

# Chapter 1100 — Intent-to-Use Applications and Requests to Divide

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## **1101 Bona Fide Intention To Use the Mark In Commerce**

Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), provides that an applicant may file an application based on a bona fide intention to use a mark in commerce “under circumstances showing the good faith of such person.”

A verified statement of the applicant’s bona fide intention to use the mark in commerce must be included in intent-to-use (“ITU”) applications under §1(b), and in applications under §§44 and 66(a), 15 U.S.C. §§1126 and 1141f(a). See TMEP §1904.01(c) regarding the requirement for a declaration of the applicant’s bona fide intention to use the mark in commerce in a §66(a) application.

If the verification is not filed with the initial application, the verified statement must also allege that the applicant has had a bona fide intention to use the mark in commerce since the filing date of the application. 37 C.F.R. §§2.34(a)(2), 2.34(a)(3)(i) and 2.34(a)(4)(ii). See TMEP §§804 *et seq.* regarding verifications.

A verified statement of the applicant’s continued bona fide intention to use the mark in commerce must also be included in a request for an extension of time

to file a statement of use. 15 U.S.C. §1051(d)(2); 37 C.F.R. §§2.89(a)(3) and (b)(3); TMEP §§1108.02 and 1108.02(e).

Reasonable variations in the wording of the statement may be acceptable. For example, the applicant may state that it has “a bona fide intention to use in commerce the mark on or in connection with...,” or may use the words “good faith” instead of “bona fide.” However, the wording “in commerce” is required and cannot be varied. *In re Custom Technologies Inc.*, 24 USPQ2d 1712 (Comm’r Pats. 1991); *In re B.E.L.-Tronics Ltd.*, 24 USPQ2d 1397 (Comm’r Pats. 1992).

See TMEP §1201.03(a) regarding an assertion by an intent-to-use applicant of a bona fide intention to use the mark in commerce through a related company.

See TMEP §1008 regarding the requirement for an allegation of a bona fide intention to use the mark in commerce in an application filed under §44 of the Trademark Act.

The USPTO will *not* evaluate the good faith of an applicant in the ex parte examination of applications. Generally, the applicant’s sworn statement of a bona fide intention to use the mark in commerce will be sufficient evidence of good faith in the ex parte context. Consideration of issues related to good faith may arise in an inter partes proceeding, but the USPTO will not make an inquiry in an ex parte proceeding unless evidence of record clearly indicates that the applicant does not have a bona fide intention to use the mark in commerce.

## **1102 Initial Examination of Intent-to-Use Applications**

In an intent-to-use application, the examining attorney will potentially examine the application twice: first, when it is initially filed based on a bona fide intention to use the mark in commerce under 15 U.S.C. §1051(b), and second, when the applicant files an allegation of use (i.e., either an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d)). See TMEP §§1104 *et seq.* regarding amendments to allege use and TMEP §§1109 *et seq.* regarding statements of use. After receipt of the application, the examining attorney will initially examine the application to determine whether the mark is eligible for registration but for the lack of evidence of use. If the mark is determined to be eligible, the mark will be approved for publication and then published for opposition. If the applicant has not submitted an amendment to allege use before approval for publication, and the application is not successfully opposed, the USPTO will issue a notice of allowance. 15 U.S.C. §1063(b); 37 C.F.R. §2.81. See TMEP §§1106 *et seq.* regarding notices of allowance. In such a case, the applicant must submit a statement of use. 15 U.S.C. §1051(d)(1); 37 C.F.R. §2.88.

An intent-to-use application is subject to the same requirements and examination procedures as other applications, except as specifically noted. The examining attorney must raise all possible refusals and requirements in initial examination.

### **1102.01 Substantive Refusals**

To the fullest extent possible, the examining attorney will examine an intent-to-use application for registrability under Trademark Act §§1, 2(a), 2(b), 2(c), 2(d), and 2(e), 15 U.S.C. §§1051 and 1052(a), (b), (c), (d), and (e), according to the same procedures and standards that apply to any other application. That is, the examining attorney must make all appropriate refusals and/or requirements with respect to issues such as ownership, deceptiveness, likelihood of confusion, mere descriptiveness, geographic significance, and surname significance. *In re Bacardi & Co. Ltd.*, 48 USPQ2d 1031 (TTAB 1997); *In re American Psychological Ass'n*, 39 USPQ2d 1467 (Comm'r Pats. 1996).

The examining attorney should not issue a requirement or refusal under these sections during examination of the statement of use if the issue could or should have been raised during initial examination, unless the failure to issue the refusal or requirement would be a clear error. See TMEP §§706.01 and 1109.08.

Where a significant length of time has elapsed since the initial examination, a mark may have become descriptive or even generic as applied to the goods/services. In such a case, since the evidence of the descriptive or generic use would not have been available during initial examination, the requirement or refusal must be issued during second examination.

The examining attorney should investigate all possible issues regarding registrability through all available sources. If appropriate, the examining attorney may require that the applicant provide literature or an explanation concerning the intended manner of use of the mark, or the meaning of the mark in relation to the goods/services, under 37 C.F.R. §2.61(b). See TMEP §814; *In re DTI Partnership LLP*, 67 USPQ2d 1699 (TTAB 2003); *In re Page*, 51 USPQ2d 1660, 1665 (TTAB 1999).

The examining attorney should also search applicant's own website to see if it provides information about the goods/services. See TMEP §710.01(b); *In re Promo Ink*, 78 USPQ2d 1301, 1303 (TTAB 2006) (the Board rejected applicant's argument that it was improper for the examining attorney to rely on evidence obtained from applicant's website when the application was based on intent-to-use and no specimens were yet required, and stated that "[t]he fact that applicant has filed an intent-to-use application does not limit the examining attorney's evidentiary options, nor does it shield an applicant from producing evidence that it may have in its possession.").

While the examining attorney must examine and act on all possible issues in the initial examination of the application, requirements or refusals specifically tied to use of the mark (e.g., ornamentation) should generally be addressed after the applicant submits an allegation of use *and* a specimen showing use of the mark in commerce. See TMEP §§1202 *et seq.* regarding use as a mark. However, an examining attorney may review a §1(b) application for which no allegation of use and specimen have been submitted, and believe it likely that a refusal of registration on the ground that the subject matter does not function as a mark may be made after an allegation of use is submitted. In that instance, this potential refusal should be brought to the applicant's attention in the first action issued by the USPTO. This is done strictly as a courtesy. If information regarding this possible ground for refusal is not provided to the applicant before the allegation of use is filed, the USPTO is not precluded from later refusing registration on this basis.

### **1102.02 Drawings**

The examination of the drawing during initial examination, before submission of an allegation of use and specimen, will focus primarily on the form of the drawing and compliance with 37 C.F.R. §§2.52, 2.53, and 2.54. Intent-to-use applicants must comply with all formal requirements related to drawings, whether in standard characters or in special form. See TMEP §§807 *et seq.* See TMEP §1104.09(f) regarding examination of the drawing after submission of an amendment to allege use, and TMEP §1109.12 regarding examination of the drawing after submission of a statement of use. The applicant may not amend the mark in a drawing if the amendment constitutes a material alteration of the mark. 37 C.F.R. §2.72(b)(2).

### **1102.03 Intent-to-Use Applications and the Supplemental Register**

A mark in an intent-to-use application is not eligible for registration on the Supplemental Register until the applicant has submitted an acceptable allegation of use (i.e., either an amendment to allege use that meets the requirements of 37 C.F.R. §§2.76(b) and (c), or a statement of use that meets the requirements of 37 C.F.R. §2.88(b)). 37 C.F.R. §§2.47(d) and 2.75(b).

If an intent-to-use applicant requests registration on the Supplemental Register before filing an acceptable allegation of use, the examining attorney will refuse registration under §23 of the Trademark Act, 15 U.S.C. §1091, on the ground that the mark is not in lawful use in commerce. If an application is based on intent-to-use in addition to another basis, registration of the entire application will be refused on the Supplemental Register unless the applicant either deletes the §1(b) basis or files a request to divide. See TMEP §§1110 *et seq.* regarding requests to divide. The examining attorney will withdraw the refusal if the applicant submits an acceptable allegation of use.

If an application is based solely on §1(b), and the applicant files an acceptable amendment to allege use or statement of use *and* an acceptable amendment to the Supplemental Register, the USPTO will consider the filing date of the amendment to allege use or statement of use to be the effective filing date of the application. 37 C.F.R. §2.75(b); TMEP §206.01. The filing date of an amendment to allege use is the date on which the applicant meets the minimum filing requirements of 37 C.F.R. §2.76(e), and the filing date of a statement of use is the date on which the applicant meets the minimum filing requirements of 37 C.F.R. §2.88(e). Due to the change in the effective filing date, the examining attorney must conduct a new search of USPTO records for conflicting marks. In this situation, the USPTO does not alter the original filing date in its automated records (i.e., the Trademark Reporting and Monitoring (“TRAM”) System and Trademark Applications and Registrations Retrieval (“TARR”) database). TMEP §206. If the new search shows that a later-filed conflicting application now has an earlier filing date (based on the change in the effective filing date of the subject application), the examining attorney must suspend action on the subject application pending disposition of the other application, if the application is otherwise in condition for suspension. See TMEP §§1208 *et seq.* regarding the procedures for handling conflicting marks in pending applications.

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

When the applicant files an allegation of use together with an amendment to the Supplemental Register, the examining attorney must examine the allegation of use before taking action on the amendment to the Supplemental Register.

See TMEP §§815 and 816 *et seq.* for additional information about the Supplemental Register.

#### **1102.04 Claims of Acquired Distinctiveness under §2(f)**

See TMEP §§1212.09 *et seq.* regarding claims of distinctiveness under §2(f), 15 U.S.C. §1052(f), in intent-to-use applications.

#### **1103 Allegations of Use**

While §1(b) of the Trademark Act provides for *filing* an application based on the applicant’s bona fide intent to use the mark in commerce, registration cannot be granted until the applicant files an allegation of use. The allegation

of use must include verified dates of first use (see TMEP §§903 *et seq.*), and a specimen of use for each class of goods/services (see TMEP §§904 *et seq.*).

An allegation of use may be filed as either an amendment to allege use or a statement of use. The principal difference between the amendment to allege use and the statement of use is the *time* of filing. The amendment to allege use may be filed after the application filing date but before approval of the mark for publication. 37 C.F.R. §2.76(a); TMEP §1104.03. If the applicant does not file an acceptable amendment to allege use during initial examination, or if an amendment to allege use is filed and withdrawn, and the USPTO issues a notice of allowance under 15 U.S.C. §1063(b)(2) (see TMEP §§1106 *et seq.*), the applicant must file a statement of use within six months of the issuance date of the notice of allowance, or within an extension of time granted for filing of the statement of use. 15 U.S.C. §1051(d). See TMEP §§1109 *et seq.* regarding statements of use.

The applicant may *not* file the allegation of use during the period after approval of the mark for publication and before issuance of the notice of allowance. 37 C.F.R. §2.88(a); TMEP §1104.03. This period is known as the “blackout period.” See TMEP §§1104.03(b) and (c).

See TMEP §§1104.02 and 1109.05 regarding the form for filing allegations of use.

#### **1104 Amendment to Allege Use Under §1(c) of the Act**

As previously stated, an intent-to-use applicant must file either an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d) before issuance of the registration. This section pertains only to amendments to allege use. Statements of use are discussed in TMEP §§1109 *et seq.*

Filing an amendment to allege use does not relieve the applicant of the duty to file a response to an outstanding Office action or to take any other action required in the case, including filing a notice of appeal to the Board or a petition to the Director. 37 C.F.R. §2.64(c)(1). See TMEP §1104.07 regarding the filing of an amendment to allege use in conjunction with an appeal. Therefore, the applicant must file a separate response to any outstanding Office action. Failure to respond to an outstanding Office action will result in abandonment of the application. See TMEP §718.06 regarding notice of abandonment for failure to respond.

## **1104.01 Minimum Filing Requirements for an Amendment to Allege Use**

The amendment to allege use must include the following minimum elements before it will be referred to the examining attorney for examination on the merits:

- (1) the prescribed fee for at least one class;
- (2) 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.

37 C.F.R. §2.76(e).

An amendment to allege use that omits the allegation of use in commerce, but asserts a verified date of first use in commerce, may be accepted as substantially in compliance with the minimum filing requirement of 37 C.F.R. §2.76(e)(3) for a verified statement that the mark is in use in commerce. *Cf. In re Carnicon Development Co.*, 34 USPQ2d 1541 (Comm'r Pats. 1992); *In re Conservation Technology Inc.*, 25 USPQ2d 1079 (Comm'r Pats. 1992). The examining attorney will require an allegation that the "mark is in use in commerce" during examination.

See TMEP §1104.08 regarding the requirements for a complete amendment to allege use.

### **1104.01(a) Review by Legal Instruments Examiner for Compliance with Minimum Filing Requirements**

A legal instruments examiner ("LIE") will conduct a preliminary review of an amendment to allege use to determine whether it is timely and complies with the minimum requirements of 37 C.F.R. §2.76(e). If so, the LIE will refer the amendment to allege use to the examining attorney for examination on the merits.

With respect to the requirement that the amendment to allege use include a verification or declaration signed by the applicant stating that the mark is in use in commerce, the LIE will review the document only to determine whether it bears a signed verification stating that the mark is in use in commerce. The examining attorney will determine whether the amendment to allege use was filed by the owner. See TMEP §1104.09(a).

See TMEP §1104.01(b) regarding processing an amendment to allege use that does not meet minimum filing requirements, and TMEP §1104.03(c) regarding processing an untimely amendment to allege use.

## **1104.01(b) Processing an Amendment to Allege Use That Does Not Meet Minimum Filing Requirements**

If an amendment to allege use is timely, but does not comply with the minimum filing requirements of 37 C.F.R. §2.76(e) (see TMEP §1104.01), the LIE will advise the applicant in writing of the deficiency. The applicant may correct the deficiency, provided the applicant does so before the mark is approved for publication. See 37 C.F.R. §2.76(g). If an acceptable amendment to correct the deficiency is not filed before the mark is approved for publication, the amendment to allege use will not be referred to the examining attorney and will not be examined on the merits. 37 C.F.R. §2.76(g).

If the filing fee for at least a single class is omitted or is deficient (e.g., if the fee is charged to a deposit account with insufficient funds, an electronic funds transfer (“EFT”) or credit card payment is refused or charged back by a financial institution, or a check is returned unpaid), the LIE will advise the applicant that the applicant must repay the fee before the mark is approved for publication, or the amendment to allege use will not be examined. In addition, when an EFT or credit card is refused or a check is returned unpaid, the applicant must pay the processing fee required by 37 C.F.R. §2.6(b)(12). This processing fee must be paid even if the applicant withdraws the amendment to allege use. See TMEP §405.06 regarding payments that are refused.

If the amendment to allege use does not include a specimen, the LIE will advise the applicant that the applicant must submit a specimen, supported by an affidavit or declaration under 37 C.F.R. §2.20 stating that the specimen is in use in commerce on or in connection with the goods/services, before the mark is approved for publication, or the USPTO will not examine the amendment to allege use.

If the amendment to allege use is not signed, the LIE will notify the applicant of the deficiency and advise the applicant that the applicant must submit a properly signed amendment to allege use before the mark is approved for publication, or the USPTO will not examine the amendment to allege use.

An amendment to allege use that does not meet the minimum filing requirements will remain in the record. If the applicant does not correct all deficiencies before approval of the mark for publication, the examining attorney will not examine the amendment to allege use. In such a case, if the applicant has submitted the fee, the fee will not be refunded and cannot be applied to a later-filed statement of use. If the mark is published for opposition and a notice of allowance issues, the applicant must file a statement of use or request for extension of time to file a statement of use within six months of the date of issuance to avoid abandonment of the application.

If the applicant wishes to establish that the amendment to allege use as filed met the minimum requirements of 37 C.F.R. §2.76(e), the applicant must file a petition under 37 C.F.R. §2.146. In addition to the petition fee (37 C.F.R. §2.6), the petition should include a copy of the amendment to allege use and specimen, and any evidence establishing that the amendment to allege use as filed met the minimum filing requirements. See Chapter 1700 for additional information about petitions. If the petition is granted, the amendment to allege use will be considered filed on the date it was originally received in the USPTO.

See TMEP §1104.03(c) regarding processing an untimely amendment to allege use.

#### **1104.01(c) Processing Defective Amendment to Allege Use Filed With Other Amendments**

After the LIE has taken appropriate action on a defective amendment to allege use (see TMEP §1104.01(b)), the LIE will process any other amendments filed with the amendment to allege use and will refer the application to the assigned examining attorney for appropriate action on those other amendments.

If the amendment to allege use did not meet the minimum filing requirements of 37 C.F.R. §2.76(e), the examining attorney will act on any other amendments in the application without considering the amendment to allege use. The examining attorney should issue requirements or refusals according to standard examination procedure without considering the amendment to allege use. Any specimen submitted becomes part of the record and may be relied on in relation to issues other than use.

If the examining attorney determines that the LIE erred in holding that the amendment to allege use did not meet the minimum filing requirements of 37 C.F.R. §2.76(e), the examining attorney should advise the applicant by telephone or e-mail that the amendment to allege use will be examined on the merits and to disregard the LIE's action, and should make an appropriate note in the "Notes-to-the-File" section of the record.

#### **1104.02 Form of Amendment to Allege Use**

To expedite processing, the USPTO recommends that an applicant file an amendment to allege use through the Trademark Electronic Application System ("TEAS"), available at <http://www.uspto.gov>. Alternatively, the owner may call the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199 to obtain a pre-printed paper form that may be used to file either a statement of use or an amendment to allege use ("Trademark/Service Mark Allegation of Use"). The applicant may mail, fax, or hand-deliver the completed form to the USPTO. If the form is faxed, it must be accompanied

by an authorization to charge the filing fee to a credit card or deposit account. The credit card authorization form is available at <http://www.uspto.gov/web/forms/2038.pdf>. If the amendment to allege use is filed through TEAS, payment must be made by credit card, deposit account, or EFT. Paper forms may be delivered by hand or courier to the Trademark Assistance Center (“TAC”), at James Madison Building, East Wing, Concourse Level, 600 Dulany Street, Alexandria, Virginia. TAC is open 8:30 a.m. to 5:00 p.m., Eastern Time, Monday through Friday, except on Federal holidays within the District of Columbia.

