

Chapter 1700

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1701 Statutory Authority of Director

The United States Patent and Trademark Office (“USPTO”) is led by the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (“Director”). The Commissioner for Trademarks oversees the staff and operations of the USPTO with regard

to trademark matters. 35 U.S.C. §3(b)(2). See TMEP §1709 regarding delegation of duties by the Director.

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

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

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

* * *

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

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

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

See TMEP §1709 regarding delegation of the Director’s authority.

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

37 C.F.R. §2.146 Petitions to the Director.

(a) Petition may be taken to the Director: (1) From any repeated or final formal requirement of the examiner in the ex parte prosecution of an application if permitted by §2.63(b); (2) in any case for which the Act of 1946, or Title 35 of the United States Code, or this Part of Title 37 of the Code of Federal Regulations specifies that the matter is to be determined directly or reviewed by the Director; (3) to invoke the supervisory authority of the

Director in appropriate circumstances; (4) in any case not specifically defined and provided for by this Part of Title 37 of the Code of Federal Regulations; (5) in an extraordinary situation, when justice requires and no other party is injured thereby, to request a suspension or waiver of any requirement of the rules not being a requirement of the Act of 1946.

(b) Questions of substance arising during the ex parte prosecution of applications, including, but not limited to, questions arising under §§2, 3, 4, 5, 6 and 23 of the Act of 1946, are not considered to be appropriate subject matter for petitions to the Director.

(c) Every petition to the Director shall include a statement of the facts relevant to the petition, the points to be reviewed, the action or relief requested, and the fee required by §2.6. Any brief in support of the petition shall be embodied in or accompany the petition. The petition must be signed by the petitioner, someone with legal authority to bind the petitioner (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under §11.14 of this chapter, in accordance with the requirements of §2.193(e)(5). When facts are to be proved on petition, the petitioner must submit proof in the form of affidavits or declarations in accordance with §2.20, signed by someone with firsthand knowledge of the facts to be proved, and any exhibits.

(d) A petition must be filed within two months of the date of issuance of the action from which relief is requested, unless a different deadline is specified elsewhere in this chapter.

(e)(1) A petition from the grant or denial of a request for an extension of time to file a notice of opposition must be filed within fifteen days from the date of issuance of the grant or denial of the request. A petition from the grant of a request must be served on the attorney or other authorized representative of the potential opposer, if any, or on the potential opposer. A petition from the denial of a request must be served on the attorney or other authorized representative of the applicant, if any, or on the applicant. Proof of service of the petition must be made as provided by §2.119. The potential opposer or the applicant, as the case may be, may file a response within fifteen days from the date of service of the petition and must serve a copy of the response on the petitioner, with proof of service as provided by §2.119. No further document relating to the petition may be filed.

(2) A petition from an interlocutory order of the Trademark Trial and Appeal Board must be filed within thirty days after the date of issuance of the order from which relief is requested. Any brief in response to the petition must be filed, with any supporting exhibits, within fifteen days from the date of service of the petition. Petitions and responses to petitions, and any documents accompanying a petition or response under this subsection must be served on every adverse party pursuant to §2.119.

(f) An oral hearing will not be held on a petition except when considered necessary by the Director.

(g) The mere filing of a petition to the Director will not act as a stay in any appeal or inter partes proceeding that is pending before the Trademark Trial

and Appeal Board nor stay the period for replying to an Office action in an application except when a stay is specifically requested and is granted or when §§2.63(b) and 2.65 are applicable to an ex parte application.

(h) Authority to act on petitions, or on any petition, may be delegated by the Director.

(i) Where a petitioner seeks to reactivate an application or registration that was abandoned, cancelled or expired because documents were lost or mishandled, the Director may deny the petition if the petitioner was not diligent in checking the status of the application or registration. To be considered diligent, a petitioner must:

(1) During the pendency of an application, check the status of the application every six months between the filing date of the application and issuance of a registration;

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

(3) If the status check reveals that the Office has not received a document filed by the petitioner, or that the Office has issued an action or notice that the petitioner has not received, the petitioner must promptly request corrective action.

(j) If the Director denies a petition, the petitioner may request reconsideration, if the petitioner:

(1) Files the request within two months of the date of issuance of the decision denying the petition; and

(2) Pays a second petition fee under §2.6.

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

Under 37 C.F.R. §2.146(a)(1), an applicant may file a petition to review an examining attorney's formal requirement if permitted by 37 C.F.R. §2.63(b). Under 37 C.F.R. §2.63(b)(1), a petition from a requirement that is repeated but not made final is permitted if the subject matter of the requirement is appropriate for petition. Under 37 C.F.R. §2.63(b)(2), a petition from a final requirement is permitted only if the final action *is limited to* subject matter appropriate for petition. See TMEP §1704 regarding petitionable subject matter. If a petition under 37 C.F.R. §2.146(a)(1) is denied, the applicant has six months from the issuance date of the Office action that repeated the requirement or made it final, or thirty days from the date of the decision on the

petition, whichever is later, to comply with the requirement. 37 C.F.R. §2.63(a).

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

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

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

See TMEP §1703 for a list of issues that often arise on petition, and TMEP §§1705 *et seq.* regarding petition procedure.

1703 Specific Types of Petitions

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

Petitions to Restore an Application Filing Date. See TMEP §1711.

Petitions to Make Special. See TMEP §1710.

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

Petitions to Revive an Application Abandoned Due to Unintentional Delay in Responding to an Office Action or Notice of Allowance are considered under 37 C.F.R. §2.66. See TMEP §§1714 *et seq.*

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

Petitions to Review the Action of an Examining Attorney. A petition to review an examining attorney's formal requirement may be filed under 37 C.F.R. §§2.63(b) and 2.146(a)(1), if the requirement is repeated or made final and the subject matter is

appropriate for petition. See TMEP §1704 regarding petitionable subject matter, and TMEP §1706 regarding the standard of review.

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

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

Petitions to Reverse a Nonfinal Decision of the Trademark Trial and Appeal Board (37 C.F.R. §2.146(e)(2)) are reviewed under the standard of clear error or abuse of discretion, if the subject matter is appropriate for consideration on petition. *Riko Enterprises, Inc. v. Lindsley*, 198 USPQ 480 (Comm'r Pats. 1977). See [Trademark Trial and Appeal Board Manual of Procedure](#) ("TBMP") §§901.02(a) and 905.

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

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

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

1704 Petitionable Subject Matter

Ex Parte Examination

Under 37 C.F.R. §2.63(b), an applicant may petition the Director to review an examining attorney's repeated or final requirement if the subject matter of the requirement is appropriate for petition. However, under 37 C.F.R. §2.146(b), "[q]uestions of substance arising during the ex parte prosecution of applications, including, but not limited to, questions arising under §§2, 3, 4, 5, 6 and 23 of the Act of 1946, are not considered to be appropriate subject matter for petitions...."

Procedural issues reviewable on petition include: whether a disclaimer was properly printed in standardized format; whether an examining attorney acted

properly in suspending an application; whether an examining attorney acted properly in holding an application abandoned for failure to file a complete response to an Office action (see TMEP §1713); and whether it was premature for an examining attorney to issue a final action.

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

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

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

If an applicant files a petition from an examining attorney's formal requirement, the applicant may not subsequently appeal the requirement to the Board. 15 U.S.C. §1070; 37 C.F.R. §2.63(b).

See TBMP §1201.05 for further information about appealable versus petitionable subject matter in examination.

Post Registration

Trademark Rule 2.146(b) applies only to questions of substance that arise during ex parte examination of applications for registration. The Director considers questions of substance, such as whether a proposed amendment materially alters a registered mark or whether a specimen supports use of a

registered mark, when reviewing the action of the Post Registration staff in connection with a proposed amendment filed under 15 U.S.C. §1057 (“§7 amendment”), or an affidavit of use under 15 U.S.C. §1058 or §1141k (“§8 affidavit” or “§71 affidavit”). The decisions of Post Registration staff under 15 U.S.C. §§1057, 1058, 1059, and 1141k may not be appealed to the Board.

Inter Partes Proceedings Before Trademark Trial and Appeal Board

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

1705 Petition Procedure

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

1705.01 Standing

A person must have standing to file a petition. See *Ex parte Lasek*, 115 USPQ 145 (Comm’r Pats. 1957).

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

1705.02 Petition Fee

A petition must be accompanied by the fee required by 37 C.F.R. §2.6.

Any petition that is not accompanied by the required fee is incomplete. A staff attorney or paralegal in the Office of the Deputy Commissioner for Trademark Examination Policy will notify the petitioner in writing that the petition is incomplete and grant the petitioner 30 days to submit the fee. If the fee is not submitted within the time allowed, the petition is denied without consideration on the merits, because the petitioner has not met the requirements for filing a petition. 37 C.F.R. §2.146(c).

A petition fee will be waived only in an extraordinary situation (see TMEP §1708), or if the record clearly shows that the petition was the result of a USPTO error. When requesting waiver of a fee, it is recommended that the petitioner submit the fee, but include a request that the fee be refunded because the petition was the result of a USPTO error. This will expedite consideration of the petition if the request for waiver of the petition fee is denied.

If a check submitted as a petition fee is returned to the USPTO unpaid, or an electronic funds transfer or credit card is refused or charged back by a financial institution, the petitioner must resubmit the petition fee, along with a fee for processing the payment that was refused or charged back, before the petition will be considered on the merits. 37 C.F.R. §2.6(b)(12). See TMEP §405.06.

1705.03 Evidence and Proof of Facts

A petition should include a statement of the relevant facts, and should be accompanied by any evidence to be considered. Under 37 C.F.R. §2.146(c), when facts are to be proved, the petitioner must submit proof in the form of an affidavit or declaration under 37 C.F.R. §2.20.

An affidavit or declaration supporting a petition should be based on firsthand knowledge. For example, if the petition arises from the loss or misplacement of a document submitted to the USPTO, it should be accompanied by the affidavit or declaration of the person who sent the document, attesting to the date of submission and identifying the document filed with the petition as a true copy of the document previously filed.

When a petition includes an unverified assertion that is not supported by evidence, a staff attorney or paralegal in the Office of the Deputy Commissioner for Trademark Examination Policy will notify the petitioner that an affidavit or declaration is required, and grant the petitioner 30 days to submit the necessary verification. If the petitioner does not submit a verification within the time allowed, the petition will be denied, or, in appropriate cases, a decision on petition will be rendered based on the information in the record, without consideration of the unverified assertion.

