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701 Statutory Authority for Examination

15 U.S.C. §1062. Publication.

(a) Upon the filing of an application for registration and payment of the prescribed fee, the Director shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made....

(b) If the applicant is found not entitled to registration, the examiner shall advise the applicant thereof and of the reason therefor. The applicant shall have a period of six months in which to reply or amend his application, which shall then be reexamined. This procedure may be repeated until (1) the examiner finally refuses registration of the mark or (2) the applicant fails for a period of six months to reply or amend or appeal, whereupon the application shall be deemed to have been abandoned, unless it can be shown to the satisfaction of the Director that the delay in responding was unintentional, whereupon such time may be extended.

702 Order of Work

702.01 Order of Examination

In general, examining attorneys should examine applications in the order in which they are received in the United States Patent and Trademark Office (“USPTO”), unless the application is made “special.” See TMEP §702.02 regarding “special” applications.

Generally, amended applications (i.e., applications that contain a response from the applicant), remands from the Trademark Trial and Appeal Board (“Board”), and statements of use are also reviewed in the order in which they are received in the USPTO.

Examining attorneys should act on applications that have been suspended as soon as they are removed from suspension. See TMEP §§716 *et seq.* regarding suspension.

Examining attorneys should immediately act on inquiries regarding applications approved for publication or issue that are returned to the examining attorney to take action or provide information.

Where appropriate, the managing attorney may direct that a particular case be given special handling.

When an examining attorney resigns, the examining attorney should spend any remaining time in the Office getting his or her amended cases (including

statements of use under 15 U.S.C. §1051(d) and appeal briefs), especially those with involved records, ready for final disposition.

702.02 “Special” Applications

While the USPTO normally processes applications in the order in which they are received, there are two procedures whereby an application can be made “special,” so that initial examination will be expedited.

Request to Make Special - Registration Inadvertently Cancelled Under 15 U.S.C. §1058, §1059, or §1141k. A new application for registration of a mark that was the subject of a previous registration that was inadvertently cancelled or expired under 15 U.S.C. §1058, §1059, or §1141k will be made “special” upon the request of the applicant if the applicant is the prior registrant or the assignee of the prior registrant. No petition fee is required in this situation. However, *the mark in the new application must be identical to the mark in the cancelled or expired registration, and the goods/services in the new application must be identical to or narrower than the goods/services in the cancelled or expired registration.*

A request to make an application special because a registration was inadvertently cancelled is reviewed in the Office of the Deputy Commissioner for Trademark Examination Policy. The applicant should first file the application via the Trademark Electronic Application System (“TEAS”). The applicant should then submit a request to make special that includes the newly assigned serial number and the number of the cancelled registration. To ensure proper routing and processing, the Office prefers that the request also be filed electronically. In TEAS, the Request to Make Special form can be accessed at <http://www.uspto.gov>.

If it is not possible to file the request electronically, it should be faxed to the attention of the Deputy Commissioner for Trademark Examination Policy at the following fax number: 571-273-0032.

If the request is submitted by mail, it should be submitted *separately* from the application, marked to the attention of the Deputy Commissioner for Trademark Examination Policy.

Petition to Make Special. A petition to make “special” is a request to the Director under 37 C.F.R. §2.146 to advance the initial examination of an application out of its regular order. See TMEP §§1710 *et seq.* regarding the petition requirements and filing procedure.

The examining attorney should promptly examine any application that has been made “special.”

702.03 Related Applications

702.03(a) Companion Applications

The term “companion applications” refers to pending applications filed by the same applicant. An application is pending until it registers or abandons. Pending applications include applications that have been approved for publication or for registration on the Supplemental Register, applications in the Intent-to-Use (“ITU”)/Divisional Unit, and revived or reinstated applications.

702.03(a)(i) Companion Applications Not Previously Assigned for the Same or Similar Marks

If an applicant has multiple pending applications, the issues in the applications are likely to be similar. When assigned a new application, an examining attorney will be assigned the companion applications filed within three months of the filing date of the first assigned application. If an applicant files more than ten applications within a three-month period, only the first ten will be assigned to one examining attorney. Examining attorneys are encouraged to assign all unassigned companion applications for the same or similar marks to themselves, even if the applications were filed outside the three-month period.

The assignment of companion applications is done electronically, based upon the owner’s name as set forth in the application. Therefore, the owner’s name should be set forth consistently in all applications.

See TMEP §702.03(a)(iv) regarding classification and identification in companion applications that have been published for opposition.

702.03(a)(ii) Companion Applications Previously Assigned

If TRAM indicates that a companion application has been assigned to a different examining attorney, the examining attorney should **not** transfer his or her application to the other examining attorney. However, the examining attorney must review the electronic record of the earlier companion application before taking action in a later companion case, and should act consistently, unless it would be clear error (see TMEP §706.01) to do so. If the examining attorney believes that acting consistently with the prior action(s) would be erroneous, he or she should bring the issue to the attention of the managing attorney or senior attorney.

See TMEP §702.03(a)(iv) regarding classification and identification in companion applications that have been published for opposition.

702.03(a)(iii) Companion Registrations

If the applicant previously filed a companion application that has matured into a registration, the examining attorney should *not* transfer his or her application to the prior examining attorney. Generally, in the later application, the examining attorney should act consistently with the registration, unless it would be clear error (see TMEP §706.01) to act consistently. However, the USPTO is not bound by the decisions of the examiners who examined the applications for the applicant's previously registered marks, based on different records. Eligibility for registration must be determined on the basis of the facts that exist at the time registration is sought. See TMEP §1216.01 and cases cited therein.

See TMEP §702.03(a)(iv) regarding classification and identification in companion registrations.

702.03(a)(iv) Classification and Identification in Companion Applications That Have Registered or Been Published for Opposition

If a companion application has been published for opposition or has registered, the examining attorney may presume that the classification and identification of goods or services in the companion application or registration are acceptable, unless the identification or classification is clearly wrong. If the examining attorney accepts the classification and identification of goods or services because they were accepted in a companion application or registration, the examining attorney must note the companion application serial number or registration number in the "Notes to the File" section of the record.

Sometimes, the classification and identification of goods and/or services in the prior companion application or registration is clearly wrong. For example, identifications and class assignments that were acceptable in the past may no longer be in accord with the current Nice Agreement classification system (see TMEP §§1401.02 *et seq.*) or with USPTO policy on acceptable identifications, which change periodically. In these cases, the examining attorney cannot adopt the classification and identification listed in the companion application or registration. See TMEP §§1402.14 and 1904.02(c)(v).

702.03(b) Conflicting Applications

The term "conflicting applications" refers to two or more pending applications that are filed by different applicants and may ultimately require a refusal of registration under §2(d) of the Trademark Act, 15 U.S.C. §1052(d), due to a likelihood of confusion between the marks. When assigned a new application, the examining attorney must search the USPTO's automated

records to determine whether there are any conflicting applications. If there are conflicting applications, the examining attorney should **not** transfer the conflicting application to the examining attorney who acted on the first conflicting application. Instead, the examining attorney should examine the assigned application and issue an Office action that includes a notice to the applicant that there is a prior-filed application to register a mark that may be likely to cause confusion with the applicant's mark. See TMEP §§1208 *et seq.* The examining attorney handling the later-filed application should act consistently with the examining attorney who handled the earlier-filed application, unless it would be clear error (see TMEP §706.01) to act consistently. If necessary, the examining attorney should review the electronic record of the earlier-filed application before taking an action in the later-filed conflicting application.

703 USPTO Does Not Issue Duplicate Registrations

The USPTO will not issue two or more identical registrations on the same register. If two applications on the same register would result in registrations that are exact duplicates, the USPTO will permit only one application to mature into registration, and will refuse registration in the other application. 37 C.F.R. §2.48. For instance, if two identical applications are filed by an applicant, and the USPTO has not taken action in either application, then the USPTO will refuse registration in both applications. However, if the USPTO has already taken action in one of the applications but not the other, then the USPTO will refuse registration in the second application.

The applicant may overcome the refusal(s) by abandoning one of the applications. If practicable, the USPTO will permit the applicant to choose which application should mature into registration. If one of the applications has matured into registration, the applicant may choose to either surrender the registration and allow the application to proceed to registration, or retain the registration and abandon the application.

Basis. Applications filed under or amended to §1 of the Trademark Act are considered identical if the only difference between them is that one is based on use in commerce under §1(a) and the other is based on intent-to-use under §1(b). However, an application filed under §1 and an application filed under §44 that are otherwise identical are *not* regarded as duplicate registrations, nor is an application under §66(a) of the Trademark Act regarded as a duplicate of an application filed under §1 or §44.

Classification Change. Where the international classification of goods/services has changed, a new application for registration of the same mark for the same goods/services in a different class will not be considered a duplicate. For example, if applicant owns a registration of a mark for legal services in Class 42, and files a new application after January 1, 2007, for

registration of the same mark for legal services in Class 45, this is not a duplicate.

Standard Character/Typed Drawing. An application for registration of a mark depicted in standard characters is considered a duplicate of an application for registration of the same mark in “typed” format (see TMEP §807.03(g)) for the same goods/services.

Standard Character/Special Form. A standard character drawing and a special form drawing of the same mark are not considered identical.

Overlapping Goods/Services. Applications/registrations with identifications that include some of the same goods/services, but also different goods/services, are not identical.

Color. A drawing on which the entire mark is lined for color (see TMEP §808.01(b)), is considered a duplicate of a color drawing of the mark, if the colors are identical. See TMEP §§807.07 *et seq.* regarding color drawings.

If the applicant claims different shades of a color (e.g., purple in one and lavender in the other), the marks are not duplicates.

Where one application/registration is not completely lined for color (i.e., if the mark on the drawing includes color(s) in addition to unclaimed or unexplained black, white, and/or gray), this is not considered a duplicate of an application seeking registration that includes a claim of the same color(s) in addition to a claim of color for, or an explanation of the presence of, the black/white/gray in the drawing. See TMEP §§807.07(d) *et seq.* regarding drawings that include black/white/gray.

Principal/Supplemental Register. An application for registration of a mark on the Principal Register is not considered a duplicate of an application for registration of the same mark on the Supplemental Register.

Registrations Issued Under Prior Acts. If eligible, marks registered under the Acts of 1881, 1905, and 1920 may also be registered under the Act of 1946 (see §46(b) of the Trademark Act of 1946). Even if the mark and the goods/services in a registration issued under the 1946 Act are identical to the mark and goods/services in a registration issued under a prior Act, the registrations are not considered duplicates. See TMEP §§1601.04, 1601.05, 1602.02 and 1602.03 regarding registrations issued under prior Acts.

Section 66(a) Application Based on Different Int’l Registration. A §66(a) application is not a duplicate of another §66(a) application or registered extension of protection based on a different international registration.

When an application is a duplicate of a registration owned by the applicant, and USPTO records show that the registration is still active, the examining attorney must refuse registration. If the registration is subject to cancellation

for failure to file an affidavit of continued use or excusable nonuse under 15 U.S.C. §1058 or §1141k, or due to expire for failure to file a renewal application under 15 U.S.C. §1059 (i.e., because the grace period has passed and no affidavit or renewal application has been filed), and the application is otherwise in condition for approval or final refusal, the examining attorney must suspend the application until the TRAM system is updated to show that the registration is cancelled or expired. See TMEP §1611 for information about how a registrant who has not timely filed a §8 affidavit or §9 renewal application may expedite the cancellation or expiration of its own registration.

704 Initial Examination

704.01 Initial Examination Must be Complete

37 C.F.R. §2.61(a). Applications for registration, including amendments to allege use under §1(c) of the Act, and statements of use under §1(d) of the Act, will be examined and, if the applicant is found not entitled to registration for any reason, applicant will be notified and advised of the reasons therefor and of any formal requirements or objections.

The initial examination of an application by the examining attorney must be a *complete* examination. A complete examination includes a search for conflicting marks and an examination of the written application, any preliminary amendment(s) or other documents filed by applicant before an initial Office action is issued, the drawing, and any specimen(s) or foreign registration(s), to determine whether the mark is eligible for the type of registration requested, whether amendment is necessary, and whether all required fees have been paid.

If, on initial examination, the examining attorney finds the mark in an application for registration on the Principal Register to be in condition for publication for opposition, the examining attorney will approve the application for publication. Similarly, if the examining attorney finds the mark in an application for registration on the Supplemental Register to be in condition for registration, the examining attorney will approve the application for registration. The USPTO will send a notice of publication or certificate of registration to the applicant in due course.

If the application is not in condition to be approved for publication or issue, the examining attorney will write, telephone, or e-mail the applicant, as appropriate, informing the applicant of the reason(s) why the mark may not be registered and of the defect(s) that can be corrected or amended to make the application acceptable.

The examining attorney's first Office action must be complete, so the applicant will be advised of all requirements for amendment and all grounds for refusal, with the exception of use-related issues that are considered for the

first time in the examination of an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d) in an intent-to-use application. See TMEP §§1102.01 and 1202 *et seq.* regarding use-related issues that are considered for the first time in the examination of an amendment to allege use or a statement of use. Every effort should be made to avoid piecemeal prosecution, because it prolongs the time needed to dispose of an application. See *also* TMEP §706 regarding new issues raised by the examining attorney after the first Office action.

Examining attorneys must also clearly explain all refusals and requirements. For example, if the identification of goods/services is indefinite, the examining attorney should explain why the identification is not acceptable and, if possible, suggest an acceptable identification. See TMEP §§705 *et seq.* for further information about examining attorneys' Office actions.

704.02 Examining Attorney's Search

If the examining attorney finds no conflicting marks, but must write to the applicant about other matters, the examining attorney must inform the applicant that no conflicting marks have been found. This is commonly called the "search clause."

In an application filed under §1 or §44 of the Trademark Act, if the examining attorney cannot make a proper search or cannot examine the application properly due to lack of adequate information, the examining attorney should specifically indicate what information is needed, request that it be furnished, and state that further action on the matter will be taken as soon as the information is received. See 37 C.F.R. §2.61(b) and TMEP §814 regarding requirements for additional information.

If some but not all of the goods/services in a §66(a) application are so indefinite that the examining attorney cannot make a proper search, the examining attorney may defer the search in part. The examining attorney must specifically indicate the good/services for which a search has been conducted by listing the goods/services for which no conflicting marks have been found, and, if relevant, issuing a §2(d) refusal that is specifically limited to certain goods/services. See TMEP §718.02(a) regarding partial refusals.

If all the goods/services in a §66(a) application are so indefinite that the examining attorney cannot make a proper search, the examining attorney may defer the search. The examining attorney must issue a full refusal, require the necessary amendments to the goods/services, and state that further action on the merits with respect to likelihood of confusion will be considered as soon as a sufficiently definite identification of goods/services is received.

Before issuing a letter deferring action, the examining attorney should consult with the managing attorney or senior attorney.

704.03 Supervisory Examining Attorney May Indicate Action for Non-Signatory Examining Attorney

When a non-signatory examining attorney examines an application, a supervisory examining attorney must thoroughly review the action. The usual procedure is for the non-signatory examining attorney to explain relevant information to the supervisory examining attorney, discussing any potential refusals or requirements. The supervisory examining attorney may indicate the action to be taken.

