

# Chapter 1700

## Matters Submitted to Director

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- 1701 Statutory Authority of Director**
- 1702 Petitions to the Director Under 37 C.F.R. §2.146 - In General**
- 1703 Specific Types of Petitions**
- 1704 Petitionable Matter**
- 1705 Petition Procedure**
  - 1705.01 Standing
  - 1705.02 Petition Fee
  - 1705.03 Evidence and Proof of Facts
  - 1705.04 Timeliness
  - 1705.05 Due Diligence
  - 1705.06 Stay or Suspension of Pending Matters
  - 1705.07 Signature of Petition
  - 1705.08 Request for Reconsideration of Denial of Petition
  - 1705.09 Appeal to Federal Court
- 1706 Standard of Review on Petition**
- 1707 Director's Supervisory Authority Under 37 C.F.R. §2.146(a)(3)**
- 1708 Waiver of Rules**
- 1709 Matters Delegated by Director**
- 1710 Petition to Make Special**
  - 1710.01 Basis for Granting or Denying Petition
  - 1710.02 Processing Petition Papers
- 1711 Review of Denial of Filing Dates**

# TRADEMARK MANUAL OF EXAMINING PROCEDURE

## **1712 Reinstatement of Applications and Registrations**

1712.01 Reinstatement of Applications Abandoned Due to Office Error

1712.02 Reinstatement of Registrations Cancelled or Expired Due to Office Error

## **1713 Petition to Reverse Holding of Abandonment for Failure to Respond Completely**

## **1714 Petition to Revive Abandoned Application**

1714.01 Procedural Requirements for Filing Petition to Revive

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

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

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

1714.01(c) Notice of Allowance Not Received

1714.01(d) Timeliness and Diligence

1714.01(e) Signed Statement That Delay Was Unintentional

1714.01(f) Applicability of Unintentional Delay Standard

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

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

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

## **1715 Letters of Protest in Pending Applications**

1715.01 Appropriate Subjects to be Raised in Letter of Protest

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

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

1715.02 Letters of Protest Filed Before Publication

1715.03 Letters of Protest Filed After Publication

1715.03(a) Timely Filing of Letter of Protest

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

## MATTERS SUBMITTED TO DIRECTOR

- 1715.04 Tracking of Letters of Protest by the Protestor
- 1715.05 Approval of Applications for Publication or Issue After Grant of a Letter of Protest
- 1715.06 Recourse After Denial of Letter of Protest
- 1715.07 Requests for Copies of Letters of Protest

### **1701 Statutory Authority of Director**

The United States Patent and Trademark Office (“USPTO”) is led by the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (“Director”). The Commissioner for Trademarks oversees the staff and operations of the USPTO with regard to trademark matters. 35 U.S.C. §3(b)(2). See TMEP §1709 regarding delegation of duties by the Director.

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

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

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

\* \* \*

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

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

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

1702

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

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

*(a) Petition may be taken to the Director: (1) From any repeated or final formal requirement of the examiner in the ex parte prosecution of an application if permitted by §2.63(b); (2) in any case for which the Act of 1946, or Title 35 of the United States Code, or this Part of Title 37 of the Code of Federal Regulations specifies that the matter is to be determined directly or reviewed by the Director; (3) to invoke the supervisory authority of the Director in appropriate circumstances; (4) in any case not specifically defined and provided for by this Part of Title 37 of the Code of Federal Regulations; (5) in an extraordinary situation, when justice requires and no other party is injured thereby, to request a suspension or waiver of any requirement of the rules not being a requirement of the Act of 1946.*

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

*(c) Every petition to the Director shall include a statement of the facts relevant to the petition, the points to be reviewed, the action or relief that is requested, and the fee required by § 2.6. Any brief in support of the petition shall be embodied in or accompany the petition. When facts are to be proved in ex parte cases, proof in the form of affidavits or declarations in accordance with § 2.20, and any exhibits, shall accompany the petition.*

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

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

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

## MATTERS SUBMITTED TO DIRECTOR

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

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

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

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

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

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

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

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

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

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

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

Under 37 C.F.R. §2.146(a)(1), an applicant may file a petition to review an examining attorney's formal requirement if permitted by 37 C.F.R. §2.63(b). Under 37 C.F.R. §2.63(b)(1), a petition from a requirement that is repeated but not made final is permitted if the subject matter of the requirement is appropriate for petition. Under 37 C.F.R. §2.63(b)(2), a petition from a final requirement is permitted only if the final action *is limited to* subject matter appropriate for petition. See TMEP §1704 regarding petitionable subject

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

matter. If a petition under 37 C.F.R. §2.146(a)(1) is denied, the applicant has six months from the date of the Office action that repeated the requirement or made it final, or thirty days from the date of the decision on the petition, whichever is later, to comply with the requirement. 37 C.F.R. §2.63(a).

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

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

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

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

### **1703 Specific Types of Petitions**

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

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

*Petitions to Make Special.* See TMEP §1710.

*Petitions to Reverse an Examining Attorney's Holding of Abandonment* for failure to file a complete response to an Office action are reviewed under 37 C.F.R. §2.146(a)(3). See TMEP §1713.

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

*Petitions to Restore Jurisdiction to the Examining Attorney* may be filed by the applicant under 37 C.F.R. §2.84, when the examining attorney does not have jurisdiction to review one of the applicant's amendments.

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

## MATTERS SUBMITTED TO DIRECTOR

requirement is repeated or made final and the subject matter is appropriate for petition. See TMEP §1704 regarding petitionable subject matter, and TMEP §1706 regarding the standard of review.

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

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

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

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

*Petitions to Add or Substitute a Basis After Publication* are reviewed under 37 C.F.R. §2.146(a)(2). See 37 C.F.R. §2.35(b)(3); TMEP §806.03(j).

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

### **1704                      Petitionable Matter**

#### ***Ex Parte Examination***

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

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Procedural issues reviewable on petition include whether a disclaimer was properly printed in standardized format; whether an examining attorney acted properly in suspending an application; whether an examining attorney acted properly in holding an application abandoned for failure to file a complete response to an Office action (see TMEP §1713); and whether it was premature for an examining attorney to issue a final action.