This procedure is also followed with respect to physical evidence. If physical evidence is available, such as a postcard receipt that shows the date of actual receipt of a document in the USPTO (see TMEP §303.02(c)), or a copy of a cancelled check that shows receipt of the filing fee for a missing document, the petitioner should include the evidence with the initial petition. However, if the evidence is omitted from the initial filing, the USPTO will give the petitioner an opportunity to supplement the petition within a specified time limit, normally 30 days.

1705.04 Timeliness

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

- Denial of a request for an extension of time to file a notice of opposition -- 15 days (37 C.F.R. §2.146(e)(1));
- Interlocutory order of the Trademark Trial and Appeal Board -- 30 days (37 C.F.R. §2.146(e)(2));
- Final decision of the Trademark Trial and Appeal Board -- two months (37 C.F.R. §2.146(d));
- Denial of a request for an extension of time to file a statement of use -- two months (37 C.F.R. §2.89(g));
- Section 7 rejection -- six months from date of issuance of Office action refusing to enter an amendment or correction (37 C.F.R. §2.176);
- Section 8 rejection -- six months from date of issuance of Office action refusing the affidavit (37 C.F.R. §2.165(b); see TMEP §§1604.18 *et seq.*);
- Section 9 rejection -- six months from date of issuance of Office action refusing renewal (37 C.F.R. §2.186(b); see TMEP §§1606.14 *et seq.*);
- Petition to revive -- two months from date of issuance of notice of abandonment (37 C.F.R. §2.66(a); see TMEP §§1714 *et seq.*);
- Petition to revive goods/services/classes deleted for failure to respond to a partial refusal or requirement - two months from date of issuance of examiner's amendment deleting (abandoning) the goods/services/classes to which the refusal or requirement pertained (37 C.F.R. §2.66(a); see TMEP §§718.02(a) and 1714 *et seq.*);
- Examining attorney's formal requirement -- six months from date of issuance (15 U.S.C. §1062(b); 37 C.F.R. §§2.62 and 2.63(b));
- Request for reconsideration of decision on petition -- two months from date of issuance (37 C.F.R. §§2.66(f)(1) and 2.146(j)(1)).

If the rules do not provide an express deadline, the petition must be filed within two months of the date of issuance of the action from which relief is requested, under 37 C.F.R. §2.146(d).

If there is no "issuance of an action," the two-month "catchall deadline" of 37 C.F.R. §2.146(d) runs from the date of actual knowledge, or the date of the phone call or other communication that prompts the filing of the petition. The two-month deadline of 37 C.F.R. §2.146(d) also applies where the petition alleges that the petitioner did not receive the action that prompts the filing of

the petition, running from the date of the petitioner's actual knowledge of said action.

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

The petition fee is refunded when a petition is denied as untimely.

Petitions filed using the certificate of mailing and certificate of transmission procedures of 37 C.F.R. §2.197 will be considered timely if mailed or transmitted to the USPTO by the due date, with a certificate that meets the requirements of 37 C.F.R. §2.197(a)(1) (see TMEP §§305.02 and 306.05 *et seq.*).

See TMEP §1705.05 regarding the duty to exercise due diligence in monitoring the status of pending matters.

1705.05 Due Diligence

Applicants and registrants are responsible for tracking the status of matters pending before the USPTO. When a petitioner seeks to reactivate an application or registration that was abandoned, cancelled, or expired due to the loss or mishandling of documents sent to or from the USPTO, the USPTO may deny the petition if the petitioner was not diligent in checking the status of the application or registration, even if the petitioner can show that the USPTO actually received documents, or declares that a notice from the USPTO was never received by the petitioner. 37 C.F.R. §2.146(i).

The required showing of diligence is necessary to protect third parties who may be harmed by the removal and later reinsertion of an application or registration into the USPTO's database. For example, a third party may have searched USPTO records and begun using a mark because the search showed no earlier-filed conflicting marks, or an examining attorney may have searched USPTO records and approved a later-filed application for a conflicting mark because the examining attorney was unaware of the earlier-filed application.

The USPTO generally processes applications, responses, and other documents in the order in which they are received. Since it is reasonable to expect some notice from the USPTO about a pending matter within six months of the filing or receipt of a document, a party who has not received the expected written action or telephone call from the USPTO within that time frame should be on notice that the filing may have been lost. The party awaiting notification has the burden of inquiring as to the cause of the delay, and requesting corrective action in writing when necessary.

To be considered diligent, a petitioner must:

- Check the status of a pending application every six months between the filing date of the application and issuance of a registration;
- Check the status of a registration every six months after filing an affidavit of use or excusable nonuse under §8 or §71 of the Trademark Act, or a renewal application under §9 of the Trademark Act (“§9 renewal application”), until the petitioner receives notice that the affidavit or renewal application has been accepted; and
- Promptly request corrective action in writing where necessary.

37 C.F.R. §2.146(i). See notice at 68 FR 55748 (Sept. 26, 2003).

Applicants and registrants should check the status on each six-month anniversary of the filing of an application for registration, §8 or §71 affidavit, or §9 renewal application to avoid abandonment or cancellation and to ensure that they meet the diligence requirement. For example, if an application was filed on October 1, 2009, the applicant should check the status on May 1, 2010, November 1, 2010, and on each six-month anniversary thereafter, until a registration is issued.

However, to provide applicants, registrants, and their attorneys with flexibility in docketing deadlines for both responses and status checks, an applicant or registrant will meet the diligence requirement if the applicant or registrant checks the status within six months of the filing or receipt of a document for which further action by the USPTO is expected.

Applicants and registrants can check the status of an application or registration through the Trademark Applications and Registrations Retrieval (“TARR”) database on the USPTO website at <http://tarr.uspto.gov>, which is available 24 hours a day, seven days a week. The party should print the TARR screen and place it in the party’s own file, in order to have a record of the status inquiry and the information learned.

A party who does not have access to the Internet can call the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199 to determine the status. After making a telephone status inquiry, a party should make a note in the party’s own file as to the date of the status inquiry and the information learned. No further documentation is required to establish that the status inquiry was made. Written status inquiries are discouraged, because they may delay processing of the application or registration.

If a status inquiry reveals that a document sent to the USPTO was not received, that an Office action or notice was issued but not received by the applicant or registrant, that an application has been abandoned or a registration cancelled or expired, or that some other problem exists, corrective action should be promptly requested in writing. 37 C.F.R. §2.146(i)(3).

Petitions should be directed to the Office of the Deputy Commissioner for Trademark Examination Policy. Requests for reinstatement should be directed to the paralegals in the Office of the Deputy Commissioner for Trademark Examination Policy, the supervisory legal instruments examiner in the law office, or the supervisor of the ITU/Divisional Unit or Post Registration Section. See TMEP §§1712 *et seq.* regarding requests for reinstatement.

Where a registrant has proof that a USPTO error caused a registration to expire or be cancelled due to failure to file a §8 affidavit, §71 affidavit, §9 renewal application, or a response to an examiner's Office action refusing to accept an affidavit of use or excusable nonuse or a renewal application, the registrant may file a request for reinstatement. See TMEP §1712.02(a) regarding the types of proof of USPTO error that will support a request for reinstatement. Generally, where there is proof that a registration was cancelled solely due to a USPTO error, a request for reinstatement will not be denied solely because the registrant was not diligent in monitoring the status of the §8 affidavit or renewal application. However, if a registrant receives a written notice of cancellation, or has actual notice that a registration was cancelled, the USPTO will deny the request for reinstatement as untimely if it was not filed: (1) within two months of the issuance date of the cancellation notice; or (2) within two months of actual notice of cancellation; if the registrant did not receive a written cancellation notice. 37 C.F.R. §2.146(d).

A request to reinstate an *application* abandoned due to USPTO error (see TMEP §1712.01) must be timely (see TMEP §1705.04) and may be denied if the applicant was not diligent in monitoring the status of the application. 37 C.F.R. §§2.66(a)(2) and 2.146(i).

1705.06 Stay or Suspension of Pending Matters

Extract from 37 C.F.R. §2.146(g). The mere filing of a petition ... will not act as a stay in any appeal or inter partes proceeding that is pending before the Trademark Trial and Appeal Board nor stay the period for replying to an Office action in an application except when a stay is specifically requested and is granted or when §§2.63(b) and 2.65 are applicable to an ex parte application.

Filing a petition does not stay the period for replying to an Office action, except when a stay is specifically requested and granted under 37 C.F.R. §2.146(g), or when 37 C.F.R. §§2.63(b) and 2.65 are applicable. Any request to stay a deadline for filing a response to an Office action or notice of appeal should be directed to the Office of the Deputy Commissioner for Trademark Examination Policy. If such a request is sent to the examining attorney, the examining attorney should forward it to the Office of the Deputy Commissioner for Trademark Examination Policy. The examining attorney should **not** suspend action on an application pending a decision on petition.

A request to suspend a proceeding before the Trademark Trial and Appeal Board pending a decision on petition should be directed to the Board. 37 C.F.R. §2.117(c); TBMP §510.03(a). See TBMP §§510 *et seq.* and 1213 regarding suspension of Board proceedings.

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

1705.07 Signature of Petition

A petition to the Director under 37 C.F.R. §2.146 must be personally signed by the individual petitioner, someone with legal authority to bind a juristic petitioner (e.g., a corporate officer or general partner of a partnership), or a practitioner authorized to practice before the USPTO pursuant to 37 C.F.R. §11.14 (“qualified practitioner”). 37 C.F.R. §2.146(c). See TMEP §602 regarding persons authorized to represent a party before the USPTO, and TMEP §§611.06 *et seq.* for guidelines on persons with legal authority to bind various types of legal entities.

Petitions to the Director under 37 C.F.R. §2.146 are often accompanied by separate verifications, signed by someone with firsthand knowledge of the facts to be proved on petition. See TMEP §1705.03. However, the petition itself must be separately signed by a proper party. If the petitioner is represented by a qualified practitioner, the practitioner must sign the petition. 37 C.F.R. §§2.193(e)(5)(i) and 11.18(a). If the petitioner is not represented by a qualified practitioner, the petition must be signed by the petitioner or someone with legal authority to bind the petitioner. 37 C.F.R. §2.146(c); TMEP §611.02. In the case of joint petitioners who are not represented by a qualified practitioner, all must sign. 37 C.F.R. §2.193(e)(5)(ii); TMEP §611.03(e).

