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## 601 Withdrawal by Opposition or Cancellation Plaintiff

### 601.01 Withdrawal by Opposer

37 CFR § 2.106(c) *The opposition may be withdrawn without prejudice before the answer is filed. After the answer is filed, the opposition may not be withdrawn without prejudice except with the written consent of the applicant or the applicant's attorney or other authorized representative.*

An opposer may withdraw its opposition without prejudice at any time before the applicant's answer is filed. After the answer is filed, however, the opposition may not be withdrawn without prejudice except with the written consent of the applicant or the applicant's attorney or other authorized representative. [Note 1.]

For information concerning the effect of a judgment entered against plaintiff for withdrawal after answer without consent, see note below. [Note 2.]

An opposer may withdraw its opposition by filing with the Board a written withdrawal signed by the opposer or the opposer's attorney. Written consent must be signed with an original, handwritten signature, a copy of an original, handwritten signature, or a complying electronic signature. [Note 3.] The withdrawal should include proof of service upon every other party to the proceeding. [Note 4.] For more information regarding service of papers, see TBMP § 113.

#### NOTES:

1. 37 CFR § 2.106(c). See *Estee Lauder Inc. v. Aloe Creme Labs., Inc.*, 178 USPQ 254, 256 (TTAB 1973) (opposition dismissed with prejudice where applicant's statement that favorable decision in civil action renders issues in opposition moot cannot be construed as consent to opposer's withdrawal). Cf. 37 CFR § 2.114(c) (withdrawal of petition for cancellation); *Johnson & Johnson v. Bio-Medical Sciences, Inc.*, 179 USPQ 765, 766 (TTAB 1973) (although there was no indication that the dismissal of the counterclaims in a previous opposition was "with prejudice," because the record showed that the counterclaims were withdrawn after answer and without consent, it was clear that dismissal was with prejudice and that therefore plaintiff was estopped from attempting to assert same counterclaim in subsequent petition to cancel).

2. See *Johnson & Johnson v. Bio-Medical Sciences, Inc.*, 179 USPQ 765, 766 (TTAB 1973) (dismissal of previous counterclaims with prejudice operated as estoppel barring same counterclaims in subsequent proceeding). Cf. *Miller Brewing Co. v. Coy International Corp.*, 230 USPQ 675, 678 (TTAB 1986) (judgment in first opposition, as result of abandonment of application without consent, operates as claim preclusion in subsequent opposition so as to bar applicant's subsequent application for an insignificantly modified mark); *United States Olympic Committee v. Bata Shoe Co.*, 225 USPQ 340, 342 (TTAB 1984) (abandonment of application without consent in previous opposition does not operate as collateral estoppel or claim preclusion in subsequent cancellation proceeding between same parties since the two cases involve two distinct marks, and does not operate as issue preclusion because no issues were actually litigated in prior opposition); *Bass Anglers Sportsman Society of America, Inc. v. Bass Pro Lures, Inc.*,

200 USPQ 819, 822 (TTAB 1978) (judgment against applicant in prior opposition due to abandonment of application without consent operated as collateral estoppel in subsequent opposition involving same marks and same parties in opposite positions); and *In re Communications Technology Corp.*, 182 USPQ 695, 696 (TTAB 1974) (judgment against applicant in prior opposition between applicant and owner of cited registration is not conclusive of likelihood of confusion and does not operate as estoppel in subsequent application for a distinctly different mark).

3. 37 CFR § 2.193(c)(1).

4. 37 CFR § 2.119(a).

## **601.02 Withdrawal by Petitioner**

**37 CFR § 2.114(c)** *The petition for cancellation may be withdrawn without prejudice before the answer is filed. After the answer is filed, the petition may not be withdrawn without prejudice except with the written consent of the registrant or the registrant's attorney or other authorized representative.*

A petitioner may withdraw its petition for cancellation without prejudice at any time before the registrant's answer is filed. After the answer is filed, however, the petition for cancellation may not be withdrawn without prejudice except with the written consent of the registrant or the registrant's attorney or other authorized representative. [Note 1.]

For information concerning the effect of a judgment entered against plaintiff for withdrawal after answer without consent, see note below. [Note 2.]

A petitioner may withdraw its petition for cancellation by filing with the Board a written withdrawal signed by the petitioner or the petitioner's attorney. Written consent must be in the form of an original, handwritten signature, a copy of an original, handwritten signature, or a complying electronic signature. [Note 3.] The withdrawal should include proof of service upon every other party to the proceeding. [Note 4.] For more information regarding service of papers, see TBMP § 113.

### **NOTES:**

1. 37 CFR § 2.114(c); *Johnson & Johnson v. Bio-Medical Sciences, Inc.*, 179 USPQ 765, 766 (TTAB 1973). *Cf.* 37 CFR § 2.106(c) (Withdrawal of Notice of Opposition); *Estee Lauder Inc. v. Aloe Creme Labs., Inc.*, 178 USPQ 254, 256 (TTAB 1973).

2. *See Johnson & Johnson v. Bio-Medical Sciences, Inc.*, 179 USPQ 765, 766 (TTAB 1973) (dismissal of previous counterclaims with prejudice operated as estoppel barring same counterclaims in subsequent proceeding). *Cf. Sunrise Jewelry Mfg. Corp. v. Fred S.A.*, 175 F.3d 1322, 50 USPQ2d 1532, 1536 (Fed. Cir. 1999) (filing of withdrawal of petition sufficient to consider that no proceeding is “pending” and that proceeding was “disposed of” for purposes of filing Section 15 declaration of incontestability); *Miller Brewing Co. v. Coy International Corp.*,

230 USPQ 675, 678 (TTAB 1986) (judgment in first opposition, as result of abandonment of application without consent, operates as claim preclusion in subsequent opposition so as to bar applicant's subsequent application for an insignificantly modified mark); *United States Olympic Committee v. Bata Shoe Co.*, 225 USPQ 340, 342 (TTAB 1984) (abandonment of application without consent in previous opposition does not operate as collateral estoppel or claim preclusion in subsequent cancellation proceeding between same parties since the two cases involve two distinct marks, and does not operate as issue preclusion because no issues were actually litigated in prior opposition); *Bass Anglers Sportsman Society of America, Inc. v. Bass Pro Lures, Inc.*, 200 USPQ 819, 822 (TTAB 1978) (judgment against applicant in prior opposition due to abandonment of application without consent operated as collateral estoppel in subsequent opposition involving same marks and same parties in opposite positions); and *In re Communications Technology Corp.*, 182 USPQ 695, 696 (TTAB 1974) (judgment against applicant in prior opposition between applicant and owner of cited registration is not conclusive of likelihood of confusion and does not operate as estoppel in subsequent application for a distinctly different mark).

3. 37 CFR § 2.193(c)(1).

4. *See* 37 CFR § 2.119(a).

### **601.03 Effect of Motion for Judgment**

A plaintiff in an opposition or cancellation proceeding may unilaterally withdraw its complaint without prejudice, even in the face of a defendant's adverse motion such as a motion to dismiss, motion for summary judgment, or motion for a more definite statement, provided that the withdrawal is filed prior to defendant's answer to the complaint. When a plaintiff unilaterally withdraws its complaint prior to answer, in the face of a defendant's pending motion for judgment, the proceeding will be dismissed without prejudice (unless plaintiff specifies that it is withdrawing with prejudice), and the pending motion will be declared moot.

## **602 Withdrawal by Opposition or Cancellation Defendant**

### **602.01 Withdrawal by Applicant**

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

*(a) Written document required. An applicant may expressly abandon an application by filing a written request for abandonment or withdrawal of the application, signed by the applicant, someone with legal authority to bind the applicant (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(2).*

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

**37 CFR § 2.135 Abandonment of application or mark.** *After the commencement of an opposition, concurrent use, or interference proceeding, if the applicant files a written abandonment of the application or of the mark without the written consent of every adverse party to the proceeding, judgment shall be entered against the applicant. The written consent of an adverse party may be signed by the adverse party or by the adverse party's attorney or other authorized representative.*

**37 CFR § 7.30 Effect of cancellation or expiration of international registration.** *When the International Bureau notifies the Office of the cancellation or expiration of an international registration, in whole or in part, the Office shall cancel, in whole or in part, the corresponding pending or registered extension of protection to the United States. The date of cancellation of an extension of protection or relevant part shall be the date of cancellation or expiration of the corresponding international registration or relevant part.*

There are five filing bases for an application: (1) use of a mark in commerce under Trademark Act § 1(a), 15 USC § 1051(a); (2) bona fide intention to use a mark in commerce under Trademark Act § 1(b), 15 USC § 1051(b); (3) a claim of priority, based on an earlier-filed foreign application under Trademark Act § 44(d), 15 USC § 1126(d); (4) ownership of a registration of the mark in the applicant's country of origin under Trademark Act § 44(e), 15 USC § 1126(e); and (5) extension of protection of an international registration to the United States, under Trademark Act § 66(a), 15 USC § 1141f(a).