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

Some issues that arise in *ex parte* examination may be reviewed by either petition or appeal. For example, a requirement for amendment of an identification of goods may be reviewed either by petition or appeal. *In re Stenographic Machines, Inc.*, 199 USPQ 313 (Comm'r Pats. 1978). On the other hand, a requirement for amendment of the classification is a procedural matter that can only be reviewed on petition. *In re Tee-Pak, Inc.*, 164 USPQ 88 (TTAB 1969).

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

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

### **Post Registration**

Trademark Rule 2.146(b) applies only to questions of substance that arise during *ex parte* examination of applications for registration. The Director considers questions of substance, such as whether a proposed amendment materially alters a registered mark, or whether a specimen supports use of a registered mark, when reviewing the action of a Post Registration examiner in connection with a proposed amendment filed under 15 U.S.C. §1057, or an

## MATTERS SUBMITTED TO DIRECTOR

affidavit of use under 15 U.S.C. §1058 or §1141k. The decisions of Post Registration examiners under 15 U.S.C. §§1057, 1058, 1059, and 1141k may not be appealed to the Trademark Trial and Appeal Board.

### ***Inter Partes Proceedings Before Trademark Trial and Appeal Board***

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

#### **1705                    Petition Procedure**

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

#### **1705.01                Standing**

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

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

#### **1705.02                Petition Fee**

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

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

A petition fee will be waived only if the record clearly shows that the petition was the result of a USPTO error. When requesting waiver of a fee, it is recommended that the petitioner submit the fee, but include a request that the fee be refunded because the petition was the result of a USPTO error. This will expedite consideration of the petition if the request for waiver of the petition fee is denied.

If a check submitted as a petition fee is returned to the USPTO unpaid, or an electronic funds transfer or credit card is refused or charged back by a

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

financial institution, the petitioner must resubmit the petition fee, along with a \$50 fee for processing the payment that was refused or charged back, before the petition will be considered on the merits. 37 C.F.R. §2.6(b)(12). See TMEP §405.06.

### **1705.03 Evidence and Proof of Facts**

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

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

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

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

### **1705.04 Timeliness**

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

- Denial of a request for an extension of time to file a notice of opposition -- 15 days (37 C.F.R. §2.146(e)(1));

## MATTERS SUBMITTED TO DIRECTOR

- Interlocutory order of the Trademark Trial and Appeal Board -- 30 days (37 C.F.R. §2.146(e)(2));
- Denial of a request for an extension of time to file a statement of use -- two months (37 C.F.R. §2.89(g));
- Section 7 rejection -- six months (37 C.F.R. §2.176);
- Section 8 rejection -- six months (37 C.F.R. §2.165(b));
- Section 9 rejection -- six months (37 C.F.R. §2.186(b));
- Petition to revive -- two months (37 C.F.R. §2.66(a));
- Examining attorney's formal requirement -- six months (15 U.S.C. §1062(b); 37 C.F.R. §§2.62 and 2.63(b));
- Request for reconsideration of decision on petition -- two months (37 C.F.R. §§2.66(f)(1) and 2.146(j)(1)).

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

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

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

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

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

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

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### 1705.05 Due Diligence

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

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

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

To be considered diligent, a petitioner must:

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

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

Applicants and registrants are encouraged to check the status on each six-month anniversary of the filing of an application for registration, §8 affidavit or §9 renewal application to avoid abandonment or cancellation and to ensure that they meet the diligence requirement. For example, if an application was filed on November 1, 2004, the applicant should check the

## MATTERS SUBMITTED TO DIRECTOR

status on May 1, 2005, November 1, 2005, and on each six-month anniversary thereafter, until a registration is issued.

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

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

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

If a status inquiry reveals that a paper was not received, or that some other problem exists, corrective action should be promptly requested in writing. 37 C.F.R. §2.146(i)(3). Petitions should be directed to the Office of the Commissioner for Trademarks. Requests for reinstatement should be directed to the Paralegal Specialists in the Office of the Commissioner for Trademarks, the supervisory legal instruments examiner in the law office, or the supervisor of the ITU Unit or Post Registration Section. See TMEP §§1712 *et seq.* regarding requests for reinstatement.

Where a registrant has proof that a USPTO error caused a registration to expire or be cancelled due to failure to file an affidavit or declaration of use or excusable nonuse under 15 U.S.C. §1058 ("8 affidavit"), a renewal application under 15 U.S.C. §1059, or a response to an examiner's Office action refusing to accept a §8 affidavit or renewal application, the registrant may file a request for reinstatement. See TMEP §1712.02 regarding the types of proof of USPTO error that will support a request for reinstatement. Generally, where there is proof that a registration was cancelled solely due to a USPTO error, a request for reinstatement will not be denied solely because the registrant was not diligent in monitoring the status of the §8 affidavit or renewal application. However, if a registrant receives a written notice of cancellation, or has actual notice that a registration was cancelled, the USPTO will deny the request for reinstatement as untimely if it was not filed (1) within two months of the mailing date of the cancellation notice, or

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

(2) within two months of actual notice of cancellation, if the registrant did not receive a written cancellation notice. 37 C.F.R. §2.146(d).

A request to reinstate an *application* abandoned due to USPTO error (see TMEP §1712.01) will be denied if the applicant was not diligent in monitoring the status of the application.

### **1705.06 Stay or Suspension of Pending Matters**

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

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

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

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

### **1705.07 Signature of Petition**

A petition should be signed by the petitioner or the petitioner's attorney.

If the petitioner has an attorney, the attorney must sign the response. 37 C.F.R. §10.18(a). If the petitioner is not represented by an attorney, the response must be signed by someone with legal authority to bind the petitioner (e.g., a corporate officer or general partner of a partnership). A non-attorney who is authorized to verify facts under 37 C.F.R. §2.33(a)(2) or §2.161(b) is *not* entitled to sign petitions, unless he or she has legal authority to bind the petitioner. Under 5 U.S.C. §500(d) and 37 C.F.R. §10.14(e), non-

## MATTERS SUBMITTED TO DIRECTOR

attorneys may not represent a party in a trademark proceeding before the USPTO.