If the applicant does not file the amendment to allege use electronically or use the pre-printed paper form designed by the USPTO, the applicant should submit the amendment to allege use in a document separate from other amendments, with the caption “Allegation of Use” appearing at the top of the first page of the document. 37 C.F.R. §2.76(d). However, this format is not mandatory. The USPTO will accept and enter any document that includes an amendment to allege use, if it meets the minimum filing requirements set forth in 37 C.F.R. §2.76(e), regardless of whether it is properly titled or includes other amendments.

See TMEP §1104.01 regarding the minimum filing requirements that must be met before an amendment to allege use can be referred to an examining attorney for examination, and TMEP §1104.08 regarding the requirements for a complete amendment to allege use.

#### **1104.03 Time for Filing Amendment to Allege Use**

An applicant may file an amendment to allege use at any time between the application filing date and the date the examining attorney approves the mark for publication. 37 C.F.R. §2.76(a).

An amendment to allege use may be filed after commencement of an ex parte appeal. See TMEP §1104.07.

An applicant may not file either an amendment to allege use or a statement of use between the date the examining attorney approves the mark for publication and the date of issuance of the notice of allowance. This period, during which no allegation of use may be filed, is known as the “blackout period.” See TMEP §§1104.03(b) and (c).

#### **1104.03(a) Use on All Goods/Services Required Before Filing**

An applicant may not file an amendment to allege use until the applicant has used the mark in commerce on or in connection with *all* goods/services for which the applicant seeks registration under §1(b), unless the applicant files a request to divide. 37 C.F.R. §2.76(c). If the applicant files an amendment to allege use before using the mark on or in connection with all the goods/services, but does not file a request to divide, the examining attorney

will require the applicant to: (1) withdraw the amendment to allege use (see TMEP §1104.10); (2) delete from the application the goods/services not covered by the amendment to allege use; or (3) file a request to divide out the goods/services that are not yet in use. See TMEP §§1110 *et seq.* regarding requests to divide.

### **1104.03(b) The “Blackout Period”**

Under 37 C.F.R. §2.76(a), an applicant may not file an amendment to allege use under 15 U.S.C. §1051(c) after the date that the application is approved for publication by the examining attorney. Under 37 C.F.R. §2.88(a), an applicant may not file a statement of use under 15 U.S.C. §1051(d) before the date of issuance of the notice of allowance. These two rules combine to create a period of time when neither an amendment to allege use nor a statement of use may be filed. This period is known as the “blackout period.” Any statement of use or amendment to allege use filed during this period will be deemed untimely and the fee will be refunded. *In re Sovran Financial Corp.*, 25 USPQ2d 1537 (Comm’r Pats. 1991). See TMEP §1104.03(c) regarding processing allegations of use filed during the blackout period.

Intent-to-use applicants are encouraged to check the TARR database on the USPTO website at <http://tarr.uspto.gov> to determine the status of the application before filing an amendment to allege use.

If the status check indicates that the status of the application is any of the following, then the blackout period is in effect because the mark has been approved for publication and a notice of allowance has not yet issued:

- Approved for Publication (by the examining attorney)
- Publication/Registration review complete (by the law office clerk)
- Published for Opposition
- Notice of Allowance—Withdrawn
- Notice of Allowance—Cancelled
- Withdrawn from publication
- Cancelled—Restored to Pendency (indicates subject registration number was issued inadvertently and correction requires restoration of the application to pendency)
- Inadvertently issued registration number—Cancelled (indicates the subject registration number was issued inadvertently and has been cancelled)
- Concurrent use proceeding terminated—granted

- Concurrent use proceeding terminated—denied
- Concurrent use proceeding pending
- Interference proceeding pending
- Interference proceeding terminated
- Opposition pending
- Opposition dismissed
- Opposition dismissed—See TTAB records
- Opposition sustained
- Opposition instituted
- Request for extension of time to file opposition
- Amendment after publication

If the reported status is one of those listed above, then the blackout period has begun and the applicant should *not* file the amendment to allege use. On the other hand, if the reported status is not one of those listed above, the applicant may file the amendment to allege use.

It is possible that the mark could be approved for publication on the same day but shortly after the applicant checks the status of the application. However, the blackout period does not begin until the day *after* a mark is approved for publication.

#### **1104.03(c) Processing Amendment to Allege Use Filed During the Blackout Period**

If an applicant files an amendment to allege use during the blackout period, the USPTO will notify the applicant that the amendment to allege use is untimely and will not be processed, and refund the filing fee.

The examining attorney should not cancel an approval of or withdraw an application from publication to process an untimely amendment to allege use. Furthermore, the examining attorney should not suspend an application or take any other similar action to extend the time for filing an amendment to allege use.

The USPTO will not retain an untimely amendment to allege use and process it as a statement of use. However, the applicant may resubmit an untimely amendment to allege use as a statement of use after the notice of allowance issues.

#### **1104.04 Processing Timely Amendment to Allege Use Located After Publication**

If an amendment to allege use is timely (see TMEP §1104.03) and complies with the minimum filing requirements so that it may be examined on the merits (see TMEP §1104.01), but the mark was published for opposition before the amendment to allege use was associated with the application, the USPTO will proceed as follows.

The examining attorney will contact the applicant or the applicant's attorney by telephone or e-mail, and give the applicant the opportunity to withdraw the amendment to allege use. The examining attorney should advise the applicant that the application will be withdrawn from publication if the amendment to allege use is not withdrawn.

##### *Amendment to Allege Use Withdrawn*

If the applicant withdraws the amendment to allege use, the examining attorney should advise applicant that a notice of allowance will issue if the application is not successfully opposed, and that the applicant must file a statement of use (or request for an extension of time to file a statement of use) within six months after the issuance date of the notice of allowance. The examining attorney should advise applicant that, instead of filing a statement of use, the applicant may file a written request that the USPTO treat the amendment to allege use as a statement of use. Such a request *must be filed within six months after the issuance date of the notice of allowance*, and should be faxed to the ITU/Divisional Unit at (571) 273-9550. The examining attorney should make a note in the "Notes-to-the-File" section of the record, reflecting the substance of the communication with the applicant. The filing date of the statement of use will be the date of receipt of the applicant's written request to treat the amendment to allege use as a statement of use.

The applicant has the option of receiving a refund of the filing fee for the amendment to allege use, or applying the fee toward the statement of use. If the applicant requests a refund, the examining attorney should ask an LIE to arrange for the refund.

Because §1(d)(1) of the Trademark Act, 15 U.S.C. §1051(d)(1), explicitly requires that a statement of use be filed within six months *after* the issuance date of the notice of allowance, the USPTO cannot process the amendment to allege use as a statement of use unless the applicant files a written request within six months after the issuance date of the notice of allowance. If the applicant does not file a statement of use, a request for an extension of time to file a statement of use, or a written request to treat the amendment to allege use as a statement of use within six months after the issuance of the notice of allowance, the application will be abandoned, even if the amendment to allege use is still in the record and the filing fee for the amendment to allege use has not been refunded.

### *Amendment to Allege Use Not Withdrawn*

If the applicant does not withdraw the amendment to allege use, and no notice of allowance has issued, the examining attorney must withdraw the application from publication. If the notice of allowance has issued, the examining attorney must ask the ITU/Divisional Unit to cancel the notice of allowance. The examining attorney should make an appropriate note in the “Notes-to-the-File” section of the record, and then examine the amendment to allege use. If the amendment to allege use can be approved, and does not raise any issues that require the examining attorney to issue an Office action requiring a response, the examining attorney should approve the amendment to allege use (see TMEP §1104.11). The mark must then be republished.

If examination of the amendment to allege use raises issues that would require the examining attorney to issue requirements or refusals in an Office action, the examining attorney should request jurisdiction for the purpose of issuing the relevant requirements or refusals. See TMEP §1504.04(a). The proposed Office action setting forth the relevant requirements or refusals must accompany the request for jurisdiction. If the applicant ultimately complies with all requirements and overcomes all refusals, the amendment to allege use will be approved. The mark must then be republished.

### *Applications that are the Subject of an Opposition*

If a notice of opposition has been filed when a timely amendment to allege use is associated with the application, the Board will usually suspend the opposition proceeding and remand the application to the examining attorney for examination of the amendment to allege use. The examining attorney should follow the procedures explained above, except that no request for jurisdiction is necessary. Once the amendment to allege use is ultimately approved or withdrawn, the application should be referred back to the Board for appropriate action. [Trademark Trial and Appeal Board Manual of Procedure](#) (“TBMP”) §219.

### *Applications that are the Subject of an Extension of Time to Oppose*

If the application is under an extension of time to file an opposition when the amendment to allege use is associated with the application, the potential opposer must continue to file further request(s) for extension(s) of time to oppose, or file a notice of opposition, if it wishes to preserve its right to oppose if the amendment to allege use is withdrawn by the applicant or approved by the examining attorney. TBMP §219. The Board will not suspend the potential opposer’s time to file a notice of opposition. See notice at 68 Fed. Reg. 55748, 55760 (Sept. 26, 2003).

**1104.05                    Amendment to Allege Use Filed in Conjunction With Application**

If an applicant files an intent-to-use application under 15 U.S.C. §1051(b), and, at the same time, files an amendment to allege use asserting dates of use before the filing date of the application, the applicant will be required to comply with all requirements related to the amendment to allege use, including the payment of the required fees for all classes.

**1104.06                    Processing Amendment to Allege Use Received Before Application is Assigned to an Examining Attorney**

If an amendment to allege use is received before an application has been assigned to an examining attorney, the LIE will review the amendment to allege use to determine whether it complies with the minimum filing requirements of 37 C.F.R. §2.76(e) and will take appropriate action. See TMEP §§1104.01 *et seq.* If the amendment to allege use complies with the minimum filing requirements, it will be placed in the record and examined on the merits when the application is assigned to an examining attorney. If it does not, the LIE will advise the applicant in writing of the deficiency and advise the applicant that it must correct the deficiency before the mark is approved for publication, or the amendment to allege use will not be examined on the merits. See 37 C.F.R. §2.76(g).

**1104.07                    Amendments to Allege Use and Ex Parte Appeals**

An amendment to allege use may be filed together with a notice of appeal to the Trademark Trial and Appeal Board, or it may be filed while an appeal is pending.

Once the appeal is filed, the Board has jurisdiction over the application. If the applicant files the amendment to allege use *with* the notice of appeal, the Board will institute the appeal, suspend action on the appeal, and remand the case to the examining attorney to examine the amendment to allege use. When the applicant files the amendment to allege use *after* commencement of the appeal, the Board may, in its discretion, suspend action on the appeal and remand the application to the examining attorney for consideration of the amendment to allege use, or it may continue action on the appeal, thus deferring examination of the amendment to allege use until after disposition of the appeal.

If the Board remands the application, the examining attorney should continue examination according to standard examining procedures until final resolution of any new issues that arise in the examination of the amendment to allege use. If all issues are resolved or made the subject of a final action, the examining attorney should refer the application back to the Board for resumption of the appeal. TBMP §1206.01.

If the examining attorney withdraws the refusal or requirement that is the subject of the appeal, he or she should advise the applicant or the applicant's attorney by telephone or e-mail, and make an appropriate note in the "Notes-to-the-File" section of the record.

#### **1104.08 Requirements for a Complete Amendment to Allege Use**

The requirements for a *complete* amendment to allege use are:

- (1) a verified statement that the applicant is believed to be the owner of the mark and that the mark is in use in commerce, specifying the dates of the applicant's first use of the mark anywhere and first use of the mark in commerce, and setting forth or incorporating by reference those goods/services specified in the application on or in connection with which the mark is in use in commerce;
- (2) one specimen or facsimile per class of the mark as used in commerce that meets the requirements of 37 C.F.R. §2.56; and
- (3) the prescribed fee for each class (see 37 C.F.R. §2.6).

37 C.F.R. §2.76(b).

#### **1104.09 Examination of Amendment to Allege Use by Examining Attorney**

If a timely filed amendment to allege use meets the minimum requirements of 37 C.F.R. §2.76(e) (see TMEP §1104.01), the examining attorney will examine the amendment to allege use.

The examining attorney must examine the amendment to allege use for compliance with all relevant sections of the Act. The following sections present examples of issues that should be considered during examination of the amendment to allege use. These sections do not exhaust all possibilities, but rather present a general framework governing the areas for examination.

##### **1104.09(a) Ownership**

The examining attorney must confirm that the proper party has filed the amendment to allege use. Only the applicant or a valid assignee under §10 of the Trademark Act, 15 U.S.C. §1060, may file an amendment to allege use.

If the party filing the amendment to allege use is the owner at the time of filing, but the records of the USPTO show title in another party, the examining attorney must refuse to approve the amendment to allege use and advise the applicant in writing that the amendment to allege use cannot be accepted, because it was not filed by the owner. To overcome the refusal, the applicant may submit evidence to establish chain of title within the response period

specified in the Office action. See 37 C.F.R. §§3.71(d) and 3.73(b). To establish ownership, the party who filed the amendment to allege use must either: (1) record an assignment or other document of title with the Assignment Services Branch, and include a statement that the document has been recorded in the response to the Office action; or (2) submit other evidence of ownership, in the form of a document transferring ownership from one party to another or an explanation, in the form of an affidavit or declaration under 37 C.F.R. §2.20, that a valid transfer of legal title has occurred. 37 C.F.R. §3.73(b)(1); TMEP §502.01.

If an amendment to allege use is filed by the owner of the mark, but there is a minor error in the manner in which the name of the owner is set out, the mistake may be corrected by amendment. See TMEP §1201.02(c) for examples of correctable and non-correctable errors.

However, if the party filing the amendment to allege use was not the owner of the mark at the time of filing, the examining attorney should not approve the amendment to allege use. The examining attorney must advise the applicant in writing that the amendment to allege use cannot be accepted, and that the true owner may file a substitute amendment to allege use (including a filing fee for each class) on or before the date the application is approved for publication.

See 37 C.F.R. §3.85 and TMEP §502.02(a) regarding the issuance of a registration certificate in the name of the new owner, and TMEP §502.02(c) regarding an examining attorney's handling of an application after the mark has been assigned.

#### **1104.09(b) Verification and Date of Execution**

The verification must be signed by the applicant or a person properly authorized to sign on behalf of the applicant. 37 C.F.R. §2.76(b)(1). See 37 C.F.R. §2.193(e)(1) and TMEP §611.03(a) as to who is properly authorized to sign on behalf of an applicant. Generally, the USPTO will not question the authority of the person who signs a verification unless there is an inconsistency in the record as to the signatory's authority to sign.

If the amendment to allege use is not filed within one year after it is signed, the examining attorney must require a substitute or supplemental verification or declaration under 37 C.F.R. §2.20 stating that the mark is still in use in commerce. 37 C.F.R. §2.76(i); TMEP §804.03.

See TMEP §§611 *et seq.* regarding signature.

#### **1104.09(c) Identification of Goods/Services**

The examining attorney must examine the identification of goods/services in an amendment to allege use to ensure that it conforms to the goods/services

specified in the application. The applicant may limit or clarify the goods/services, but may not add to or expand the identification. 37 C.F.R. §2.71(a). The amendment to allege use must include *all* the goods/services for which the applicant seeks registration under §1(b). An amendment to allege use cannot be accepted for only some of the goods/services unless it is accompanied by a request to divide out the goods/services that are not in use. See 37 C.F.R. §2.76(c); TMEP §1104.03(a).

If the applicant has not specified the goods/services in the amendment to allege use, as required by 37 C.F.R. §2.76(b)(1)(ii), or if the goods/services specified in the amendment to allege use exceed the scope of the goods/services specified in the application, the examining attorney must require an amendment.

In a *paper* amendment to allege use, if goods/services identified in the application are omitted from the amendment to allege use, but the applicant has not indicated an intention to delete those goods/services from the application or filed a request to divide the application, the examining attorney should confirm that the applicant intends to delete the omitted goods/services. The applicant may amend the amendment to allege use to claim use on or in connection with the goods/services that were omitted, provided that: (1) the applicant did not expressly delete the goods/services; and (2) the applicant verifies in an affidavit or declaration under 37 C.F.R. §2.20 that it has used the mark in commerce on or in connection with those goods/services prior to filing the amendment to allege use. Inadvertently omitted goods/services may not be reinserted by examiner's amendment, because verification is required.

If the applicant lists *all* the goods/services identified in the application in the section of a pre-printed paper amendment to allege use form designated for the identification of goods/services that are not in use (the effect of which is a representation that the mark was not used in connection with any goods/services), then the applicant has not expressed an intention to delete these goods/services, and the examining attorney must inquire as to the discrepancy.

Omission of goods/services in a paper amendment to allege use is the only instance when an applicant may reinsert inadvertently omitted goods/services. Once expressly deleted or omitted from the identification of goods/services in a statement of use or request for extension of time to file a statement of use, goods/services may not be reinserted by later amendment. TMEP §1402.07(e).

When an amendment to allege use is filed electronically, the TEAS form requires the applicant to expressly indicate an intention to delete a class, or to delete goods/services within a class. Therefore, if any of the goods/services identified in the application do not appear in the identification of goods/services in the amendment to allege use, the examining attorney

should not issue any inquiry with respect to these deleted goods/services. The applicant may not thereafter reinsert these goods/services.

If an amendment of the identification of goods/services results in the addition of class(es) to the application after an amendment to allege use is filed, the examining attorney must require payment of the fee(s) for filing the amendment to allege use in the added class(es), in addition to the fee(s) required by 37 C.F.R. §2.6(a)(1) for adding a class(es) to the application. TMEP §1403.02(c).