An application for an extension of protection of an international registration to the United States is referred to as a “§ 66(a) application.” Unlike applications under Trademark Act §§ 1 and 44, the basis for a § 66(a) application cannot be changed and there cannot be more than one basis. [Note 1.]

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 the applicant's attorney or other authorized representative. [Note 2.]

However, after the commencement of an opposition proceeding, if the applicant files a written abandonment of its subject application or mark without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant. [Note 3.] The written consent of an adverse party may be signed by the adverse party itself, or by the adverse party's attorney or other authorized representative. [Note 4.] The written consent of the adverse party must be signed with an original, handwritten signature, a copy of an original, handwritten signature, or a complying electronic signature. [Note 5.]

For information concerning the effect of a 37 CFR § 2.135 (abandonment of application or mark) judgment against applicant, see cases cited in the note below. [Note 6.]

In an opposition to an application having multiple classes, if the applicant files a request to amend the application to delete an opposed class in its entirety, the request for amendment is, in effect, an abandonment of the application with respect to that class, and is governed by 37 CFR § 2.135.

Occasionally, an application may be the subject of more than one opposition brought by unrelated opposers. If an applicant files an abandonment in one opposition, with or without the written consent of the opposer to that opposition, the applicant is usually allowed time to inform the Board whether the abandonment is with or without the consent of the remaining opposers. If the abandonment is with consent in any of the remaining oppositions, the applicant must submit the written consent of any of the remaining opposers who have consented so that judgment is not entered against applicant. Judgment will be entered against the applicant in the remaining oppositions for which the written consent of the opposer is not submitted. [Note 7.]

An abandonment of an opposed application should be filed with the Board, and should bear at the top of its first page both the application serial number, and the opposition number and title. The Board encourages the use of ESTTA (Electronic System for Trademark Trials and Appeals), the Board's electronic filing system, for filing an abandonment of an opposed application. Use of the TEAS system is not appropriate for filing and abandonment of an opposed application.

The abandonment should include proof of service upon every other party to the proceeding. [Note 8.] *See* TBMP § 113. If an applicant files an unconsented abandonment after the commencement of an opposition, but before applicant has been notified of the opposition by the Board, applicant will be allowed an opportunity to obtain and submit the written consent of every adverse party, or to withdraw the abandonment and defend against the opposition, failing which judgment will be entered against applicant. [Note 9.] *Cf.* TBMP § 218. If an opposition and an unconsented abandonment of the opposed application are filed on the same day, the abandonment (unless specifically made with prejudice) is without prejudice to applicant; no proceeding will be instituted; and any submitted opposition fee will be refunded. [Note 10.] *Cf.* TBMP § 218.

**Abandonment prior to publication.** If, after an opposition is filed, it comes to the attention of the Board that the opposed application was abandoned prior to its publication for opposition, the Board will advise the parties that the application is not subject to opposition unless applicant files a petition to the Director under 37 CFR § 2.66 or 37 CFR § 2.146, as appropriate, and the petition is granted. If a prior abandonment comes to the attention of the Board at a time reasonably contemporaneous with the filing of the opposition, and the application is not revived, the opposition will not be instituted, and any submitted opposition fee will be refunded. If the prior abandonment comes to the attention of the Board at a later stage in the opposition, and the application is not revived, the opposition will be dismissed without prejudice. [Note 11.]

**Abandonment for failure to respond to office action after remand.** If, during the pendency of an opposition, the Board grants a request by the trademark examining attorney for remand of a § 1 or § 44 application under 37 CFR § 2.130, and the application thereafter becomes abandoned by operation of law for failure of the applicant to respond to an Office action issued by the examining attorney, or because a final refusal to register is affirmed on appeal, judgment under 37 CFR § 2.135 will not be entered against applicant in the opposition. *See* TBMP § 515 (Motion to Remand Application to Examining Attorney). 37 CFR § 2.135 comes into play only when there is a written abandonment by the applicant. However, opposer will be given time to decide whether it wishes to go forward to obtain a determination of the opposition on its merits,

or to have the opposition dismissed without prejudice as moot. [Note 12.] Cf. TBMP § 602.02(b). If, after remand under 37 CFR § 2.130, applicant files a written abandonment of its application without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant pursuant to 37 CFR § 2.135. A Trademark Act § 66(a) application may not be remanded under 37 CFR § 2.130. [Note 13.]

**Abandonment of Trademark Act § 66(a) application as the result of cancellation of the underlying international registration by the International Bureau.** If an international registration is cancelled, in whole or in part, by the International Bureau (IB) for any reason, the IB will notify the USPTO and the USPTO will abandon the corresponding § 66(a) application, in whole or in part, as appropriate. [Note 14.] When a partial cancellation of the international registration occurs, the IB notifies the USPTO of a “restriction of the request for extension of protection.” When a total cancellation occurs, the IB notifies the USPTO of “the death of the international registration.” In the case of a § 66(a) application that is the subject of an opposition, if the USPTO is notified of a partial cancellation of the international registration, and such partial cancellation affects the opposed classes, if judgment under 37 CFR § 2.135 is not entered against applicant, opposer will be given time to decide whether it wishes to go forward to obtain a determination of the opposition on its merits, or to have the opposition dismissed without prejudice as moot. If a § 66(a) application that is the subject of an opposition is abandoned by the Office as the result of total cancellation of the underlying international registration or renunciation of the protection sought in the United States, and if judgment under 37 CFR § 2.135 is not entered against applicant, opposer will be given time to decide whether it wishes to go forward to obtain a determination of the opposition on its merits, or to have the opposition dismissed without prejudice as moot. [Note 15.]

**Other exemplary situations involving applicant's abandonment of its application.**

If an applicant whose application is the subject of an opposition files an abandonment of the application with the written consent of the opposer, the opposition will be dismissed without prejudice, and the application will stand abandoned.

If the applicant files an abandonment of the application with the written consent of the opposer, and the opposer files a withdrawal of the opposition, the opposition will be dismissed without prejudice, and the application will stand abandoned.

If the applicant files an abandonment of the application with prejudice with the written consent of the opposer, the opposition will be dismissed without prejudice (and the application will stand abandoned with prejudice to applicant's right to re-register the same mark for the same goods or services), unless the parties specify otherwise in writing. [Note 16.]

If the applicant files an abandonment of the application with prejudice with the written consent of the opposer, and the opposer files a withdrawal of the opposition with prejudice with the written consent of the applicant, the opposition will be dismissed with prejudice, and the application will stand abandoned with prejudice to applicant's right to reregister the same mark for the same goods or services. [Note 17.]

## NOTES:

1. See 37 CFR § 2.34(b)(3) and 37 CFR § 2.35; TMEP § 806.01(e) and TMEP § 1904.01. Cf. TMEP § 1904.09, which discusses the limited ability to transform a § 66(a) application to one under §§ 1 or 44.
2. 37 CFR § 2.68.
3. 37 CFR § 2.135. See *Goodway Corp. v. International Marketing Group Inc.*, 15 USPQ2d 1749, 1750 (TTAB 1990) (applicant's abandonment of certain applications without opposer's written consent resulted in entry of judgment against application with respect to such applications); *Grinnell Corp. v. Grinnell Concrete Pavingstones Inc.*, 14 USPQ2d 2065, 2067 (TTAB 1990) (consent required for abandonment without prejudice regardless of motivation for abandonment, i.e., a concession by applicant that it is not owner of mark and that judgment would be unfair to real owner, a nonparty to the case); and *In re First National Bank of Boston*, 199 USPQ 296, 301 (TTAB 1978) (where abandonment of application and notice of opposition were filed on same day, consent was not required because there was no application to oppose). See also *Fleming Companies Inc. v. Thriftway Inc.*, 21 USPQ2d 1451, 1453 (TTAB 1991), *aff'd*, 809 F. Supp. 38, 26 USPQ2d 1551 (S.D. Ohio 1992) (where excepted user abandoned application in concurrent use proceeding, judgment precluded such applicant from obtaining any registration at all, although it may remain in proceeding as defaulting user). Cf. *Kraft Foods, Inc. v. Desnoes & Geddes Ltd.*, 64 USPQ2d 1154, 1157 (TTAB 2002) (although not applicable to the facts of the case where the abandonment was filed after the Board's decision and during the pendency of an appeal, the Board stated "Trademark Rule 2.135 provides that during the pendency of an opposition, if the applicant files an abandonment of the application without the consent of the adverse party, judgment shall be entered against the applicant ....").
4. See 37 CFR § 2.135.
5. 37 CFR § 2.193(c)(1).
6. *Aromatique Inc. v. Lang*, 25 USPQ2d 1359, 1361 (TTAB 1992) (applicant, by abandoning application with prejudice in prior opposition is estopped in subsequent opposition from attempting to register virtually identical mark for identical goods); *Miller Brewing Co. v. Coy International Corp.*, 230 USPQ 675, 678 (TTAB 1986) (judgment in first opposition, as a result of abandonment of application without consent, operates as claim preclusion in subsequent opposition so as to bar applicant's subsequent application for an insignificantly modified mark); *United States Olympic Committee v. Bata Shoe Co.*, 225 USPQ 340, 342 (TTAB 1984) (abandonment of application without consent in previous opposition does not operate as collateral estoppel or claim preclusion in subsequent cancellation proceeding between same parties since the two cases involve two distinct marks, and does not operate as issue preclusion because no issues were actually litigated in the prior opposition); *Bass Anglers Sportsman Society of America, Inc. v. Bass Pro Lures, Inc.*, 200 USPQ 819, 822 (TTAB 1978) (judgment against applicant in prior opposition due to abandonment of application without consent operated as collateral estoppel in subsequent opposition involving same marks and same parties in opposite positions); and *In re Communications Technology Corp.*, 182 USPQ 695, 696 (TTAB