See TMEP §§712.01(a) *et seq.* for guidelines on persons who have legal authority to bind various types of petitioners.

See TMEP 804.05 regarding signature of documents filed electronically.

### **1705.08 Request for Reconsideration of Denial of Petition**

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

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

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

### **1705.09 Appeal to Federal Court**

Under 15 U.S.C. §1071(a)(1) and 37 C.F.R. §2.145(a), a registrant who is adversely affected by the Director's decision regarding a renewal application or an affidavit or declaration under 15 U.S.C. §1058 may appeal to the United States Court of Appeals for the Federal Circuit or commence a civil action for review of the decision on petition. 15 U.S.C. §§1071(a)(1) and (b)(1); 37 C.F.R. §§2.145(a) and 2.145(c).

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

The deadline for filing an appeal or commencing a civil action is two months from the mailing date of the decision. 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.

### **1706 Standard of Review on Petition**

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

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

In review of an examining attorney's formal requirement under 37 C.F.R. §§2.63(b) and 2.146(a)(1), the standard of review is whether the examining attorney's judgment was correct, the same standard that the Trademark Trial and Appeal Board would use if it were considering the requirement on appeal. *In re Du Pont Merck Pharmaceutical Co.*, 34 USPQ2d 1778 (Comm'r Pats. 1995); *In re Stenographic Machines, Inc.*, 199 USPQ 313 (Comm'r Pats. 1978). However, in review of an examining attorney's action under 37 C.F.R. §2.146(a)(3), the Director will reverse the examining attorney only upon a finding of clear error or abuse of discretion. *In re GTE Education Services*, 34 USPQ2d 1478 (Comm'r Pats. 1994); *In re Direct Access Communications (M.C.G.) Inc.*, 30 USPQ2d 1393 (Comm'r Pats. 1993).

The Director also uses the clear error or abuse of discretion standard when reviewing an action of the Trademark Trial and Appeal Board under 37 C.F.R. §2.146(a)(3). *Riko Enterprises, Inc. v. Lindsley*, 198 USPQ 480 (Comm'r Pats. 1977).

The Director reviews the actions of Post Registration examiners on affidavits of use or excusable nonuse under 15 U.S.C. §1058 or §1141k, renewal applications under 15 U.S.C. §1059, and amendments to registrations under 15 U.S.C. §1057, to determine whether the judgment of the examiner was correct. See *In re Umax Data System, Inc.*, 40 USPQ2d 1539 (Comm'r Pats. 1996) (announcing change in standard of review of petitions to review Post Registration examiners' decisions on amendments to registrations under 15 U.S.C. §1057).

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

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

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

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

## MATTERS SUBMITTED TO DIRECTOR

The Director may also exercise supervisory authority under 37 C.F.R. §2.146(a)(3) to make changes to USPTO practice. See *In re Umax Data System, Inc.*, 40 USPQ2d 1539 (Comm'r Pats. 1996) (announcing change in standard of review of petitions to review Post Registration examiners' decisions on amendments to registrations under 15 U.S.C. §1057).

### 1708 Waiver of Rules

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

All three of the above conditions must be satisfied before a waiver will be granted, and the burden is on the petitioner to show that the situation is extraordinary. Disasters like fires, hurricanes and snow storms are considered to be extraordinary situations. Extraordinary circumstances have also been found in certain cases where a petitioner avers by affidavit or declaration that it did not receive an Office action issued regarding an affidavit of use under 15 U.S.C. §1058 or renewal application under 15 U.S.C. §1059.

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

A change of attorneys is not considered to be an extraordinary situation, *In re Unistar Radio Networks, Inc.*, 30 USPQ2d 1390 (Comm'r Pats. 1993), nor is a misunderstanding or lack of awareness of the requirements of the Rules of Practice considered extraordinary. *In re Buckhead Marketing & Distribution, Inc.*, 71 USPQ2d 1620 (Dir USPTO 2004) (applicant's lack of knowledge of application filing fee increase not extraordinary situation); *B and E Sales Co. Inc. v. Andrew Jergens Co.*, 7 USPQ2d 1906 (Comm'r Pats. 1988); *Gustafson v. Strange*, 227 USPQ 174 (Comm'r Pats. 1985). Errors by attorneys are imputed to the client and the client is bound by the consequences. *In re Sotheby's Inc.*, 18 USPQ2d 1969 (Comm'r Pats. 1991).

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

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

The Director has no authority to waive a statutory requirement, such as the deadline for filing a proper renewal application under 15 U.S.C. §1059 or affidavit of use of a registered mark under 15 U.S.C. §1058. *In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984).

### **1709 Matters Delegated by Director**

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

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

Authority to decide trademark-related petitions filed under 37 C.F.R. §2.146 has been delegated to the Deputy Commissioner for Trademark Examination Policy. Authority to decide the following petitions has been delegated to the staff attorneys and paralegal specialists in the Office of the Commissioner for Trademarks:

- Petitions to make special (TMEP §§1710 et seq.);
- Petitions to add or substitute a filing basis after publication (37 C.F.R. §2.35(b)(3); TMEP §806.03(j));
- Petitions to revive (37 C.F.R. §2.66; TMEP §§1714 et seq.);
- Requests by departments or agencies of the Government to waive fees pursuant to 15 U.S.C. §1113(b);
- Requests to reinstate abandoned applications (TMEP §1712.01); and
- Requests to review the denial of application filing dates (TMEP §1711).

### **1710 Petition to Make Special**

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

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

## MATTERS SUBMITTED TO DIRECTOR

statement of facts should be supported by an affidavit or declaration under 37 C.F.R. §2.20.

When a new application for registration is accompanied by a petition to make “special,” the USPTO will give the application a serial number and process the fees before routing the application to the Office of the Commissioner for Trademarks for a decision on the petition.