Petitions to revive under 37 C.F.R. §2.66 (see TMEP §§1714 *et seq.*) must include a statement that the delay was unintentional, signed by someone with firsthand knowledge. 37 C.F.R. §§2.66(b)(2) and (c)(2); TMEP §1714.01(e). Where a petition to revive under 37 C.F.R. §2.66 consists only of a statement that the delay was unintentional and/or that the applicant did not receive an Office action or notice of allowance, the petition may be signed by someone with firsthand knowledge, and no separate signature by the petitioner, someone with legal authority to bind the petitioner, or a qualified practitioner is required. However, any response to an Office action accompanying the petition (see TMEP §1714.01(a)(i)-(ii)) must be signed by a proper party. 37 C.F.R. §§2.62(b) and 11.18(a); TMEP §712.

If it appears that a petition (or a response accompanying a petition) was signed by an improper party, the staff attorney or paralegal reviewing the

petition will follow the procedures in TMEP §§611.05 *et seq.* for processing documents signed by unauthorized parties.

See *also* TMEP 611.01(c) regarding signature of documents filed electronically.

1705.08 Request for Reconsideration of Denial of Petition

Under 37 C.F.R. §2.146(j), if a petition is denied, the petitioner may request reconsideration by: (1) filing the request for reconsideration within two months of the issuance date of the decision denying the petition; and (2) paying a second petition fee under 37 C.F.R. §2.6.

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

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

1705.09 Appeal to Federal Court

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

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

The deadline for filing an appeal or commencing a civil action is two months from the issuance date of the decision. 37 C.F.R. §2.145(d)(1). Under 37 C.F.R. §2.145(d)(2), one day is added to any two-month period that includes February 28.

1706 Standard of Review on Petition

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

In review of an examining attorney's formal requirement under 37 C.F.R. §§2.63(b) and 2.146(a)(1), the standard of review is whether the examining

attorney's judgment was correct, the same standard that the Trademark Trial and Appeal Board would use if it were considering the requirement on appeal. *In re Du Pont Merck Pharmaceutical Co.*, 34 USPQ2d 1778 (Comm'r Pats. 1995); *In re Stenographic Machines, Inc.*, 199 USPQ 313 (Comm'r Pats. 1978). However, in review of an examining attorney's action under 37 C.F.R. §2.146(a)(3), the Director will reverse the examining attorney only upon a finding of clear procedural error or abuse of discretion (see TMEP §706.01). *In re GTE Education Services*, 34 USPQ2d 1478 (Comm'r Pats. 1994); *In re Direct Access Communications (M.C.G.) Inc.*, 30 USPQ2d 1393 (Comm'r Pats. 1993). See 37 C.F.R. §2.146(b) and TMEP §1704 regarding petitionable subject matter.

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

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

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

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

Under 35 U.S.C. §2 and 37 C.F.R. §2.146(a)(3), the Director may exercise supervisory authority on petition in appropriate circumstances. As noted in TMEP §1706, the Director may review the actions of an examiner or paralegal under 37 C.F.R. §2.146(a)(3) for clear procedural error or abuse of discretion.

In some cases, the Director will exercise supervisory authority under 37 C.F.R. §2.146(a)(3) even where there has been no clear procedural error or abuse of discretion, if a petitioner can show that it has substantially complied with the requirements of the statute or rules. See *In re Carnicon Development Co.*, 34 USPQ2d 1541 (Comm'r Pats. 1992) (assertion of verified date of first use, coupled with statement of current method of use, interpreted as substantially in compliance with minimum filing requirement of 37 C.F.R. §2.88(e)(3) for an allegation in a statement of use that the "mark is in use in commerce.").

The Director may also exercise supervisory authority under 37 C.F.R. §2.146(a)(3) to make changes to USPTO practice. See, e.g., *In re L.G. Lavorazioni Grafite S.r.l.*, 61 USPQ2d 1063 (Comm'r Pats. 2001); *In re Slack*, 54 USPQ2d 1504 (Comm'r Pats. 2000); *In re Moisture Jamzz, Inc.*, 47

USPQ2d 1762 (Comm'r Pats. 1997); *In re El Taurino Restaurant, Inc.*, 41 USPQ2d 1220 (Comm'r Pats. 1996); *In re Umax Data System, Inc.*, 40 USPQ2d 1539 (Comm'r Pats. 1996); *In re Monte Dei Maschi Di Siena*, 34 USPQ2d 1415 (Comm'r Pats. 1995).

1708 Waiver of Rules

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

All three of the above conditions must be satisfied before a waiver will be granted, and the burden is on the petitioner to show that the situation is extraordinary. Disasters like fires, hurricanes, and snowstorms are considered to be extraordinary situations. Extraordinary circumstances have also been found in certain cases where a petitioner avers by affidavit or declaration that it did not receive an Office action issued regarding a §8 affidavit or §9 renewal application.

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

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

Mail delays are not considered extraordinary, because the Trademark Rules of Practice provide procedures designed to avoid lateness due to mail delay. *In re Sportco, Inc.*, 209 USPQ 671 (Comm'r Pats. 1980); *In re Chicago Historical Antique Automobile Museum, Inc.*, 197 USPQ 289 (Comm'r Pats. 1978). See 37 C.F.R. §2.197 regarding certificates of mailing.

A party will not be excused from compliance with the rules because the results in a particular case may be harsh. See *Buckhead*, 71 USPQ2d at

1623 (rejecting petitioner's argument that "justice requires" waiver of the filing date requirements of 37 C.F.R. §2.21 to prevent the loss of priority relative to a conflicting application).

The Director has no authority to waive a statutory requirement, such as the deadline for filing a proper §8 affidavit or §9 renewal application. *In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984).

1709 Matters Delegated by Director

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

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

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

1710 Petition to Make Special

The USPTO generally examines applications in the order in which they are received. A petition to make "special" is a request to advance the initial examination of an application out of its regular order.

A petition to make "special" must be accompanied by: (1) the fee required by 37 C.F.R. §2.6; (2) an explanation of why special action is requested; and (3) a statement of facts that shows that special action is justified. The statement of facts should be supported by an affidavit or declaration under 37 C.F.R. §2.20.

The petition is reviewed in the Office of the Deputy Commissioner for Trademark Examination Policy. The applicant should first file the application via the Trademark Electronic Application System ("TEAS") at <http://www.uspto.gov>. The applicant should then submit a petition to make special that includes the newly assigned serial number. To ensure proper routing and processing, the Office prefers that the petition also be filed electronically. In TEAS, the Petition to Make Special form can be accessed by clicking on the link entitled "Petition Forms."

Alternatively, the petition should be faxed to the attention of the Deputy Commissioner for Trademark Examination Policy at the following fax number: 571-273-0032. If the petition is submitted by mail, it should be submitted *separately* from the application, marked to the attention of the Deputy Commissioner for Trademark Examination Policy.

An application for registration of a mark that was the subject of a previous registration that was inadvertently cancelled or expired will be made “special” upon applicant’s request. No petition is required in this situation. See TMEP §702.02 regarding the requirements and filing procedure for a Request to Make Special.

1710.01 Basis for Granting or Denying Petition

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

The fact that the applicant is about to embark on an advertising campaign is *not* considered a circumstance that justifies advancement of an application out of the normal order of examination, because this situation applies to a substantial number of applicants.

The most common reasons for granting petitions to make “special” are the existence of actual or threatened infringement, pending litigation, or the need for a registration as a basis for securing a foreign registration.

1710.02 Processing Petition

Each petition to make “special,” together with the petition decision, is made part of the record. If the petition is granted, the prosecution history of the application in the Trademark Reporting and Monitoring (“TRAM”) System will reflect that the petition for “special” handling has been granted.

1711 Review of Denial of Filing Dates

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

However, in the limited circumstances listed below, the applicant may request restoration of the filing date without a formal petition:

- (1) The USPTO has no record of receipt of the application, but the applicant presents proof that a complete application was filed through the Trademark Electronic Application System (“TEAS”), in the form of a copy of a TEAS “Success” page confirming receipt of the

application (see TMEP §303.02(a)) or a copy of an e-mail confirmation issued by the USPTO that includes the date of receipt and a summary of the TEAS submission.

- (2) The USPTO has no record of receipt of the application, but the applicant presents proof of actual receipt in the form of evidence that a USPTO employee signed for or acknowledged the envelope containing the application (e.g., a certified mail receipt that bears a USPTO date stamp or label, or the signature of a USPTO employee), accompanied by an affidavit or declaration under 37 C.F.R. §2.20 attesting to the contents of the envelope.
- (3) A filing date was denied, but the application itself clearly shows on its face that the applicant met all relevant filing date requirements on the filing date being requested. If the application was filed on paper, the applicant must resubmit any returned documents showing the cancelled filing date.
- (4) A filing date was denied to a paper application due to the omission of an element, such as a drawing, but the element was in fact included in the application as originally submitted, *and* the applicant submits *all* of the following: (a) a return postcard indicating that the USPTO specifically acknowledged receipt of the element in question (see TMEP §303.02(c)); (b) a substitute to replace the lost element; (c) the application documents that were returned; *and* (d) a copy of the Notice of Incomplete Trademark Application.
- (5) Applicant provides evidence that applicant attempted to file the application through TEAS, but TEAS was unavailable due to technical problems (e.g., a computer screen printout showing receipt of a "Fatal Error - Access Denied" error message, or a copy of an e-mail message from the TEAS Help Desk stating that the TEAS application forms were temporarily unavailable). *See In re Henkel Loctite Corp.*, 69 USPQ2d 1638 (Dir USPTO 2003).

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

Procedure for Filing Request. In any request to restore an application filing date, the applicant should first refile the application, with the application filing fee required by 37 C.F.R. §2.6(a)(1)(i), (ii), or (iii), as appropriate. The USPTO prefers that the application be filed electronically via TEAS at <http://www.uspto.gov>. *The application filing fee must be included even if the applicant has not yet received a refund of the fee previously paid.*

After the applicant receives a new serial number, the applicant should submit a request to restore the original filing date. To ensure proper routing and processing, the Office prefers that the request also be filed electronically. In TEAS, the Request to Restore Filing Date form can be accessed by clicking on the link entitled "Petition Forms" at <http://www.uspto.gov>. Alternatively, the request should be faxed to the Office of the Deputy Commissioner for Trademark Examination Policy at 571-273-8950. The request should: (1) include the new serial number; (2) state the reason(s) why the applicant believes the filing date was denied in error; and (3) include a copy of any Notice of Incomplete Trademark Application received from the USPTO. See TMEP §204.02.