1974) (judgment against applicant in prior opposition between applicant and owner of cited registration is not conclusive of likelihood of confusion and does not operate as an estoppel in subsequent application for a distinctly different mark).

*But cf. Sharp Kabushiki Kaisha v. ThinkSharp Inc.*, 448 F.3d 1368, 79 USPQ2d 1376 (Fed. Cir. 2006) (applicant with two similar marks under opposition did not defend one, accepting default judgment; default judgment did not preclude applicant's defense of other mark in related opposition); *Zachry Infrastructure LLC v. American Infrastructure Inc.*, 101 USPQ2d 1249, 1254-55 (TTAB 2011) (no estoppel where certain applications expressly abandoned after civil action because they were filed prior to commencement of oppositions on related applications and an applicant faced with oppositions against more than one application should be able to choose which opposition to defend). *See also Johnson & Johnson v. Bio-Medical Sciences, Inc.*, 179 USPQ 765, 766 (TTAB 1973) (voluntary dismissal of previous counterclaims with prejudice operated as estoppel barring same counterclaims in subsequent proceeding).

7. 37 CFR § 2.135. *See also New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1550-51 (TTAB 2011) (abandonment must be with written consent of all opposers or judgment will be entered for each opposer who has not consented).

8. *See* 37 CFR § 2.119(a).

9. *Cf. In re First National Bank of Boston*, 199 USPQ 296, 301 (TTAB 1978) (where opposition and abandonment were filed on same day).

10. *In re First National Bank of Boston*, 199 USPQ 296, 301 (TTAB 1978) (where opposition and abandonment were filed on same day, opposition was not considered to have been pending when abandonment was filed, and opposer's consent was not at issue).

11. *Societe des Produits Nestle S.A. v. Basso Fedele & Figli*, 24 USPQ2d 1079, 1080 (TTAB 1992).

12. *Cf. Bank of America National Trust & Savings Ass'n v. First National Bank of Allentown*, 220 USPQ 892, 894 n.6 (TTAB 1984) (opposer elected to adjudicate pleaded issues where applicant had conceded that use was not made until after filing date, and its application was held void ab initio); *Daggett & Ramsdell, Inc. v. Procter & Gamble Co.*, 119 USPQ 350, 350 (TTAB 1958), *rev'd on other grounds*, 275 F.2d 955, 125 USPQ 236 (CCPA 1960) (applicant in prior opposition consented to judgment and therefore not entitled to registration but in subsequent opposition against same applicant, opposer pressed for determination on merits).

13. *See* 37 CFR § 7.25 (Sections of part 2 applicable to extension of protection); TMEP § 1504.05(a) ("In a § 66(a) application, the examining attorney may not request a remand during an inter partes proceeding.").

14. *See* 37 CFR § 7.30; TMEP § 1904.08.

15. A "cancellation" by the holder of an international registration is a removal of some or all of

the goods and services as to all of the designated countries. A “renunciation” is the deletion of all the goods and services to some, but not all, of the designated countries. *See also* TMEP § 1906.01(e) (limitation, renunciation, or cancellation of international registration).

16. *See Aromatique Inc. v. Lang*, 25 USPQ2d 1359, 1361 (TTAB 1992). *See also Wells Cargo, Inc. v. Wells Cargo, Inc.*, 606 F.2d 961, 203 USPQ 564 (CCPA 1979) (applicant's successor in interest is bound by act of withdrawal of application with prejudice and is barred from again seeking to register same mark for same goods).

17. *Cf. Montana v. United States*, 440 U.S. 147 (1979) (changes in controlling facts essential to a judgment will render collateral estoppel inapplicable in a subsequent action raising the same issues); *Mayer/Berkshire Corp. v. Berkshire Fashions, Inc.*, 424 F.3d 1229, 76 USPQ2d 1310 (Fed. Cir. 2005) (“A change in trademark usage can constitute a change in transactional facts that avoids preclusion based on the earlier noninfringement decision.”); *Bingaman v. Dept. of the Treasury*, 127 F.3d 1431 (Fed. Cir. 1997) (“Collateral estoppel is subject to exceptions when the circumstances dictate. . . . Courts have crafted an exception to the collateral estoppel principle when there has been a change in the applicable law between the time of the original decision and the subsequent litigation in which collateral estoppel is invoked.”). *See generally* 6 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION: *Res Judicata and Changes in the Facts*, § 32:88 (2011).

## **602.02 Withdrawal by Respondent**

### **602.02(a) Surrender or Voluntary Cancellation of Registration**

**37 CFR § 2.134(a) Surrender or Voluntary Cancellation of Registration.** *After the commencement of a cancellation proceeding, if the respondent applies for cancellation of the involved registration under section 7(e) of the Act of 1946 without the written consent of every adverse party to the proceeding, judgment shall be entered against the respondent. The written consent of an adverse party may be signed by the adverse party or by the adverse party's attorney or other authorized representative.*

**37 CFR § 2.172 Surrender for cancellation.** *Upon application by the owner, the Director may permit any registration to be surrendered for cancellation. The application for surrender must be signed by the owner of the registration, someone with legal authority to bind the owner (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter. When a registration has more than one class, one or more entire class(es) but fewer than the total number of classes may be surrendered. Deletion of fewer than all the goods or services in a single class constitutes amendment of the registration as to that class (see § 2.173), not surrender.*

**37 CFR § 7.30 Effect of cancellation or expiration of international registration.** *When the International Bureau notifies the Office of the cancellation or expiration of an international registration, in whole or in part, the Office shall cancel, in whole or in part, the corresponding pending or registered extension of protection to the United States. The date of cancellation of an extension of protection or relevant part shall be the date of cancellation or expiration of the*

*corresponding international registration or relevant part.*

A registered extension of protection to the United States of an international registration also is referred to as a “§ 66(a) registration.”

A registrant that wishes to voluntarily surrender its registration for cancellation may file in the Office a written application, signed by the registrant, or an attorney as defined in 37 CFR § 10.1(c) who has an actual or implied written or verbal power of attorney from the owner. [Note 1.] There is no fee for a voluntary surrender for cancellation. [Note 2.] A registrant that wishes to voluntarily cancel its § 66(a) registration may do so by filing such request with either the USPTO or the International Bureau (IB). [Note 3.] However, after the commencement of a cancellation proceeding, if the respondent applies for surrender of its subject registration under Trademark Act § 7(e), 15 U.S.C. § 1057(e), without the written consent of every adverse party to the proceeding, judgment will be entered against the respondent. [Note 4.] The written consent of an adverse party may be signed by the adverse party itself, or by the adverse party's attorney or other authorized representative. [Note 5.]

For information concerning the effect of a judgment of this type, *see* TBMP § 602.01.

In a cancellation proceeding against any registration having multiple classes, if the respondent files a request to amend the registration to delete an entire class sought to be cancelled, the request for amendment is, in effect, a voluntary surrender of the registration with respect to that class, and is governed by 37 CFR § 2.134(a). [Note 6.] For a registration under Trademark Act §§ 1 or 44, deletion of some of the goods or services in a single class constitutes an amendment, not a voluntary surrender, of the registration as to that class. [Note 7.] For information about amendments to registrations involved in Board proceedings, *see* TBMP § 514.