705 The Examining Attorney's Letter or Action

If an examining attorney determines that a mark is not entitled to registration, or that amendment is required, the examining attorney will notify the applicant in a written Office action, or by e-mail or telephone communication, which is typically followed by a written action. This constitutes the examining attorney's official action.

Written Office actions may be of a variety of styles, including: (1) an "examiner's amendment" (see TMEP §§707 *et seq.*), in which the examining attorney formally makes amendments to the application; (2) a "priority action (see TMEP §§708 *et seq.*)," setting forth and explaining the requirements discussed by telephone with the individual applicant, someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner of a partnership), or with a practitioner authorized to practice before the USPTO pursuant to 37 C.F.R. §11.14 ("qualified practitioner") designated by the applicant; (3) a letter explaining the bases for refusal(s) or requirement(s); (4) an examiner's amendment combined with a priority action (see TMEP §708.05); or (5) a suspension notice (see TMEP §§716 *et seq.*). Office actions may be prepared through the use of standardized form paragraphs, in combination with language written to address the particular facts relevant to the refusal(s) or requirement(s). The examining attorney may send the Office action by regular mail or e-mail (if applicant has authorized e-mail communications). See TMEP §§304 *et seq.* regarding e-mail.

The USPTO encourages the use of examiner's amendments and priority actions whenever appropriate.

705.01 Language in Examining Attorney's Letter

The examining attorney must indicate the status of the application at the beginning of each letter.

In first actions, this may be done by stating that the examining attorney has reviewed the application and made the determinations that follow, or by using language such as "Upon examination of this application..." The examining attorney must acknowledge any document received before the first action by identifying the document and the date of its receipt.

In subsequent actions, examining attorneys should begin letters with a sentence such as, "This Office action is in response to applicant's communication filed on [date]." Other documents received, such as supplemental amendments, affidavits, and new drawings, should also be acknowledged.

Refusals to register should be couched in the statutory language of the section of the Trademark Act that is the basis of the refusal, and the examining attorney must cite the appropriate section of the Act. For example, registration of a trademark should not be refused "because it is a surname," but "because it *consists of matter that is primarily merely a surname under §2(e)(4) of the Trademark Act.*"

Registration must be refused only as to the specific register (i.e., Principal or Supplemental) for which registration is requested. However, when refusing registration on the Principal Register, the examining attorney should also state, to the extent possible, whether the record indicates that an amendment to the Supplemental Register or to seek registration on the Principal Register under §2(f) may be appropriate.

The words "capable" and "incapable" should be reserved for addressing an amendment to the Supplemental Register.

Examining attorneys are encouraged to use form paragraphs to accelerate the preparation of Office actions and increase the uniformity of the substance and appearance of these actions. However, examining attorneys should use the form paragraphs only if they apply to a particular situation, and should expand on the form paragraphs when necessary to explain and support the relevant requirements or refusals.

705.02 Examining Attorneys Should Not Volunteer Statements

In Office actions, and e-mail and telephone communications, examining attorneys should not volunteer statements about applicants' rights that are gratuitous and unnecessary to the examination of the matters presented in applications. The examining attorney's responsibility is limited to evaluating the registrability of the mark presented in the application. See *In re American Physical Fitness Research Institute Inc.*, 181 USPQ 127 (TTAB 1974). See also TMEP §1801.

705.03 Citation of Conflicting Marks

When refusing registration under 15 U.S.C. §1052(d) based on a likelihood of confusion with a previously registered mark, the examining attorney must give the registration number(s) and attach to the Office action a copy of each cited registration, which will become part of the record. The examining attorney should explain the reasons that the mark in each cited registration is a basis for refusal under §2(d).

If an applicant notifies the USPTO that the USPTO failed to attach a cited registration, or that the USPTO attached a registration but did not cite the registration as a bar to registration in the Office action, the USPTO will reissue the Office action citing and attaching the relevant registration(s) and provide the applicant with a new response period.

705.04 Reference to Matter in Printed or Online Publications

When the examining attorney refers to matter in a printed publication, the examining attorney should provide the citation for the publication, and include the relevant material with the Office action. It is not necessary to attach a published legal decision to an Office action. A citation is sufficient. See TMEP §705.05 regarding citation of decisions.

When the examining attorney refers to an online publication, such as an article downloaded from the Internet, the examining attorney should provide any information that would aid a party in locating the document, including the complete URL address of the website, the time and date the search was conducted, and the terms searched. See TMEP §710.01(b) for a discussion of the weight accorded to Internet evidence. See *also* TMEP §710.01(a) regarding evidence from a research database.

705.05 Citation of Decisions and USPTO Publications

When citing court or administrative decisions, the *United States Patents Quarterly* (USPQ or USPQ2d) citation should be given. If possible, a parallel citation to the United States Reports (U.S.), Federal Reporter (F., F.2d, or F.3d), or Federal Supplement (F. Supp. or F. Supp.2d) should also be given. The court or tribunal (2d Cir., C.C.P.A., Fed. Cir., TTAB, etc.) and the date of the decision should always be given.

When citing to a decision that is published and reported only in LexisNexis® and/or Westlaw®, for which there are no official print versions, the citing party should provide the name of the research service, case name, proceeding name and docket number, database identifier, court name, date, and screen, page, or paragraph numbers, if assigned. When citing to an unpublished decision of the Board, the examining attorney must either provide the Board's [TTABVUE](#) website address and explain how the applicant may locate and view the decision, or append the decision to the Office action.

Non-Precedential Decisions. Prior to December 27, 2006, it was the policy of the Trademark Trial and Appeal Board that Board opinions not designated as precedential should not be cited and, if cited, were to be disregarded. *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1275 n.9 (TTAB 1992). The Board has changed that policy. In announcing the change, the Board stated that:

[T]he Board will henceforth permit citation to any TTAB disposition as follows:

- The TTAB will continue its current practice of designating all final decisions as either precedential or not precedential. Unless specifically designated as precedential, an order on a motion should be considered not precedential.
- The TTAB will continue its practice of considering precedential decisions as binding upon the TTAB.
- A decision designated as not precedential is not binding upon the TTAB but may be cited for whatever persuasive value it might have.
- Citation to all TTAB decisions should be to the United States Patent Quarterly, if the decision appears therein; otherwise, to a USPTO public electronic database. If a non-precedential decision does not appear in the United States Patent Quarterly or the USPTO's public electronic databases, the citing party should append a copy of the decision to the motion or brief in which the decision is cited.
- Decisions of other tribunals may be cited to the extent allowed and for the purposes permitted by the tribunal that issued the decision.

See [Citation of Opinions to the Trademark Trial and Appeal Board](#) (OG Jan. 23, 2007).

The examining attorney may cite sections of the *Trademark Manual of Examining Procedure* ("TMEP") or [Trademark Trial and Appeal Board Manual of Procedure](#) ("TBMP"). The abbreviations "TMEP" and "TBMP" are usually sufficient; however, if the person prosecuting the application appears to be unfamiliar with USPTO practice, the examining attorney should identify the Manuals by their full names in the first citation to the Manuals. It is not necessary to provide a copy of the relevant section(s) of the Manuals.

When the examining attorney cites a Director's order or notice, the examining attorney should provide the title and date of the notice, and the specific issue of the *Official Gazette* in which it may be found.

705.06 Reviewing and Signing of Letters

Examining attorneys must review and sign every Office action using an electronic signature. The signature block should include the name, law office, and telephone number of the examining attorney. The signature block should be set forth as follows:

/Examining attorney's full name/
Trademark Examining Attorney
Law Office xxx
(571) 272-xxxx

If an examining attorney does not have signatory authority, he or she should sign the action and refer it to an authorized signatory examining attorney, who will review and approve the action. Review by a reviewer should ordinarily be done within two working days after receipt from the non-signatory examining attorney.

705.07 Processing Outgoing Office Actions

A date is placed on all copies of paper Office actions when they are issued. For outgoing e-mail communications, including electronically issued Office actions, the date is applied automatically when the communication is released to the USPTO's electronic mail system.

One copy of the action signed by the examining attorney, along with any supporting evidence and/or copies of registered marks or pending applications cited as a bar to registration, is sent to the Trademark Image Capture and Retrieval System ("TICRS") and is available for review by the public through the Trademark Document Retrieval ("TDR") portal on the USPTO website at <http://www.uspto.gov>.

An applicant who authorizes e-mail communication will not receive the actual Office action by e-mail. Instead, upon issuance of the Office action, the USPTO will e-mail a notice to the applicant with a link or web address to access the Office action using TDR. The Office action will not be attached to the e-mail notice. Upon receipt of the e-mail notice, the applicant may use the link or web address to view and print the actual Office action and any evidentiary attachments.

705.08 Six-Month Response Clause

Generally, the examining attorney's letter or Office action should include a "six-month response clause" notifying the applicant that the applicant must respond to the action within six months of the issuance date to avoid abandonment under 15 U.S.C. §1062(b). See TMEP §§711 *et seq.* regarding the deadline for response to an Office action.

The examining attorney should *not* include a six-month response clause in an examiner's amendment (see TMEP §§707 *et seq.*) or suspension notice (see TMEP §§716 *et seq.*), or in a situation where the time for response runs from the issuance date of a previous Office action (see TMEP §§711.01 and 715.03(c)).

New Matter Raised by Examining Attorney After First Action

If in the first Office action an examining attorney inadvertently failed to refuse registration on a clearly applicable ground or to make a necessary requirement, the examining attorney must take appropriate action to correct the inadvertent error in a subsequent action. Examining attorneys should exercise great care to avoid these situations, and should take this step only when the failure to do so would result in clear error (see TMEP §706.01). After the first action, supervisors (e.g., supervisors reviewing the quality of the examining attorney's work) should not introduce any new reason for refusal that is not clearly justified under the Act or rules.

Since it is unusual to make a new refusal or requirement that could have been raised in the first action, an examining attorney who does make a new refusal or requirement must clearly explain why the refusal or requirement is necessary, and apologize for the delay in raising the issue, if appropriate. See TMEP §711.02 regarding supplemental Office actions.

Sometimes, the examining attorney must issue a new refusal or requirement because the applicant submits information that raises a new issue.

In a §66(a) application, the examining attorney cannot issue a new refusal more than 18 months after the date on which the International Bureau of the World Intellectual Property Organization ("IB") forwards the request for extension of protection to the USPTO. See TMEP §1904.03(a).

706.01 "Clear Error"

The term "clear error" refers to an administrative internal guideline used by the USPTO to determine whether an examining attorney should issue a refusal or requirement that could or should have been raised in a previous action.

It is the policy of the USPTO to do a complete examination upon initial review of an application by an examining attorney, and to issue all possible refusals and requirements in the first Office action. TMEP §704.01. The USPTO will not issue a new refusal or requirement that could or should have been made in an earlier Office action unless it is necessary to do so to prevent the issuance of a registration that would violate the Trademark Act or applicable rules. See, e.g., TMEP §706. For example, the Director will not restore jurisdiction to an examining attorney to issue a new refusal of registration unless the failure to issue the refusal would result in the issuance of a registration that would violate the Trademark Act or applicable rules. See TMEP §1504.04. See *also* TMEP §1109.08 regarding the issuance of refusals and requirements during examination of a statement of use that could or should have been issued during initial examination of the application.

The internal “clear error” standard is merely an administrative guideline. It does not confer on an applicant any entitlement to a showing of clear error, nor does it impose a higher standard of proof on the examining attorney than is otherwise required to establish a prima facie case for the refusal or requirement.

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 made during examination 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 previously raised.

The question of whether a refusal or requirement was procedurally proper is reviewable on petition under 37 C.F.R. §2.146. However, “[q]uestions of substance arising during the ex parte prosecution of applications, including, but not limited to, questions arising under §§2, 3, 4, 5, 6 and 23 of the Act of 1946, are not considered to be appropriate subject matter for petitions....” 37 C.F.R. §2.146(b). Thus, the Director cannot consider on petition whether the issuance of or failure to issue a substantive refusal was a “clear error.” See TMEP §1704 regarding petitionable subject matter, and TMEP §1706 regarding the standard of review on petition.

On appeal, the Trademark Trial and Appeal Board will review only the correctness of the underlying substantive refusal of registration. See *In re Jump Designs, LLC*, 80 USPQ2d 1370 (TTAB 2006); *In re Sambado & Son, Inc.*, 45 USPQ2d 1312 (TTAB 1997).

707 Examiner’s Amendment

An examiner’s amendment should be used whenever appropriate to expedite prosecution of an application. An examiner’s amendment is a communication to the applicant in which the examining attorney states that the application has been amended in a specified way. Except in the situations listed in TMEP §707.02, the amendment must be specifically authorized by the individual applicant, someone with legal authority to bind a juristic applicant

(e.g., an officer of a corporation or general partner of a partnership), or the applicant's qualified practitioner. Cf. 37 C.F.R. §2.74(b). See TMEP §707.01 regarding the authorization of an examiner's amendment. Authorization is usually given in a telephone conversation, e-mail communication, or interview between the examining attorney and the applicant or the applicant's qualified practitioner. See TMEP §§304 *et seq.* regarding e-mail.

The examining attorney may issue an examiner's amendment whenever the required amendment does not have to be verified by the applicant. For example, in appropriate circumstances, an examiner's amendment may be used to amend the identification of goods/services, enter a disclaimer, add the state of incorporation, or amend from the Principal to the Supplemental Register.

The following are examples of amendments that may **not** be made by examiner's amendment: the dates of use, if verification would be required (see TMEP §903.04); the mark on a special-form drawing (see TMEP §807.04), if the changes would require the filing of a substitute special form drawing; and amendments that require the submission of substitute specimen(s) (see TMEP §904.05). An application cannot be expressly abandoned by examiner's amendment (see TMEP §718.01).

An authorization to charge a fee to a deposit account cannot be entered by examiner's amendment, unless the record already contains a written authorization, signed and submitted by someone authorized to charge fees to the account. See TMEP §405.03 regarding deposit accounts.

Examiner's amendments generally are not used when there are statutory refusals. However, if there is a potential statutory refusal, and an amendment will obviate the refusal, the examining attorney may attempt to resolve the issues through an examiner's amendment.

Example: If the applicant could overcome a surname refusal for a mark that is in use in commerce by amending to the Supplemental Register, the examining attorney may initiate telephone or e-mail contact and suggest the amendment. If the applicant authorizes the amendment, the examining attorney may issue an examiner's amendment amending the application to the Supplemental Register.

Example: If the mark contains the term "organic" and the applicant could overcome a potential deceptiveness refusal by amending the identification to state that the goods are organic, the examining attorney may initiate telephone or e-mail contact and suggest the amendment. If the applicant authorizes the amendment, the examining attorney may issue an examiner's amendment amending the identification.