#### **1104.09(d) Use in Commerce and Dates of Use**

An amendment to allege use must include a verified statement that “the mark is in use in commerce,” and must specify the dates of the applicant’s first use of the mark and first use of the mark in commerce for each class of goods/services. 37 C.F.R. §2.76(b)(1)(ii). The applicant may amend the dates of use if the applicant supports the amendment with an affidavit or declaration under 37 C.F.R. §2.20. 37 C.F.R. §2.71(c). The applicant may not amend the dates of use to recite dates of use that are subsequent to the filing of the amendment to allege use. However, the applicant may withdraw the amendment to allege use. 37 C.F.R. §2.76(h).

The requirement for a verified statement that “the mark is in use in commerce” is a minimum filing requirement that must be satisfied before the amendment to allege use may be examined on the merits. 37 C.F.R. §2.76(e)(3). See TMEP §§1104.01 *et seq.* regarding amendments to allege use that do not meet minimum filing requirements.

#### **1104.09(e) Specimen**

An amendment to allege use must include a specimen for each class of goods/services. The examining attorney must review the specimen for compliance with all relevant requirements. See TMEP §§904.04 *et seq.* regarding material that is appropriate as a trademark specimen, TMEP §§1301.04 *et seq.* regarding material that is appropriate as a service mark specimen, and TMEP §§1202 *et seq.* and 1301.02 *et seq.* regarding use as a mark.

If the applicant submits a substitute specimen in conjunction with an amendment to allege use, the applicant must verify that the applicant used the substitute specimen in commerce on or in connection with the goods/services prior to filing the amendment to allege use. Similarly, if the applicant submits a new specimen in support of a multiple-class application that is not identical to the specimen originally filed, the applicant must verify that the applicant used the new specimen in commerce on or in connection with the goods/services prior to filing the amendment to allege use. TMEP §904.05.

If, in fact, the mark was first used on dates other than those asserted in the amendment to allege use, the dates of use must be corrected. See TMEP §§903.04 and 1104.09(d) regarding amendment of the dates of use.

If the amendment to allege use is filed through TEAS, the specimen must be a digitized image in .jpg or .pdf format. 37 C.F.R. §2.56(d)(4). See TMEP §904.02(a) for additional information about electronically filed specimens.

#### **1104.09(f) Drawing**

Under 37 C.F.R. §2.51(b), the drawing in an intent-to-use application must be a substantially exact representation of the mark as intended to be used *and* as actually used, as shown on the specimen filed with the amendment to allege use. An applicant may not amend the mark in the original drawing if the amendment constitutes a material alteration of the mark. 37 C.F.R. §2.72(b)(2); TMEP §§807.14 *et seq.* The same standards that apply to use applications in determining whether specimens support use of the mark and whether amendments to the drawing can be permitted also apply to amendments to allege use.

Therefore, if the mark in the drawing filed with the original application is not a substantially exact representation of the mark as used on the specimen filed with the amendment to allege use, the examining attorney must require: (1) *either* submission of a new specimen *or* an amendment of the mark in the drawing to agree with the mark shown on the specimen, if such an amendment would not be a material alteration of the mark as shown in the original drawing; or (2) submission of a new specimen, if amendment of the mark would be a material alteration of the mark as shown in the original drawing. 37 C.F.R. §2.72(b)(2). See TMEP §§807.14 *et seq.* regarding material alteration.

#### **1104.09(g) Fees**

While the payment of the fee for at least one class is enough to meet the minimum filing requirements for an amendment to allege use (37 C.F.R. §2.76(e)), the examining attorney must require payment of fees to cover *all* classes identified in the application before approving the amendment to allege use. The applicant may amend the identification to delete class(es).

If class(es) are added to the application after the filing of the amendment to allege use, the examining attorney must require payment of the fee(s) for filing the amendment to allege use in the added class(es), in addition to the fee(s) required by 37 C.F.R. §2.6(a)(1) for adding class(es) to the application. See TMEP §1403.02(c) regarding the amount of the fee(s) for adding class(es) to an application.

If the applicant submits a filing fee that is deficient (e.g., if the fee is charged to a deposit account with insufficient funds, a check is returned unpaid, or an

EFT or credit card payment is refused or charged back by a financial institution), the examining attorney must require repayment of the fee before approving the amendment to allege use. In addition, when an EFT or credit card is refused, or a check is returned unpaid, the examining attorney must require a processing fee under 37 C.F.R. §2.6(b)(12). This processing fee must be paid even if the applicant withdraws the amendment to allege use or deletes a class(es). See TMEP §405.06 regarding payments that are refused.

**1104.09(h) Issuance of Actions by Examining Attorney Related to the Amendment to Allege Use**

When an LIE reviews an amendment to allege use and refers it to the examining attorney for examination on the merits, the examining attorney will examine the amendment to allege use.

If the examining attorney determines that the amendment to allege use is not acceptable, or that it raises new issues in the case, the examining attorney will issue an Office action stating all refusals and requirements arising in the examination of the amendment to allege use and incorporating all unresolved issues from any outstanding Office action in the application. The examining attorney's action related to the amendment to allege use supersedes any outstanding Office action, and the applicant's response on all issues is due within six months from the date of the new action. The new action must be nonfinal, because those issues arising from the examination of the amendment to allege use will have been raised for the first time.

If the amendment to allege use was referred for examination before the case was assigned to the examining attorney, the examining attorney will examine the application as a whole, including the amendment to allege use, and will issue a first Office action addressing all issues in the application and the amendment to allege use.

If the application is suspended, the examining attorney should examine the amendment to allege use. If any action is required, the examining attorney should remove the application from suspension and take appropriate action. Any refusals or requirements that were operative at the time of suspension should be incorporated in the examining attorney's Office action.

If the amendment to allege use is referred for examination on the merits at the same time as a response, or if it is referred for examination when the application is in the examining attorney's amended docket after receipt of a response, the examining attorney should consider both the response and the amendment to allege use. If the amendment to allege use is acceptable in all respects, the examining attorney should approve the amendment to allege use and take whatever action is necessary on the response. See TMEP §1104.11 regarding approval of the amendment to allege use.

See TMEP §1104.07 regarding an amendment to allege use filed with a notice of appeal or after the commencement of an appeal.

#### **1104.10 Amendment and Withdrawal of Amendment to Allege Use**

The applicant may amend the amendment to allege use to correct deficiencies, to overcome a refusal, to comply with a requirement, or for any other purpose.

The applicant may withdraw the amendment to allege use at any time before approval of the mark for publication. 37 C.F.R. §2.76(h). The USPTO will *not* refund the fee for filing an amendment to allege use that is withdrawn (except as provided in TMEP §1104.04).

A withdrawn amendment to allege use document, specimen(s), and any other materials filed with the amendment to allege use will remain part of the record.

The applicant may authorize the examining attorney to issue an examiner's amendment that withdraws the amendment to allege use.

If the applicant withdraws the amendment to allege use, the application will be processed as an intent-to-use application subject to publication and issuance of a notice of allowance. After issuance of the notice of allowance, the applicant must file a statement of use.

If the applicant wishes to request withdrawal of an amendment to allege use during an *ex parte* appeal, the applicant should direct the request to the Trademark Trial and Appeal Board.

If the applicant withdraws the amendment to allege use, the examining attorney will withdraw any requirements or refusals specifically related to use of the mark, such as objections related to the form of the verified statement itself, the agreement of the mark as used on the specimens with the mark shown on the drawing, or the use of the applied-for designation as a trademark or service mark evidenced by the specimen. The examining attorney should also withdraw any requirement or refusal related to the execution of the amendment to allege use.

The examining attorney should maintain any requirement or refusal arising from the amendment to allege use not specifically related to the dates of use or use of the mark, such as refusals under 15 U.S.C. §1052(e)(1), §1052(e)(2), §1052(e)(3), or §1052(e)(4). The amendment to allege use document, specimen(s), and any materials submitted with the amendment to allege use may be relied on to support refusals or requirements under these sections.

If the applicant withdraws the amendment to allege use after it has been approved, the examining attorney must withdraw the approval from TRAM.

#### **1104.11 Approval of Amendment to Allege Use After Examination**

The examining attorney must approve the amendment to allege use if it complies with the requirements specified in 37 C.F.R. §§2.76(b) and (c). The amendment to allege use must be approved even if requirements or refusals unrelated to 37 C.F.R. §2.76(b) or §2.76(c) are necessary as a result of the examination of the amendment to allege use. *Approval of the amendment to allege use does not signify that the application is in condition for approval for publication.*

The examining attorney should *not* approve the amendment to allege use if it does not meet all the requirements of 37 C.F.R. §§2.76(b) and (c), e.g., if the applicant has not provided both a specimen and a fee for each class, if the amendment to allege use was not filed by the owner of the mark, or if the goods/services in the amendment to allege use do not conform to the goods/services specified in the application.

On the other hand, if the amendment to allege use meets the requirements of 37 C.F.R. §§2.76(b) and (c), but requirements or refusals related to use of the mark, inconsistencies between the mark in the drawing and the mark on the specimens, or other matters require action, the examining attorney *should* approve the amendment to allege use, and then take action on those other issues. For example, if the specimen shows ornamental use of the proposed mark, the examining attorney should approve the amendment to allege use and issue a refusal based on ornamental use of the proposed mark.

When approving an amendment to allege use, the examining attorney must perform the appropriate TRAM transaction to ensure that a computer-generated notice is issued advising the applicant that the amendment to allege use has been approved and that, if and when the application publishes, it will be published in the same manner as a use-based application. In other words, publication in the *Official Gazette* will include dates of use and, if the application survives the opposition period, the USPTO will issue a certificate of registration rather than a notice of allowance.

#### **1105 Publication of Intent-to-Use Applications for Opposition**

If an amendment to allege use has been submitted and accepted, the intent-to-use application is processed as a use application. If the examining attorney determines that the mark is entitled to registration, the examining attorney will approve the mark for publication and the mark will be published for opposition. If the application is not successfully opposed, the mark will register and the USPTO will issue a certificate of registration.

If no amendment to allege use has been accepted for an intent-to-use application, and the examining attorney determines that the mark is entitled to registration but for the submission of an allegation of use, the examining attorney will approve the mark for publication and the mark will be published for opposition. If the application is not successfully opposed, the USPTO will issue a notice of allowance. 15 U.S.C. §1063(b)(2); 37 C.F.R. §2.81(b).

## **1106 Notice of Allowance**

### **1106.01 Issuance of the Notice of Allowance**

Section 13(b)(2) of the Trademark Act, 15 U.S.C. §1063(b)(2), provides for issuance of a notice of allowance if a §1(b) application is published for opposition and is not successfully opposed. The notice of allowance in an intent-to-use application will issue within the same time frame that a registration would issue in a use application (normally twelve weeks after the date of publication). The USPTO does not publish any notification in the *Official Gazette* that a notice of allowance has been issued.

The notice of allowance will list the serial number of the application, the name of the applicant, the correspondence address, the mark, the identification of goods/services, and the date of issuance of the notice of allowance. 37 C.F.R. §2.81(b). The notice of allowance is a key document because its issue date establishes the due date for filing a statement of use.

The accuracy of the information stated on the notice of allowance is important. If there are any errors in the notice of allowance, or if the applicant believes that the notice of allowance issued in error (e.g., because an amendment to allege use was previously approved by the USPTO or the filing basis of the application should not be designated as intent-to-use under §1(b)), the applicant should notify the ITU/Divisional Unit immediately, preferably by fax or telephone. See TMEP §1106.04. Telephone and fax numbers may be found on the USPTO website at <http://www.uspto.gov>.

If an applicant asserts other bases for registration in addition to §1(b), the USPTO will publish the mark for opposition and will issue a notice of allowance if there is no successful opposition. The goods/services for all the bases will remain in the application pending the filing and approval of a statement of use for the goods/services based on §1(b) unless the applicant files a request to divide, or a request to delete the §1(b). See TMEP §§1110 *et seq.* regarding requests to divide, and TMEP §806.04(a) regarding the deletion of a §1(b) basis after issuance of a notice of allowance. If the applicant fails to timely file a statement of use or a request for an extension of time to file a statement of use in response to a notice of allowance, the entire application will be abandoned, unless the applicant files a request to divide before the expiration of the deadline for filing the statement of use. TMEP §806.02(d). The applicant may file a petition to revive if the delay in filing the

statement of use or extension request was unintentional. See TMEP §§1714 *et seq.*

## **1106.02 Action by Examining Attorney After Issuance of the Notice of Allowance**

If, after issuance of the notice of allowance but before submission of the statement of use, the USPTO determines that a clear error (see TMEP §706.01) was made in approving the mark for publication, the USPTO will cancel the notice of allowance and return the application to examination. The examining attorney will issue an appropriate Office action that includes the relevant requirement or refusal and informs the applicant of the cancellation of the notice of allowance. See TMEP §1106.03 regarding cancellation of the notice of allowance.

After the notice of allowance issues, the examining attorney has jurisdiction to act in the case. 37 C.F.R. §2.84(a). Therefore, the examining attorney does not have to request jurisdiction to take an action, as would be required after publication but before the notice of allowance issues. However, after a notice of allowance issues, the examining attorney should not make a refusal or requirement that could or should have been made during initial examination of the application unless the initial failure to make the refusal or requirement was a clear error. If the examining attorney determines that he or she must make a refusal or requirement after issuance of the notice of allowance that could or should have been made during initial examination, the examining attorney must consult with his/her managing attorney or senior attorney before taking the action. This must be done whether the action is to be taken before, during, or after examination of the statement of use, and regardless of whether the notice of allowance is cancelled. This applies to any refusal that arguably could or should have been made during initial examination, such as most refusals under §2(d) or §2(e)(1) of the Act.

There is no restriction in the Trademark Act or Trademark Rules of Practice as to the period of time prior to registration when the USPTO may issue a new requirement or new refusal. The USPTO has a duty to issue valid registrations and has broad authority to correct errors made by examining attorneys and other USPTO employees. See *Last Best Beef LLC v. Dudas*, 506 F.3d 333, 340, 84 USPQ2d 1699, 1704 (4th Cir. 2007) (“[F]ederal agencies, including the USPTO, have broad authority to correct their prior errors.”); see also *BlackLight Power Inc. v. Rogan*, 295 F.3d 1269, 63 USPQ2d 1534 (Fed. Cir. 2002) (affirming that USPTO officials acted within their authority in a reasonable manner to withdraw a patent from issuance in order to fulfill the USPTO’s mission to issue valid patents, even after Notice of Allowance, payment of the issue fee and notification of the issue date, and with publication of the drawing and claim in the *Official Gazette*).

Thus, if the USPTO discovers that a mistake was made during initial examination that would result in issuance of a registration in violation of the Trademark Act or applicable rules, the USPTO must issue any necessary requirements or refusals, even if they could or should have been raised during initial examination.

See TMEP §1109.08 regarding the issuance of refusals and requirements during examination of a statement of use.

### **1106.03 Cancellation of Notice of Allowance**

If the USPTO cancels the notice of allowance before the filing or examination of the statement of use, the USPTO will refund any fees paid in conjunction with a statement of use or request(s) for extension(s) of time to file a statement of use, except where: (1) the applicant files a request to delete the §1(b) basis from a multiple-basis application (see TMEP §806.04(a)); or (2) the notice of allowance is cancelled as a result of an amendment to the filing basis after publication, pursuant to a petition to the Director (see TMEP §806.03(j)(ii)).

Cancellation of the notice of allowance is done by the ITU/Divisional Unit of the USPTO. To request that a notice of allowance be cancelled, a USPTO employee must send an e-mail request to the ITU/Divisional Unit's internal mailbox with a clear statement of the reason why the notice of allowance is being cancelled. The ITU staff will enter an appropriate note in the "Notes-to-the-File" section of the record stating who requested the cancellation and why. When the notice of allowance is cancelled, the examining attorney must inform the applicant that this has been done.

When the notice of allowance is cancelled, the application is returned to initial examination. The examining attorney does not have to request jurisdiction to issue an Office action. If the applicant overcomes the refusal or complies with the requirement, the examining attorney may approve the mark for publication again. The mark must be republished.

If the application is returned to initial examination, any statement of use previously submitted will remain in the record but will not be examined unless it is resubmitted with the required fee as an amendment to allege use or statement of use at the appropriate time.

If the applicant files a statement of use or request for an extension of time to file a statement of use after the notice of allowance has been cancelled, the ITU/Divisional Unit will inform the applicant in writing that the statement of use or extension request is untimely, and refund the filing fee.

#### **1106.04 Correction of Errors in Notice of Allowance**

When the applicant receives a notice of allowance, the applicant should check the accuracy of the information. If there are any errors in the notice of allowance, the applicant should notify the ITU/Divisional Unit of the USPTO immediately, preferably by fax or telephone. Telephone and fax numbers may be found on the USPTO website at [www.uspto.gov/teas/contactUs.htm](http://www.uspto.gov/teas/contactUs.htm).

##### *Correction of USPTO Error*

If an error in the notice of allowance was the result of a USPTO error (e.g., entering data incorrectly or failing to enter a timely filed amendment), the USPTO will determine whether the change requires republication. If necessary, the ITU staff will contact the examining attorney by e-mail to approve the change and determine whether republication is required.

If the change may be made without republication, the ITU staff will make the correction and issue a corrected notice of allowance. *The USPTO will not issue a new notice of allowance or extend the time for filing a statement of use.*

If republication is required, and no action by the examining attorney that requires a response is necessary, the ITU staff will make the correction, cancel the notice of allowance, and refund any fees paid for filing a statement of use or request(s) for extension of time to file a statement of use. The application will then be scheduled for republication. If the application is not successfully opposed, the USPTO will issue a new notice of allowance.

If the examining attorney must issue an Office action that requires a response as a result of the requested correction, the ITU staff will cancel the notice of allowance, refund any fees paid for filing a statement of use or request(s) for extension of time to file a statement of use, and forward the application to the examining attorney for further action.

##### *Correction of Applicant's Error*

If an error in the notice of allowance is the result of an applicant's error (e.g., providing incorrect information in the application or in an amendment to the application), the applicant must file a written amendment, which will be processed like any other amendment filed after issuance of the notice of allowance and before filing of the statement of use. See TMEP §1107.