In a cancellation proceeding against a § 66(a) registration, if the respondent requests a deletion of some of the goods or services in a single class, and such deletion will effect only the registered extension of protection to the United States, the deletion is considered an amendment and may be filed with the USPTO. [Note 8.] The USPTO will notify the IB about the change in the registered extension of protection to the United States. [Note 9.] Similarly, if the USPTO is notified by the IB that a limitation of the list of goods and services affects the registered extension of protection to the United States, but not the international registration, and such limitation results in a deletion of only some of the goods and services in a single class, the deletion is considered an amendment to the § 66(a) registration. [Note 10.] However, if the respondent requests a cancellation with the IB as to some of the goods and services in a single class in the international registration without the written consent of every adverse party to the proceeding, the request is, in effect, a voluntary cancellation of the § 66(a) registration with respect to those goods or services and judgment will be entered against the registrant as to the deleted goods or services. [Note 11.] In this latter situation, the respondent is not deleting goods and services that affect only the registered extension of protection to the United States but is, instead, deleting goods and services that affect its international registration and all reliant extensions of protection, including the one to the United States that is the subject matter of the cancellation proceeding. For further information about amendments to applications and registrations, *see* 37 CFR § 2.133; TBMP § 514 and TBMP § 605.03(b).

A partial restriction of an international registration may be due to the “ceasing of effect” of the basic registration. This occurs when the home country registration is limited by the country of origin. The USPTO will restrict any § 66(a) registration when notified by the IB of a partial restriction. The § 66(a) registrant has the option of transforming the deleted goods, services and/or classes into a national application. [Note 12.] Should a respondent involved in a Board cancellation proceeding opt to transform the goods, services and/or classes that are the subject matter of the partial restriction, and that are involved in the Board's cancellation proceeding, the Board proceeding may go forward with respect to the new national registration resulting from the transformation. Alternatively, the Board may dismiss the cancellation without prejudice to the petitioner to bring an opposition against the new national application resulting from the transformation or to petition to cancel the new national registration resulting from the transformation. Should a respondent elect not to transform the goods, services and/or classes that are the subject matter of the partial restriction, and that are involved in the Board proceedings, the partial restriction is treated as a cancellation of the international registration with respect to the deleted goods, services and/or classes. In the latter case, the partial restriction is, in effect, a voluntary cancellation of the § 66(a) registration with respect to those goods, services and/or classes. Where the partial restriction occurs without the written consent of every adverse party, judgment will be entered against the registrant as to the deleted goods, services and/or classes. [Note 13.]

An application for voluntary surrender of a registration that is the subject of a Board inter partes proceeding should be filed with the Board, and should bear at the top of its first page both the registration number and the inter partes proceeding number and title. The Board encourages the use of the ESTTA filing system for filing a voluntary surrender where the registration is subject to a petition to cancel. Use of the TEAS system is not appropriate for filing a voluntary surrender of a registration subject to a petition to cancel. The application for voluntary surrender should include proof of service upon every other party to the proceeding. [Note 14.] *See* TBMP § 113.

If a registrant whose registration is the subject of a petition for cancellation files a surrender or voluntary cancellation of the registration with the written consent of the petitioner, the petition for cancellation will be dismissed without prejudice, and the registration will be cancelled.

If the registrant files a surrender or voluntary cancellation of the registration with the written consent of the petitioner, and the petitioner files a withdrawal of the petition for cancellation, the petition for cancellation will be dismissed without prejudice, and the registration will be cancelled.

If the registrant files a surrender or voluntary cancellation of the registration with prejudice with the written consent of the petitioner, the petition for cancellation will be dismissed without prejudice (the registration will be cancelled with prejudice to registrant's right to reregister the same mark for the same goods or services), unless the parties specify otherwise in writing.

If the registrant files a surrender or voluntary cancellation of the registration with prejudice with the written consent of the petitioner, and the petitioner files a withdrawal of the petition for

cancellation with prejudice with the written consent of the registrant, the petition for cancellation will be dismissed with prejudice, and the registration will be cancelled with prejudice to registrant's right to re-register the same mark for the same goods or services. [Note 15.]

**NOTES:**

1. See TMEP § 1608 (Surrender of Registration For Cancellation).
2. See Trademark Act § 7(e), 15 U.S.C. § 1057(e); 37 CFR § 2.172; TMEP § 1403.07 (for multiple class registrations) and TMEP § 1608 (Surrender of Registration For Cancellation). The requirement for a statement that the original certificate has been lost or destroyed has been eliminated.
3. See TMEP § 1608. Cf. TMEP § 1906.01(e) (a request to cancel the international registration must be filed with the IB).
4. See 37 CFR § 2.134(a). Cf. 37 CFR § 2.135; *Goodway Corp. v. Int'l Mktg. Group Inc.*, 15 USPQ2d 1749, 1750 (TTAB 1990); *Grinnell Corp. v. Grinnell Concrete Pavingstones Inc.*, 14 USPQ2d 2065, 2067 (TTAB 1990)(consent required for abandonment without prejudice regardless of motivation for abandonment, i.e., a concession by applicant that it is not the owner of the mark and that judgment would be unfair to the real owner, a nonparty to the case); *In re First Nat'l Bank of Boston*, 199 USPQ 296, 301 (TTAB 1978) (where abandonment of application and notice of opposition were filed on the same day, consent was not required because there was no application to oppose).
5. See 37 CFR § 2.134(a).
6. See *G&W Labs., Inc. v. GW Pharma Ltd.*, 89 USPQ2d 1571, 1574 (TTAB 2009) (“The request to delete a class of goods or services sought to be cancelled is, in effect, a voluntary cancellation of the registration as to the class under Section 7(e) of the Trademark Act.”).
7. 37 CFR § 2.172. See also TMEP § 1403.07 and TMEP § 1609.03.
8. See TMEP §§ 1609.03 and 1904.13(a). See also TMEP § 1904.02(c) and TMEP § 1904.02(c)(ii), explaining the USPTO requirement that identifications in international registrations that provide the basis for a § 66(a) application, and ensuing registered extension of protection, must meet the same standards of specificity as §§ 1 and 44 applications; and explaining the USPTO's policy where the identification in the international registration is indefinite, respectively.
9. See TMEP § 1904.13(a).
10. See TMEP § 1904.02(e)(ii), TMEP § 1904.02(e)(iii), and TMEP § 1904.15.
11. See 15 USC § 1141j(a); TMEP § 1609.03. Cf. *G&W Labs., Inc. v. GW Pharma Ltd.*, 89 USPQ2d 1571, 1574 (TTAB 2009) (“The request to delete a class of goods or services sought to

be cancelled is, in effect, a voluntary cancellation of the registration as to the class under Section 7(e) of the Trademark Act.”).

12. See TMEP § 1904.09.

13. 37 CFR § 2.134(a).

14. See 37 CFR § 2.119(a).

15. Cf. *Montana v. United States*, 440 U.S. 147 (1979) (changes in controlling facts essential to a judgment will render collateral estoppel inapplicable in a subsequent action raising the same issues); *Mayer/Berkshire Corp. v. Berkshire Fashions, Inc.*, 424 F.3d 1229, 76 USPQ2d 1310 (Fed. Cir. 2005) (“A change in trademark usage can constitute a change in transactional facts that avoids preclusion based on the earlier noninfringement decision.”); *Bingaman v. Dept. of the Treasury*, 127 F.3d 1431 (Fed. Cir. 1997) (“Collateral estoppel is subject to exceptions when the circumstances dictate. . . . Courts have crafted an exception to the collateral estoppel principle when there has been a change in the applicable law between the time of the original decision and the subsequent litigation in which collateral estoppel is invoked.”). See generally 6 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION: *Res Judicata and Changes in the Facts*, § 32:88 (2011).