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

Furthermore, applicants must exercise due diligence in monitoring the status of applications. 37 C.F.R. §2.146(i); TMEP §1705.05. To be considered diligent, an applicant must check the status of a pending application every six months between the filing date of the application and issuance of a registration. 37 C.F.R. §2.146(i)(1).

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

The USPTO scans images of applications almost immediately after they are received in the USPTO and uploads these scanned images into TICRS. Because very little time passes between receipt of the application and creation of the scanned image, it is highly likely that the TICRS file of an application will be an exact copy of what was received in the USPTO. Accordingly, if TICRS does not include an image of a missing element that a petitioner declares was submitted with the application, the Director will not grant the petition unless there is evidence to corroborate the petitioner's

declaration. An example of corroborating evidence is a postcard submitted with the original application that bears: (1) a USPTO date stamp; and (2) an itemized list of materials submitted that includes the missing element. *In re Group Falck A/S*, 62 USPQ2d 1797, 1798 (Dir USPTO 2002).

1712 Reinstatement of Applications and Registrations

1712.01 Reinstatement of Applications Abandoned Due to Office Error

If an applicant has proof that an application was inadvertently abandoned due to a USPTO error, an applicant may file a request to reinstate the application, instead of a formal petition to revive. There is no fee for a request for reinstatement. To ensure proper routing and processing, the Office prefers that the request be filed electronically. In TEAS, the Request for Reinstatement form can be accessed by clicking on the link entitled “Petition Forms” at <http://www.uspto.gov>. Requests for reinstatement are handled by the paralegals in the Office of the Deputy Commissioner for Trademark Examination Policy, or by the supervisory legal instruments examiners in the ITU/Divisional Unit or the Examination Support Unit.

The following are examples of situations where the USPTO may reinstate an application that was held abandoned for failure to timely file a statement of use or response to an Office action or that was held abandoned in total after a partial refusal or requirement:

- (1) The applicant presents proof that a response to an Office action, statement of use, or request for extension of time to file a statement of use was timely filed through TEAS, in the form of a copy of a TEAS “Success” page confirming receipt of the application (see TMEP §303.02(a)) or a copy of an e-mail confirmation issued by the USPTO that includes the date of receipt and a summary of the TEAS submission.
- (2) There is an image of the timely filed response, statement of use, or extension request in TIGRS.
- (3) The timely filed document is found in the USPTO.
- (4) The applicant supplies a copy of the document and proof that it was timely mailed to the USPTO in accordance with the certificate of mailing requirements of 37 C.F.R. §2.197 (for the specific requirements for providing proof, see TMEP §305.02(f)).
- (5) The applicant supplies a copy of the document and proof that it was timely transmitted to the USPTO by fax in accordance with the certificate of facsimile transmission requirements of 37 C.F.R. §2.197

(for the specific requirements for providing proof, see TMEP §306.05(d)).

- (6) The applicant presents proof of actual receipt in the USPTO in the form of a return postcard showing a timely USPTO date stamp or label, on which the applicant specifically refers to the document at issue (see TMEP §303.02(c)).
- (7) The applicant presents proof of actual receipt in the USPTO in the form of evidence that a USPTO employee signed for or acknowledged the envelope (e.g., a certified mail receipt that bears a USPTO date stamp or label, or the signature of a USPTO employee), accompanied by an affidavit or declaration under 37 C.F.R. §2.20 attesting to the contents of the envelope.
- (8) The document that became lost was accompanied by a fee, and there is proof that the USPTO processed the fee (e.g., a cancelled check). The request for reinstatement must include an affidavit or declaration under 37 C.F.R. §2.20 that attests to the contents of the filing.
- (9) The USPTO sent an Office action or notice of allowance to the wrong address due to a USPTO error, i.e., the USPTO either entered the correspondence address incorrectly or failed to enter a proper notice of change of address filed *before* the issuance date of the action or notice. See TMEP §609.03 regarding the applicant's duty to notify the USPTO when the correspondence address changes.
- (10) An application is abandoned in total for failure to respond to an Office action or for an incomplete response to a final Office action when the Office action states that the refusal or requirement applies to only certain goods, services, and/or classes. See TMEP §718.02(a).
- (11) An application is abandoned in total after a refusal or requirement that applies to only certain goods, services, and/or classes is upheld on appeal or when the applicant withdraws or fails to prosecute an appeal of a refusal or requirement that applies to only certain goods, services, and/or classes to the Board. See TMEP §718.02(a).

A request for reinstatement must be filed within two months of the issuance date of the notice of abandonment or, if the applicant has not received a notice of abandonment, within two months of the date the applicant had actual knowledge that the application was abandoned. 37 C.F.R. §2.146(d).

If the applicant did not receive a notice of abandonment, the applicant must have been duly diligent in monitoring the status of the application, or the request for reinstatement may be denied. To be duly diligent, the applicant must check the status of a pending application every six months between the

filing date of the application and issuance of a registration. 37 C.F.R. §2.146(i)(1); TMEP §1705.05.

When an application is reinstated, a computer-generated notice of reinstatement is sent to the correspondence address of record. The TRAM System and TARR database are updated accordingly.

If the applicant is not entitled to reinstatement, a request for reinstatement may be considered as a petition to revive. Any petition to revive must meet all the requirements of 37 C.F.R. §2.66. See TMEP §§1714 *et seq.*

1712.02 Reinstatement of Registrations Cancelled or Expired Due to Office Error

1712.02(a) Request for Reinstatement

A registrant may file a request to reinstate a cancelled or expired registration if the registrant has proof that a USPTO error caused a registration to be cancelled or expired due to failure to file a §8 affidavit, §71 affidavit, §9 renewal application, or a response to an examiner's Office action refusing to accept an affidavit or renewal application. There is no fee for a request for reinstatement. A request that the USPTO reinstate a registration that has been cancelled or expired due to USPTO error should be captioned as a "Request for Reinstatement of Registration," and should be directed to the Supervisor of the Post Registration Section.

The following are examples of situations where the USPTO may reinstate a cancelled or expired registration:

- (1) The registrant presents proof that a proper affidavit or renewal application was timely filed through TEAS, in the form of a copy of a TEAS "Success" page confirming receipt of the document (see TMEP §303.02(a)) or a copy of an e-mail confirmation issued by the USPTO that includes the date of receipt and a summary of the TEAS submission.
- (2) There is an image of a timely filed affidavit, renewal application, or response to Office action in TIGRS.
- (3) The timely filed affidavit, renewal application, or response to Office action is found in the USPTO.
- (4) The registrant supplies a copy of the affidavit, renewal application, or response to Office action, with proof that it was timely mailed to the USPTO in accordance with the certificate of mailing requirements of 37 C.F.R. §2.197 (for the specific requirements for providing proof, see TMEP §305.02(f)).

- (5) The registrant supplies a copy of the affidavit, renewal application, or response to Office action, with proof that it was timely transmitted to the USPTO by fax in accordance with the certificate of transmission requirements of 37 C.F.R. §2.197 (for the specific requirements for providing proof, see TMEP §306.05(d)).
- (6) The registrant presents proof of actual receipt in the USPTO in the form of a return postcard showing a timely USPTO date stamp or label, on which the registrant specifically refers to the §8 affidavit, §71 affidavit, §9 renewal application, or response (see TMEP §303.02(c)).
- (7) The registrant presents proof of actual receipt in the USPTO in the form of evidence that a USPTO employee signed for or acknowledged the envelope (e.g., a certified mail receipt that bears a USPTO date stamp or label, or the signature of a USPTO employee), accompanied by an affidavit or declaration under 37 C.F.R. §2.20 attesting to the contents of the envelope.
- (8) The document that became lost was accompanied by a fee, and there is proof that the USPTO processed the fee (e.g., a cancelled check). The registrant must submit an affidavit or declaration under 37 C.F.R. §2.20 attesting to the contents of the original filing.
- (9) The USPTO sent an Office action to the wrong address due to a USPTO error, i.e., the USPTO either entered the correspondence address incorrectly or failed to enter a proper notice of change of address filed *before* the issuance date of the action.
- (10) The registrant supplies a copy of a response to a Post Registration Office action, with proof that it was timely transmitted to the USPTO by Internet e-mail and accompanied by a certificate of transmission under 37 C.F.R. §2.197. See notice at 64 Fed. Reg. 33056, 33063 (June 21, 1999). *NOTE: Section 8 affidavits, §71 affidavits, and §9 renewal applications cannot be filed by e-mail. TMEP §304.02.*

Generally, where there is proof that a registration was cancelled solely due to USPTO error, a request for reinstatement will not be denied solely because the registrant was not diligent in monitoring the status of the affidavit or renewal application. However, if a registrant receives a written notice of cancellation, or has actual notice that a registration was cancelled, the USPTO will deny the request for reinstatement as untimely if it was not filed:

- (1) within two months of the issuance date of the cancellation notice; or
- (2) within two months of actual notice of cancellation, if the registrant did not receive a written cancellation notice. 37 C.F.R. §2.146(d). See TMEP §1705.04 regarding timeliness.

Please note that the Director has no authority to waive a statutory requirement, such as the deadline for filing a proper renewal application under 15 U.S.C. §1059 or affidavit of use of a registered mark under 15 U.S.C. §1058. *Checkers Drive-In Restaurants Inc. v. Commissioner of Patents and Trademarks.*, 51 F.3d 1078, 1085, 34 USPQ2d 1574, 1581 (D.C. App. 1995), *cert. denied* 516 U.S. 866 (1995); *In re Mother Tucker's Food Experience (Canada) Inc.*, 925 F.2d 1402, 1406, 17 USPQ2d 1795, 1798 (Fed. Cir. 1991); *In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984). Therefore, if the registrant did not timely file a §8 affidavit, §71 affidavit, or §9 renewal application, a request to reinstate a cancelled or expired registration will be denied, regardless of the reason for the delay.