#### **1107 Amendment After Issuance of the Notice of Allowance and Before Filing of the Statement of Use**

Generally, the only amendments that may be entered in an application between the issuance of the notice of allowance and the submission of a statement of use are: (1) the deletion of specified goods/services from the identification of goods/services; (2) the deletion of a basis in a multiple-basis

application; and (3) changes of attorney and changes of address. See 37 C.F.R. §2.77(a). “Deletion,” within the meaning of 37 C.F.R. §2.77, means the elimination of an existing item in an identification of goods/services in its entirety. Deletion is distinct from other types of amendments to limit an identification, such as amendments to limit the goods/services as to types, channels of trade or class of purchasers, or to restrict an existing item in scope by the introduction of some qualifying language, or the substitution of specific terms for more general terms.

The USPTO will normally not consider any other amendment to the application during this period. If the applicant submits any other amendment during this period, the USPTO will place the amendment in the record for consideration at the time of examination of the statement of use. 37 C.F.R. §2.77(b). The ITU staff will advise the applicant in writing that the amendment has been received but that it will not be considered until the examining attorney examines the statement of use unless the applicant files a petition to the Director. The ITU staff will enter a notation in the “Notes-to-the-File” section of the record directing the examining attorney’s attention to the amendment.

The applicant may file a petition under 37 C.F.R. §§2.146(a)(3) and (a)(5) to waive 37 C.F.R. §2.77 to permit an examining attorney to examine an amendment (other than an amendment deleting a basis or deleting specified goods/services) during the period between the issuance of the notice of allowance and the filing of the statement of use. TMEP §1107.01. *In re Upsher-Smith Laboratories, Inc.*, 45 USPQ2d 1371 (Comm’r Pats. 1997). The petition must be accompanied by the fee required by 37 C.F.R. §2.6. See TMEP Chapter 1700 regarding petitions.

The filing of an amendment after issuance of the notice of allowance does not extend the deadline for filing the statement of use. Unless the notice of allowance is cancelled because the amendment requires republication, the applicant must file a statement of use or request for an extension of time to file a statement of use.

See TMEP §1106.04 regarding correction of errors in a notice of allowance, TMEP §806.04(a) regarding the deletion of a §1(b) basis after issuance of a notice of allowance, and TMEP §806.03(j)(ii) regarding amendments to add or substitute a basis between issuance of the notice of allowance and filing the statement of use.

#### **1107.01 Examination of Amendment Filed After the Notice of Allowance Issues But Before a Statement of Use is Filed**

As noted in TMEP §1107, an applicant may file a petition to the Director under 37 C.F.R. §§2.146(a)(3) and (a)(5) to waive 37 C.F.R. §2.77 to permit an examining attorney to examine an amendment during the period between the issuance of a notice of allowance and the filing of a statement of use. *In*

*re Upsher-Smith Laboratories, Inc.*, 45 USPQ2d 1371 (Comm'r Pats. 1997). If such a petition is granted, the examining attorney will either accept or reject the proposed amendment(s) in accordance with the following procedures:

*Amendment Accepted; Republication Not Required:* If an examining attorney determines that an amendment is acceptable and republication is not required, the examining attorney will call or e-mail the applicant to notify the applicant of the acceptance, and make a note in the "Notes-to-the-File" section of the record that the proposed amendment has been accepted and that the applicant has been notified of the acceptance. The examining attorney will instruct the LIE to enter the amendment. The application will await the filing of a statement of use or extension request.

*Amendment Unacceptable:* If an examining attorney determines that an amendment is unacceptable, the examining attorney will call or e-mail the applicant to notify the applicant that the amendment is not accepted, and make a note in the "Notes-to-the-File" section of the record that the proposed amendment is unacceptable and that the applicant has been notified of this. The application will await filing of a statement of use or extension request. The applicant must accept the refusal to enter the amendment, but may again request to amend the application when filing the statement of use.

*Amendment Accepted; Republication Required:* If an examining attorney determines that the amendment is acceptable, but that republication is required, the examining attorney will call or e-mail the applicant to ask if the applicant wishes to maintain the request for amendment in light of the fact that republication is required. If the applicant elects to maintain the request, the examining attorney will make a note in the "Notes-to-the-File" section of the record that the proposed amendment has been accepted, that republication is required, and that the applicant has been advised of this. The examining attorney will have the amendment entered, and will request that the ITU staff cancel the notice of allowance by sending an e-mail message to the internal TM ITU Cancel mailbox. The ITU staff will cancel the notice of allowance and the application will be scheduled for republication.

*Examiner's Amendment Required; Republication Not Required:* If an examining attorney determines that an examiner's amendment is necessary, and republication is not required, the examining attorney will prepare, but not mail, the examiner's amendment. The examiner's amendment must contain a statement that republication is not required. The examining attorney must e-mail the internal TMPHOTOCOMP mailbox, with the unmailed

examiner's amendment attached, along with instructions for entering the requested amendment. The body of the e-mail message must include a statement that republication is not required. The Office of Trademark Program Control will enter and mail the examiner's amendment.

*Examiner's Amendment Required; Republication Required:* If an examining attorney determines that an examiner's amendment is necessary, and republication is required, the examining attorney will call or e-mail the applicant to ask if the applicant wishes to maintain the request for amendment in light of the fact that republication is required. If the applicant elects to maintain the request, the examining attorney will prepare, but not mail, the examiner's amendment. The examiner's amendment must contain a statement that republication is required. The examining attorney must e-mail the internal TMPHOTOCOMP mailbox, with the unmailed examiner's amendment attached, along with instructions for entering the requested amendment. The body of the e-mail message must contain a statement that republication of the mark will be required, and request cancellation of the notice of allowance. The Office of Trademark Program Control will ask the ITU staff to cancel the notice of allowance, enter and mail the examiner's amendment, and republish the mark.

*The granting of a petition to examine an amendment between issuance of the notice of allowance and filing of the statement of use does not extend the deadline for filing a statement of use or request for an extension of time to file a statement of use (unless the notice of allowance is cancelled).* Regardless of whether an applicant has received a response to a proposed amendment, the applicant must file its extension request or statement of use when it becomes due. The extension request or statement of use may refer to the proposed amended identification.

See TMEP §1505.03 *et seq.* for examples of situations where republication is and is not required.

## **1108                    Requests for Extensions of Time to File the Statement of Use**

Section 1(d) of the Trademark Act, 15 U.S.C. §1051(d), requires that a statement of use be filed within six months after the issuance of the notice of allowance, or before the expiration of a previously granted extension of time to file a statement of use. If the mark is not in use in commerce before the expiration of the six-month period following the issuance of the notice of allowance, the applicant must file a request for an extension of time to file a statement of use within the six-month period to avoid abandonment of the application.

The first six-month extension may be requested without a showing of good cause. Up to four additional six-month extensions may be requested; each must include a showing of good cause. 15 U.S.C. §1051(d)(2). Thus, the total time available for filing the statement of use may not be extended beyond thirty-six months from the issuance date of the notice of allowance.

**To expedite processing**, it is recommended that the applicant file the extension request through TEAS, at <http://www.uspto.gov>. Alternatively, an applicant may call the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199 to obtain a pre-printed paper form. The applicant may mail, fax, or hand-deliver the completed form to the USPTO. If the form is faxed, it must be accompanied by an authorization to charge the filing fee to a credit card or deposit account. The credit card authorization form is available at <http://www.uspto.gov/web/forms/2038.pdf>. If the extension request is filed through TEAS, payment must be made by credit card, deposit account, or EFT.

Paper forms may be delivered by hand or courier to the Trademark Assistance Center (“TAC”), at James Madison Building, East Wing, Concourse Level, 600 Dulany Street, Alexandria, Virginia. TAC is open 8:30 a.m. to 5:00 p.m., Eastern Time, Monday through Friday, except on Federal holidays within the District of Columbia.

Extension requests are processed by the ITU/Divisional Unit of the USPTO.

#### **1108.01 Time for Filing Requests for Extensions of Time to File the Statement of Use**

Under 15 U.S.C. §1051(d), the applicant must file the extension request within six months of the issuance date of the notice of allowance, or before the expiration of a previously granted extension; otherwise the application is abandoned. 15 U.S.C. §1051(d)(4); 37 C.F.R. §§2.65(c) and 2.88(h).

Extensions of time are granted in six-month increments. 37 C.F.R. §2.89(c). The first extension will begin to run from the expiration of the six-month period following issuance of the notice of allowance. An applicant will receive the full benefit of each extension before a subsequent extension will begin to run. The six-month period following issuance of the notice of allowance (or any subsequent six-month extension period) will not be cut short by the grant of an extension. No extension will be granted for more than six months. 37 C.F.R. §2.89(c).

The applicant cannot file two extension requests within the same six-month period following the issuance of the notice of allowance. For example, if the notice of allowance was issued May 6, 2009, and the applicant files the first extension request on July 2, 2009, the applicant may file the second extension request no earlier than November 7, 2009 (the beginning of the second six-month period after issuance of the notice of allowance) and no

later than May 6, 2010 (the expiration of the first extension of time to file a statement of use).

The USPTO will notify the applicant of the grant or denial of an extension request, and of the reasons for a denial. However, failure to notify the applicant of the grant or denial of an extension request before the expiration of the requested extension does not relieve the applicant of the duty to file a statement of use or further extension request. 37 C.F.R. §2.89(g).

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

A paper extension request is considered timely if it is received in the Office by the due date or mailed or transmitted by the due date with a certificate of mailing or facsimile transmission under 37 C.F.R. §2.197. See TMEP §§305.02 *et seq.* and 306.05 *et seq.* for certificate of mailing and certificate of facsimile transmission procedures to avoid lateness.

## **1108.02 Requirements for Request for an Extension of Time to File a Statement of Use**

### *First Extension Request*

The first request for an extension of time to file a statement of use must include: (1) a written request from the applicant, before expiration of the six-month period following issuance of the notice of allowance; (2) the prescribed fee for each class of goods/services; and (3) a verified statement signed by the applicant or a person properly authorized to sign on behalf of the applicant (TMEP §804) that the applicant has a continued bona fide intention to use the mark in commerce, specifying those goods/services identified in the notice of allowance on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce. 37 C.F.R. §2.89(a).

### *Second and Subsequent Extension Requests*

A second or subsequent extension request must be submitted before expiration of a previously granted extension of time and must include: (1) a written request from the applicant; (2) the prescribed fee for each class of goods/services; (3) a verified statement signed by the applicant or a person

properly authorized to sign on behalf of the applicant that the applicant has a continued bona fide intention to use the mark in commerce, specifying those goods/services identified in the notice of allowance on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce; **and** (4) a showing of good cause, as required by 37 C.F.R. §2.89(d). 37 C.F.R. §2.89(b). Extensions of time under 37 C.F.R. §2.89(b) (i.e., second and subsequent extension requests) are granted in six-month increments and may not aggregate more than 24 months. 37 C.F.R. §2.89(c).

### **1108.02(a) Ownership**

The party filing the extension request must be the owner of the application, i.e., the person or entity who is entitled to use the mark, at the time of filing. 15 U.S.C. §1051(d)(2); 37 C.F.R. §§2.89(a)(3) and 2.89(b)(3). If the party filing the extension request is not the owner of record, the request should include either a statement that the assignment or other document of title is recorded (or filed for recordation) in the Assignment Services Branch of the USPTO, or other evidence that the party filing the extension request is the owner of the application in accordance with 37 C.F.R. §§3.71(d) and 3.73(b). (*Note:* An application under §1(b) cannot be assigned before the applicant files an allegation of use, except to a successor to the applicant's business, or portion of the business to which the mark pertains. See TMEP §501.01(a).)

If the extension request is filed by someone other than the owner of record and does not include the necessary evidence of ownership, the ITU staff will issue an Office action denying the request. If the party who filed the extension request was the owner at the time of filing, the applicant may submit evidence to establish the chain of title after expiration of the statutory filing period, within the time provided in the Office action advising the applicant of the denial.

To establish ownership, the new owner must either: (1) record an assignment or other document of title with the Assignment Services Branch, *and* state in the response to the Office action that the document has been recorded; or (2) submit other evidence of ownership, in the form of a document transferring ownership from one party to another or an explanation, supported by an affidavit or declaration under 37 C.F.R. §2.20 that a valid transfer of legal title has occurred. 37 C.F.R. §3.73(b)(1); TMEP §502.01. The USPTO recommends that requests to record documents with the Assignment Services Branch be filed through Electronic Trademark Assignment System ("ETAS") at <http://etas.uspto.gov>.

If an extension request is filed by the owner, but there is a minor error in the manner in which the name of the owner is set out, the mistake may be corrected by amendment. See TMEP §1201.02(c) for examples of correctable and non-correctable errors.

If the party who filed the extension request was not the owner at the time of filing, the true owner may not file a substitute extension request unless there is time remaining in the statutory period for filing the extension request. *Cf. In re Colombo Inc.*, 33 USPQ2d 1530 (Comm’r Pats. 1994). See TMEP §1108.05 for applicant's recourse if an extension request is denied.

If the applicant notifies the ITU/Divisional Unit during the processing of an extension request that an assignment or other document of title has been recorded, and there is a clear chain of title, the ITU staff will update the owner of record in TRAM and TARR. See 37 C.F.R. §3.85 and TMEP §502.02(a) regarding the issuance of a registration certificate in the name of a new owner, and TMEP §§504 *et seq.* regarding the circumstances in which the “Ownership” field in TRAM and TARR will be automatically updated after recordation of a document with the Assignment Services Branch, even if the new owner does not notify the Trademark Operation that the document has been recorded.

#### **1108.02(b) Verification**

The extension request must be verified by someone properly authorized to sign on behalf of applicant. If the extension request is unsigned or signed by the wrong party, a substitute verification must be submitted before the expiration of the deadline for filing the statement of use. 37 C.F.R. §§2.89(a)(3) and 2.89(b)(3). See 37 C.F.R. §2.193(e)(1) and TMEP §611.03(a) regarding the definition of a person properly authorized to sign on behalf of applicant. Generally, the USPTO will not question the authority of the person who signs a verification unless there is an inconsistency in the record as to the signatory’s authority to sign.

If the extension request is not filed within one year after it is signed, the USPTO will require a substitute verification or declaration under 37 C.F.R. §2.20 that the applicant still has a bona fide intention to use the mark in commerce. 37 C.F.R. §2.89(h). See TMEP §804.03.

See TMEP §§611 *et seq.* regarding signature.

#### **1108.02(c) Filing Fees**

A filing fee sufficient to cover at least one class must be submitted within the statutory time for filing the extension request, or the request will be denied. In a multiple-class application, if the applicant files a fee sufficient to pay for at least one class, but insufficient to cover all the classes, the ITU staff will issue a notice of fee deficiency allowing the applicant thirty days to remit the amount by which the fee is deficient or specify the class(es) to be abandoned. If the USPTO does not receive a timely response to a fee deficiency letter, the USPTO will apply the fees paid to the lowest-numbered class(es) in

ascending order, and will delete the goods/services in the higher-numbered class(es) from the application. See 37 C.F.R. §§2.89(a)(2) and 2.89(b)(2).

If the filing fee for at least a single class is omitted or is deficient (e.g., if the fee is charged to a deposit account with insufficient funds, an EFT or credit card payment is refused or charged back by a financial institution, or a check is returned unpaid), the fee for at least one class of goods/services must be submitted before the expiration of the statutory filing period. If the extension request was not accompanied by an authorization to charge deficient fee(s) to a deposit account (37 C.F.R. §2.208) that has sufficient funds to cover the fee, and the applicant does not resubmit the fee before expiration of the statutory deadline, the extension request will be denied and the application will be abandoned. 37 C.F.R. §§2.89(a)(2) and (b)(2). In addition, when an EFT or credit card is refused or a check is returned unpaid, the applicant must pay the processing fee required by 37 C.F.R. §2.6(b)(12). See TMEP §405.06 regarding payments that are refused.

#### **1108.02(d) Identification of Goods/Services**

The applicant must identify or reference the goods/services on or in connection with which the applicant still has a bona fide intention to use the mark in commerce in the extension request. 15 U.S.C. §1051(d)(2); 37 C.F.R. §§2.89(a)(3) and (b)(3). The goods/services identified in the extension request must conform to those identified in the notice of allowance. 37 C.F.R. §2.89(f). If the applicant wants to delete goods/services from the application, the applicant should clearly specify those goods/services to be deleted.

The applicant may incorporate by reference the goods/services listed in the notice of allowance. This is advisable where applicant intends to retain all the goods/services identified in the notice of allowance, to avoid the possibility that goods/services may be inadvertently omitted. Thus, the applicant may specify the goods/services by referring to “those goods/services identified in the notice of allowance” or “those goods/services identified in the notice of allowance except... [followed by a listing of the goods/services to be deleted].”

If the applicant lists the goods/services with specificity in the extension request, and omits any goods/services that were listed in the notice of allowance, the USPTO will presume these goods/services to be deleted. The applicant may not thereafter request that the goods/services be reinserted in the application. 37 C.F.R. §2.89(f). In this situation, the applicant cannot file a petition under 37 C.F.R. §2.66, claiming unintentional delay in filing an extension request for the omitted goods/services.

If an applicant files an extension request on a pre-printed paper form provided by the USPTO and fails to check either of the boxes available for identifying the goods/services on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce, the ITU staff will assume that the applicant has a continued bona fide intention to use the mark

in commerce on or in connection with all the goods/services identified in the notice of allowance, and will grant the extension request, if it meets all other requirements of 15 U.S.C. §1051(d)(2) and 37 C.F.R. §2.89. *In re Omega-3 Marketing Inc.*, 35 USPQ2d 1158 (Comm'r Pats. 1994).

If the applicant lists goods/services to be deleted and the result would be to delete *all* of the goods/services in the notice of allowance, or if the applicant fails to identify or incorporate by reference *any* goods/services, the USPTO will presume this was a typographical error. Applicant will be allowed to correct the mistake. The ITU staff will issue a letter noting that no goods/services were specified or incorporated by reference in the extension request, and granting applicant thirty days in which to submit a verified statement clarifying the goods/services. However, if by mistake the applicant lists goods/services to be deleted and removal does not result in the deletion of all goods/services, the goods/services specifically listed will be deleted and may not later be reinserted.

