

# **Chapter 1600**

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1613.18(a) Response to Examiner's Refusal Required Before Petition

1613.18(b) Decision on Petition Is Final Action of the USPTO

1613.18(c) Request for Reconsideration of Denial of Petition

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### **1601.01 Registrations Now Being Issued**

Currently, the United States Patent and Trademark Office ("USPTO") issues registrations only under the Trademark Act of 1946, 15 U.S.C. §§1051 *et seq.* These are either Principal Register registrations or Supplemental Register registrations. See TMEP §801.02(a) regarding the Principal Register, and TMEP §801.02(b) regarding the Supplemental Register.

#### **1601.01(a) Certificate of Registration**

The USPTO issues registration certificates for all registrations resulting from applications based on §§1, 44, and 66(a) of the Trademark Act, 15 U.S.C. §§1051, 1126, and 1141f(a). The registration certificate includes the owner's name and address, the mark, the goods/services, and the international class(es). The certificate is signed by the Director and issued under the seal of the USPTO. 15 U.S.C. §§1057(a) and 1093; 37 C.F.R. §2.151. See *Notice of Reformatted Trademark Registration Certificate* at [74 Fed. Reg. 34559](#) (July 16, 2009).

#### **1601.01(b) Duplicate Certificate of Registration**

If the owner of the registration does not receive the original certificate of registration, or a corrected, amended, or new certificate of registration issued by the USPTO, the USPTO will issue a duplicate certificate if the owner files a

written request within one year of issuance, stating that the certificate was never received.

Any request for a duplicate registration certificate should be faxed to the Post Registration Section at (571) 273-9500.

The owner of a registration may obtain a certified copy of the registration from the Document Services Branch of the Public Records Division of the USPTO for a fee (see TMEP §111).

#### **1601.01(c) Registered Extension of Protection of International Registration to the United States**

Effective November 2, 2003, §66(a) of the Trademark Act, 15 U.S.C. §1141f(a), permits the holder of an international registration to file a request for extension of protection of the international registration to the United States. See TMEP §§1904 *et seq.*

Unless the request for extension of protection is refused under §68 of the Trademark Act, 15 U.S.C. §1141h, the USPTO will issue a certificate of extension of protection and publish notice of such certificate in the *Official Gazette*. Section 69(a) of the Trademark Act, 15 U.S.C. §1141i(a). The certificate of registration will look the same as the certificates issued for registrations resulting from applications based on §§1 and 44 of the Act. From the date of issuance of the certificate, the extension of protection has the same effect and validity as a registration on the Principal Register, and the holder of the international registration has the same rights and remedies as the owner of a registration on the Principal Register. Section 69(b) of the Trademark Act, 15 U.S.C. §1141i(b).

Under §66(b), 15 U.S.C. §1141f(b), unless the extension of protection is refused, the proper filing of the request for extension of protection constitutes constructive use of the mark, conferring the same rights as those specified in §7(c) of the Trademark Act, 15 U.S.C. §1057(c), as of the earliest of the following:

- (1) The international registration date, if the request for extension of protection was made in the international application;
- (2) The date of recordal of the subsequent designation requesting an extension of protection to the United States, if the request for extension of protection to the United States was made in a subsequent designation; or
- (3) The date of priority claimed pursuant to §67 of the Trademark Act, 15 U.S.C. §1141g.

Upon registration, the USPTO will refer to an extension of protection to the United States as a “registration” or a “registered extension of protection.” 37 C.F.R. §7.25(c).

A registered extension of protection remains part of the international registration after registration in the United States. See 15 U.S.C. §1141j, 37 C.F.R. §7.30, and TMEP §1904.08 for information about the dependence of the extension of protection on the underlying international registration. In this respect, the registered extension of protection differs from a registration issuing from a §44 application, which exists independent of the underlying foreign registration, pursuant to §44(f), 15 U.S.C. §1126(f).

See TMEP §1609.01(a) regarding amendment of registered extensions of protection under §7 of the Trademark Act, 15 U.S.C. §1057.

## **1601.02                    Repeal of Prior Acts**

The Act of 1946 became effective on July 5, 1947. Most Acts relating to trademarks that existed prior to the Act of 1946 were repealed as of the effective date of the Act of 1946. Repealed Acts include the Act of 1881, the Act of 1905, the Act of 1920, and the amendment entitled “Act of June 10, 1938.” The repeal did not affect the validity of registrations granted under prior Acts. Trademark Act §46(a), 15 U.S.C. §1051 note.

## **1601.03                    Additional Registration under Act of 1946**

Marks that were registered under any previous Act may be registered again, under the Act of 1946, if the mark meets the requirements of the Act of 1946. Trademark Act §46(b), 15 U.S.C. §1051 note.

However, the USPTO will not issue duplicate registrations for marks that are registered under the 1946 Act. §2.48. See TMEP §703.

## **1601.04                    1881 and 1905 Act Registrations**

Registrations that were issued under the Acts of 1881 and 1905 may be renewed under §9 of the Act of 1946, 15 U.S.C. §1059. These registrations are subject to, and entitled to the benefits of, the provisions of the Act of 1946 as though registered on the Principal Register of the Act, except with certain limitations that are set out in §46(b), 15 U.S.C. §1051 note. Some of these limitations can be removed if the registrant claims the benefits of the Act of 1946 under §12(c), 15 U.S.C. §1062(c). See TMEP §1603.

Marks registered under the “10-year proviso” of §5 of the Act of 1905 are deemed to have become distinctive of the goods or services under §2(f) of the Act of 1946, 15 U.S.C. §1052(f). Trademark Act §46(b), 15 U.S.C. §1051 note.

See TMEP §1602.02 regarding the duration of and requirements for maintaining registrations issued under the Acts of 1881 and 1905.

#### **1601.05                    1920 Act Registrations**

Registrations under the Act of 1920 are subject to, and entitled to the benefits of, the provisions of the Act of 1946 relating to marks registered on the Supplemental Register, and may not be renewed, unless renewal is required to support a foreign registration. Trademark Act §46(b), 15 U.S.C. §1051 note.

See TMEP §1602.03 regarding the duration of and requirements for maintaining registrations issued under the Act of 1920.

#### **1601.06                    Registrations Issued Under Prior Classification Systems**

Prior to September 1, 1973, the United States used its own system for the classification of goods and services, which is different from the international classification system. For all registrations issued on the basis of an application filed on or before August 31, 1973, the classification under which the registration issued governs for all statutory purposes, including affidavits under §8, 15 U.S.C. §1058, and renewal applications under §9, 15 U.S.C. §1059. See 37 C.F.R. §§2.85(b) and 2.183(f).

As of September 1, 1973, the international system for classification of goods and services is the primary classification system used by the United States, and it applies to all applications filed on or after September 1, 1973, and their resulting registrations, for all statutory purposes. See TMEP §1401.02; 37 C.F.R. §2.85(a).

A registrant whose registration issued under the United States classification system may voluntarily amend the registration under §7 of the Trademark Act, 15 U.S.C. §1057, to adopt the international classification set forth in the current version of the *Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks* ("Nice Agreement"). The registrant must pay the filing fee required for §7 amendments under 37 C.F.R. §2.6. See 37 C.F.R. §2.84(e)(3) and TMEP §1609.04.

#### **1601.07                    Form of Copies of Registrations**

Before August 24, 1920, the name of the Act under which a registration was issued was not designated on the copy of the registration on file in the Trademark Search Library. Beginning with registrations issued on August 24, 1920, each registration includes in the heading either the words "Act of Feb. 20, 1905" or the words "Act of Mar. 19, 1920." The first registrations under the Act of 1920 apparently were issued on August 24, 1920.

Registrations under the Act of 1881 range from Number 8,191, issued on May 17, 1881, through Number 44,357, issued on March 28, 1905. No registrations were issued between March 28, 1905, and July 4, 1905. On July 4, 1905, the first registration under the Act of 1905 was issued as Number 44,358.

The Act of 1946 provides that the certificates of registration for marks registered on the Supplemental Register shall be conspicuously different from certificates issued for marks registered on the Principal Register. Trademark Act §25, 15 U.S.C. §1093. Certificates issued under the 1946 Act are clearly marked either “Principal Register” or “Supplemental Register,” with the date the application was filed.

## **1602                      Duration and Maintenance of Registrations**

The Trademark Act of 1946, 15 U.S.C. §§1051 *et seq.*, became effective on July 5, 1947, and as of that date the Trademark Acts of 1881, 1905, and 1920 were repealed insofar as they were inconsistent with the Act of 1946. Trademark Act §46(a), 15 U.S.C. §1051 note.

The duration of registrations has varied, depending upon the Act under which the registration was issued. See TMEP §§1602.01, 1602.02, 1602.03, and 1614.

### **1602.01                      Act of 1946**

#### *Registrations Resulting From Applications Under §§1 and 44*

The Trademark Law Revision Act of 1988, Pub. L. No. 100-667, 102 Stat. 3935, which took effect on November 16, 1989, amended §9 of the Trademark Act of 1946 to reduce both the duration of registration and the term of renewal from twenty to ten years. All registrations issued or renewed on or after November 16, 1989 are issued or renewed for a ten-year period.

Thus, registrations issued under the Act of 1946 on or after November 16, 1989, remain in force for ten years, provided that affidavits of use or excusable nonuse under §8 of the Act are filed. 37 C.F.R. §2.181(a)(2). See 37 C.F.R. §2.160(a) and TMEP §1604.04 regarding the due dates for affidavits of use or excusable nonuse. Registrations issued under the Act of 1946 before November 16, 1989 remain in force for twenty years, provided that an affidavit or declaration of use or excusable nonuse was filed during the sixth year after the date of registration. 37 C.F.R. §2.181(a)(1). See TMEP §§1604 *et seq.* regarding affidavits of use under §8 of the 1946 Act.

Effective November 16, 1989, registrations under the Act of 1946 may be renewed for periods of ten years from the end of the expiring period. 37 C.F.R. §2.181(a). Before November 16, 1989, registrations under the Act of 1946 were renewed for twenty-year periods. The applicable term for

renewals that were processed during the transition depends on whether the USPTO *granted renewal* before or after November 16, 1989. If the USPTO granted renewal before November 16, 1989, the renewal term is twenty years; if the USPTO granted renewal on or after November 16, 1989, the renewal term is ten years, regardless of the date on which the renewal application was filed. *In re Maytag Corp.*, 21 USPQ2d 1615 (Comm'r Pats. 1991). See TMEP §§1606 *et seq.* regarding renewal under §9 of the 1946 Act.

### *Registered Extensions of Protection*

Section 9 of the Trademark Act does not apply to registered extensions of protection of international registrations to the United States. Renewal of an international registration and its corresponding extension of protection to the United States must be made at the International Bureau of the World Intellectual Property Organization (“IB”), in accordance with Article 7 of the Madrid Protocol. 37 C.F.R. §7.41(a). See TMEP §1614 for further information about renewal of international registrations.

Section 71 of the Act, 15 U.S.C. §1141k, requires the periodic filing of affidavits of use in commerce or excusable nonuse for registered extensions of protection. See TMEP §1613 regarding due dates and requirements for §71 affidavits.

## **1602.02 Acts of 1881 and 1905**

Registrations under the Act of 1905 were issued for an original term of twenty years, and were renewable for twenty-year periods. Registrations under the Act of 1881 were issued for an original term of thirty years, and were renewable under the Act of 1905 for twenty-year periods.

Effective November 16, 1989, registrations issued under the 1905 Act and the 1881 Act are renewable under the 1946 Act for periods of ten years. Before November 16, 1989, registrations issued under the 1905 Act and the 1881 Act were renewable under the 1946 Act for periods of twenty years. Trademark Act §46(b), 15 U.S.C. §1051 note; 37 C.F.R. §2.181(b).

A registrant under the 1905 Act or the 1881 Act may file an affidavit or declaration under §12(c) of the Trademark Act, 15 U.S.C. §1062(c), to claim the benefits of the 1946 Act, without affecting the term of the registration. See TMEP §1603. Under §8(a)(1) of the 1946 Act, 15 U.S.C. §1058(a)(1), if the registrant claims the benefits of the 1946 Act, the registrant must file an affidavit or declaration of use or excusable nonuse within the sixth year after publication of the notice of the §12(c) claim in the *Official Gazette*, to avoid cancellation. See TMEP §§1604 *et seq.* regarding affidavits or declarations of use or excusable nonuse.

Section 8(a)(2) of the 1946 Act, 15 U.S.C. §1058(a)(2), requires that owners of marks registered under the Acts of 1905 and 1881 file affidavits of use or excusable nonuse at the end of each successive ten-year period following the date of registration, even if the registrant does not claim the benefits of the 1946 Act under §12(c) of the Act. However, this requirement does not apply to a registration renewed for a twenty-year term (i.e., a registration renewed prior to November 16, 1989) until a renewal application is due. See TMEP §1604.04(b).

### **1602.03            Act of 1920**

The Act of 1920 did not specify any term of registration. However, the Act of 1946 provided that 1920 Act registrations would expire six months after July 5, 1947 (the effective date of the 1946 Act), or twenty years from the date of registration, whichever was later. A 1920 Act registration may not be renewed, unless renewal is required to support a foreign registration. In that instance, the registration may be renewed on the Supplemental Register for a ten-year period, in the same manner as a registration issued under the 1946 Act. Trademark Act §46(b), 15 U.S.C. §1051 note; 37 C.F.R. §2.181(c). See TMEP §§1606 *et seq.* regarding renewal.

The requirement that renewal be necessary to support a foreign registration applies to all renewals of a 1920 Act registration, not just the first renewal. *Ex parte U.S. Steel Corp.*, 157 USPQ 435 (Comm'r Pats. 1968).

The application for renewal of a 1920 Act registration should identify the foreign registration(s) that the renewal is needed to support, the country, the name of the present owner, the registration number, and the date of registration, and must show that the foreign registration(s) is currently in force.

Under §8(a)(2) of the 1946 Act, 15 U.S.C. §1058(a)(2), an affidavit or declaration of use or excusable nonuse under §8 is also required at the end of each successive ten-year period following the date of registration. However, this requirement does not apply to a registration renewed for a twenty-year term (i.e., a registration renewed prior to November 16, 1989) until a renewal application is due. See TMEP §1604.04(b).

### **1602.04            Trademark Law Treaty Implementation Act Changes**

The Trademark Law Treaty Implementation Act of 1998 ("TLTIA"), Pub. L. No. 105-330, 112 Stat. 3064, changed the requirements for filing affidavits or declarations of use or excusable nonuse under 15 U.S.C. §1058 ("§8 affidavits"), and renewal applications under 15 U.S.C. §1059 ("§9 renewal applications"), effective October 30, 1999. See *Post Registration: Changes to Requirements for Maintaining Trademark Registrations*, at [1228 TMOG 187](#) (Nov. 30, 1999), for a discussion of these changes.

TLTIA did not change the duration of registrations. See TMEP §§1602 *et seq.* regarding the term of registrations.

### **1603 Bringing Prior Act Registrations Under 1946 Act, §12(c)**

Owners of marks registered under the Acts of 1905 or 1881 may claim the benefits of the Act of 1946, but are not required to do so. Trademark Act §12(c), 15 U.S.C. §1062(c). The 1946 Act refers to a “registrant” claiming the benefits of the Act. The term “registrant” includes both the original registrant and a person who has acquired ownership through proper transfer of title. See 15 U.S.C. §1127. The claim must be made by the person who owns the mark at the time the claim is made.

To claim the benefits of the Act of 1946, the owner of the registration must file an affidavit or a declaration under 37 C.F.R. §2.20. The affidavit or declaration must: (1) set forth those items listed in the registration on which the mark is currently in use in commerce; (2) state that the benefits of the Act of 1946 are claimed for the mark; (3) be accompanied by the fee required by 37 C.F.R. §2.6; and (4) be filed by the owner and signed by a person properly authorized to sign on behalf of the owner. 37 C.F.R. §2.153. No specimen is required. Goods or services not listed in the affidavit will be deleted from the registration. The affidavit or declaration under §12(c) of the Act may be filed at any time during the life of the registration.

A claim of the benefits of the 1946 Act does *not* affect or alter the *term* of the 1905 or 1881 Act registration. These registrations still remain in force for the times indicated in TMEP §1602.02, *subject to cancellation if acceptable affidavits of use or excusable nonuse are not filed under 15 U.S.C. §1058*. The deadline for *renewal* (and the affidavit of use or excusable nonuse required during the year before the end of every ten-year period after the date of the registration) is calculated from the date of issue of the registration, *not* from the date of publication of the notice of the registrant’s claim of the benefits of the 1946 Act.

#### **1603.01 Notification and Printing of Mark in *Official Gazette***

If the affidavit or declaration claiming the benefits of the Act of 1946 is acceptable, the mark and accompanying notice of the claim of benefits of the 1946 Act are printed in the *Official Gazette* under the heading “Registrations Published Under Sec. 12(c).” 37 C.F.R. §2.154. The USPTO notifies the registrant of the printing of the mark in the *Official Gazette*, and also informs the registrant of the requirement for filing affidavits of use or excusable nonuse under 15 U.S.C. §1058. 37 C.F.R. §2.155.

If an affidavit or declaration claiming the benefits of the Act of 1946 is unacceptable, the USPTO notifies the registrant of the defect.



These marks are not subject to opposition on their appearance in the *Official Gazette*. 37 C.F.R. §2.156.

### **1603.02 Cancellation and Incontestability**

If the benefits of the Act of 1946 are claimed, registrants under the Acts of 1905 and 1881 may subsequently file affidavits (or declarations) under §15 of the Act of 1946, 15 U.S.C. §1064, whereby the marks shall be incontestable. See TMEP §§1605 *et seq.*

Once the registrant claims the benefits of the Act of 1946, registrations under the 1905 and 1881 Acts are subject to cancellation under §14 of the Act of 1946, 15 U.S.C. §1064. See TMEP §1607.

### **1603.03 Affidavits of Use in Commerce Required**

After the benefits of the Act of 1946 are claimed for a registration issued under the Act of 1881 or the Act of 1905, the registrant must file an affidavit or declaration of use or excusable nonuse during the sixth year after the date of publication of the notice of the registrant's claim of the benefits of the 1946 Act in the *Official Gazette*, or within the six-month grace period after expiration of the sixth year, to avoid cancellation under §8(a)(1) and (a)(3) of the Act. 15 U.S.C. §§1058(a)(1) and (a)(3). An affidavit of use or excusable nonuse must also be filed within one year before the end of every ten-year period after the date of the registration, or within the six-month grace period thereafter. 15 U.S.C. §§1058(a)(2) and (a)(3). See TMEP §§1604 *et seq.* for further information about affidavits or declarations of use or excusable nonuse under 15 U.S.C. §1058.

### **1604 Affidavit of Use or Excusable Nonuse of Mark in Commerce under §8 of the Trademark Act**

15 U.S.C. §1058. *Duration, affidavits and fees.*

*(a) Time Periods for Required Affidavits. Each registration shall remain in force for 10 years, except that the registration of any mark shall be canceled by the Director unless the owner of the registration files in the United States Patent and Trademark Office affidavits that meet the requirements of subsection (b), within the following time periods:*

*(1) Within the 1-year period immediately preceding the expiration of 6 years following the date of registration under this Act or the date of the publication under section 12(c).*

*(2) Within the 1-year period immediately preceding the expiration of 10 years following the date of registration, and each successive 10-year period following the date of registration.*

*(3) The owner may file the affidavit required under this section within the 6-month grace period immediately following the expiration of the periods*

*established in paragraphs (1) and (2), together with the fee described in subsection (b) and the additional grace period surcharge prescribed by the Director.*

*(b) Requirements for Affidavit. The affidavit referred to in subsection (a) shall—*

*(1)(A) state that the mark is in use in commerce;*

*(B) set forth the goods and services recited in the registration on or in connection with which the mark is in use in commerce;*

*(C) be accompanied by such number of specimens or facsimiles showing current use of the mark in commerce as may be required by the Director; and*

*(D) be accompanied by the fee prescribed by the Director; or*

*(2)(A) set forth the goods and services recited in the registration on or in connection with which the mark is not in use in commerce;*

*(B) include a showing that any nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark; and*

*(C) be accompanied by the fee prescribed by the Director.*

*(c) Deficient Affidavit. If any submission filed within the period set forth in subsection (a) is deficient, including that the affidavit was not filed in the name of the owner of the registration, the deficiency may be corrected after the statutory time period, within the time prescribed after notification of the deficiency. Such submission shall be accompanied by the additional deficiency surcharge prescribed by the Director.*

*(d) Notice of Requirement. Special notice of the requirement for such affidavit shall be attached to each certificate of registration and notice of publication under section 12(c).*

*(e) Notification of Acceptance or Refusal. The Director shall notify any owner who files any affidavit required by this section of the Director's acceptance or refusal thereof and, in the case of a refusal, the reasons therefor.*

*(f) Designation of Resident for Service of Process and Notices. If the owner is not domiciled in the United States, the owner may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the last designated address, or if the owner does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, such notices or process may be served on the Director.*

Under 15 U.S.C. §1058, the owner of a registration must periodically file affidavits or declarations of use or excusable nonuse of the mark. The purpose of the affidavit or declaration of use or excusable nonuse (“§8 affidavit”) is to remove marks that are no longer being used in commerce from the register.

#### **1604.01                    Registrations to Which §8 Affidavit Pertains**

##### *Registered Extensions of Protection*

Section 8 of the Trademark Act applies only to registrations resulting from applications under §1 or §44 of the Trademark Act. However, §71 of the Act, 15 U.S.C. §1141k, requires periodic affidavits of use or excusable nonuse in registered extensions of protection of international registrations to the United States. See TMEP §§1613-1613.19 for further information about §71 affidavits.

##### *Six-Year Section 8 Affidavits for Registrations Resulting From Applications Under §1 or §44*

Under §§8(a)(1) and (a)(3) of the Trademark Act, an affidavit or declaration under §8 of the Act is required during the sixth year after the date of registration for registrations issued on either the Principal Register or the Supplemental Register or the date of publication under §12(c) for registrations issued under the Acts of 1881 and 1905 for which the owner has claimed the benefits of the Act of 1946 under §12(c), or within the six-month grace period after expiration of the sixth year. 15 U.S.C. §§1058(a)(1) and (a)(3); TMEP §1603.03.

##### *Ten-Year Section 8 Affidavits Required for All Registrations Resulting From Applications Under §1 or §44*

Section 8(a)(2) of the Trademark Act requires an affidavit or declaration of use or excusable nonuse at the end of each successive ten-year period following the date of registration, or within the six-month grace period after the end of the ten-year period. However, the provisions of §8(a)(2) of the Act, requiring the filing of a §8 affidavit at the end of each successive ten-year period after registration, do not apply to a registration issued or renewed for a twenty-year term until a renewal application is due. See TMEP §1604.04(b).

#### **1604.02                    Notice of When Affidavit Is Due**

A statement noting the requirement for filing the affidavits or declarations of use or excusable nonuse under §8 of the Act is included on each certificate of registration as originally issued. 15 U.S.C. §1058(d). This is the only notice that the USPTO provides regarding this requirement. The owner must file the affidavit or declaration within the time periods required by §8 of the Act

regardless of whether the owner receives the notice. 37 C.F.R. §2.162. The USPTO does not provide any reminder of the due date(s) of the affidavits.

### **1604.03 Form for Filing §8 Affidavit**

To expedite processing, it is recommended that the owner file the §8 affidavit through the Trademark Electronic Application System ("TEAS"). See TMEP §301 for more information about electronic filing. Forms for filing affidavits of use or excusable nonuse under §8, combined affidavits of use and incontestability under §§8 and 15 (see TMEP §1605.05), and §8 affidavits combined with renewal applications under §9 of the Act (see TMEP §1604.19) are available through TEAS at <http://www.uspto.gov>. Alternatively, the owner can call the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199 to obtain a pre-printed form that can be filled out and mailed, faxed, or hand delivered to the USPTO.

See TMEP §1604.04 regarding the deadline for filing the affidavit, and TMEP §1604.05 regarding the requirements for filing the affidavit.

### **1604.04 Time for Filing §8 Affidavit**

*37 C.F.R. §2.160(a). During the following time periods, the owner of the registration must file an affidavit or declaration of continued use or excusable nonuse, or the registration will be cancelled:*

*(1)(i) For registrations issued under the Trademark Act of 1946, on or after the fifth anniversary and no later than the sixth anniversary after the date of registration; or*

*(ii) For registrations issued under prior Acts, on or after the fifth anniversary and no later than the sixth anniversary after the date of publication under section 12(c) of the Act; and*

*(2) For all registrations, within the year before the end of every ten-year period after the date of registration.*

*(3) The affidavit or declaration may be filed within a grace period of six months after the end of the deadline set forth in paragraphs (a)(1) and (a)(2) of this section, with payment of the grace period surcharge per class required by section 8(a)(3) of the Act and § 2.6.*

Under §§8(a)(1) and (a)(2) of the Trademark Act, the owner of the registration must file an affidavit or declaration of use or excusable nonuse:

- (1) on or after the fifth anniversary and no later than the sixth anniversary of the date of registration or date of publication under §12(c) of the Act; and

- (2) within the year before the end of every ten-year period after the date of registration. 37 C.F.R. §2.160(a).

See TMEP §1604.04(b) regarding registrations in twenty-year terms.

Under §8(a)(3) of the Act, 15 U.S.C. §1058(a)(3), the owner may file the affidavit or declaration within a grace period of six months after the expiration of the deadlines set forth in §§8(a)(1) and (a)(2) of the Act, 15 U.S.C. §§1058(a)(1) and (a)(2), with an additional grace period surcharge.

Affidavits may be filed on the registration anniversary dates at the end of the fifth and sixth years, or at the end of the ninth and tenth years.

*Example:* For a registration issued on Nov. 1, 2005, a six-year affidavit may be filed as early as Nov. 1, 2010, and may be filed as late as Nov. 1, 2011, before entering the six-month grace period.

A §8 affidavit or declaration filed through TEAS is considered to have been filed on the date the USPTO receives the transmission, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. 37 C.F.R. §2.195(a)(2).

Section 8 affidavits or declarations filed on paper are considered timely if they are received in the USPTO by the due date or if they are mailed or transmitted by the due date with a certificate of mailing or facsimile transmission under 37 C.F.R. §2.197. See TMEP §§305.02 and 306.05 for certificate of mailing and certificate of facsimile transmission procedures to avoid lateness.