An application for registration of a mark that was the subject of a previous registration that was inadvertently cancelled or expired will be made “special” upon applicant’s request. See TMEP §702.02. No petition is required in this situation. However, the mark and goods/services in the new application must be identical to the mark and goods/services in the previous registration, or the USPTO will not grant “special” status.

An application that has once been made “special” and advanced out of turn for examination will continue to be “special” until a date of publication in the *Official Gazette* is assigned to the application. See TMEP §702.02.

### **1710.01 Basis for Granting or Denying Petition**

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

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

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

### **1710.02 Processing Petition Papers**

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

### **1711 Review of Denial of Filing Dates**

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

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

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

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

In the above situations, a Staff Attorney or Paralegal Specialist in the Office of the Commissioner for Trademarks may restore the original filing date without a formal petition or a petition fee. In all other circumstances, the applicant must file a formal petition, including the petition fee required by 37 C.F.R. §2.6.

The request should be directed to the Office of the Commissioner for Trademarks, and should include all the application materials and a cover

## MATTERS SUBMITTED TO DIRECTOR

letter identified as a “Request for Restoration of the Filing Date.” *In all requests to restore a filing date, the applicant must resubmit the application filing fee(s), even if the applicant has not yet received a refund of the fee(s) previously paid.*

All requests to restore filing dates, whether made by formal petition or informal request, must be filed promptly. If the USPTO mails an action advising the applicant of the denial or cancellation of the filing date, the request to restore the filing date must be filed within two months of the mailing date of the action. 37 C.F.R. §2.146(d).

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

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

The USPTO scans images of applications almost immediately after they are received in the USPTO and uploads these scanned images into TICRS. Because very little time passes between receipt of the application and creation of the scanned image, it is highly likely that the TICRS file of an application will be an exact copy of what was received in the USPTO. Accordingly, if TICRS does not include an image of a missing element that a petitioner declares was submitted with the application, the Director will not find on petition that the element was submitted, unless there is evidence to corroborate the petitioner’s declaration. An example of corroborating evidence is a postcard submitted with the original application that bears (1) a USPTO date stamp, and (2) an itemized list of materials submitted that includes the missing element. *In re Group Falck A/S*, 62 USPQ2d 1797, 1798 (Dir USPTO 2002).

### **1712 Reinstatement of Applications and Registrations**

#### **1712.01 Reinstatement of Applications Abandoned Due to Office Error**

If an application was inadvertently abandoned due to a USPTO error, an applicant may file a request to reinstate the application, instead of a formal petition to revive. There is no fee for a request for reinstatement. Such a

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

request should be captioned as a “Request for Reinstatement.” Requests for reinstatement are handled by the Paralegal Specialists in the Office of the Commissioner for Trademarks, or by the supervisory legal instruments examiner in the ITU Unit or the law office to which the application is assigned.

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

- (1) The applicant presents proof that a response to an Office action, statement of use or request for extension of time to file a statement of use was timely filed through TEAS, in the form of a copy of an e-mail confirmation issued by the USPTO that includes the date of receipt and a summary of the submission.
- (2) There is an image of a timely-filed response to Office action, statement of use, or request for extension of time to file a statement of use in TIGRS.
- (3) The timely-filed correspondence is found in the USPTO.
- (4) The applicant supplies a copy of the correspondence and proof that it was timely mailed to the USPTO in accordance with the certificate of mailing requirements of 37 C.F.R. §2.197 (for the specific requirements for providing proof, see TMEP §305.02(f)).
- (5) The applicant supplies a copy of the correspondence and proof that it was timely transmitted to the USPTO by fax in accordance with the certificate of facsimile transmission requirements of 37 C.F.R. §2.197 (for the specific requirements for providing proof, see TMEP §306.05(d)).
- (6) The applicant presents proof of actual receipt in the USPTO in the form of a return postcard showing a timely USPTO date stamp or label, on which the applicant specifically refers to the correspondence at issue (see TMEP §303.02(c)).
- (7) The applicant presents proof of actual receipt in the USPTO in the form of evidence that a USPTO employee signed for or acknowledged the envelope (e.g., a certified mail receipt that bears an Office date stamp or label, or the signature of a USPTO employee), accompanied by an affidavit or declaration under 37 C.F.R. §2.20 attesting to the contents of the envelope.
- (8) The papers that became lost were accompanied by a fee, and there is proof that the USPTO processed the fee (e.g., a cancelled check). The request for reinstatement must include an affidavit or declaration under 37 C.F.R. §2.20 that attests to the contents of the correspondence.

## MATTERS SUBMITTED TO DIRECTOR

- (9) The USPTO sent an Office action or notice of allowance to the wrong address due to a USPTO error. A “USPTO error in sending an action or notice to the wrong address” means that the USPTO either entered the correspondence address incorrectly or failed to enter a proper notice of change of address filed *before* the mailing date of the action or notice. See TMEP §603.03 regarding the applicant’s duty to notify the USPTO when the correspondence address changes.

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

If the applicant did not receive a notice of abandonment, the applicant must have been duly diligent in monitoring the status of the application, or the request for reinstatement will be denied. To be duly diligent, the applicant must check the status of a pending application every six months between the filing date of the application and issuance of a registration. 37 C.F.R. §2.146(i)(1); TMEP §1705.05.

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

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

### **1712.02 Reinstatement of Registrations Cancelled or Expired Due to Office Error**

#### ***Request for Reinstatement***

A registrant may file a request to reinstate a cancelled or expired registration if the registrant has proof that USPTO error caused a registration to be cancelled or expired due to failure to file: (1) an affidavit or declaration of use or excusable nonuse under 15 U.S.C. §1058 (“§8 affidavit”); (2) a renewal application under 15 U.S.C. §1059; or (3) a response to an examiner’s Office action refusing to accept a §8 affidavit or renewal application. There is no fee for a request for reinstatement. A request that the USPTO reinstate a registration that has been cancelled or expired due to USPTO error should be captioned as a “Request for Reinstatement of Registration,” and should be directed to the Supervisor of the Post Registration Section of the Office.