Example: If the applicant could overcome a likelihood-of-confusion refusal as to several registrations by amending a vague or indefinite identification of goods/services, the examining attorney may initiate telephone or e-mail contact and suggest the amendment only if it would obviate the refusals as to all the registrations that would be cited. If the applicant agrees to the proposed amendment clarifying the identification, the examining attorney may issue an examiner's amendment. If the applicant does not agree with the examining attorney's suggested identification and proposes an amendment that would obviate the refusal as to some, but not all, of registrations, the examining attorney may issue a combined examiner's amendment/priority action. See TMEP §708.05. However, when it is clear from the outset that amending the identification would not obviate the refusal as to one or more of the registrations, the examining attorney must not initiate telephone or e-mail contact, because it is not possible to offer the applicant a specific action to place the application in condition for publication, suspension, or registration.

Example: If the identification is vague or indefinite, the examining attorney may seek authorization to amend the identification by examiner's amendment, even when the amendment would not overcome a potential likelihood-of-confusion refusal. The examining attorney would then issue a notice of suspension. To ensure that the applicant understands that amending the identification will only put the application in condition for suspension, during the telephone or e-mail discussion, the examining attorney must notify the applicant of the prior pending application and the forthcoming suspension. The resulting examiner's amendment should also include this information.

See TMEP §708.04 regarding priority actions involving statutory refusals.

An examining attorney without partial signatory authority must have proper authorization from the managing attorney, senior attorney, or a reviewing examining attorney before initiating an examiner's amendment.

See TMEP §707.03 regarding the form of an examiner's amendment.

An applicant should **not** file correspondence confirming an examiner's amendment, because this will delay processing of the application. A written response to an examiner's amendment is not required.

If an applicant wishes to object to the examiner's amendment, this should be done immediately (preferably by telephone or e-mail), so that the objection can be considered before publication or issue. See TMEP §1402.07(e) regarding an applicant's objection to an examiner's amendment of the identification of goods/services on the ground that the examiner's amendment

does not reflect the agreement between the applicant and the examining attorney.

Often an applicant will seek to respond to an outstanding Office action with an amendment or other response by telephone. The examining attorney is encouraged to enter an examiner's amendment if this amendment will immediately place the application in condition for publication for opposition, issuance of a registration, or suspension. See TMEP §§716 *et seq.* regarding suspension. However, an applicant does not have an unlimited right to the entry of an examiner's amendment in response to an Office action. If the applicant does not agree to an amendment that the examining attorney believes will immediately place the application in condition for publication for opposition or issuance of a registration, the applicant must file a complete written response to the outstanding Office action.

See TMEP §708.05 regarding combined examiner's amendment/priority actions.

NOTE: In a §66(a) application, an examiner's amendment may *not* be issued on a first action because the IB will not accept such amendments. Examiner's amendments may be issued on second and subsequent actions. See TMEP §1904.02(h) regarding Office actions in §66(a) applications.

707.01 Approval of Examiner's Amendment by Applicant or Applicant's Attorney

Except in the situations set forth in TMEP §707.02 in which an examiner's amendment is permitted without prior authorization by the applicant, an examining attorney may amend an application by examiner's amendment only after securing approval of the amendment from the individual applicant, someone with legal authority to bind a juristic applicant, or the applicant's qualified practitioner by telephone, e-mail, or in person during an interview. *Cf.* 37 C.F.R. §§2.62(b) and 2.74(b). See TMEP §602 *et seq.* for guidelines on persons who may practice before the USPTO.

If the applicant has a qualified practitioner, the examining attorney must speak directly with the practitioner. If a qualified practitioner from the same firm as the qualified practitioner of record claims to be authorized by the practitioner of record to conduct business and approve amendments with respect to a specific application, the examining attorney will permit the practitioner to conclude business, and will note this fact in the examiner's amendment. Paralegals and legal assistants cannot authorize examiner's amendments, even if only conveying the appointed qualified practitioner's approval by indicating that the practitioner has approved the amendment.

If the applicant is *pro se*, the examining attorney must speak directly with the individual applicant or with someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner of a partnership). *Cf.*

37 C.F.R. §11.14(e). For joint applicants who are not represented by a qualified practitioner, each joint applicant must authorize the examiner's amendment. See TMEP §§611.06 *et seq.* for guidelines on persons who have legal authority to bind various types of applicants.

A non-attorney who is authorized to verify facts on behalf of an applicant under 37 C.F.R. §2.193(e)(1) is *not* entitled to authorize an examiner's amendment, unless he or she has legal authority to bind the applicant. The broad definition of "person properly authorized to sign on behalf of the applicant" in 37 C.F.R. §2.193(e)(1) (see TMEP §§611.03(a) and 804.04) does not apply to examiner's amendments.

The applicant or the applicant's qualified practitioner must actually authorize the examiner's amendment. The examining attorney may not leave an e-mail or voicemail message for the applicant or the qualified practitioner indicating that an amendment shall be entered if the applicant or practitioner does not respond to the message.

If an examining attorney contacts an applicant and reaches agreement to issue an examiner's amendment, but later determines that an Office action must be issued instead to state a refusal or requirement, the examining attorney should telephone or e-mail the applicant immediately to advise the applicant of the change of position.

Examining attorneys without partial signatory authority must advise applicants that issuance of the examiner's amendment is subject to review by a supervisory attorney.

707.02 Examiner's Amendment Without Prior Authorization by Applicant or Applicant's Attorney

Examining attorneys have the discretion to amend applications by examiner's amendment without prior approval by the applicant or the applicant's qualified practitioner (sometimes referred to as a "no-call" examiner's amendment) in the following situations:

- (1) Changes to international classification, either before or after publication (see *Groening v. Missouri Botanical Garden*, 59 USPQ2d 1601 (Comm'r Pats. 1999));
- (2) Deletion of "TM," "SM," "©," or "®" from the drawing;
- (3) Addition of a description of the mark where an Office action or regular examiner's amendment is otherwise unnecessary *and* one of the following conditions applies:
 - (a) The record already contains an informal indication of what the mark comprises (see TMEP §808.03(b));

Example - The cover letter accompanying a paper application refers to the mark as a stylized golf ball design. If appropriate, the examining attorney could enter an amendment that “the mark consists of the stylized design of a golf ball.”

Example – The application refers to the mark as a blue, red, and yellow ball and includes an accurate and properly worded color claim listing all colors in the mark, but the color yellow is omitted from the formal description of the colors in the mark (see TMEP §807.07(a)(ii)). The examining attorney may enter an amendment of the formal color description to accurately reflect all colors in the mark;

- (b) The mark consists only of wording in stylized font, with no color claim and with no design element (see TMEP §808.03(b)); or
 - (c) The mark includes no color claim and consists only of wording in combination with underlining or a common geometric shape used as a vehicle for the display of the wording (see TMEP §808.03(b)).
- (4) If the examining attorney determines that a description of the mark will not be printed in the *Official Gazette* or on the registration certificate, and it is unnecessary to issue an Office action or a regular examiner’s amendment regarding other matters, the examining attorney may enter an amendment to that effect. See TMEP §§808.03 *et seq.*;
 - (5) Amendment of the application to enter a standard character claim when the record clearly indicates that the drawing is intended to be in standard character form. See TMEP §807.03(g);
 - (6) Correction of an obvious misspelling(s), typographical error(s), redundanc(ies) in the identification of goods/services, or in an otherwise accurate and complete description of the mark. See TMEP §§808.03(a) and 1402.01(a);

Example - The goods are recited as “T-shurtz.” The examining attorney could amend to “T-shirts.” However, “shirtz” could not be amended to “shirts” without calling the applicant, because “shirtz” (without the “T-” prefix) might also be a misspelling of “shorts.”

- (7) When an applicant fails to respond to a refusal or requirement that is expressly limited to only certain goods, services, and/or class(es), the examining attorney may issue an examiner’s amendment deleting the goods/services/classes to which the refusal or requirement pertained. Similarly, when an applicant fails to respond to a requirement to amend some terminology in an otherwise acceptable identification of goods/services, the examining attorney may issue an examiner’s

amendment deleting the unacceptable terminology from the identification. See TMEP §§718.02(a) and 1402.13;

- (8) Deletion of bracketed material from an entry taken from the USPTO's [*Acceptable Identification of Goods and Services Manual*](#). Bracketed material sometimes appears in the Manual for informational purposes but should not be included in an identification of goods/services. If this material is entered in an identification, it will be automatically deleted in a TEAS Plus application. In a TEAS or paper application, the examining attorney may delete the bracketed material with a "no-call" examiner's amendment;
- (9) If, in response to a general or specific inquiry about translation and/or transliteration of non-English wording in the mark, the applicant does not directly state that the term has no meaning in a foreign language but instead responds to the effect that "the mark has only trademark significance," the examining attorney may enter a statement that "the term has no meaning in a foreign language" into the record. See TMEP §809.01(a);
- (10) When an applicant provides a translation statement that has the proper translation but is not suitable for printing, the examining attorney may "reformat" the statement, without changing the substance, into a simple, clear statement as to meaning. See TMEP §809.03.

If the examining attorney must contact the applicant or the applicant's qualified practitioner about other matters, or if the record contains any ambiguity as to the applicant's intent, the examining attorney should advise the applicant that the above changes have been made.

A copy of the examiner's amendment will be sent to the applicant. Any applicant who disagrees with any of these changes should contact the examining attorney immediately after receipt of the examiner's amendment, preferably by telephone or e-mail.

707.03 Form of the Examiner's Amendment

An examiner's amendment should include the following information: the name, law office, and telephone number of the examining attorney; the name of the person interviewed; the date of the interview; the actual amendment; and, if applicable, a statement to the effect that the amendment has been authorized by the applicant or the applicant's qualified practitioner.

The examiner's amendment should not include a six-month response clause, because a written response by the applicant is not required for an examiner's amendment.

The examiner's amendment must include a search clause (see TMEP §704.02) if it is a first action, or if the applicant has not previously been advised of the results of a search.

The examining attorney should not state in the examiner's amendment that the application is ready for publication or issue, because some unforeseen circumstance might require that further action be taken in the application.

The examiner's amendment must indicate any refusals or requirements that are withdrawn and/or continued by the examining attorney.

708 Priority Action

708.01 Priority Action Defined

A "priority action" is an Office action that is issued following a telephone conversation, personal interview, or e-mail communication in which the examining attorney and the individual applicant, someone with legal authority to bind a juristic applicant (e.g., an officer of a corporation or general partner of a partnership), or the applicant's qualified practitioner discuss the various issues raised in an application and what actions the applicant must take to put the application in condition for publication or registration. A priority action is generally used when the action requires verification by the applicant. The use of priority actions is encouraged to expedite examination.

A priority action should be issued according to the following procedure: (1) the examining attorney telephones or e-mails the applicant or applicant's qualified practitioner and requests that the applicant take some specific action, explaining the reasons; (2) the applicant or applicant's qualified practitioner specifically discusses the merits of the application with the examining attorney; (3) the examining attorney prepares and signs a priority action that fully discusses all refusals or requirements, includes evidence to support the refusals and/or requirements, and specifically describes what action the applicant may take in order to put the application into condition for publication or registration; and (4) the USPTO sends a copy of the priority action to the applicant.

If the evidence of record supports a statutory refusal of registration, a priority action may be issued only if the examining attorney believes that an amendment or explanation will obviate the refusal. See TMEP §708.04.

See TMEP §708.03 regarding the form of a priority action.

708.02 Discussion of Issues and Agreements

The examining attorney must discuss the issues with the individual applicant, a person with legal authority to bind a juristic applicant, or the applicant's qualified practitioner. The broad definition of "person properly authorized to

sign on behalf of the applicant” in 37 C.F.R. §2.193(e)(1) (see TMEP §§611.03(a) and 804.04) does not apply to priority actions.

Only the applicant, someone with legal authority to bind the applicant, or a qualified practitioner can agree to a priority action. If the applicant has a qualified practitioner, the examining attorney must speak directly to the practitioner. See TMEP §602 *et seq.* for guidelines on persons who may practice before the USPTO.

If a qualified practitioner from the same firm as the qualified practitioner of record claims to be authorized by the qualified practitioner of record to conduct business and approve amendments with respect to a specific application, the examining attorney will permit the practitioner to authorize issuance of the priority action, and will note this fact in the priority action.

Paralegals and legal assistants cannot authorize issuance of a priority action, even if only conveying the qualified practitioner’s approval by indicating that the practitioner has agreed to the priority action.

If the applicant is *pro se*, the examining attorney must speak directly to the individual applicant or to someone with legal authority to bind a juristic applicant (e.g., an officer of a corporation or general partner of a partnership). *Cf.* 37 C.F.R. §11.14(e). See TMEP §§611.06 *et seq.* for guidelines on persons who have legal authority to bind various types of applicants.

A non-attorney who is authorized to verify facts on behalf of an applicant under 37 C.F.R. §2.193(e)(1) may not authorize issuance of a priority action, unless he or she also has legal authority to bind the applicant.

During the telephone conversation, e-mail discussion, or other communication, the examining attorney must fully discuss all refusals and requirements relating to the application, and explain the reason for each refusal or requirement. Whenever possible, the examining attorney should suggest appropriate language for amendments.

A priority action is *not* appropriate when:

1. the examining attorney leaves a voicemail or e-mail message for the applicant or applicant’s qualified practitioner, but the applicant or practitioner does not call back or respond to the message;
2. the examining attorney telephones the applicant or applicant’s attorney but the attorney does not have time to discuss the application and requests that the examining attorney send a letter; or
3. the examining attorney e-mails the applicant or applicant’s attorney and merely states that there are problems with the

application (e.g., indefinite identification, a disclaimer requirement, and clarification of entity type) and that a letter will be sent.

All the issues in the priority action must be discussed on the merits with the applicant or the applicant's qualified practitioner in a good-faith attempt to resolve any issues and place the application in condition for publication or registration, as appropriate. However, an agreement as to precisely how all issues will be resolved is not necessary.

Example: If the goods are identified as "computer equipment," the examining attorney may seek authorization to amend the identification to list the types of computer equipment. If the applicant or applicant's attorney does not agree to the suggested amendment, the examining attorney may issue a priority action that fully explains the identification requirement. It may also state that "the applicant will submit an acceptable identification of goods that specifies the common commercial names of the types of computer equipment." It is not necessary that there be an agreement that "the applicant will amend the identification of goods to, for example, computer keyboards, computer monitors, and computer printers."

The priority action may state that the applicant will follow one of two alternative courses of action, for example, providing either an amended drawing or a new specimen.

708.03 Form of the Priority Action

The priority action should reference the date of the telephone call, e-mail message, or other communication, and the name and title (where appropriate) of the person who authorized the priority action. See TMEP §708.02 for information about who may authorize issuance of a priority action.

A priority action must include a six-month response clause (see TMEP §705.08) so that it is clear that the applicant must timely respond to the priority action to avoid abandonment of the application.

The priority action must include a search clause (see TMEP §704.02) if it is a first action, or if the applicant has not previously been advised of the results of a search.

The priority action must also: (1) fully discuss all refusals and/or requirements; (2) include sufficient evidence to support all refusals and/or requirements; and (3) specifically describe what action the applicant may take in order to put the application into condition for publication or registration. See TMEP §708.02 regarding discussion of issues on the merits.

The examining attorney should discuss each issue separately, stating the reason for the refusal and/or requirement and/or citing the relevant sections of the statute, rules, and/or TMEP. The essential nature of the refusal or requirement, and any pertinent advisories relating thereto, must be clearly stated in the priority action, and fully supported by appropriate evidence (if applicable), because the action of the USPTO is based exclusively on the written record. 37 C.F.R. §2.191.

