

# **Chapter 200**

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## **201                      What Constitutes Filing Date**

In an application under §1 or §44 of the Trademark Act, 15 U.S.C. §1051 or §1126, the filing date of an application is the date on which all the elements set forth in 37 C.F.R. §2.21(a) (see TMEP §202) are received in the United States Patent and Trademark Office ("USPTO").

In a request for an extension of protection of an international registration to the United States under §66(a) of the Trademark Act, 15 U.S.C. §1141f(a), the filing date is: (1) the international registration date, if the request for extension of protection to the United States is made in an international application; or (2) the date that the subsequent designation was recorded by the International Bureau of the World Intellectual Property Organization ("IB"), if the request for extension of protection to the United States is made in a subsequent designation. 15 U.S.C. §1141f(b); 37 C.F.R. §7.26. See TMEP §§1904 *et seq.* for further information about §66(a) applications.

Granting a filing date to an application does not necessarily mean that all requirements for registration have been satisfied. It is possible that registration could be refused on a substantive ground. See TMEP §818 for a list of potential grounds of refusal. If registration is not refused on any substantive basis (or if the applicant overcomes any substantive refusals), the applicant must comply with any procedural requirements issued by the examining attorney during examination, in accordance with applicable rules and statutes, in order to obtain a registration.

### **201.01                      Effective Filing Date Controls for Purposes of Determining Priority for Publication or Issue**

The filing date of an application (see TMEP §201) is also the *effective* filing date, *except* where: (1) the applicant is entitled to priority under 15 U.S.C. §1126(d) or §1141g (see TMEP §206.02); (2) the applicant amends an intent-to-use application filed under 15 U.S.C. §1051(b) to the Supplemental Register (see TMEP §206.01); or (3) the application was filed before November 16, 1989, the applicant had not used the mark in commerce for one year before the application filing date, and the applicant amends to the Supplemental Register on or after November 16, 1989 (see TMEP §206.03). The effective filing date is controlling for purposes of determining priority for publication or issue (see TMEP §1208.01) and constructive use priority (see TMEP §201.02).

## **201.02 Constructive Use Priority**

Under 15 U.S.C. §§1057(c) and 1141f(b), filing *any* application for registration on the Principal Register, including an intent-to-use application, constitutes constructive use of the mark, provided the application matures into a registration. Upon registration, filing affords the applicant nationwide priority over others, except: (1) parties who used the mark before the applicant's filing date; (2) parties who filed in the USPTO before the applicant; or (3) parties who are entitled to an earlier priority filing date based on the filing of a foreign application under 15 U.S.C. §1126(d) or §1141g (see TMEP §206.02). See *Aktieselskabet AF 21. November 2001 v. Fame Jeans Inc.*, 525 F.3d 8, 86 USPQ2d 1527 (D.C. Cir. 2008); *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991).

## **202 Requirements for Receiving a Filing Date**

Under 37 C.F.R. §2.21(a), the USPTO will grant a filing date to an application under §1 or §44 of the Trademark Act that is in the English language and contains all of the following:

- (1) The name of the applicant;
- (2) A name and address for correspondence;
- (3) A clear drawing of the mark;
- (4) A listing of the goods or services; and
- (5) The filing fee for at least one class of goods or services.

The filing date requirements apply to both the Principal and the Supplemental Register. *Kraft Group LLC v. Harpole*, 90 USPQ2d 1837 (TTAB 2009) (use in commerce is not required for receipt of a filing date for an application requesting registration on the Supplemental Register).

If an application does not satisfy all the above requirements, it will not be given a filing date. The USPTO will notify the applicant of the reason(s) why the application was not given a filing date, and refund the application filing fee.

The applicant must provide a physical address to which paper correspondence can be mailed in order to receive a filing date. An e-mail address and authorization to send communications by e-mail cannot be substituted for a physical address. A post office box is acceptable.

Applications that do not meet the minimum requirements for receipt of a filing date are referred to as "informal." See TMEP §203 regarding review for compliance with minimum filing requirements, and TMEP §§204 *et seq.* for information about how the USPTO handles informal applications.

In an application under §66(a) of the Trademark Act, 15 U.S.C. §1141f(a) (i.e., a request for extension of protection of an international registration to the United States), compliance with the minimum filing requirements of §66(a) of the Act will be determined by the IB prior to sending the application to the USPTO. See TMEP §§1904 *et seq.* for further information about §66(a) applications.