See TMEP §1107 regarding amendments to the identification of goods/services filed between the issuance of the notice of allowance and the filing date of the statement of use.

#### **1108.02(e) Bona Fide Intention to Use the Mark in Commerce**

A request for an extension of time to file a statement of use must include a verified statement that the applicant has a continued bona fide intention to use the mark in commerce on or in connection with the goods/services identified in the notice of allowance. 37 C.F.R. §§2.89(a)(3) and (b)(3). This is a statutory requirement that must be satisfied before expiration of the statutory period for filing the extension request. *In re Custom Technologies Inc.*, 24 USPQ2d 1712 (Comm'r Pats. 1991); *In re Raychem Corp.*, 20 USPQ2d 1355 (Comm'r Pats. 1991), *modified*, *In re IMI Cornelius Inc.*, 33 USPQ2d 1062 (Comm'r Pats. 1994).

The USPTO will accept an allegation of actual use in commerce as meeting the requirement for an allegation of bona fide intention to use the mark in commerce in an extension request. *In re Vitamin Beverage Corp.*, 37 USPQ2d 1537 (Comm'r Pats. 1995).

See TMEP §1101 for additional information about the requirement for an allegation of the applicant's bona fide intention to use the mark in commerce.

#### **1108.02(f) Good Cause Required for Extensions Beyond the First Six-Month Extension**

No showing of good cause is required in the first request for an extension of time to file a statement of use, but each subsequent extension request must include a showing of good cause. 15 U.S.C. §1051(d)(2); 37 C.F.R. §§2.89(b)(4) and 2.89(d). The showing of good cause must include a

statement of the applicant's ongoing efforts to make use of the mark in commerce on or in connection with each of the goods/services covered by the extension request. Efforts to use the mark in commerce may include product or service research or development, market research, manufacturing activities, promotional activities, steps to acquire distributors, steps to obtain required governmental approval, or other similar activities. In the alternative, a satisfactory explanation for the failure to make such efforts may be submitted. 37 C.F.R. §2.89(d).

A mere assertion that the applicant is engaged in ongoing efforts is not enough; the efforts must be specified. *In re Comdial Corp.*, 32 USPQ2d 1863 (Comm'r Pats. 1993). However, the USPTO will not require a detailed explanation or evidence in a showing of good cause. The statement concerning good cause only has to refer to the types of activities listed in the rule or similar types of activities. For example, the applicant may simply state that the applicant is engaged in manufacturing and promotional activities.

The applicant may satisfy the requirement for a showing of good cause by asserting that the applicant believes that it has made valid use of the mark in commerce, and is in the process of preparing (or is concurrently filing) a statement of use, but that if the statement of use is found by the USPTO to be fatally defective, the applicant will need additional time to file a new statement of use. However, such a statement will be accepted only once as a statement of the applicant's ongoing efforts to make use of the mark in commerce. Repetition of these same allegations in a subsequent extension request is not, without more, deemed to be a statement of the applicant's *ongoing* efforts, as required by 37 C.F.R. §2.89(d). *In re SPARC Int'l Inc.*, 33 USPQ2d 1479 (Comm'r Pats. 1993), *overruled on other grounds*, *In re El Taurino Restaurant, Inc.*, 41 USPQ2d 1220 (Comm'r Pats. 1996). If these allegations are repeated, the extension request will be denied.

If an extension request does not include a showing of good cause, or if the showing of good cause in an extension request is deemed insufficient, the ITU staff will issue an Office action denying the extension request but granting the applicant thirty days to overcome the denial by submitting a verified showing of good cause (or a substitute extension request that includes a showing of good cause). This showing may be submitted even if the statutory period for filing the statement of use has expired. *El Taurino*, 41 USPQ2d at 1222.

### **1108.03            Only One Extension Request May Be Filed With or After a Statement of Use**

An applicant may file a request for an extension of time to file a statement of use with a statement of use, or after filing the statement of use if there is time remaining in the existing six-month period in which the statement of use was filed, provided that granting the extension request would not extend the time

for filing the statement of use more than thirty-six months beyond the issuance of the notice of allowance. *The applicant may not request any further extensions of time after this request.* 37 C.F.R. §2.89(e)(1).

The purpose of such a request (sometimes called an “insurance” extension request) is to secure additional time to correct any deficiency in the statement of use that must be corrected before the expiration of the deadline for filing the statement of use. See TMEP §1109.16(a) regarding the deficiencies that must be cured before expiration of the statutory filing period. Consider the following examples:

*Example:* If the notice of allowance was issued February 6, 2009, and the applicant files a statement of use on August 6, 2009 (but does not file an “insurance” extension request), the applicant has only until August 6, 2009 to cure any deficiency that must be corrected before the expiration of the statutory period for filing the statement of use. After August 6, 2009, it is too late to file an “insurance” extension request, because no time remains in the existing six-month period in which the statement of use was filed.

*Example:* If the notice of allowance was issued February 6, 2009, the applicant could file a statement of use, together with an “insurance” extension request, on or before August 6, 2009. If the extension request were granted, this would give the applicant until February 6, 2010 to cure any deficiency that must be corrected before the expiration of the statutory filing period. No further extension request(s) could be filed.

*Example:* If the notice of allowance was issued February 6, 2009, and the applicant filed a statement of use on February 7, 2009, the applicant could file an “insurance” extension request within the time remaining in the existing six-month period in which the statement of use was filed, i.e., on or before August 6, 2009. If the request were granted, this would give the applicant until February 6, 2010 to cure any deficiency that must be corrected before the expiration of the statutory filing period. No further extension request(s) could be filed.

An “insurance” extension request filed with or filed after a statement of use must meet all relevant requirements, including payment of the applicable fee. If the request is not the first request for an extension of time, and thus a showing of good cause is required, the applicant may satisfy the requirement for a showing of good cause by asserting that the applicant believes that it has made valid use of the mark in commerce, as evidenced by the statement of use, but that if the statement of use is found to be fatally defective, the applicant will need additional time to correct defects or file a substitute statement of use. 37 C.F.R. §2.89(e)(2); TMEP §1108.02(f).

The filing fee for the “insurance” extension request will not be refunded, even if the extension is not needed to perfect the statement of use.

If the applicant files an “insurance” extension request in conjunction with a statement of use, and the applicant submits fees sufficient for one but not both filings, the USPTO will apply the fees as follows: (1) if there is enough money to cover the extension request, the USPTO will apply the fees to the extension request to avoid abandonment of the application; or (2) if there is enough money to cover the statement of use, but not enough to cover the extension request, the USPTO will apply the fees to the statement of use. See TMEP §1110.07 regarding the application of fees when an applicant submits a request to divide along with an extension request and statement of use.

If an applicant files an “insurance” extension request with a statement of use and the extension request is defective, the ITU staff will deny the request and advise the applicant of the reason for denial. If the statement of use meets the minimum requirements for examination on the merits, the ITU staff will then forward the application to the examining attorney. If there is time remaining in the current period for filing a statement of use, the applicant may file a substitute extension request.

See TMEP §1108.03(a) regarding the processing of an extension request after a statement of use has been referred to an examining attorney.

### **1108.03(a) Processing Extension Request Filed After Statement of Use Has Been Referred to Examining Attorney**

Under 37 C.F.R. §2.89(e)(1), an applicant may file a request for an extension of time to file a statement of use after filing a statement of use if: (1) there is time remaining in the existing six-month period in which the statement of use was filed; and (2) granting the extension request would not extend the time for filing the statement of use more than thirty-six months beyond the issuance of the notice of allowance. See TMEP §1108.03.

When an extension request is filed after the statement of use has been referred to the examining attorney, the request will be referred to the examining attorney. The USPTO will not examine the extension request unless the applicant needs the extension to perfect the statement of use.

If the examining attorney issues a requirement or refusal based on the statement of use, the examining attorney should note in the Office action that the extension request is being referred to the ITU/Divisional Unit for processing of the extension request. The filing of such an extension request is not in itself a proper response to an outstanding Office action, and does *not* extend the time for responding to an outstanding Office action. See TMEP §§1109.16(c) and (d). If the examining attorney does not issue a requirement

or refusal based on the statement of use, the USPTO will not take formal action on the extension request.

The USPTO will not refund the filing fee for the extension request, even if the extension is not needed to perfect the statement of use.

#### **1108.04 Recourse After Denial of Extension Request**

If an extension request is denied, the applicant will be notified of the reason(s) for denial.

To avoid abandonment of the application, the applicant must meet the minimum requirements for filing the extension request on or before the deadline for filing a statement of use.

If the USPTO denies the extension request because the applicant failed to meet minimum filing requirements on or before the statutory deadline, and there is time remaining in the applicant's existing period for filing the statement of use, the applicant may file the statement of use and/or a substitute extension request. Otherwise, the applicant's only recourse after denial of the extension request is a petition under 37 C.F.R. §§2.89(g) and 2.146, or a petition to revive under 37 C.F.R. §2.66, if appropriate. See TMEP §1108.05 regarding petitions that may be filed after the denial of an extension request.

The minimum filing requirements that must be satisfied before expiration of the statutory deadline are: (1) a verified statement, signed by a person properly authorized to sign on behalf of the applicant, that the applicant has a continued bona fide intention to use the mark in commerce; (2) an identification of the goods/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/services. *In re El Taurino Restaurant, Inc.*, 41 USPQ2d 1220, 1222 (Comm'r Pats. 1996).

#### **1108.05 Petitions From Denial of Request For An Extension of Time to File a Statement of Use**

If an extension request is denied, and there is no time remaining in the statutory filing period, the application is abandoned. Applicant's recourse is as follows:

- *Petition to Revive Under 37 C.F.R. §2.66.* If the applicant unintentionally failed to comply with the minimum filing requirements (see TMEP §1108.04 for a list of these requirements), the applicant may file a petition to revive under 37 C.F.R. §2.66, within two months of the issuance date of the denial of the extension request, and must

include the fee required by 37 C.F.R. §2.6. See TMEP §§1714 *et seq.* regarding petitions to revive.

- *Request for Reinstatement.* If the applicant has proof that shows on its face that the extension request met the minimum requirements when filed, the applicant may request reinstatement within two months of the issuance date of the denial of the extension request. For example, if the extension request is denied due to the omission of a fee, and the applicant has proof that shows on its face that the fee was included, the applicant may request reinstatement. No fee is required. The request should be directed to the ITU/Divisional Unit. See TMEP §1712.01 regarding the types of evidence that support reinstatement.
- *Petition Under 37 C.F.R. §2.146.* The applicant may file a petition under 37 C.F.R. §2.146 if the applicant believes that the ITU staff's denial of an extension request was improper (e.g., if applicant contends that the extension request actually met the requirements of 15 U.S.C. §1051(d)(2) and 37 C.F.R. §2.89, but was improperly denied). 37 C.F.R. §§2.89(g) and 2.146(a)(2). For example, the applicant might file a petition claiming that the denial was improper if the ITU staff denied an extension request because the applicant's showing of good cause was insufficient, but applicant believes that the showing was sufficient. The applicant must file the petition within two months of the issuance date of the denial of the extension request, and must include the fee required by 37 C.F.R. §2.6. See TMEP Chapter 1700 regarding petitions.

Filing a petition or request for reinstatement does not stay the time for filing a statement of use or further extension request. 37 C.F.R. §2.89(g). However, if the applicant fails to file a statement of use or further request(s) for extension(s) of time to file a statement of use during the pendency of a petition, the applicant will be given an opportunity to perfect the petition by paying the fee(s) for each missed extension request and filing 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).

If a petition is granted, the term of the requested six-month extension will run from the date of the expiration of the previously existing six-month period for filing a statement of use. 37 C.F.R. §2.89(g).

No petition or request for reinstatement will be granted if it would extend the deadline for filing a statement of use beyond thirty-six months after the issuance of the notice of allowance. 15 U.S.C. §1051(d)(2).

## **1109 Statement of Use Under §1(d) of the Trademark Act**

As noted in TMEP §1103, an intent-to-use applicant must file an allegation of use in order to obtain a registration. This section discusses statements of use only. See TMEP §§1104 *et seq.* regarding amendments to allege use.

Under 15 U.S.C. §1051(d), a statement of use must be filed within six months of the issuance date of the notice of allowance, or within a previously granted extension of time to file a statement of use.

### **1109.01 Minimum Filing Requirements for a Statement of Use**

The statement of use must meet the following minimum filing requirements before it may be referred to an examining attorney for examination on the merits:

- (1) the prescribed fee for at least one class;
- (2) one specimen or facsimile of the mark as used in commerce; and
- (3) a verification or declaration signed by the applicant or a person properly authorized to sign on behalf of the applicant that the mark is in use in commerce.

37 C.F.R. §2.88(e).

A statement of use that omits the allegation of use in commerce, but asserts a verified date of first use in commerce, may be accepted as substantially in compliance with the minimum filing requirement of 37 C.F.R. §2.88(e)(3) for a verified statement that the mark is in use in commerce. *In re Carnicon Development Co.*, 34 USPQ2d 1541 (Comm’r Pats. 1992); *In re Conservation Technology Inc.*, 25 USPQ2d 1079 (Comm’r Pats. 1992). The examining attorney will require an allegation that the “mark is in use in commerce” during examination. See TMEP §1109.09.

See TMEP §1109.02 regarding review of the statement of use for compliance with minimum filing requirements, and TMEP §1109.06 regarding the requirements for a complete statement of use.

### **1109.02 Review for Compliance with Minimum Filing Requirements**

Statements of use are reviewed by the ITU/Divisional Unit to determine whether they are timely and in compliance with the minimum requirements listed in 37 C.F.R. §2.88(e). If the statement of use is untimely, either because it is premature or late, the ITU staff will notify the applicant in writing that the statement of use cannot be considered because it is untimely, and refund the filing fee.

If the statement of use is timely, but does not comply with one or more of the minimum filing requirements of 37 C.F.R. §2.88(e), the ITU staff will notify the applicant in writing of the defect and advise the applicant that the USPTO will not examine the statement of use on the merits unless the applicant corrects the defect before expiration of the deadline for filing a statement of use.

If the statement of use is filed by someone other than the owner of record, the ITU staff will issue an Office action granting the applicant thirty days in which to submit evidence to establish chain of title. See TMEP §1109.10 for further information.

If the applicant does not correct the deficiency before the expiration of the statutory deadline, the application will be abandoned. In such a case, the USPTO will *not* refund the filing fee.

The applicant may not withdraw the statement of use and return the application to the previous status of awaiting filing of the statement of use, even if the statement of use fails to meet the minimum filing requirements. 37 C.F.R. §2.88(g); TMEP §1109.17. However, in limited circumstances, an applicant may file an “insurance” extension request after the filing of a statement of use, in order to gain more time to comply with the minimum requirements for filing the statement of use. 37 C.F.R. §2.89(e)(1). See TMEP §§1108.03 and 1109.16(c) for further information.

#### **1109.02(a) Petition to Review Refusal Based on Noncompliance with Minimum Filing Requirements**

If the ITU staff determines that a statement of use does not meet the minimum filing requirements of 37 C.F.R. §2.88(e), and there is no time remaining in the statutory filing period, the applicant’s recourse is as follows:

- *Petition to Revive Under 37 C.F.R. §2.66.* If the applicant unintentionally failed to comply with the minimum filing requirements, the applicant may file a petition to revive under 37 C.F.R. §2.66 within two months of the issuance date of the Office action notifying the applicant that the statement of use is deficient. See TMEP §§1714 *et seq.* regarding petitions to revive.
- *Request for Reinstatement.* If the applicant has *proof that shows on its face* that the statement of use met the minimum requirements when filed, the applicant may request reinstatement, within two months of the issuance date of the Office action notifying the applicant that the statement of use is deficient. For example, if the statement of use is rejected due to the omission of a specimen or fee, and the applicant has proof that shows on its face that the missing element was included, the applicant may request reinstatement. No fee is required. The request should be directed to

the ITU/Divisional Unit. See TMEP §1712.01 regarding the types of evidence that support reinstatement.

- *Petition Under 37 C.F.R. §2.146.* If the applicant contends that the statement of use met the minimum requirements of 37 C.F.R. §2.88(e) when filed but was improperly denied by the ITU staff, and the applicant does *not* have proof that shows *on its face* that the statement of use was complete when filed (see TMEP §1712.01), the applicant may file a petition under 37 C.F.R. §2.146(a)(3), asking the Director to review the action of the ITU staff. The petition must be filed within two months of the issuance date of the Office action notifying the applicant that the statement of use is deficient, and must include the petition fee required by 37 C.F.R. §2.6, proof in the form of an affidavit or declaration under 37 C.F.R. §2.20, and any available evidence showing that the statement of use was complete when filed. See TMEP §1705.03 regarding proof of facts on petition.

No petition or request for reinstatement will be granted if it would extend the deadline for filing a statement of use beyond thirty-six months after the issuance of the notice of allowance. 15 U.S.C. §1051(d)(2).

### **1109.03 Use on All Goods/Services Required Before Filing**

The applicant may not file a statement of use until the applicant has made use of the mark in commerce on or in connection with *all* goods/services specified in the notice of allowance, unless the applicant files a request to divide. 37 C.F.R. §2.88(c). See TMEP §§1110 *et seq.* regarding requests to divide.

If the applicant files a statement of use for some of the goods/services identified in the notice of allowance, and a request for an extension of time to file a statement of use for other goods/services that are identified in the notice of allowance, but does not file a request to divide, the ITU/Divisional Unit will issue an Office action granting the applicant additional time to either: (1) file a request to divide, or (2) delete the goods/services that are not in use from the application. If the applicant met the minimum requirements for filing the statement of use and extension request before expiration of the deadline for filing the statement of use, the applicant may file the request to divide after expiration of the statutory deadline for filing the statement of use. If the applicant does not file an acceptable request to divide within the time specified in the Office action, the goods/services that are not covered by the statement of use will be deleted from the application.

See TMEP §1109.13 regarding examination of a statement of use that omits, but does not expressly delete, some of the goods/services identified in the notice of allowance.