A priority action may be used for a final or nonfinal refusal or requirement. See TMEP §708.04 regarding refusal of registration in a priority action, and TMEP §§714 *et seq.* regarding final actions.

708.04 Refusal of Registration in Priority Action

Priority actions are generally used when there are no statutory refusals. However, if there is sufficient evidence to support a statutory refusal, and the examining attorney believes that an amendment or explanation will obviate the refusal, the examining attorney may attempt to resolve the issues through a priority action.

Example: If the applicant could overcome a surname refusal by submitting a claim of acquired distinctiveness under §2(f) of the Trademark Act for a mark that has been used in commerce for more than five years, the examining attorney may initiate telephone or e-mail contact and discuss the refusal and the requirements for submitting a claim of acquired distinctiveness. See TMEP §§1212 *et seq.* regarding §2(f). Because the claim of five years of use is generally required to be supported by a properly signed affidavit or declaration under 37 C.F.R. §2.20, the examining attorney may issue a priority action that fully discusses the refusal, includes sufficient evidence to support the refusal, and reiterates the suggested amendment and requirement.

Example: If the applicant could overcome a likelihood-of-confusion refusal as to several registrations by amending a vague or indefinite identification of goods/services, the examining attorney may initiate telephone or e-mail contact and suggest the amendment. If the applicant or applicant's attorney does not authorize an examiner's amendment, the examining attorney may issue a priority action that fully discusses the refusal, includes sufficient evidence to support the refusal, and reiterates the suggested amendment to the identification. However, if amending the identification would obviate the refusal as to fewer than all of the registrations, the examining attorney must not initiate telephone or e-mail communication, and, therefore, may not issue a priority action.

Example: If there are multiple co-pending applications, and a likelihood-of-confusion refusal could be obviated as to some of the

applications by amending the identification, the examining attorney may initiate telephone or e-mail contact and suggest the amendment only as to those applications. If the applicant or applicant's attorney does not authorize an examiner's amendment, the examining attorney may issue priority actions that fully discuss the refusal, include sufficient evidence to support the refusal, and reiterate the suggested amendment to the identification. The examining attorney may not issue a priority action for any co-pending applications where an amendment to the identification would not obviate the refusal.

Example: If the applicant could overcome a descriptiveness refusal for a mark that is in use in commerce by amending to the Supplemental Register, the examining attorney may initiate telephone or e-mail contact to discuss the refusal and suggest the amendment. If the applicant's attorney agrees that the mark is descriptive, but needs to consult with the applicant about amending to the Supplemental Register, the examining attorney may issue a priority action that fully discusses the refusal, includes sufficient evidence to support the refusal, and offers the option of amending to the Supplemental Register.

Example: If the applicant could overcome a geographically descriptive refusal for a mark that is in use in commerce by amending to the Supplemental Register, the examining attorney may initiate telephone or e-mail contact to discuss the refusal and suggest the amendment. Even if the applicant disagrees as to the merits of the underlying refusal, the examining attorney may issue a priority action that fully discusses the refusal, includes sufficient evidence to support the refusal, and reiterates the option of amending to the Supplemental Register.

In the priority action, the examining attorney must clearly state the basis for the refusal that was discussed, citing the relevant sections of the statute and rules, attaching evidence to support the refusal, and indicating the resolutions agreed upon or the options offered.

If the priority action includes a final refusal, the priority action must clearly indicate that the refusal is FINAL, and should contain any additional supporting evidence necessary for a complete record on appeal. See TMEP §§714 *et seq.* regarding final actions.

708.05 Combined Examiner's Amendment/Priority Action

An examining attorney may issue an Office action that combines an examiner's amendment and priority action, if the requirements for both have been met. The examiner's-amendment portion reflects the authorized amendments, and the priority-action section addresses the refusals and

requirements that remain outstanding and to which the applicant must still respond. An examining attorney may not issue a “no-call” examiner’s amendment/priority action, because the issues in the priority action portion of the action have not been discussed with the applicant or applicant’s qualified practitioner.

The action must include a six-month response clause (see TMEP §705.08) so that it is clear that the applicant must timely respond to the issues raised in the priority action to avoid abandonment of the application. The action must also include the subheadings “Priority Action” and “Examiner’s Amendment” to facilitate processing.

Example: After determining that an application requires a disclaimer and clarification of the entity type and color claim, and that the specimen shows ornamental use of the mark, if the examining attorney obtains authorization from the applicant or applicant’s attorney only to amend the entity type and color claim, a combined examiner’s amendment/priority action may be issued. The examiner’s-amendment section memorializes the amendments to the entity type and color claim. The priority action portion fully addresses the ornamental refusal and disclaimer requirement, includes sufficient evidence to support each, and reiterates the action that would put the application in condition for publication or registration.

Example: If the examining attorney determines that an application lacks the necessary translation statement and that the specimen is unacceptable, and during a discussion of these issues the applicant agrees to entry of a suggested translation statement, but states that she needs to consider what to do about the specimen, the examining attorney may issue a combined examiner’s amendment/priority action. The examiner’s-amendment section memorializes the agreed-upon translation statement. The priority-action portion fully addresses the specimen refusal and includes all actions that would put the application in condition for publication or registration.

Example: If the application contains the “SM” symbol on the drawing, an indefinite identification, and an unclear entity type, the examining attorney may not issue a no-call examiner’s amendment/priority action to delete by examiner’s amendment the “SM” symbol and address by priority action the identification and entity requirements. Since no discussion occurred, the requirements for a priority action have not been met. However, the examining attorney may telephone or e-mail the applicant or applicant’s attorney, discuss the requirements, and issue a combined examiner’s amendment/priority action, if appropriate.

NOTE: In a §66(a) application, an examining attorney may not issue a combined examiner’s amendment/priority action as a first action. See TMEP §1904.02(h) regarding Office actions in §66(a) applications.

709 Interviews

A discussion between the applicant or applicant's qualified practitioner and the examining attorney in which the applicant presents matters for the examining attorney's consideration is considered an interview. An interview can be conducted in person, by telephone, or by e-mail. See TMEP §§304 *et seq.* regarding e-mail.

The application will not normally be processed out of turn as a result of the interview, and the interview does not extend the deadline for response to an outstanding Office action.

The examining attorney may not discuss inter partes questions with any of the interested parties. See TMEP §1801.

709.01 Personal Interviews

Personal interviews with examining attorneys concerning applications and other matters pending before the USPTO are permissible on any working day and must be in the office of the respective examining attorney, within office hours that the examining attorney may designate.

Personal interviews should be arranged in advance, preferably by fax, e-mail, or telephone. This will ensure that the assigned examining attorney will be available for the interview at the scheduled time and will have an opportunity to review the application record. The unexpected appearance of a qualified practitioner or applicant requesting an interview without any previous notice to the examining attorney is not appropriate.

An interview should be conducted only when it could serve to develop and clarify specific issues and lead to a mutual understanding between the examining attorney and the applicant. Interviews should not extend beyond a reasonable time.

The examining attorney should not hesitate to state that matter presented for consideration during the interview requires further research, if this is the case. Furthermore, the examining attorney may conclude an interview when it appears that no common ground can be reached.

During an interview with a *pro se* applicant who is not familiar with USPTO procedure, the examining attorney may in his or her discretion make suggestions that will advance the prosecution of the application, but these interviews should not be allowed to become unduly long.

When an agreement is reached during an interview but it is not possible to resolve all issues through an examiner's amendment, the examining attorney should make a note in the "Notes-to-the-File" section of the record concerning the agreement, and request that the applicant incorporate the agreement in its response.

Sometimes, the examining attorney who conducted the interview is transferred, resigns, or retires, and examination of the application is taken over by another examining attorney. If there is an indication in the record that an interview was held, the new examining attorney should endeavor to ascertain whether any agreements were reached during the interview. The new examining attorney should take a position consistent with agreements previously reached, unless doing so would be a clear error (see TMEP §706.01).

Except in unusual situations, no interview on the merits is permitted after the brief on appeal is filed, or after an application has been forwarded for publication or issue.

709.02 Persons Who May Represent Applicant in an Interview

In general, interviews are not granted to persons who lack proper authority from the applicant. See TMEP §§602 *et seq.* regarding persons who may represent an applicant before the USPTO in a trademark matter, and TMEP §§611.06 *et seq.* for information as to persons who have authority to bind various types of juristic applicants.

The examining attorney may request proof of a person's authority if there is any reason to suspect that the person is not, in fact, a qualified practitioner who is authorized to represent the applicant. 37 C.F.R. §2.17(b)(2).

For an interview with an examining attorney who does not have signatory authority, arrangements should be made for the presence of an examining attorney who does have such authority and who is familiar with the application, so that an authoritative agreement may be reached, if possible, at the time of the interview.

USPTO employees are forbidden to engage in oral or written communication with a disbarred, suspended, or excluded practitioner (see TMEP §608.02), unless the practitioner is the applicant.

Requests for interviews from third parties are inappropriate and should be directed to the Office of the Deputy Commissioner for Trademark Examination Policy. See TMEP §1801.

709.03 Making Substance of Interview of Record

The substance of an interview must always be made of record in the application, since the action of the USPTO is based exclusively on the written record. 37 C.F.R. §2.191. This should be done promptly after the interview while the matters discussed are fresh in the minds of the parties.

If possible, agreements reached in the interview should be incorporated in an examiner's amendment or priority action. Otherwise, to ensure that any

agreements reached at an interview will be implemented, and to avoid subsequent misunderstanding, the examining attorney should include, in the “Notes-to-the-File” section of the record, a list of the issues discussed and indicate whether any agreement was reached. See TMEP §709.04 for further information about “Notes-to-the-File”.

The applicant or the applicant’s qualified practitioner may also make the substance of an interview part of the record by incorporating a summary of the interview in the applicant’s response to the Office action. If there is any disagreement between the examining attorney and the applicant as to the substance of the interview, the written record governs. 37 C.F.R. §2.191.

709.04 Telephone and E-Mail Communications

Use of the telephone and e-mail is encouraged. Examining attorneys should initiate telephone and e-mail communications whenever possible to expedite prosecution of an application. Similarly, applicants and qualified practitioners may telephone or e-mail examining attorneys, if they feel that a call or e-mail will advance prosecution of an application.

All documents filed in connection with the application should include the telephone number of the applicant or the applicant’s qualified practitioner.

The examining attorney should return telephone calls and e-mail messages within a reasonable time, normally the same working day and never later than the next working day.

Generally, the examining attorney who prepared the action, and not the supervisory or reviewing examining attorney, should be the person contacted by telephone or e-mail. However, a non-signatory examining attorney must secure proper authorization from the managing attorney, senior attorney, or reviewing examining attorney before approving an amendment.

The action of the USPTO is based exclusively on the written record. 37 C.F.R. §2.191. Therefore, the examining attorney must use an examiner’s amendment (see TMEP §§707 *et seq.*), priority action (see TMEP §§708 *et seq.*), upload a relevant e-mail communication, or enter a note in the “Notes-to-the-File” section of the record to make the substance of the telephone call or the resolution of any issue part of the written record. See TMEP §709.03.

Notes in the “Notes-to-the-File” section must not summarize arguments or legal conclusions. Rather, the note-to-the-file must merely list the issues discussed and indicate any agreement that may have been reached. If no agreement was reached, that should be noted also.

If an examining attorney does not respond to a telephone or e-mail message within two business days, the applicant may telephone the law office manager

or supervisor. Contact information is available on the USPTO website at <http://www.uspto.gov/teas/contactUs.htm>.

709.05 Informal Communications

An applicant may conduct informal communications with an examining attorney regarding a particular application by telephone, e-mail (see TMEP §§304 *et seq.*), or fax. Informal communications should be conducted only if they serve to develop and clarify specific issues and lead to a mutual understanding between the examining attorney and the applicant. For example, an applicant may telephone or send an e-mail regarding:

- Questions about an outstanding Office action that do not constitute a response;
- Authorization to issue an examiner's amendment or priority action (see TMEP §§707.01 and 708.01);
- Notification of termination of a cancellation proceeding that is the basis for suspension (see TMEP §716.02(a)).

An informal communication does not constitute a response to an outstanding Office action and does not extend the deadline for response.

If it is unclear whether a written communication is an informal inquiry or a response to an Office action, the USPTO will process the communication as a response.

Informal communications must be made part of the record, because the USPTO uses them in decision making, and anything used in decision making must be made of record. 37 C.F.R. §2.191. That is, the examining attorney should make a note in the "Notes-to-the-File" section of the record that an applicant or qualified practitioner called to discuss a particular issue, or should upload a relevant e-mail communication. See TMEP §709.04 for further information about "Notes-to-the-File".

The applicant should monitor the status of an application after an informal communication to avoid abandonment. This may be done through the Trademark Applications and Registrations Retrieval ("TARR") database at <http://tarr.uspto.gov/>, or by calling the Trademark Assistance Center ("TAC") at (571) 272-9250 or (800) 786-9199. See TMEP §§108.03 and 1705.05 regarding the duty to monitor the status of an application in cases where a notice or action from the USPTO is expected.

709.06 Interviews Prior to Filing Application

No interviews are permitted before the filing of an application. If a party has general questions about how to file an application, he or she can call the

Trademark Assistance Center at (571) 272-9250 or (800) 786-9199. See TMEP §108.02.

USPTO employees cannot give advice on trademark law. It is inappropriate for USPTO personnel to give legal advice, to act as a counselor for individuals, or to recommend a qualified practitioner. 37 C.F.R. §2.11.

710 Evidence

710.01 Evidence Supporting Refusal or Requirement

In general, the examining attorney must always support his or her action with relevant evidence and ensure that proper citations to the evidence are made in the Office action.

All evidence that the examining attorney relies on in making a requirement or refusal must be placed in the record and copies must be sent to the applicant.

In appropriate cases, the examining attorney may also present evidence that may appear contrary to the USPTO's position, with an appropriate explanation as to why this evidence was not considered controlling. In some cases, this may foreclose objections from an applicant and present a more complete picture if there is an appeal. *Cf. In re Federated Department Stores Inc.*, 3 USPQ2d 1541, 1542 n.2 (TTAB 1987).

710.01(a) Evidence From Research Database

If evidence is obtained from a research database, the record should include an indication of the specific search that was conducted. The record should indicate the libraries and/or files that were searched and the results. If the examining attorney does not review all of the documents located in a search, the record should indicate the number of documents that were reviewed. The search summary should be made a part of the record and will provide most of this information. Information not indicated on the search summary, such as the number of documents viewed, should be stated in narrative in the Office action. The Office action should include a citation to the research service, indicating the service, the library and the file searched, and the date of the search (e.g., "LEXIS®, News and Business, All News (Sept. 25, 2009)").

When evidence is obtained from a research database, the examining attorney does not have to make all stories of record. It is sufficient to include only a portion of the search results, as long as that portion is a representative sample of what the entire search revealed. *In re Vaughan Furniture Co. Inc.*, 24 USPQ2d 1068, 1069 n.2 (TTAB 1992). *See also In re Federated Department Stores Inc.*, 3 USPQ2d 1541, 1542 n.2 (TTAB 1987).