If the owner of the registration does not file an affidavit or declaration of use or excusable nonuse before the end of the grace period, the registration will be cancelled. 37 C.F.R. §§2.160(a) and 2.164(b). See TMEP §1604.07 regarding who may file a §8 affidavit.

The Director has no authority to waive the deadline for filing a proper affidavit of use of a registered mark under 15 U.S.C. §1058. See *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) ("[I]n establishing cancellation as the penalty for failure to file the required affidavit, Congress made no exception for the innocent or the negligent. Thus, the Commissioner had no discretion to do other than cancel Checkers's service mark registration in this case."); *In re Mother Tucker's Food Experience (Canada) Inc.*, 925 F.2d 1402, 1405, 17 USPQ2d 1795, 1798 (Fed. Cir. 1991) ("It was not within the Commissioner's discretionary authority to waive this requirement."); *cf. In re Holland American Wafer Co.*, 737 F.2d 1015, 1018, 222 USPQ 273, 275 (Fed. Cir. 1984) ("Timeliness set by statute is not a minor technical defect which can be waived by the Commissioner.").

#### **1604.04(a) Premature Filing of §8 Affidavit**

The affidavit cannot be filed before the periods specified in §8(a) of the Act. The purpose of the affidavit is to show that the mark is still in use in commerce within the relevant period, which cannot be done by an affidavit filed before that period. *Cf. In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984). If an affidavit is filed before the period specified in §§8(a)(1) and (a)(2) of the Act, the USPTO will issue a notice advising the owner: (1) that the affidavit is premature; (2) of the appropriate time for filing the affidavit; (3) that the fee(s) submitted will be held; and (4) that the owner may file a new affidavit at the appropriate time or may request a refund at any time. There is no deficiency surcharge. The prematurely filed affidavit will remain in the record for informational purposes only. The owner of the registration must file a newly executed affidavit or declaration before the end of the grace period, or the registration will be cancelled and the USPTO will refund the fees.

See TMEP §1604.08(b) regarding the date of execution of a §8 affidavit.

#### **1604.04(b) Registrations in Twenty-Year Terms**

As noted in TMEP §1604.04, §8(a)(2) of the Trademark Act, 15 U.S.C. §1058(a)(2), requires an affidavit or declaration of use or excusable nonuse at the end of each successive ten-year period following the date of registration for all registrations. However, this requirement does not apply to a registration issued or renewed for a twenty-year term (i.e., a registration issued or renewed before November 16, 1989) until a renewal application is due. See notice at [1228 TMOG 187](#), 189 (Nov. 30, 1999).

*Example:* If a registration was issued or renewed on November 15, 1989, no §8(a)(2) affidavit is due between November 15, 1998 and November 15, 1999. Section 8(a)(2) of the Act does not apply until the renewal application is due, i.e., between November 15, 2008 and November 15, 2009.

#### **1604.05 Requirements for §8 Affidavit or Declaration of Use or Excusable Nonuse**

*37 C.F.R. §2.161. Requirements for a complete affidavit or declaration of continued use or excusable nonuse*

*A complete affidavit or declaration under section 8 of the Act must:*

*(a) Be filed by the owner within the period set forth in § 2.160(a);*

*(b) Include a statement that is signed and verified (sworn to) or supported by a declaration under § 2.20 by a person properly authorized to sign on behalf of the owner under § 2.193(e)(1), attesting to the use or excusable nonuse of the mark within the period set forth in section 8 of the Act. The verified statement must be executed on or after the beginning of the filing period*

*specified in § 2.160(a).*

*(c) Include the registration number;*

*(d)(1) Include the fee required by § 2.6 for each class of goods or services that the affidavit or declaration covers;*

*(2) If the affidavit or declaration is filed during the grace period under section 8(a)(3) of the Act, include the grace period surcharge per class required by § 2.6;*

*(3) If at least one fee is submitted for a multi-class registration, but the class(es) to which the fee(s) should be applied are not specified, the Office will issue a notice requiring either the submission of additional fee(s) or an indication of the class(es) to which the original fee(s) should be applied. Additional fee(s) may be submitted if the requirements of § 2.164 are met. If the required fee(s) are not submitted and the class(es) to which the original fee(s) should be applied are not specified, the Office will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class;*

*(e)(1) Specify the goods or services for which the mark is in use in commerce, and/or the goods or services for which excusable nonuse is claimed under § 2.161(f)(2);*

*(2) If the affidavit or declaration covers less than all the goods or services, or less than all the classes in the registration, specify the goods or services being deleted from the registration;*

*(f)(1) State that the registered mark is in use in commerce on or in connection with the goods or services in the registration; or*

*(2) If the registered mark is not in use in commerce on or in connection with all the goods or services in the registration, set forth the date when use of the mark in commerce stopped and the approximate date when use is expected to resume; and recite facts to show that nonuse as to those goods or services is due to special circumstances that excuse the nonuse and is not due to an intention to abandon the mark;*

*(g) Include a specimen showing current use of the mark for each class of goods or services, unless excusable nonuse is claimed under § 2.161(f)(2). The specimen must:*

*(1) Show the mark as actually used on or in connection with the goods or in the sale or advertising of the services. A photocopy or other reproduction of the specimen showing the mark as actually used is acceptable. However, a photocopy that merely reproduces the registration certificate is not a proper specimen;*

*(2) Be flat and no larger than 8.5 inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long. If a specimen exceeds these size requirements (a "bulky specimen"), the Office will create a facsimile of the specimen that meets the requirements of the rule (i.e., is flat and no larger than 8.5 inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long) and put it in the record. In the absence of non-bulky alternatives, the Office may accept an audio or video cassette*

*tape recording, CD-ROM, or a specimen in another appropriate medium.*

*(3) Be a digitized image in .jpg or .pdf format, if transmitted through TEAS.*

## **1604.06 Fees for §8 Affidavit**

### **1604.06(a) Filing Fee for Affidavit or Declaration**

Under 15 U.S.C. §1058(b) and 37 C.F.R. §2.161(d)(1), an affidavit or declaration of use or excusable nonuse must include the fee required by 37 C.F.R. §2.6 for each class of goods or services that the affidavit or declaration covers. See TMEP §§1401.02, 1401.04 *et seq.*, and 1601.06 regarding use of international classification or prior United States classification to calculate fees due.

### **1604.06(b) Grace Period Surcharge and Deficiency Surcharge**

If the affidavit or declaration is filed during the grace period under §8(a)(3) of the Act, 15 U.S.C. §1058(a)(3), it must include the grace period surcharge per class required by 37 C.F.R. §2.6.

Section 8(c) of the Trademark Act, 15 U.S.C. §1058(c), requires a “deficiency surcharge” for correcting deficiencies in the affidavit or declaration after expiration of the deadlines specified in §8. See TMEP §§1604.17 *et seq.* regarding the deadlines and surcharge for correcting deficiencies.

Only a single deficiency surcharge is required for correcting one or more deficiencies in a multiple-class registration. Similarly, only a single deficiency surcharge is required to correct several deficiencies within one §8 affidavit or one combined filing under §§8 and 9. See TMEP §1604.19 regarding combined filings under §§8 and 9.

The grace period surcharge applies only where no filing was made during the sixth year after the date of registration (or date of publication under §12(c) of the Act), or within the year before the end of any ten-year period after the date of registration. An owner who files within these periods, but corrects a deficiency after these periods have expired, will be subject to the deficiency surcharge only. On the other hand, someone who files during the grace period and cures deficiencies after expiration of the grace period will be subject to both the grace period surcharge (for the ability to file the affidavit during the grace period) *and* the deficiency surcharge (for the ability to correct a deficiency after the end of the grace period). H.R. Rep. No. 105-194, 105<sup>th</sup> Congress, 1<sup>st</sup> Sess. 17 (1997).

### **1604.06(c) Processing Affidavit or Declaration Filed With Insufficient Fees**

An affidavit or declaration that does not include a fee, or does not include sufficient fees for all the classes to which the affidavit pertains (and the grace



period surcharge, where applicable), is deficient. Fee deficiencies may be cured before expiration of the deadlines set forth in §8 of the Act, 15 U.S.C. §1058, without payment of a deficiency surcharge, or after expiration of the deadlines set forth in §8 of the Act with the deficiency surcharge required by §8(c) of the Act. See TMEP §§1604.17 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

If the affidavit or declaration was filed without sufficient fee(s), but the affidavit or declaration included an authorization to charge deficient fees to a USPTO deposit account (37 C.F.R. §2.208), the required fee(s) (and grace period surcharge, where applicable) will be charged to the deposit account. If the deposit account authorization was included with the affidavit or declaration as filed, and the deposit account had sufficient funds to cover the fee(s) in question, there is no fee deficiency and no deficiency surcharge is required.

An authorization to charge fees to a deposit account with insufficient funds to cover the fee is regarded as a deficiency.

If a check submitted as payment of a filing fee for an affidavit of use or excusable nonuse is returned unpaid, or an electronic funds transfer (“EFT”) or credit card payment is refused or charged back by a financial institution, this is regarded as a deficiency. In addition to the deficiency surcharge (where applicable), there is a fee for processing the payment that was refused. 37 C.F.R. §2.6(b)(12). See TMEP §405.06 for additional information.

If at least one fee is submitted for a multiple-class registration, but the class(es) to which the fee(s) should be applied are not specified, the Post Registration staff will issue an Office action requiring either the submission of additional fee(s) or an indication of the class(es) to which the original fee(s) should be applied. If the owner does not submit the required fee(s) or specify the class(es) to which the original fee(s) should be applied, the USPTO will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class and will delete any unpaid class(es). 37 C.F.R. §2.161(d)(3). See TMEP §1608 regarding surrender of the registration as to class(es) that are omitted from a §8 affidavit.

## **1604.07                    Ownership and Who May File §8 Affidavit**

### **1604.07(a)              Affidavit or Declaration Must be Filed by Owner**

The affidavit or declaration of use or excusable nonuse must be filed by the owner of the registration. Filing by the owner is a minimum requirement that must be met before the expiration of the deadlines set forth in §8(a) of the Act, 15 U.S.C. §1058(a), (i.e., during the sixth year after the date of registration or publication under §12(c) of the Trademark Act, or within the year before the end of every ten-year period after the date of registration), or

within the six-month grace period after expiration of these deadlines. 37 C.F.R. §§2.160(a) and 2.161(a).

If it is unclear whether the party who filed the affidavit is the present owner, the Post Registration staff will issue an Office action requiring the party to establish its ownership. If the party who filed the affidavit was the owner of the registration at the time of filing, the owner may file evidence to establish ownership, even if the filing period set forth in §8 of the Act has expired. There is no deficiency, and no deficiency surcharge is required for providing evidence to establish ownership. See TMEP §1604.07(b).

If the affidavit or declaration was not filed in the name of the owner of the registration, and there is time remaining in the statutory filing period (which includes the grace period), the true owner may (1) submit, in response to an Office action, a correction of the name in the filing of record or (2) file a complete new affidavit or declaration, together with the filing fee per class required by 37 C.F.R. §2.6, and, if applicable, a specimen of use for each class. If a new affidavit or declaration is filed during the grace period, the owner must include the grace period surcharge per class with the new affidavit or declaration. If a correction is submitted, the owner must also confirm that the original affidavit was signed by a person properly authorized to sign on behalf of the true owner. 37 C.F.R. §2.193(e)(1); TMEP §1604.08(a). If the original affidavit was not signed by an authorized signatory, the owner must also submit a statement, signed and verified (sworn to) or supported by a declaration under 37 C.F.R. §2.20 by a person properly authorized to sign on behalf of the owner, that affirms the representations in the original affidavit. 37 C.F.R. §2.161(b).

If the affidavit or declaration was not filed in the name of the owner of the registration, and there is no time remaining in the grace period, the deficiency may be corrected within a prescribed time. 15 U.S.C. §1058(c). The Post Registration staff will issue an Office action notifying the party who filed the affidavit of the ownership issue and of the time period within which it must be corrected. The true owner may submit a correction to the filing of record within the prescribed time and must also include the deficiency surcharge. 37 C.F.R. §2.6(a)(20). If a correction is submitted, the owner must also verify that the original affidavit was signed by a person properly authorized to sign on behalf of the true owner. 37 C.F.R. §2.193(e)(1); TMEP §1604.08(a). If the original affidavit was not signed by an authorized signatory, the owner must also submit a statement, signed and verified (sworn to) or supported by a declaration under 37 C.F.R. §2.20 by a person properly authorized to sign on behalf of the owner, that affirms the representations in the original affidavit. 37 C.F.R. §2.161(b).

See *also* TMEP §1604.07(f) regarding mistakes in setting forth the name of the owner.

#### **1604.07(b) Establishing Ownership**

When the affidavit is filed by someone other than the original owner of the registration, the USPTO cannot accept the affidavit unless there is a clear chain of title from the original owner to the party who filed the affidavit. 37 C.F.R. §3.73(b); TMEP §502.01.

When the affidavit is filed, the Post Registration staff will check the records of the Assignment Services Branch of the USPTO, available at <http://assignments.uspto.gov/assignments>. If the records of the Assignment Services Branch show a clear chain of title in the party who filed the affidavit, no inquiry will be issued. The Post Registration staff will enter the change of ownership into the automated records of the Trademark Operation (i.e., the Trademark Reporting and Monitoring (“TRAM”) System and Trademark Applications and Registrations Retrieval (“TARR”) database), if necessary.

If the records of the Assignment Services Branch do not show a clear chain of title in the party who filed the affidavit, the Post Registration staff will issue an Office action requiring the party to establish its ownership of the registration. To establish ownership, the party must: (1) record documents in the Assignment Services Branch of the USPTO that show each change of ownership, and include a statement in the response to the Office action that the documents have been recorded; or (2) submit documentary evidence of a chain of title from the original owner to the party who filed the affidavit. 37 C.F.R. §3.73(b)(1); TMEP §502.01.

“Documentary evidence of a chain of title from the original owner to the assignee” (37 C.F.R. §3.73(b)(1)(i)) normally consists of the same type of documents that would be recorded in the Assignment Services Branch, e.g., assignment documents, certificates of merger, or certificates of change of name. In the alternative, an affidavit or declaration containing sufficient facts to support the transfer of title may be accepted.

The owner may submit evidence of ownership even if the filing period set forth in §8 of the Act has expired. If the party who filed the affidavit was the owner of the registration at the time of filing, there is no deficiency, and no deficiency surcharge is required for providing evidence to establish ownership.

See TMEP §1604.07(a) regarding an affidavit or declaration filed by a party who was not the owner of the registration at the time of filing.

#### **1604.07(c) Acceptance Notice Issued in Name of Owner of Record**

The notification of acceptance of a §8 affidavit is issued in the name of the owner of record, as shown in TRAM and TARR.

When a party other than the original owner files a §8 affidavit, the USPTO will accept the affidavit if the new owner submits documentary evidence of the chain of title (see TMEP §1604.07(b)), even if the new owner does not record the documents of ownership in the Assignment Services Branch. 37 C.F.R. §3.73. However, the USPTO will not issue the notice of acceptance of the §8 affidavit in the name of the new owner unless the new owner: (1) records the appropriate document in the Assignment Services Branch; and (2) notifies the Post Registration staff that the document has been recorded. 37 C.F.R. §3.85.

See TMEP §§504 *et seq.* regarding the circumstances in which the “Ownership” field in TRAM and TARR will be automatically updated after recordation of a document with the Assignment Services Branch, even if the new owner does not notify the Post Registration staff that the document has been recorded. See *also* TMEP §505.02 regarding requests to update ownership information after registration, TMEP §609.02(f) regarding correspondence after recordation of a change of ownership, TMEP §502.01 regarding establishing ownership of a registration, and TMEP §502.03 regarding issuance of a new certificate in the name of a new owner.

#### **1604.07(d) Changes of Legal Entity**

The procedures for establishing ownership, as discussed in TMEP §1604.07(b), also apply to changes of name and changes of legal entity. See TMEP §1604.07(e) regarding changes of name.

A change in the state of incorporation is a change of legal entity, creating a new party.

The death of a partner, or other change in the membership of a partnership, creates a change in legal entity unless the partnership agreement provides for continuation of the partnership and the relevant state law permits this.

A merger of companies into a new company normally constitutes a change of legal entity.

Affidavits may be accepted from trustees, executors, administrators, and the like, when supported by a court order or other evidence of the person’s authority to act on behalf of the present owner. If there is a court order, a copy of the order should be submitted.

#### **1604.07(e) Changes of Name**

A mere change of the name of a party is not a change of entity and will not require an inquiry regarding ownership, if there is clear title in the party who filed the §8 affidavit. Therefore, if the owner records a change of name with the Assignment Services Branch and subsequently files the §8 affidavit in its former name, the USPTO will not issue an inquiry regarding ownership.

However, if it is unclear from the records of the Assignment Services Branch whether the party who filed the affidavit is the owner of record, the owner must either record evidence of the change of name in the Assignment Services Branch or submit proof of the change of name. See 37 C.F.R. §3.73(b) and TMEP §1604.07(b). For a corporation, this is done by recording or submitting a certificate of change of name issued by the Secretary of State (or other authorized body) of the state of incorporation.

See TMEP §1604.07(c) regarding issuance of the notice of acceptance of the affidavit in the name of the new owner.

#### **1604.07(f)            Correction of Mistake in Setting Forth the Name of the Owner**

If the affidavit or declaration was filed by the owner of the registration, but there is a mistake in the manner in which the name of the owner is set out in the affidavit, the mistake can be corrected. *In re Atlanta Blue Print Co.*, 19 USPQ2d 1078 (Comm'r Pats. 1990). No deficiency surcharge is required in this situation.

See TMEP §1604.07(a) regarding an affidavit or declaration mistakenly filed in the name of a person or existing legal entity who did not own the mark as of the filing date.

See TMEP §1201.02(c) for examples of correctable and non-correctable errors.

#### **1604.08            Execution of Affidavit or Declaration**

##### **1604.08(a)           Persons Who May Sign Affidavit or Declaration**

Under 37 C.F.R. §2.161(b), the §8 affidavit or declaration must include a statement that is signed and verified (sworn to) or supported by a declaration under 37 C.F.R. §2.20 by a person properly authorized to sign on behalf of the owner. A “person who is properly authorized to sign on behalf of the owner” is: (1) a person with legal authority to bind the owner; (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or (3) an attorney as defined in 37 C.F.R. §11.1 who has an actual written or verbal power of attorney or an implied power of attorney from the owner. 37 C.F.R. §2.193(e)(1).

Generally, the USPTO does not question the authority of the person who signs a verification unless there is an inconsistency in the record as to the signatory’s authority to sign. See TMEP §611.03(a).

#### **1604.08(b) Date of Execution of Affidavit or Declaration**

Under 37 C.F.R. §2.161(b), the verified statement must be executed on or after the beginning of the relevant filing period specified in §8 of the Act, 15 U.S.C. §1058, (i.e., on or after the fifth anniversary of the date of registration or publication under §12(c), on or after the beginning of the one-year period before the end of each ten-year period after the date of registration, or during the available grace period). Because the purpose of the affidavit is to attest to the use or excusable nonuse of the mark within the time periods specified in §8 of the Act, the affidavit cannot be executed before these time periods begin.

An affidavit filed within the period specified in §8 of the Act, but executed before that period, is deficient. The owner of the registration will be required to submit a substitute or supplemental affidavit or declaration attesting to use in commerce (or excusable nonuse) on or in connection with the goods or services within the relevant period specified in §8 of the Act.

If the prematurely executed §8 affidavit was filed during the relevant period specified in §8(a) of the Act (i.e., during the sixth year after the date of registration or publication under §12(c) of the Trademark Act, or within one year before the end of any ten-year period after the date of registration), the substitute affidavit may be filed before expiration of the relevant period for no fee, or after expiration of the relevant period with the deficiency surcharge required under §8(c) of the Act. If the prematurely executed §8 affidavit was filed during the grace period, the substitute affidavit may be filed before expiration of the grace period for no fee, or after expiration of the grace period with the deficiency surcharge. See TMEP §1604.04 regarding the deadlines for filing §8 affidavits, and TMEP §§1604.17 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

*Date of Execution Omitted.* If the §8 affidavit is signed, but the date of execution is omitted, the Post Registration staff must require that the owner of the registration set forth the date of execution for the record. If the affidavit was executed within the relevant filing period, no deficiency fee is required. If there are no other outstanding issues, the owner may provide the Post Registration staff with the date by telephone or e-mail and the Post Registration staff must make a note in the “Notes-to-the-File” section of the record. If the affidavit was not executed within the relevant filing period, the affidavit is deficient, and the owner must submit a substitute or supplemental affidavit, as discussed above.

#### **1604.08(c) Signature of Electronically Transmitted Affidavit or Declaration**

See 37 C.F.R. §2.193(c) and TMEP §611.01(c) regarding signature of an affidavit or declaration filed through TEAS.

#### **1604.08(d) Form and Wording of Verification**

The format of the verification may be: (1) the classical form for verifying, which includes an oath (jurat) (see TMEP §804.01(a)); or (2) a declaration under 37 C.F.R. §2.20 or 28 U.S.C. §1746 instead of an oath (see TMEP §804.01(b)).

#### **1604.09 Goods and/or Services Set Forth in §8 Affidavit or Declaration**

##### **1604.09(a) Goods and/or Services Must be Specified or Expressly Incorporated by Reference**

Under 15 U.S.C. §1058(b) and 37 C.F.R. §2.161(e)(1), the affidavit or declaration must specify the goods/services recited in the registration on or in connection with which the mark is in use in commerce, and/or the goods/services for which excusable nonuse is claimed. See TMEP §1604.10 regarding use in commerce, and TMEP §1604.11 regarding excusable nonuse. The affidavit or declaration may incorporate by reference the identification set forth in the registration certificate (e.g., “all goods/services listed in the registration” or “all goods/services listed in the registration except... [specifying the goods/services not covered by the affidavit or declaration]”). Incorporation by reference is recommended, to avoid inadvertent omissions.

If the owner is alleging use with respect to some of the goods/services and excusable nonuse for other goods/services, the owner must clearly indicate which goods/services are in use and which goods/services are not in use.

##### **1604.09(b) Deletion of Goods and/or Services**

If the owner of the registration intends to delete goods/services from the registration, this should be expressly stated in the affidavit or declaration. 37 C.F.R. §2.161(e)(2). Once an owner expressly indicates an intention to delete goods, services, or classes from a registration, they may not be reinserted. For example, reinsertion is prohibited after the owner submits a TEAS §8 form indicating that certain goods, services, or classes are to be deleted, as the form states that the filing does not cover the deleted goods, services, or classes and that they are to be permanently deleted from the registration.

##### **1604.09(c) Failure to List All Goods and/or Services Recited in Registration**

An affidavit or declaration that fails to list or incorporate by reference all the goods/services recited in the registration, and does not include a statement of intent to delete the omitted goods/services, is deficient. The Post Registration

staff will issue an Office action requiring the party to either file a substitute or supplemental affidavit or declaration that the mark was in use in commerce on or in connection with the omitted goods/services or state that the omitted goods/services should be deleted.

If the owner files a substitute or supplemental affidavit or declaration adding the omitted goods/services, the owner must verify that the mark was in use in commerce on or in connection with the goods/services during the relevant filing period specified in §8 of the Act, 15 U.S.C. §1058. This substitute affidavit may be filed before expiration of the relevant deadline set forth in §8 of the Act for no fee, or after expiration of the deadline set forth in §8 of the Act with the deficiency surcharge required by §8(c) of the Act. See TMEP §§1604.17 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

If the owner does not file a substitute or supplemental affidavit or declaration that the mark was in use in commerce on or in connection with the omitted goods/services within the period for response to the Office action (see TMEP §1604.16), the omitted goods/services will be deleted from the registration.

#### **1604.09(d) New Goods and/or Services Cannot be Added**

Goods and/or services that are not listed in the registration may not be set forth in the §8 affidavit.

#### **1604.10 Use in Commerce**

The §8 affidavit must state that the mark is in use in commerce on or in connection with the goods and/or services listed in the registration, unless excusable nonuse is claimed. 37 C.F.R. §2.161(f)(1). See TMEP §1604.11 regarding excusable nonuse. The §8 affidavit does not have to specify the type of commerce (e.g., interstate) in which the mark is used. The USPTO presumes that someone who states that the mark is in use in commerce is stating that the mark is in use in a type of commerce that Congress can regulate, unless there is contradictory evidence in the record.

A §8 affidavit that does not state that the mark is in use in commerce is deficient. The owner must submit a substitute affidavit or declaration stating that the mark was in use in commerce on or in connection with the goods and/or services listed in the registration during the relevant period specified in §8 of the Trademark Act, 15 U.S.C. §1058, as follows:

- (1) If the §8 affidavit was filed during the sixth year after the date of registration or publication under §12(c) of the Act, the substitute affidavit must state that the mark was in use in commerce on or in connection with the goods/services before the expiration of the sixth year after the date of registration or publication under §12(c), if accurate; or



- (2) If the §8 affidavit was filed within one year before the end of any ten-year period after the date of registration, the substitute affidavit must state that the mark was in use in commerce on or in connection with the goods/services within one year before the end of the ten-year period after the date of registration, if accurate; or
- (3) If the §8 affidavit was filed during the grace period, the substitute affidavit must state that the mark was in use in commerce on or in connection with the goods/services before the expiration of the grace period, if accurate.

If the §8 affidavit was filed during the relevant period specified in §8(a) of the Act (i.e., during the sixth year after the date of registration or publication under §12(c) of the Act, or within one year before the end of any ten-year period after the date of registration), the substitute affidavit may be filed before expiration of the relevant period for no fee, or after expiration of the relevant period with the deficiency surcharge required under §8(c) of the Act. If the §8 affidavit was filed during the grace period, the substitute affidavit may be filed before expiration of the grace period for no fee, or after expiration of the grace period with the deficiency surcharge. See TMEP §1604.04 regarding the deadlines for filing §8 affidavits, and TMEP §§1604.17 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

While a substitute affidavit may be filed after the expiration of the period specified in §8 of the Act, the substitute affidavit must attest to use within the time period specified in §8 of the Act. Therefore, if the substitute affidavit does not state that the mark was in use in commerce on or in connection with the goods/services within the relevant period specified in §8 of the Act, the USPTO will not accept the §8 affidavit, and the registration will be cancelled.