1712.02(b) Formal Petition

If a registrant failed to timely respond to an examiner's Office action refusing to accept a §8 affidavit, §71 affidavit, or §9 renewal application due to an extraordinary situation, but the registrant does not have the proof of USPTO error that would support a request for reinstatement, the registrant may file a formal petition under 37 C.F.R. §§2.146(a)(3) and 2.146(a)(5) to waive a rule and accept a late response. Pursuant to 37 C.F.R. §2.146(d), the petition must be filed within two months of the cancellation notice. If the registrant did not receive the cancellation notice, or no cancellation notice was issued, the petition must be filed within two months of the date of actual notice of the cancellation, *and* the record must show that the registrant was diligent in monitoring the status of the registration, pursuant to 37 C.F.R. §2.146(i). See TMEP §§1705.04 and 1705.05 regarding timeliness and diligence.

The unintentional delay standard of 37 C.F.R. §2.66 does *not* apply to registered marks. TMEP §1714.01(f)(ii). Under 37 C.F.R. §§2.146(a)(5) and 2.148, the Director may waive any provision of the rules that is not a provision of the statute, only when an extraordinary situation exists, justice requires, and no other party is injured. See TMEP §1708. The failure to receive an Office action is considered an extraordinary situation that justifies a waiver of a rule. Therefore, if the registrant did not receive an examiner's Office action refusing to accept an affidavit or renewal application, but the registrant does not have proof that non-receipt was due to USPTO error (see TMEP §1712.02(a), paragraph 9), the registrant may file a formal petition under 37 C.F.R. §2.146.

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

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

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

1713 Petition to Reverse Holding of Abandonment for Incomplete Response

1713.01 Standard of Review

Under 37 C.F.R. §2.65(a), an application may become abandoned when an applicant's response, although received within the six-month response period, is incomplete. See TMEP §§718.03 *et seq.* regarding incomplete responses.

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

However, the Director will reverse the examining attorney's holding of abandonment only if there is clear procedural error or abuse of discretion (see TMEP §706.01). *In re GTE Education Services*, 34 USPQ2d 1478 (Comm'r Pats. 1994); *In re Legendary, Inc.*, 26 USPQ2d 1478 (Comm'r Pats. 1992). *Note:* The "unintentional delay" standard for reviving abandoned applications pursuant to 37 C.F.R. §2.66(a) does *not* apply to applications held abandoned because a response was deemed incomplete under 37 C.F.R. §2.65(a). See TMEP §1714.01(f)(ii).

1713.02 Failure to Respond to Notice Granting Additional Time to Perfect Response or to Denial of Request for Reconsideration with Time Remaining

If an examining attorney issues an action granting an applicant additional time to complete a response under 37 C.F.R. §2.65(b) (see TMEP §718.03), or a "Request for Reconsideration Denied – No Appeal Filed - Time Remaining" (or, if appropriate, "SU - Request for Reconsideration Denied – No Appeal Filed - Time Remaining"), and the applicant does not receive the action or fails to timely respond due to some extraordinary circumstance, and the application is abandoned for failure to file a complete response, the applicant

may file a petition to the Director under 37 C.F.R. §2.146 to reverse the holding of abandonment.

If the applicant submits the response with the petition and the petition is granted, the Director will instruct the examining attorney to review the response. If the applicant does not submit the response and the petition is granted, the USPTO will send a notice to the applicant directing the applicant to view the action on the Trademark Document Retrieval (“TDR”) portal on the USPTO website at <http://www.uspto.gov>, and providing the applicant with a new 30-day period in which to perfect the response.

However, if an examining attorney issues an Office action granting an applicant additional time to complete a response when it appears that a response is signed by an improper party, and the applicant fails to complete the response within the time granted or remaining, the examining attorney must hold the application abandoned for failure to file a complete response. See TMEP §§715.03(b), 718.03, and 718.03(b). If the applicant wishes to submit evidence that an authorized party signed the original response, the applicant may petition the Director to reverse the holding and reinstate the application under 37 C.F.R. §2.146. If the evidence establishes that a proper party signed the response, the Director will grant the petition and instruct the examining attorney to review the response. If, however, the evidence establishes that the response was signed by an unauthorized party, the Director will find (1) that the application should have been abandoned for failure to respond, (2) that the petition will be construed as a petition to revive under 37 C.F.R. §2.66, and (3) that revival based on unintentional delay is proper.

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

1714 Petition to Revive Abandoned Application

37 C.F.R. §2.66. Revival of abandoned applications.

(a) The applicant may file a petition to revive an application abandoned because the applicant did not timely respond to an Office action or notice of allowance, if the delay was unintentional. The applicant must file the petition:

(1) Within two months of the date of issuance of the notice of abandonment; or

(2) Within two months of actual knowledge of the abandonment, if the applicant did not receive the notice of abandonment, and the applicant was

diligent in checking the status of the application every six months in accordance with §2.146(i).

(b) The requirements for filing a petition to revive an application abandoned because the applicant did not timely respond to an Office action are:

- (1) The petition fee required by §2.6;*
- (2) A statement, signed by someone with firsthand knowledge of the facts, that the delay in filing the response on or before the due date was unintentional; and*
- (3) Unless the applicant alleges that it did not receive the Office action, the proposed response.*

(c) The requirements for filing a petition to revive an application abandoned because the applicant did not timely respond to a notice of allowance are:

- (1) The petition fee required by §2.6;*
- (2) A statement, signed by someone with firsthand knowledge of the facts, that the delay in filing the statement of use (or request for extension of time to file a statement of use) on or before the due date was unintentional;*
- (3) Unless the applicant alleges that it did not receive the notice of allowance and requests cancellation of the notice of allowance, the required fees for the number of requests for extensions of time to file a statement of use that the applicant should have filed under §2.89 if the application had never been abandoned;*
- (4) Unless the applicant alleges that it did not receive the notice of allowance and requests cancellation of the notice of allowance, either a statement of use under §2.88 or a request for an extension of time to file a statement of use under §2.89; and*
- (5) Unless a statement of use is filed with or before the petition, or the applicant alleges that it did not receive the notice of allowance and requests cancellation of the notice of allowance, the applicant must file any further requests for extensions of time to file a statement of use under §2.89 that become due while the petition is pending, or file a statement of use under §2.88.*

(d) In an application under section 1(b) of the Act, the Director will not grant the petition if this would permit the filing of a statement of use more than 36 months after the date of issuance of the notice of allowance under section 13(b)(2) of the Act.

(e) The Director will grant the petition to revive if the applicant complies with the requirements listed above and establishes that the delay in responding was unintentional.

(f) If the Director denies a petition, the applicant may request reconsideration, if the applicant:

- (1) Files the request within two months of the date of issuance of the decision denying the petition; and*
- (2) Pays a second petition fee under §2.6.*

Upon proper submission of a petition to revive, an abandoned application may be revived under 37 C.F.R. §2.66 if the delay in responding to an Office action or notice of allowance was unintentional. 15 U.S.C. §§1051(d)(4) and 1062(b). Petitions filed under 37 C.F.R. §2.66 are handled by the paralegals in the Office of the Deputy Commissioner for Trademark Examination Policy. See TMEP §1709 regarding the delegation of authority to decide petitions.

To expedite processing, the USPTO recommends that all petitions to revive be filed through TEAS, at <http://www.uspto.gov>.

1714.01 Procedural Requirements for Filing Petition to Revive

The procedural requirements for filing a petition to revive an application abandoned for failure to respond to an examining attorney's Office action are set forth in 37 C.F.R. §2.66(b). See TMEP §1714.01(a) *et seq.* The procedural requirements for filing a petition to revive an application abandoned for failure to timely file a statement of use or request for extension of time to file a statement of use are set forth in 37 C.F.R. §2.66(c). See TMEP §§1714.01(b) and (c).

When a petition does not meet the procedural requirements of 37 C.F.R. §2.66, a paralegal in the Office of the Deputy Commissioner for Trademark Examination Policy will notify the petitioner that the petition does not meet the requirements of the rule, and grant the petitioner 30 days to supplement the petition by submitting the missing element(s). If the petitioner does not submit the necessary information or fees within the time allowed, the petition will be denied.

If a petition to revive filed through TEAS is automatically granted by the electronic system and it is subsequently determined that the petition does not meet the procedural requirements of 37 C.F.R. §2.66, a paralegal in the Office of the Deputy Commissioner for Trademark Examination Policy will notify the petitioner that the granting of the petition has been rescinded because the petition does not meet the requirements of the rule. The petitioner will be granted 30 days to supplement the petition by submitting the missing element(s). If the petitioner does not submit the necessary information or fee(s) within the time allowed, the petition will be denied.

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

To expedite processing, the USPTO recommends that all petitions to revive be filed through TEAS, at <http://www.uspto.gov>.

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

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

- (1) The petition fee required by 37 C.F.R. §2.6;
- (2) A statement, signed by someone with firsthand knowledge of the facts, that the delay in filing the response on or before the due date was unintentional. The statement does not have to be verified; and
- (3) Unless the applicant alleges that it did not receive the Office action, the applicant's proposed response to the Office action. 37 C.F.R. §2.66(b)(3).

If the petition states that applicant did not receive the Office action, and the petition is granted, the USPTO will issue a new Office action and provide the applicant with a new response period, or, if all issues previously raised remain the same, after reviving the application, the USPTO will send a notice to the applicant directing the applicant to view the previously issued Office action on the TDR portal on the USPTO website at <http://www.uspto.gov>, and provide the applicant with a new six-month period in which to file a response.

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

The procedural requirements for filing a petition to revive an application abandoned for failure to respond to an examining attorney's *final* Office action are the same as listed in TMEP §1714.01(a)(i) above. See 37 C.F.R. §2.66(b). However, where a final action has issued, the petition must include a *proper* response, as defined in 37 C.F.R. §2.64(a).

In general, the only proper response to a final action is a notice of appeal to the Trademark Trial and Appeal Board (see TMEP §§1501 *et seq.*), a petition to the Director if permitted under 2.63(b), or compliance with any requirement made by the examining attorney. 37 C.F.R. §2.64(a). See TMEP §715.01. In some cases, after a final refusal of registration on the Principal Register, an amendment requesting registration on the Supplemental Register or registration under 15 U.S.C. §1052(f) may also be a proper response. See TMEP §§714.05(a)(i), 816.04, and 1212.02(h). A request for reconsideration is not a proper response to a final action, unless it is accompanied by a notice of appeal to the Board, or satisfies all outstanding requirements and overcomes all outstanding refusals. See TMEP §§715.03 and 1714.01(f)(ii).