See TMEP §710.01(b) regarding evidence originating in foreign publications.

710.01(b) Internet Evidence

Articles downloaded from the Internet are admissible as evidence of information available to the general public, and of the way in which a term is being used by the public. However, the weight given to this evidence must be carefully evaluated, because the source may be unknown. See *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1475-76 (TTAB 1999); *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370-71 (TTAB 1998). When making Internet evidence part of the record, the examining attorney should provide complete information as to the source or context of the evidence. Any information that would aid a party in locating the relevant document should be included in the citation (e.g., the complete URL address of the website, the time and date the search was conducted, and the terms searched).

A list of Internet search results has little probative value, because such a list does not show the context in which the term is used on the listed web pages. See *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 967, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007) (GOOGLE® search results that provided very little context of the use of ASPIRINA deemed to be “of little value in assessing the consumer public perception of the ASPIRINA mark”); *In re Tea and Sympathy, Inc.*, 88 USPQ2d 1062, 1064 n.3 (TTAB 2008) (truncated Google® search results entitled to little probative weight without additional evidence of how the searched term is used); *In re Thomas*, 79 USPQ2d 1021 (TTAB 2006) (Board rejected an applicant’s attempt to show weakness of a term in a mark through citation to a large number of GOOGLE® “hits” because the “hits” lacked sufficient context); *In re King Koil Licensing Co. Inc.*, 79 USPQ2d 1048 (TTAB 2006); *In re Remacle*, 66 USPQ2d 1222, 1223 n.2 (TTAB 2002); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058 (TTAB 2002). The examining attorney should attach copies of the website pages that show how the term is actually used.

As long as it is written in the English language, information originating on foreign websites or in foreign news publications that are accessible to the United States public may be relevant to discern United States consumer impression of a proposed mark. The probative value of such evidence will vary depending upon the context and manner in which the term is used. In *Bayer*, NEXIS® evidence that originated in foreign publications was deemed to be of “some probative value with respect to prospective consumer perception in the United States,” the Court noting “the growing availability and use of the internet as a resource for news, medical research results, and general medical information.” 488 F.3d at 969, 82 USPQ2d at 1835. In *Remacle*, the Board held evidence from a website in Great Britain admissible, noting that:

[I]t is reasonable to assume that professionals in medicine, engineering, computers, telecommunications and many other fields are likely to utilize all available resources, regardless of country of origin or medium. Further, the Internet is a resource that is widely

available to these same professionals and to the general public in the United States. Particularly in the case before us, involving sophisticated medical technology, it is reasonable to consider a relevant article from an Internet web site, in English, about medical research in another country, Great Britain in this case, because that research is likely to be of interest worldwide regardless of its country of origin.

66 USPQ2d at 1224 n.5. However, the weight given to such evidence may vary depending upon the context and manner in which the term is used. In *King Koil*, the Board gave only “limited probative value” to the contents of websites of commercial entities outside the United States showing use of the term “breathable” in relation to mattresses and bedding, stating that:

[C]onsumers may visit foreign web sites for informational purposes, even if they are more likely to focus on internet retailers that can easily ship items or make items available for pick up in a store in a location convenient to the purchaser. That would appear especially likely in a case such as this, where the item in question, a mattress, is large and potentially more expensive to ship than a smaller item. Accordingly, while we do not discount entirely the impact of foreign web sites in this case, we find them of much more limited probative value than in the *Remacle* case.

79 USPQ2d at 1050. See also *In re Cell Therapeutics, Inc.*, 67 USPQ2d 1795, 1797-98 (TTAB 2003) (relying on several NEXIS® items from foreign wire services to support a refusal and distinguishing earlier decisions that accorded such evidence little probative value given the sophisticated public and the widespread use of personal computers that increase access to such sources).

With respect to evidence taken from the online Wikipedia® encyclopedia, at www.wikipedia.org, the Board has noted that “[t]here are inherent problems regarding the reliability of Wikipedia entries because Wikipedia is a collaborative website that permits anyone to edit the entries,” and has stated as follows:

[T]he Board will consider evidence taken from Wikipedia so long as the non-offering party has an opportunity to rebut that evidence by submitting other evidence that may call into question the accuracy of the particular Wikipedia information. Our consideration of Wikipedia evidence is with the recognition of the limitations inherent with Wikipedia (e.g., that anyone can edit it and submit intentionally false or erroneous information)....

As a collaborative online encyclopedia, Wikipedia is a secondary source of information or a compilation based on other sources. As recommended by the editors of Wikipedia, the information in a

particular article should be corroborated. The better practice with respect to Wikipedia evidence is to corroborate applicant's Wikipedia evidence....

In re IP Carrier Consulting Group, 84 USPQ2d 1028, 1032 (TTAB 2007).

Given its inherent limitations, any information obtained from Wikipedia® should be treated as having limited probative value. If the examining attorney relies upon Wikipedia® evidence and makes it of record, then additional supportive and corroborative evidence from other sources should also be made of record, especially when issuing final actions.

The examining attorney must check applicant's own website for information about the goods/services. See *In re Promo Ink*, 78 USPQ2d 1301, 1303 (TTAB 2006), where 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. According to the Board, "The 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." See also *In re Reed Elsevier Properties Inc.*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007).

When a document found on the Internet is not the original publication, the examining attorney or Trademark Law Library staff should try to obtain a copy of the originally published document, if practicable. Electronic-only documents are considered to be original publications, and scanned images are considered to be copies of original publications. See notice at 64 Fed. Reg. 33056, 33063 (June 21, 1999).

See also TBMP §1208.03.

710.01(c) Record Must Be Complete Prior to Appeal

The record in any application must be complete prior to appeal. 37 C.F.R. §2.142(d). Accordingly, if an examining attorney or applicant attempts to introduce new evidence at the time of the appeal, the new evidence will generally be excluded from the record. TBMP §§1207 *et seq.* See *Rexall Drug Co. v. Manhattan Drug Co.*, 284 F.2d 391, 128 USPQ 114 (C.C.P.A. 1960); *In re Psygnosis Ltd.*, 51 USPQ2d 1594 (TTAB 1999). However, the Board may consider evidence submitted after appeal, despite its untimeliness, if the non-offering party: (1) does not object to the evidence; and (2) discusses the evidence or otherwise treats it as being of record. See TBMP §1207.03 and cases cited therein. Therefore, examining attorneys and applicants should either consider or object to new evidence.

Whenever an examining attorney objects to evidence submitted by an applicant, the objection should be raised as soon as possible and continued

in the examining attorney's brief, or the Board may consider the objection to be waived. *In re Broyhill Furniture Industries, Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001).

If the applicant or examining attorney wishes to introduce new evidence at the time of or during appeal, the party seeking to introduce the new evidence may request the Board to suspend the appeal and remand the case. See TMEP §§1504.05 *et seq.* and TBMP §1207.02 regarding requests for remand.

The Board may take judicial notice of definitions from printed dictionaries, even if they are not made of record by the applicant or examining attorney prior to appeal. *In re La Peregrina Ltd.*, 86 USPQ2d 1645 (TTAB 2008); *In re Dodd Int'l, Inc.*, 222 USPQ 268 (TTAB 1983); *In re Cannon, Inc.*, 219 USPQ 820 (TTAB 1983); TBMP §1208.04. However, the better practice is to attach the relevant material to ensure that it is in the record. The examining attorney must include a copy of the title page of the dictionary. *In re Gregory*, 70 USPQ2d 1792 (TTAB 2004) (Board declined to take judicial notice of dictionary definitions submitted with examining attorney's appeal brief, where neither the photocopied pages nor the examining attorney's brief specified the dictionaries from which the copies were made).

The Board will not take judicial notice of online dictionary definitions that are not available in printed form, unless the dictionary is readily available and verifiable, due to concerns about the reliability of such material. See *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006) (Board took judicial notice of the *Encarta Dictionary*, because it was a widely known reference that was readily available in specifically denoted editions via the Internet and CD-ROM, holding that it was "the electronic equivalent of a print publication and applicant may easily verify the excerpt"). However, it refused to take judicial notice of a definition excerpted from www.wordsmyth.net, where the source of the definition was not identified on the submitted website excerpt or by the examining attorney and thus could not be verified. See also *In re CyberFinancial.Net, Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002) (Board took judicial notice of online dictionary that was also available in printed form); *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999) (Board refused to take judicial notice of online dictionary that did not exist in printed format, where the source was unknown and the Board was unsure whether the dictionary was readily available or reliable, stating that the evidence should have been made of record **prior to** appeal, so applicant would have the opportunity to check the reliability of the evidence and offer rebuttal evidence).

710.02 Search for Evidence Indicating No Refusal or Requirement Necessary

It is USPTO practice to indicate the results of a search for evidence when the examining attorney considers an issue and determines that no action will be

taken on it. This information is helpful for internal review. The “Notes-to-the-File” section of the record should be used to reflect that a search for evidence was conducted in any case where the examining attorney determines that a search would be useful for review of the application, but that no further action is required. The examining attorney should simply note the parameters of the search conducted *without stating any opinions or conclusions*.

For instance, in the case of a search of telephone directories for surnames, the record should indicate only the directories investigated and the number of occurrences of the surname. Or, in the case of a search for the meaning of a term, the record should show the sources checked and whether the term was found. Examining attorneys should provide the same information indicated in TMEP §710.01(a) regarding searches of research databases in this type of case.

Examining attorneys should **not** provide any analysis, opinions, or conclusions regarding the evidence when the examining attorney determines that a refusal or requirement is not appropriate. The examining attorney should not place in the record copies of e-mail messages or other communications between the examining attorney and other USPTO personnel concerning the application. Also, the examining attorney should not refer to any registration or pending application that was considered in a §2(d) search, unless the examining attorney determines that there is a conflict and issues an Office action based on the application or registration. The examining attorney should not place copies of marks not cited under §2(d) in the record.

710.03 Evidence of Third-Party Registrations

The Trademark Trial and Appeal Board does not take judicial notice of registrations, and the submission of a list of registrations does not make these registrations part of the record. *In re 1st USA Realty Professionals, Inc.*, 84 USPQ2d 1581 (TTAB 2007); *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974). Furthermore, the submission of a copy of a commercial search report is not proper evidence of third-party registrations. *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983).

To make registrations of record, soft copies of the registrations or the complete electronic equivalent (i.e., complete printouts taken from any of the USPTO’s automated systems (X-Search, TESS, TARR, or TRAM)) must be submitted. *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998); *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455 (TTAB 1998); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1561 n.6 (TTAB 1996); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1231-32 (TTAB 1992).

If the applicant submits improper evidence of third-party registrations, the examining attorney should object to the evidence in the next Office action, or

the Board may consider the objection to be waived. See *In re 1st USA Realty Professionals, supra* (Board considered applicant's own registration, provided for the first time on appeal, because it had been referred to during prosecution and the examining attorney addressed the issue without objection; Board also allowed evidence of a list of third-party registrations because the examining attorney did not advise applicant of the insufficiency of the list while there was still time to correct the mistake); *In re Broyhill Furniture Industries, Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001) (objection to evidence waived where it was not interposed in response to applicant's reliance on listing of third-party registrations in response to initial Office action). If the applicant files an appeal, the examining attorney should continue the objection to the evidence in his or her appeal brief.

See TMEP §1207.01(d)(iii) regarding the relevance of third-party registrations to a determination of likelihood of confusion under 15 U.S.C. §1052(d).

711 Deadline for Response to Office Action

The statutory period for response to an examining attorney's Office action is six months from the date of issuance. 15 U.S.C. §1062(b); 37 C.F.R. §2.62(a). The examining attorney has no discretion to shorten or extend this period. The applicant must file a response within six months of the issuance date of the Office action, unless the examining attorney has issued a supplemental action resetting the period for response. See TMEP §711.02 regarding supplemental Office actions.

In a §66(a) application, a response to an Office action is due within six months of the date on which the USPTO sends the action to the IB, not the date on which the refusal is processed by the IB. See §1904.02(h) for further information about issuing Office actions in §66(a) applications.

To expedite processing, the USPTO recommends that responses to Office actions be filed through TEAS, at <http://www.uspto.gov>.

Filing an amendment to allege use does not extend the deadline for filing a response to an outstanding Office action, appeal to the Board, or petition to the Director. 37 C.F.R. §2.64(c)(1); TMEP §1104.

See TMEP §310 for information about computing the response period; TMEP §§305.02 and 306.05 for certificate of mailing and certificate of facsimile transmission procedures to avoid lateness; and TMEP §§718.02 and 718.03 *et seq.* regarding abandonment for failure to respond or incomplete response to an Office action.

711.01 Time May Run from Previous Action

In most cases, the six-month statutory period to respond to an Office action runs from the issuance date of the Office action. In some situations, the

examining attorney's Office action does not re-start the beginning of a statutory response period. For example, a notice that an applicant's response was incomplete (see TMEP §§718.03 *et seq.*), or a notice that an applicant's request for reconsideration of a final action fails to overcome a refusal or satisfy an outstanding requirement (see TMEP §§715.03(a) and (c)), does not begin a new response period. In all cases where the statutory response period runs from the date of a previous Office action, the examining attorney must include a statement to that effect in the Office action, and must omit the six-month response clause.

711.02 Supplemental Office Action Resetting Response Period

Sometimes the examining attorney must issue a supplemental Office action that resets the six-month statutory period for response. If the examining attorney discovers after issuing an action that a refusal or requirement that should have been raised was overlooked, the examining attorney must issue a supplemental Office action addressing the issue and resetting the period for response. See TMEP §706. The examining attorney must also issue a supplemental Office action if a new issue arises after the issuance date of a previous Office action (e.g., during examination of an amendment to allege use).

If the examining attorney issues a supplemental Office action, a new six-month response period will begin running from the issuance date of the supplemental action. 15 U.S.C. §1062(b). In a supplemental Office action, the examining attorney should: (1) indicate that the action is supplemental to and supersedes the previous action; (2) incorporate all outstanding issues by reference to the previous action; and (3) include the standard six-month response clause.

In a §66(a) application, the examining attorney cannot issue a new refusal more than 18 months after the date on which the IB forwards the request for extension of protection to the USPTO. See TMEP §1904.03(a).

See TMEP §§717 *et seq.* regarding reissuing of Office actions.

712 Signature on Response to Office Action

A response to an Office action must be personally signed by the individual applicant, someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner of a partnership), or a qualified practitioner. 37 C.F.R. §§2.62(b), 2.193(e)(2), and 11.18(a). The examining attorney must review the application record to determine whether the applicant is represented by a qualified practitioner, and must ensure that all responses and amendments are properly signed. See TMEP §§611.03(b) and 712.02 regarding the proper person to sign, and TMEP §§611.06 *et seq.* as to persons who have legal authority to bind various types of juristic entities.

The signatory must personally sign his or her name. In a document filed through TEAS, the person identified as the signer must manually enter the elements of the electronic signature. See TMEP §611.01(b).

The name of the person who signs the response should be set forth in printed or typed form immediately below or adjacent to the signature, or identified elsewhere in the filing (e.g., in a cover letter or other document that accompanies the filing). See TMEP §611.01(b).