#### **1109.04 Time for Filing Statement of Use**

The statement of use must be filed within six months after the issuance date of the notice of allowance or within a previously granted extension of time for filing a statement of use. See TMEP §§1108 *et seq.* regarding extension requests.

If the applicant does not timely file a statement of use within this time period, the application is abandoned. 15 U.S.C. §1051(d)(4); 37 C.F.R. §2.88(h). If the failure to timely file a statement of use is unintentional, the applicant may file a petition to revive under 37 C.F.R. §2.66. See TMEP §§1714 *et seq.*

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

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

Any statement of use filed after the examining attorney approves the mark for publication but before the issuance of the notice of allowance is untimely and will not be considered. The USPTO will refund the filing fee. 37 C.F.R. §§2.76(a) and 2.88(a); TMEP §1104.03(c).

#### **1109.05 Form of Statement of Use**

To expedite processing, it is recommended that the statement of use be filed through TEAS, available at <http://www.uspto.gov>. A statement of use filed through TEAS is considered to have been filed on the date the USPTO receives the transmission, regardless of whether that date is a Saturday, Sunday, or federal holiday within the District of Columbia. 37 C.F.R. §2.195(a)(2). When a statement of use is filed electronically, TEAS almost immediately displays a “Success” page that confirms receipt. This page is evidence of filing should any question arise as to the filing date of the document, and it may be printed or copied-and-pasted into an electronic record for storage. TEAS also separately sends an e-mail acknowledgement of receipt, which includes a summary of the filed information.

Alternatively, the applicant may call the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199 to obtain a pre-printed paper form. The completed form may be mailed, faxed, or hand-delivered to the USPTO. If the form is faxed, it must be accompanied by an authorization to charge the filing fee to a credit card or deposit account. The credit card authorization form is available at <http://www.uspto.gov/web/forms/2038.pdf>. If a statement

of use is filed through TEAS, payment must be made by credit card, deposit account, or EFT. Paper forms may be delivered by hand or courier to the Trademark Assistance Center (“TAC”), at James Madison Building, East Wing, Concourse Level, 600 Dulany Street, Alexandria, Virginia. TAC is open 8:30 a.m. to 5:00 p.m., Eastern Time, Monday through Friday, except on Federal holidays within the District of Columbia.

If the applicant does not file electronically or use the USPTO’s pre-printed form, the statement of use should be captioned as an “Allegation of Use.” 37 C.F.R. §2.88(d). However, this format is not mandatory. The USPTO will accept and enter a document that meets the minimum filing requirements set forth in 37 C.F.R. §2.88(e), regardless of whether it is properly titled.

### **1109.06 Requirements For a Complete Statement of Use**

The requirements for a *complete* statement of use must include the following elements:

- (1) a verified statement that the applicant is believed to be the owner of the mark and that the mark is in use in commerce, specifying the dates of the applicant’s first use of the mark and first use of the mark in commerce, and setting forth or incorporating by reference those goods/services specified in the notice of allowance on or in connection with which the mark is in use in commerce;
- (2) one specimen or facsimile per class of the mark as used in commerce; and
- (3) the fee per class required by 37 C.F.R. §2.6.

37 C.F.R. §2.88(b).

### **1109.07 Examination of the Statement of Use — In General**

If the statement of use is timely and complies with the minimum filing requirements of 37 C.F.R. §2.88(e), the ITU staff will refer it to the examining attorney for examination on the merits. If available, the same examining attorney who initially examined the application will examine the statement of use. Examination of the statement of use is sometimes referred to as “second examination.”

The examining attorney will review the statement of use to confirm that it meets the requirements of the Act and the rules. See TMEP §1109.06 for the requirements for a complete statement of use.

The examining attorney will examine the specimen to confirm that it shows appropriate use as a mark on or in connection with the goods/services identified in the statement of use (see TMEP §§1202 *et seq.* regarding use of

subject matter as a trademark, and 1301.02 *et seq.* regarding use of matter as a service mark), and will also determine whether the mark shown on the drawing is a substantially exact representation of the mark as used on the specimen (see TMEP §§807.12(a) *et seq.* and 1109.12).

If the applicant has complied with the statutory requirements for a statement of use before the expiration of the deadline for filing the statement of use, the applicant may amend or correct the statement of use during examination. See TMEP §§1109.16(a)-(d) regarding compliance with statutory requirements before the expiration of the time for filing the statement of use.

If the examining attorney finds the statement of use acceptable, the USPTO will notify the applicant that the statement of use is approved. See TMEP §1109.18 regarding approval of the statement of use. The USPTO will then issue the registration and publish notice of the registration in the *Official Gazette*. The application is not again subject to opposition.

See TMEP §§1109.16 *et seq.* regarding the issuance of Office actions and correction of defects in a statement of use.

#### **1109.08 Examination of the Statement of Use – New Requirements and Refusals**

Generally, in examining the statement of use, the USPTO will only issue requirements or refusals concerning matters related to the statement of use. The examining attorney should not make a requirement or refusal concerning matters that could or should have been raised during initial examination, unless the failure to do so in initial examination constitutes a clear error, i.e., would result in issuance of a registration in violation of the Act or applicable rules. See TMEP §706.01 regarding “clear error.” For example, if the goods/services were published for opposition in the wrong class, it would be clear error for the examining attorney not to require correction of the classification when examining the statement of use.

If the examining attorney determines that he or she must make a refusal or requirement that could or should have been made during initial examination of the application, the examining attorney must consult the managing attorney or senior attorney before taking the action. This applies to any refusal that arguably could or should have been made during initial examination, such as most refusals under §2(d) or §2(e)(1) of the Act.

The examining attorney must act on all new issues arising in the examination of the statement of use. For example:

- The examining attorney must issue a refusal if the specimen fails to show use of the designation as a mark. See TMEP §§1202 *et seq.* and 1301.02 *et seq.* regarding use as a mark.

- The examining attorney must issue an appropriate refusal or requirement if there is evidence that the mark has become descriptive or generic as applied to the goods/services during the time that has elapsed since initial examination.

Generally, the USPTO will not conduct any search for conflicting marks or issue any refusals under §2(d) of the Act in the examination of the statement of use. However, if the examining attorney determines that a second search is necessary, the examining attorney will conduct a second search and take any action that is appropriate.

### **1109.09 Use in Commerce**

The filing of a verified statement that “the mark is in use in commerce” is a minimum requirement that must be satisfied before the expiration of the statutory period for filing the statement of use. 15 U.S.C. §1051(d)(1); 37 C.F.R. §2.88(e)(3). If the examining attorney determines, before taking an action in connection with the statement of use, that the verified statement of use in commerce has been omitted, the examining attorney should refer the application to the ITU/Divisional Unit for appropriate action.

An application that omits the allegation of use in commerce, but asserts a verified date of first use in commerce, is considered to be substantially in compliance with the minimum filing requirements under 37 C.F.R. §2.88(e)(3). *In re Carnicon Development Co.*, 34 USPQ2d 1541 (Comm’r Pats. 1992); *In re Conservation Technology Inc.*, 25 USPQ2d 1079 (Comm’r Pats. 1992). Thus, if the applicant files a statement containing a verified date of first use *in commerce* on or before the expiration of the period for filing the statement of use, the applicant has met the minimum filing requirements. The examining attorney must require a verified statement that the “mark is in use in commerce” before approving the statement of use. This statement may be filed after expiration of the deadline for filing the statement of use, within the period for response to the examining attorney’s Office action.

An applicant is not required to specify the method of use or the type of commerce in which a mark is used. TMEP §§901.03 and 905.

### **1109.09(a) Dates of Use**

The statement of use must include the dates of the applicant’s first use of the mark and first use of the mark in commerce on or in connection with the goods/services specified in the notice of allowance. 15 U.S.C. §1051(d)(1). Where the applicant claims a §1(a) filing basis for some of the goods/services and a §1(b) filing basis for other goods/services, the statement of use must include dates of use for the §1(b) goods/services that are covered by the notice of allowance. 37 C.F.R. §2.88(b)(1)(ii). See TMEP §903.08 regarding applications in which more than one date is specified for a particular class.

Setting forth the dates of use is not a minimum filing requirement that must be met before the application will be referred to the examining attorney. If the dates of use are omitted from the statement of use, but the statement that “the mark is in use in commerce” is included, the dates may be supplied after the expiration of the statutory period for filing the statement of use. The applicant may also amend or correct the dates of use after the expiration of the deadline for filing the statement of use, if the applicant meets the requirements of 37 C.F.R. §2.71(c)(2). Any amendment to the dates of use must be verified. 37 C.F.R. §2.71(c).

The date of first use in commerce may not be earlier than the date of first use anywhere. TMEP §903.03.

The applicant must state dates of use for each class. The dates of first use for each class must apply to at least one item in the class but do not have to apply to more than one item. However, the applicant must have used the mark in commerce on all items listed in the notice of allowance before filing the statement of use, unless the applicant files a request to divide. TMEP §1109.03. See TMEP §1110.07 regarding the division of an application in which a statement of use is due.

While the dates of use may be supplied after expiration of the statutory filing period, the applicant must make valid use of the mark in commerce on or in connection with all the goods/services in the application before the expiration of the statutory filing period. 37 C.F.R. §2.71(c)(2). If the applicant attempts to amend the dates of use to state a date of first use in commerce that is later than the time permitted for filing the statement of use, the examining attorney must refuse registration because the applicant failed to make use within the time permitted, and also inform the applicant that the application is deemed abandoned. When refusing registration on this ground, the examining attorney should issue a regular Office action with a six-month response clause. See TMEP §1109.16(b).

#### **1109.09(b) Specimens**

The examining attorney must examine the specimens to confirm that they show use of the subject matter as a mark on or in connection with the goods/services identified in the statement of use. See TMEP §§1202 *et seq.* regarding use of subject matter as a trademark, and 1301.02 *et seq.* regarding use of matter as a service mark. The examining attorney must also determine whether the mark as used on the specimens is a substantially exact representation of the mark on the drawing (see TMEP §§807.12(a) *et seq.* and 1109.12). The examining attorney should issue requirements and refusals, as appropriate, based on the examination of the specimens, subject to the same standards that govern the examination of specimens in a §1(a) application. TMEP §§904 *et seq.*

The submission of at least one specimen with a statement of use is a statutory requirement that must be satisfied before expiration of the statutory period for filing the statement of use. 15 U.S.C. §1051(d)(1); 37 C.F.R. §2.88(e); *In re Campbell*, 33 USPQ2d 1055 (Comm'r Pats. 1993). If the examining attorney determines, before taking an action regarding the statement of use, that no specimen was submitted with the statement of use, the examining attorney should refer the application to the ITU/Divisional Unit for appropriate action.

In a multiple-class application, the applicant must submit one specimen for each class of goods/services in the statement of use before the statement of use may be approved. 37 C.F.R. §§2.86(b) and 2.88(b)(2). However, only one specimen for one class is needed to comply with the minimum filing requirements. If at least one specimen is filed within the time permitted for filing the statement of use, the applicant may submit specimen(s) for the other class(es) after the expiration of the statutory filing period, if the applicant verifies that the additional specimen(s) was in use in commerce before the expiration of the deadline for filing the statement of use. 37 C.F.R. §2.59(b).

If the applicant files at least one specimen with the statement of use, but the specimen is unacceptable, the applicant may provide a substitute specimen after the expiration of the time permitted for filing the statement of use, provided that the applicant verifies that the substitute specimen was in use in commerce before the expiration of the deadline for filing the statement of use. 37 C.F.R. §2.59(b). If the applicant does not provide an acceptable specimen that was in use in commerce before the expiration of the deadline, the examining attorney must refuse registration because the applicant failed to make use of the mark within the time permitted, and inform the applicant that the application is deemed abandoned. The examining attorney should issue a regular Office action with a six-month response clause. TMEP §1109.16(b). See TMEP §1108.03 regarding the filing of an "insurance" request for an extension of time to file a statement of use in order to gain additional time to make proper use of the mark.

If the dates of first use change as a result of the submission of a new specimen, the applicant must amend the dates of use in the statement of use. The amendment must be supported by an affidavit or declaration. 37 C.F.R. §2.71(c); TMEP §1109.09(a).

If the statement of use is filed electronically using TEAS, the applicant must submit a digitized image in .jpg or .pdf format. 37 C.F.R. §2.56(d)(4). See TMEP §904.02(a) for additional information about electronically filed specimens.

## 1109.10 Ownership

### *Review by the ITU/Divisional Unit*

Section 1(d)(1) of the Trademark Act, 15 U.S.C. §1051(d)(1), requires that “the applicant shall file ... a verified statement that the mark is in use in commerce ...” within six months of the notice of allowance, or within a previously granted extension of time to file a statement of use. The party filing the statement of use must be the owner of the mark at the time of filing. This is a statutory requirement that must be satisfied before the expiration of the deadline for filing the statement of use. *In re Colombo, Inc.*, 33 USPQ2d 1530 (Comm’r Pats. 1994).

If the party who files a statement of use was the owner of the mark at the time of filing, evidence to establish ownership may be provided after expiration of the deadline for filing the statement of use. However, if the party who files a statement of use was not the owner of the mark at the time of filing, and no time remains in the statutory period for filing the statement of use, the application is abandoned.

The question of whether the statement of use was filed by the owner will be determined by the ITU/Divisional Unit. If a statement of use is filed by someone other than the owner of record, the ITU staff will issue an Office action granting the applicant thirty days in which to submit evidence to establish chain of title. If the party who filed the statement of use was the owner at the time of filing, evidence to establish ownership may be provided after expiration of the deadline for filing the statement of use. See 37 C.F.R. §§3.71(d) and 3.73. To establish ownership, the new owner must either: (1) record an assignment or other document of title with the Assignment Services Branch, and include a statement in the response to the Office action that the document has been recorded; or (2) submit other evidence of ownership, in the form of a document transferring ownership from one party to another, or an explanation, supported by an affidavit or declaration under 37 C.F.R. §2.20, that a valid transfer of legal title occurred prior to filing the statement of use. 37 C.F.R. §3.73(b)(1); TMEP §502.01.

If the applicant does not establish that the party who filed the statement of use was the owner of the application at the time of filing, the ITU/Divisional Unit will abandon the application. The true owner may then file a petition to revive under 37 C.F.R. §2.66, accompanied by either a substitute statement of use or request for extension of time to file a statement of use, provided that granting the petition would not extend the period for filing the statement of use beyond thirty-six months after the issuance date of the notice of allowance. See TMEP §1714.01(b) regarding the requirements for petitions to revive.

If a statement of use is filed by the owner of the mark, but there is a minor error in the manner in which the name of the owner is set out, the mistake

may be corrected by amendment. See TMEP §1201.02(c) for examples of correctable and non-correctable errors.

#### *Review by Examining Attorney*

If an examining attorney determines, *before* taking an action in connection with the statement of use, that the statement of use was filed by someone other than the owner of record, the examining attorney should return the statement of use to the ITU/Divisional Unit for appropriate action.

If the examining attorney determines, *after* taking an action regarding the statement of use, that the statement of use was filed by someone other than the owner of record, the examining attorney must require the applicant to submit evidence to establish chain of title, as discussed above. If the party who filed the statement of use was not the owner of the mark at the time of filing, and no time remains in the statutory period for filing the statement of use, the examining attorney must refuse registration because no acceptable statement of use was filed within the time permitted, and inform the applicant that the application is deemed abandoned. When refusing registration on this ground, the examining attorney should issue a regular Office action with a six-month response clause. See TMEP §1109.16(b).

### **1109.11 Verification and Execution**

The requirement that a statement of use include a signed verification or declaration is a statutory requirement that must be satisfied before expiration of the deadline for filing the statement of use. 15 U.S.C. §1051(d)(1); 37 C.F.R. §2.88(e)(3); *In re Kinsman*, 33 USPQ2d 1057 (Comm'r Pats. 1993).

If, before taking an action in connection with the statement of use, the examining attorney determines that the statement of use does not include a signed verification or declaration, the examining attorney should return the application to the ITU/Divisional Unit for appropriate action.

#### **1109.11(a) Authority of Signatory**

A statement of use must include a statement that is signed and verified by a person properly authorized to sign on behalf of the applicant under 37 C.F.R. §2.193(e)(1). 37 C.F.R. §2.88(b)(1). Anyone who can verify the initial application may verify the statement of use. Generally, if the statement of use is filed by the owner of the mark, the USPTO will not question the authority of the person who signs a verification unless there is an inconsistency in the record as to the signatory's authority to sign. See TMEP §611.03(a).

### **1109.11(b) Verification of Essential Elements**

The examining attorney must review the verified statement of use to confirm that it conforms to the requirements of the Act and the rules. The verified statement must include an allegation that the applicant believes it is the owner of the mark, and a verification of the dates of use and identification of the goods/services. 15 U.S.C. §1051(d)(1); 37 C.F.R. §2.88(b)(1). See TMEP §1109.10 regarding ownership, TMEP §1109.09(a) regarding dates of use, and TMEP §1109.13 regarding the identification of goods/services.

The averment of ownership is an essential element of the verification. If it is omitted, the examining attorney must require the applicant to submit a verified statement that the applicant is the owner of the mark. This statement may be submitted after expiration of the time for filing the statement of use.

### **1109.11(c) Date of Execution**

If the statement of use was executed before the stated dates of use, the examining attorney must require that the statement be re-executed. See TMEP §903.06(a) regarding apparent discrepancies between dates of use and execution dates, and TMEP §§903.04 and 1109.09(a) regarding amendment of the dates of use.

If the statement of use is filed more than one year after the date of execution, the examining attorney will require a substitute verification or declaration under 37 C.F.R. §2.20 stating that the mark is still in use in commerce. 37 C.F.R. §2.88(k); TMEP §804.03.

### **1109.11(d) Signature of Electronically Transmitted Statement of Use**

See TMEP §611.01(c) regarding signature of documents filed through TEAS.

