

need not be filed if it is the subject of another proceeding between the same parties or anyone in privity therewith.

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

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

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

(c) The opposition may be withdrawn without prejudice before the answer is filed. After the answer is filed, the opposition may not be withdrawn without prejudice except with the written consent of the applicant or the applicant's attorney or other authorized representative.

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

#### **§ 2.107 Amendment of pleadings in an opposition proceeding.**

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

[48 FR 23136, May 23, 1983]

#### **CANCELLATION**

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

#### **§ 2.111 Filing petition for cancellation.**

(a) A cancellation proceeding is commenced by the timely filing of a petition for cancellation, together with the required fee, in the Patent and Trademark Office.

(b) Any entity which believes that it is or will be damaged by a registration may file a petition, which should be addressed to the Trademark Trial and Appeal Board, to cancel the registra-

tion in whole or in part. The petition need not be verified, and may be signed by the petitioner or the petitioner's attorney or other authorized representative. The petition may be filed at any time in the case of registrations on the Supplemental Register or under the Act of 1920, or registrations under the Act of 1881 or the Act of 1905 which have not been published under section 12(c) of the Act, or on any ground specified in section 14(3) or (5) of the Act. In all other cases the petition and the required fee must be filed within five years from the date of registration of the mark under the Act or from the date of publication under section 12(c) of the Act.

(c)(1) The petition must be accompanied by the required fee for each class in the registration for which cancellation is sought (see § 2.6). If the fee submitted is insufficient for a cancellation against all of the classes in the registration, and the particular class or classes against which the cancellation is filed are not specified, the Office will issue a written notice allowing petitioner a set time in which to submit the required fees(s) (provided that the five-year period, if applicable, has not expired) or to specify the class or classes sought to be cancelled. If the required fee(s) is not submitted, or the specification made, within the time set in the notice, the cancellation will be presumed to be against the class or classes in ascending order, beginning with the lowest numbered class, and including the number of classes in the registration for which the fees submitted are sufficient to pay the fee due for each class.

(2) If persons are joined as party petitioners, each must submit a fee for each class for which cancellation is sought. If the fees submitted are insufficient for each named party petitioner, the Office will issue a written notice allowing the named party petitioners until a set time in which to submit the required fee(s) (provided that the five-year period, if applicable, has not expired) or to specify the petitioner(s) to which the submitted fees apply. If the required fee(s) is not submitted, or the specification made, within the time set in the notice, the first named party will be presumed to

be the party petitioner and additional parties will be deemed to be party petitioners to the extent that the fees submitted are sufficient to pay the fee due for each party petitioner. If persons are joined as party petitioners against a registration sought to be cancelled in more than one class, the fees submitted are insufficient, and no specification of parties and classes is made within the time set in the written notice issued by the Office, the fees submitted will be applied first on behalf of the first-named petitioner against as many of the classes in the registration as the submitted fees are sufficient to pay, and any excess will be applied on behalf of the second-named party to the petition against the classes in the registration in ascending order.

(3) The filing date of the petition is the date of receipt in the Patent and Trademark Office of the petition together with the required fee. If the amount of the fee filed with the petition is sufficient to pay for at least one person to petition to cancel one class of goods or services but is less than the required amount because multiple party petitioners and/or multiple classes in the registration for which cancellation is sought are involved, and the required additional amount of the fee is filed within the time limit set in the notification of the defect by the Office, the filing date of the petition with respect to the additional party petitioners and/or classes is the date of receipt in the Patent and Trademark Office of the additional fees.

[48 FR 3976 Jan. 28, 1983, as amended at 54 FR 37596, Sept. 11, 1989; 63 FR 48097, Sept. 9, 1998; 64 FR 48924, Sept. 8, 1999]

#### **§2.112 Contents of petition for cancellation.**

(a) The petition to cancel must set forth a short and plain statement showing why the petitioner believes it is or will be damaged by the registration, state the grounds for cancellation, and indicate, to the best of petitioner's knowledge, the name and address of the current owner of the registration. A duplicate copy of the petition, including exhibits, shall be filed with the petition.

(b) Petitions to cancel different registrations owned by the same party

may be joined in a consolidated petition when appropriate, but the required fee must be included for each party joined as petitioner for each class sought to be cancelled in each registration against which the petition to cancel is filed.

[48 FR 3977 Jan. 28, 1983, as amended at 51 FR 28710, Aug. 11, 1986; 54 FR 34897, Aug. 22, 1989]

#### **§2.113 Notification of cancellation proceeding.**

When a petition for cancellation has been filed in proper form (see §§2.111 and 2.112), a notification shall be prepared by the Trademark Trial and Appeal Board, which shall identify the title and number of the proceeding and the registration or registrations involved and shall designate a time, not less than thirty days from the mailing date of the notification, within which an answer must be filed. A copy of the notification shall be forwarded to the attorney or other authorized representative of the petitioner, if any, or to the petitioner. The duplicate copy of the petition for cancellation and exhibits shall be forwarded with a copy of the notification to the respondent (see §2.118), who shall be the party shown by the records of the Patent and Trademark Office to be the current owner of the registration or registrations sought to be cancelled, except that the Board, in its discretion, may join or substitute as respondent a party who makes a showing of a current ownership interest in such registration or registrations. When the party identified by the petitioner, pursuant to §2.112(a), as the current owner of the registration or registrations is not the record owner thereof, a courtesy copy of the petition for cancellation shall be forwarded with a copy of the notification to the alleged current owner, which may file a motion to be joined or substituted as respondent. If the petition is found to be defective as to form, the party filing the petition shall be so advised and allowed a reasonable time for correcting the informality.

[54 FR 34897, Aug. 22, 1989; 54 FR 38041, Sept. 14, 1989]