#### **1604.11 “Excusable Nonuse” of Mark**

*Extract from 37 C.F.R. §2.161. A complete affidavit or declaration under section 8 of the Act must:*

*. . .*

*(f) . . .*

*(2) If the registered mark is not in use in commerce on or in connection with all the goods or services in the registration, set forth the date when use of the mark in commerce stopped and the approximate date when use is expected to resume; and recite facts to show that nonuse as to those goods or services is due to special circumstances that excuse the nonuse and is not due to an intention to abandon the mark[.]*

The purpose of Section 8 of the Trademark Act is to remove from the register those registrations that have become deadwood. See *Morehouse Mfg. Corp.*

*v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (C.C.P.A. 1969). It is not intended, however, to cancel registrations because of a temporary interruption in the use of the mark due to circumstances beyond the control of the owner of the registration. *In re Moorman Mfg. Co.*, 203 USPQ 712 (Comm'r Pats. 1979). Thus, if the mark is not in use in commerce but the owner believes the registration should not be cancelled, the owner may file an affidavit or declaration showing that nonuse is due to special circumstances that excuse the nonuse, and is not due to any intention to abandon the mark. 15 U.S.C. §1058(b)(2). *Ex parte Kelley-How-Thomson Co.*, 118 USPQ 40 (Comm'r Pats. 1958).

#### *Requirements for Affidavit*

Since "showing" implies proof, merely stating that special circumstances exist and there is no intention to abandon the mark is not sufficient. *In re Conusa Corp.*, 32 USPQ2d 1857 (Comm'r Pats. 1993); *In re Moorman Mfg. Co.*, *supra*; *Ex parte Astra Pharmaceutical Products, Inc.*, 118 USPQ 368 (Comm'r Pats. 1958); *Ex parte Denver Chemical Mfg. Co.*, 118 USPQ 106 (Comm'r Pats. 1958). The affidavit must state when use in commerce stopped and give the approximate date when use is expected to resume. 37 C.F.R. §2.161(f)(2). It should also specify the reason for nonuse, the specific steps being taken to put the mark back in use, and any other relevant facts.

Sufficient facts must be set forth to demonstrate clearly that nonuse is due to some special circumstance beyond the owner's control or "forced by outside causes." *In re Conusa Corp.*, *supra*; *In re Moorman Mfg. Co.*, *supra*; *Ex parte Kelley-How-Thomson Co.*, *supra*.

The goods/services for which excusable nonuse is claimed must be specified. See TMEP §§1604.09 *et seq.* regarding proper specification of the goods and services.

In a multiple-class registration, there must be a recitation of facts as to nonuse for each class to which the affidavit pertains, or it must be clear that the facts recited apply to all the classes.

#### *Presumption of Abandonment*

If the mark has not been in use for three consecutive years and the owner has done nothing to try to resume use of the mark, the Office may presume that the owner has abandoned the mark. 15 U.S.C. §1127. See *Imperial Tobacco Ltd. v. Phillip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990); *Stromgren Supports Inc. v. Bike Athletic Co.*, 43 USPQ2d 1100 (TTAB 1997).

#### *Examples of Special Circumstances That Do and Do Not Excuse Nonuse*

In addition to a showing that there is no intention to abandon the mark, the owner must show that nonuse is due to special circumstances beyond the

owner's control that excuse nonuse. The following examples provide general guidelines as to what is considered to be a special circumstance that excuses nonuse:

- *Business Decision.* Nonuse related to a business decision is not beyond the owner's control and does not excuse nonuse.
- *Decreased Demand.* Decreased demand for the product sold under the mark, resulting in its discontinuance for an indefinite period, does not excuse nonuse. The purpose of the affidavit requirement is to eliminate registrations of marks that are in nonuse due to ordinary changes in social or economic conditions. See *In re Conusa Corp.*, *supra*; *In re Parmalat S.p.A.*, 32 USPQ2d 1860 (Comm'r Pats. 1991); *Ex parte Astra Pharmaceutical Products, Inc.*, *supra*; *Ex parte Denver Chemical Mfg. Co.*, *supra*.
- *Trade Embargo or Other Circumstance Beyond Owner's Control.* Nonuse may be considered excusable where the owner of the registration is willing and able to continue use of the mark in commerce, but is unable to do so due to a trade embargo.
- *Sale of a Business.* Temporary nonuse due to the sale of a business might be considered excusable.
- *Retooling.* The mark might be out of use temporarily because of an interruption of production for retooling of a plant or equipment, with production possible again at a scheduled time. However, nonuse due to retooling is excusable only if the owner shows that the plant or equipment being retooled was essential to the production of the goods and that alternative equipment was unavailable on the market. *In re New England Mutual Life Insurance Co.*, 33 USPQ2d 1532 (Comm'r Pats. 1991).
- *Orders on Hand.* If the product is of a type that cannot be produced quickly or in large numbers (e.g., airplanes), yet there are orders on hand and activity toward filling them, nonuse might be considered excusable.
- *Illness, Fire, and Other Catastrophes.* Illness, fire, and other catastrophes may create situations of temporary nonuse, with the owner being able to outline arrangements and plans for resumption of use. Such nonuse is often excusable. However, a mere statement that the owner is ill and cannot conduct his or her business will not in itself excuse nonuse; the owner must show that the business is an operation that could not continue without his or her presence. *New England Mutual Life Insurance*, *supra*.

- *Negotiations with Distributors.* A recitation of efforts to negotiate agreements that would allow for resumption of use of the mark, or a statement that samples of the goods have been shipped to potential distributors, may establish lack of intention to abandon the mark, but does not establish the existence of special circumstances that excuse the nonuse. *In re Parmalat, supra; In re Moorman, supra.*
- *Use in Foreign Country.* Use of the mark in a foreign country has no bearing on excusable nonuse of a mark in commerce that can be regulated by the United States Congress. *In re Conusa, supra.*
- *Use of Mark on Different Goods/Services.* Use of the mark on goods/services other than those recited in the registration does not establish either special circumstances or lack of intention to abandon the mark. *Ex parte Kelley-How-Thomson Co., supra.*
- *Use of Mark in Another Form.* Use of a mark as an essential part of a materially different composite mark does not excuse the failure to use the mark at issue. *In re Continental Distilling Corp., 254 F.2d 139, 117 USPQ 300 (C.C.P.A. 1958).*

#### *Supplementary Evidence or Explanation of Nonuse*

If the USPTO determines that the facts set forth do not establish excusable nonuse, the owner may file supplementary evidence or explanation, within the response period set forth in the Office action. If the affidavit included a claim of excusable nonuse when filed, no deficiency surcharge will be required for supplementing this claim with additional evidence or an explanation.

#### *Substitute Affidavit Claiming Use*

If the owner responds to the Office action by submitting a substitute affidavit with a claim of use, the USPTO will examine the substitute use affidavit.

### **1604.12 Specimen Showing Current Use of Mark in Commerce**

#### **1604.12(a) Specimen for Each Class Required**

A §8 affidavit must include a specimen or facsimile showing current use of the mark for each class of goods or services, unless excusable nonuse is claimed. 15 U.S.C. §1058(b); 37 C.F.R. §2.161(g).

See TMEP §§904.03 *et seq.* regarding trademark specimens, and TMEP §§1301.04 *et seq.* regarding service mark specimens.

The specimen must show use of essentially the same mark as the mark shown in the registration, and must be used on or in connection with the goods/services listed in the registration. A specimen that shows use of a materially different mark (see TMEP §1604.13), or shows use of the mark on

other goods or services, is unacceptable. An affidavit or declaration that does not include an acceptable specimen for each class of goods/services is deficient. See 37 C.F.R. §2.161(g).

If a single specimen supports multiple classes, the owner may so indicate, and the Post Registration staff need not require multiple copies of the specimen. The Post Registration staff should make a note in the “Notes-to-the-File” section of the record indicating which classes the specimen supports.

Under 37 C.F.R. §2.161(g)(2), the specimen must be flat and no larger than 8½ inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long. If a specimen exceeds these size requirements, the USPTO will create a facsimile of the specimen that meets the requirements of the rule (i.e., is flat and no larger than 8½ inches wide by 11.69 inches long), put it in the record, and destroy the original bulky specimen. If the copy of the specimen created by the USPTO does not adequately depict the mark, the Post Registration staff will require a substitute specimen that meets the size requirements of the rule, and an affidavit or declaration verifying the use of the substitute specimen.

If the specimen is otherwise deficient, the Post Registration staff will require a substitute specimen, together with an affidavit or declaration that the substitute specimen was in use in commerce on or in connection with the goods or services during the relevant period specified in §8 of the Act. See 37 C.F.R. §2.164; see *also* TMEP §1604.12(c) regarding substitute specimens.

The USPTO will not return specimens filed with a §8 affidavit or declaration.

#### **1604.12(b) Specimens in Electronically Filed Affidavits**

If the owner files the §8 affidavit through TEAS, the owner must submit a digitized image in .jpg or .pdf format. 37 C.F.R. §2.161(g)(3).

Sometimes, no visible specimen is in the record due to a technical problem during submission of the affidavit. In this situation, the Post Registration staff should first send an e-mail to the TEAS mailbox to ask whether the problem can be fixed by uploading the file again. If it cannot, the Post Registration staff must ask the owner to submit: (1) the specimen (or a facsimile of the specimen) that was attached to the original electronically filed affidavit; and (2) a statement by the person who transmitted the affidavit to the USPTO that the specimen being submitted is a true copy of the specimen submitted with the electronically filed affidavit. This statement does not have to be verified. Alternatively, the owner may submit a new specimen, together with an affidavit or declaration that the substitute specimen was in use in commerce on or in connection with the goods/services during the relevant period specified in §8 of the Act. No deficiency surcharge is required. See TMEP

§1604.12(c) regarding the requirements for an affidavit supporting use of substitute specimens.

The Office prefers that the specimen, whether a true copy of the original or a substitute, be submitted electronically via the Trademark Electronic Application System (“TEAS”). In TEAS, the Response to Office Action form can be accessed by clicking on the link entitled “Response Forms” at <http://www.uspto.gov>.

#### **1604.12(c)      Substitute Specimens**

If a specimen for any class is omitted or is deficient, the owner must file a substitute specimen, together with an affidavit or declaration that the substitute specimen was in use in commerce on or in connection with the goods or services during the relevant period specified in §8 of the Act, 15 U.S.C. §1058, as follows:

- (1) If the §8 affidavit was filed during the sixth year after the date of registration or publication under §12(c) of the Act, 15 U.S.C. §1062(c), the affidavit supporting use of the substitute specimen must state that the substitute specimen was in use in commerce before the expiration of the sixth year after the date of registration or publication under §12(c), if accurate; or
- (2) If the §8 affidavit was filed within one year before the end of any ten-year period after the date of registration, the affidavit supporting use of the substitute specimen must state that the substitute specimen was in use in commerce within one year before the end of the ten-year period after the date of registration, if accurate; or
- (3) If the §8 affidavit was filed during the grace period, the affidavit supporting use of the substitute specimen must state that the substitute specimen was in use in commerce before the expiration of the grace period, if accurate.

If the §8 affidavit was filed during the relevant period specified in §8(a) of the Act (i.e., during the sixth year after the date of registration or publication under §12(c) of the Trademark Act, or within one year before the end of any ten-year period after the date of registration), the substitute specimen may be filed before expiration of the relevant period for no fee, or after expiration of the relevant period with the deficiency surcharge required under §8(c) of the Act. If the §8 affidavit was filed during the grace period, the substitute specimen may be filed before expiration of the grace period for no fee, or after expiration of the grace period with the deficiency surcharge. See TMEP §1604.04 regarding the deadlines for filing §8 affidavits, and TMEP §§1604.17 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

While a substitute specimen and supporting affidavit may be filed after the expiration of the period specified in §8 of the Act, the supporting affidavit must attest to use of the specimen within the time period specified in §8 of the Act. Therefore, if the affidavit supporting the substitute specimen does not state that the specimen was in use in commerce prior to the end of the relevant period specified in §8 of the Act, the USPTO will not accept the affidavit, and the registration will be cancelled as to any class for which no proper specimen was submitted.

See 37 C.F.R. §2.193(e)(1) and TMEP §611.03(a) regarding the proper person to sign an affidavit or declaration.

#### **1604.13 Differences in the Mark as Used on the Specimen and the Mark as Registered**

The mark to which the §8 affidavit pertains must be essentially the same as the mark that appears in the registration. Where the specimen reflects a change in the mark since the registration issued, acceptance of the affidavit will depend on the degree of change. A *material* alteration of the mark will result in refusal of the affidavit on the ground that the registered mark is no longer in use. *In re Int'l Nickel Co., Inc.*, 282 F.2d 952, 127 USPQ 331 (C.C.P.A. 1960); *In re Continental Distilling Corp.*, 254 F.2d 139, 117 USPQ 300 (C.C.P.A. 1958); *Ex parte Richards*, 153 USPQ 853 (Comm'r Pats. 1967). See also *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986); *In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984).

Mere changes in background or styling, or modernization, are not ordinarily considered to be material changes in the mark. See *Ex parte Petersen & Pegau Baking Co.*, 100 USPQ 20 (Comm'r Pats. 1953) (change in matter determined to be mere background and type face held not a material alteration of "PETER PAN" mark). Whether the change in a mark as used on the specimen is a material change is a question of fact that the Post Registration staff must determine on a case-by-case basis.

Generally, the standard used to determine whether a change is material under §8 is the same as the standard used to determine whether the mark in a registration may be amended under 15 U.S.C. §1057(e). If the mark could be amended under §7(e) because the character of the mark had not been materially altered, then the specimen filed with the §8 affidavit should be accepted. In determining whether a change constitutes a material alteration, the USPTO will always compare the mark in the specimen to the mark as originally registered. See TMEP §§807.14 *et seq.* and 1609.02(a) for additional information about material alteration.

However, where the registered mark is currently used as one of several elements in a composite mark, the decision as to whether to accept the specimen requires consideration of whether the registered mark makes an

impression apart from the other elements of the composite mark. If the display of the composite is such that the essence of the registered mark makes a separate impression, then the specimen may be sufficient for purposes of the §8 requirement. In many cases, word elements are severable from design elements, because words tend to dominate in forming a commercial impression. *In re DeWitt Int'l Corp.*, 21 USPQ2d 1620 (Comm'r Pats. 1991). If the mark, as used on the §8 specimen, creates a separate impression apart from any other material on the specimen, then the specimen may be accepted as evidence of current use of the registered mark.

If the USPTO determines that the mark on the specimen is a material alteration of the registered mark, the owner may file a substitute specimen. If the owner files a substitute specimen after expiration of the relevant filing period specified in §8 of the Act, the owner must pay the deficiency surcharge required by §8(c) of the Act, 15 U.S.C. §1058(c), and 37 C.F.R. §2.6. See TMEP §1604.12(c) regarding substitute specimens, and 37 C.F.R. §2.164 and TMEP §§1604.17 *et seq.* regarding the procedures for correcting deficiencies in a §8 affidavit.

#### **1604.13(a) Possible Amendment of Mark in Registration**

If the USPTO accepts the §8 affidavit, and there is a difference between the mark on the specimen filed with the affidavit and the mark in the registration, the mark as originally registered remains the mark of record. If the owner wants to change the mark in the registration to agree with the mark currently used, the owner must file a separate request for amendment under §7(e) of the Act, 15 U.S.C. §1057(e), and pay the fee required by 37 C.F.R. §2.6. See *Ex parte Petersen & Pegau Baking Co.*, 100 USPQ 20 (Comm'r Pats. 1953). See TMEP §§1609.02 *et seq.* regarding amendment of a registered mark under §7(e).

However, amending the mark in a registration under §7(e) to agree with the mark as shown on a §8 specimen is not mandatory.

#### **1604.14 Designation of Domestic Representative by Foreign Owner**

Under 15 U.S.C. §1058(f), if the owner of the registration is not domiciled in the United States, the affidavit or declaration may include the name and address of a United States resident upon whom notices or process in proceedings affecting the registration may be served. The USPTO encourages parties who do not reside in the United States to designate domestic representatives. To expedite processing, the USPTO recommends that designations of domestic representative be filed through TEAS, at <http://www.uspto.gov>. See TMEP §610.



The designation should be signed by the individual owner, someone with legal authority to bind a juristic owner (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”). In the case of joint owners who are not represented by a qualified practitioner, all must sign. 37 C.F.R. §2.193(e)(8); TMEP §611.03(h).

#### **1604.15 Office Actions and Notices Regarding Affidavit**

Upon receipt of a §8 affidavit, the USPTO updates the prosecution history of the registration in TRAM and TARR to indicate that the affidavit has been filed.

When a §8 affidavit is filed electronically, TEAS almost immediately displays a “Success” page that confirms receipt. This page is evidence of filing should any question arise as to the filing date of the affidavit, and it may be printed or copied-and-pasted into an electronic record for storage. TEAS also separately sends an e-mail acknowledgement of receipt, which includes a summary of the filed information.

If a §8 affidavit is filed on paper, no acknowledgment of receipt of the affidavit is sent before it is examined, unless the applicant includes a stamped, self-addressed postcard with the affidavit (see TMEP §303.02(c) *et seq.*).

If, upon examination, the USPTO determines that the affidavit or declaration is acceptable, the USPTO sends a notice of acceptance. If the affidavit or declaration is not acceptable, the USPTO issues an action stating the reasons for refusal. 37 C.F.R. §2.163.

The propriety of the original registration is not re-examined in connection with the affidavit under §8.

#### **1604.16 Response to Office Action**

*Deadline.* Under 37 C.F.R. §2.163(b), the owner must file a response to a refusal within six months of the issuance date of the Office action, or before the end of the relevant filing period set forth in §8(a) of the Act, whichever is later. If no response is received within that time, the registration will be cancelled, unless time remains in the grace period under §8(a)(3) of the Act, 15 U.S.C. §1058(a)(3). If time remains in the grace period, the owner may file a complete new affidavit, with a new fee.

The owner may file a petition to the Director under 37 C.F.R. §§2.146(a)(5) and 2.148 to waive 37 C.F.R. §2.163(b) so that a late response to an Office action can be accepted. However, the Director will waive a rule only in an extraordinary situation, where justice requires and no other party is injured. See TMEP §1708. The failure to receive an Office action has been found to be an extraordinary circumstance that warrants a waiver of 37 C.F.R.

§2.163(b). The “unintentional delay” standard of 37 C.F.R. §2.66 does not apply to the failure to respond to an Office action issued in connection with a §8 affidavit. TMEP §1714.01(f)(ii).

*Signature.* The response must be signed by a qualified practitioner, or by the owner of the registration or someone with legal authority to bind the owner. If the owner is represented by a qualified practitioner, the practitioner must sign. 37 C.F.R. §§2.193(e)(2)(i) and 11.18(a). If the owner is not represented by a qualified practitioner, the individual owner or someone with legal authority to bind a juristic owner must sign. 37 C.F.R. §§2.163(b) and 11.14(e); TMEP §611.03(b). In the case of joint owners who are not represented by a qualified practitioner, all must sign. 37 C.F.R. §2.193(e)(2)(ii). See TMEP §§611.06 *et seq.* for guidelines on persons with legal authority to bind various types of juristic entities, and TMEP §§602 *et seq.* regarding persons who are qualified to represent others before the USPTO in trademark cases.

When it appears that a response to an Office action is signed by an improper party, the Post Registration staff must treat the response as incomplete and follow the procedures in TMEP §§611.05 *et seq.*

*Correction of Deficiencies.* See TMEP §§1604.17 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

#### **1604.17                      Correction of Deficiencies in §8 Affidavit**

*37 C.F.R. §2.164. Correcting deficiencies in affidavit or declaration.*

*(a) If the affidavit or declaration is filed within the time periods set forth in section 8 of the Act, deficiencies may be corrected, as follows:*

*(1) Correcting deficiencies in affidavits or declarations timely filed within the periods set forth in sections 8(a)(1) and 8(a)(2) of the Act. If the affidavit or declaration is timely filed within the relevant filing period set forth in section 8(a)(1) or section 8(a)(2) of the Act, deficiencies may be corrected before the end of this filing period without paying a deficiency surcharge. Deficiencies may be corrected after the end of this filing period with payment of the deficiency surcharge required by section 8(c) of the Act and § 2.6.*

*(2) Correcting deficiencies in affidavits or declarations filed during the grace period. If the affidavit or declaration is filed during the six-month grace period provided by section 8(a)(3) of the Act, deficiencies may be corrected before the expiration of the grace period without paying a deficiency surcharge. Deficiencies may be corrected after the expiration of the grace period with payment of the deficiency surcharge required by section 8(c) of the Act and § 2.6.*

*(b) If the affidavit or declaration is not filed within the time periods set forth in section 8 of the Act, the registration will be cancelled.*

**1604.17(a)      Correcting Deficiencies in Affidavits or Declarations  
Timely Filed Within the Periods Set Forth in §8(a) of the  
Act**

If the affidavit or declaration is filed during the periods set forth in §8(a) of the Act (i.e., during the sixth year after the date of registration or publication under §12(c) of the Act, or within one year before the end of any ten-year period after the date of registration), deficiencies may be corrected, after notification from the Office, within the relevant period without paying a deficiency surcharge, or after the expiration of the relevant period with payment of the deficiency surcharge required by §8(c) of the Act, 15 U.S.C. §1058(c).

Any deficiency must be cured before the end of the relevant filing period set forth in §8 of the Act or within the set period for response to the Office action, whichever is later. 15 U.S.C. §1058(c). If no response is filed, or if the owner does not correct the deficient affidavit, within this time period, the registration will be cancelled. See TMEP §1604.16.

**1604.17(b)      Correcting Deficiencies in Affidavits or Declarations  
Filed During the Grace Period**

If the affidavit or declaration is filed during the six-month grace period under §8(a)(3) of the Act, 15 U.S.C. §1058 (a)(3), deficiencies may be corrected, after notification from the Office, before the expiration of the grace period without paying a deficiency surcharge, or after the expiration of the grace period with the deficiency surcharge required by §8(c) of the Act, 15 U.S.C. §1058(c).

Deficiencies must be cured within six months of the issuance date of the Office action. 37 C.F.R. §2.163(b). See TMEP §1604.16.

**1604.17(c)      Defects That Cannot be Cured After Expiration of the  
Grace Period**

The registration will be cancelled if an affidavit or declaration of use or excusable nonuse is not filed within the time period set forth in §8 of the Act (including the grace period). 15 U.S.C. §1058(a).. Untimely filing cannot be cured after expiration of the grace period, even with a deficiency surcharge. See TMEP §1604.04 regarding the deadline for filing the affidavit.

**1604.18              Petition Under 37 C.F.R. §2.146**

The action of the Post Registration staff on a §8 affidavit may not be appealed to the Trademark Trial and Appeal Board, but the owner may file a petition to the Director for review of the action under 37 C.F.R. §§2.146(a)(2) and

2.165(b). A petition fee is required by 37 C.F.R. §§2.6 and 2.146(c). See TMEP Chapter 1700 regarding petitions.

**1604.18(a) Response to Examiner's Refusal Required Before Petition**

A response to the initial refusal to accept an affidavit or declaration is required before filing a petition, unless the Post Registration staff directs otherwise or there is no time remaining to respond to the refusal. 37 C.F.R. §2.165(a).

If the Post Registration staff continues the refusal to accept the affidavit or declaration, the owner may file a petition for review of the action under 37 C.F.R. §2.146(a)(2) within six months of the issuance date. If the owner does not file a petition within six months, the registration will be cancelled. 37 C.F.R. §2.165(b).

**1604.18(b) Decision on Petition Is Final Action of the USPTO**

The decision on a petition under 37 C.F.R. §2.146 is the final action of the USPTO. In the absence of a request for reconsideration (see TMEP §1604.18(c)), or an appeal to an appropriate court (see TMEP §1604.18(d)) within two months of the issuance date of the decision on petition, the registration will be cancelled.

**1604.18(c) Request for Reconsideration of Denial of Petition**

Under 37 C.F.R. §2.146(j), if a petition is denied, the petitioner may file a request for reconsideration within two months of the issuance date of the decision denying the petition. A second petition fee must be paid with the request for reconsideration. See TMEP §1705.08 regarding requests for reconsideration of petition decisions.

**1604.18(d) Appeal to Federal Court**

The owner of the registration may appeal to the United States Court of Appeals for the Federal Circuit or commence a civil action for review of the decision denying a petition. 15 U.S.C. §§1071(a)(1) and (b)(1); 37 C.F.R. §§2.145(a) and 2.145(c).

The deadline for filing an appeal or commencing a civil action is two months from the issuance date of the decision on petition. 15 U.S.C. §§1071(a)(2) and (b)(1); 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.

Under 37 C.F.R. §2.165(c), a decision on petition is necessary before the owner can file an appeal or commence a civil action in any court.

**Section 8 Affidavit or Declaration of Use or Excusable Nonuse Combined with Renewal Application**

A §8 affidavit and a §9 renewal application may be combined into a single document, if the document meets the requirements of both §§8 and 9 of the Act. 37 C.F.R. §2.166.

The filing fee for the combined §8 and §9 filing is the sum of the cost of the individual filings. For example, if the filing fee for the §8 affidavit is \$100 per class, and the filing fee for the renewal application is \$400 per class, then the filing fee for the combined §8 and §9 document is \$500 per class.

If the combined §8 and §9 document is filed during the grace period, the filing fees per class and the grace period surcharge per class must be paid for *both* the §8 affidavit and the §9 renewal application.

*Example:* The period for filing a §8 affidavit and §9 renewal application expires on November 19, 2009. A combined §8 and §9 document is filed November 21, 2009, during the six-month grace period. The proper fees are as follows: (1) filing fee for the §8 affidavit, per class; (2) grace period surcharge for the §8 affidavit, per class; (3) filing fee for the §9 renewal application, per class; *and* (4) grace period surcharge for the §9 renewal application, per class.

Failure to include the proper fees is a deficiency that may require a deficiency surcharge. See TMEP §§1604.17 *et seq.* and 1606.13 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

Only a single deficiency surcharge is required for curing one or more deficiencies in a combined §8 and §9 filing, even if both the §8 affidavit and the §9 renewal application are deficient. Similarly, only a single deficiency surcharge is required to correct several deficiencies within one document.