### **1109.12 Drawing**

Under 37 C.F.R. §2.51(b), the drawing in an intent-to-use application must be a substantially exact representation of the mark as intended to be used *and* as actually used on filing the allegation of use. An applicant may not amend the mark in a drawing if the amendment is a material alteration of the mark on the drawing originally submitted with the application. 37 C.F.R. §2.72(b)(2); TMEP §§807.13(a) and 807.14 *et seq.* Also, the mark in the drawing must agree with the mark as used on the specimen(s). TMEP §§807.12(a) *et seq.* The same standards that apply to §1(a) applications for determining whether a specimen supports use of the mark and whether an amendment to the mark may be permitted also apply in the examination of the statement of use.

Therefore, if the mark in the drawing filed with the application is not a substantially exact representation of the mark as used on the specimen, the examining attorney must require: (1) *either* submission of a new specimen or an amendment of the mark in the drawing, if the amendment of the mark would not be a material alteration of the mark on the original drawing; or (2) submission of a new specimen, if the amendment of the mark would be a material alteration of the mark on the original drawing. 37 C.F.R. §2.72(b)(2).

### **1109.13 Identification of Goods/Services in Statement of Use**

The statement of use must either list or incorporate by reference the goods/services specified in the notice of allowance on or in connection with which the mark is in use in commerce. 15 U.S.C. §1051(d)(1); 37 C.F.R. §2.88(b)(1)(ii). The goods/services specified in the statement of use must conform to the goods/services identified in the notice of allowance. 37 C.F.R. §2.88(i)(1). To incorporate the goods/services by reference, the applicant may state that the mark is in use on “those goods/services identified in the notice of allowance” or “those goods/services identified in the notice of allowance except...[followed by an identification of the goods/services to be deleted].” If the applicant omits any goods/services that were listed in the notice of allowance, the ITU/Divisional Unit will delete these goods/services from the application. The applicant may not thereafter reinsert the deleted goods/services. 37 C.F.R. §2.88(i)(2). In this situation, the applicant cannot file a petition under 37 C.F.R. §2.66, claiming unintentional delay in filing a statement of use for the omitted goods/services.

If the applicant fails to identify or incorporate by reference any goods or services, or if the applicant lists all the goods/services in the section of a pre-printed form designated for the identification of goods that are not in use, the Office will permit applicant to correct the mistake. The ITU staff will issue a letter noting that no goods or services were specified or incorporated by reference in the statement of use, and granting the applicant thirty days in which to submit a verified statement clarifying the goods/services.

### **1109.14 Classification**

If the mark published in the wrong class of the goods/services, the examining attorney must ensure that the classification is corrected. This may be done in an examiner’s amendment without prior approval by the applicant (see TMEP §707.02). Republication is not required.

If class(es) are added to the application after the filing of the statement of use, the examining attorney must require payment of the fee(s) for filing the statement of use for the added class(es), in addition to the fee(s) required by 37 C.F.R. §2.6(a)(1) for adding a class(es) to the application. TMEP §1403.02(c).

## **1109.15 Filing Fees**

Payment of the filing fee for at least a single class is a statutory requirement that must be satisfied before the expiration of the statutory filing period. See 37 C.F.R. §§2.88(b)(3). *In re L.R. Sport Inc.*, 25 USPQ2d 1533 (Comm'r Pats. 1992).

In a multiple-class application, if the applicant files the fee for at least one class of goods/services but fails to file the fees for additional class(es), the ITU staff will issue an Office action granting the applicant thirty days in which to submit fees to cover *all* class(es), or specify the class(es) to be abandoned. The additional fees may be paid after the time for filing the statement of use has expired, within the six-month period for response to the examining attorney's Office action. If the applicant does not submit the fees or specify the classes to be abandoned within the set time period, the USPTO will apply the fees paid to the lowest-numbered class(es) in ascending order, and will delete the goods/services in the higher-numbered class(es) from the application. 37 C.F.R. §2.88(b)(3).

If an applicant files a statement of use and a request to divide the application at the same time, and the fees submitted are sufficient for one but not both, the fees will be applied first to the statement of use, and the applicant will be notified of the deficiency. See TMEP §§1110.02 and 1110.07 for further information about filing fees for requests to divide.

If the applicant files an "insurance" extension request in conjunction with a statement of use (see TMEP §1108.03), and the applicant submits fees sufficient for one but not both, the USPTO will apply the fees as follows: (1) if there is enough money to cover the extension request, the USPTO will apply the fees to the extension request to avoid abandonment of the application; or (2) if there is enough money to cover the statement of use, but not enough to cover the extension request, the USPTO will apply the fees to the statement of use.

See TMEP §1109.15(a) regarding returned checks, EFT and credit card payments that are refused by financial institutions, and fees charged to deposit accounts with insufficient funds.

### **1109.15(a) Processing Deficient Fees**

If the filing fee for at least a single class is deficient (e.g., if the fee is charged to a deposit account with insufficient funds, an EFT or credit card payment is refused or charged back by a financial institution, or a check is returned unpaid), the fee for at least one class of goods/services must be repaid before the expiration of the statutory filing period, or the application is abandoned.

If a check is returned unpaid or an EFT or credit card payment is refused, and the statement of use was accompanied by an authorization to charge

deficient fee(s) to a deposit account (37 C.F.R. §2.208) that has sufficient funds to cover the fee, the USPTO will charge the filing fee for the statement of use and the fee for processing the returned check or refused payment (37 C.F.R. §2.6(b)(12)) to the deposit account.

If the examining attorney determines, *before* taking an action regarding the statement of use, that the filing fee for at least a single class of goods or services has not been paid, the examining attorney should e-mail the ITU/Divisional Unit and request that the SOU Processing Complete status be withdrawn and that the ITU staff notify the applicant in writing of the defect. See TMEP §1109.15.

If the examining attorney determines, *after* taking an action regarding the statement of use, that the filing fee for at least a single class of goods or services has not been paid, the examining attorney must refuse registration on the ground that the filing fee for the statement of use was not paid. If there is time remaining in the statutory period for filing the statement of use, the examining attorney should require the applicant to resubmit the filing fee on or before the statutory deadline. If a check was returned unpaid, or an EFT or credit card was refused, the examining attorney should also require submission of the processing fee required by 37 C.F.R. §2.6(b)(12). The processing fee may be paid after expiration of the statutory deadline for filing the statement of use.

If the fee for at least a single class has not been paid, and there is no time remaining in the statutory period for filing the statement of use, the examining attorney will issue an Office action refusing registration and stating that the application is abandoned because a proper statement of use was not filed within the time required by statute. 37 C.F.R. §§2.88(e)(1) and 2.88(h). In such a case, the examining attorney should issue a regular Office action, with a six-month response clause. If the applicant does not establish within the six-month response period that the fee for at least a single class of goods/services was paid prior to the expiration of the statutory filing period, the application will be abandoned.

If the fee for at least a single class is paid before expiration of the statutory deadline, but the fee(s) for additional class(es) are deficient, the USPTO will issue an Office action granting the applicant thirty days in which to submit fees to cover *all* class(es), or specify the class(es) to be abandoned. The additional fees may be paid after the time for filing the statement of use has expired, within the six-month period for response to the examining attorney's Office action. If the applicant does not submit the fees or specify the classes to be abandoned within the set time period, the USPTO will apply the fees paid to the lowest-numbered class(es) in ascending order, and will delete the goods/services in the higher-numbered class(es) from the application. 37 C.F.R. §2.88(b)(3). If a check was returned unpaid, or an EFT or credit card payment was refused, the USPTO will also require submission of the processing fee required by 37 C.F.R. §2.6(b)(12).

If the statement of use has been approved and the mark is registered when the Office learns that the fee for the statement of use was deficient, the USPTO will cancel the registration as inadvertently issued, because the statutory requirements for registration have not been met. If the fee for at least a single class of goods/services was not paid before the expiration of the statutory filing period, the application will be abandoned. If the fee for at least a single class of goods/services was timely paid, but the fees for additional class(es) have not been paid, the USPTO will restore the application to pendency and refer it to the examining attorney for appropriate action.

See TMEP §405.06 regarding payments that are refused.

### **1109.16 Correcting Defects in Statement of Use**

The applicant must comply with the statutory requirements for filing a statement of use (37 C.F.R. §2.88(b)) before the expiration of the deadline for filing the statement of use (i.e., within six months of the issuance date of the notice of allowance or before the expiration of an extension of time for filing a statement of use). Other defects may be cured after the expiration of the statutory filing period, within the period for response to the Office action notifying the applicant of the defect. See TMEP §1109.16(a) regarding defects that must be cured before the expiration of the statutory filing period.

#### **1109.16(a) Statutory Requirements That Must Be Met Within Statutory Filing Period**

The applicant must comply with the statutory requirements for filing a statement of use (37 C.F.R. §2.88(b)) before expiration of the period for filing the statement of use (i.e., within six months of the issuance date of the notice of allowance or before the expiration of an extension of time for filing a statement of use). Thus, the following deficiencies must be cured before expiration of the statutory filing period:

- (1) *Specimens and Dates of Use in Commerce.* The applicant must make valid use of the mark in commerce and must provide one specimen that was in use before the expiration of the time permitted for filing the statement of use. 37 C.F.R. §2.59(b)(2). If the applicant does not provide an acceptable specimen that was in use in commerce before the expiration of the deadline for filing the statement of use, the examining attorney must refuse registration because the applicant failed to make use within the time permitted. See TMEP §1109.09(b).

The examining attorney must refuse registration on the same grounds if the applicant attempts to amend the dates of use to state a date of first use in commerce that is later than the time permitted for

filing the statement of use. 37 C.F.R. §2.71(c)(2); TMEP §1109.09(a).

- (2) *Filing by Owner.* The party filing the statement of use must be the owner of the mark at the time of filing. If the party who filed the statement of use was not the owner at the time of filing the statement of use, the applicant may not provide a substitute statement of use (or the equivalent) in the name of the true owner after the expiration of the deadline for filing the statement of use. *In re Colombo, Inc.*, 33 USPQ2d 1530 (Comm'r Pats. 1994). Therefore, if the party filing the statement of use was not the owner of the mark at the time of filing, and no time remains in the statutory period for filing the statement of use, the application will be abandoned for failure to file a statement of use. See TMEP §1109.10 for further information.
- (3) *Verification.* The statement of use must be verified by the applicant or a person properly authorized to sign on behalf of applicant under 37 C.F.R. §2.193(e)(1). If the statement of use is unsigned or signed by the wrong party, a substitute verification must be filed before the expiration of the statutory period for filing the statement of use. 37 C.F.R. §2.88(e)(3). Generally, however, the USPTO does not question the authority of the person who verifies a statement of use. See TMEP §1109.11(a).
- (4) *Filing Fee For At Least a Single Class.* Payment of the filing fee for at least a single class is a statutory requirement that must be satisfied before the expiration of the statutory period for filing the statement of use. See TMEP §§1109.15 and 1109.15(a).

When refusing registration on the above grounds, the examining attorney should issue a regular Office action with a six-month response clause. This gives the applicant six months to establish that it met the statutory requirements on or before the expiration of the time for filing the statement of use. See TMEP §1109.16(b).

**1109.16(b) Issuance of Examining Attorney's Office Action Holding that a Statement of Use Does Not Meet the Requirements**

When the examining attorney determines that the applicant did not meet the minimum statutory requirements within the period for filing the statement of use, the examining attorney must issue an Office action refusing registration on the ground that the applicant did not file a statement of use that meets the requirements of 15 U.S.C. §1051(d)(1). If there is time remaining in the statutory filing period, the Office action should state that the deficiency must be cured before the expiration of the deadline for filing the statement of use.

If there is no time remaining in the statutory filing period, the examining attorney should issue an Office action with a six-month response clause, stating that the application will be abandoned for failure to timely file a statement of use that meets the requirements of §1(d)(1) of the Act. Even though the statutory filing period has expired, the Office action should include a six-month response clause. This gives the applicant six months to establish that it met the minimum requirements on or before the expiration of the time for filing the statement of use.

If the applicant fails to respond to the Office action, the application will be abandoned for failure to respond. If the applicant responds to the Office action, but does not establish that the requirements for filing a statement of use had been satisfied *as of the expiration of the deadline for filing the statement of use*, the examining attorney will make the refusal of registration final. If the applicant does not respond, the application will be abandoned for failure to respond to the final refusal.

See TMEP §1109.16(e) regarding the applicant's recourse after an examining attorney's refusal of registration on the ground that the applicant did not comply with the statutory requirements for filing the statement of use within the statutory filing period.

#### **1109.16(c) Requesting an Extension of Time to File a Statement of Use for the Purpose of Compliance with Minimum Filing Requirements**

In limited circumstances, an applicant may file a request for an extension of time to file a statement of use after filing a statement of use, in order to gain more time to comply with the minimum requirements for filing the statement of use (sometimes called an "insurance" extension request). An applicant may file an extension request after filing a statement of use only if: (1) there is time remaining in the existing six-month period in which the statement of use was filed; (2) no extension request was filed together with the statement of use; *and* (3) granting the extension would not extend the time for filing the statement of use more than thirty-six months beyond the issuance of the notice of allowance. 37 C.F.R. §2.89(e)(1). See TMEP §1108.03 regarding the time periods and requirements for filing an "insurance" extension request, and TMEP §1108.03(a) regarding the procedures for processing such a request.

The filing of an "insurance" extension request is not in itself a proper response to an Office action, and does not extend the six-month period for response to the Office action. See TMEP §1109.16(d).

*Example:* Assume that a notice of allowance issues July 3, 2009, the applicant files a statement of use on July 22, 2009, and the examining attorney issues an Office action requiring substitute specimens on August 6, 2009. The applicant may file an

“insurance” extension request on or before January 3, 2010, which would give the applicant until July 3, 2010 to make proper use of the mark. However, the applicant must file a response to the Office action on or before February 6, 2010. See TMEP §1109.16(d) for information about responding to an Office action in this situation.

**1109.16(d) Response to Office Action Required Within Six Months of Issuance Date Regardless of Expiration Date of Period for Filing the Statement of Use**

In limited circumstances, when the applicant files an “insurance” extension request in conjunction with or after filing a statement of use (see TMEP) and the examining attorney has issued an Office action, the six-month period for response to the Office action will expire before the statutory deadline for filing the statement of use. To avoid abandonment, the applicant must respond within six months of the issuance date of the Office action, regardless of the expiration date of the time for filing the statement of use.

If the time for filing the statement of use expires after the time for responding to an Office action, and the applicant believes that it can cure a deficiency raised in the Office action before expiration of the time for filing the statement of use, the applicant should timely respond to the Office action, stating in the response that it intends to comply with the minimum requirements for filing the statement of use on or before the expiration of the statutory filing period.

If the applicant files such a response, the examining attorney should *not* suspend the application. Instead, the examining attorney should make final any outstanding refusal or requirement. The applicant will then have six months from the issuance date of the final Office action to cure statutory deficiencies. Of course, applicant still must comply with the minimum requirements for filing the statement of use before the expiration date of the deadline for filing the statement of use.

*Example:* If the deadline for filing the statement of use expires July 3, 2009, and the examining attorney issues an Office action requiring substitute specimens on March 4, 2009, the applicant has until September 4, 2009 to file the substitute specimens, but the applicant must verify that the specimens were in use in commerce on or before July 3, 2009.

If the applicant files a proper response to the final Office action within six months of the date of issuance, *and* complies with the minimum requirements for filing the statement of use before the expiration of the period for filing the statement of use, the examining attorney will withdraw the refusal based on non-compliance with the statutory requirements for filing the statement of use.

### **1109.16(e) Applicant's Recourse After Refusal of Registration**

If the applicant unintentionally fails to meet the minimum requirements for *filing* a statement of use within the time permitted, as set forth in 37 C.F.R. §2.88(e) (see TMEP §1109.01), the applicant may file a petition to revive under 37 C.F.R. §2.66. However, if the applicant met the minimum filing requirements of 37 C.F.R. §2.88(e), but the examining attorney refuses registration on the ground that the applicant failed to satisfy the statutory requirements for a *complete* statement of use on or before the statutory deadline (e.g., because the specimen is unacceptable or the dates of use are subsequent to the deadline for filing the statement of use), the applicant cannot overcome the refusal by filing a petition to revive under 37 C.F.R. §2.66. TMEP §1714.01(f)(ii). The applicant's only recourse is to appeal the examining attorney's refusal of registration to the Trademark Trial and Appeal Board.

See 37 C.F.R. §2.88(b) and TMEP §1109.16(a) regarding the statutory requirements that must be met within the statutory period for filing the statement of use (i.e., within six months of the issuance date of the notice of allowance or before the expiration of an extension of time for filing a statement of use).

### **1109.17 Withdrawal of the Statement of Use Prohibited**

Once an applicant has filed a statement of use, the applicant may not withdraw the statement of use, even if the USPTO determines that the statement of use does not comply with the minimum filing requirements. 37 C.F.R. §2.88(g). *In re Informix Software, Inc.*, 32 USPQ2d 1861 (Comm'r Pats. 1993). Thus, an applicant may not amend the basis from §1(a) to §1(b) after a statement of use has been filed.

See TMEP §1109.16(e) regarding the applicant's recourse after an examining attorney's refusal of registration on the ground that applicant did not meet the statutory requirements for filing a statement of use before the expiration of the statutory deadline.

### **1109.18 Approval of the Statement of Use**

Approval of the statement of use indicates that the mark is eligible for registration. If the examining attorney determines that the application is in condition for registration, the examining attorney will approve the mark for registration under §1(d) of the Trademark Act, 15 U.S.C. §1051(d). Before approving the mark for registration, the examining attorney must ensure that the information contained in the record is accurate, that all amendments filed by the applicant have been examined, that material that should be printed in the *Official Gazette* and on the registration certificate has been properly entered into TRAM, and that material that should not be printed has been

deleted from TRAM. See TMEP §817 regarding preparation of an application for publication or registration. If an assignment has been recorded, the examining attorney should ensure that the ownership information in TRAM is updated to reflect the true owner of record. See TMEP §502.02(c). The examining attorney must also perform the appropriate TRAM transaction to ensure that the computer-generated notice of approval of the statement of use is issued.

If the applicant filed an amendment to the Supplemental Register with or after filing a statement of use, and the application is otherwise in condition to be approved for registration, the examining attorney should approve the statement of use and approve the application for registration on the Supplemental Register. See TMEP §1102.03 regarding the examination of intent-to-use applications for registration on the Supplemental Register.