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

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- (1) The registrant presents proof that a proper §8 affidavit or renewal application was timely filed through TEAS, in the form of a copy of an e-mail confirmation issued by the USPTO that includes the date of receipt and a summary of the submission (see TMEP §301).
- (2) There is an image of a timely-filed §8 affidavit, renewal application, or response to Office action in TICRS.
- (3) The timely-filed §8 affidavit, renewal application, or response to Office action is found in the USPTO.
- (4) The registrant supplies a copy of the §8 affidavit, renewal application, or response with proof that it was timely mailed to the USPTO in accordance with the certificate of mailing requirements of 37 C.F.R. §2.197 (for the specific requirements for providing proof, see TMEP §305.02(f)).
- (5) The registrant supplies a copy of the §8 affidavit, renewal application, or response, with proof that it was timely transmitted to the USPTO by fax in accordance with the certificate of transmission requirements of 37 C.F.R. §2.197 (for the specific requirements for providing proof, see TMEP §306.05(d)).
- (6) The registrant presents proof of actual receipt in the USPTO in the form of a return postcard showing a timely USPTO date stamp or label, on which the registrant specifically refers to the §8 affidavit, renewal application, or response at issue (see TMEP §303.02(c)).
- (7) The registrant presents proof of actual receipt in the USPTO in the form of evidence that a USPTO employee signed for or acknowledged the envelope (e.g., a certified mail receipt that bears a USPTO date stamp or label, or the signature of a USPTO employee), accompanied by an affidavit or declaration under 37 C.F.R. §2.20 attesting to the contents of the envelope.
- (8) The papers that became lost were accompanied by a fee, and there is proof that the USPTO processed the fee (e.g., a cancelled check). The registrant must submit an affidavit or declaration under 37 C.F.R. §2.20 attesting to the contents of the original mailing.
- (9) The USPTO sent an Office action to the wrong address due to an Office error. A “USPTO error in sending an action to the wrong address” means that the USPTO either entered the correspondence address incorrectly or failed to enter a proper notice of change of address filed *before* the mailing date of the action.
- (10) The registrant supplies a copy of a response to an Office action, with proof that it was timely transmitted to the USPTO by Internet e-mail and accompanied by a certificate of transmission under 37 C.F.R.

## MATTERS SUBMITTED TO DIRECTOR

2.197. See notice at 64 Fed. Reg. 33056, 33063 (June 21, 1999).  
*NOTE: Section 8 affidavits and renewal applications cannot be filed by e-mail. TMEP §304.02.*

Generally, where there is proof that a registration was cancelled solely due to USPTO error, a request for reinstatement will not be denied solely because the registrant was not diligent in monitoring the status of the §8 affidavit or renewal application (see TMEP §1705.05). However, if a registrant receives a written notice of cancellation, or has actual notice that a registration was cancelled, the USPTO will deny the request for reinstatement as untimely if it was not filed (1) within two months of the mailing date of the cancellation notice, or (2) within two months of actual notice of cancellation, if the registrant did not receive a written cancellation notice. 37 C.F.R. §2.146(d). See TMEP §1705.04 regarding timeliness.

### **Formal Petition**

If a registrant unintentionally failed to timely respond to an examiner's Office action refusing to accept a §8 affidavit or renewal application, but the registrant does not have the proof of USPTO error that would support a request for reinstatement, the registrant may file a formal petition under 37 C.F.R. §§2.146(a)(3) and 2.146(a)(5) to waive a rule and accept a late response. Pursuant to 37 C.F.R. §2.146(d), the petition must be filed within two months of the cancellation notice. If the registrant did not receive the cancellation notice, the petition must be filed within two months of the date of actual notice of the cancellation, *and* the record must show that the registrant was diligent in monitoring the status of the registration, pursuant to 37 C.F.R. §2.146(i). See TMEP §§1705.04 and 1705.05 regarding timeliness and diligence.

The unintentional delay standard of 37 C.F.R. §2.66 does *not* apply to registered marks. TMEP 1714.01(f)(ii). Under 37 C.F.R. §§2.146(a)(5) and 2.148, the Director may waive any provision of the Rules that is not a provision of the statute, when an extraordinary situation exists, justice requires, and no other party is injured. See TMEP §1708. The failure to receive an Office action is considered an extraordinary situation that justifies a waiver of a rule. Therefore, if the registrant did not receive an examiner's Office action refusing to accept a §8 affidavit or renewal application, but the registrant does not have proof that non-receipt was due to USPTO error (see paragraph 9 above), the registrant may file a formal petition under 37 C.F.R. §2.146.

The Director has no authority to waive a statutory requirement, such as the deadline for filing a §8 affidavit or renewal application. *In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984). Therefore, if the registrant did not timely file a §8 affidavit or renewal

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

application, a petition to extend or waive the statutory deadline will be denied, regardless of the reason for the delay.

If a registrant contends that a §8 affidavit or renewal application was timely filed, but the registrant does not have proof that the §8 affidavit or renewal application was received in the USPTO before the due date, the Director will not grant a petition to accept the affidavit or renewal application.

### **1713                    Petition to Reverse Holding of Abandonment for Failure to Respond Completely**

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

When an examining attorney holds an application abandoned because the applicant's response is incomplete, the applicant may petition to the Director to reverse the holding under 37 C.F.R. §2.146. However, the Director will reverse the examining attorney's holding of abandonment only if there is clear error or abuse of discretion. *In re GTE Education Services*, 34 USPQ2d 1478 (Comm'r Pats. 1994); *In re Legendary, Inc.*, 26 USPQ2d 1478 (Comm'r Pats. 1992). *Note:* The "unintentional delay" standard for reviving abandoned applications pursuant to 37 C.F.R. §2.66(a) does *not* apply to applications held abandoned under 37 C.F.R. §2.65(a). See TMEP §1714.01(f)(ii).