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

712.01 Persons Who May Sign Response

The examining attorney must ensure that the record establishes the authority of the persons who signs the response. Under 5 U.S.C. §500(d) and 37 C.F.R. §§2.193(e)(2) and 11.14(e), non-attorneys may not sign responses to Office actions or otherwise represent a party in a trademark proceeding before the USPTO. 37 C.F.R. §11.5(b)(2); TMEP §608.01. See TMEP §§602 *et seq.* regarding persons who are authorized to represent others before the USPTO, and TMEP §611.04 for examples of authorized and potentially unauthorized signatories.

If an applicant is represented by a qualified practitioner, the practitioner must personally sign the response. 37 C.F.R. §§2.193(e)(2)(i) and 11.18(a). This applies to both in-house and outside counsel.

If the applicant or registrant is not represented by a qualified practitioner, the individual applicant or someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner of a partnership) must sign the response. 37 C.F.R. §2.62(b) and §2.193(e)(2)(ii). In the case of joint applicants who are not represented by a qualified practitioner, all must sign the response. See TMEP §§611.06 *et seq.* for guidelines as to persons who have legal authority to bind various types of juristic entities. A person who is authorized to verify facts on behalf of an applicant under 37 C.F.R. §2.193(e)(1) is *not* entitled to sign responses to Office actions, unless he or she also has legal authority to bind the applicant or is a qualified practitioner.

Example: A corporate manager might have the firsthand knowledge and implied authority to act on behalf of the applicant required to verify facts under 37 C.F.R. §2.193(e)(1) and still not have legal authority to bind the applicant.

If the applicant is represented by a qualified practitioner, and the response consists only of a declaration (e.g., if the verification was omitted from the initial application and no other issues were raised in the Office action), the response may be signed by a person authorized to verify facts on behalf of an applicant under 37 C.F.R. §2.193(e)(1) (see TMEP §804.04), and no separate signature by the practitioner is required. However, if the response includes a

verification and also contains legal arguments or amendments, the response must be signed by the practitioner.

Similarly, if the applicant is *pro se* (i.e., is not represented by a qualified practitioner), and the response consists only of a declaration, the response may be signed by a person authorized to verify facts on behalf of an applicant under 37 C.F.R. §193(e)(1), and no separate signature by someone with legal authority to bind the applicant is required. However, if the response includes a verification and also contains legal arguments or amendments, the response must be signed by the individual applicant or someone with legal authority to bind a juristic applicant. 37 C.F.R. §§2.62(b), 2.74(b), and 2.193(e)(2).

If a response to an Office action appears to be signed by an unauthorized person (e.g., a foreign attorney who is not licensed to practice before the USPTO or a corporate employee who does not have legal authority to bind the applicant), the examining attorney must treat the response as incomplete and require the applicant to submit a properly signed response. The response cannot be ratified by an examiner's amendment. See TMEP §§608.01, 611.05 *et seq.*, and 712.03 for further information.

These same principles apply to authorizations of examiner's amendments and priority actions. See TMEP §§707.01 and 708.02.

712.02 Unsigned Response

The examining attorney should treat an unsigned response as an incomplete response, and should either call the applicant to obtain permission to enter an examiner's amendment from an authorized party (if appropriate), or issue a notice of incomplete response granting the applicant additional time to perfect the response, pursuant to 37 C.F.R. §2.65(b). See TMEP §718.03(b). If the response does not require a verification that must be signed by the applicant (see TMEP §§804 *et seq.*), the applicant, a person with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner of a partnership), or the applicant's qualified practitioner, may either request that the amendment(s) be entered through an examiner's amendment, or submit a properly signed copy of the response. If the response requires a verification that must be signed by the applicant, the applicant must submit a signed verification. A duplicate of the original response can be submitted through TEAS (using the response to Office action form) or a properly signed copy of the original document can be submitted by fax (unless it is excluded by 37 C.F.R. §2.195(d)). The examining attorney must defer action on the merits of the response until the applicant files a properly signed response. In a TEAS Plus application, the applicant must file the response through TEAS, or the applicant will lose TEAS Plus status (see TMEP §819.02(b)).

The substitute response must be personally signed by the individual applicant, someone with legal authority to bind a juristic applicant (e.g., a

corporate officer or general partner of a partnership), or a qualified practitioner. 37 C.F.R. §§2.62(b), 2.193(e)(2), and 11.18(a). See TMEP §§611.03(b) and 712.02 for further information about the proper party to sign.

If an applicant fails to submit a properly signed response within the time granted under 37 C.F.R. §2.65(b), the examining attorney must hold the application abandoned for failure to file a complete response. See TMEP §718.03(a). In this situation, the applicant cannot file a petition to revive under 37 C.F.R. §2.66. The applicant's recourse is to file a petition to the Director to reverse the examining attorney's holding of abandonment under 37 C.F.R. §2.146. See TMEP §1713.01.

712.03 Response Signed by an Unauthorized Person

Notice of Incomplete Response. A response to an Office action must be personally signed by the individual applicant, someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner of a partnership), or a qualified practitioner (see TMEP §§602 *et seq.*). 37 C.F.R. §§2.62(b), 2.193(e)(2), and 11.18; TMEP §§611.03(b) and 712.02. When it appears that a response to an Office action was signed by an improper party (e.g., a foreign attorney who is not licensed to practice before the USPTO or a corporate employee who does not have legal authority to bind the applicant), the examining attorney must treat the response as incomplete. The examining attorney must issue a notice of incomplete response granting the applicant additional time to perfect the response, pursuant to 37 C.F.R. §2.65(b) (see TMEP §718.03(b)), and send the notice to the correspondence address of record. See TMEP §611.05(a). The examining attorney should defer action on the merits of the response until a properly signed response is filed.

Applicant's Reply to Notice of Incomplete Response. If the person who signed the response was authorized to sign, the applicant's reply to the notice of incomplete response should state the nature of the relationship of the signer to the applicant. If the signer has legal authority to bind the applicant, the person should so state, and should set forth his or her title or position. If the signer is an attorney authorized to practice before the USPTO pursuant to 37 C.F.R. §11.14(a), the attorney should identify him or herself as an attorney and indicate the United States state bar of which he or she is a member in good standing. If the signer meets the requirements of either 37 C.F.R. §11.14(b) or §11.14(c), the person should explain how he or she meets these requirements. See TMEP §611.05(b) for further information.

If the person who signed the response is not an authorized signer, and all proposed amendments in the improperly signed response can be resolved by an examiner's amendment, the individual applicant or a person with legal authority to bind a juristic applicant may telephone the examining attorney to authorize such an amendment. Otherwise, the applicant must submit a

response signed by the applicant or someone with legal authority to bind the applicant (see TMEP §§712.01 *et seq.*), or by a qualified practitioner. This should be done through TEAS (using the response to Office action form), or may be done by fax (unless it is excluded by 37 C.F.R. §2.195(d)). In a TEAS Plus application, the applicant must file the response through TEAS, or the applicant will lose TEAS Plus status (see TMEP §819.02(b)). See TMEP §611.01(c) regarding signature of documents submitted through TEAS. When a response is signed by an unauthorized party, it is not acceptable for the applicant to ratify the response through an examiner's amendment.

Unsatisfactory Response or No Response. If no acceptable response is received within the time granted under 37 C.F.R. §2.65(b), the examining attorney must hold the application abandoned for failure to file a complete response. See TMEP §718.03(a). In this situation, the applicant cannot file a petition to revive under 37 C.F.R. §2.66. The applicant's recourse is to file a petition to the Director to reverse the examining attorney's holding of abandonment under 37 C.F.R. §2.146. See TMEP §1713.01.

713 Examination of Amendments and Responses to Office Actions

37 C.F.R. §2.63. Reexamination.

(a) After response by the applicant, the application will be reexamined or reconsidered. If registration is again refused or any formal requirement[s] is repeated, but the examiner's action is not stated to be final, the applicant may respond again.

(b) After reexamination the applicant may respond by filing a timely petition to the Director for relief from a formal requirement if: (1) The requirement is repeated, but the examiner's action is not made final, and the subject matter of the requirement is appropriate for petition to the Director (see §2.146(b)); or (2) the examiner's action is made final and such action is limited to subject matter appropriate for petition to the Director. If the petition is denied, the applicant shall have until six months from the date of the Office action which repeated the requirement or made it final or thirty days from the date of the decision on the petition, whichever date is later, to comply with the requirement. A formal requirement which is the subject of a petition decided by the Director may not subsequently be the subject of an appeal to the Trademark Trial and Appeal Board.

The examining attorney will consider the applicant's response and will determine whether the mark may be approved for publication or registration. The examining attorney must carefully consider all arguments, comments, and amendments made or proposed by the applicant.

If the applicant's response has put the application in condition for approval for publication for opposition or registration on the Supplemental Register, the

examining attorney will approve the application for publication or registration, as appropriate.

If the applicant's response has not put the application in condition for publication or registration, the examining attorney will issue an Office action, or telephone or e-mail the applicant, depending on the circumstances.

If the applicant's response does not present any new issues, and the applicant has had an opportunity to reply to all points raised by the examining attorney, the examining attorney's next action should be stated to be final. See TMEP §§714 *et seq.*

If the examining attorney has cited an earlier-filed conflicting application, and the applicant responds by arguing that there is no likelihood of confusion, the examining attorney should suspend the application pending disposition of the conflicting application, if applicant's arguments are not persuasive. See TMEP §716.02(c) regarding suspension pending disposition of an earlier-filed conflicting application, TMEP §716.03 regarding the applicant's request to remove an application from suspension, and TMEP §§1208 *et seq.* regarding conflicting marks in pending applications.

713.01 Previous Action by Different Examining Attorney

When assigned to act on an application that was previously handled by a different examining attorney, the examining attorney should act consistently with the examining attorney who handled the earlier-filed application, unless it would be clear error (see TMEP §706.01) to act consistently.

713.02 Noting All Outstanding Refusals or Requirements

When acting on an amendment or response to an Office action, the examining attorney must note all outstanding refusals or requirements in every Office action. The examining attorney must indicate whether particular refusals or requirements are withdrawn or maintained, and whether the applicant's response is acceptable, where appropriate.

To prevent any misunderstanding, every refusal or requirement in the prior action that is still outstanding must be referenced in any subsequent action. Even when suspending action on an application, the examining attorney must note all outstanding refusals or requirements. While this is done as a courtesy to prevent any misunderstanding, a refusal or requirement issued in a previous action remains in effect unless the examining attorney specifically indicates that it has been withdrawn. If an examining attorney issues an Office action that does not mention an outstanding refusal or requirement that was raised in a previous action, the refusal or requirement may be made final in a subsequent action, if the application is otherwise in condition to be made final.

713.03 Response to Applicant's Arguments

When the applicant submits arguments attempting to overcome a refusal or requirement, the examining attorney must respond to the applicant's arguments.

In response to a refusal under §2(d), 15 U.S.C. §1052(d), the applicant may respond that the cited registration should be cancelled because the registrant has not filed the required maintenance documents.

The examining attorney must not withdraw a refusal of registration under §2(d) until the TRAM system shows that the registration has actually been cancelled or expired. To allow ample time for processing of timely filed post-registration maintenance documents, the USPTO waits until 30 days *after* the expiration of the grace period before updating its records to show that the registration is cancelled or expired.

If the examining attorney determines that 30 days have passed since the expiration of the grace period, but the TRAM system does not indicate that the registration has been cancelled or expired, the examining attorney should contact the Supervisor of the Post Registration Section and request that the database be updated to show that the registration is cancelled or expired.

714 Final Action

37 C.F.R. §2.64. Final action.

(a) On the first or any subsequent reexamination or reconsideration the refusal of the registration or the insistence upon a requirement may be stated to be final, whereupon applicant's response is limited to an appeal, or to a compliance with any requirement, or to a petition to the Director if permitted by §2.63(b).

(b) During the period between a final action and expiration of the time for filing an appeal, the applicant may request the examiner to reconsider the final action. The request 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 qualified to practice under §11.14, in accordance with the requirements of §2.193(e)(2). The filing of a request for reconsideration will not extend the time for filing an appeal or petitioning the Director, but normally the examiner will reply to a request for reconsideration before the end of the six-month period if the request is filed within three months after the date of the final action. The Office will enter amendments accompanying requests for reconsideration after final action if the amendments comply with the rules of practice in trademark cases and the Act.

(c)(1) If an applicant in an application under section 1(b) of the Act files an amendment to allege use under §2.76 during the six-month response period after issuance of a final action, the examiner shall examine the amendment.

The filing of an amendment to allege use does not extend the deadline for filing a response to an outstanding Office action, appeal to the Trademark Trial and Appeal Board, or petition to the Director.

(2) If the amendment to allege use under §2.76 is acceptable in all respects, the applicant will be notified of its acceptance.

(3) If, as a result of the examination of the amendment to allege use under §2.76, the applicant is found not entitled to registration for any reason not previously stated, applicant will be notified and advised of the reasons and of any formal requirements or refusals. The Trademark Examining Attorney shall withdraw the final action previously issued and shall incorporate all unresolved refusals or requirements previously stated in the new non-final action.

714.01 Not Permissible on First Action

A first action by an examining attorney may not be a final action. An applicant is entitled to at least one opportunity to reply to any issue raised by the examining attorney.

714.02 Not Permissible on Suspension

A letter of suspension cannot be made final. See TMEP §§716 *et seq.* regarding suspension.

714.03 When Final Action is Appropriate

Final action is appropriate when a clear issue has been developed between the examining attorney and the applicant, i.e., the examining attorney has previously raised all outstanding issues and the applicant has had an opportunity to respond to them.

For a second action to be made final, all requirements or refusals must have been made in the first action. No refusal or requirement may be made final, even if it is a repeated refusal or requirement, unless the entire action is made final. Thus, if the examining attorney makes a new refusal or requirement in a second or subsequent action, a repeated refusal or requirement may not be made final.

In a §44(d) application, the examining attorney may not issue a final action until the applicant submits a copy of the foreign registration. When the application is otherwise in condition for final refusal, the examining attorney must suspend action on the application pending receipt of a copy of the foreign registration. The notice of suspension must indicate all outstanding refusals or requirements that will be made final upon receipt of the foreign registration if no new issues are raised. See TMEP §§716.02(b) and 1003.04(b).

Second actions should be final actions whenever possible. While an applicant is entitled to a full and fair hearing, it is in the interest of the public that prosecution be limited to as few actions as is consistent with proper examination. Neither the Act nor the rules of practice give an applicant the right to an extended prosecution.

See TMEP §§714.05 *et seq.* for further discussion of when an examining attorney should issue a nonfinal action rather than a final action, and TMEP §714.06 regarding final actions that are premature.

714.04 Form of the Final Action

When making an action final, the examining attorney must restate any requirements or refusals that remain outstanding, and must cite the rule(s) and/or statute(s) that provide the basis for these refusals or requirements. The examining attorney should place all evidence in support of his or her refusal in the record at the time the final action is issued.

The final action should include a clear and unequivocal statement that the refusal or requirement is final. When there is more than one ground set out as the basis for the final action, the action may conclude with a paragraph containing wording such as “This action is made FINAL” or “This is a FINAL action,” which covers all grounds.