## **202.01 Clear Drawing of the Mark**

In a §66(a) application, the drawing must meet the requirements of the Madrid Protocol and the *Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to That Agreement*, which are available on the IB's website at <http://www.wipo.int/madrid/en/>. The IB will determine whether the drawing meets these requirements before sending the application to the USPTO. See TMEP §§1904 *et seq.* for further information about §66(a) applications.

Under 37 C.F.R. §2.21(a)(3), a §1 or §44 applicant must submit “a clear drawing of the mark” to receive a filing date, except in applications for registration of sound, scent, and other non-visual marks. A separate drawing page (or digital image of a separate drawing page in an application filed through the Trademark Electronic Application System (“TEAS”)) is not mandatory, but is encouraged. See TMEP §807.09 regarding “drawings” in applications for registration of non-visual marks.

A “drawing” is simply a depiction of the mark for which registration is sought. 37 C.F.R. §2.52. A drawing that includes multiple elements that do not comprise an identifiable mark, or that consists of wording describing the mark, does not constitute a clear drawing of the mark.

An application that includes two or more drawings displaying materially different marks does not meet the requirement for a “clear drawing of the mark.” Therefore, an application is denied a filing date if it includes two or more drawings displaying materially different marks. See *Humanoids Group v. Rogan*, 375 F.3d 301, 71 USPQ2d 1745 (4<sup>th</sup> Cir. 2004).

However, if an applicant (1) submits a separate drawing page showing a mark in a paper application, (2) enters a standard character mark in the “Mark Information” field of an application filed through TEAS, or (3) attaches a .jpg file containing a mark to the “Mark Information” field of a TEAS application, and a different mark appears elsewhere in the application, the drawing page or mark shown in the “Mark Information” field on TEAS will control for purposes of determining the nature and elements of the mark. The USPTO will grant a filing date to the application, and disregard any other mark that appears elsewhere in the application. The applicant will not be permitted to amend the mark if the amendment is a material alteration of the mark on the drawing page in a paper application or the “Mark Information” field in a TEAS application. *In re L.G. Lavorazioni Grafite S.r.l.*, 61 USPQ2d 1063 (Dir

USPTO 2001). See 37 C.F.R. §2.72 and TMEP §§807.14 *et seq.* regarding material alteration of a mark.

A specimen showing the mark does not satisfy the requirement for a drawing. If the only depiction of the mark is on a specimen (e.g., an advertisement, a photograph of the goods, or the overall packaging), then there is no drawing, and the application will be denied a filing date.

See TMEP §§807 *et seq.* for additional information about the examination of drawings.

See *also* TMEP §204.03 regarding the examining attorney's handling of applications that are erroneously granted a filing date.

## **202.02 Listing of Recognizable Goods or Services**

The USPTO will deny a filing date to an application under §1 or §44 of the Trademark Act if the application does not identify recognizable goods or services. See TMEP §1402.02 for further information.

## **202.03 Filing Fee for At Least One Class of Goods or Services**

In an application under §1 or §44 of the Trademark Act, the applicant must pay the filing fee for at least one class of goods or services before an application can be given a filing date. 37 C.F.R. §2.21(a)(5). The fee can be paid by credit card, check, money order, electronic funds transfer ("EFT"), or by an authorization to charge a deposit account. 37 C.F.R. §2.207. See TMEP §§405 *et seq.* for additional information about fees.

The amount of the trademark application filing fee varies depending on whether the application is filed through TEAS or on paper. An applicant has three choices. The applicant can file:

- A paper application at the highest fee per class, set forth in 37 C.F.R. §2.6(a)(1)(i);
- A regular TEAS application at a lower fee per class, set forth in 37 C.F.R. §2.6(a)(1)(ii); or
- A TEAS Plus application (see TMEP §§819 *et seq.*) at the lowest fee per class, set forth in 37 C.F.R. §2.6(a)(1)(iii).

See TMEP §§819 *et seq.* regarding TEAS Plus. See *also* notices at [70 Fed. Reg. 2952 \(Jan. 19, 2005\)](#) and [70 Fed. Reg. 38768 \(July 6, 2005\)](#). The current fee schedule is available on the USPTO website at <http://www.uspto.gov>.

The complete fee for at least a single class must be submitted with the application as filed. Partial or piecemeal fee payments are unacceptable and will be returned.