## **602.02(b) Cancellation Under Section 8 or 71; Expiration Under Section 9 or 70**

**37 CFR § 2.134(b)** *After the commencement of a cancellation proceeding, if it comes to the attention of the Trademark Trial and Appeal Board that the respondent has permitted his involved registration to be cancelled under § 8 of the Act of 1946 or has failed to renew his involved registration under § 9 of the Act of 1946, an order may be issued allowing respondent until a set time, not less than fifteen days, in which to show cause why such cancellation or failure to renew should not be deemed to be the equivalent of a cancellation by request of respondent without the consent of the adverse party and should not result in entry of judgment against respondent as provided by paragraph (a) of this section. In the absence of a showing of good and sufficient cause, judgment may be entered against respondent as provided by paragraph (a) of this section.*

**37 CFR § 7.30** *Effect of Cancellation or expiration of international registration. When the International Bureau notifies the Office of the cancellation or expiration of an international registration, in whole or in part, the Office shall cancel, in whole or in part, the corresponding pending or registered extension of protection to the United States. The date of cancellation of an extension of protection or relevant part shall be the date of cancellation or expiration of the corresponding international registration or relevant part.*

**37 CFR § 7.36** *Affidavit or declaration of use in commerce or excusable nonuse required to avoid cancellation of an extension of protection to the United States.*

*(a) Subject to the provisions of section 71 of the Act, a registered extension of protection shall*

*remain in force for the term of the international registration upon which it is based unless the international registration expires or is cancelled under section 70 of the Act due to cancellation of the international registration by the International Bureau.*

*(b) During the following time periods, the holder of an international registration must file an affidavit or declaration of use or excusable nonuse, or the registered extension of protection will be cancelled under section 71 of the Act:*

*(1) On or after the fifth anniversary and no later than the sixth anniversary after the date of registration in the United States; and*

*(2) Within the six-month period preceding the end of each ten-year period after the date of registration in the United States, or the three-month grace period immediately following, with payment of the grace period surcharge required by section 71(a)(2)(B) of the Act and § 7.6.*

*(3) The affidavit or declaration may be filed within a grace period of six months after the end of the deadline set forth in paragraphs (b)(1) and (b)(2) of this section, with payment of the grace period surcharge per class required by section 71(a)(3) of the Act and § 7.6.*

*(c) For the requirements for the affidavit or declaration, see § 7.37.*

**37 CFR § 7.41 *Renewal of international registration and extension of protection.***

*(a) Any request to renew an international registration and its extension of protection to the United States must be made at the International Bureau in accordance with Article 7 of the Madrid Protocol.*

With respect to registrations issued under Trademark Act §§ 1 or 44, 15 U.S.C. §§ 1051 and 1126 if it comes to the attention of the Board, during the course of a proceeding, that respondent has permitted its involved registration to be cancelled under Trademark Act § 8, 15 U.S.C. § 1058, or has failed to renew its involved registration under Trademark Act § 9, 15 U.S.C. § 1059, the Board may issue an order allowing respondent time to show cause why the cancellation, or the failure to renew, should not be deemed to be the equivalent of a cancellation by request of respondent without the consent of petitioner and should not result in entry of judgment against respondent. [Note 1.]

Similarly, in the case of a § 66(a) registration, if it comes to the attention of the Board during the course of a proceeding that respondent has allowed its extension of protection to the United States to be cancelled under Trademark Act § 71, 15 U.S.C. § 1141k, [Note 2] or has failed to renew its extension of protection under Trademark Act § 70, 15 U.S.C. § 1141j, [Note 3] the Board may issue an order allowing respondent time to show cause why the cancellation should not be deemed to be the equivalent of a cancellation by request of respondent without the consent of petitioner and should not result in entry of judgment against respondent.

In a cancellation proceeding against any registration having multiple classes, if the respondent permits an entire class which is the subject of the cancellation proceeding to be cancelled under

Trademark Act §§ 8 or 71, or fails to renew the registration under Trademark Act §§ 9 or 70 with respect to that class, the cancellation or failure to renew with respect to that class is governed by 37 CFR § 2.134(b).

An order to show cause under 37 CFR § 2.134(b) may be issued by the Board upon motion by the petitioner, or (if the failure to file a § 8 or § 9 affidavit or a § 70 renewal or § 71 affidavit comes to the attention of the Board in another manner) upon the Board's own initiative. [Note 4.]

For information concerning motions for an order to show cause under 37 CFR § 2.134(b), see TBMP § 535.

The purpose of 37 CFR § 2.134(b), and the policy underlying the issuance of a show cause order, is to prevent a cancellation proceeding respondent whose subject registration comes due, during the course of the proceeding, for a § 8 or § 9 affidavit, or in the case of a § 66(a) registration, a § 71 affidavit or § 70 renewal, from being able to moot the proceeding, and avoid judgment, by deliberately failing to file the required affidavits or renewal applications. [Note 5.] The Board's policy governing application of 37 CFR § 2.134(b) is as follows:

“The paragraph has been modified to provide an opportunity for the respondent in such situation to ‘show cause’ why judgment should not be entered against it. If respondent submits a showing that the cancellation or expiration was the result of an inadvertence or mistake, judgment will not be entered against it. If respondent submits a showing that the cancellation or expiration was occasioned by the fact that its registered mark had been abandoned and that such abandonment was not made for purposes of avoiding the proceeding but rather was the result, for example, of a two-year period of nonuse which commenced well before respondent learned of the existence of the proceeding, judgment will be entered against it only and specifically on the ground of abandonment.” [Note 6.]

If, in response to an order to show cause a respondent submits a showing that the cancellation of its registration or registered extension of protection under Trademark Act §§ 8 or 71, respectively, or failure to renew the registration or registered extension of protection under Trademark Act §§ 9 or 70, respectively, was the result of inadvertence or mistake, judgment will not be entered against it by reason of the cancellation. [Note 7.]

If respondent submits a showing that it permitted its registration or registered extension of protection to be cancelled under Trademark Act §§ 8 or 71, respectively, or failed to renew the registration or registered extension of protection under Trademark Act §§ 9 or 70, respectively, because its registered mark had been abandoned, and that the abandonment was not made for purposes of avoiding the proceeding, judgment will be entered against it only and specifically on the ground of abandonment (if abandonment has not been pleaded as a ground for cancellation, plaintiff will be allowed to amend its pleading appropriately). [Note 8.]

In those cases where the Board finds that respondent has shown good and sufficient cause why judgment should not be entered against it, petitioner may be given time to decide whether it



wishes to go forward with the cancellation proceeding, or to have the cancellation proceeding dismissed without prejudice as moot. [Note 9.] In those cases where the Board enters judgment against the respondent only and specifically on the ground of abandonment, petitioner may be given time to decide if it wishes to go forward to obtain a determination of the remaining issues, or to have the cancellation proceeding dismissed without prejudice as to those issues. [Note 10.]

As noted above, the purpose of 37 CFR § 2.134(b) is to prevent a cancellation proceeding respondent from being able to moot the proceeding, and avoid judgment, by deliberately failing to file a required affidavit of use under Trademark Act §§ 8 or 71, or renewal application under Trademark Act §§ 9 or 70. The rule provides not that an order to show cause “shall” be issued, but rather that an order “may” be issued. Normally, the Board, in the exercise of its discretion under the rule, does not issue a show cause order in those cases where the failure to file a required affidavit under §§ 8 or 71, or renewal application under §§ 9 or 70, occurs after the filing of a petition for cancellation, but before respondent has been notified by the Board. [Note 11.] Rather, the Board issues an action notifying respondent of the filing of the proceeding, advising both parties that the registration has been cancelled under §§ 8 or 71, or has expired under § 9, or has not been renewed under § 70, and allowing petitioner time to elect whether it wishes to go forward with the cancellation proceeding, or to have the cancellation proceeding dismissed without prejudice as moot. *Cf.* TBMP § 602.01 (withdrawal by applicant). However, on the rare occasion that a petitioner believes that the respondent had knowledge of the filing of the petition to cancel (notwithstanding the fact that respondent had not received its service copy of the petitioner to cancel and had not been notified by the Board of the commencement of the proceeding), and that respondent deliberately failed to file a required affidavit of use under §§ 8 or 71, or renewal application under §§ 9 or 70, in an effort to moot the proceeding, and avoid judgment, the petitioner may file a motion for an order to show cause under 37 CFR § 2.134(b) stating the reasons for its belief. *See* TBMP § 535.

Where, during the course of a proceeding, respondent's registration or registered extension of protection expires or is cancelled, respondent demonstrates that the cancellation or expiration was not occasioned by respondent's intent to moot the proceeding, and petitioner elects to go forward with the proceeding, “[t]he expiration of the registration does not extinguish either actual notice or constructive notice [of the registration] during the term of the registration.” [Note 12.]

#### NOTES:

1. *See Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154 (TTAB 1989); *C.H. Guenther & Son Inc. v. Whitewing Ranch Co.*, 8 USPQ2d 1450 (TTAB 1988); *Abraham's Seed v. John One Ten*, 1 USPQ2d 1230 (TTAB 1986). *Cf. In re Checkers of North America Inc.*, 23 USPQ2d 1451 (Comm'r 1992), *aff'd sub nom., Checkers Drive-In Rests., Inc. v. Comm'r of Patents and Trademarks*, 51 F.3d 1078, 34 USPQ2d 1574 (D.C. Cir. 1995); *Global Maschinen GmbH v. Global Banking Sys., Inc.*, 227 USPQ 862 (TTAB 1985).