### **1714                    Petition to Revive Abandoned Application**

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

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

- (1) Within two months of the mailing date of the notice of abandonment; or*
- (2) Within two months of actual knowledge of the abandonment, if the applicant did not receive the notice of abandonment, and the applicant was diligent in checking the status of the application every six months in accordance with § 2.146(i).*

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

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

## MATTERS SUBMITTED TO DIRECTOR

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

*(1) The petition fee required by §2.6;*

*(2) A statement, signed by someone with firsthand knowledge of the facts, that the delay in filing the statement of use (or request for extension of time to file a statement of use) on or before the due date was unintentional;*

*(3) Unless the applicant alleges that it did not receive the notice of allowance and requests cancellation of the notice of allowance, the required fees for the number of requests for extensions of time to file a statement of use that the applicant should have filed under §2.89 if the application had never been abandoned;*

*(4) Unless the applicant alleges that it did not receive the notice of allowance and requests cancellation of the notice of allowance, either a statement of use under §2.88 or a request for an extension of time to file a statement of use under §2.89; and*

*(5) Unless a statement of use is filed with or before the petition, or the applicant alleges that it did not receive the notice of allowance and requests cancellation of the notice of allowance, the applicant must file any further requests for extensions of time to file a statement of use under §2.89 that become due while the petition is pending, or file a statement of use under §2.88.*

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

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

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

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

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

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

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

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **1714.01 Procedural Requirements for Filing Petition to Revive**

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

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

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

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

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

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

*NOTE: Response to Final Action.* The USPTO will not grant a petition to revive an application abandoned for failure to respond to a final Office action unless the applicant submits a proper response, as defined in 37 C.F.R. §2.64(a), or states that it did not receive the Office action. If a petition does not include a proper response to a final action, the petition will be treated as incomplete. The applicant will be given an opportunity to perfect the petition by submitting a proper response to the final action. If the applicant does not submit a proper response within the time allowed, the petition will be denied. After a final action, the only response that an applicant may make as a matter of right is (1) either an appeal to the Trademark Trial and

## MATTERS SUBMITTED TO DIRECTOR

Appeal Board (see TMEP §1501 *et seq.*) or a petition under 2.63(b), whichever is appropriate, or (2) compliance with any requirement made by the examining attorney. TMEP §715.01. A request for reconsideration is not a proper response to a final action. See TMEP §§715.03 and 1714.01(f)(ii). In some cases, after a final refusal of registration on the Principal Register, an amendment requesting registration on the Supplemental Register or registration under 15 U.S.C. §1052(f) may also be a proper response. See TMEP §§714.05(a)(i), 816.04 and 1212.02(h).

If the petition states that applicant did not receive the Office action, and the petition is granted, the USPTO will remail the Office action.

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

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

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

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

- (1) The petition fee required by 37 C.F.R. §2.6;
- (2) A statement, signed by someone with firsthand knowledge of the facts, that the delay in filing the statement of use (or request for extension of time to file a statement of use) on or before the due date was unintentional. The statement does not have to be verified;
- (3) Either a statement of use under 37 C.F.R. §2.88 or a request for an extension of time to file a statement of use under 37 C.F.R. §2.89;
- (4) The required fees for the number of extension requests that the applicant should have filed if the application had never been abandoned;

*Example:* If a notice of allowance was issued June 14, 2004, and a petition to revive was filed December 23, 2004, the petition must be accompanied by: (1) either a statement of use or request for an extension of time to file a statement of use, with the required filing fee; and (2) the fee for the first extension request due that was

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

December 14, 2004. These fees are in addition to the standard petition fee; and

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

The USPTO will *not* grant a petition to revive an intent-to-use application if granting the petition would extend the period for filing the statement of use beyond thirty-six months after the mailing date of the notice of allowance. 15 U.S.C. §§1051(d)(1) and (2); 37 C.F.R. §2.66(d). In these cases, the petition will be denied, and the petition fee will be refunded.

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

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

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

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

### **1714.01(c) Notice of Allowance Not Received**

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

The procedural requirements for filing a petition to revive an application abandoned for failure to respond to a notice of allowance are listed in 37 C.F.R. §2.66(c). *If the applicant did not receive the notice of allowance*, the petition must include the following:

- (1) The petition fee required by 37 C.F.R. §2.6; and

## MATTERS SUBMITTED TO DIRECTOR

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

If the applicant did not receive the notice of allowance, it is not necessary to file a statement of use or request for an extension of time to file a statement of use, or the fees for the number of extension requests that would have been due if the application had never been abandoned. 37 C.F.R. §§2.66(c)(3) and (4). If the petitioner files an extension request with a petition that alleges nonreceipt of the notice of allowance, the USPTO will cancel the notice of allowance, refund the filing fee for the extension request, and forward the file to the Publication and Issue Section of the USPTO to reissue the notice of allowance.

If the petitioner files a statement of use with a petition that alleges nonreceipt of the notice of allowance, the USPTO will give the petitioner the option of: (1) having the notice of allowance cancelled and reissued, and the filing fee for the statement of use refunded; or (2) paying the additional filing fees for the extension requests that would have been due if the application had never been abandoned, so that the statement of use can be processed.

### **1714.01(d) Timeliness and Diligence**

Under 37 C.F.R. §2.66(a), a petition to revive an abandoned application must be filed: (1) within two months of the mailing date of the notice of abandonment; or (2) within two months of actual knowledge of the abandonment, if the applicant did not receive the notice of abandonment, *and* the applicant was diligent in checking the status of the application. See TMEP §1705.04 regarding petition timeliness, and TMEP §1705.05 regarding an applicant's duty to exercise due diligence in monitoring the status of an application. If a petition is untimely, or if the applicant was not diligent, the USPTO will deny the petition and refund the petition fee. To be considered diligent, the applicant should check the status of a pending application every six months between the filing date of the application and issuance of a registration. 37 C.F.R. §§2.66(a)(2) and 2.146(i)(1).

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

### **1714.01(e) Signed Statement That Delay Was Unintentional**

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

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Except when alleging non-receipt of an Office action or notice of allowance, it is not necessary to explain the circumstances that caused the unintentional delay. If the applicant did not receive the Office action or notice of allowance, this should be stated; no further explanation is necessary.

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

See TMEP §804.05 regarding signature of documents filed through TEAS.