To expedite processing, it is recommended that the combined §8 and §9 filing be submitted through TEAS, at <http://www.uspto.gov>. When the combined filing is submitted electronically, TEAS almost immediately displays a “Success” page that confirms receipt. This page is evidence of filing should any question arise as to the filing date of the document, and it may be printed or copied-and-pasted into an electronic record for storage. TEAS also separately sends an e-mail acknowledgement of receipt, which includes a summary of the filed information.

Alternatively, the owner of the registration can call the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199 to obtain a pre-printed form that can be filled out and mailed, faxed, or hand-delivered to the USPTO.

See TMEP §1605.05 regarding a combined filing under §§8 and 15 of the Act.

**Affidavit of Incontestability Under §15 of the Trademark Act**

Section 15 of the Trademark Act, 15 U.S.C. §1065, provides a procedure by which the exclusive right to use a registered mark in commerce on or in connection with the goods or services covered by the registration can become “incontestable,” if the owner of the registration files an affidavit stating that the mark has been in continuous use in commerce for a period of five years after the date of registration. To expedite processing, it is recommended that the owner file the §15 affidavit through TEAS, available at <http://www.uspto.gov>. See TMEP §1605.02.

Under §33(b) of the Act, 15 U.S.C. §1115(b), if the right to use the mark has become incontestable under §15, then the registration is conclusive evidence of the validity of the registered mark and its registration, of the registrant’s ownership of the mark, and of the owner’s exclusive right to use the registered mark in commerce, subject to certain defenses and exceptions. Sections 15 and 33(b) apply only to registrations issued on the Principal Register.

Filing an affidavit of incontestability under §15 of the Trademark Act (“§15 affidavit”) is optional. An eligible registrant may choose to claim the benefits of incontestability and file an appropriate affidavit, or may elect to retain the registration without those benefits. The requirements for maintaining and renewing a federal registration are not affected.

The USPTO does not “accept” §15 affidavits. *Arman’s Systems, Inc. v. Armand’s Subway, Inc.*, 215 USPQ 1048, 1050 n.2. (TTAB 1982). Rather, the USPTO reviews the affidavit to determine whether it is consistent with the requirements of the statute and rules (e.g., whether it is signed, whether it was filed at an appropriate time, and whether the §15 claims are properly set forth).

When a §15 affidavit complies with the requirements of the statute and rules, the USPTO updates its records to acknowledge receipt of the affidavit and sends a notice of acknowledgment to the owner of the registration. Acknowledging receipt of the affidavit provides notice to the public that an affidavit of incontestability has been filed; it is not a determination by the USPTO that the registration is in fact incontestable. The question of whether the registration is incontestable arises and is determined by a court if there is a proceeding involving the mark.

If the §15 affidavit does not comply with the statute and rules, the USPTO issues a written action notifying the owner of any inconsistency or error, but does not require correction. The owner is given six months from the issuance date of the Office action to file a response. If no response is received within that time, the §15 affidavit will be abandoned. The USPTO does *not* update

its records to acknowledge receipt of a noncompliant affidavit. The owner may file a new §15 affidavit, with a new filing fee.

A fee is required for each class in the registration to which the §15 affidavit or declaration pertains. 37 C.F.R. §§2.6 and 2.167(g). If insufficient fees are included with the affidavit, the Post Registration staff will issue an Office action allowing the owner additional time to submit the required fees. 37 C.F.R. §2.167(g).

The limitation of grounds that a third party can raise in a petition to cancel a registered mark under 15 U.S.C. §1064 filed more than five years from the date of registration does *not* depend on the filing of a §15 affidavit. TMEP §1605.06.

See TMEP §1605.05 regarding a combined affidavit or declaration under §§8 and 15 of the Act, and TMEP §1216.02 regarding the effect of “incontestability” in ex parte examination.

#### **1605.01                    Registrations to Which §15 Affidavit Pertains**

The provisions of §15 of the Trademark Act apply only to registrations issued on the Principal Register under the Act of 1946 and to registrations issued under the Acts of 1905 and 1881 that have been “published” under §12(c) of the Act, 15 U.S.C. §1062(c). See TMEP §1603 regarding §12(c).

A §15 affidavit may be filed for a registered extension of protection of an international registration to the United States. Section 73 of the Trademark Act, 15 U.S.C. §1141m.

Section 15 affidavits may not be filed for marks registered on the Supplemental Register of the Act of 1946, marks registered under the Act of 1920, or marks registered under the Acts of 1905 and 1881 for which the benefits of the Act of 1946 have not been claimed under §12(c). If a §15 affidavit is filed for a registration that is not eligible for the benefits of §15, the USPTO will not review it and will refund the filing fee.

#### **1605.02                    Form for Filing Affidavit of Incontestability**

To expedite processing, it is recommended that the owner file the §15 affidavit through TEAS, available at <http://www.uspto.gov>. When the affidavit is submitted electronically, TEAS almost immediately displays a “Success” page that confirms receipt. This page is evidence of filing should any question arise as to the filing date of the affidavit, and it may be printed or copied-and-pasted into an electronic record for storage. TEAS also separately sends an e-mail acknowledgement of receipt, which includes a summary of the filed information.

Alternatively, the owner can call the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199 to obtain a pre-printed form that can be filled out and mailed, faxed, or hand-delivered to the USPTO.

### **1605.03 Time for Filing Affidavit of Incontestability**

The owner may not file a §15 affidavit until the federally registered mark has been in continuous use in commerce for at least five consecutive years after the date of registration. This may be any five-year period after the date of registration for marks registered under the Act of 1946, or after the date of publication under §12(c) for marks registered under the Acts of 1905 and 1881.

The owner may file the affidavit within one year after the five-year period that is selected. 37 C.F.R. §2.167(f). The affidavit must be both executed and filed within that one-year period. If the affidavit is filed too early, the USPTO will not review it and will refund the filing fee. The owner may file a new affidavit, with a fee, during the statutory filing period.

An affidavit filed through TEAS is considered to have been filed on the date the USPTO receives the transmission, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. 37 C.F.R. §2.195(a)(2).

Section 15 affidavits filed on paper are considered timely if they are received in the USPTO by the due date or if they are mailed or transmitted by the due date with a certificate of mailing or facsimile transmission under 37 C.F.R. §2.197. See TMEP §§305.02 and 306.05 for certificate of mailing and certificate of facsimile transmission procedures to avoid lateness.

The USPTO will not acknowledge a §15 affidavit unless a §8 affidavit is pending or has been accepted by the Office. If a §15 affidavit is filed alone during the statutory period for filing the §8 affidavit, the Post Registration staff will notify the owner that the registration will be cancelled without an acceptable §8 affidavit. In response to such notification, the owner may request that the §15 affidavit be treated as a deficient §8 affidavit. See TMEP §1604.04 regarding the deadline for filing a §8 affidavit and TMEP §1604.05 regarding the requirements for filing a §8 affidavit.

See TMEP §1605.05 regarding a combined affidavit under §§8 and 15 of the Act.

### **1605.04 Requirements for Affidavit or Declaration of Incontestability**

Section 15 of the Act refers to the affidavit or declaration merely as “setting forth” the specified information. See 15 U.S.C. §1065(3). Therefore, no showing or proof beyond the owner’s verified statement is required.



*Must be Filed by Owner.* In order to be effective, the §15 affidavit or declaration must be filed by the person who is the owner of the registration at the time the affidavit is filed. 37 C.F.R. §2.167(a). If the affidavit was filed by the wrong party, the true owner may file a new affidavit, with a new filing fee.

*Fee.* A fee is required for each class in the registration to which the §15 affidavit or declaration pertains. See 37 C.F.R. §§2.6 and 2.167(g). If insufficient fees are included with the affidavit, the Post Registration staff will issue an Office action allowing the owner additional time to submit the required fees. 37 C.F.R. §2.167(g).

*Goods/Services Must be Recited.* The §15 affidavit must specify the goods or services recited in the registration on or in connection with which the mark has been in continuous use for the five-year period after the date of registration or publication under §12(c), and is still in use in commerce. 15 U.S.C. §1065(3); 37 C.F.R. §2.167(c). More than one affidavit may be filed at different times for different goods/services in the same registration.

*Mark Must be in Use in Commerce.* Regardless of the basis for registration, the use on which the §15 affidavit is based must be use in commerce. This applies to both foreign and domestic registrants. It is not necessary to specify the type of commerce (e.g., interstate) in which the mark is used. The USPTO presumes that someone who states that the mark is in use in commerce is stating that the mark is in use in a type of commerce that the United States Congress can regulate, unless there is contradictory evidence in the record. See TMEP §§901 *et seq.* regarding use in commerce.

*No Adverse Decision or Pending Proceeding Involving Rights in the Mark.* The §15 affidavit must state that there has been no final decision adverse to the owner's claim of ownership of the mark for the goods or services, or to the owner's right to register the mark or to keep the mark on the register. It must also state that there is no proceeding involving these rights pending in the USPTO or in a court and not finally disposed of. 15 U.S.C. §§1065(1) and (2); 37 C.F.R. §§2.167(d) and (e). If the USPTO finds facts contrary to either of the foregoing statements, the USPTO will not acknowledge receipt of the §15 affidavit. See TMEP §1605. (The USPTO does not consider a proceeding involving the mark in which the owner is the plaintiff, where there is no counterclaim involving the owner's rights in the mark, to be a "proceeding involving these rights" that would preclude the filing or acknowledgment of a §15 affidavit.)

If the USPTO finds that there is a proceeding pending that involves the owner's right to register the mark or to keep the mark on the register, the USPTO will not acknowledge the affidavit, even if the proceeding was instituted after the owner filed the §15 affidavit but before the affidavit was reviewed by the USPTO. If a pending proceeding is later dismissed, the owner may file a new affidavit, with a new filing fee.

*Verification.* The §15 affidavit must be signed and verified (sworn to) or supported by a declaration under 37 C.F.R. §2.20 by the owner of the registration or a person properly authorized to sign on behalf of the owner of the registration. 37 C.F.R. §2.167(a). A “person who is properly authorized to sign on behalf of the owner” is: (1) a person with legal authority to bind the owner; (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or (3) an attorney as defined in 37 C.F.R. §11.1 who has an actual written or verbal power of attorney or an implied power of attorney from the owner. 37 C.F.R. §2.193(e)(1). Generally, the USPTO does not question the authority of the person who signs a §15 affidavit, unless there is an inconsistency in the record as to the signatory’s authority to sign. TMEP §611.03(a).

See 37 C.F.R. §2.193(c) and TMEP §611.01(c) regarding signature of electronically filed affidavits or declarations.

## **1605.05 Combining §15 Affidavit with §8 Affidavit**

A §15 affidavit may be combined with a §8 affidavit, if the combined affidavit or declaration meets the requirements of both §§8 and 15.

The filing fee for a combined §8 and §15 affidavit is the sum of the cost of the individual filings. For example, if the filing fee for the §8 affidavit is \$100 per class, and the filing fee for the §15 affidavit is \$200 per class, then the filing fee for the combined affidavit or declaration under §§8 and 15 is \$300 per class.

If the combined §8 and §15 affidavit is filed during the §8 grace period, the grace period surcharge per class for the §8 affidavit must be paid. There is no grace period surcharge for a §15 affidavit.

If a combined §8 and §15 affidavit is filed, and the §8 affidavit is deficient, the deficiency may be corrected before expiration of the relevant deadline set forth in §8 of the Act for no fee, or after expiration of the relevant deadline with the deficiency surcharge required by §8(c) of the Act, 15 U.S.C. §1058(c). See TMEP §§1604.17 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies in a §8 affidavit. There is no deficiency surcharge for a §15 affidavit.

To expedite processing, it is recommended that the owner file the combined §8 and §15 affidavit through TEAS, available at <http://www.uspto.gov>. When the combined affidavit is submitted electronically, TEAS almost immediately displays a “Success” page that confirms receipt. This page is evidence of filing should any question arise as to the filing date of the affidavit, and it may be printed or copied and pasted into an electronic record for storage. TEAS also separately sends an e-mail acknowledgement of receipt, which includes a summary of the filed information. Alternatively, the owner can call the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199 to obtain

a pre-printed form that can be filled out and mailed, faxed, or hand-delivered to the USPTO.

See TMEP §1613.19 regarding a combined filing under §§71 and 15 of the Act.

#### **1605.06                    Section 14 Limitation is Independent of §15 Affidavit**

Section 14 of the Trademark Act, 15 U.S.C. §1064, limits the grounds that a third party can raise in a petition to cancel a mark registered on the Principal Register when the petition is filed more than five years from the date of registration or publication under §12(c). This limitation of grounds does *not* depend on the filing of a §15 affidavit. [Trademark Trial and Appeal Board Manual of Procedure](#) (“TBMP”) §307.02(b).

#### **1606                        Renewal of Registration Under Trademark Act §9 of the Trademark Act**

*15 U.S.C. §1059. Renewal of registration.*

*(a) Subject to the provisions of section 8, each registration may be renewed for periods of 10 years at the end of each successive 10-year period following the date of registration upon payment of the prescribed fee and the filing of a written application, in such form as may be prescribed by the Director. Such application may be made at any time within 1 year before the end of each successive 10-year period for which the registration was issued or renewed, or it may be made within a grace period of 6 months after the end of each successive 10-year period, upon payment of a fee and surcharge prescribed therefor. If any application filed under this section is deficient, the deficiency may be corrected within the time prescribed after notification of the deficiency, upon payment of a surcharge prescribed therefor.*

*(b) If the Director refuses to renew the registration, the Director shall notify the registrant of the Director’s refusal and the reasons therefor.*

*(c) If the registrant is not domiciled in the United States the registrant may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, or if the registrant does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, such notices or process may be served on the Director.*

## **1606.01 Which Registrations Must be Renewed Under §9**

### **1606.01(a) Registrations Based on Applications Under §1 or §44 Must Be Renewed Under §9**

Section 9 of the Trademark Act, 15 U.S.C. §1059, requires that registrations resulting from applications based on §1 or §44 of the Trademark Act be renewed periodically. See TMEP §§1606.02 *et seq.* for information about the requirements for renewal under §9.

### **1606.01(b) Section 9 Does Not Apply to Extensions of Protection of International Registrations to the United States**

Section 9 of the Trademark Act does not apply to registered extensions of protection of international registrations to the United States. Renewal of international registrations must be made at the IB, in accordance with Article 7 of the Madrid Protocol. 37 C.F.R. §7.41(a). See TMEP §1614 for further information about renewal of international registrations.

### **1606.01(c) Renewal of Registrations Issued Under Prior U.S. Trademark Acts Must Be Renewed Under §9**

An application for renewal of a registration issued under a prior Act, where required, must meet all the requirements of §9 of the Act and 37 C.F.R. §2.183. See TMEP §1602.02 regarding the renewal of registrations issued under the Acts of 1881 and 1905, and TMEP §1602.03 regarding the renewal of registrations issued under the Act of 1920.

## **1606.02 Requirements for Renewal Under §9**

*37 C.F.R. §2.183. Requirements for a complete renewal application.*

*A complete renewal application must include:*

*(a) A request for renewal of the registration, signed by the registrant or the registrant's representative;*

*(b) The fee required by §2.6 for each class;*

*(c) The additional fee required by §2.6 for each class if the renewal application is filed during the six-month grace period set forth in section 9(a) of the Act;*

*(d) If the renewal application covers less than all the goods or services in the registration, a list of the particular goods or services to be renewed.*

*(e) If at least one fee is submitted for a multi-class registration, but the class(es) to which the fee(s) should be applied are not specified, the Office will issue a notice requiring either the submission of additional fee(s) or an indication of the class(es) to which the original fee(s) should be applied. Additional fee(s) may be submitted if the requirements of §2.185 are met. If the*

*required fee(s) are not submitted and the class(es) to which the original fee(s) should be applied are not specified, the Office will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class.*

*(f) Renewals of registrations issued under a prior classification system will be processed on the basis of that system, unless the registration has been amended to adopt international classification pursuant to §2.85(e)(3).*

### **1606.03 Time for Filing §9 Renewal Application**

The application for renewal must be filed within one year before the expiration of the registration, or within the six-month grace period after the expiration of the registration with an additional grace period surcharge. If no renewal application is filed before the end of the grace period, the registration will expire. 15 U.S.C. §1059(a); 37 C.F.R. §2.182. See TMEP §§1602 *et seq.* as to the term of a registration.

A renewal application may be filed on the anniversary dates of the statutory period.

*Example:* For a registration issued on November 5, 1998, an application for renewal may be filed as early as November 5, 2007, and as late as November 5, 2008, before entering the six-month grace period.

Under 37 C.F.R. §2.195(a)(2), a renewal application filed through TEAS is considered to have been filed on the date the USPTO receives the transmission, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. When the renewal application is submitted electronically, TEAS almost immediately displays a “Success” page that confirms receipt. This page is evidence of filing should any question arise as to the filing date of the application, and it may be printed or copied-and-pasted into an electronic record for storage. TEAS also separately sends an e-mail acknowledgement of receipt, which includes a summary of the filed information.

An application for renewal of a registration filed on paper is considered timely if it is received in the USPTO by the due date or if it is mailed or transmitted by the due date with a certificate of mailing or facsimile transmission in accordance with 37 C.F.R. §2.197. See TMEP §§305.02 and 306.05 for certificate of mailing and certificate of facsimile transmission procedures to avoid lateness.

The Director has no authority to waive the deadline for filing a proper §9 renewal application. See *In re Holland American Wafer Co.*, 737 F.2d 1015, 1018, 222 USPQ 273, 275 (Fed. Cir. 1984) (“Timeliness set by statute is not a minor technical defect which can be waived by the Commissioner.”). Cf.

*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) ("[I]n establishing cancellation as the penalty for failure to file the required affidavit [under 15 U.S.C. §1058], Congress made no exception for the innocent or the negligent. Thus, the Commissioner had no discretion to do other than cancel Checkers's service mark registration in this case"); *In re Mother Tucker's Food Experience (Canada) Inc.*, 925 F.2d 1402, 1405-06, 17 USPQ2d 1795, 1798 (Fed. Cir. 1991).

#### **1606.03(a) Premature Filing of §9 Renewal Application**

A renewal application may not be filed before the period specified in §9 of the Act. *In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984). If an application for renewal is filed more than one year before the expiration date of the registration, the USPTO will advise the registrant: (1) that the renewal application is premature; (2) of the appropriate time period for filing a renewal application; (3) that the fees submitted will be held; and (4) that the registrant may file a new renewal application at the appropriate time or may request a refund at any time. The prematurely filed renewal application will be placed in the record for informational purposes only. A timely renewal application must be filed before the end of the grace period, or the registration will expire and the fees will be refunded. There is no deficiency surcharge for filing a timely substitute renewal application.

#### **1606.04 Form for Filing §9 Renewal Application**

To expedite processing, it is recommended that the owner file the renewal application through TEAS.

Because the deadlines for filing renewal applications coincide with the deadlines for filing affidavits of use or excusable nonuse under 15 U.S.C. §1058(a)(2) at the end of each ten-year period following the date of registration, the USPTO has created a form for filing a §8 affidavit combined with a §9 renewal application. See TMEP §1604.19 for more information about combined filings under §§8 and 9 of the Act.

The form for the combined filing is available through TEAS at <http://www.uspto.gov>. Alternatively, the owner can call the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199 to obtain a pre-printed form that can be filled out and mailed, faxed, or hand-delivered.

The USPTO's §9 renewal form cannot be used to renew an international registration. See TMEP §1614 for information about renewal of international registrations.

## **1606.05 Fees for §9 Renewal Applications**

### **1606.05(a) Fee for Filing Application for Renewal Under §9**

A renewal application must include the fee required by 37 C.F.R. §2.6 for each class of goods/services for which renewal is sought. 15 U.S.C. §1059(a); 37 C.F.R. §2.183(b). See TMEP §§1401.02, 1401.04, and 1601.06 regarding use of international classification or prior United States classification for calculation of fees due. See TMEP §1606.05(c) regarding renewal applications filed with insufficient fees.

### **1606.05(b) Grace Period Surcharge and Deficiency Surcharge**

If the renewal application is filed during the six-month grace period, there is an additional grace period surcharge for each class for which renewal is sought. 15 U.S.C. §1059(a); 37 C.F.R. §§2.6 and 2.183(c).

Under §9(a) of the Trademark Act, a deficiency surcharge is required for correcting a deficiency after expiration of the relevant deadline specified in §9 of the Act. If the renewal application is filed within one year before the expiration of the registration, a deficiency surcharge is required for correcting deficiencies after the expiration date of the registration. If the renewal application is filed during the grace period, a deficiency surcharge is required for correcting deficiencies after expiration of the grace period. See TMEP §§1606.13 *et seq.* for further information regarding the procedures, deadlines, and surcharge for correcting deficiencies.

Only a single deficiency surcharge is required for correcting one or more deficiencies in a multiple-class registration. Similarly, only a single deficiency surcharge is required to correct several deficiencies within one renewal application or one combined filing under §§8 and 9. See TMEP §1604.19 regarding combined filings under §§8 and 9.

The grace period surcharge applies only if no filing was made within the year before the expiration of the registration. Someone who files within one year before the expiration of the registration, but corrects a deficiency after expiration of the registration, will be subject to the deficiency surcharge only. On the other hand, someone who files during the grace period and cures a deficiency after the grace period expires will be subject to both the grace period surcharge (for the ability to file the renewal application during the grace period) *and* the deficiency surcharge (for the ability to correct a deficiency after the expiration of the grace period). H.R. Rep. No. 105-194, 105<sup>th</sup> Congress, 1<sup>st</sup> Sess. 17 (1997).

### **1606.05(c)      Processing §9 Renewal Application Filed with Insufficient Fees**

A §9 renewal application that does not include sufficient fees to cover the filing fee for all the classes to which the application pertains (and the grace period surcharge, where applicable), is deficient. If the renewal application is filed within one year before the expiration date of the registration, the deficiency may be corrected before the expiration date of the registration for no fee, or after the expiration date of the registration with the deficiency surcharge required by §9(a) of the Act, 15 U.S.C. §1059(a). If the renewal application is filed during the grace period, the deficiency may be corrected before expiration of the grace period for no fee, or after expiration of the grace period with the deficiency surcharge required by §9(a) of the Act. See TMEP §§1606.13 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

If the renewal application was filed without sufficient fee(s), but included an authorization to charge additional fees to a USPTO deposit account, the required fee (and grace period surcharge, where applicable) will be charged to the deposit account. If the deposit account authorization was included with the renewal application as filed, and the deposit account had sufficient funds to cover the fee(s) in question, there is no fee deficiency and no deficiency surcharge is required.

An authorization to charge fees to a deposit account with insufficient funds to cover the fee is regarded as a deficiency.

If a check submitted as payment of a filing fee for a renewal application is returned unpaid, or an EFT or credit card payment is refused or charged back by a financial institution, this is also regarded as a deficiency. In addition to the deficiency surcharge (where applicable), there is a fee for processing the payment that was refused. 37 C.F.R. §2.6(b)(12). See TMEP §405.06.

If at least one fee is submitted for a multiple-class registration, but the class(es) to which the fee(s) should be applied are not specified, the Post Registration staff will issue a notice requiring either the submission of additional fee(s) or an indication of the class(es) to which the original fee(s) should be applied. If the required fee(s) are not submitted and the class(es) to which the original fee(s) should be applied are not specified, the USPTO will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class and will delete any unpaid classes. 37 C.F.R. §2.183(e). See TMEP §1608 regarding surrender of the registration as to class(es) that are omitted from a §9 renewal application.

### **1606.06      Ownership and Who May File §9 Renewal Application**

The Trademark Act and the Trademark Rules of Practice do not require that a renewal application be filed by the owner of the registration.



Therefore, if the renewal applicant is not the owner of record, the USPTO does not require that the renewal applicant show continuity of title from the original registrant before granting renewal.

However, registrations are renewed in the name of the party who is the owner of record of the registration, as shown in TRAM and TARR. The registration will be renewed in the name of a new owner only if the owner: (1) records an assignment or other document of title with the Assignment Services Branch; and (2) notifies the Post Registration staff at the time the renewal application is filed that the document has been recorded with the Assignment Services Branch. See TMEP §§504 *et seq.* regarding the circumstances in which the “Ownership” field in TRAM and TARR will be automatically updated after recordation of a document with the Assignment Services Branch, even if the new owner does not notify the Trademark Operation that the document has been recorded.

See TMEP §502.03 regarding issuance of a new certificate in the name of a new owner.

#### **1606.07                    Execution of §9 Renewal Application**

Under 37 C.F.R. §2.183(a), a renewal application must be signed by “the registrant or the registrant’s representative.” Verification is not required.

Generally, the USPTO does not question the authority of the person who signs a renewal application, unless there is an inconsistency in the record as to the signatory’s authority to sign.

The Trademark Act and the Trademark Rules of Practice do not require that a renewal application be executed within any particular time period. Therefore, the USPTO will accept undated renewal applications, and will not issue any inquiry or requirement regarding the date of execution of a renewal application.

See TMEP §1606.12 regarding signature of a response to an Office action issued in connection with a renewal application.

#### **1606.08                    Goods and/or Services Set Forth in §9 Renewal Application**

##### **1606.08(a)                Listing of Goods and/or Services Required Only for Partial Renewal**

Neither the Trademark Act nor the Trademark Rules of Practice requires a listing of the goods/services in the registration, if the renewal application covers all the goods/services in the registration. However, if the renewal application covers less than all the goods/services, the renewal application

must include a list of the goods/services for which renewal is sought.  
37 C.F.R. §2.183(d).

**1606.08(b) No Goods or Services Listed**

If no goods or services are specified in the renewal application, it will be presumed that renewal is sought for all the goods/services in the registration.

**1606.08(c) Some Goods and/or Services Listed**

If the renewal application lists only some of the goods/services set forth in the registration, it will be presumed that renewal is sought for only the goods/services listed, and the goods/services omitted from the renewal application will be deleted from the registration.

**1606.08(d) Goods and/or Services Not Listed in Registration May Not Be Listed in Renewal Application**

Goods/services that are not listed in the registration may not be listed in the renewal application.