If a petition does not include a proper response to a final action or claim that the final action was not received, the petition will be treated as incomplete. The applicant will be given an opportunity to perfect the petition by submitting

the required response (e.g., a notice of appeal) or claim of non-receipt. If the applicant does not submit a proper response or claim of non-receipt within the time allowed, the petition will be denied.

If the petition states that applicant did not receive the final action, and the petition is granted, the USPTO will issue a new final action and provide the applicant with a new response period. If all issues previously raised remain the same, the USPTO will send a notice to the applicant directing the applicant to view the previously issued final action on the TDR portal on the USPTO website at <http://www.uspto.gov>, and provide the applicant with a new six-month period in which to file a response.

If the applicant received the Office action, and no response was filed within the statutory response period, a late notice of appeal may be submitted with the petition.

Filing a request for reconsideration or incomplete response does *not* extend the time for filing a notice of appeal to the Board or petition to the Director under 37 C.F.R. §2.63(b)(2). 37 C.F.R. §2.64(b). See TMEP §§715.03(c) and 718.03(b). Therefore, if the applicant timely filed a request for reconsideration or a response to the Office action that does not overcome all outstanding refusals and satisfy all outstanding requirements, a late appeal will *not* be accepted on petition.

The unintentional delay standard of 37 C.F.R. §2.66 does *not* apply to applications that are abandoned due to an incomplete response to an examining attorney's Office action. TMEP §§1713 and 1714.01(f)(ii).

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

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

To expedite processing, the USPTO recommends that all petitions to revive be filed through TEAS, at <http://www.uspto.gov>.

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

- (1) The petition fee required by 37 C.F.R. §2.6;
- (2) A statement, signed by someone with firsthand knowledge of the facts, that the delay in filing the statement of use (or request for extension of time to file a statement of use) on or before the due date

was unintentional (37 C.F.R. §2.66(c)(2)). The statement does not have to be verified;

- (3) Either a statement of use under 37 C.F.R. §2.88 or a request for an extension of time to file a statement of use under 37 C.F.R. §2.89 (37 C.F.R. §2.66(c)(4)); and
- (4) The required fees for the number of extension requests that the applicant should have filed if the application had never been abandoned (37 C.F.R. §2.66(c)(3)).

Example 1: If a notice of allowance was issued January 14, 2009, and the applicant did not file a statement of use or extension request by July 14, 2009, the application becomes abandoned. If a petition to revive is filed July 23, 2009, with a statement of use, the petition must include: (1) the fee for the statement of use; (2) the fee for the extension request that was due July 14, 2009; and (3) the petition fee.

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

Unless a statement of use is filed with or before the petition, the applicant must file any further requests for extension of time to file a statement of use that become due while the petition is pending, or file a statement of use (37 C.F.R. §2.66(c)(5)). See TMEP §1714.01(b)(i).

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

The USPTO will *not* grant a petition to revive an intent-to-use application if granting the petition would extend the period for filing the statement of use beyond thirty-six months after the issuance date of the notice of allowance.

15 U.S.C. §§1051(d)(1) and (2); 37 C.F.R. §2.66(d). In these cases, the petition will be denied, and the petition fee will be refunded.

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

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

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

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

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

Please note that an applicant may file a petition to revive and an extension request through TEAS. However, if the applicant files a statement of use with the petition to revive form in TEAS, the TEAS form will require submission of the fee(s) for the missing extension request(s). See TMEP §§1108 *et seq.* regarding extension requests, and TMEP §§1109 *et seq.* regarding statements of use.

1714.01(c) Notice of Allowance Not Received

To expedite processing, the USPTO recommends that all petitions to revive be filed through TEAS, at <http://www.uspto.gov>.

The procedural requirements for filing a petition to revive an application abandoned for failure to respond to a notice of allowance are listed in 37

C.F.R. §2.66(c). *If the applicant did not receive the notice of allowance, the petition must include the following:*

- (1) The petition fee required by 37 C.F.R. §2.6; and
- (2) A statement, signed by someone with firsthand knowledge of the facts, that the applicant did not receive the notice of allowance, and that the delay in filing the statement of use (or request for extension of time to file a statement of use) on or before the due date was unintentional. The statement does not have to be verified.

If the applicant did not receive the notice of allowance, it is not necessary to file a statement of use or request for an extension of time to file a statement of use, or the fees for the number of extension requests that would have been due if the application had never been abandoned. 37 C.F.R. §§2.66(c)(3) and (4). If the petition is granted, the USPTO will cancel the original notice of allowance and issue a new notice, giving the applicant a new six-month period in which to file a statement of use or extension request. However, if the petitioner files an extension request with a petition that alleges nonreceipt of the notice of allowance, the USPTO will presume that the applicant wants to maintain the issue date of the original notice of allowance and will process the extension request.

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

If the petitioner files a statement of use with a petition that alleges nonreceipt of the notice of allowance but does not include the required fees for any missing extension requests, the USPTO will give the petitioner the option of: (1) having the notice of allowance cancelled and reissued, the statement of use not processed, and the filing fee for the statement of use refunded; or (2) paying the additional filing fees for the extension requests that would have been due if the application had never been abandoned, so that the statement of use can be processed. If the applicant files the statement of use with the petition to revive form in TEAS, the TEAS form will require submission of the fees for the missing extension requests.

1714.01(d) Timeliness and Diligence

Under 37 C.F.R. §2.66(a), a petition to revive an abandoned application must be filed: (1) within two months of the issuance date of the notice of abandonment; or (2) within two months of actual knowledge of the abandonment, if the applicant did not receive the notice of abandonment, *and* the applicant was diligent in checking the status of the application. A petition to revive an application as to goods/services/classes deleted (abandoned) for

failure to respond to a partial refusal or requirement must be filed: (1) within two months of the issuance date of the examiner's amendment setting forth the changes that will be made in the identification of goods/services; or (2) within two months of actual knowledge of the issuance of the examiner's amendment, provided the application has not registered, if the applicant did not receive the examiner's amendment *and* the applicant was diligent in checking the status of the application.

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

If a petition is untimely, or if the applicant was not diligent, the USPTO will deny the petition and refund the petition fee. To be considered diligent, the applicant must check the status of a pending application every six months between the filing date of the application and issuance of a registration. 37 C.F.R. §§2.66(a)(2) and 2.146(i)(1).

The applicant may file a petition to revive before the applicant receives the notice of abandonment.

1714.01(e) Signed Statement That Delay Was Unintentional

Under 37 C.F.R. §§2.66(b)(2), 2.66(c)(2), and 2.193(e)(4), a petition to revive must include a statement, signed by someone with firsthand knowledge of the facts, that the delay in responding to the Office action or notice of allowance was unintentional. Generally, it is not necessary to explain the circumstances that caused the unintentional delay and the statement does not have to be verified.

However, if the applicant is alleging that non-receipt of an Office action or notice of allowance caused the unintentional delay, this should be stated; no further explanation is necessary.

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

The person signing the statement must have firsthand knowledge of the facts, but it is not necessary to specifically state in the petition that the signatory has firsthand knowledge. Generally, the USPTO will not question the signatory's authority to sign the statement. However, any response to an Office action accompanying the petition (see TMEP §1714.01(a)(i)-(ii)) must be signed by a qualified practitioner, or by the individual applicant or someone with legal

authority to bind a juristic applicant (e.g., a corporate officer or general partner of a partnership) if the applicant is not represented by a qualified practitioner. 37 C.F.R. §§2.62(b), 2.193(e)(2), and 11.18(a). See TMEP §§611.03(b) and 712 *et seq.* regarding signature of responses to Office actions, TMEP §602 regarding persons authorized to represent a party before the USPTO, and TMEP §§611.06 *et seq.* for guidelines on persons with legal authority to bind various types of legal entities.

See *also* TMEP §1705.07 regarding signature of petitions, and TMEP §611.01(c) regarding signature of documents filed through TEAS.

1714.01(f) Applicability of Unintentional Delay Standard

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

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

The minimum filing requirements for a statement of use are listed in 37 C.F.R. §2.88(e): (1) the fee for at least a single class of goods or services; (2) at least one specimen or facsimile of the mark as used in commerce; and (3) a verification or declaration signed by the applicant stating that the mark is in use in commerce.

The minimum filing requirements for a request for extension of time to file a statement of use are: (1) a verified statement that the applicant has a continued bona fide intention to use the mark in commerce; (2) a specification of the goods or services on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce; and (3) payment of the prescribed fee for at least one class of goods or services. TMEP §1108.04. See *In re El Taurino Restaurant, Inc.*, 41 USPQ2d 1220, 1222 (Comm’r Pats. 1996).

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

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

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

The unintentional delay standard of Trademark Rule 2.66 applies only to the *failure* to respond to an examining attorney's Office action or a notice of allowance. 15 U.S.C. §§1051(d)(4) and 1062(b).

Examining Attorney's Holding of Abandonment for Failure to File Complete Response to Office Action - 37 C.F.R. §2.65(a)

The unintentional delay standard of 37 C.F.R. §2.66 does *not* apply to an incomplete response to an examining attorney's Office action. Incomplete responses to examining attorneys' Office actions are governed by 37 C.F.R. §2.65(b), which gives the examining attorney discretion to grant an applicant additional time to respond if the applicant's failure to file a complete response is inadvertent. If the examining attorney holds the application abandoned for failure to file a complete response to an Office action, the applicant may file a petition to the Director to review the examining attorney's action under 37 C.F.R. §2.146. The Director will reverse the examining attorney's action only if there is clear procedural error (see TMEP §706.01) or abuse of discretion. See TMEP §1713.

A request for reconsideration of a final refusal (see TMEP §§715.03 *et seq.*) that is not accompanied by a proper notice of appeal will be treated as an incomplete response to the final Office action. If the examining attorney denies the request for reconsideration, the time for filing a notice of appeal runs from the issuance date of the final action. TMEP §715.03(c). If the time for appeal has expired, the applicant may not file a petition to revive under 37 C.F.R. §2.66.