## **1110 Request to Divide an Application**

*37 C.F.R. §2.87. Dividing an application.*

*(a) Application may be divided. An application may be divided into two or more separate applications upon the payment of a fee for each new application created and submission by the applicant of a request in accordance with paragraph (d) of this section.*

*(b) Fee. In the case of a request to divide out one or more entire classes from an application, only the fee for dividing an application as set forth in §2.6(a)(19) will be required. However, in the case of a request to divide out some, but not all, of the goods or services in a class, the applicant must submit the application filing fee as set forth in §2.6(a)(1) for each new separate application to be created by the division, in addition to the fee for dividing an application.*

*(c) Time for filing. (1) A request to divide an application may be filed at any time between the application filing date and the date on which the trademark examining attorney approves the mark for publication; or during an opposition, concurrent use, or interference proceeding, upon motion granted by the Trademark Trial and Appeal Board.*

*(2) In an application under section 1(b) of the Act, a request to divide may also be filed with a statement of use under §2.88 or at any time between the filing of a statement of use and the date on which the trademark examining attorney approves the mark for registration.*

*(3) In a multiple-basis application, a request to divide out goods or services having a particular basis may also be filed during the period between the issuance of the notice of allowance under section 13(b)(2) of the Act and the filing of a statement of use under §2.88.*

*(d) Form. A request to divide an application should be made in a separate document from any other amendment or response in the application. The title "Request to Divide Application" should appear at the top of the first page of the*

document.

*(e) Outstanding time periods apply to newly created applications. Any time period for action by the applicant which is outstanding in the original application at the time of the division will apply to each separate new application created by the division, except as follows:*

*(1) If an Office action pertaining to less than all the classes in a multiple-class application is outstanding, and the applicant files a request to divide out the goods, services, and/or class(es) to which the Office action does not pertain before the response deadline, a response to the Office action is not due in the new (child) application(s) created by the division of the application;*

*(2) If an Office action pertaining to less than all the bases in a multiple-basis application is outstanding, and the applicant files a request to divide out the goods/services having the basis or bases to which the Office action does not pertain before the response deadline, a response to the Office action is not due in the new (child) application(s) created by the division of the application; or*

*(3) In a multiple-basis application in which a notice of allowance has issued, if the applicant files a request to divide out the goods/services having the basis or bases to which the notice of allowance does not pertain before the deadline for filing the statement of use, the new (child) applications created by the division are not affected by the notice of allowance.*

*(f) Signature. The request to divide must be signed by the applicant, someone with legal authority to bind the applicant (e.g., a corporate officer or general partner of a partnership), or a practitioner who meets the requirements of § 11.14, in accordance with the requirements of § 2.193(e)(2).*

*(g) Section 66(a) applications - change of ownership with respect to some but not all of the goods or services. (1) When the International Bureau of the World Intellectual Property Organization notifies the Office that an international registration has been divided as the result of a change of ownership with respect to some but not all of the goods or services, the Office will construe the International Bureau's notice as a request to divide. The Office will record the partial change of ownership in the Assignment Services Branch, and divide out the assigned goods/services from the original (parent) application. The Office will create a new (child) application serial number, and enter the information about the new application in its automated records.*

*(2) To obtain a certificate of registration in the name of the new owner for the goods/services that have been divided out, the new owner must pay the fee(s) for the request to divide, as required by §2.6 and paragraph (b) of this section. The examining attorney will issue an Office action in the child application requiring the new owner to pay the required fee(s). If the owner of the child application fails to respond, the child application will be abandoned. It is not necessary for the new owner to file a separate request to divide.*

*(3) The Office will not divide a section 66(a) application based upon a change of ownership unless the International Bureau notifies the Office that the international registration has been divided.*

## **1110.01 Application May be Divided**

Under 37 C.F.R. §2.87(a), an applicant may divide the application into two or more separate applications upon payment of the applicable fees. When dividing an application, the applicant preserves the filing date for all the goods/services covered by the application. See 37 C.F.R. §2.87(b) and TMEP §1110.02 regarding the fees for a request to divide.

An applicant may request division of an application for any reason. For example, in an intent-to-use application, the applicant may wish to proceed to publication or registration with the goods/services on or in connection with which the applicant has used the mark in commerce and retain an active intent-to-use application for any remaining goods/services.

The applicant *must* file a request to divide if the applicant files an amendment to allege use before making use on all the goods/services for which applicant seeks registration under §1(b), or a statement of use before making use on all the goods/services specified in the notice of allowance. 37 C.F.R. §§2.76(c) and 2.88(c); TMEP §§1104.03(a) and 1109.03.

## **1110.02 Fees for Filing Request to Divide**

*Request to Divide Out One or More Entire Classes.* With a request to divide out one or more entire classes from an application, only the fee for dividing the application (“divisional fee”), as set forth in 37 C.F.R. §2.6(a)(19), is required. A divisional fee is required for each new (child) application created by the division of the original (parent) application. 37 C.F.R. §2.87(b). No separate application filing fee is required for any new applications created.

*Request to Divide Out Some, But Not All, of the Goods/Services in a Single Class.* A request to divide out some, but not all, of the goods/services in a single class must be accompanied by both: (1) the divisional fee for each new (child) application created by the division of the original (parent) application (37 C.F.R. §2.6(a)(19)); *and* (2) an application filing fee for each new separate application created by the division, as set forth in 37 C.F.R. §2.6(a)(1). The amount of the new application filing fee depends on the method used to file the original application and request to divide, as follows:

- If the original application was filed through TEAS Plus and the request to divide is filed through TEAS, then the new application filing fee is the same as the TEAS Plus application filing fee (37 C.F.R. §2.6(a)(1)(iii));
- If the original application was not filed through TEAS Plus, and the request to divide is filed through TEAS, then the new application filing fee is the same as the TEAS application filing fee (37 C.F.R. §2.6(a)(1)(ii));

- If the request to divide is filed on paper, then the new application filing fee is the same as the fee for filing an application on paper (37 C.F.R. §2.6(a)(1)(i)), regardless of how the original application was filed.

The current fee schedule is available on the USPTO website at <http://www.uspto.gov>.

If the request to divide does not include the required fee(s), the ITU/Divisional Unit will notify the applicant in writing of the deficiency and grant the applicant time to submit the required fees. The applicant must submit the fee(s) within the time permitted, or the request to divide will be considered abandoned and the application will not be divided. If the applicant does not submit the necessary fees, the ITU/Divisional Unit will notify the applicant that the request to divide is considered abandoned.

See TMEP §1110.07 regarding the application of fees when an applicant files a request to divide in conjunction with a statement of use and/or request for an extension of time to file a statement of use, but submits insufficient fees.

### **1110.03 Time for Filing Request to Divide**

An applicant may file a request to divide at any time between the filing of the application and the date the examining attorney approves the mark for publication; or during an opposition, concurrent use, or interference proceeding, upon motion granted by the Trademark Trial and Appeal Board. 37 C.F.R. §2.87(c)(1).

A request to divide a §1(b) application may also be filed with a statement of use, or at any time between the filing of a statement of use and the date the examining attorney approves the mark for registration. 37 C.F.R. §2.87(c)(2).

In a *multiple-basis* application, a request to divide out goods/services having a particular basis may also be filed during the period between the issuance of the notice of allowance and the filing of the statement of use. 37 C.F.R. §2.87(c)(3).

If the USPTO receives a request to divide at any other time, the USPTO will deny the request, and refund any fees submitted with the request.

### **1110.04 Form and Processing of Request to Divide**

A request to divide can be filed either on paper or through TEAS.

In TEAS, the applicant can file a request to divide directly as part of the TEAS “Allegation of Use” form, but only when the request to divide is limited to the creation of only one child application. If the applicant wishes to create more than one child application, or if the request to divide is being made in a

context other than an “Allegation of Use” scenario, the applicant can still file electronically by doing the following: (1) choose the “global form” offering within TEAS, and (2) select therein the “Request to Divide Application” choice from the form pull-down list, which is found in the “Miscellaneous” form category. A “Request to Divide Registration” offering is also available in the global form, within the “Post- Registration” form category.

A paper request to divide should be made in a separate document from any other amendment or response in the application. The title “Request to Divide Application” should appear at the top of the first page of the document. 37 C.F.R. §2.87(d).

All requests to divide should be immediately referred to the ITU/Divisional Unit for processing, unless the application is the subject of a proceeding before the Trademark Trial and Appeal Board. See TMEP §1110.09 regarding requests to divide applications that are the subject of a proceeding at the Board.

#### **1110.05 Outstanding Time Periods Apply to Newly Created Applications**

Any outstanding deadline in effect at the time an application is divided applies not only to the original application, but also to each separate new application created by the division of the application, **except** in the following circumstances:

- (1) If an Office action pertaining to less than all the classes in a multiple-class application is outstanding, and the applicant files a request to divide out the goods, services, and/or class(es) to which the Office action does not pertain before the response deadline, a response to the Office action is not due in the new (child) application(s) created by the division of the application;
- (2) If an Office action pertaining to less than all the bases in a multiple-basis application is outstanding, and the applicant files a request to divide out the goods/services having the basis or bases to which the Office action does not pertain before the response deadline, a response to the Office action is not due in the new (child) application(s) created by the division of the application; or
- (3) In a multiple-basis application in which a notice of allowance has issued, if the applicant files a request to divide out the goods/services having the basis or bases to which the notice of allowance does not pertain before the deadline for filing the statement of use, the new (child) application(s) created by the division is/are not affected by the notice of allowance.

37 C.F.R. §2.87(e).

## **1110.06 Signature of Request to Divide**

A request to divide must be signed by the applicant, someone with legal authority to bind the applicant (e.g., a corporate officer or general partner of a partnership), or a practitioner who meets the requirements of 37 C.F.R. §11.14 (“qualified practitioner”). 37 C.F.R. §§2.87(f) and 2.193(e)(2). The ITU/Divisional Unit must ensure that the request to divide is signed by a proper party. If the applicant is represented by a qualified practitioner, the practitioner must sign the request to divide. 37 C.F.R. §§2.193(e)(2)(i) and 11.18(a). If the applicant is *pro se*, the request must be signed by the individual applicant or someone with legal authority to bind a juristic applicant. 37 C.F.R. §§2.193(e)(2)(ii) and 11.14(e). See TMEP §611.06 *et seq.* for more information about persons who have legal authority to bind various types of entities who are not represented by an attorney, and TMEP §§611.05 *et seq.* regarding processing documents signed by someone other than the applicant or the applicant’s designated qualified practitioner.

## **1110.07 Dividing an Application When Statement of Use is Due**

Filing a request to divide does not extend the deadline for filing a statement of use or request for an extension of time to file a statement of use.

Any outstanding deadline in effect at the time the application is divided applies not only to the original application, but also to each new application created by the division of the application. 37 C.F.R. §2.87(e). Therefore, if a notice of allowance has issued and a statement of use is due, a statement of use, or request for extension of time to file a statement of use, is due in each separate new application created by the division, unless the following exception applies:

- In a multiple-basis application, if the applicant files a request to divide out the goods/services having the basis or bases to which the notice of allowance does not pertain before the deadline for filing the statement of use, the new (child) application(s) created by the division are not affected by the notice of allowance. 37 C.F.R. §2.87(e)(3); TMEP §1110.05.

A request to divide *must* be filed if the applicant files a statement of use before making use of the mark in commerce on all the goods/services specified in the notice of allowance as based on §1(b), unless the applicant deletes the goods/services that are not in use. 37 C.F.R. §2.88(c); TMEP §1109.03.

Requests to divide are given priority in processing over any other document, with one exception: if the applicant submits a request for extension of time to file a statement of use at the same time as or before the request to divide, *and* the extension request applies to the resulting applications, the extension request will be processed first. This provides the applicant with an extension

that applies to all resulting applications without requiring additional fees for extension requests.

When the applicant files a request to divide goods/services that are in use from goods/services that are not yet in use, the USPTO puts the goods/services in use in the newly created (child) application, and retains the goods/services not in use in the original (parent) application. More child applications may later be created from the parent application.

When the applicant files a request to divide goods/services based solely on §44(e) from goods/services that are not yet in use, the USPTO puts the goods/services that are based solely on §44 in a newly created (child) application, and retains the goods/services not in use in the original (parent) application.

If the applicant submits a request to divide along with a statement of use and a request for an extension of time to file a statement of use, and the fees are insufficient to cover all three, the fees will be applied first to the extension request (if there is enough to cover the extension request), second to the statement of use, and last to the request to divide. See TMEP §1108.02(c) regarding fee deficiencies in extension requests, TMEP §1109.15(a) regarding fee deficiencies in statements of use, and TMEP §1110.02 regarding fee deficiencies in requests to divide.

#### **1110.08 Dividing an Application When Response to Office Action is Due**

Filing a request to divide is not a proper response to an Office action and does not relieve an applicant of the duty to respond to any outstanding Office action or to take any other required action.

Any outstanding deadline in effect at the time the application is divided applies not only to the original application, but also to each new application created by the division of the application. 37 C.F.R. §2.87(e). Therefore, if a response to an Office action is due, the response is due in each separate new application created by the division of the application, unless one of the following exceptions applies:

- (1) If the Office action pertains to less than all the classes in a multiple-class application, and the applicant files a request to divide out the goods, services, or class(es) to which the Office action does not pertain before the response deadline, a response to the Office action is not due in the new (child) application(s) created by the division of the application.
- (2) If the Office action pertains to less than all the bases in a multiple-basis application, and the applicant files a request to divide out the goods/services having the basis or bases to which the Office action

does not pertain before the response deadline, a response to the Office action is not due in the new (child) application(s) created by the division of the application.

37 C.F.R. §§2.87(e)(1) and (2).

If the applicant files a request to divide goods/services that are subject to a refusal from goods/services that are not subject to a refusal, the USPTO puts the goods/services that are *not* subject to refusal in the new (child) application, and retains the goods/services that *are* subject to refusal in the original (parent) application. More child applications may later be created from the parent application.

When a request to divide is filed together with a response to an Office action, the response should be entered first, and then the request to divide should be referred to the ITU/Divisional Unit. The ITU/Divisional Unit will process the request and then return the application to regular processing.

A request to divide may be made by examiner's amendment, if the applicant pays the fees by deposit account authorization or faxes an authorization to charge the fees to a credit card. However, fees cannot be charged to a deposit account by examiner's amendment, unless the record already contains a written authorization signed and submitted by someone who is authorized to charge fees to the account. See TMEP §405.03 regarding deposit accounts.

#### **1110.09 Dividing an Application Subject to a Proceeding at Trademark Trial and Appeal Board**

A request to divide may be filed during an opposition, concurrent use, or interference proceeding, upon motion granted by the Trademark Trial and Appeal Board. 37 C.F.R. §2.87(c). When an application is the subject of a proceeding before the Board, any request to divide should first be referred to the Board for appropriate action. If the Board determines that the request to divide should be granted, the Board will refer the request to the ITU/Divisional Unit with instructions for dividing the application. The ITU/Divisional Unit will process the request and then return the application to regular processing. See TBMP §516.

See TBMP §1205.02 regarding the filing of a request to divide filed with or after an appeal.

#### **1110.10 Dividing a §44 Application**

When the applicant divides an application that includes a claim of priority under §44(d), the separate new (child) application(s) created through the division retain the priority filing date, provided that each new application meets the requirements of §44(d). This is true even if the applicant does not

ultimately perfect a §44(e) basis. See 37 C.F.R. §§2.35(b)(3) and (4); TMEP §§806.01(c) and 806.02(f).

When an applicant requests division of an application that includes a copy of a foreign registration, the applicant does not have to provide additional copies for each new application created by the division.

#### **1110.11 Dividing a §66(a) Application**

If ownership of an international registration changes for some but not all of the goods/services, the USPTO will not divide a §66(a) application unless the IB notifies the USPTO that the international registration has been divided. 37 C.F.R. §2.87(g)(3). See TMEP §1110.11(a) for further information about division of a §66(a) application after a partial change of ownership.

In all other situations, a §66(a) applicant may divide a §66(a) application into two or more separate applications, if applicant meets all the requirements of 37 C.F.R. §2.87. See TMEP §§1110.02 – 1110.06 for further requirements for filing a request to divide.

#### **1110.11(a) Dividing a §66(a) Application After Change of Ownership With Respect to Some But Not All of the Goods/Services**

When ownership of an international registration changes for some but not all of the goods/services for all designated Contracting Parties, the International Bureau of the World Intellectual Property Organization (“IB”) will create a separate new international registration for the goods/services that have been transferred, and notify the USPTO accordingly. See the IB’s *Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol* (2008), Para. B.II.65.01.

When the IB notifies the USPTO of the division of an international registration resulting from a change of ownership with respect to some but not all of the goods/services, the USPTO will construe the IB’s notice as a request to divide. The USPTO will record the partial change of ownership in the Assignment Services Branch, and divide out the assigned goods/services from the original (parent) application. The USPTO will create a new (child) application serial number, and enter the information about the new application in its automated records. 37 C.F.R. §2.87(g)(1).

To obtain a certificate of registration in the name of the new owner for the goods/services that have been divided out, the new owner must pay the required fee(s) for the request to divide. 37 C.F.R. §§2.6, 2.87(b), and 2.87(g)(2). The application will be forwarded to the examining attorney to issue an Office action in the new (child) application requiring the new owner to pay the required fees. See TMEP §1110.02 regarding the amount of the fee(s) for a request to divide. If the owner of the child application fails to respond, the child application will be abandoned. The USPTO will not

approve the child application for publication or registration until the new owner pays the required divisional fees. It is not necessary for the new owner to file a separate request to divide.

The USPTO will not divide a §66(a) application based upon a change of ownership, unless the IB notifies the USPTO that the international registration has been divided. 37 C.F.R. §2.87(g)(3).

See TMEP §1615.02 regarding division of registered extensions of protection of international registrations, and TMEP §501.07 regarding assignment of extensions of protection.

#### **1110.12            Division of Registrations**

See TMEP §§1615 *et seq.* regarding division of registrations.