The final action must also mention any refusals or requirements that have been withdrawn. See TMEP §713.02.

The examining attorney must include a statement that the only proper response to a final action is an appeal to the Board (or a petition to the Director, if permitted under 37 C.F.R. §2.63(b)), or compliance with the outstanding requirement(s). 37 C.F.R. §2.64(a).

A final action must include a six-month response clause (see TMEP §705.08) so that it is clear that the applicant must file a timely response to avoid abandonment of the application.

714.05 Delineating New Issues Requiring Issuance of Nonfinal Action

It is sometimes difficult to determine what constitutes a new issue requiring a new nonfinal action, rather than a final action, after receipt of a response. See TMEP §§714.05(a) through 714.05(f) regarding the propriety of issuing a final action in specific situations, and TMEP §§715.03(b) and 715.04(b) regarding new issues presented in a request for reconsideration of an examining attorney's final action.

In a §66(a) application, the examining attorney cannot issue a new refusal more than 18 months after date on which the IB forwards the request for extension of protection to the USPTO. See TMEP §1904.03(a).

714.05(a) Unacceptable Amendment Proposed By Applicant

Generally, an unacceptable amendment raises a new issue requiring a new nonfinal action, unless the amendment is a direct response to a previous requirement.

If an amendment is not offered in direct response to a requirement, and the amendment is not acceptable, the examining attorney generally must issue a new nonfinal action with a six-month response clause, addressing the issues raised by the amendment and continuing all other refusals and requirements. The following are examples of amendments that would require a new nonfinal action:

- (1) Amendments to the drawing, unless the examining attorney had previously required that the drawing be amended;
- (2) Amendments to the Supplemental Register and amendments to assert acquired distinctiveness under 15 U.S.C. §1052(f), unless the amendment is irrelevant to an outstanding refusal (see TMEP §714.05(a)(i));
- (3) Amendments to disclaim the entire mark (see TMEP §1213.06);
- (4) Amendments to the drawing that materially alter the mark, if the examining attorney had required a new drawing because the original drawing was of poor quality that could not be reproduced, but had not previously raised the issue of material alteration. See TMEP §714.05(c) regarding advisory statements.

However, evidence or amendments that are merely cumulative and are not significantly different from material previously submitted do *not* raise a new issue that requires the examining attorney to issue a nonfinal action. See *In re GTE Education Services*, 34 USPQ2d 1478 (Comm'r Pats. 1994) (examining attorney properly determined that no new issue had been raised in request for reconsideration of final refusal based on inadequate specimens, where the substitute specimens submitted with the request were deficient for same reason as the original specimens). Generally, the examining attorney may issue a final action if the same refusal or requirement was made before.

714.05(a)(i) Amendment to Supplemental Register or Submission of Claim of Acquired Distinctiveness

If registration is refused under §2(e)(1), §2(e)(2), or §2(e)(4) of the Trademark Act, 15 U.S.C. §1052(e)(1), §1052(e)(2), or §1052(e)(4), or on grounds

pertaining to other non-inherently distinctive subject matter (e.g., product or container configurations (see TMEP §§1202.02(b)(i) and (ii)), color marks (see TMEP §§1202.05 *et seq.*), or marks that comprise matter that is purely ornamental (see TMEP §§1202.03 *et seq.*)), an amendment to the Supplemental Register or to claim acquired distinctiveness under 15 U.S.C. §1052(f) presents a new issue. This is true even if the examining attorney previously issued an *advisory* statement indicating that the examining attorney believed the mark to be unregistrable on the Supplemental Register or under §2(f).

If the examining attorney determines that the amendment does not overcome the refusal, the examining attorney should issue a new nonfinal refusal of registration with a six-month response clause. See TMEP §816.04 regarding refusal of registration after an amendment to the Supplemental Register, and TMEP §1212.02(h) regarding refusal of registration after an applicant submits a claim of acquired distinctiveness under §2(f).

However, if the amendment is irrelevant to an outstanding refusal, the examining attorney may issue a final refusal or requirement. For example, if registration is refused under §2(a) (see TMEP §§1203 *et seq.*), §2(b) (see TMEP §1204), §2(d) (see TMEP §§1207 *et seq.*), §2(e)(3) (see TMEP §1210.01(b)), or §2(e)(5) (see TMEP §§1202.02(a) *et seq.*) of the Trademark Act, an amendment to the Supplemental Register or a claim of distinctiveness under §2(f) does *not* raise a new issue, and the examining attorney may issue a final refusal. See *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1696 (TTAB 1992) (amendment to the Supplemental Register in response to a refusal of registration under §2(a) does not raise a new issue). Likewise, in a §66(a) application, an amendment to the Supplemental Register does not raise a new issue, because a mark in a §66(a) application is not eligible for registration on the Supplemental Register. Section 68(a)(4) of the Trademark Act, 15 U.S.C. §1141h(a)(4). Thus, an amendment to the Supplemental Register cannot overcome the refusal.

Exception: An amendment to the Supplemental Register in a §1(b) application for which no allegation of use has been filed does raise a new issue, because the examining attorney must 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. 37 C.F.R. §2.75(b); TMEP §1102.03. In this situation, if the applicant files a proper amendment to allege use or statement of use, the examining attorney will consider the amendment to the Supplemental Register.

See TMEP §§715.03(b) and 715.04(b) regarding new issues presented in a request for reconsideration of an examining attorney's final action.

714.05(a)(ii) Amendment of Identification of Goods/Services

If the applicant responds to a nonfinal Office action requiring an amendment to the identification of goods/services, and the examining attorney determines that the identification is still unacceptable, generally the examining attorney must issue a final requirement to amend the identification of goods/services. There are only two exceptions to this rule:

- (1) If the amended identification is broader in scope than the original identification, *and* the prior Office action failed to advise the applicant that amendments broadening the identification are prohibited under 37 C.F.R. §2.71(a), the examining attorney cannot issue a final Office action.
- (2) If the amended identification sets forth goods/services in multiple classes, but the applicant has not submitted all the requirements for a multiple-class application (e.g., specimens and fees for all classes), *and* the prior Office action failed to advise the applicant that the missing elements were required, the examining attorney cannot issue a final Office action. See TMEP §§1403 *et seq.* regarding multiple-class applications.

If the examining attorney issues a *nonfinal* action requiring amendment of the identification because it is indefinite, and the applicant responds with an amended identification that is definite, but is otherwise unacceptable (e.g., because it includes a registered trademark or service mark (see TMEP §1402.09)), this is not considered a new issue, and the examining attorney must issue a final Office action requiring amendment of the identification.

However, if the examining attorney issues a *final* action requiring amendment of the identification because it is indefinite, and the applicant responds with an amended identification that is definite but is otherwise unacceptable (e.g., because it includes a registered mark), the examining attorney should treat the response as incomplete, and grant the applicant additional time to cure this deficiency, pursuant to 37 C.F.R. §2.65(b). See TMEP §718.03(b) for further information about granting an applicant additional time to perfect an incomplete response. *Examining attorneys are encouraged to try to resolve these issues by examiner's amendment.*

714.05(b) Section 2(d) Refusal Based on Earlier-Filed Application That Has Matured Into Registration

The examining attorney must issue a new nonfinal action when first refusing registration under §2(d) of the Trademark Act, 15 U.S.C. §1052(d), even if the applicant had been advised of the existence of an earlier-filed application before it matured into the registration on which the refusal is based.

In a §66(a) application, a new nonfinal refusal under §2(d) of the Act may be issued more than 18 months after the date on which the IB forwards the request for extension of protection to the USPTO, provided that the USPTO had notified the IB of the conflicting application prior to expiration of the 18-month period.

714.05(c) Advisory Statement Cannot Serve as Foundation for Final Refusal or Requirement

Except as provided in TMEP §714.05(a)(ii), an advisory statement in an Office action indicating that a refusal or requirement will be issued if specified circumstances arise cannot serve as the foundation for issuing a final requirement or refusal in the next action. To establish the foundation for issuing a final refusal or requirement in the next Office action, an initial requirement or refusal must relate to matter that is of record at the time of the action.

714.05(d) Submission of Consent Agreement or Assertion of Unity of Control in Response to §2(d) Refusal

Consent Agreement. If an applicant files a consent agreement in response to a *nonfinal* refusal under §2(d) of the Trademark Act, and the examining attorney finds the consent agreement insufficient to overcome the refusal, the examining attorney should issue a final refusal, assuming the application is otherwise in condition for final refusal.

If an applicant files an executed consent agreement in response to a *final* refusal under §2(d) of the Trademark Act, and the examining attorney finds the consent agreement insufficient to overcome the refusal, the examining attorney should issue a *new final* refusal, i.e., an “Examiner’s Subsequent Final Refusal,” with a six-month response clause. However, the examining attorney should not issue a subsequent final refusal if the applicant merely states that it is negotiating a consent agreement.

Assertion of Unity of Control. If an applicant asserts unity of control (see TMEP §§1201.07 *et seq.*) in response to a *nonfinal* refusal under §2(d), and the examining attorney determines that unity of control has not been established, the examining attorney should issue a final refusal, assuming that the application is otherwise in condition for final refusal.

If an applicant asserts unity of control in response to a *final* refusal under §2(d), and the examining attorney determines that unity of control has not been established, the examining attorney should issue an “Examiner’s Subsequent Final Refusal,” with a six-month response clause.

714.05(e) Submission of Substitute Specimen in Response to Refusal for Failure to Show Use of the Mark in Commerce

If an applicant submits a substitute specimen in response to a *nonfinal* refusal under §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127 (for trademarks), or §§1, 2, 3, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, 1053, and 1127 (for service marks), and unlike in the original specimen, the mark on the substitute specimen now does not agree with the mark on the drawing (see TMEP §807.12), but the specimen would otherwise be acceptable to show use in connection with the goods/services, the examining attorney may allow the applicant to amend the drawing if such an amendment would not constitute a material alteration of the mark. If any remaining issues can be handled by examiner's amendment, and the mark is a standard character mark, the examining attorney may give the applicant the option to amend the drawing by examiner's amendment. If not, the examining attorney must issue a final refusal that also gives the applicant the option to overcome the refusal by submitting a substitute drawing.

If an amendment of the drawing would be a material alteration, the examining attorney must issue a final refusal, assuming the application is otherwise in condition for final refusal, because the substitute specimen does not present a new issue. The underlying basis for refusal, i.e., that the applicant has not provided evidence of use of the applied-for mark in commerce, remains the same.

See TMEP §904.07(a) for further information about refusal of registration on the ground that the specimen does not show the mark used in commerce.

714.05(f) Submission of Substitute Specimen in Response to Refusal for Failure to Show the Applied-For Mark Functioning as a Mark

If an applicant submits a substitute specimen in response to a *nonfinal* refusal under §§1 and 45 of the Trademark Act, and unlike in the original specimen, the mark on the substitute specimen now does not agree with the mark on the drawing (see TMEP §807.12), but the specimen would otherwise be acceptable to identify the goods/services of the applicant and indicate the source of those goods/services, the examining attorney may allow the applicant to amend the drawing if such an amendment would not constitute a material alteration of the mark. If any remaining issues can be handled by examiner's amendment, and the mark is a standard character mark, the examining attorney may give the applicant the option to amend the drawing by examiner's amendment. If not, the examining attorney must issue a final refusal that also gives the applicant the option to overcome the refusal by submitting a substitute drawing.

If an amendment of the drawing would be a material alteration, the examining attorney must issue a final refusal, assuming the application is otherwise in condition for final refusal, because the substitute specimen does not present a new issue. The underlying basis for refusal, i.e., that the applicant has not provided evidence of use of the applied-for mark as a trademark or service mark, remains the same.

See TMEP §904.07(b) for further information about refusal of registration on the ground that the specimen does not show the applied-for mark functioning as a mark.

714.06 Applicant’s Recourse When Final Action is Premature

If an applicant believes that a refusal to register or a requirement has been made final prematurely, the applicant must raise the issue while the application is still pending before the examining attorney. It is not a ground for appeal to the Trademark Trial and Appeal Board. TBMP §1201.02. The applicant may raise the matter by filing a request for reconsideration with the examining attorney, or by contacting the managing attorney or senior attorney in the examining attorney’s law office. If the examining attorney does not withdraw the finality, the applicant may file a petition to the Director under 37 C.F.R. §2.146. See TMEP Chapter 1700 regarding petitions.

If, on request for reconsideration, the examining attorney finds the final action to have been premature, the examining attorney should issue a new nonfinal action with a six-month response clause.

715 Action After Issuance of Final Action

715.01 Proper Response to Final Action

An applicant must respond to a final action within six months of the issuance date. 15 U.S.C. §1062(b); 37 C.F.R. §2.62(a).

In general, the only proper response to a final action is a notice of appeal to the Board, a petition to the Director if permitted under 37 C.F.R. §2.63(b)(2), or compliance with an outstanding requirement. 37 C.F.R. §2.64(a).

After a final refusal to register on the Principal Register, an amendment requesting registration on the Supplemental Register or registration on the Principal Register under §2(f) of the Trademark Act may be a proper response in some circumstances. See TMEP §§714.05(a)(i), 816.04 and 1212.02(h).

715.02 Action After Final Action

Once an action has been properly made final, the examining attorney normally should not change his or her position. However, this does not mean

that an applicant's amendment or argument will not be considered after final action. An amendment may be accepted and entered if it places the application in condition for publication or registration, or will put the application in better form for appeal (i.e., reduce the issues on appeal). For example, an amendment requesting registration on the Supplemental Register or on the Principal Register under §2(f) may be a proper response to a final refusal of registration on the Principal Register in some circumstances. See TMEP §§714.05(a)(i), 816.04, and 1212.02(h).

If the examining attorney believes that an examiner's amendment (see TMEP §§707 *et seq.*) will immediately put the application in condition for publication or registration, or reduce the issues on appeal, the examining attorney should issue an examiner's amendment.

If the applicant files a response that complies with all outstanding requirements and overcomes all outstanding refusals, the examining attorney should approve the application for publication or registration, as appropriate.

The applicant may request reconsideration after final action, within six months of the issuance date of the final action. However, filing a request for reconsideration does *not* extend the time for filing a notice of appeal to the Board or petition to the Director under 37 C.F.R. §2.63(b)(2). 37 C.F.R. §2.64(b).

See TMEP §716.06 regarding suspension after final action.

715.03 Request for Reconsideration After Final Action

Under 37 C.F.R. §2.64(b), the applicant may file a request for reconsideration before the deadline for filing an appeal to the Board.

However, filing a request for reconsideration does *not* extend the deadline for filing a notice of appeal or petition to the Director under 37 C.F.R. §2.63(b)(2). 37 C.F.R. §2.64(b); TMEP §715.03(c). The USPTO cannot extend the statutory deadline for filing an appeal. 15 U.S.C. §1062(b); 37 C.F.R. §2.142(a). Therefore, if an applicant files a request for reconsideration of a final action and wants to preserve the right to appeal if the request is unsuccessful, the applicant must file a notice of appeal (with the fee required by 37 C.F.R. §2.6) before the expiration of the six-month period for response to the final action, or the application will be abandoned. See TMEP §§715.04 *et seq.* for information about processing a request for reconsideration filed with a notice of appeal. If the request for reconsideration is unsuccessful, and the applicant has not timely filed a notice of appeal, the application will be abandoned for incomplete response. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a).