If an application does not include a filing fee for at least a single class, the USPTO will deny a filing date. *In re Buckhead Marketing & Distribution, Inc.*, 71 USPQ2d 1620 (Dir USPTO 2004); *In re Paulsen*, 35 USPQ2d 1638 (Comm'r Pats. 1995). If a filing date has been granted when the USPTO discovers that the applicant has not paid the filing fee for at least a single class, the filing date will be cancelled. See TMEP §204.01.

See TMEP §§202.03(a) and 405.06 regarding payments that are refused or charged back by financial institutions, and TMEP §405.03 regarding deposit accounts.

The filing fee for a §66(a) application will be sent to the USPTO by the IB, pursuant to Article 8 of the Madrid Protocol. Generally, the examining attorney should not require additional fees during examination, except where the application is divided due to a change in ownership with respect to some but not all of the goods/services. See TMEP §810 for further information about application filing fees, and TMEP §§1904 *et seq.* for further information about §66(a) applications.

#### **202.03(a) Fee Payment Refused or Charged Back By Financial Institution**

Where a check submitted as payment of an application filing fee is returned to the USPTO unpaid, or an EFT or credit card payment is refused or charged back by a financial institution, the application is treated as though the fee had never been paid.

If the original application was accompanied by an authorization to charge fee deficiencies to a deposit account (37 C.F.R. §2.208), then the application filing fee and the processing fee required by 37 C.F.R. §2.6(b)(12) (see TMEP §§202.03(a)(i) and 405.06) are charged to the deposit account, and the original filing date remains unchanged.

However, if the original application was not accompanied by an authorization to charge deficient fees to a deposit account that has sufficient funds to cover the fee, and the applicant has not paid the filing fee for at least one class of goods or services, the filing date is void and will be cancelled. *In re Paulsen*, 35 USPQ2d 1638 (Comm'r Pats. 1995).

In some cases, the applicant will have resubmitted the fee before the USPTO discovers that the payment was refused. In these cases, the USPTO will change the filing date to the date when the fee for a single class of goods or services was resubmitted.

In a multiple-class application, if the fee for at least a single class has been paid, but the payment of the filing fee for additional class(es) is refused, the filing date of the application is not affected. The applicant must: (1) resubmit the fee for the additional class(es), or delete the additional class(es); and (2) pay the processing fee required by 37 C.F.R. §2.6(b)(12). The applicant must pay the processing fee even if the applicant chooses to delete the additional class(es).

See TMEP §§202.03(a)(i) and 405.06 regarding payments refused by financial institutions, and TMEP §204.03 regarding the examining attorney's handling of applications that are erroneously granted a filing date.

#### **202.03(a)(i) Processing Fee for Payment Refused or Charged Back By Financial Institution**

There is a fee for processing any payment refused (including a check returned unpaid) or charged back by a financial institution. 37 C.F.R. §2.6(b)(12). See TMEP §405.06. However, this is not a filing date requirement. If an applicant resubmits the filing fee without paying the processing fee, the USPTO will give the application a filing date as of the date of resubmission, and the examining attorney will require submission of the processing fee during examination.

### **203 Review for Compliance With Minimum Requirements**

In applications under §66(a) of the Trademark Act, 15 U.S.C. §1141f(a), the IB will determine whether the application complies with §66(a) prior to sending the request for extension of protection of an international registration to the USPTO. See TMEP §§1904 *et seq.* for further information about §66(a) applications.

Applications under §1 or §44 of the Act are given a receipt date (see TMEP §303.01) and then reviewed for compliance with the minimum requirements for granting a filing date (see 37 C.F.R. §2.21(a) and TMEP §202 for a list of these requirements).

If the minimum requirements of 37 C.F.R. §2.21 have been met, the USPTO assigns a filing date as of the date of receipt in the USPTO. See TMEP §§401 *et seq.* regarding the processing of new applications that meet the minimum requirements for receipt of a filing date, and TMEP §§204 *et seq.* regarding the processing of applications that do not meet these minimum requirements.

The minimum requirements for receipt of a filing date under 37 C.F.R. §2.21(a) apply to all applications under §§1 and 44 of the Act, whether filed electronically or on paper. When an application is filed electronically, the TEAS system will not accept the transmission if the fields corresponding to the minimum filing requirements are not filled in. However, if the fields are

filled in with incomplete or inappropriate information, the TEAS system will accept the transmission, but the USPTO will deny the application a filing date upon review for compliance with minimum filing requirements. For example, if the services were identified as “miscellaneous services,” TEAS would accept the transmission, but the USPTO would not give the application a filing date (see TMEP §§202.02 and 1402.02).