### **1714.01(f)      Applicability of Unintentional Delay Standard**

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

Trademark Rule 2.66 applies only to the "failure" to respond to an Office action or notice of allowance. This includes the failure to meet minimum filing requirements for a statement of use or request for an extension of time to file a statement of use.

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

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

An applicant who fails to meet the minimum filing requirements for a statement of use or request for an extension of time to file a statement of use has, in effect, not filed the statement of use or extension request. Therefore, if the failure to meet the minimum filing requirements was unintentional, the applicant may file a petition to revive under 15 U.S.C. §1051(d)(4) and 37 C.F.R. §2.66.

An applicant may also file a petition to revive under 37 C.F.R. §2.66 if the applicant timely files a notice of appeal from an examining attorney's final

## MATTERS SUBMITTED TO DIRECTOR

refusal, but unintentionally fails to include the appeal fee required by 15 U.S.C. §1070.

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

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

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

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

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

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

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### ***Registered Marks***

Trademark Rule 2.66 applies only to abandoned applications, not to registered marks. If a registrant fails to timely respond to an Office action regarding an affidavit or declaration of use or excusable nonuse under 15 U.S.C. §1058 or §1141k, or a renewal application under 15 U.S.C. §1059, the registrant may file a petition to the Director under 37 C.F.R. §§2.146(a)(3) and 2.146(a)(5) to waive a rule and accept a late response. However, the Director will waive a rule only in an extraordinary situation, where justice requires and no other party is injured. The Director has no authority to waive a statutory requirement. See TMEP §1708 regarding the waiver of rules.

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

### ***Dismissal of Appeal for Failure to File a Brief***

An applicant cannot file a petition to revive under 37 C.F.R. §2.66 if an application is abandoned because the Board dismisses an appeal for failure to file a brief. In this situation, the applicant may file a motion with the Board to set aside the dismissal and accept a late-filed brief. TBMP §1203.02(a). If the Board denies this motion, the applicant may file a petition to the Director under 37 C.F.R. §2.146, asking the Director to reverse the Board's order. The petition must be filed within thirty days of the mailing date of the Board's order. 37 C.F.R. §2.6(e)(2). The Director will reverse the Board's action only if the Board clearly erred or abused its discretion.

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

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

### **1715 Letters of Protest in Pending Applications**

Protests from third parties who object to the registration of marks in pending applications must be sent in writing to the Office of the Commissioner for Trademarks. The Administrator for Trademark Identifications, Classification and Practice ("Administrator") will determine whether the information should or should not be given to the examining attorney for consideration. Third parties may not contact an examining attorney directly, either orally or in writing, regarding a particular application. If a third party attempts to contact an examining attorney, the examining attorney should refer the third party to the Office of the Commissioner for Trademarks. If an examining attorney receives a letter of protest without any indication that it has been granted by

## MATTERS SUBMITTED TO DIRECTOR

the Administrator, the letter should be referred to the Administrator for consideration. If the letter of protest was mistakenly entered in the record as a paper received from the applicant, all evidence of that receipt should be expunged from the records of the USPTO.

The purpose of a letter of protest is to permit third parties to bring facts relevant to the registrability of the mark to the attention of the USPTO. The procedure is intended to achieve this objective without causing undue delay in the examination process and without compromising the objectivity or the *ex parte* character of the examination process. *In re BPJ Enterprises Ltd.*, 7 USPQ2d 1375 (Comm'r Pats. 1988). The letter of protest must contain factual, objective evidence.

The Administrator will grant a letter of protest only if the protestor submits *prima facie* evidence supporting a refusal of registration, such that publication of the mark without consideration of the issue and evidence presented in the letter of protest was or would be a clear error by the USPTO. See TMEP §§1715.02 and 1715.03.

When a protest is granted, the actual letter of protest is not made part of the record, or forwarded to the examining attorney or the applicant. The examining attorney receives a form letter from the Administrator indicating that a letter of protest was filed and briefly indicating the nature of the protest, with the factual evidence filed with the letter of protest attached.

### **1715.01            Appropriate Subjects to be Raised in Letter of Protest**

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

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

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

- (1) A third party files an objection to the registration of a term because it is allegedly generic or descriptive. The objection must be accompanied by *evidence* of genericness or descriptiveness. The

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

evidence should be objective, independent, factual evidence that the examining attorney can use to support the suggested refusal. Personal opinions are subjective and may be self-serving, and are not forwarded to the examining attorney. If the protest is granted, the examining attorney is informed that an objection to registration has been filed on the ground that the mark is generic or descriptive, and is given a copy of any factual evidence submitted with the letter of protest.

- (2) A third party notifies the USPTO of the existence of a federally registered mark or prior-pending application and alleges that there is a likelihood of confusion between this mark and the mark in the application that is the subject of the letter of protest. If the protest is granted, the examining attorney is notified that an objection to the registration of the mark has been made on the ground of an alleged likelihood of confusion with a registered mark or prior-pending application, and is given a copy of the registration or application information as it appears in the automated records of the USPTO.
- (3) A third party files a request that prosecution of an application be suspended because of pending litigation that is relevant to the registrability of the mark. The litigation must be specifically identified and a copy of the relevant pleadings must be enclosed. The litigation must involve a federally registered mark or prior-pending application of the protestor and grounds that are clearly relevant to the right of the applicant to register the mark in the application that is the subject of the letter of protest. If the protest is granted, the examining attorney is informed that a request for suspension has been received based on the existence of pending litigation. Copies of the relevant pleadings are placed in the record.

To preserve the integrity and objectivity of the *ex parte* examination process, the Administrator will consider and act on the letter of protest without consulting with the examining attorney. The Administrator considers only the record in the application and the protestor's submissions. *In re BPJ Enterprises Ltd.*, 7 USPQ2d 1375 (Comm'r Pats. 1988).

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

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

- (1) A third party claims earlier common law use of a trademark but does not have a federal registration or previously-filed pending application for that mark. The examining attorney can only consider registrations and prior-pending applications when determining likelihood of confusion. Earlier common law use, state registrations and other

## MATTERS SUBMITTED TO DIRECTOR

claims based on evidence other than federal registrations and prior-pending applications for federal registration are not appropriate for presentation to examining attorneys during *ex parte* examination.