2. A § 66(a) registration is subject to the § 71 requirements for affidavits of continued use (or excusable nonuse). A § 71 affidavit is filed with the USPTO, not the IB. *See Trademark Act § 71*, 15 U.S.C. §1114k; TMEP § 1613 and TMEP § 1904.10.

3. A renewal under Trademark Act § 70, 15 U.S.C. § 1141j refers to a renewal of the international registration underlying a § 66(a) registration. A § 66(a) registration will be cancelled under § 70 for failure to renew the international registration on which it is based. Renewals of international registrations are filed directly with the International Bureau (IB), not the USPTO. If the IB does not renew the underlying international registration, the IB will notify the USPTO that the international registration has expired. The corresponding extension of protection to the U.S. will expire as of the expiration date of the international registration and the § 66(a) registration will be cancelled by the Office. See Trademark Act § 70, 15 U.S.C. § 1141j; TMEP § 1614 and TMEP § 1905.

4. See *C.H. Guenther & Son Inc. v. Whitewing Ranch Co.*, 8 USPQ2d 1452 (TTAB 1988) (motion for order to show cause); *Abraham's Seed v. John One Ten*, 1 USPQ2d 1232 (TTAB 1986) (show cause order issued where respondent's failure to file § 8 affidavit came to Board's attention following receipt of petitioner's final brief but before final decision).

5. See *In re Checkers of North America Inc.*, 23 USPQ2d 1451, 1454 (Comm'r 1992), *aff'd sub nom. Checkers Drive-In Restaurants, Inc. v. Comm'r of Patents and Trademarks*, 51 F.3d 1078, 34 USPQ2d 1574 (D.C. Cir. 1995) (petitioner should not be deprived of a judgment in its favor by a respondent who lets its registration lapse during a cancellation proceeding); *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154, 1156 (TTAB 1989) (although judgment entered on ground of abandonment in view of concession that failure to file § 8 affidavit was due to discontinued use of mark, judgment was not entered on ground of likelihood of confusion where respondent showed that failure to file § 8 affidavit with respect to that ground was result of deliberate business decision made prior to commencement of proceeding and not for purposes of avoiding proceeding).

6. See *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154, 1156 (TTAB 1989) (where registrant stated that failure to file § 8 affidavit, with respect to ground of likelihood of confusion, was result of deliberate business decision made prior to commencement of proceeding and not to avoid judgment, judgment was not entered as to that ground); *C.H. Guenther & Son Inc. v. Whitewing Ranch Co.*, 8 USPQ2d 1450 (TTAB 1988) (failure to renew was unintentional and not due to abandonment); *Abraham's Seed v. John One Ten*, 1 USPQ2d 1232 (respondent's belief that it was improper to file a § 8 affidavit since “the cancellation action had priority,” while erroneous, was treated as sufficient showing of cause to avoid entry of judgment).

7. See *C.H. Guenther & Son Inc. v. Whitewing Ranch Co.*, 8 USPQ2d 1450 (TTAB 1988) (failure to renew was unintentional and not due to abandonment); *Abraham's Seed v. John One Ten*, 1 USPQ2d 1232 (respondent's belief that it was improper to file a § 8 affidavit since “the cancellation action had priority,” while erroneous, was treated as sufficient showing of cause to avoid entry of judgment).

8. See *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154, 1156 (TTAB 1989) (where registrant stated that failure to file § 8 affidavit, with respect to ground of likelihood of confusion, was result of deliberate business decision made prior to commencement of proceeding

and not to avoid judgment, judgment was not entered as to that ground and petitioner was allowed time to advise whether it wished to go forward on that ground).

9. *See Abraham's Seed v. John One Ten*, 1 USPQ2d 1230 (TTAB 1986) (opted for decision on merits). *Cf. C.H. Guenther & Son Inc. v. Whitewing Ranch Co.*, 8 USPQ2d 1450 (TTAB 1988) (where petitioner moved for show cause order and respondent filed response showing good cause along with uncontested motion to dismiss petition as moot, petition was dismissed as moot).

10. *See Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154 (TTAB 1989). *Cf. United Rum Merchants Ltd. v. Distillers Corp. (S.A.)*, 9 USPQ2d 1481, 1484 n.3 (TTAB 1988); *Bank of Am. Nat'l Trust & Savings Ass'n v. First Nat'l Bank of Allentown*, 220 USPQ 892, 894 n.6 (TTAB 1984) (where application was held void ab initio, opposer elected to adjudicate pleaded issues); and *Daggett & Ramsdell, Inc. v. Procter & Gamble Co.*, 119 USPQ 350, 350 (TTAB 1958), *rev'd on other grounds*, 275 F.2d 955, 125 USPQ 236 (CCPA 1960).

11. *See Global Maschinen GmbH v. Global Banking Sys. Inc.*, 227 USPQ 862, 863 n.1 (TTAB1985).

12. *Fishking Processors, Inc. v. Fisher King Seafoods Ltd.*, 83 USPQ2d 1762, 1765 (TTAB 2007) (where, after expiration of the registration during the course of the proceeding, petitioner elected to go forward on its claims, respondent was not precluded from asserting a laches defense).

## **603 Withdrawal by Interference or Concurrent Use Applicant**

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

*(a) Written document required. An applicant may expressly abandon an application by filing a written request for abandonment or withdrawal of the application, signed by the applicant, someone with legal authority to bind the applicant (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(2).*

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

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

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

After the commencement of an interference or concurrent use proceeding, if an applicant whose application is a subject of the proceeding files a written abandonment of its application or mark

without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant. [Note 1.] Any concurrent use proceeding will be dissolved, and registration to applicant will be refused.

If, after the commencement of a concurrent use proceeding involving two or more applicants, one of the applicants files an unconsented abandonment of its application, but not of its common law use of its mark, judgment will be entered against that applicant with respect to the registration sought by it. However, if the abandoning applicant is specified as an excepted concurrent user in any other application involved in the proceeding, the abandoning applicant will remain a party to the proceeding as a concurrent user, and every other applicant to the proceeding who, in its own application, has listed that party as an excepted user will retain the burden of proving its entitlement to registration in view of the acknowledged rights of the abandoning applicant. [Note 2.] On the other hand, if a party to a concurrent use proceeding abandons all rights in its mark and in its application (if any), any remaining party that seeks concurrent registration may move to amend its application to delete the abandoning party as an excepted user. If the abandoning party is the only excepted user specified in a remaining party's application, the remaining party may move to amend its application to seek a geographically unrestricted registration. [Note 3.] *See* TBMP § 1106.05. If the motion is granted, the concurrent use proceeding will be dissolved without prejudice, and the application will be republished, for purposes of opposition, as an application for a geographically unrestricted registration

If an application which is the subject of an interference or concurrent use proceeding has multiple classes, and the applicant files a request to amend the application to delete a class, the request for amendment is, in effect, an abandonment of the application with respect to that class, and is governed by 37 CFR § 2.135.

A request for abandonment of an application that is the subject of an interference or concurrent use proceeding should be filed with the Board. The Board encourages the use of the ESTTA filing system for filing an abandonment of an application involved in an interference or in a concurrent use proceeding. Use of the TEAS system for filing an abandonment of such an application is not appropriate. The top of its first page should list both the application serial number, and the interference or concurrent use proceeding number and title. The abandonment should include proof of service thereof upon every other party to the proceeding. [Note 4.] *See* TBMP § 113.

If, during the pendency of an interference or concurrent use proceeding involving an application under Trademark Act § 1 or § 44, the Board grants a request by the Trademark Examining Attorney for remand under 37 CFR § 2.130 and the application thereafter becomes abandoned by operation of law, for failure of the applicant to respond to an Office action, or because a final refusal to register is affirmed on appeal, judgment under 37 CFR § 2.135 will not be entered against applicant in the interference, or in the concurrent use proceeding. *See* TBMP § 515 (motion to remand application to examining attorney). 37 CFR § 2.135 comes into play only when there is a written abandonment by the applicant. If, after remand under 37 CFR § 2.130, applicant files a written abandonment of its application without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant pursuant to 37

CFR § 2.135. An application under Trademark Act § 66(a) may not be remanded under 37 CFR § 2.130. [Note 5.]

Applications based solely on Trademark Act §§ 44 or 66(a) are not subject to concurrent use registration proceedings. [Note 6.] Applications under § 66(a) are not permitted to have more than one basis. [Note 7.] As a consequence, § 66(a) applications cannot be subject to concurrent use proceedings.