**1606.09 Affidavit of Use in Commerce or Excusable Nonuse Not Required**

The Trademark Act does not require that a renewal application include an affidavit or declaration of use in commerce, a specimen of use, or a showing that any nonuse is due to special circumstances that excuse the nonuse, and not due to any intention to abandon the mark. See notice at [1228 TMOG 187](#) (Nov. 30, 1999). See also TMEP §§1604 *et seq.* regarding affidavits of use or excusable nonuse under 15 U.S.C. §1058.

**1606.10 Designation of Domestic Representative by Foreign Applicant for Renewal Under §9**

A renewal applicant who is not domiciled in the United States may set forth the name and address of a United States resident on whom notices or process in proceedings affecting the registration may be served. The USPTO encourages parties who do not reside in the United States to designate domestic representatives. 15 U.S.C. §1059(c). See TMEP §610.

The designation should be signed by the individual registrant, someone with legal authority to bind a juristic registrant (e.g., a corporate officer or general partner of a partnership), or a qualified practitioner. In the case of joint owners who are not represented by a qualified practitioner, all must sign.  
37 C.F.R. §2.193(e)(8); TMEP §611.03(h).

## **1606.11 Office Actions and Notices Regarding §9 Renewal Application**

Upon receipt of a §9 renewal application, the prosecution history of the registration in TRAM and TARR are updated to show that the renewal application has been filed.

When a renewal application is filed electronically, TEAS almost immediately displays a “Success” page that confirms receipt. This page is evidence of filing should any question arise as to the filing date of the document, and it may be printed or copied-and-pasted into an electronic record for storage. TEAS also separately sends an e-mail acknowledgement of receipt, which includes a summary of the filed information. For renewal applications filed on paper, no acknowledgment of receipt of the application is sent before it is examined.

If the renewal application is examined and found acceptable, the USPTO sends the registrant a notice that renewal has been granted. The USPTO does not issue an Updated Registration Certificate (“URC”) for renewed registrations.

If the renewal application is not acceptable, the USPTO issues an action stating the reasons for refusal. 15 U.S.C. §1059(b); 37 C.F.R. §2.184(a).

The propriety of the original registration is not re-examined on renewal.

## **1606.12 Response to Office Action**

*Deadline.* If the renewal application is not acceptable, the USPTO will notify the renewal applicant of the reason(s) for refusal. 15 U.S.C. §1059(b); 37 C.F.R. §2.184(a). The registrant must file a response to a refusal of renewal within six months of the issuance date of the Post Registration Office action, or before the expiration date of the registration, whichever is later. If no response is filed within this time period, the registration will expire, unless time remains in the grace period under §9(a) of the Act, 15 U.S.C. §1059(a). If time remains in the grace period, the registrant may file a complete new renewal application, with a new fee. 37 C.F.R. §2.184(b)(1).

The registrant may file a petition to the Director under 37 C.F.R. §§2.146(a)(5) and 2.148 to waive 37 C.F.R. §2.184(b)(1) and accept a late response to an Office action. However, the Director will waive a rule only in an extraordinary situation, where justice requires and no other party is injured. See TMEP §1708. The failure to receive an Office action has been found to be an extraordinary circumstance that warrants a waiver of 37 C.F.R. §2.184(b). The “unintentional delay” standard of 37 C.F.R. §2.66 does not apply to a registrant’s failure to respond to an Office action issued in connection with a renewal application. TMEP §1714.01(f)(ii).

*Signature.* The response must be signed by a qualified practitioner, or by the registrant or someone with legal authority to bind the registrant. If the registrant is represented by a qualified practitioner, the practitioner must sign. 37 C.F.R. §§2.193(e)(2)(i) and 11.18(a). If the registrant is not represented by a qualified practitioner, the individual owner or someone with legal authority to bind a juristic owner must sign. 37 C.F.R. §§2.184(b)(2) and 11.14(e); TMEP §611.03(b). In the case of joint registrants who are not represented by a qualified practitioner, all must sign. 37 C.F.R. §2.193(e)(2)(ii). See TMEP §§611.06 *et seq.* for guidelines on persons with legal authority to bind various types of juristic entities, and TMEP §§602 *et seq.* regarding persons who are qualified to represent others before the USPTO in trademark cases.

When it appears that a response to an Office action is signed by an improper party, the Post Registration staff must treat the response as incomplete and follow the procedures in TMEP §§611.05 *et seq.*

*Correction of Deficiencies.* The renewal applicant may correct deficiencies, if the requirements of 37 C.F.R. §2.185 are met. See TMEP §§1606.13 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

### **1606.13                      Correction of Deficiencies in §9 Renewal Applications**

*37 C.F.R. §2.185. Correcting deficiencies in renewal application.*

*(a) If the renewal application is filed within the time periods set forth in section 9(a) of the Act, deficiencies may be corrected, as follows:*

*(1) Correcting deficiencies in renewal applications filed within one year before the expiration date of the registration. If the renewal application is filed within one year before the expiration date of the registration, deficiencies may be corrected before the expiration date of the registration without paying a deficiency surcharge. Deficiencies may be corrected after the expiration date of the registration with payment of the deficiency surcharge required by section 9(a) of the Act and §2.6.*

*(2) Correcting deficiencies in renewal applications filed during the grace period. If the renewal application is filed during the six-month grace period, deficiencies may be corrected before the expiration of the grace period without paying a deficiency surcharge. Deficiencies may be corrected after the expiration of the grace period with payment of the deficiency surcharge required by section 9(a) of the Act and §2.6.*

*(b) If the renewal application is not filed within the time periods set forth in section 9(a) of the Act, the registration will expire. This deficiency cannot be cured.*

**1606.13(a)      Correcting Deficiencies in §9 Renewal Applications Filed Within the Year Before the Expiration Date of the Registration**

If the renewal application is filed within one year before the expiration date of the registration, deficiencies may be corrected before the expiration date without paying a deficiency surcharge, or after the expiration date with payment of the deficiency surcharge required by §9(a) of the Act. 37 C.F.R. §2.185(a)(1).

Any deficiency must be cured within the set period for response to the Office action, i.e., within six months of the issuance date of the action, or before the expiration date of the registration, whichever is later. If no response is filed within this time period, the registration will expire, unless time remains in the grace period. If time remains in the grace period, the registrant may file a complete new renewal application, with a new fee. 37 C.F.R. §2.184(b). See TMEP §1606.12.

**1606.13(b)      Correcting Deficiencies in Renewal Applications Filed During the Grace Period**

If the renewal application is filed during the grace period, deficiencies may be corrected before the expiration of the grace period without paying a deficiency surcharge, or after the expiration of the grace period with the deficiency surcharge required by §9(a) of the Act. 37 C.F.R. §2.185(a)(2).

Deficiencies must be cured within six months of the issuance date of the Office action. 37 C.F.R. §2.184(b). See TMEP §1606.12.

**1606.13(c)      Late Filing Cannot be Cured**

If the renewal application is not filed within the statutory filing period (which includes the grace period), the registration will expire. Filing after the expiration of the grace period is not a deficiency that can be cured, even with a deficiency surcharge. 37 C.F.R. §§2.182 and 2.185(b).

**1606.14      Petition Under 37 C.F.R. §2.146**

The action of the Post Registration staff on a §9 renewal application may not be appealed to the Trademark Trial and Appeal Board, but the registrant may file a petition to the Director for review of the action under 37 C.F.R. §§2.146(a)(2) and 2.186(b). A petition fee is required by 37 C.F.R. §§2.6 and 2.146(c). See TMEP Chapter 1700 regarding petitions.

**1606.14(a) Response to Examiner's Refusal Required Before Petition**

A response to the initial refusal to accept a renewal application is required before filing a petition, unless the Post Registration staff directs otherwise or there is no time remaining to respond to the refusal. 37 C.F.R. §2.186(a).

If the Post Registration staff continues the refusal of the renewal application, the registrant may file a petition for review of the action under 37 C.F.R. §2.146(a)(2), within six months of the issuance date of the action continuing the refusal. If the registrant does not file a petition within six months of the issuance date, the registration will expire. 37 C.F.R. §2.186(b).

**1606.14(b) Decision on Petition is Final Action of the USPTO**

The decision on a petition under 37 C.F.R. §2.146 is the final action of the USPTO. In the absence of a request for reconsideration of the decision (see TMEP §1606.14(c)), or an appeal to federal court (see TMEP §1606.14(d)) within two months of the issuance date of the decision on petition, the registration will expire.

**1606.14(c) Request for Reconsideration of Denial of Petition**

Under 37 C.F.R. §2.146(j), if a petition is denied, the petitioner may file a request for reconsideration within two months of the issuance date of the decision denying the petition. A second petition fee must be paid with the request for reconsideration. See TMEP §1705.08 regarding requests for reconsideration of petition decisions.

**1606.14(d) Appeal to Federal Court**

The registrant 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).

The deadline for filing an appeal or commencing a civil action is two months from the issuance date of the decision on petition. 15 U.S.C. §§1071(a)(2) and (b)(1); 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.

Under 37 C.F.R. §2.186(c), a decision on petition is necessary before the registrant can file an appeal or commence a civil action in any court.

**1606.15                    Section 9 Renewal Application Combined with Affidavit  
or Declaration of Use or Excusable Nonuse**

A §9 renewal application and a §8 affidavit may be combined into a single document, if the document meets the requirements of both §§8 and 9 of the Act. 37 C.F.R. §2.166. See TMEP §1604.19 for further information about combined filings under §§8 and 9.

**1607                    Cancellation of Registrations Under §§14 and 37 of the  
Trademark Act**

A petition to cancel a registration owned by another party may be filed with the Trademark Trial and Appeal Board under §14 of the Trademark Act, 15 U.S.C. §1064. See TBMP §§303, 307, 308, and 309, for the requirements and fees for filing a petition to cancel a registration. The cancellation petition can be filed through the Electronic System for Trademark Trials and Appeals (“ESTTA”) at <http://estta.uspto.gov/>.

See TMEP §1608 regarding the voluntary surrender of one’s own registration for cancellation.

Registrations can also be cancelled under §37 of the Trademark Act, 15 U.S.C. §1119, pursuant to the final order of the court in an action involving a registered mark. The party who has prevailed in the civil action must submit a certified copy of the court order or decree to the Office of the Solicitor of the USPTO. See TMEP §1610.

**1608                    Surrender of Registration for Cancellation**

The owner of a registration may voluntarily surrender his or her registration for cancellation, under §7(e) of the Trademark Act, 15 U.S.C. §1057(e). There is no fee.

A request to surrender a registration must be signed by the individual owner, someone with legal authority to bind a juristic owner (e.g., a corporate officer or general partner of a partnership), or a qualified practitioner. 37 C.F.R. §2.172. In the case of joint owners who are not represented by a qualified practitioner, all must sign. 37 C.F.R. §2.193(e)(6).

Filing a §8 affidavit, §71 affidavit, or §9 renewal application for fewer than the total number of classes in the registration is regarded as a surrender of the registration as to the class(es) that are omitted.

Unless the registration is the subject of a cancellation proceeding before the Trademark Trial and Appeal Board, a request for surrender is handled by the Post Registration Section. See TBMP §602.02(a) as to the voluntary surrender of a registration that is the subject of a cancellation proceeding before the Board.

If the registration is surrendered in its entirety, the USPTO updates its records accordingly, and sends the owner of record a notice that the registration is cancelled.

If fewer than all classes are surrendered, the USPTO enters a notation in the record, and updates TRAM and TARR to indicate that specified classes have been cancelled under §7(e) of the Act. A certified copy of the updated registration certificate may be obtained from the Document Services Branch of the Public Records Division for a fee. See TMEP §111.

A request to surrender a registered extension of protection of an international registration to the United States may be filed either directly with the IB or with the USPTO. If it is filed with the USPTO, the USPTO will notify the IB of the cancellation of the request for extension of protection to the United States. See TMEP §§1906.01 *et seq.* regarding requests to record changes at the IB, and TMEP §1906.01(e) regarding renunciation, limitation, or cancellation of an international registration.

## **1609                    Amendment and Correction of Registrations**

### **1609.01                Amendment of Registration - In General**

#### **1609.01(a)            Limited Amendments to Registered Extension of Protection**

An extension of protection of an international registration remains part of (and dependent on) the international registration even after registration in the United States. 15 U.S.C. §1141j; 37 C.F.R. §7.30; TMEP §§1601.01(c) and 1904.08. All requests to record changes to an international registration must be filed at the IB.

Accordingly, the holder of a registered extension of protection may file a request for amendment under §7 of the Trademark Act with the USPTO only in limited circumstances, where the change will affect only the extension of protection to the United States. For example, a holder may request to amend the registered extension of protection to add a voluntary disclaimer, to amend the translation of the mark that was provided during examination in the USPTO, or to limit or partially surrender goods/services/classes. If the USPTO grants the §7 request, the USPTO will notify the IB of the change to the extension of protection to the United States.

The USPTO will not accept an amendment of a registered extension of protection involving the holder's name or address that has not been recorded with the IB. 37 C.F.R. §7.22; TMEP §1906.01(c).

The mark in a registered extension of protection cannot be amended. See TMEP §§1609.02 and 1906.01(i).



See TMEP §§1904.13 *et seq.* regarding amendment and correction of registered extensions of protection, and 1906.01 *et seq.* regarding requests to record changes at the IB.

#### **1609.01(b)      Amendment of Registration Resulting From §1 or §44 Application**

Under §7(e) of the Trademark Act, a registration based on an application under §1 or §44 of the Trademark Act may be amended “for good cause.” Any request for amendment of a mark must be accompanied by the required fee. 15 U.S.C. §1057(e); 37 C.F.R. §§2.6 and 2.173(b)(1). Original certificates of registration are not required for requests for amendment under §7, and owners are strongly discouraged from submitting them. If original certificates are submitted, they will be scanned into TICS and discarded. See notice at [69 FR 51362](#) (Aug. 19, 2004), removing the requirement that a section 7 request include the original certificate.

The request for amendment must be signed and verified (sworn to) or supported by a declaration under 37 C.F.R. §2.20 by the individual owner of the registration, someone with legal authority to bind a juristic owner (e.g., a corporate officer or general partner of a partnership), or a qualified practitioner. 37 C.F.R. §2.173(b)(2). In the case of joint owners who are not represented by a qualified practitioner, all must sign. 37 C.F.R. §2.193(e)(6). See TMEP §§611.06 *et seq.* for guidelines on persons with legal authority to bind various types of juristic entities, and TMEP §§602 *et seq.* regarding persons who are qualified to represent others before the USPTO in trademark cases.

Requests to amend registrations are handled by the Post Registration Section, unless the registration is the subject of an inter partes proceeding before the Trademark Trial and Appeal Board. 37 C.F.R. §2.173(a).

Requests to amend registrations that are the subject of inter partes proceedings before the Trademark Trial and Appeal Board are handled by the Board. See 37 C.F.R. §2.133; TBMP §§514 *et seq.* If a request to amend a registration that is the subject of an inter partes proceeding is filed with the Post Registration Section, the Post Registration staff will deny the request, and advise the owner to file a motion to amend pursuant to 37 C.F.R. §2.133. See TBMP §§502 *et seq.* for further information about filing motions with the Board.

If the request for amendment is granted, the USPTO sends an updated registration certificate showing the amendment to the owner of record, and updates USPTO records accordingly.

## **1609.02                    Amendment of Mark**

### *Mark in Registered Extension of Protection Cannot be Amended*

The holder of a registered extension of protection of an international registration to the United States cannot file a request to amend the mark under §7 of the Trademark Act. A registered extension of protection remains part of the international registration, and all requests to record changes to such a registration must be filed at the IB. However, the Madrid Protocol and the *Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to That Agreement* (“Common Regs.”) do not permit amendment of the mark in an international registration. If the holder of the international registration wants to change the mark in any way, even slightly, the holder must file a new international application. The IB’s *Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol* (2008) (“*Guide to International Registration*”), Para. B.II.69.02, provides as follows:

[T]here is no provision for a mark that is recorded in the International Register to be amended in any way, either on renewal or at any other time. If the holder wishes to protect the mark in a form which differs, even slightly, from the mark as recorded, he must file a new international application. This is true even if the mark has been allowed to be changed in the basic application, the registration resulting from the basic application or the basic registration....

Therefore, the mark in a registered extension of protection cannot be amended.

Although the mark in a registered extension of protection cannot be amended, in some situations the holder of a registered extension of protection may file a request under §7 of the Trademark Act to add a standard character claim. If the international registration does not indicate that the mark is in standard characters, and the holder seeks to amend the registered extension of protection to add a standard character claim, the Post Registration staff must contact the Supervisor of the Madrid Processing Unit (“MPU”) via e-mail for instructions on how to proceed. The holder may not add a standard character claim unless the mark meets the United States requirements for a standard character claim, as set forth in 37 C.F.R. §2.52(a). See TMEP §§807.03(a)-(b).

### *Amendment of Mark in Registration Based on §1 or §44 Application*

Under 15 U.S.C. §1057(e), upon application by the owner and payment of the prescribed fee, a registration based on an application under §1 or §44 of the Trademark Act may be amended for good cause, if the amendment does not

materially alter the character of the mark. 37 C.F.R. §2.173(d). See TMEP §§807.14 *et seq.* and 1609.02(a) regarding material alteration.

#### **1609.02(a) Determining What Constitutes Material Alteration of Mark**

Section 7(e) of the Trademark Act, 15 U.S.C. §1057(e), prohibits an amendment that materially alters the character of the mark. “Material alteration” is the standard for evaluating amendments to marks at all relevant stages of processing, both during examination of the application and after registration. See 37 C.F.R. §§2.72 and 2.173(d); TMEP §§807.14 *et seq.*

In determining whether a proposed amendment is a material alteration of a registered mark, the USPTO will always compare the proposed amendment to the mark *as originally registered*.

The general test of whether an alteration is material is whether, if the mark in an application for registration had been published, the change would require republication in order to present the mark fairly for purposes of opposition. If republication would be required, the amendment is a material alteration.

An amendment of a registered mark is acceptable if the modified mark contains the essence of the original mark (i.e., the mark as originally registered), and the mark as amended creates essentially the same impression as the original mark. *In re Umax Data System, Inc.*, 40 USPQ2d 1539 (Comm’r Pats. 1996). For example, in marks consisting of wording combined with a design, if the word is the essence of the mark and the design is merely background embellishment or display that is not integrated into the mark in any significant way, the removal or change of the design will not be a material alteration of the mark. See *Ex parte Petersen & Pegau Baking Co.*, 100 USPQ 20 (Comm’r Pats. 1953). On the other hand, if a design is integrated into a mark and is a distinctive feature necessary for recognition of the mark, then a change in the design would materially alter the mark. See *In re Dillard Department Stores, Inc.*, 33 USPQ2d 1052 (Comm’r Pats. 1993) (proposed deletion of highly stylized display features of mark “IN•VEST•MENTS” held to be a material alteration); *Ex parte Kadane-Brown, Inc.*, 79 USPQ 307 (Comm’r Pats. 1948) (proposed amendment of “BLUE BONNET” mark to delete a star design and to change the picture of the girl held a material alteration).

When a mark is solely a picture or design, an alteration must be evaluated by determining whether the new form has the same commercial impression as the original mark, i.e., whether the form as altered would be likely to be recognized as the same mark. See *Ex parte Black & Decker Mfg. Co.*, 136 USPQ 379 (Comm’r Pats. 1963) (proposed amendment to delete circle found to be a material alteration, where the circle was determined to be a prominent element of a design mark).

Marks entirely comprised of words can sometimes be varied as to their style of lettering, size, and other elements of form without resulting in a material alteration of the mark. See *Ex parte Squire Dingee Co.*, 81 USPQ 258, *recon. denied*, 81 USPQ 543 (Comm'r Pats. 1949) (amendment from block lettering to script not a material alteration). However, changing from special form to standard characters, or the reverse, may be a material alteration. TMEP §807.03(d).

A generic or purely informational term may be deleted if the essence of the mark in appearance or meaning is not changed, but a word or feature that is necessary to the significance of the mark may not be deleted. Likewise, a unique or prominent design feature may not be deleted. See *In re Richards-Wilcox Mfg. Co.*, 181 USPQ 735 (Comm'r Pats. 1974), *overruled on other grounds*, *In re Umax Data System, Inc.*, 40 USPQ2d 1539 (Comm'r Pats. 1996) (proposed amendment to block lettering from mark comprising a diamond design surrounding the word "FYER-WALL" with an inverted channel bracket around the letters "RW" held a material alteration). See also TMEP §807.14(a) regarding amendments deleting matter from a mark.

#### **1609.02(b) New Drawing Required**

When applying for an amendment to a registration that involves a change in the mark, the owner of the registration must submit a new drawing displaying the amended mark. 37 C.F.R. §2.173(b)(3). See TMEP §§807 *et seq.* regarding drawings.

#### **1609.02(c) Supporting Specimen and Declaration**

The owner of the registration must submit one specimen showing use of the proposed mark as amended on or in connection with the goods or services, and must include an affidavit or a declaration under 37 C.F.R. §2.20 stating that the specimen was in use in commerce at least as early as the date the §7 amendment was filed. 37 C.F.R. §2.173(b)(3).

A request to amend a registration under §7 must be signed and verified (sworn to) or supported by a declaration under 37 C.F.R. §2.20 by the individual owner of the registration, someone with legal authority to bind a juristic owner (e.g., a corporate officer or general partner of a partnership), or a qualified practitioner. 37 C.F.R. §2.173(b)(2); TMEP §§611.03(f) and 1609.01(b). In the case of joint owners who are not represented by a qualified practitioner, all must sign. 37 C.F.R. §2.193(e)(6). If the affidavit or a declaration supporting use of the substitute specimen is submitted in a separate document, it must be signed by a person properly authorized to sign a verification on behalf of the owner. See TMEP §611.03(a) as to persons properly authorized to verify facts on behalf of an owner.

A specimen showing use of the proposed mark as amended on or in connection with the goods or services is required, even if the mark originally registered based on a foreign registration under §44 of the Trademark Act, 15 U.S.C. §1126(e). See TMEP §1015 regarding the independence of a §44 registration from the underlying foreign registration.

See *also* TMEP §§904 *et seq.* regarding specimens.

#### **1609.02(d) Conforming Amendments**

If a registration includes a disclaimer, description of the mark, and/or other miscellaneous statement (e.g., lining or stippling statement (see TMEP §808.01(b)), translation, transliteration, or color claim), any request to amend the registration must also include a request to make any necessary conforming amendments to the disclaimer, description, and/or miscellaneous statement. 37 C.F.R. §2.173(f). For example, if the mark is “XYZ INC.,” with a disclaimer of the entity designator “INC.,” and the owner of the registration proposes to amend the mark to remove “INC.,” the proposed amendment should also request that the disclaimer be deleted.

If a proposed amendment does not include all necessary conforming amendment(s), the Post Registration staff will issue an Office action requiring the amendment(s).

#### **1609.02(e) Amendment of Black-and-White Drawing of Mark for Which Color is Claimed to Substitute Color Drawing**

Prior to November 2, 2003, the USPTO did not publish marks or issue registrations in color. An applicant who wanted to show color in a mark was required to submit a black-and-white drawing, with a statement describing the color(s). See TMEP §807.07(g). Effective November 2, 2003, the USPTO accepts color drawings. Black-and-white drawings with a color claim, or drawings that show color by use of lining patterns, are no longer permitted. Color drawings must be accompanied by a color claim naming the color(s) that are a feature of the mark, and a separate statement specifying where the color(s) appear(s) on the mark. 37 C.F.R. §2.52(b)(1); TMEP §§807.07(a) *et seq.*

In a registration based on an application filed before November 2, 2003, if the application included a black-and-white drawing with a statement claiming color, the owner may file a request under §7 of the Trademark Act to substitute a color drawing for the black-and-white drawing. The request must include: (1) a color drawing showing the same colors claimed in the registration; (2) a color claim naming the color(s) that are a feature of the mark; (3) a description of where the color(s) appear(s) in the mark; and (4) the fee required by 37 C.F.R. §2.6. 37 C.F.R. §2.173(a). No specimen is

required if the owner is merely substituting a color drawing for a legally equivalent black-and-white drawing, and is not amending the mark.

**1609.02(f) Amendment of Black-and-White Drawing to Color Drawing**

A special form drawing registered in black-and-white may be amended under §7(e) to include a claim of color, as long as the amendment does not constitute a material alteration. Requests to amend the mark to color must include: (1) a color drawing; (2) a color claim naming the color(s) that are a feature of the mark; (3) a statement specifying where the color(s) appear(s) in the mark; (4) a specimen showing the mark as depicted on the amended drawing; and (5) the fee required by 37 C.F.R. §2.6. 37 C.F.R. §2.173(b)(2). See TMEP §§807.07 *et seq.* regarding requirements for color drawings, and TMEP §§807.14(e) *et seq.* regarding amendments to color features of marks.

**1609.02(g) Amendment to Special Form Drawing Containing Black, White, and/or Gray**

When a mark shown in special form is amended under §7(e), and the mark shown on the new drawing page contains gray, or the description of the mark refers to black, white, and/or gray, the owner must clarify whether the mark is in color. Specifically, the record must contain either: (1) a statement that the mark is not in color; or (2) a statement that the colors black, white, and/or gray are features of the mark and a statement specifying the location of the colors. If not all are claimed as colors, the color location statement must specify that the black/white/gray is not claimed as color and represents background, outlining, shading, and/or transparent areas.

Likewise, if the §7(e) amendment includes a statement that color is claimed as a feature of the mark and the drawing contains black, white, and/or gray, the record must contain one of the following: (1) a statement that the color(s) black, white, and/or gray are features of the mark and statement specifying the location of the colors; or (2) a statement that the black/white/gray represents background, outlining, shading, and/or transparent areas and is not a part of the mark. No statement regarding a white background is required if the background of the drawing is white and it is clear that the white background is not part of the mark.

See TMEP §§807.07(f) *et seq.* regarding requirements for drawings containing black, white, and/or gray.

### **1609.03                    Amendment of Identification of Goods or Services**

#### *Identification of Goods/Services in Registered Extension of Protection*

The identification of goods/services in a registered extension of protection of an international registration to the United States can be amended only in limited circumstances that will affect only the extension of protection to the United States. TMEP §1609.01(a). Specifically, the holder of a registered extension of protection may file a request with the USPTO to amend the registered extension of protection to limit or partially surrender goods and/or services. If the USPTO grants the §7 request, the USPTO will notify the IB of the change to the extension of protection to the United States. See TMEP §1904.13(a).