Examining Attorney's Refusal of Registration on Ground That Applicant Did Not Meet Statutory Requirements Before Expiration of Deadline For Filing Statement of Use

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

Goods/Services Omitted from Statement of Use or Request for Extension of Time to File a Statement of Use

If the applicant lists the goods/services in a statement of use or request for an extension of time to file a statement of use, and omits any goods or services that were listed in the notice of allowance, the USPTO will presume these goods/services to be deleted. The applicant may not thereafter request that the goods/services be reinserted in the application. 37 C.F.R. §§2.88(i)(2) and 2.89(f); TMEP §§1108.02(d) and 1109.13. In these situations, the applicant may not file a petition under 37 C.F.R. §2.66 claiming unintentional delay in filing a statement of use or extension request for the omitted goods/services.

Registered Marks

Trademark Rule 2.66 applies only to abandoned applications, not to registered marks. If a registrant fails to timely respond to an Office action regarding a §8 affidavit, §71 affidavit, or §9 renewal application, the registrant may file a petition to the Director under 37 C.F.R. §§2.146(a)(5) and 2.148 to waive a rule and accept a late response. However, the Director will waive a rule only in an extraordinary situation, where justice requires, and no other party is injured. The Director has no authority to waive a statutory requirement. See TMEP §1708 regarding the waiver of rules.

See TMEP §§1712.02 *et seq.* regarding requests to reinstate cancelled or expired registrations.

Dismissal of Appeal for Failure to File a Brief

An applicant cannot file a petition to revive under 37 C.F.R. §2.66 if an application is abandoned because the Board dismisses an appeal for failure to file a brief. In this situation, the applicant may file a motion with the Board to set aside the dismissal and accept a late-filed brief. See TBMP §1203.02(a). If the Board denies this motion, the applicant may file a petition to the Director under 37 C.F.R. §2.146, asking the Director to reverse the Board's order. The petition must be filed within thirty days of the issuance date of the Board's order. 37 C.F.R. §2.146(e)(2). The Director will reverse the Board's action only if the Board clearly erred or abused its discretion.

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

Under 37 C.F.R. §2.66(f), if a petition to revive is denied, the applicant may request reconsideration by: (1) filing the request for reconsideration within two months of the issuance date of the decision denying the petition; and (2) paying a second petition fee under 37 C.F.R. §2.6. See TMEP §1705.08.

1715

Letters of Protest in Pending Applications

A letter of protest is an informal procedure created by and existing at the discretion of the USPTO, whereby third parties may bring to the attention of the USPTO evidence bearing on the registrability of a mark. The letter of protest procedure applies only to pending applications and is intended to aid in examination without causing undue delay and without compromising the integrity and objectivity of the ex parte examination process. See *In re BPJ Enterprises, Ltd.*, 7 USPQ2d 1375 (Comm'r Pats. 1988); *In re Pohn*, 3 USPQ2d 1700 (Comm'r Pats. 1987).

Letters of protest are reviewed in the Office of the Deputy Commissioner for Trademark Examination Policy ("Deputy Commissioner") to determine whether the submitted information should be given to the examining attorney for consideration. To preserve the integrity and objectivity of the ex parte examination process, the letter of protest never becomes part of the application file and the Deputy Commissioner acts on the letter of protest without consulting with the examining attorney. The Deputy Commissioner considers only the record in the application and the evidence submitted by the protestor. *BPJ Enterprises*, 7 USPQ2d at 1378.

If a third party attempts to contact an examining attorney regarding a letter of protest, the examining attorney will refer the third party to the Deputy Commissioner's Office. If an examining attorney receives a letter of protest, the letter will be referred to the Deputy Commissioner's Office for consideration. If the letter of protest is mistakenly entered in the record as a document received from the applicant, all evidence of that receipt will be expunged from the application record.

The Deputy Commissioner will grant a letter of protest filed before publication where it is determined that the evidence is relevant and supports any reasonable ground for refusal appropriate in ex parte examination. The Deputy Commissioner will grant a letter of protest filed after publication only if the protestor submits prima facie evidence supporting a refusal of registration, such that publication of the mark without consideration of the issue and evidence presented in the letter of protest was a clear error (see TMEP §706.01) by the USPTO. See TMEP §§1715.02 and 1715.03 *et seq.*

1715.01

Appropriate and Inappropriate Subjects to be Raised in Letter of Protest

It is inappropriate to use the letter of protest procedure to delay registration or to present purely adversarial arguments. The USPTO denies letters of protest that merely present adversarial arguments that registration should be refused. Adversarial arguments in letters of protest are not sent to the examining attorney. These objections to registration should be made in an opposition proceeding after publication or, in the case of the Supplemental Register, a cancellation proceeding after registration. The letter of protest

procedure may not be used to circumvent the requirements for filing an opposition. The USPTO also denies letters of protest that do not include factual, objective evidence.

1715.01(a) Issues Appropriate as Subject of Letter of Protest

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

- (1) A third party files an objection to the registration of a term because it is allegedly generic or descriptive. The objection must be accompanied by *evidence* of genericness or descriptiveness. The evidence should be objective, independent, and factual evidence that the examining attorney may use to support the suggested refusal. Personal opinions are subjective and may be self-serving, and are not forwarded to the examining attorney. If the letter of protest is granted, the examining attorney is informed that an objection to registration has been filed on the ground that the mark is generic or descriptive, and is given a copy of any factual evidence submitted with the letter of protest.
- (2) A third party notifies the USPTO of the existence of a federally registered mark or prior-pending application and alleges that there is a likelihood of confusion between this mark and the mark in the application that is the subject of the letter of protest. If the letter of protest is granted, the examining attorney is notified that an objection to the registration of the mark has been made on the ground of an alleged likelihood of confusion with a registered mark or prior-pending application, and is referred to the registration or application information as it appears in the automated records of the USPTO.
- (3) A third party files a request that prosecution of an application be suspended because of pending litigation claiming infringement based on the applicant's use of the applied-for mark. The litigation must be specifically identified and a copy of the relevant pleadings must be enclosed. The litigation must involve a federally registered mark or prior-pending application of the protestor, and the protestor must allege that there is a likelihood of confusion between this mark and the mark in the application that is the subject of the letter of protest. Normally, a court proceeding is not considered relevant to the registrability of a mark unless the remedy requested in the proceeding is cancellation, abandonment, or amendment of the relevant application. If the letter of protest is granted, the examining attorney is informed that a request for suspension has been received based on an alleged likelihood of confusion with a registered mark or

prior-pending application that is the subject of pending litigation. Copies of the relevant pleadings are placed in the record.

- (4) Registered marks are being used inappropriately in identifications of goods and services for particular applications. (See TMEP §1402.09.)
- (5) A third party notifies the USPTO of the existence of a subsequently filed U.S. application and alleges that the application contains a proper claim of priority under §44(d) to which the third party is entitled and that there is a likelihood of confusion between its mark and the mark in a prior-filed application that is the subject of the letter of protest. See TMEP §§1003.05 and 1904.01(e).

1715.01(b) Issues Inappropriate as Subject of Letter of Protest

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

- (1) A third party claims earlier common-law use of a trademark but does not have a federal registration or previously filed pending application for that mark. The examining attorney can only consider registrations and prior-pending applications when determining likelihood of confusion. Earlier common-law use, state registrations, and other claims based on evidence other than federal registrations and prior-pending applications for federal registration are not appropriate for presentation to examining attorneys during ex parte examination.
- (2) A third party claims that the applicant is not the proper owner of the mark. This issue requires proof that is beyond the scope of authority of an examining attorney to require during ex parte examination. *In re Apple Computer, Inc.*, 57 USPQ2d 1823 (Comm'r Pats. 1998).
- (3) Numerous third parties set forth the opinion that the mark should not register, but do not offer any evidence or legal reason to support the refusal. The letter of protest procedure should not be used as a means for expressing public opinion about a particular mark. The trademark registration process is governed by statutory laws and federal regulations. Public opinion may not be used to influence the application process; therefore, mass mailings by special-interest groups will not be made part of the record. Letters of protest that raise the same objection to registration submitted by five or more different parties will be considered a mass mailing.
- (4) A third party requests that prosecution of an application be suspended or refused because of pending litigation, but does not provide proof that the pending litigation includes grounds upon which the Office can suspend or refuse registration (e.g., the litigation does

not involve a federally registered mark or prior-pending application of the protestor).

- (5) A third party claims that the applicant has committed fraud against the USPTO.

1715.02 Letter of Protest Filed Before Publication

1715.02(a) Standard of Review for Letter of Protest Filed Before Publication

The Deputy Commissioner will grant a letter of protest filed before publication in all cases where it is determined that the evidence is relevant and supports any reasonable ground for refusal appropriate in ex parte examination. The letter of protest will be reviewed and decided upon even if the examining attorney has not yet taken a first action in the application that is the subject of the letter of protest. Upon granting a letter of protest, the Deputy Commissioner will forward the relevant evidence (but not the letter of protest itself) to the examining attorney. Letters of protest filed before publication will be denied if they merely present purely adversarial arguments, or are otherwise inappropriate.

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

A letter of protest filed before publication will be dismissed as moot when the issue raised has already been considered by the examining attorney unless: (1) the evidence provided by the protestor is significant additional evidence not currently of record in the application; or (2) the examining attorney clearly erred in his or her consideration of the issue and such error would result in the issuance of a registration in violation of the Trademark Act or applicable rules. See TMEP §706.01 regarding clear error.

1715.02(b) Action by Examining Attorney Before Publication

Under the new standard for granting a pre-publication letter of protest, the examining attorney is *not* required to issue a refusal as a result of the grant. The examining attorney is required only to consider the evidence and make an independent determination whether to issue the requirement or refusal requested in the letter of protest. The examining attorney need not inform the applicant that a letter of protest was granted unless he or she is issuing a refusal based upon the information provided with the letter of protest. The prosecution history of the application will reflect the grant of a letter of protest and a memorandum granting the protest and all relevant evidence will become part of the official record. If the examining attorney decides against issuing the requirement or refusal, a note in the in the “Notes-to-the-File”

section of the record must be entered indicating that the evidence was reviewed.

Letters of Protest Filed Before Publication but Granted After Publication

In certain circumstances, a letter of protest filed before publication may not be reviewed by the Deputy Commissioner until after publication or during the period when the USPTO cannot withdraw the mark from publication. Such letters are reviewed under the pre-publication standard. If granted and referred to the examining attorney after publication, the examining attorney is not required to issue a refusal or requirement as a result of the grant. However, the examining attorney should consult with his or her managing attorney to determine whether a refusal or requirement is warranted.