## **204 Defective or Informal Applications**

If an application under §1 or §44 of the Trademark Act does not meet the minimum requirements for receipt of a filing date set forth in 37 C.F.R. §2.21(a) (see TMEP §202), the application is void. These applications are also referred to as “incomplete” or “informal.”

### **204.01 Filing Date Cancelled if Minimum Filing Requirements not Met**

Applications under §1 or §44 of the Trademark Act are initially assigned a filing date and serial number and then reviewed for compliance with the minimum requirements for receipt of a filing date set forth in 37 C.F.R. §2.21(a). If the minimum filing requirements have not been met, the USPTO cancels the filing date and serial number, refunds any filing fee submitted, and sends a notice to the applicant explaining why the application is defective.

See TMEP §204.02 regarding the procedures for requesting review of the denial of a filing date by the Office of the Deputy Commissioner for Trademark Examination Policy.

### **204.02 Resubmission of Applications**

The USPTO prefers that all applications be filed through TEAS. However, if the USPTO denies a filing date in a paper application, the applicant may resubmit the original papers or a copy of the original papers, together with the item(s) necessary to correct the defect(s), and a new filing fee. The applicant should cross off the cancelled serial number. *A filing fee for at least a single class of goods or services must be included when the applicant resubmits an application, even if the applicant has not yet received a refund of the fee previously submitted.*

The new filing date will be the date on which a complete application, including all elements required by 37 C.F.R. §2.21(a), is received in the USPTO. Note that applications claiming priority under §44(d) of the Trademark Act must meet all filing date requirements within six months of the filing date of the foreign application. 37 C.F.R. §2.34(a)(4)(i); TMEP §§806.01(c) and 1003.02.



If an applicant believes that the USPTO committed an error in denying the application a filing date, the applicant may submit a request to restore the filing date. See TMEP §1711. The USPTO prefers that the applicant file a new application, including the required application filing fee, using TEAS, located at <http://www.uspto.gov>. 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.” 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. Although applicants have two (2) months from the issuance date of a Notice of Incomplete Trademark Application to file a request to restore the original filing date (37 C.F.R. §2.146(d)), it is recommended that the applicant file the request immediately upon receipt of the new serial number, to expedite processing.

#### **204.03                    Examining Attorney’s Handling of Applications That Are Erroneously Accorded a Filing Date**

Sometimes an application under §1 or §44 that does not meet the minimum requirements of 37 C.F.R. §2.21 for receipt of a filing date is erroneously referred to an examining attorney for examination. In this situation, if the examining attorney discovers the error *before* issuing an action in the case, then the examining attorney should have the application declared informal. The USPTO will cancel the filing date and serial number, refund any filing fee submitted, and send a notice to the applicant explaining why the application is defective. See TMEP §204.01.

If, however, an examining attorney discovers *after* issuing an action that the application as filed did not meet the minimum requirements for receipt of a filing date, then the examining attorney must issue a supplemental Office action, refusing registration on the ground that the application was not eligible to receive a filing date. Any outstanding refusals and requirements must be maintained and incorporated into the supplemental Office action. The applicant should be given six months to comply with all filing date requirements. If the applicant fails to qualify for a filing date within the response period, the application is void. If a filing fee was submitted with the original application, the examining attorney must have the filing fee refunded and update the USPTO’s automated records to indicate that the application is abandoned.

If the applicant complies with the filing date requirements within six months of the issuance of the examining attorney's Office action, the application will receive a new filing date as of the date on which the applicant satisfied all minimum filing date requirements. In such a case, the examining attorney must conduct a new search of Office records for conflicting marks, and issue another Office action if necessary.

## **205 Filing Date Is Not Normally Changed**

After an application has been given a filing date, the USPTO will normally not vacate the filing date or physically alter the designation of the original filing date in the Trademark Reporting and Monitoring ("TRAM") System, except where the application as originally filed was erroneously accorded a filing date (see TMEP §204.03) or where the Office grants restoration of a filing date (see TMEP §§204.02 and 1711).