All requests to record changes to an international registration must be filed at the IB. See TMEP §§1906.01 *et seq.* regarding requests to record changes at the IB. Note that the IB does not permit amendments that expand the list of goods/services in an international registration. See TMEP §1906.01(i).

See *also* TMEP §1904.15 regarding a notification of limitation in the list of goods/services in a registered extension of protection

#### *Amendment of Registration Based on §1 or §44 Application*

In registrations based on applications under §§1 and 44 of the Trademark Act, amendments may be made to the identification of goods/services to restrict the identification or otherwise to change it in ways that would not require republication of the mark. However, goods/services may not be added to a registration by amendment. See 37 C.F.R. §2.173(e). Changed circumstances (e.g., new technology) will not render acceptable an amendment that is not otherwise permissible. See *In re Capp Enterprises, Inc.*, 32 USPQ2d 1855 (Comm'r Pats. 1993); *In re Fortex Industries, Inc.*, 18 USPQ2d 1224 (Comm'r Pats. 1990); *In re Carter Hawley Hale Stores, Inc.*, 200 USPQ 179 (Comm'r Pats. 1978). For example, if the goods in the registration are identified as “phonograph records,” the identification of goods cannot be amended to “compact discs.”

In a multiple-class registration, deletion of less than all the goods or services in a single class constitutes an amendment, whereas deletion of an entire class constitutes a surrender of the registration for cancellation as to the class deleted. See 37 C.F.R. §2.172. See TMEP §1608 regarding surrender.

### **1609.04                    Amendment of Classification**

#### *Classification of Goods/Services in Registered Extension of Protection Cannot be Amended Under §7*

The classification of goods/services in a registered extension of protection of an international registration to the United States cannot be amended under §7

of the Trademark Act. 37 C.F.R. §2.85(d); TMEP §§1401.03(d) and 1609.01(a). However, the holder of a registered extension of protection may request to amend the registered extension of protection to surrender class(es). See TMEP §1904.13(a).

#### *Amendment of Registration Based on §1 or §44 Application*

In a registration that issued based on an application under §1 or §44 of the Trademark Act, the classification of the goods/services may be amended under §7 of the Trademark Act, if the requested international classification is consistent with the current version of the *Nice Agreement*. 37 C.F.R. §2.85(e)(3). In such a case, the USPTO will amend the international classification of goods/services and issue an updated registration certificate with the new classification noted.

The owner of a registration may reclassify registrations from multiple United States classes into a single international classification. For example, goods in United States classes 21 and 26 often fall into only International Class 9. Hence, an owner can request an amendment from United States classes 21 and 26 into International Class 9. If the owner reclassifies any of the goods/services in this manner, the owner must reclassify all the goods/services in the registration to the international classification system. 37 C.F.R. §2.85(e)(3).

The amendment must include the fee required by 37 C.F.R. §2.6 for §7 amendments.

### **1609.05 Disclaimer of Mark**

A registered mark may be amended to disclaim part of the mark. 37 C.F.R. §2.173(a). However, no amendment seeking the elimination of a disclaimer will be permitted, unless deletion of the disclaimed portion of the mark is also sought. 37 C.F.R. §2.173(g). This exception to the general prohibition against amendments to delete disclaimers applies in the limited situation where the mark is amended to delete the disclaimed matter. See TMEP §1609.02(d) regarding conforming amendments.

An amended registration must still contain registrable matter, and the mark as amended must be registrable as a whole. 37 C.F.R. §2.173(c).

### **1609.06 Territorial Restrictions**

A registration cannot be restricted territorially by amendment under §7(e) of the Act. *In re Forbo*, 4 USPQ2d 1415 (Comm'r Pats. 1984). Generally, a concurrent use restriction cannot be removed from a registration by an amendment under §7(e), except where an entity that was the *only* exception to the owner's right to exclusive use of its registered mark assigns its rights in the mark to the owner of the registration, so that all rights in the mark are



merged in the owner. *In re Alfred Dunhill Ltd.*, 4 USPQ2d 1383 (Comm'r Pats. 1987); TBMP §§1101.02 and 1114.

#### **1609.07                    Dates of Use**

The USPTO will accept a correction request changing the dates of use, even if the corrected dates are later than the dates originally set forth in the registration. See *In re Pamex Foods, Inc.*, 209 USPQ 275 (Comm'r Pats. 1980); *Grand Bag & Paper Co. v. Tidy-House Paper Products, Inc.*, 109 USPQ 395 (Comm'r Pats. 1956). However, the USPTO will not enter a correction if the corrected dates are later than the dates that would have been accepted during examination. Therefore, the USPTO will not enter the following corrections:

- If the application for the registration was based on use in commerce under 15 U.S.C. §1051(a), the registration cannot be corrected to specify a date of use that is later than the application filing date (see 37 C.F.R. §2.71(c)(1));
- If the application for the registration was based on intent-to-use under 15 U.S.C. §1051(b) in which a statement of use was filed under 15 U.S.C. §1051(d), the registration cannot be corrected to specify a date of use that is later than the statutory deadline for filing the statement of use (i.e., within six months of the issuance date of the notice of allowance or before the expiration of an extension of time for filing a statement of use) (see 37 C.F.R. §2.71(c)(2));
- If the application for the registration was based on intent-to-use under 15 U.S.C. §1051(b) in which an amendment to allege use was filed under 15 U.S.C. §1051(c), the registration cannot be corrected to specify a date of use that is later than the filing date of the amendment to allege use (see TMEP §903.04); and
- The date of first use in commerce may not be earlier than the date of first use anywhere (see TMEP §903.03).

#### **1609.08                    Effect of Amendment of Registration on Limitation of Grounds for Cancellation of a Registration**

Section 14 of the Trademark Act, 15 U.S.C. §1064, limits the grounds that a third party can raise in a petition to cancel a mark registered on the Principal Register when the petition is filed more than five years after the date of registration.

Ordinarily, the five-year period runs from the date of the registration of the mark for a registration issued on the Principal Register under the Act of 1946, and from the date of publication under §12(c) of the Act for registrations

issued under prior Acts and published under §12(c) of the Act of 1946, 15 U.S.C. §1062(c).

However, when a registration has been amended, the five-year period runs from the date of the amendment, to the extent that the amendment of the registration has in any way enlarged the owner's rights, as though the registration had issued on the date of the amendment. See TBMP §307.02(c)(2).

#### **1609.09                    Amendment from Supplemental to Principal Register Not Permitted**

A registration on the Supplemental Register may not be amended to the Principal Register. If the owner of a registration wishes to seek registration on the Principal Register of a mark for which it owns a registration on the Supplemental Register, the owner must file a new application. Under 15 U.S.C. §1062(a), a mark must be published for opposition before it can be registered on the Principal Register.

#### **1609.10                    Correction of Mistake in Registration**

The USPTO may make a correction to a registration in appropriate cases, upon written request by the owner of the registration. See §7(g) of the Trademark Act, 37 C.F.R. §2.174, and TMEP §1609.10(a) regarding correction of USPTO errors; and §7(h) of the Act, 37 C.F.R. §2.175, and TMEP §1609.10(b) regarding correction of errors by the owner of a registration. Original certificates of registration need not be submitted with requests for correction under §7, and owners are strongly discouraged from submitting them. If original certificates are submitted, they will be scanned into TICS and discarded. See notice at [69 FR 51362](#) (Aug. 19, 2004), removing the requirement that a section 7 request include the original certificate.

Requests for correction of registrations are handled by the Post Registration Section.

If the request for correction is granted, the USPTO sends an updated registration certificate to the owner of record, and updates USPTO records to show the correction.

#### **1609.10(a)                Correction of USPTO Error**

##### *Registered Extension of Protection*

If USPTO records show that a clerical error occurred through the fault of the USPTO, the USPTO will correct the error without charge. See TMEP

§1904.14 regarding a notification of correction in the international register with respect to a registered extension of protection.

*Registration Based on Application under §1 or §44*

If a clerical error occurred through the fault of the USPTO, the USPTO will correct the error without charge. 15 U.S.C. §1057(g); 37 C.F.R. §2.174. Section 7(g) gives the Director the discretion to issue a certificate of correction of the existing registration, or to issue a new certificate of registration without charge.

The owner of the registration should submit a written request, specifying the error to be corrected. This request should be signed by the individual owner of the registration, someone with legal authority to bind a juristic owner, or the owner's qualified practitioner, and directed to the Post Registration Section.

The USPTO will issue a certificate of correction if the change is non-material, such as a slight misspelling in the mark or the identification of goods/services, or an error in entering the owner's name or address.

A USPTO error in classification may be corrected if the requested classification is consistent with the current version of the *Nice Agreement*. Republication is not required.

If correction of a USPTO error would result in a material change (e.g., a material change of the mark or a broadening of the identification of goods/services), the USPTO will not issue a certificate of correction under §7(g). Section 12(a) of the Trademark Act, 15 U.S.C. §1062(a), requires examination and publication prior to registration. Therefore, if the error results in a material change to the registration, the error can be corrected only by canceling the registration as inadvertently issued and republishing it with the correct information. The USPTO will give the owner the option of either: (1) keeping the registration as issued; or (2) having the registration cancelled as inadvertently issued and republished. If the owner chooses to have the mark republished, and registration is not successfully opposed, the USPTO will issue a new certificate of registration with a new registration date.

In some cases, further examination may be required to correct a USPTO error that would materially change the registration, e.g., where a proposed amendment to the mark or the identification of goods/services was filed prior to registration, but not timely made of record and reviewed by the examining attorney. In this situation, the registration will be cancelled as inadvertently issued and returned to examination. The examining attorney will examine the amendment using standard examination procedures. If the examining attorney approves the amendment, the mark will be republished.

A request to have a registration cancelled as inadvertently issued should be directed to the Office of the Deputy Commissioner for Trademark Examination Policy.

## **1609.10(b) Correction of Owner's Error**

### *Registered Extension of Protection*

Generally, all requests to record changes to an international registration must be filed at the IB, because an extension of protection of an international registration remains part of the international registration even after registration in the United States. However, in the limited circumstance where the holder of an international registration makes a mistake in a document filed during prosecution in the USPTO that affects only the extension of protection to the United States, the registrant may request correction of the error pursuant to 37 C.F.R. §2.175. See TMEP §1904.13(b).

See TMEP §§1906 and 1906.01 *et seq.* regarding requests to record changes at the IB, and TMEP §1904.14 regarding a notification of correction in the International Register with respect to a registered extension of protection.

### *Registration Based on Application under §1 or §44*

Under §7(h) of the Trademark Act, 15 U.S.C. §1057(h), if a mistake in a registration occurs in good faith through the fault of the owner of the registration, the Director may correct the error upon written request and payment of the fee required by 37 C.F.R. §2.6, *provided* the correction does not result in a change that would require republication of the mark.

The owner of the registration must file a written request specifying the error, explaining how the error occurred, and showing that it occurred in good faith. 37 C.F.R. §2.175(b)(1). The request must be signed and verified or supported by a declaration under 37 C.F.R. §2.20 by the individual owner, someone with legal authority to bind a juristic owner (e.g., a corporate officer or general partner of a partnership), or a qualified practitioner. 37 C.F.R. §2.175(b)(2). In the case of joint owners who are not represented by a qualified practitioner, all must sign. 37 C.F.R. §2.193(e)(6). The request for correction should be directed to the Post Registration Section. See TMEP §§611.06 *et seq.* for guidelines on persons with legal authority to bind various types of juristic entities, and TMEP §§602 *et seq.* regarding persons who are qualified to represent others before the USPTO in trademark cases.

As noted above, the owner of a registration cannot correct a mistake if the changes would require republication of the mark. 15 U.S.C. §1057(h); 37 C.F.R. §2.175(a). Thus, a correction cannot be made if it would materially alter the mark, or broaden the identification of goods/services. See TMEP §§807.14 and 1609.02(a) regarding material alteration, and TMEP §1609.03 regarding changes to the identification of goods/services.

A registration can be corrected to cure an inadvertent error in the manner in which the owner's name is set forth. However, the registration cannot be corrected to substitute another entity as the owner. See TMEP §1201.02(c)

for examples of correctable and non-correctable errors in identifying the owner of an application or registration.

Section 7(h) gives the Director the discretion to issue either a certificate of correction of the existing registration or a new certificate of registration. See *In re Pamex Foods, Inc.*, 209 USPQ 275, 277-78 (Comm'r Pats. 1980). In either case, if the mistake was made by the owner of the registration, a fee is required. See 15 U.S.C. §1057(h); 37 C.F.R. §§2.6 and 2.175(b)(3).

#### **1609.11                    Change of Owner's Address Can Be Filed Through TEAS**

It is not necessary to file a §7 amendment to change the address of the owner of a registration. This can be done through TEAS, at <http://www.uspto.gov>.

*Note: The owner's address often differs from the correspondence address. The correspondence address can also be changed through TEAS, using a different form. See TMEP §609.02(e) for information about changing the correspondence address after registration.*

#### **1610                    Court Orders Concerning Registrations**

The USPTO must rectify the register and make appropriate entry upon its records in response to a court order certified to the USPTO pursuant to 15 U.S.C. §1119. That section provides:

In any action involving a registered mark the court may determine the right to registration, order the cancellation of registrations, in whole or in part, restore cancelled registrations, and otherwise rectify the register with respect to the registrations of any party to the action. Decrees and orders shall be certified by the court to the Director, who shall make appropriate entry upon the records of the Patent and Trademark Office, and shall be controlled thereby.

Any such order affecting a registration must be *certified* to the USPTO, and should be addressed to the Office of the Solicitor, Mail Stop 8, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450. 37 C.F.R. §1.1(a)(3)(iii). An uncertified copy of the court order is unacceptable. If the registration affected by the order is the subject of a pending or suspended inter partes proceeding at the Trademark Trial and Appeal Board, that fact should be noted in a cover letter to the Office of the Solicitor. Once the USPTO receives the certified order, appropriate action will typically be taken by the USPTO without the necessity of any submission by an interested party. However, if it would be helpful for purposes of determining the scope or effect of an order, the USPTO may, at the Director's discretion, issue a show cause order directing the registrant and parties to the action from which the order arose to respond and provide information or arguments regarding the order.

## Updating Automated Records to Show the Status of Registrations

USPTO records will be automatically updated to indicate the status of registrations as follows:

- (1) When the owner of a registration timely files a §8 affidavit and/or §9 renewal application, USPTO records are updated to indicate receipt of the document and the action taken on it. This information appears in TRAM and TARR.
- (2) If no §8 affidavit is filed before the end of the grace period (see TMEP §1604.04 regarding the deadline for filing a §8 affidavit), USPTO records are automatically updated to indicate that the registration is cancelled, and this information appears in TRAM and TARR. However, USPTO records are not updated to show that the registration is cancelled until 30 days *after* the expiration of the grace period.
- (3) If no §9 renewal application is filed before the end of the grace period (see TMEP §1606.03 regarding the deadline for filing a renewal application), USPTO records are automatically updated to indicate that the registration is expired, and this information appears in TRAM and TARR. However, USPTO records are not updated to show that the registration is expired until 30 days *after* the expiration of the grace period.

The reason the USPTO waits until 30 days *after* the expiration of the grace period before updating its records to show that the registration is cancelled or expired is to avoid inadvertent cancellation or expiration of a registration due to a delay in entering a timely filed §8 affidavit or §9 renewal application into USPTO records.

If the owner of a registration who has not timely filed a §8 affidavit or §9 renewal application wants to expedite cancellation or expiration of its own registration, the owner may request in writing that the USPTO expedite the processing of the cancellation or expiration of the registration. The request should be signed by the owner, someone with legal authority to bind the owner (e.g., a corporate officer or general partner of a partnership), or a qualified practitioner, and should specifically state that no §8 affidavit or renewal application was filed on or before the end of the grace period. Such a request should be directed to the Post Registration Section; if it is sent to the examining attorney, the examining attorney should forward it to the Supervisor of the Post Registration Section.

See TMEP §716.02(e) regarding suspension of an application for a conflicting mark pending cancellation of the cited registration under §8 of the Act or expiration of the cited registration for failure to renew under §9 of the Act.

### **Powers of Attorney and Designations of Domestic Representative Filed After Registration**

To expedite processing, the USPTO recommends that powers of attorney, requests to revoke powers of attorney, requests to withdraw as attorney, and designations of domestic representative be filed through TEAS, at <http://www.uspto.gov>. When these documents are filed through TEAS, the data is automatically entered into TRAM and TARR.

The USPTO considers a power of attorney to end with registration. See TMEP §604.02.

When the owner of a registration files a new power of attorney or designation of domestic representative *on paper*, the USPTO scans an image of the power or designation into the record, but does not update TRAM and TARR, unless the owner concurrently takes an action such as filing a §8 or §15 affidavit, §9 renewal application, or request to amend or correct a registration under §7 of the Trademark Act. Likewise, when the owner of a registration files a *paper* request to revoke a power of attorney, or a qualified practitioner files a request to withdraw, the USPTO scans an image of the document into the record but does not change the “Attorney” field in TRAM and TARR.

When the owner of a registration files a §8 or §15 affidavit, §9 renewal application, or request to amend or correct a registration through a qualified practitioner, the USPTO will update TRAM and TARR to indicate the name of the practitioner who filed the document, and any designation of domestic representative. If the owner does not have a qualified practitioner, the USPTO will update TRAM and TARR to indicate the owner’s address as shown in the affidavit, renewal application, or amendment.

See TMEP §§605 *et seq.* regarding powers of attorney, TMEP §610 regarding designations of domestic representative by parties not domiciled in the United States, TMEP §607 regarding withdrawal of attorney, and TMEP §609.02(e) regarding changes of correspondence address filed after registration.

### **Affidavit of Use in Commerce or Excusable Nonuse Under §71 of the Trademark Act**

*15 U.S.C. §1141k. Duration, affidavits and fees.*

*(a) Time Periods for Required Affidavits. Each extension of protection for which a certificate has been issued under section 69 shall remain in force for the term of the international registration upon which it is based, except that the extension of protection of any mark shall be canceled by the Director unless the holder of the international registration files in the United States Patent and Trademark Office affidavits that meet the requirements of subsection (b), within the following time periods:*

*(1) Within the 1-year period immediately preceding the expiration of 6 years following the date of issuance of the certificate of extension of protection.*

*(2) Within the 1-year period immediately preceding the expiration of 10 years following the date of issuance of the certificate of extension of protection, and each successive 10-year period following the date of issuance of the certificate of extension of protection.*

*(3) The holder may file the affidavit required under this section within a grace period of 6 months after the end of the applicable time period established in paragraph (1) or (2), together with the fee described in subsection (b) and the additional grace period surcharge prescribed by the Director.*

*(b) Requirements for Affidavit. The affidavit referred to in subsection (a) shall—*

*(1)(A) state that the mark is in use in commerce;*

*(B) set forth the goods and services recited in the extension of protection on or in connection with which the mark is in use in commerce;*

*(C) be accompanied by such number of specimens or facsimiles showing current use of the mark in commerce as may be required by the Director; and*

*(D) be accompanied by the fee prescribed by the Director; or*

*(2)(A) set forth the goods and services recited in the extension of protection on or in connection with which the mark is not in use in commerce;*

*(B) include a showing that any nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark; and*

*(C) be accompanied by the fee prescribed by the Director.*

*(c) Deficient Affidavit. If any submission filed within the period set forth in subsection (a) is deficient, including that the affidavit was not filed in the name of the holder of the international registration, the deficiency may be corrected after the statutory time period, within the time prescribed after notification of the deficiency. Such submission shall be accompanied by the additional deficiency surcharge prescribed by the Director.*

*(d) Notice of Requirement. Special notice of the requirement for such affidavit shall be attached to each certificate of extension of protection.*

*(e) Notification of Acceptance or Refusal. The Director shall notify the holder of the international registration who files any affidavit required by this section of the Director's acceptance or refusal thereof and, in the case of a refusal, the reasons therefor.*

*(f) Designation of Resident for Service of Process and Notices. If the holder of the international registration of the mark is not domiciled in the United States, the holder may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the*



*address specified in the last designation so filed. If the person so designated cannot be found at the last designated address, or if the holder does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, such notices or process may be served on the Director.*

Under §71 of the Trademark Act, 15 U.S.C. §1141k, a registered extension of protection to the United States will be cancelled unless the holder of the international registration periodically files affidavits of use in commerce or excusable nonuse (“§71 affidavits”). The purpose of the §71 affidavit is to remove marks that are no longer being used in commerce from the register.

### **1613.01 Registrations to Which §71 Affidavit Pertains**

Section 71 of the Trademark Act applies only to registered extensions of protection of international registrations to the United States. However, §8 of the Act, 15 U.S.C. §1058, requires periodic affidavits of use or excusable nonuse for registrations resulting from applications under §1 or §44 of the Trademark Act. See TMEP §§1604 *et seq.* for further information about §8 affidavits.

### **1613.02 Notice of When Affidavit Is Due**

A statement noting the requirement for filing the affidavits or declarations of use or excusable nonuse under §71 of the Act is included on each certificate of registration as originally issued. 15 U.S.C. §1141k(d). This is the only notice that the USPTO provides regarding this requirement. The holder must file the affidavit or declaration within the time periods required by §71 of the Act regardless of whether the holder receives the notice. 37 C.F.R. §7.38. The USPTO does not provide any reminder of the due date(s) of the affidavits.

### **1613.03 Form for Filing §71 Affidavit**

To expedite processing, it is recommended that the holder file the §71 affidavit through the Trademark Electronic Application System (“TEAS”). See TMEP §301 for more information about electronic filing. Forms for filing affidavits of use or excusable nonuse under §71 are available through TEAS at <http://www.uspto.gov>. Alternatively, the holder can call the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199 to obtain a pre-printed form that can be filled out and mailed, faxed, or hand delivered to the USPTO.

See TMEP §1613.04 regarding the deadline for filing the affidavit, and TMEP §1613.05 regarding the requirements for filing the affidavit.

## **1613.04 Time for Filing §71 Affidavit**

*37 C.F.R. §7.36(b). During the following time periods, the holder of an international registration must file an affidavit or declaration of use or excusable nonuse, or the registered extension of protection will be cancelled under section 71 of the Act:*

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

*(2) Within the year before the end of every ten-year period after the date of registration in the United States.*

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

Under §§71(a)(1) and (a)(2) of the Trademark Act, the holder of the international registration must file an affidavit or declaration of use or excusable nonuse:

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

(2) within the year before the end of every ten-year period after the date of registration in the United States. 37 C.F.R. §7.36(b).

Under §71(a)(3) of the Act, 15 U.S.C. §1141k(a)(3), the holder may file the affidavit or declaration within a grace period of six months after the expiration of the deadlines set forth in §§71(a)(1) and (a)(2) of the Act, 15 U.S.C. §§1141k(a)(1) and (a)(2), with an additional grace period surcharge.

Affidavits may be filed on the U.S. registration anniversary dates at the end of the fifth and sixth years, or at the end of the ninth and tenth years.

*Example:* For a registration issued on Nov. 1, 2005, a six-year affidavit may be filed as early as Nov. 1, 2010, and may be filed as late as Nov. 1, 2011, before entering the six-month grace period.

A §71 affidavit or declaration filed through TEAS is considered to have been filed on the date the USPTO receives the transmission, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. 37 C.F.R. §2.195(a)(2).

Section 71 affidavits or declarations filed on paper are considered timely if they are received in the USPTO by the due date or if they are mailed or transmitted by the due date with a certificate of mailing or facsimile transmission under 37 C.F.R. §2.197. See TMEP §§305.02 and 306.05 for certificate of mailing and certificate of facsimile transmission procedures to avoid lateness.

If the holder of the registration does not file an affidavit or declaration of use or excusable nonuse before the end of the grace period, the registration will be cancelled. 37 C.F.R. §§7.36(b) and 7.39(d). See TMEP §1613.07 regarding who may file a §71 affidavit.

The Director has no authority to waive the deadline for filing a proper affidavit of use of a registered mark under 15 U.S.C. §1141k. See *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) ("[I]n establishing cancellation as the penalty for failure to file the required affidavit, Congress made no exception for the innocent or the negligent. Thus, the Commissioner had no discretion to do other than cancel Checkers's service mark registration in this case."); *In re Mother Tucker's Food Experience (Canada) Inc.*, 925 F.2d 1402, 1405, 17 USPQ2d 1795, 1798 (Fed. Cir. 1991) ("It was not within the Commissioner's discretionary authority to waive this requirement."); cf. *In re Holland American Wafer Co.*, 737 F.2d 1015, 1018, 222 USPQ 273, 275 (Fed. Cir. 1984) ("Timeliness set by statute is not a minor technical defect which can be waived by the Commissioner.").

#### *Premature Filing of §71 Affidavit*

The affidavit cannot be filed before the periods specified in §71(a) of the Act. The purpose of the affidavit is to show that the mark is still in use in commerce within the relevant period, which cannot be done by an affidavit filed before that period. Cf. *In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984). If an affidavit is filed before the period specified in §§71(a)(1) and (a)(2) of the Act, the USPTO will issue a notice advising the holder: (1) that the affidavit is premature; (2) of the appropriate time for filing the affidavit; (3) that the fee(s) submitted will be held; and (4) that the holder may file a new affidavit at the appropriate time or may request a refund at any time. There is no deficiency surcharge. The prematurely filed affidavit will remain in the record for informational purposes only. The holder of the registration must file a newly executed affidavit or declaration before the end of the grace period or the registration will be cancelled and the USPTO will refund the fees.

See TMEP §1613.08(b) regarding the date of execution of a §71 affidavit.