#### **NOTES:**

1. 37 CFR § 2.135.

2. *See Fleming Cos. Inc. v. Thriftway Inc.*, 21 USPQ2d 1451, 1456 (TTAB 1991), *aff'd*, 809 F. Supp. 38, 26 USPQ2d 1551 (S.D. Ohio 1992) (although judgment was entered against excepted user in view of abandonment of its application without consent and therefore user was not entitled to a registration, because said party was listed as exception to plaintiff's right to use, plaintiff was required to show entitlement to concurrent registration); *Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305 (TTAB 1984) (once concurrent user is acknowledged, even if application owned by user is expressly abandoned, plaintiff is not entitled to unrestricted registration and still must show entitlement to concurrent use registration). *Cf.* 37 CFR § 2.99(d)(3); *Precision Tune Inc. v. Precision Auto-Tune Inc.*, 4 USPQ2d 1095 (TTAB 1987) (settlement agreement sufficient to show entitlement as to non-defaulting user but still must show entitlement as to defaulting users and may do so through an ex parte type of showing).

3. *See Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305 (TTAB 1984).

4. *See* 37 CFR § 2.119(a).

5. *See* 37 CFR § 2.130 and 37 CFR § 7.25 (“Sections of part 2 applicable to extension of protection”).

6. *See* 37 CFR § 2.99(g); TMEP § 1207.04(b).

7. *See* 37 CFR § 2.34(b)(3); TMEP § 1904.01(a).

### **604 Consent to Judgment**

If a party to an inter partes proceeding before the Board does not wish to litigate the case, and is willing to accept entry of judgment against itself, the party may file a statement with the Board indicating that it consents to entry of judgment against itself. Upon receipt of such a statement, the Board will enter judgment against the filing party.

## **605 Settlement**

### **605.01 In General**

A substantial percentage of the inter partes cases filed with the Board are eventually settled. The Board encourages settlement, and several aspects of Board practice and procedure, including its discovery practice (*see* [TBMP Chapter 400](#)) and its usual willingness to suspend proceedings for reasonable times while parties negotiate for settlement serve to facilitate the resolution of cases by agreement. *See* [TBMP § 510.03](#) and [TBMP § 605.02](#).

### **605.02 Suspension for Settlement Negotiations**

Parties that are negotiating for settlement, and wish to defer further litigation of the case pending conclusion of their negotiations, should remember to file stipulations to extend or suspend the running of the time periods set in the case. The parties are encouraged to use the ESTTA system to file their consented motions (using the “consent motions” option), which in most cases provides an immediate grant of the consented scheduling motion.

When the Board is notified that parties are negotiating for settlement, the Board may suspend proceedings for a period of up to six months, either upon request or sua sponte, subject to the right of either party to request resumption at any time prior to the expiration of the suspension period. *See* [TBMP § 510.03](#). The suspension period may be further extended upon request, or upon notification to the Board that the parties are still engaged in their settlement negotiations. However, once proceedings have been suspended for over a year, the Board may require that the parties submit a report as to the status of their negotiations in order to show good cause for continued suspension. This report should include a summary of the progress of the parties' negotiations, without disclosure of any confidential information or matter, and an anticipated timetable for resolution. Absent such a report, any subsequent motion to extend or suspend for settlement negotiations may be denied, even though agreed to by the parties. [Note 1.] Even if the parties state that they are engaged in settlement negotiations and wish to postpone discovery and trial, protracted suspension without substantial progress toward resolution of the matter may be taken to indicate that further suspension would not be useful. Consequently, further suspension requests may be denied even though the parties have provided a report on the status of their negotiations. For a discussion of motions to suspend, *see* [TBMP § 510](#).

For inter partes proceedings commenced on or after November 1, 2007, the Board generally will not find good cause to suspend proceedings or extend the schedule after an answer is filed but before the scheduled discovery conference has taken place, even upon stipulation or consent. [Note 2.] *See* [TBMP § 401.01](#) (Discovery Conferences); [TBMP § 509.01\(a\)](#) (Motions to Extend Time) and [TBMP § 510.03\(a\)](#) (Suspension). This is because the discovery conference provides the parties with the opportunity to discuss settlement. [Note 3.]

#### **NOTES:**

1. *Cf. Central Mfg. Inc. v. Third Millennium Tech. Inc.*, 61 USPQ2d 1210, 1211 (TTAB 2001) (where opposer's statements that the parties were engaged in settlement negotiations were found

to be false and filed in bad faith, opposer was sanctioned with dismissal).

2. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

3. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

## **605.03 Settlement Agreements**

### **605.03(a) In General**

When an inter partes proceeding before the Board is settled, the parties should promptly notify the Board of the settlement. It is not necessary that the parties file a copy of their settlement agreement with the Board. Rather, they may simply file a stipulation stating the desired disposition of the proceeding (i.e., “It is hereby stipulated that the opposition be sustained,” “It is hereby stipulated that the petition for cancellation be dismissed with prejudice,” or the like). If there is a counterclaim, the stipulation should also state the desired disposition of the counterclaim. If, in a proceeding with a counterclaim, the parties stipulate to the disposition of the claim against which the counterclaim was brought, but there is no stipulation to dispose of the counterclaim, and there is no withdrawal of the counterclaim, consent by one party to entry of judgment against itself on the counterclaim, etc., the counterclaim will go forward, notwithstanding the fact that judgment has been entered on the original claim. *See* TBMP § 606.

If the proceeding is to be dismissed, the stipulation should specify whether the dismissal is to be with prejudice or without prejudice. If no specification is made, the Board, in its action dismissing the proceeding, will simply state that the proceeding is being dismissed “in accordance with the agreement of the parties.” However, if the agreement itself also fails to indicate whether the dismissal is to be with or without prejudice, at some later time a dispute may arise between the parties as to whether they intended the dismissal to be with or without prejudice. A clear specification in the stipulation may avoid future trouble.

A settlement agreement may simply call for a party to withdraw with, or without, prejudice, or with, or without, consent. In such a case, the parties need not file a settlement stipulation, because the withdrawal, when filed, will result in a final disposition of the proceeding in accordance with the applicable rules. [Note 1.]

A settlement stipulation, which is not in accordance with the applicable rules and the statute, will be given no effect by the Board.

### **NOTES:**

1. 37 CFR § 2.134 and 37 CFR § 2.135.

## **605.03(b) With Amendment of Subject Application or Registration**

If a settlement agreement is contingent upon amendment of a defendant's subject application or registration, the request for amendment is governed by 37 CFR § 2.133(a) and should be filed with the Board. *See* TBMP § 514 (Motion to Amend Application or Registration). The request should list at the top of the page both the number of the subject application or registration, and the Board proceeding number and title. The request also should include proof of service thereof upon every other party to the proceeding. [Note 1.] *See* TBMP § 113.

A proposed amendment to a defendant's application or registration must comply with all applicable rules and statutory provisions. *See* TBMP § 514.01. Thus, for example, a proposed amendment to a § 1 or § 44 application or registration that materially alters the character of the defendant's subject mark, [Note 2] or a proposed amendment to a § 66(a) application or registration that involves an amendment to the mark at all, [Note 3] cannot be approved by the Board. [Note 4.] If a settlement agreement calls for an amendment that may amount to a material change in the defendant's mark, the parties may wish to also agree that if a request for amendment of the defendant's subject application or registration is denied by the Board, the defendant will abandon that application, or voluntarily surrender that registration, and file a new application for registration of the altered mark; and that the plaintiff will not oppose the new application or seek to cancel any registration that matures therefrom. *See* TBMP § 602 (Withdrawal by Opposition or Cancellation Defendant) for a discussion of abandonment of an application and surrender or voluntary cancellation of a registration.

In an opposition to any application having multiple classes, if the applicant files a request to amend the application to delete an opposed class in its entirety, the request for amendment is, in effect, an abandonment of the application with respect to that class, and is governed by 37 CFR § 2.135. Similarly, in a cancellation proceeding against any registration having multiple classes, if the respondent files a request to amend the registration to delete an entire class sought to be cancelled, the request for amendment is, in effect, a voluntary surrender of the registration with respect to that class, and is governed by 37 CFR § 2.134(a). *See* TBMP §§ 602.01 (Withdrawal by Applicant) and TBMP § 602.02 (Withdrawal by Respondent).