In an application under §1 or §44 of the Trademark Act, if the application met the minimum requirements for receipt of a filing date (see TMEP §202) when originally filed, but during examination it is discovered that the applicant did not have a right to apply on the assigned filing date (e.g., because the applicant did not own the mark), the application is *void*, because a valid application was not created. See TMEP §§803.06 and 1201.02(b). The USPTO will *not* refund the filing fee in such a case. If, subsequent to the assigned filing date, the applicant became eligible to apply, the applicant may file a new application (including a filing fee).

## **206 Effective Filing Date**

The filing date of an application (see TMEP §201) is also the *effective* filing date, *except* in the situations described in the subsections below. In these situations, the USPTO does not alter the original filing date in its automated records.

In the situations described below, because the effective filing date will likely be subsequent to the date on which the examining attorney searched USPTO records for conflicting marks, the examining attorney must conduct another search.

### **206.01 Amendment of §1(b) Application from Principal Register to Supplemental Register upon Filing of Allegation of Use**

An applicant relying on a bona fide intention to use the mark in commerce under 15 U.S.C. §1051(b) is not eligible for registration on the Supplemental Register until the applicant has submitted an acceptable amendment to allege use under 15 U.S.C. §1051(c) or statement of use under 15 U.S.C. §1051(d). 37 C.F.R. §§2.47(d) and 2.75(b).

If an application is based solely on §1(b), and the applicant files an acceptable amendment to allege use or statement of use *and* an acceptable amendment to the Supplemental Register, the USPTO will consider the filing date of the amendment to allege use or statement of use to be the effective filing date of the application. 37 C.F.R. §2.75(b). The examining attorney must conduct a new search of USPTO records for conflicting marks. See TMEP §206.04 regarding examining attorney's action after conducting a new search.

Amendment of an application from the Supplemental to the Principal Register does not change the effective filing date of an application. *Kraft Group LLC v. Harpole*, 90 USPQ2d 1837 (TTAB 2009) (filing date did not change when applicant who originally sought registration on the Supplemental Register without alleging use in commerce amended to seek registration on the Principal Register under §1(b)).

See TMEP §§816.02 and 1102.03 for additional information about examination of intent-to-use applications on the Supplemental Register.

## **206.02                    Application Claiming Priority under §44(d) or §67**

When an applicant is entitled to priority based on a foreign application, the effective filing date is the date on which the foreign application was first filed in the foreign country. The priority claim for the United States application must be filed within six months after the filing date of the foreign application. 15 U.S.C. §§1126(d)(1) and 1141g; 37 C.F.R. §§2.34(a)(4)(i) and 7.27(c); TMEP §§1003.02 and 1904.01(e).

In an application under §44(d) of the Trademark Act, the applicant can submit a priority claim after the filing date of the United States application if: (1) the applicant submits the priority claim within the six-month priority period (37 C.F.R. §2.35(b)(5)); and (2) the applicant was entitled to priority on the filing date of the United States application. If the priority claim is submitted after the examining attorney has conducted a search of USPTO records for conflicting marks, he or she must conduct a new search.

In an application under §66(a) of the Act, the priority claim must be set forth in the international application or subsequent designation filed with the IB. The priority claim will be part of the request for extension of protection sent to the USPTO by the IB. See TMEP §1904.01(e).

## **206.03                    Applications Filed Before November 16, 1989, That Are Amended to the Supplemental Register on or After November 16, 1989**

In an application filed before November 16, 1989, the date of the amendment to the Supplemental Register becomes the effective filing date of the application if: (1) the applicant had not used the mark in commerce for one

year before the application filing date; and (2) the applicant amends to the Supplemental Register on or after November 16, 1989. See TMEP §816.02.

#### **206.04                    Examining Attorney's Action After Conducting New Search**

When the effective filing date changes to a later date, the examining attorney must conduct a new search of USPTO records for conflicting marks. If the search shows that because of the new, later effective filing date, there is a later-filed conflicting application that now has an earlier filing date, the examining attorney must suspend action of the subject application pending disposition of the other application, if the application is otherwise in condition for suspension. See TMEP §§1208 *et seq.* regarding the procedures for handling conflicting marks in pending applications. If the examining attorney is handling a later-filed application that has been suspended pending disposition of the subject application, the examining attorney must withdraw the application from suspension and either approve it for publication or take action on any other outstanding issues. If a later-filed conflicting application is being handled by a different examining attorney, the examining attorney should contact the other examining attorney to notify him or her of the change in the effective filing date of the subject application.