject to the filing of a new opposition. Any opposition filed on or after the filing date of the abandonment will be returned by the Board to the opposer, and the opposition fee will be refunded.¹²³

The abandonment of an application that is not the subject of an inter partes proceeding before the Board (i.e., an opposition, interference, or concurrent use proceeding) is without prejudice to the applicant. It is not necessary that applicant obtain a potential opposer's consent thereto.¹²⁴

In contrast, after the commencement of an opposition, interference, or concurrent use proceeding, if an applicant files an express abandonment of its application (or if a 66(a) application is abandoned by the Office as the result of cancellation of the underlying international registration) without the written consent of every adverse party to the proceeding,

¹²¹ Cf. TBMP § 212.06 (Action by Board—After Consideration of Amendment).

¹²² If an international registration is cancelled by the International Bureau for any reason, the IB will notify the USPTO and the USPTO will abandon the corresponding 66(a) application. See 37 CFR § 7.30.

¹²³ See *Societe des Produits Nestle S.A. v. Basso Fedele & Figli*, 24 USPQ2d 1079, 1081 n.1 (TTAB 1992) and *In re First National Bank of Boston*, 199 USPQ 296, 297 (TTAB 1978) (notice of opposition and abandonment both filed on same day; no opposition). Cf. TBMP § 602.01 (Withdrawal by Applicant).

¹²⁴ See 37 CFR § 2.68.

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judgment will be entered against the applicant.¹²⁵ However, if an application is abandoned after the commencement of an opposition, interference, or concurrent use proceeding, but before applicant has been notified thereof by the Board, the applicant will be given an opportunity to obtain the written consent of every adverse party, or to withdraw the abandonment and litigate the proceeding, failing which judgment shall be entered against applicant.¹²⁶

An applicant may expressly abandon its application by filing in the Office a written statement of abandonment or withdrawal of the application, signed by the applicant or by the applicant's attorney or other authorized representative.¹²⁷

When an applicant files an express abandonment of an application that is the subject of a pending or granted request for extension of time to oppose, or a 66(a) application is abandoned by the Office as the result of cancellation of the underlying international registration, a Board administrative staff member will prepare a letter acknowledging the abandonment, and notifying potential opposer that the application is no longer subject to the filing of a new opposition.

219 Amendment to Allege Use; Statement of Use

An amendment to allege use under Section 1(c) of the Act, 15 U.S.C. § 1051(c), filed in an intent-to-use application (i.e., an application under Section 1(b) of the Act, 15 U.S.C. § 1051(b)) after approval for publication, is late-filed.¹²⁸ Thus, *an amendment to allege use filed during an extension of time to oppose or during an opposition is late-filed.*

A statement of use under Section 1(d) of the Act, 15 U.S.C. § 1051(d), is premature if it is filed in an intent-to-use application prior to the issuance of a notice of allowance under Section 13(b)(2) of the Act, 15 U.S.C. § 1063(b)(2).¹²⁹ A notice of allowance is issued in an intent-to-use application (for which no amendment to allege use has been timely filed and accepted) only after the time for opposing has expired and all oppositions filed have been dismissed.¹³⁰ Thus, *a statement of use filed during an extension of time to oppose or during an opposition is premature.*

¹²⁵ See 37 CFR § 2.135.

¹²⁶ See *In re First National Bank of Boston, supra*. Cf. TBMP § 602.01 (Withdrawal by Applicant).

¹²⁷ See 37 CFR § 2.68.

¹²⁸ See 37 CFR § 2.76(a); and *In re Sovran Financial Corp.*, 25 USPQ2d 1537, 1538 (Comm'r 1992) (amendment to allege use filed during blackout period denied as untimely).

¹²⁹ See Section 1(d)(1) of the Act, 15 U.S.C. § 1051(d)(1), and 37 CFR § 2.88(a).

¹³⁰ See Section 13(b)(2) of the Act, 15 U.S.C. § 1063(b)(2), and 37 CFR § 2.81(b).

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Any late-filed amendment to allege use or premature statement of use will be returned to the applicant, and any fee submitted therewith will be refunded.¹³¹

If an intent-to-use application has been published and is under a well taken request for an extension of time to oppose when a timely filed amendment to allege use (*i.e.*, an amendment to allege use filed prior to approval for publication) is associated with the application, the Board will issue an action approving the extension of time (or, if already approved, noting that potential opposer has been granted an extension of time to oppose until a specified date) and advise the potential opposer that if it wishes to preserve its right to oppose should the amendment to allege use be ultimately withdrawn by the applicant or approved by the examining attorney, the potential opposer must continue to file further timely requests for extensions of time to oppose, or it must file the notice of opposition.

The Board will then return the application to the trademark examining attorney for appropriate action with respect to the amendment to allege use. The examining attorney, in turn, will process the amendment to allege use in the same manner¹³² as any other timely filed amendment to allege use that is not associated with the application file until after publication. In the event that the amendment to allege use is ultimately withdrawn by the applicant, or approved by the examining attorney, the examining attorney should return the application to the Board (before any scheduled republication of applicant's mark) for further appropriate action with respect to the extension of time to oppose.¹³³ If the application is abandoned while it is before the examining attorney, the Board should be notified.

The filing of the amendment to allege use will be considered good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark, but it will not constitute extraordinary circumstances justifying an extension of time beyond 120 days from publication.

If an intent-to-use application has already been published, and is the subject of an opposition, when a timely filed amendment to allege use (*i.e.*, an amendment to allege use filed prior to approval for publication) is associated with the application, the Board normally will suspend the opposition and return the application to the trademark examining attorney for appropriate action¹³⁴ with respect to the amendment to allege use. In the event that the amendment to allege use is ultimately withdrawn by the applicant, or approved by the examining attorney, the examining attorney should return the application to the Board (prior to any scheduled

¹³¹ See 37 CFR §§ 2.76(a) and 2.88(a).

¹³² Described in TMEP § 1104.04.

¹³³ See TMEP § 1104.04.

¹³⁴ As described in TMEP § 1104.04.

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republishing of applicant's mark) for further appropriate action with respect to the opposition.¹³⁵ If the application is abandoned while it is before the examining attorney, the Board should be notified.

220 Inadvertent Issuance of a Notice of Allowance

Sometimes a notice of allowance is issued mistakenly in an intent-to-use application that, at the time of such issuance, is the subject of an unexpired extension of time to oppose or a timely opposition. If a notice of allowance is inadvertently issued in an intent-to-use application which is the subject of an unexpired extension of time to oppose or a timely opposition, and a statement of use is filed, the notice of allowance will be cancelled (by the Intent To Use Division of the Office of Trademark Services) as inadvertently issued. The statement of use will be returned, and the fee submitted therewith will be refunded. If the inadvertently issued notice of allowance has already been cancelled when the Board receives the statement of use, the Board itself will return the statement of use and refund the fee submitted therewith. If the inadvertently issued notice of allowance has not already been cancelled when the Board receives the statement of use, the Intent To Use Division will return the statement of use and refund the fee when it cancels the notice of allowance.

Sometimes a notice of allowance issues between the time an extension request is submitted but not yet approved. Additionally, by the time the Board receives the file for action the extension requested has expired, and no opposition or further extension requests have been filed. In that case, the Board will issue an action acknowledging the extension request; indicating that it was well taken but that time has since expired and no opposition or further request has been filed. The Board will also indicate that a notice of allowance was inadvertently issued during the requested extension period, but since the requested time period has run without subsequent action by the potential opposer, the notice of allowance will not be withdrawn.

¹³⁵ See TMEP § 1104.04.