### **1613.05 Requirements for §71 Affidavit or Declaration of Use or Excusable Nonuse**

*37 C.F.R. §7.37. Requirements for a complete affidavit or declaration of use in commerce or excusable nonuse.*

*A complete affidavit or declaration under section 71 of the Act must:*

*(a) Be filed by the holder of the international registration within the period set forth in §7.36(b);*

*(b) Include a statement that is signed and verified (sworn to) or supported by a declaration under §2.20 of this chapter by a person properly authorized to sign on behalf of the holder, attesting to the use in commerce or excusable nonuse of the mark within the period set forth in section 71 of the Act. The verified statement must be executed on or after the beginning of the filing period specified in §7.36(b). A person who is properly authorized to sign on behalf of the holder is:*

*(1) A person with legal authority to bind the holder; or*

*(2) A person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the holder; or*

*(3) An attorney as defined in §11.1 of this chapter who has an actual written or verbal power of attorney or an implied power of attorney from the holder.*

*(c) Include the U.S. registration number;*

*(d)(1) Include the fee required by §7.6 for each class of goods or services that the affidavit or declaration covers;*

*(2) If the affidavit or declaration is filed during the grace period under section 71(a)(3) of the Act, include the grace period surcharge per class required by §7.6;*

*(3) If at least one fee is submitted for a multi-class registration, but the class(es) to which the fee(s) should be applied are not specified, the Office will issue a notice requiring either the submission of additional fee(s) or an indication of the class(es) to which the original fee(s) should be applied. If the required fee(s) are not submitted within the time period set out in the Office action and the class(es) to which the original fee(s) should be applied are not specified, the Office will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class;*

*(e)(1) Specify the goods or services for which the mark is in use in commerce, and/or the goods or services for which excusable nonuse is claimed under §7.37(f)(2);*

*(2) Specify the goods or services being deleted from the registration, if the affidavit or declaration covers less than all the goods or services or less than all the classes in the registration;*

*(f)(1) State that the registered mark is in use in commerce on or in connection with the goods or services in the registration; or*

*(2) If the registered mark is not in use in commerce on or in connection with all the goods or services in the registration, set forth the date when use of the mark in commerce stopped and the approximate date when use is expected to resume and recite facts to show that nonuse as to those goods or services is due to special circumstances that excuse the nonuse and is not due to an intention to abandon the mark; and*

*(g) Include a specimen showing current use of the mark for each class of goods or services, unless excusable nonuse is claimed under §7.37(f)(2). The specimen must meet the requirements of §2.56 of this chapter.*

## **1613.06 Fees for §71 Affidavit**

### **1613.06(a) Filing Fee for Affidavit or Declaration**

Under 15 U.S.C. §1141k(b) and 37 C.F.R. §7.37(d)(1), an affidavit or declaration of use or excusable nonuse must include the fee required by 37 C.F.R. §7.6 for each class of goods or services that the affidavit or declaration covers. See TMEP §§1401.02 and 1401.04 *et seq.* regarding use of international classification to calculate fees due.

### **1613.06(b) Grace Period Surcharge and Deficiency Surcharge**

If the affidavit or declaration is filed during the grace period under §71(a)(3) of the Act, 15 U.S.C. §1141k (a)(3), it must include the grace period surcharge per class required by 37 C.F.R. §7.6.

Section 71(c) of the Trademark Act, 15 U.S.C. §1141k(c), requires a “deficiency surcharge” for correcting deficiencies in the affidavit or declaration after expiration of the deadlines specified in §71. See TMEP §§1613.17 *et seq.* regarding the deadlines and surcharge for correcting deficiencies.

Only a single deficiency surcharge is required for correcting one or more deficiencies in a multiple-class registration. Similarly, only a single deficiency surcharge is required to correct several deficiencies within one §71 affidavit.

The grace period surcharge applies only where no filing was made during the sixth year after the date of registration, or within the year before the end of any ten-year period after the date of registration. A holder who files within these periods, but corrects a deficiency after these periods have expired, will be subject to the deficiency surcharge only. On the other hand, someone who files during the grace period and cures deficiencies after expiration of the grace period will be subject to both the grace period surcharge (for the ability to file the affidavit during the grace period) *and* the deficiency surcharge (for the ability to correct a deficiency after the end of the grace period). See H.R. Rep. No. 105-194, 105<sup>th</sup> Congress, 1<sup>st</sup> Sess. 17 (1997).

### **1613.06(c) Processing Affidavit or Declaration Filed With Insufficient Fees**

An affidavit or declaration that does not include a fee, or does not include sufficient fees for all the classes to which the affidavit pertains (and the grace period surcharge, where applicable), is deficient. Fee deficiencies may be cured before expiration of the deadlines set forth in §71 of the Act, 15 U.S.C. §1141k, without payment of a deficiency surcharge, or after expiration of the deadlines set forth in §71 of the Act with the deficiency surcharge required by §71(c) of the Act. See TMEP §§1613.17 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

If the affidavit or declaration was filed without sufficient fee(s), but the affidavit or declaration included an authorization to charge deficient fees to a USPTO deposit account (37 C.F.R. §2.208), the required fee(s) (and grace period surcharge, where applicable) will be charged to the deposit account. If the deposit account authorization was included with the affidavit or declaration as filed, and the deposit account had sufficient funds to cover the fee(s) in question, there is no fee deficiency and no deficiency surcharge is required.

An authorization to charge fees to a deposit account with insufficient funds to cover the fee is regarded as a deficiency.

If a check submitted as payment of a filing fee for an affidavit of use or excusable nonuse is returned unpaid, or an electronic funds transfer (“EFT”) or credit card payment is refused or charged back by a financial institution, this is regarded as a deficiency. In addition to the deficiency surcharge (where applicable), there is a fee for processing the payment that was refused. 37 C.F.R. §2.6(b)(12). See TMEP §405.06 for additional information.

If at least one fee is submitted for a multiple-class registration, but the class(es) to which the fee(s) should be applied are not specified, the Post Registration staff will issue an Office action requiring either the submission of additional fee(s) or an indication of the class(es) to which the original fee(s) should be applied. If the holder does not submit the required fee(s) or specify the class(es) to which the original fee(s) should be applied, the USPTO will presume that the fee(s) cover the classes in ascending order, beginning with the lowest-numbered class and will delete any unpaid class(es). 37 C.F.R. §7.37(d)(3). See TMEP §1608 regarding surrender of the registration as to class(es) that are omitted from a §71 affidavit.

## **1613.07                    Ownership and Who May File §71 Affidavit**

### **1613.07(a)            Affidavit or Declaration Must Be Filed by Holder**

The affidavit or declaration of use or excusable nonuse must be filed by the holder of the international registration. Filing by the holder is a minimum requirement that must be met before the expiration of the deadlines set forth in §71(a) of the Act, 15 U.S.C. §1141k(a), (i.e., during the sixth year after the date of registration in the United States, or within the year before the end of every ten-year period after the date of registration in the United States), or within the six-month grace period after expiration of these deadlines. 37 C.F.R. §§7.36(b), 7.37(a).

If it is unclear whether the party who filed the affidavit is the present holder, the Post Registration staff will issue an Office action requiring the party to establish its ownership. See TMEP §1613.07(b).

If the affidavit or declaration was not filed in the name of the holder of the registration, and there is time remaining in the statutory filing period (which includes the grace period), the true holder may (1) submit, after notification from the Office, a correction of the name in the filing of record or (2) file a complete new affidavit or declaration, together with the filing fee per class required by 37 C.F.R. §7.6, and, if applicable, a specimen of use for each class. If a new affidavit or declaration is filed during the grace period, the holder must include the grace period surcharge per class with the new affidavit or declaration. If a correction is submitted, the holder must also confirm that the original affidavit was signed by a person properly authorized to sign on behalf of the true holder. 37 C.F.R. §§2.193(e)(1) and 7.37(b); TMEP §1613.08(a). If the original affidavit was not signed by an authorized signatory, the holder must also submit a statement, signed and verified (sworn to) or supported by a declaration under 37 C.F.R. §2.20 by a person properly authorized to sign on behalf of the holder, that affirms the representations in the original affidavit. 37 C.F.R. §7.37(b).

If the affidavit or declaration was not filed in the name of the holder of the registration, and there is no time remaining in the grace period, the deficiency may be corrected within a prescribed time. 15 U.S.C. §1141k(c). The Post Registration staff will issue an Office action notifying the party who filed the affidavit of the ownership issue and of the time period within which it must be corrected. The true holder may submit a correction to the filing of record within the prescribed time and must also include the deficiency surcharge. 37 C.F.R. §7.6(a)(8). If a correction is submitted, the holder must also verify that the original affidavit was signed by a person properly authorized to sign on behalf of the true holder. 37 C.F.R. §§2.193(e)(1) and 7.37(b); TMEP §1613.08(a). If the original affidavit was not signed by an authorized signatory, the holder must also submit a statement, signed and verified (sworn to) or supported by a declaration under 37 C.F.R. §2.20 by a person properly authorized to sign on behalf of the holder, that affirms the representations in the original affidavit. 37 C.F.R. §7.37(b).

See *also* TMEP §1613.07(e) regarding mistakes in setting forth the name of the holder.

### **1613.07(b) Establishing Ownership**

When the affidavit is filed by someone other than the original holder of the registration, the USPTO cannot accept the affidavit unless there is a clear chain of title from the original holder to the party who filed the affidavit. TMEP §502.01.

If USPTO records do not show a clear chain of title in the party who filed the affidavit, the Post Registration staff will issue an Office action requiring the party to establish its ownership of the registration. Ownership can be established by recording the appropriate documents with the International

Bureau of the World Intellectual Property Organization (“IB”). 37 C.F.R. §7.22; TMEP §1904.06. Actual evidence cannot be submitted to the USPTO to establish ownership of an extension of protection.

Because an extension of protection remains part of the international registration, assignments of extensions of protection to the United States must first be recorded at the IB. A holder cannot file an assignment (or other document transferring title) of an extension of protection to the United States directly with the Assignment Services Branch of the USPTO. The USPTO will record only those notifications received from the IB. The IB will notify the USPTO of any changes of the name of the holder or in ownership of the international registration recorded in the International Register, and the USPTO will automatically update its database to reflect the change(s). TMEP §§501.07 and 1904.06.

The holder should notify the Post Registration staff when Office records indicate that the change in the name or ownership has been received from the IB. The USPTO cannot recognize the party who filed the §71 affidavit as the current holder until notification is received from the IB that a change in name or ownership has been recorded. Therefore, the holder may wish to contact the IB at <http://www.wipo.int/madrid/en/contact.html> regarding the recordation of the appropriate documents. Additionally, a new holder can check TARR to determine whether the trademark database has been updated to reflect all changes received from the IB.

See TMEP §1613.07(a) regarding an affidavit or declaration filed by a party who was not the holder of the registration at the time of filing.

### **1613.07(c) Changes of Legal Entity**

The procedures for establishing ownership, as discussed in TMEP §1613.07(b), also apply to changes of name and changes of legal entity. See TMEP §1613.07(d) regarding changes of name.

A change in the country or other jurisdiction of incorporation is a change of legal entity, creating a new party.

The death of a partner, or other change in the membership of a partnership, normally creates a change in legal entity unless the partnership agreement provides for continuation of the partnership and the relevant law permits this.

A merger of companies into a new company normally constitutes a change of legal entity.

Affidavits may be accepted from trustees, executors, administrators, and the like, when supported by a court order or other evidence of the person’s authority to act on behalf of the present holder. If there is a court order, a copy of the order should be submitted.



### **1613.07(d) Changes of Name**

A mere change of the name of a party is not a change of entity and will not require an inquiry regarding ownership, if there is clear title in the party who filed the §71 affidavit. Therefore, if the holder records a change of name with the IB and subsequently files the §71 affidavit in its former name, the USPTO will not issue an inquiry regarding ownership.

However, if it is unclear from USPTO records whether the party who filed the affidavit is the holder of record, the holder must record appropriate documentation of the change of name with the IB. See 37 C.F.R. §7.22 and TMEP §1613.07(b). Actual evidence cannot be submitted to the USPTO to establish ownership of an extension of protection.

### **1613.07(e) Correction of Mistake in Setting Forth the Name of the Holder**

If the affidavit or declaration was filed by the holder of the registration, but there is a mistake in the manner in which the name of the holder is set out in the affidavit, the mistake can be corrected. See *In re Atlanta Blue Print Co.*, 19 USPQ2d 1078 (Comm'r Pats. 1990). No deficiency surcharge is required in this situation.

See TMEP §1613.07(a) regarding an affidavit or declaration mistakenly filed in the name of a person or existing legal entity who did not own the mark as of the filing date.

See TMEP §1201.02(c) for examples of correctable and non-correctable errors.

## **1613.08 Execution of Affidavit or Declaration**

### **1613.08(a) Persons Who May Sign Affidavit or Declaration**

Under 37 C.F.R. §7.37(b), the §71 affidavit or declaration must include a statement that is signed and verified (sworn to) or supported by a declaration under 37 C.F.R. §2.20 by a person properly authorized to sign on behalf of the holder. A “person who is properly authorized to sign on behalf of the holder” is: (1) a person with legal authority to bind the holder; (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the holder; or (3) an attorney as defined in 37 C.F.R. §11.1 who has an actual written or verbal power of attorney or an implied power of attorney from the holder. 37 C.F.R. §7.37(b).

Generally, the USPTO does not question the authority of the person who signs a verification unless there is an inconsistency in the record as to the signatory’s authority to sign. See TMEP §611.03(a).

### **1613.08(b) Date of Execution of Affidavit or Declaration**

Under 37 C.F.R. §7.37(b), the verified statement must be executed on or after the beginning of the relevant filing period specified in §71 of the Act, 15 U.S.C. §1141k, (i.e., on or after the fifth anniversary of the date of registration in the United States, on or after the beginning of the one-year period before the end of each ten-year period after the date of registration in the United States, or during the available grace period). Because the purpose of the affidavit is to attest to the use or excusable nonuse of the mark within the time periods specified in §71 of the Act, the affidavit cannot be executed before these time periods begin.

An affidavit filed within the period specified in §71 of the Act, but executed before that period, is deficient. The holder of the registration will be required to submit a substitute or supplemental affidavit or declaration attesting to use in commerce (or excusable nonuse) on or in connection with the goods or services within the relevant period specified in §71 of the Act.

If the prematurely executed §71 affidavit was filed during the relevant period specified in §71(a) of the Act (i.e., during the sixth year after the date of registration in the United States or within one year before the end of any ten-year period after the date of registration in the United States), the substitute affidavit may be filed before expiration of the relevant period for no fee, or after expiration of the relevant period with the deficiency surcharge required under §71(c) of the Act. If the prematurely executed §71 affidavit was filed during the grace period, the substitute affidavit may be filed before expiration of the grace period for no fee, or after expiration of the grace period with the deficiency surcharge. See TMEP §1613.04 regarding the deadlines for filing §71 affidavits and TMEP §§1613.17 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

*Date of Execution Omitted.* If the §71 affidavit is signed, but the date of execution is omitted, the Post Registration staff must require that the holder of the registration set forth the date of execution for the record. If the affidavit was executed within the relevant filing period, no deficiency fee is required. If there are no other outstanding issues, the holder may provide the Post Registration staff with the date by telephone or e-mail and the Post Registration staff must make a note in the “Notes-to-the-File” section of the record. If the affidavit was not executed within the relevant filing period, the affidavit is deficient, and the holder must submit a substitute or supplemental affidavit, as discussed above.

### **1613.08(c) Signature of Electronically Transmitted Affidavit or Declaration**

See 37 C.F.R. §2.193(c) and TMEP §611.01(c) regarding signature of an affidavit or declaration filed through TEAS.

#### **1613.08(d) Form and Wording of Verification**

The format of the verification may be: (1) the classical form for verifying, which includes an oath (jurat) (see TMEP §804.01(a)); or (2) a declaration under 37 C.F.R. §2.20 or 28 U.S.C. §1746 instead of an oath (see TMEP §804.01(b)).

#### **1613.09 Goods and/or Services Set Forth in §71 Affidavit or Declaration**

##### **1613.09(a) Goods and/or Services Must Be Specified or Expressly Incorporated by Reference**

Under 15 U.S.C. §1141k(b) and 37 C.F.R. §7.37(e)(1), the affidavit or declaration must specify the goods/services recited in the registration on or in connection with which the mark is in use in commerce, and/or the goods/services for which excusable nonuse is claimed. See TMEP §1613.10 regarding use in commerce and TMEP §1613.11 regarding excusable nonuse. The affidavit or declaration may incorporate by reference the identification set forth in the registration certificate (e.g., “all goods/services listed in the registration” or “all goods/services listed in the registration except... [specifying the goods/services not covered by the affidavit or declaration]”). Incorporation by reference is recommended to avoid inadvertent omissions.

If the holder is alleging use with respect to some of the goods/services and excusable nonuse for other goods/services, the holder must clearly indicate which goods/services are in use and which goods/services are not in use.

##### **1613.09(b) Deletion of Goods and/or Services**

##### **1613.09(b) Deletion of Goods and/or Services**

If the holder of the registration intends to delete goods/services from the registration, this should be expressly stated in the affidavit or declaration. 37 C.F.R. §7.37(e)(2). Once a holder expressly indicates an intention to delete goods, services, or classes from a registration, they may not be reinserted.

##### **1613.09(c) Failure to List All Goods and/or Services Recited in Registration**

An affidavit or declaration that fails to list or incorporate by reference all the goods/services recited in the registration, and does not include a statement of intent to delete the omitted goods/services, is deficient. The Post Registration staff will issue an Office action requiring the party to either file a substitute or supplemental affidavit or declaration that the mark was in use in commerce

on or in connection with the omitted goods/services or state that the omitted goods/services should be deleted.

If the holder files a substitute or supplemental affidavit or declaration adding the omitted goods/services, the holder must verify that the mark was in use in commerce on or in connection with the goods/services during the relevant filing period specified in §71 of the Act, 15 U.S.C. §1141k. This substitute affidavit may be filed before expiration of the relevant deadline set forth in §71 of the Act for no fee, or after expiration of the deadline set forth in §71 of the Act with the deficiency surcharge required by §71(c) of the Act. See TMEP §§1613.17 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

If the holder does not file a substitute or supplemental affidavit or declaration that the mark was in use in commerce on or in connection with the omitted goods/services within the period for response to the Office action (see TMEP §1613.16), the omitted goods/services will be deleted from the registration.

#### **1613.09(d) New Goods and/or Services Cannot Be Added**

Goods and/or services that are not listed in the registration may not be set forth in the §71 affidavit.

#### **1613.10 Use in Commerce**

The §71 affidavit must state that the mark is in use in commerce on or in connection with the goods and/or services listed in the registration, unless excusable nonuse is claimed. 37 C.F.R. §7.37(f)(1). See TMEP §1613.11 regarding excusable nonuse. The §71 affidavit does not have to specify the type of commerce (e.g., interstate) in which the mark is used. The USPTO presumes that someone who states that the mark is in use in commerce is stating that the mark is in use in a type of commerce that Congress can regulate, unless there is contradictory evidence in the record.

A §71 affidavit that does not state that the mark is in use in commerce is deficient. The holder must submit a substitute affidavit or declaration stating that the mark was in use in commerce on or in connection with the goods and/or services listed in the registration during the relevant period specified in §71 of the Trademark Act, 15 U.S.C. §1141k, as follows:

- (1) If the §71 affidavit was filed during the sixth year after the date of registration in the United States, the substitute affidavit must state that the mark was in use in commerce on or in connection with the goods/services before the expiration of the sixth year after the date of registration, if accurate; or
- (2) If the §71 affidavit was filed within one year before the end of any ten-year period after the date of registration in the United States, the

substitute affidavit must state that the mark was in use in commerce on or in connection with the goods/services within one year before the end of the ten-year period after the date of registration, if accurate; or

- (3) If the §71 affidavit was filed during the grace period, the substitute affidavit must state that the mark was in use in commerce on or in connection with the goods/services before the expiration of the grace period, if accurate.

If the §71 affidavit was filed during the relevant period specified in §71(a) of the Act (i.e., during the sixth year after the date of registration in the United States, or within one year before the end of any ten-year period after the date of registration in the United States), the substitute affidavit may be filed before expiration of the relevant period for no fee, or after expiration of the relevant period with the deficiency surcharge required under §71(c) of the Act. If the §71 affidavit was filed during the grace period, the substitute affidavit may be filed before expiration of the grace period for no fee, or after expiration of the grace period with the deficiency surcharge. See TMEP §1613.04 regarding the deadlines for filing §71 affidavits, and TMEP §§1613.17 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

While a substitute affidavit may be filed after the expiration of the period specified in §71 of the Act, the substitute affidavit must attest to use within the time period specified in §71 of the Act. Therefore, if the substitute affidavit does not state that the mark was in use in commerce on or in connection with the goods/services within the relevant period specified in §71 of the Act, the USPTO will not accept the §71 affidavit, and the registration will be cancelled.

#### **1613.11 “Excusable Nonuse” of Mark**

*Extract from 37 C.F.R. §7.37. A complete affidavit or declaration under section 71 of the Act must:*

*. . .*

*(f) . . .*

*(2) If the registered mark is not in use in commerce on or in connection with all the goods or services in the registration, set forth the date when use of the mark in commerce stopped and the approximate date when use is expected to resume and recite facts to show that nonuse as to those goods or services is due to special circumstances that excuse the nonuse and is not due to an intention to abandon the mark[.]*

The purpose of Section 71 of the Trademark Act is to remove from the register those registrations that have become deadwood. See *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (C.C.P.A.

1969). It is not intended, however, to cancel registrations because of a temporary interruption in the use of the mark due to circumstances beyond the control of the holder of the registration. See *In re Moorman Mfg. Co.*, 203 USPQ 712 (Comm'r Pats. 1979). Thus, if the mark is not in use in commerce but the holder believes the registration should not be cancelled, the holder may file an affidavit or declaration showing that nonuse is due to special circumstances that excuse the nonuse, and is not due to any intention to abandon the mark. 15 U.S.C. §1141k(b)(2). See *Ex parte Kelley-How-Thomson Co.*, 118 USPQ 40 (Comm'r Pats. 1958).

#### *Requirements for Affidavit*

Since "showing" implies proof, merely stating that special circumstances exist and there is no intention to abandon the mark is not sufficient. See *In re Conusa Corp.*, 32 USPQ2d 1857 (Comm'r Pats. 1993); *In re Moorman Mfg. Co.*, *supra*; *Ex parte Astra Pharmaceutical Products, Inc.*, 118 USPQ 368 (Comm'r Pats. 1958); *Ex parte Denver Chemical Mfg. Co.*, 118 USPQ 106 (Comm'r Pats. 1958). The affidavit must state when use in commerce stopped and give the approximate date when use is expected to resume. 37 C.F.R. §7.37(f)(2). It should also specify the reason for nonuse, the specific steps being taken to put the mark back in use, and any other relevant facts.

Sufficient facts must be set forth to demonstrate clearly that nonuse is due to some special circumstance beyond the holder's control or "forced by outside causes." See *In re Conusa Corp.*, *supra*; *In re Moorman Mfg. Co.*, *supra*; *Ex parte Kelley-How-Thomson Co.*, *supra*.

The goods/services for which excusable nonuse is claimed must be specified. See TMEP §§1613.09 *et seq.* regarding proper specification of the goods and services.

In a multiple-class registration, there must be a recitation of facts as to nonuse for each class to which the affidavit pertains, or it must be clear that the facts recited apply to all the classes.

#### *Presumption of Abandonment*

If the mark has not been in use for three consecutive years and the holder has done nothing to try to resume use of the mark, the Office may presume that the holder has abandoned the mark. 15 U.S.C. §1127. See *Imperial Tobacco Ltd. v. Phillip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990); *Stromgren Supports Inc. v. Bike Athletic Co.*, 43 USPQ2d 1100 (TTAB 1997).

#### *Examples of Special Circumstances That Do and Do Not Excuse Nonuse*

In addition to a showing that there is no intention to abandon the mark, the holder must show that nonuse is due to special circumstances beyond the

holder's control that excuse nonuse. The following examples provide general guidelines as to what is considered to be a special circumstance that excuses nonuse:

- *Business Decision.* Nonuse related to a business decision is not beyond the holder's control and does not excuse nonuse.
- *Decreased Demand.* Decreased demand for the product sold under the mark, resulting in its discontinuance for an indefinite period, does not excuse nonuse. The purpose of the affidavit requirement is to eliminate registrations of marks that are in nonuse due to ordinary changes in social or economic conditions. See *In re Conusa Corp.*, *supra*; *In re Parmalat S.p.A.*, 32 USPQ2d 1860 (Comm'r Pats. 1991); *Ex parte Astra Pharmaceutical Products, Inc.*, *supra*; *Ex parte Denver Chemical Mfg. Co.*, *supra*.
- *Trade Embargo or Other Circumstance Beyond Holder's Control.* Nonuse may be considered excusable where the holder of the registration is willing and able to continue use of the mark in commerce, but is unable to do so due to a trade embargo.
- *Sale of a Business.* Temporary nonuse due to the sale of a business might be considered excusable.
- *Retooling.* The mark might be out of use temporarily because of an interruption of production for retooling of a plant or equipment, with production possible again at a scheduled time. However, nonuse due to retooling is excusable only if the holder shows that the plant or equipment being retooled was essential to the production of the goods and that alternative equipment was unavailable on the market. See *In re New England Mutual Life Insurance Co.*, 33 USPQ2d 1532 (Comm'r Pats. 1991).
- *Orders on Hand.* If the product is of a type that cannot be produced quickly or in large numbers (e.g., airplanes), yet there are orders on hand and activity toward filling them, nonuse might be considered excusable.
- *Illness, Fire, and Other Catastrophes.* Illness, fire, and other catastrophes may create situations of temporary nonuse, with the holder being able to outline arrangements and plans for resumption of use. Such nonuse is often excusable. However, a mere statement that the holder is ill and cannot conduct his or her business will not in itself excuse nonuse; the holder must show that the business is an operation that could not continue without his or her presence. See *New England Mutual Life Insurance*, *supra*.

- *Negotiations with Distributors.* A recitation of efforts to negotiate agreements that would allow for resumption of use of the mark, or a statement that samples of the goods have been shipped to potential distributors, may establish lack of intention to abandon the mark, but does not establish the existence of special circumstances that excuse the nonuse. See *In re Parmalat, supra*; *In re Moorman, supra*.
- *Use in Foreign Country.* Use of the mark in a foreign country has no bearing on excusable nonuse of a mark in commerce that can be regulated by the United States Congress. See *In re Conusa, supra*.
- *Use of Mark on Different Goods/Services.* Use of the mark on goods/services other than those recited in the registration does not establish either special circumstances or lack of intention to abandon the mark. See *Ex parte Kelley-How-Thomson Co., supra*.
- *Use of Mark in Another Form.* Use of a mark as an essential part of a materially different composite mark does not excuse the failure to use the mark at issue. See *In re Continental Distilling Corp.*, 254 F.2d 139, 117 USPQ 300 (C.C.P.A. 1958).