If it is determined that a refusal or requirement must be made after publication and prior to the filing of a notice of opposition or issuance of a notice of allowance, the examining attorney must request that the Director restore jurisdiction so that the examining attorney may take action on the application. See TMEP §1504.04. If a notice of opposition has been filed, the examining attorney must request that the Board remand the application so that the examining attorney may take the specified action. See TMEP §1504.05(a).

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

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

1715.03 Letters of Protest Filed After Publication

1715.03(a) Standard of Review for Letters of Protest Filed After Publication

When a letter of protest is filed more than 30 days after the date of publication, the letter of protest will generally be denied as untimely. See TMEP §1715.03(b).

When a letter of protest is filed within 30 days after the date of publication, the letter of protest will be granted only where publication of the mark constituted clear error, because the evidence establishes a prima facie case for refusal of registration. *In re BPJ Enterprises Ltd.*, 7 USPQ2d 1375 (Comm'r Pats. 1988). See TMEP §706.01 regarding clear error.

1715.03(b) Timely Filing of Letter of Protest

The most appropriate time for filing a letter of protest is before publication of a mark, because the purpose of the letter of protest is to assist the USPTO in the examination of an application for registration. However, circumstances may preclude filing during that period in certain cases. For example, the protestor may not be aware of an application until publication, or the evidence relevant to registrability may not be available until after publication.

Letters of protest filed more than 30 days after publication are generally denied as untimely, because a letter of protest filed after publication may delay the registration process significantly. *In re BPJ Enterprises Ltd.*, 7 USPQ2d 1375 (Comm'r Pats. 1988). This applies to all applications, including intent-to-use applications under 15 U.S.C. §1051(b). *In re G. Heileman Brewing Co., Inc.*, 34 USPQ2d 1476 (Comm'r Pats. 1994).

Exceptions to the 30-day rule are made only in special circumstances, where the protestor could not earlier have obtained the information provided in the letter. *In re Pohn*, 3 USPQ2d 1700 (Comm'r Pats. 1987).

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

The letter of protest procedure applies *only* to pending applications. The Director has no authority to cancel a registration in order to consider a letter of protest. Therefore, a letter of protest will be denied as untimely if the mark registers before issuance of the decision on the letter. Once the mark has registered, the protestor's remedy is to file a petition to cancel with the Board.

1715.03(c) Jurisdiction of Application When a Letter of Protest Is Granted After Publication

As a general rule, after publication, the examining attorney does not have jurisdiction to act on an application. TMEP §1504.04. Therefore, upon granting a letter of protest filed after publication and before issuance of the registration or notice of allowance, the Commissioner for Trademarks will restore jurisdiction of the application to the examining attorney. The Commissioner also will restore jurisdiction when a letter of protest is granted and an extension of time to file an opposition has been filed. However, if an opposition has been instituted, the Board has jurisdiction over the application. TMEP §1504.02. Therefore, upon request, the Board will generally restore jurisdiction and remand the application to the examining attorney. See TBMP §215 for further information concerning the effect of a letter of protest when an opposition or request for extension of time to oppose has been filed.

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

1715.03(d) Action by Examining Attorney After Publication

If the USPTO grants a letter of protest filed after publication, the examining attorney must issue the refusal or requirement, except in unusual circumstances. The examining attorney should inform the applicant that a letter of protest was granted. If the notice of allowance was cancelled, the examining attorney should so inform the applicant. Before issuing the Office action with the refusal or requirement, the examining attorney must have the action reviewed by his or her managing attorney.

However, the granting of the letter of protest is not a final determination by the USPTO that registration must be refused. In unusual circumstances, the examining attorney may discover additional evidence that would justify approval of the application for registration after the grant of a letter of protest, or the applicant may overcome the refusal or satisfy the requirement. If a

letter of protest is granted after publication and the examining attorney later determines that the mark should be approved for issuance of a registration or notice of allowance, the examining attorney must obtain permission from the Administrator for Trademark Policy and Procedure (“Administrator”) before approving the application for issue. After conferring with the Administrator, an appropriate note must be entered in the “Notes-to-the-File” section of the record.

1715.03(e) Letter of Protest Does Not Stay or Extend Opposition Period

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

1715.04 Information for Parties Filing Letter of Protest

Third parties who object to the registration of a mark in a pending application should never contact an examining attorney directly, either orally or in writing. Instead, they may submit a request in writing to the USPTO entitled “LETTER OF PROTEST,” protesting registration of a particular trademark based on factual, objective evidence that is relevant to the examination of the mark. Note that if the evidence is not included, the letter of protest will be denied.

The type of evidence that is relevant to the examination of the mark depends upon the nature of the objection raised. Objections on the basis that a mark, or portion of a mark, is descriptive or generic must be accompanied by factual, objective evidence that supports the suggested refusal. When likelihood of confusion with existing federally registered marks or prior pending applications is alleged, it is not necessary to submit copies of registration certificates or printouts from the USPTO database. Submission of the relevant registration or application serial number(s) is sufficient if the goods and/or services are identical. Otherwise, evidence of the relatedness of the goods and/or services should be included. However, if third-party registrations are offered to show that the mark or a portion of the mark is descriptive, generic, or so commonly used that the public will look to other elements to distinguish the source of the goods or services, a list of the registrations or copy of a search report is not proper evidence of such registrations. See TMEP 1207.01(d)(iii). Rather, copies of these registration certificates should be included.

A separate itemized index must accompany any submission of evidence exceeding 75 pages or the letter of protest may not be considered. Moreover,

the Office encourages the use of an index in all letters of protests that contain multiple forms of evidence as it aids in the consideration of the details of all the evidence provided by the protestor. The index must be provided on plain paper (not letterhead) and contain a concise factual description of each category or form of evidence included. To maintain the integrity of the ex parte examination process, the index should not identify the protestor or its representatives or contain any arguments or persuasive language.

If the objection applies to more than one pending application, a separate letter must be sent for each application with relevant evidence accompanying each individual letter. Every letter of protest must include the name and address of the protestor in order for a response to be sent.

1715.04(a) Submitting Letter of Protest

Because letters of protest are not made an official part of the application record, it is important that they be properly designated and submitted to the USPTO. In order to insure their proper routing and processing, the Office prefers that letters of protest be filed electronically via the Trademark Electronic Application System ("TEAS"). A separate letter of protest must be filed for each individual application that is being protested. In TEAS, the Letter of Protest form can be accessed by clicking on the link entitled "Petition Forms" at <http://www.uspto.gov>. Otherwise, letters of protest should be faxed to the attention of the Deputy Commissioner for Trademark Examination Policy to the following fax number: 571-273-0032. This is the only fax number that may be used. Failure to submit the letter of protest properly may result in it being considered untimely.

Letters of protest with significant amounts of evidence should be sent via the United States Postal Service as first class mail, and addressed as follows:

Letter of Protest
ATTN: Deputy Commissioner for Trademark Examination Policy
600 Dulany Street
Alexandria, VA 22314-5793

Submissions relating to a letter of protest, including requests for copies of letters of protest (see TMEP §1715.05), should not include a request for a return receipt. If a protestor hand delivers the letter of protest or uses a private courier service, the letter of protest must be delivered to the attention of the Deputy Commissioner for Trademark Examination Policy at the Trademark Assistance Center, James Madison Building - East Wing, Concourse Level, 600 Dulany Street, Alexandria, Virginia, and be clearly identified as a letter of protest.

1715.04(b) Tracking of Letters of Protest by the Protestor

A protestor will always receive a response from the Deputy Commissioner granting, denying, or holding moot the letter of protest, and should generally receive the response within 60 days of filing the letter. The protestor should monitor the application status by checking the TARR database at <http://tarr.uspto.gov> to determine whether an action granting the letter of protest has been taken. This information will be in the public record only if the letter of protest is granted. If a protestor has not received a response within six months of submitting a letter of protest, the protestor should contact the Office of the Deputy Commissioner to confirm receipt of the letter of protest.

Protestors should continue to monitor the status of the application being protested because the application may be approved for publication, republication, or issuance of a registration even after a letter of protest is granted. Ongoing monitoring will ensure protestors the opportunity to take other action (such as filing a notice of opposition) if the refusal or requirement raised as a result of the letter of protest is successfully overcome by the applicant. A protestor may file a second letter of protest after publication only if a substantially different basis for filing the letter of protest is raised or significant additional evidence is provided that clearly establishes a prima facie case for refusal of registration.

1715.05 Requests for Copies of Letters of Protest

Any party who requests a copy of a letter of protest should mail the request to the Office of the Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451 or fax the request to 571-273-0032. All requests should be directed to the attention of the Deputy Commissioner for Trademark Examination Policy. Upon review of the letter of protest material, the Deputy Commissioner will usually forward a copy of the letter of protest and its attachment to the requester. The Deputy Commissioner will deny the request for a copy of the letter of protest only if the letter of protest itself or its attachments contain material that would potentially be exempt from disclosure under the Freedom of Information Act ("FOIA"). If, in the opinion of the Deputy Commissioner, any part of the letter of protest or its attachments should be exempt from disclosure under FOIA, the matter will be forwarded to the Office of General Counsel of the USPTO for further review.

1715.06 Recourse After Denial of Letter of Protest

If the Deputy Commissioner denies a letter of protest, the protestor may pursue remedies otherwise available, such as an opposition proceeding, if the protestor complies with all relevant requirements and deadlines. Filing a letter of protest does not stay or extend the time for filing a notice of opposition. TMEP §1715.03(b).

The protestor may not file a request for reconsideration of the denial of the letter of protest with the Deputy Commissioner, because the request would unduly delay final disposition of the application. *In re BPJ Enterprises Ltd.*, 7 USPQ2d 1375 (Comm'r Pats. 1988). However, the protestor may petition the Director to review the Deputy Commissioner's decision to deny the letter of protest under 37 C.F.R. §2.146(a)(3).

The Deputy Commissioner has broad discretion in determining whether to grant a letter of protest. In any petition to review the denial of a letter of protest, the Deputy Commissioner's action will be reversed only where there has been a clear error or abuse of this broad discretion. *In re Pohn*, 3 USPQ2d 1700, 1702 (Comm'r Pats. 1987).

The protestor may not present additional evidence with the petition. On petition, the Director will consider only the evidence that was properly before the Deputy Commissioner in acting on the letter of protest. *In re BPJ Enterprises, supra*.