In addition, with respect to a cancellation proceeding against a § 66(a) registration, if the respondent requests cancellation with the International Bureau (IB) as to some of the goods and services in a single class in the international registration, without the written consent of every adverse party to the proceeding, the request is, in effect, a voluntary cancellation of the § 66(a) registration with respect to those goods or services and judgment will be entered against the registrant as to the deleted goods or services. [Note 5.] *See* TBMP § 602.02 (Withdrawal by Respondent). However, if the respondent requests a deletion of some of the goods or services in a single class, and such deletion will effect only the registered extension of protection to the United States, the deletion is considered an amendment, and may be filed with the USPTO, subject to 37 CFR § 2.133 (amendment of application or registration during proceedings). Similarly, if the USPTO is notified by the IB that a limitation of the list of goods and services affects the registered extension of protection to the United States, but not the international registration, and such limitation results in a deletion of some of the goods and services in a single class, the deletion is considered an amendment to the § 66(a) registration. [Note 6.] Such a



limitation is also subject to 37 CFR § 2.133.

#### **NOTES:**

1. See 37 CFR § 2.119(a).
2. See Trademark Act § 7(e), 15 U.S.C. § 1057(e); 37 CFR §§ 2.72 and 2.173.
3. The mark in a § 66(a) registration cannot be amended under Trademark Act § 7, 15 U.S.C. § 1057. See 37 CFR § 2.72, providing only for amendments to the mark in § 1 and § 44 applications; and the *International Bureau's Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol*, Para. B.II.69.02 (2002) at www.wip.int/madrid/en/guide. See also TMEP § 1609.02(a) and TMEP § 1904.02(j); *Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act*, 68 Fed. Reg. 55748, 55756 (September 26, 2003).
4. See Trademark Act § 7(e), 15 U.S.C. § 1057; 37 CFR § 2.71(b), 37 CFR § 2.72, 37 CFR § 2.173(a), and 37 CFR § 2.73(b); *Vaughn Russell Candy Co. and Toymax Inc. v. Cookies In Bloom, Inc.*, 47 USPQ2d 1635 (TTAB 1998) (material alteration); *Aries Sys. Corp. v. World Book Inc.*, 23 USPQ2d 1742 (TTAB 1992), summ. judgment granted in part, 26 USPQ2d 1926 (TTAB 1993) (expansion of scope of goods); *Mason Eng'g and Design Corp. v. Mateson Chem. Corp.*, 225 USPQ 956 (TTAB 1985) (amendment to dates of use not supported by affidavit or declaration).
5. Cf. Trademark Act § 70, 15 USC § 1141j. Cf. 37 CFR § 2.172 (for registrations under §§ 1 and 44, a deletion of fewer than all the goods or services in a single class constitutes an amendment of the registration as to that class, not a surrender.).
6. See TMEP § 1904.15.

#### **605.03(c) With Amendment of Plaintiff's Pending Application**

The plaintiff in an inter partes proceeding before the Board may own a pending application for registration that has been rejected by the trademark examining attorney in view of the defendant's subject registration, or which may be rejected by the examining attorney when and if defendant's subject application matures to registration. In such a case, a settlement agreement may be contingent upon the approval of an amendment to be filed in the plaintiff's application, or acceptance of a consent agreement to be filed therein, and the consequent approval of the application for publication.

The Board has no jurisdiction over a plaintiff's application which is still pending before the trademark examining attorney. [Note 1.] Thus, when the plaintiff in an inter partes proceeding before the Board owns an application which is still pending before the trademark examining attorney, and an amendment or consent agreement is filed in the application pursuant to a settlement agreement between the parties, the amendment should be filed with the examining attorney, not with the Board. The examining attorney should consider the amendment or

agreement and take appropriate action (including, if the amendment or consent agreement puts the application in condition for publication, approving the application for publication), notwithstanding the fact that action on the application may previously have been suspended pending the final determination of the inter partes proceeding before the Board. Indeed, if settlement of the inter partes proceeding is contingent upon approval of the amendment, or acceptance of the consent agreement, by the examining attorney, proceedings before the Board may be suspended pending action by the examining attorney on the amendment or consent agreement.

#### **NOTES:**

1. *See Home Juice Co. v. Runclin Cos.*, 231 USPQ 897, 898 n.7 (TTAB 1986) (cannot instruct examining attorney to pass application to registration).

### **605.03(d) Breach of Settlement Agreement**

If an agreement settling an inter partes proceeding before the Board is breached by one of the parties, an adverse party's remedy is by way of civil action. The Board has no jurisdiction to enforce such an agreement. However, while the Board does not have jurisdiction to enforce the contract, agreements to cease use of a mark or not to use a mark in a certain format are routinely upheld and enforced to the extent a party may not obtain a registration for exclusive use that may be precluded by the terms of a settlement agreement. [Note 1.]

#### **NOTES:**

1. *See Bausch & Lomb, Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1528 (TTAB 2008) (registration refused where agreement recited the parties' rights to the marks containing a common term and applicant's use was not expressly authorized); *Vaughn Russell Candy Co. and Toymax Inc. v. Cookies in Bloom Inc.*, 47 USPQ2d 1635, 1638 n.6 (TTAB 1998) (registration refused where settlement agreement precluded use of a portion of applicant's mark); and *In re Sun Refining and Marketing Co.*, 23 USPQ2d 1072, 1074 (TTAB 1991) (refusal affirmed since settlement agreement containing geographic restrictions clearly showed that applicant was not entitled to unrestricted registration).

### **605.03(e) Effect of Judgment Based Upon Agreement**

For information concerning the effect of agreements and judgments resulting therefrom, see cases cited in the note below. [Note 1.]

#### **NOTES:**

1. *Kimberly-Clark Corp. v. Fort Howard Paper Co.*, 772 F.2d 860, 227 USPQ 36, 39 (Fed. Cir. 1985) (construction of 1924 agreement found that goods in current application not encompassed within agreement, registration permitted); *Chromalloy American Corp. v. Kenneth Gordon (New Orleans), Ltd.*, 736 F.2d 694, 222 USPQ 187, 191 n.4 (Fed. Cir. 1984) (unless principles of res judicata apply, consent given in a decree should be treated as any other contractual consent and

as a factor to be taken into consideration in determining likelihood of confusion); *Wells Cargo, Inc. v. Wells Cargo, Inc.*, 606 F.2d 961, 203 USPQ 564, 567 (CCPA 1979) (although agreement can be implied from applicant's withdrawal of application with consent and with prejudice in prior opposition, that agreement was not itself a settlement of the substantive rights of the parties and estoppel does not rest on that agreement but instead on the act of withdrawing the application with prejudice); *Danskin, Inc. v. Dan River, Inc.*, 498 F.2d 1386, 182 USPQ 370, 372 (CCPA 1974) (equitable estoppel barring opposition rested on terms of the agreement between parties in settlement of prior proceeding ); and *United States Olympic Comm. v. Bata Shoe Co.*, 225 USPQ 340, 342 (TTAB 1984) (abandonment of application without consent in prior opposition does not operate as res judicata when different marks were involved in subsequent proceeding). *See also Epic Metals Corp. v. H.H. Robertson Co.*, 870 F.2d 1574, 10 USPQ2d 1296, 1299 (Fed. Cir. 1989) (district court erred in construction of consent judgment); *Hartley v. Mentor Corp.*, 869 F.2d 1469, 10 USPQ2d 1138, 1142 (Fed. Cir. 1989) (intent of the parties is generally controlling with respect to preclusive effect of stipulated judgment).

### **605.03(f) Consent Orders**

The Board will dismiss, sustain, etc., a Board inter partes proceeding, if the parties so stipulate and will also enter judgment against a party which submits its written consent to entry of judgment against itself, or which concedes that its case is not well taken. *See* TBMP § 605.03(a). Further, the Board encourages the use of stipulated evidence in Board inter partes proceedings. [Note 1.] *See* TBMP § 705. However, the Board does not issue advisory opinions. Nor does the Board issue consent orders.

#### **NOTES:**

1. *See* 37 CFR § 2.123(b).

### **606 Effect on Counterclaim**

If, prior to the determination of a counterclaim, the parties stipulate to the disposition of the claim against which the counterclaim was brought, or the original claim is withdrawn, dismissed for failure to prosecute, or otherwise disposed of, the counterclaim will nevertheless go forward, unless the parties stipulate to its disposition, or it is withdrawn by the counterclaimant, or one party consents to entry of judgment against itself on the counterclaim, etc. [Note 1.] *Cf.* TBMP § 901.02(a).

#### **NOTES:**

1. *See, e.g., Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc.*, 14 USPQ2d 1879, 1880 (TTAB 1990) (opposition dismissed with prejudice; applicant elected to go forward with counterclaim to cancel opposer's registration and had standing to do so).