#### *Supplementary Evidence or Explanation of Nonuse*

If the USPTO determines that the facts set forth do not establish excusable nonuse, the holder may file supplementary evidence or explanation, within the response period set forth in the Office action. If the affidavit included a claim of excusable nonuse when filed, no deficiency surcharge will be required for supplementing this claim with additional evidence or an explanation.

#### *Substitute Affidavit Claiming Use*

If the holder responds to the Office action by submitting a substitute affidavit with a claim of use, the USPTO will examine the substitute use affidavit.

### **1613.12 Specimen Showing Current Use of Mark in Commerce**

#### **1613.12(a) Specimen for Each Class Required**

A §71 affidavit must include a specimen or facsimile showing current use of the mark for each class of goods or services, unless excusable nonuse is claimed. 15 U.S.C. §1141k(b); 37 C.F.R. §7.37(g).

See TMEP §§904.03 *et seq.* regarding trademark specimens and TMEP §§1301.04 *et seq.* regarding service mark specimens.

The specimen must show use of essentially the same mark as the mark shown in the registration, and must be used on or in connection with the goods/services listed in the registration. A specimen that shows use of a



materially different mark (see TMEP §1613.13), or shows use of the mark on other goods or services, is unacceptable. An affidavit or declaration that does not include an acceptable specimen for each class of goods/services is deficient. See 37 C.F.R. §7.37(g).

If a single specimen supports multiple classes, the holder may so indicate, and the Post Registration staff need not require multiple copies of the specimen. The Post Registration staff should make a note in the “Notes-to-the-File” section of the record indicating which classes the specimen supports.

The specimen should be flat and no larger than 8½ inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long. If a specimen exceeds these size requirements, the USPTO will create a facsimile of the specimen that meets these requirements (i.e., is flat and no larger than 8½ inches wide by 11.69 inches long), put it in the record, and destroy the original bulky specimen. If the copy of the specimen created by the USPTO does not adequately depict the mark, the Post Registration staff will require a substitute specimen that meets these size requirements, and an affidavit or declaration verifying the use of the substitute specimen.

If the specimen is otherwise deficient, the Post Registration staff will require a substitute specimen, together with an affidavit or declaration that the substitute specimen was in use in commerce on or in connection with the goods or services during the relevant period specified in §71 of the Act. See 37 C.F.R. §7.39; see *also* TMEP §1613.12(c) regarding substitute specimens.

The USPTO will not return specimens filed with a §71 affidavit or declaration.

#### **1613.12(b) Specimens in Electronically Filed Affidavits**

If the holder files the §71 affidavit through TEAS, the holder should submit a digitized image in .jpg or .pdf format.

Sometimes, no visible specimen is in the record due to a technical problem during submission of the affidavit. In this situation, the Post Registration staff should first send an e-mail to the TEAS mailbox to ask whether the problem can be fixed by uploading the file again. If it cannot, the Post Registration staff must ask the holder to submit: (1) the specimen (or a facsimile of the specimen) that was attached to the original electronically filed affidavit; and (2) a statement by the person who transmitted the affidavit to the USPTO that the specimen being submitted is a true copy of the specimen submitted with the electronically filed affidavit. This statement does not have to be verified. Alternatively, the holder may submit a new specimen, together with an affidavit or declaration that the substitute specimen was in use in commerce on or in connection with the goods/services during the relevant period specified in §71 of the Act. No deficiency surcharge is required. See TMEP

§1613.12(c) regarding the requirements for an affidavit supporting use of substitute specimens.

The Office prefers that the specimen, whether a true copy of the original or a substitute, be submitted electronically via the Trademark Electronic Application System (“TEAS”). In TEAS, the Response to Office Action form can be accessed by clicking on the link entitled “Response Forms” at <http://www.uspto.gov>.

### **1613.12(c)      Substitute Specimens**

If a specimen for any class is omitted or is deficient, the holder must file a substitute specimen, together with an affidavit or declaration that the substitute specimen was in use in commerce on or in connection with the goods or services during the relevant period specified in §71 of the Act, 15 U.S.C. §1141k, as follows:

- (1) If the §71 affidavit was filed during the sixth year after the date of registration in the United States, the affidavit supporting use of the substitute specimen must state that the substitute specimen was in use in commerce before the expiration of the sixth year after the date of registration, if accurate; or
- (2) If the §71 affidavit was filed within one year before the end of any ten-year period after the date of registration in the United States, the affidavit supporting use of the substitute specimen must state that the substitute specimen was in use in commerce within one year before the end of the ten-year period after the date of registration, if accurate; or
- (3) If the §71 affidavit was filed during the grace period, the affidavit supporting use of the substitute specimen must state that the substitute specimen was in use in commerce before the expiration of the grace period, if accurate.

If the §71 affidavit was filed during the relevant period specified in §71(a) of the Act (i.e., during the sixth year after the date of registration in the United States, or within one year before the end of any ten-year period after the date of registration in the United States), the substitute specimen may be filed before expiration of the relevant period for no fee, or after expiration of the relevant period with the deficiency surcharge required under §71(c) of the Act. If the §71 affidavit was filed during the grace period, the substitute specimen may be filed before expiration of the grace period for no fee, or after expiration of the grace period with the deficiency surcharge. See TMEP §1613.04 regarding the deadlines for filing §71 affidavits and TMEP §1613.17 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

While a substitute specimen and supporting affidavit may be filed after the expiration of the period specified in §71 of the Act, the supporting affidavit must attest to use of the specimen within the time period specified in §71 of the Act. Therefore, if the affidavit supporting the substitute specimen does not state that the specimen was in use in commerce prior to the end of the relevant period specified in §71 of the Act, the USPTO will not accept the affidavit, and the registration will be cancelled as to any class for which no proper specimen was submitted.

See 37 C.F.R. §2.193(e)(1) and TMEP §611.03(a) regarding the proper person to sign an affidavit or declaration.

### **1613.13 Differences in the Mark as Used on the Specimen and the Mark as Registered**

The mark to which the §71 affidavit pertains must be essentially the same as the mark that appears in the registration. Where the specimen reflects a change in the mark since the registration issued, acceptance of the affidavit will depend on the degree of change. A *material* alteration of the mark will result in refusal of the affidavit on the ground that the registered mark is no longer in use. See *In re Int'l Nickel Co., Inc.*, 282 F.2d 952, 127 USPQ 331 (C.C.P.A. 1960); *In re Continental Distilling Corp.*, 254 F.2d 139, 117 USPQ 300 (C.C.P.A. 1958); *Ex parte Richards*, 153 USPQ 853 (Comm'r Pats. 1967). See also *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986); *In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984).

Mere changes in background or styling, or modernization, are not ordinarily considered to be material changes in the mark. See *Ex parte Petersen & Pegau Baking Co.*, 100 USPQ 20 (Comm'r Pats. 1953) (change in matter determined to be mere background and type face held not a material alteration of "PETER PAN" mark). Whether the change in a mark as used on the specimen is a material change is a question of fact that the Post Registration staff must determine on a case-by-case basis.

Generally, the standard used to determine whether a change is material under §71 is the same as the standard used to determine whether the mark in a registration based on an application under §1 or §44 of the Trademark Act may be amended under 15 U.S.C. §1057(e). If the mark could be amended under §7(e) because the character of the mark had not been materially altered, then the specimen filed with the §71 affidavit should be accepted. In determining whether a change constitutes a material alteration, the USPTO will always compare the mark in the specimen to the mark as originally registered. See TMEP §§807.14 *et seq.* and 1609.02(a) for additional information about material alteration.

However, where the registered mark is currently used as one of several elements in a composite mark, the decision as to whether to accept the

specimen requires consideration of whether the registered mark makes an impression apart from the other elements of the composite mark. If the display of the composite is such that the essence of the registered mark makes a separate impression, then the specimen may be sufficient for purposes of the §71 requirement. In many cases, word elements are severable from design elements, because words tend to dominate in forming a commercial impression. See *In re DeWitt Int'l Corp.*, 21 USPQ2d 1620 (Comm'r Pats. 1991). If the mark, as used on the §71 specimen, creates a separate impression apart from any other material on the specimen, then the specimen may be accepted as evidence of current use of the registered mark.

If the USPTO determines that the mark on the specimen is a material alteration of the registered mark, the holder may file a substitute specimen. If the holder files a substitute specimen after expiration of the relevant filing period specified in §71 of the Act, the holder must pay the deficiency surcharge required by §71(c) of the Act, 15 U.S.C. §1141k(c), and 37 C.F.R. §7.6. See TMEP §1613.12(c) regarding substitute specimens, and 37 C.F.R. §7.39 and TMEP §§1613.17 *et seq.* regarding the procedures for correcting deficiencies in a §71 affidavit.

#### **1613.13(a)      Amendment of Mark in Registration**

If the USPTO accepts the §71 affidavit, and there is a difference between the mark on the specimen filed with the affidavit and the mark in the registration, the mark as originally registered remains the mark of record. The holder cannot file a request for amendment under §7(e) of the Act as the mark in a registered extension of protection cannot be amended. In some situations, however, the owner may file a request under §7(e) to add a standard character claim. See TMEP §1609.02.

#### **1613.14      Designation of Domestic Representative by Foreign Holder**

Under 15 U.S.C. §1141k(f), if the holder of the international registration of the mark is not domiciled in the United States, the affidavit or declaration may include the name and address of a United States resident upon whom notices or process in proceedings affecting the registration may be served. The USPTO encourages parties who do not reside in the United States to designate domestic representatives. To expedite processing, the USPTO recommends that designations of domestic representative be filed through TEAS, at <http://www.uspto.gov>. See TMEP §610.

The designation should be signed by the individual holder, someone with legal authority to bind a juristic holder (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"). In the case of

joint holders who are not represented by a qualified practitioner, all must sign. 37 C.F.R. §2.193(e)(8); TMEP §611.03(h).

### **1613.15 Office Actions and Notices Regarding Affidavit**

Upon receipt of a §71 affidavit, the USPTO updates the prosecution history of the registration in TRAM and TARR to indicate that the affidavit has been filed.

When a §71 affidavit is filed electronically, TEAS almost immediately displays a “Success” page that confirms receipt. This page is evidence of filing should any question arise as to the filing date of the affidavit, and it may be printed or copied-and-pasted into an electronic record for storage. TEAS also separately sends an e-mail acknowledgement of receipt, which includes a summary of the filed information.

If a §71 affidavit is filed on paper, no acknowledgment of receipt of the affidavit is sent before it is examined, unless the applicant includes a stamped, self-addressed postcard with the affidavit (see TMEP §303.02(c) *et seq.*).

If, upon examination, the USPTO determines that the affidavit or declaration is acceptable, the USPTO sends a notice of acceptance. If the affidavit or declaration is not acceptable, the USPTO issues an action stating the reasons for refusal. 37 C.F.R. §7.39.

The propriety of the original registration is not re-examined in connection with the affidavit under §71.

### **1613.16 Response to Office Action**

*Deadline.* Under 37 C.F.R. §7.39(a), the holder must file a response to a refusal within six months of the issuance date of the Office action, or before the end of the relevant filing period set forth in §71(a) of the Act, whichever is later. If no response is received within that time, the registration will be cancelled, unless time remains in the grace period under §71(a)(3) of the Act, 15 U.S.C. §1141k(a)(3). If time remains in the grace period, the holder may file a complete new affidavit, with a new fee.

The holder may file a petition to the Director under 37 C.F.R. §§2.146(a)(5) and 2.148 to waive 37 C.F.R. §7.39(a) so that a late response to an Office action can be accepted. However, the Director will waive a rule only in an extraordinary situation, where justice requires and no other party is injured. See TMEP §1708. The failure to receive an Office action has been found to be an extraordinary circumstance that warrants a waiver of 37 C.F.R. §7.39(a). The “unintentional delay” standard of 37 C.F.R. §2.66 does not apply to the failure to respond to an Office action issued in connection with a §71 affidavit. TMEP §1714.01(f)(ii).

*Signature.* The response must be signed by a qualified practitioner, or by the holder of the registration or someone with legal authority to bind the holder. If the holder is represented by a qualified practitioner, the practitioner must sign. 37 C.F.R. §§2.193(e)(2)(i), 7.39(a), and 11.18(a). If the holder is not represented by a qualified practitioner, the individual holder or someone with legal authority to bind a juristic holder must sign. 37 C.F.R. §§7.39(a) and 11.14(e); TMEP §611.03(b). In the case of joint holders who are not represented by a qualified practitioner, all must sign. 37 C.F.R. §2.193(e)(2)(ii). See TMEP §§611.06 *et seq.* for guidelines on persons with legal authority to bind various types of juristic entities, and TMEP §§602 *et seq.* regarding persons who are qualified to represent others before the USPTO in trademark cases.

When it appears that a response to an Office action is signed by an improper party, the Post Registration staff must treat the response as incomplete and follow the procedures in TMEP §§611.05 *et seq.*

*Correction of Deficiencies.* See TMEP §§1613.17 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

#### **1613.17                      Correction of Deficiencies in §71 Affidavit**

*37 C.F.R. §7.39(c). If the affidavit or declaration is filed within the time periods set forth in section 71 of the Act, deficiencies may be corrected, as follows:*

*(1) Correcting deficiencies in affidavits or declarations timely filed within the periods set forth in sections 71(a)(1) and 71(a)(2) of the Act. If the affidavit or declaration is timely filed within the relevant filing period set forth in section 71(a)(1) or section 71(a)(2) of the Act, deficiencies may be corrected before the end of this filing period without paying a deficiency surcharge. Deficiencies may be corrected after the end of this filing period with payment of the deficiency surcharge required by section 71(c) of the Act and § 7.6.*

*(2) Correcting deficiencies in affidavits or declarations filed during the grace period. If the affidavit or declaration is filed during the six-month grace period provided by section 71(a)(3) of the Act, deficiencies may be corrected before the expiration of the grace period without paying a deficiency surcharge. Deficiencies may be corrected after the expiration of the grace period with payment of the deficiency surcharge required by section 71(c) of the Act and § 7.6.*

*(d) If the affidavit or declaration is not filed within the time periods set forth in section 71 of the Act, the registration will be cancelled.*

**1613.17(a)      Correcting Deficiencies in Affidavits or Declarations  
Timely Filed Within the Periods Set Forth in §71(a) of the  
Act**

If the affidavit or declaration is filed during the periods set forth in §71(a) of the Act (i.e., during the sixth year after the date of registration in the United States, or within one year before the end of any ten-year period after the date of registration in the United States), deficiencies may be corrected, after notification from the Office, within the relevant period without paying a deficiency surcharge, or after the expiration of the relevant period with payment of the deficiency surcharge required by §71(c) of the Act, 15 U.S.C. §1141k(c).

Any deficiency must be cured before the end of the relevant filing period set forth in §71 of the Act or within the set period for response to the Office action, whichever is later. 15 U.S.C. §1141k(c). If no response is filed, or if the holder does not correct the deficient affidavit, within this time period, the registration will be cancelled. See TMEP §1613.16.

**1613.17(b)      Correcting Deficiencies in Affidavits or Declarations  
Filed During the Grace Period**

If the affidavit or declaration is filed during the six-month grace period under §71(a)(3) of the Act, 15 U.S.C. §1141k (a)(3), deficiencies may be corrected, after notification from the Office, before the expiration of the grace period without paying a deficiency surcharge, or after the expiration of the grace period with the deficiency surcharge required by §71(c) of the Act, 15 U.S.C. §1141k(c).

Deficiencies must be cured within six months of the issuance date of the Office action. 37 C.F.R. §7.39(a). See TMEP §1613.16.

**1613.17(c)      Defects That Cannot Be Cured After Expiration of the  
Grace Period**

The registration will be cancelled if an affidavit or declaration of use or excusable nonuse is not filed within the time period set forth in §71 of the Act (including the grace period). 15 U.S.C. §1141k(a). Untimely filing cannot be cured after expiration of the grace period, even with a deficiency surcharge. See TMEP §1613.04 regarding the deadline for filing the affidavit.

**1613.18            Petition Under 37 C.F.R. §2.146**

The action of the Post Registration staff on a §71 affidavit may not be appealed to the Trademark Trial and Appeal Board, but the holder may file a petition to the Director for review of the action under 37 C.F.R. §§2.146(a)(2)

and 7.40(b). A petition fee is required by 37 C.F.R. §§2.6 and 2.146(c). See TMEP Chapter 1700 regarding petitions.

**1613.18(a) Response to Examiner's Refusal Required Before Petition**

A response to the initial refusal to accept an affidavit or declaration is required before filing a petition, unless the Post Registration staff directs otherwise or there is no time remaining to respond to the refusal. 37 C.F.R. §7.40(a).

If the Post Registration staff continues the refusal to accept the affidavit or declaration, the holder may file a petition for review of the action under 37 C.F.R. §2.146(a)(2) within six months of the issuance date. If the holder does not file a petition within six months, the registration will be cancelled. 37 C.F.R. §7.40(b).

**1613.18(b) Decision on Petition Is Final Action of the USPTO**

The decision on a petition under 37 C.F.R. §2.146 is the final action of the USPTO. In the absence of a request for reconsideration (see TMEP §1613.18(c)), or an appeal to an appropriate court (see TMEP §1613.18(d)) within two months of the issuance date of the decision on petition, the registration will be cancelled.

**1613.18(c) Request for Reconsideration of Denial of Petition**

Under 37 C.F.R. §2.146(j), if a petition is denied, the petitioner may file a request for reconsideration within two months of the issuance date of the decision denying the petition. A second petition fee must be paid with the request for reconsideration. See TMEP §1705.08 regarding requests for reconsideration of petition decisions.

**1613.18(d) Appeal to Federal Court**

The holder of the registration may appeal to the United States Court of Appeals for the Federal Circuit or commence a civil action for review of the decision denying a petition. 15 U.S.C. §1071(a)(1) and (b)(1); 37 C.F.R. §2.145(a) and (c).

The deadline for filing an appeal or commencing a civil action is two months from the issuance date of the decision on petition. 15 U.S.C. §1071(a)(2) and (b)(1); 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.

Under 37 C.F.R. §7.40(c), a decision on petition is necessary before the holder can file an appeal or commence a civil action in any court.



## **1613.19                    Section 71 Affidavit Combined With Section 15 Affidavit**

A §71 affidavit may be combined with a §15 affidavit, if the combined affidavit or declaration meets the requirements of both §§71 and 15.

The filing fee for a combined §71 and §15 affidavit is the sum of the cost of the individual filings. For example, if the filing fee for the §71 affidavit is \$100 per class, and the filing fee for the §15 affidavit is \$200 per class, then the filing fee for the combined affidavit or declaration under §§71 and 15 is \$300 per class.

If the combined §71 and §15 affidavit is filed during the §71 grace period, the grace period surcharge per class for the §71 affidavit must be paid. There is no grace period surcharge for a §15 affidavit.

If a combined §71 and §15 affidavit is filed, and the §71 affidavit is deficient, the deficiency may be corrected before expiration of the relevant deadline set forth in §71 of the Act for no fee, or after expiration of the relevant deadline with the deficiency surcharge required by §71(c) of the Act, 15 U.S.C. §1141k(c). See TMEP §§1613.17 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies in a §71 affidavit. There is no deficiency surcharge for a §15 affidavit.

## **1614                    Renewal of Registered Extension of Protection**

The holder of a registered extension of protection of an international registration to the United States must renew the international registration with the IB. 37 C.F.R. §7.41(a). Renewal of international registrations is governed by Article 7 of the Madrid Protocol and Rules 29 - 31 of the Common Regs. See TMEP §1905.

Under §70(b) of the Trademark Act, 15 U.S.C. §1141j(b), and Article 3<sup>ter</sup>(2) of the Protocol, if the international registration is not renewed, the IB will notify the USPTO that the registration has expired. The corresponding extension of protection to the United States will expire as of the expiration date of the international registration. The USPTO will cancel the extension of protection.

Section 9 of the Trademark Act, 15 U.S.C. §1069, does not require renewal of a registered extension of protection with the USPTO. However, the holder must file affidavits of use or excusable nonuse under §71 of the Trademark Act, 15 U.S.C. §1141k. See TMEP §1613.

## **1615                    Division of Registrations**

*37 C.F.R. §2.171(b). Partial change of ownership. (1) In a registration resulting from an application based on section 1 or section 44 of the Act, if ownership of a registration has changed with respect to some but not all of the goods and/or services, the owner(s) may file a request that the registration be*

*divided into two or more separate registrations. The assignment or other document changing title must be recorded in the Office. The request to divide must include the fee required by §2.6(a)(8) for each new registration created by the division, and be signed by the owner of the registration, someone with legal authority to bind the owner (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under §11.14 of this chapter, in accordance with §2.193(e)(2) of this chapter.*

*(2)(i) When the International Bureau of the World Intellectual Property Organization notifies the Office that an international registration has been divided as the result of a change of ownership with respect to some but not all of the goods or services, the Office will construe the International Bureau's notice as a request to divide. The Office will record the partial change of ownership in the Assignment Services Branch, and divide out the assigned goods/services from the registered extension of protection (parent registration), issue an updated certificate for the parent registration, and publish notice of the parent registration in the Official Gazette.*

*(ii) The Office will create a new registration number for the child registration, and enter the information about the new registration in its automated records. The Office will notify the new owner that the new owner must pay the fee required by §2.6 to obtain a new registration certificate for the child registration. It is not necessary for the new owner to file a separate request to divide.*

*(iii) The Office will not divide a registered extension of protection unless the International Bureau notifies the Office that the international registration has been divided.*

A registration can be divided only if ownership of the registration has changed with respect to some, but not all, of the goods/services. 37 C.F.R. §2.171(b). Requests to divide registrations are processed in the Post Registration Section.

See TMEP §1615.01 regarding division of registrations based on applications under §§1 and 44 of the Trademark Act, and TMEP §1615.02 regarding division of registered extensions of protection.

### **1615.01                    Division of Registration Based on Application Under §1 or §44 of the Trademark Act**

If ownership of a registration has changed with respect to some but not all of the goods/services, the owner is strongly encouraged to file a request that a registration be divided into two or more separate registrations, to ensure that USPTO records will accurately reflect current ownership information.

A party requesting division of a registration must: (1) record the change of ownership with the Assignment Services Branch of the USPTO; (2) file a

request to divide; and (3) pay the fee required by 37 C.F.R. §2.6(a)(8) for each new registration created by the division. 37 C.F.R. §2.171(b)(1).

The request must be signed by the individual owner of the registration, someone with legal authority to bind a juristic owner (e.g., a corporate officer or general partner of a partnership), or a qualified practitioner. 37 C.F.R. §2.171(b)(1) and 2.193(e)(2); TMEP §611.03(b). If the owner is represented by a qualified practitioner, the practitioner must sign. 37 C.F.R. §§2.193(e)(2)(i) and 11.18(a). If the owner is not represented by a qualified practitioner, the individual owner or someone with legal authority to bind a juristic (e.g., a corporate officer or general partner of a partnership) owner must sign. 37 C.F.R. §§2.193(e)(2)(ii) and 11.14(e). In the case of joint owners who are not represented by a qualified practitioner, all must sign. 37 C.F.R. §2.193(e)(2)(ii). If the request does not meet these requirements, the Post Registration staff will issue an Office action granting the party who filed the request six months in which to comply with the requirements of the rule. If there is no response, the request to divide will be dismissed.

A party who requests division of a registration issued under the old United States classification system (see TMEP §1401.02) must agree to adopt the international classification system for both the parent and child registration. See TMEP §1609.04 regarding amendment of classification.

Once the registration is divided, the USPTO will: (1) create a new registration number for the child registration and update the information about the parent and child registration in its automated records; (2) issue a new registration certificate for the child registration and an amended registration certificate for the parent registration; (3) publish notice of both the parent and child registrations in the Official Gazette and scan both the child and amended parent registration certificates into TIGRS; and (4) send a registration certificate for the child registration to the new owner. The USPTO will not send an amended registration certificate for the parent registration to the owner of the parent registration unless the owner submits a request and pays the fee required by 37 C.F.R. §2.6(a)(8).

A registration may be divided more than once.

## **1615.02 Division of Registered Extension of Protection**

When ownership of an international registration changes with respect to some but not all of the goods/services for all designated Contracting Parties, the IB will create a separate new international registration for the goods/services that have been transferred, and notify the USPTO accordingly. See the IB's *Guide to International Registration*, Para. B.II.65.01.

When the IB notifies the USPTO of the division of an international registration resulting from a change of ownership with respect to some but not all of the goods/services, the USPTO will construe the IB's notice as a request to

divide. The USPTO will record the partial change of ownership in the Assignment Services Branch, divide out the assigned goods/services from the registered extension of protection (parent registration), issue an updated certificate for the parent registration, and publish notice of the parent registration in the *Official Gazette*. 37 C.F.R. §2.171(b)(2)(i).

The USPTO will create a new registration number for the child, and enter the information about the new registration into TRAM and TARR. The USPTO will notify the new owner that the new owner must pay the fee required by 37 C.F.R. §2.6(a)(8) to obtain a new registration certificate for the child registration. It is not necessary for the new owner to file a separate request to divide. 37 C.F.R. §2.171(b)(2)(ii). If the new owner does not respond to the notice, the child registration will remain active, as long as the owner files the necessary maintenance documents, but the USPTO will not issue a new registration certificate for the child registration, or publish notice of the child registration in the *Official Gazette*.

The USPTO will not divide a registered extension of protection to the United States unless the IB notifies the USPTO that the international registration has been divided. 37 C.F.R. §2.171(b)(2)(iii).

A registration may be divided more than once.

See TMEP §1110.11 regarding division of a pending §66(a) application after ownership has changed with respect to some but not all of the goods/services, and TMEP §501.07 regarding assignment of extensions of protection.

## **1616 Replacement**

If a United States national registration and a subsequently issued certificate of extension of protection of an international registration to the United States are (1) owned by the same person, (2) identify the same mark, and (3) list the same goods or services, the extension of protection shall have the same rights as those accrued to the United States national registration at the time the certificate of extension of protection issues. Section 74 of the Trademark Act, 15 U.S.C. §1141n; 37 C.F.R. §7.28(a); Article 4<sup>bis</sup>. See TMEP §1904.12 for further information on requests to note replacement of a United States national registration with a registered extension of protection. All requests to note replacements should be directed to the Madrid Processing Unit.