- (2) A third party claims that the applicant is not the proper owner of the mark. This issue requires proof that is beyond the scope of authority of an examining attorney to require during *ex parte* examination. *In re Apple Computer, Inc.*, 57 USPQ2d 1823 (Comm'r Pats. 1998).
- (3) Numerous third parties set forth the opinion that the mark should not register but do not offer any evidence or legal reason to support the refusal. The trademark registration process is governed by statutory laws and federal regulations. Public opinion cannot be used to influence the application process; therefore, mass mailings by special interest groups will not be made part of the record.

### **1715.02 Letters of Protest Filed Before Publication**

If a letter of protest is filed before the mark is published for opposition, the Administrator will determine whether the letter contains sufficient evidence to establish a *prima facie* case that supports a refusal of registration. If the Administrator determines that publication of the mark for opposition without consideration of the issue and evidence presented in the letter of protest might result in a clear error by the USPTO, the Administrator will grant the protest and forward the evidence in the letter of protest to the examining attorney in the manner described in TMEP §1715. The examining attorney should issue any refusal or requirement supported by the evidence, and should notify the applicant that a letter of protest was filed and provide the applicant with a copy of the information that has been made a part of the record. See notice at 1172 TMOG 93 (March 28, 1995).

Letters of protest that are filed before an examining attorney has taken a first action in the application that is the subject matter of the protest will not be decided until such action is taken. This is to give the examining attorney the opportunity to make an initial decision in the application and to provide a basis for a determination by the Administrator as to whether or not that action constituted a "clear error."

### **1715.03 Letters of Protest Filed After Publication**

When a letter of protest is filed after publication, the Administrator will first determine whether the letter is timely, *i.e.*, whether it was filed within 30 days of the date of publication. If not, the letter of protest will generally be denied. See TMEP §1715.03(a).

When a letter of protest is filed within 30 days after the date of publication, the Administrator will make an initial determination of whether publication of the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

mark constituted clear error, *i.e.* whether the protester presents *prima facie* evidence that supports a refusal of registration. *In re BPJ Enterprises Ltd.*, 7 USPQ2d 1375 (Comm'r Pats. 1988).

If a mark has been published for opposition but no notice of allowance has issued, the examining attorney does not have jurisdiction to consider the information in the letter of protest. Therefore, if the Administrator determines that the letter of protest should be granted, the Administrator will submit a formal request to the Commissioner for Trademarks to restore jurisdiction of the application to the examining attorney. The Administrator will include copies of the relevant evidence with this request. If the Commissioner agrees that the letter of protest should be granted and restores jurisdiction to the examining attorney, the Administrator will grant the protest and refer the application with the relevant evidence to the examining attorney. If the Commissioner does not agree that the letter of protest should be granted, the Administrator will deny the letter of protest.

If a notice of allowance has issued in an application based on 15 U.S.C. §1051(b), the examining attorney has jurisdiction over the application, so a formal restoration of jurisdiction is unnecessary. Therefore, if the Administrator grants the letter of protest, the Administrator will make the relevant evidence part of the record for consideration by the examining attorney during examination of the statement of use.

### **1715.03(a) Timely Filing of Letter of Protest**

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

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

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

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

## MATTERS SUBMITTED TO DIRECTOR

The letter of protest procedure applies *only* to pending applications. The Director has no authority to cancel a registration in order to consider a letter of protest. Therefore, a letter of protest will be denied as untimely if the mark registers before issuance of the decision on the letter.

### **1715.03(b) Letter of Protest Does Not Stay or Extend Opposition Period**

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

### **1715.04 Tracking of Letters of Protest by the Protestor**

A protestor will always receive a response from the Administrator either granting or denying the letter of protest. Generally, the Administrator will make every effort to respond to letters of protest within sixty days of the time they are received in the Office of the Commissioner for Trademarks, or within sixty days after the examining attorney's initial Office action, whichever is later. If a protestor has not received a response from the Administrator within six months of submitting a letter of protest, the protestor should ascertain whether or not a first action has been taken in the application that is the subject of the letter of protest. If such an action has been taken, the protestor should contact the Office of the Commissioner for Trademarks to make sure the letter of protest has been received in that Office. The protestor can check the TARR database at <http://tarr.uspto.gov> to determine whether an action has been taken.

### **1715.05 Approval of Applications for Publication or Issue After Grant of a Letter of Protest**

If the Administrator grants a letter of protest, the examining attorney will issue a requirement or refusal consistent with the Administrator's action, except in unusual circumstances. However, granting a letter of protest does not constitute a binding determination by the Administrator as to the merits. In some circumstances, the examining attorney may discover additional evidence that would justify approval of the application after the grant of a letter of protest, or the applicant may overcome the refusal or satisfy the requirement. If the Administrator grants a letter of protest and the examining attorney later determines that the mark should be approved for publication, republication or issue, the Administrator must approve the examining attorney's approval of the application for publication, republication or issue.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Due to the possibility that the application may be approved for publication, republication or issue, protestors should continue to monitor the status of the application being protested so that they may take appropriate action (such as filing a notice of opposition) if the refusal or requirement raised as a result of the letter of protest is successfully overcome by the applicant.

### **1715.06 Recourse After Denial of Letter of Protest**

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

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

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

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

### **1715.07 Requests for Copies of Letters of Protest**

Any party who requests a copy of a letter of protest should mail the request to the Office of the Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451, or fax the request to (571) 273-8900. All requests should be directed to the attention of the Administrator for Trademark Identifications, Classification and Practice. Upon review of the letter of protest material, the Administrator will usually forward a copy of the letter of protest and its attachment to the requester. The Administrator will deny the request for a copy of the letter of protest only if the letter of protest or its attachments contain material that would potentially be exempt from disclosure under the Freedom of Information Act ("FOIA"). If, in the opinion of the Administrator, any part of the letter of protest materials should be exempt from disclosure under FOIA, the matter will be forwarded to the Office of General Counsel of the USPTO for further review.