The examining attorney should construe any document filed after final action that responds to the outstanding refusals or requirements as a request for

reconsideration. If the request for reconsideration does not overcome or resolve all outstanding refusals and requirements, the examining attorney must issue a written action that advises the applicant of the status of the application. The Office action should discuss any new evidence submitted with a request for reconsideration.

Regardless of whether an applicant submits new evidence with a request for reconsideration, the examining attorney may introduce additional evidence directed to the issue(s) for which reconsideration is sought. TBMP §1207.04. See *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198 (TTAB 2009); *In re Giger*, 78 USPQ2d 1405 (TTAB 2006). If the evidence is significantly different from the evidence currently of record, the examining attorney must issue a new final refusal, i.e., an “Examiner’s Subsequent Final Refusal,” with a six-month response clause.

In determining the appropriate action to take upon receipt of a request for reconsideration, the examining attorney must determine whether: (1) the applicant has timely filed a notice of appeal; and (2) the request for reconsideration presents a new issue. See TMEP §§715.03(a), 715.03(b), and 715.04 *et seq.* for further information as to how examining attorneys should handle requests for reconsideration.

715.03(a) Examining Attorney’s Action When No New Issue is Presented in Request for Reconsideration and No Notice of Appeal Has Been Filed

If the request for reconsideration convinces the examining attorney that a refusal or requirement should be withdrawn, the examining attorney may withdraw the refusal or requirement and approve the application for publication or registration, if it is in condition for such action.

If the examining attorney is not persuaded by the request for reconsideration and there is no time remaining in the response period, the application should be abandoned for incomplete response. If there is time remaining in the response period, the examining attorney must issue an Office action using the “Request for Reconsideration Denied – No Appeal Filed - Time Remaining” (or, if appropriate, “SU - Request for Reconsideration Denied – No Appeal Filed - Time Remaining”) selection that: (1) acknowledges the request for reconsideration; (2) indicates that it is denied and explains why it does not overcome or resolve the final refusal; (3) states that the final refusal is maintained; and (4) advises the applicant that the time for appeal runs from the issuance date of the final Office action. The examining attorney should advise the applicant that the applicant has the remainder of the response period to comply with any outstanding requirement and/or to file a notice of appeal to the Board. The Office action must *not* include a six-month response clause (see TMEP §705.08).

If the applicant has submitted a timely response, but there are fewer than thirty days remaining in the six-month response period, or there is no time remaining in the six-month response period, and the applicant has made a good-faith but incomplete attempt to comply with all outstanding requirements and to overcome all outstanding refusals, the examining attorney has discretion under 37 C.F.R. §2.65(b) to issue an Office action using the “Examiner’s Action Continuing Final Refusal – 30 day Letter” selection that gives the applicant additional time to resolve the matters that remain outstanding. See TMEP §718.03(b). The Office action must *not* include a six-month response clause. This additional time should be granted *only* if the record indicates that the applicant can place the application in condition for approval by completing the response. If the examining attorney believes that an examiner’s amendment (see TMEP §§707 *et seq.*) will immediately put the application in condition for publication or registration, the examining attorney should attempt to contact the applicant to obtain authorization to issue an examiner’s amendment.

Unsigned Responses and TEAS Responses Consisting Only of a Signature. If an examining attorney receives an unsigned response to a final action or a TEAS response to a final action that consists only of a signature, the examining attorney should not hold the application abandoned for failure to respond completely. Instead, the examining attorney must issue an Office action using the “Examiner’s Action Continuing Final Refusal – 30 day Letter” selection that gives the applicant additional time to complete the response, with an appropriate explanation. Granting additional time to complete a response under 37 C.F.R. §2.65(b) does not extend the deadline for filing an appeal to the Board (or petition to the Director under 37 C.F.R. §2.63(b)(2), if appropriate). See 15 U.S.C. §1062(b); 37 C.F.R. §2.142(a).

If, after being afforded additional time, the applicant then fails to submit a complete response (or a request for reconsideration) that resolves all outstanding issues within the time granted under 37 C.F.R. §2.65(b), the examining attorney must hold the application abandoned for failure to file a complete response. Thus, after providing the applicant *one* opportunity to perfect, if the applicant fails to do so within the six-month period (or the additional 30 days), the examining attorney must then follow the standard procedure regarding incomplete responses.

If the examining attorney denies the request for reconsideration and holds the application abandoned for incomplete response, the applicant may file a petition to the Director under 37 C.F.R. §2.146 to reverse the examining attorney’s holding of abandonment. However, the Director will reverse the examining attorney’s action on petition only if there is clear procedural error or abuse of discretion (see TMEP §706.01). *In re GTE Education Services*, 34 USPQ2d 1478 (Comm’r Pats. 1994); *In re Legendary Inc.*, 26 USPQ2d 1478 (Comm’r Pats. 1992). See TMEP §1713.01. The unintentional delay

standard of 37 C.F.R. §2.66 does not apply in this situation. See TMEP §1714.01(f)(ii).

715.03(b) Examining Attorney’s Action When New Issue or New Evidence is Presented in Request for Reconsideration and No Notice of Appeal Has Been Filed

If the request for reconsideration includes an amendment that presents a new issue, whether related to the final refusal or not, the examining attorney must issue a nonfinal action with a six-month response clause that addresses the new issue and maintains the final refusal or a new final action (i.e., an “Examiner’s Subsequent Final Refusal”), if appropriate. For example, in the case of an amendment to the Supplemental Register or an amendment that asserts a claim of acquired distinctiveness under §2(f) for the first time, but fails to place the application in condition for approval, the examining attorney should issue a nonfinal action. See TMEP §714.05(a)(i).

Whenever the examining attorney issues a new *nonfinal* action after review of an applicant’s request for reconsideration, the Office action should explain that the applicant must respond to all requirements or refusals within six months of the issuance date of the action, but that the applicant should not file an appeal to the Board because an appeal would be premature under 15 U.S.C. §1070 and 37 C.F.R. §2.141(a). If the applicant’s response does not resolve all outstanding requirements or refusals and put the application in condition for publication or registration on the Supplemental Register, the examining attorney must issue an “Examiner’s Subsequent Final Refusal” with a six-month response clause. This provides the applicant the opportunity to file an appeal.

Evidence or amendments that are merely cumulative and are not significantly different from material previously submitted do *not* raise a new issue that requires the examining attorney to issue a new final or nonfinal action. *In re GTE Education Services*, 34 USPQ2d 1478 (Comm’r Pats. 1994) (examining attorney properly determined that no new issue had been raised in request for reconsideration of final refusal based on inadequate specimens, where the substitute specimens submitted with the request were deficient for the same reason as original specimens).

If the request for reconsideration does not raise a new issue, but presents new evidence that is significantly different from evidence previously submitted, the examining attorney should issue an “Examiner’s Subsequent Final Refusal,” with a six-month response clause. This provides applicant with the opportunity to respond before filing an appeal. Any response to the subsequent final refusal will be treated as a new request for reconsideration and processed according to the guidelines set forth in TMEP §§715.03 *et seq.*

Example: If an applicant files an executed consent agreement in response to a final refusal under §2(d) of the Trademark Act, and

the examining attorney finds the consent agreement insufficient to overcome the refusal, the examining attorney must issue an “Examiner’s Subsequent Final Refusal.” However, the examining attorney should not issue a subsequent final refusal if the applicant merely states that it is negotiating a consent agreement. See TMEP §714.05(d).

Example: The examining attorney should issue an “Examiner’s Subsequent Final Refusal” if the applicant asserts unity of control (see TMEP §§1201.07 *et seq.*) in response to a final refusal under §2(d), and the examining attorney determines that unity of control has not been established. See TMEP §714.05(d).

Submission of new arguments in response to the same refusal or requirement does not raise a new issue that requires the examining attorney to issue a subsequent final or nonfinal action. Generally, if the same refusal or requirement was made before, the examining attorney does not have to issue a subsequent final or nonfinal action.

See TMEP §§714.05 *et seq.* for further information about delineating new issues that require issuance of a nonfinal action.

When an application has been suspended after final action, and the grounds for refusal remain operative after the application is removed from suspension and no new issues have been raised, the examining attorney must issue an “Examiner’s Subsequent Final Refusal,” with a six-month response clause. See TMEP §716.06.

In a §66(a) application, the examining attorney cannot issue a new refusal more than 18 months after the date the IB forwards the request for extension of protection to the USPTO. See TMEP §1904.03(a).

715.03(c) Time for Appeal Runs from Issuance Date of Final Action

Filing a request for reconsideration does not stay the time for responding to a final refusal. 15 U.S.C. §1062(b); 37 C.F.R. §§2.64(b) and 2.142(a). If the examining attorney denies an applicant’s request for reconsideration, the deadline for filing a notice of appeal to the Board (or petition to the Director if permitted by 37 C.F.R. §2.63(b)(2)) runs from the issuance date of the final action. If this deadline has expired and the applicant has not filed a notice of appeal, the application will be abandoned due to an incomplete response. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). The applicant may not file a petition to revive under 37 C.F.R. §2.66, based on unintentional delay. See TMEP §1714.01(f)(ii). The applicant’s recourse is to file a petition to the Director under 37 C.F.R. §2.146 to reverse the examining attorney’s holding of abandonment. However, the Director will reverse the examining attorney’s

action on petition only if there is clear procedural error (see TMEP §706.01) or abuse of discretion. See TMEP §1713.01.

715.04 Request for Reconsideration Filed in Conjunction With Notice of Appeal

The Board has jurisdiction over an application upon the filing of the notice of appeal. In response to a request from an applicant, the Board may remand an application to the examining attorney for consideration of specific facts or issues. 37 C.F.R. §2.142(d). See TBMP §1209 regarding remand during an appeal, TBMP §515 regarding remand during an inter partes proceeding, and TMEP §1504.05(a).

If an applicant files a notice of appeal with a request for reconsideration, the Trademark Trial and Appeal Board will acknowledge the appeal, suspend further proceedings with respect to the appeal, including the applicant's time to file an appeal brief, and remand the application to the examining attorney for review of the request for reconsideration. TBMP §1209.04. See TMEP §§1501 *et seq.* and TBMP Chapter 1200 for further information about ex parte appeals.

If, upon remand, the examining attorney determines that the outstanding refusal or requirement should be withdrawn, the examining attorney may approve the application for publication or registration. In this situation, the appeal is moot. If there are remaining unresolved refusals, the Board should be notified to resume the appeal.

715.04(a) Examining Attorney's Action When No New Issue is Presented in Request for Reconsideration and Notice of Appeal Has Been Filed

If the request for reconsideration does not overcome or resolve the issues on appeal, and no new issue is presented therein, the examining attorney must issue an Office action using the "Request for Reconsideration Denied – Return to TTAB" (or, if appropriate, "SU - Request for Reconsideration Denied - Return to TTAB") selection that: (1) acknowledges the request for reconsideration; (2) indicates that it is denied and explains why it does not overcome all refusals or satisfy all requirements; (3) states that the final refusal(s) and/or requirements are maintained; and (4) advises the applicant that the Board will be notified to resume the appeal. An Office action denying reconsideration of the final action must *not* include a six-month response clause.

715.04(b) Examining Attorney's Action When New Issue or New Evidence is Presented and Notice of Appeal Has Been Filed

If the request for reconsideration includes an amendment that presents a new issue, whether related to the final refusal or not, the examining attorney must issue a new nonfinal Office action with a six-month response clause that addresses the new issue and maintains the final refusal. For example, in the case of an amendment to the Supplemental Register or an amendment that asserts a claim of acquired distinctiveness under §2(f) for the first time, but fails to place the application in condition for approval, a nonfinal action may be appropriate. See TMEP §714.05(a)(i).

Whenever the examining attorney issues a new *nonfinal* action after remand of an application by the Board, the Office action should explain that the applicant must respond to all refusals and/or requirements within six months of the issuance date of the action, but should not file another appeal to the Board. If the applicant's response does not resolve all outstanding refusals and/or requirements and put the application in condition for publication or registration on the Supplemental Register, the examining attorney must issue an "Examiner's Subsequent Final Refusal," with the six-month response clause omitted from the action. The subsequent final action should also notify the applicant that the appeal will be resumed.

If the request for reconsideration does not raise a new issue, but presents new evidence that is significantly different from evidence previously submitted, the examining attorney must issue an "Examiner's Subsequent Final Refusal," with a six-month response clause. This provides applicant with the opportunity to respond before the appeal. For example, if an applicant files a consent agreement in response to a final refusal under §2(d) of the Trademark Act, and the examining attorney finds the consent agreement insufficient to overcome the refusal, the examining attorney must issue an "Examiner's Subsequent Final Refusal" that discusses applicant's consent agreement. However, the examining attorney should not issue a subsequent final refusal if the applicant merely states that it is negotiating a consent agreement. See TMEP §714.05(d). Any response to the subsequent final action will be treated as a new request for reconsideration and processed according to the guidelines set forth in TMEP §§715.04 *et seq.*

Evidence or amendments that are merely cumulative and are not significantly different from material previously submitted do *not* raise a new issue that requires the examining attorney to issue a new action. *In re GTE Education Services*, 34 USPQ2d 1478 (Comm'r Pats. 1994) (examining attorney properly determined that no new issue had been raised in request for reconsideration of final refusal based on inadequate specimens, where the substitute specimens submitted with the request were deficient for the same reason as the original specimens).

Submission of new arguments in response to the same refusal or requirement does not raise a new issue that requires the examining attorney to issue a new action. Generally, if the same refusal or requirement was made before, the examining attorney may issue an Office action denying reconsideration of the final action.

See TMEP §714.05 *et seq.* for further information about delineating new issues that require issuance of a nonfinal action.

In a §66(a) application, the examining attorney cannot issue a new refusal more than 18 months after the date the IB forwards the request for extension of protection to the USPTO. See TMEP §1904.03(a).

716 Suspension of Action by USPTO

37 C.F.R. §2.67. Suspension of action by the Patent and Trademark Office.

Action by the Patent and Trademark Office may be suspended for a reasonable time for good and sufficient cause. The fact that a proceeding is pending before the Patent and Trademark Office or a court which is relevant to the issue of registrability of the applicant's mark, or the fact that the basis for registration is, under the provisions of Section 44(e) of the Act, registration of the mark in a foreign country and the foreign application is still pending, will be considered prima facie good and sufficient cause. An applicant's request for a suspension of action under this section filed within the 6-month response period (see §2.62) may be considered responsive to the previous Office action. The first suspension is within the discretion of the Examiner of Trademarks and any subsequent suspension must be approved by the Director.

The term “suspension of action” means suspending action *by the examining attorney*. It does not mean suspending or extending an applicant's time to respond. The Trademark Act requires that an applicant respond within six months of an examining attorney's Office action, and the examining attorney has no discretion to suspend or extend the time for the applicant's response. 15 U.S.C. §1062(b).

The examining attorney should suspend an application only after all issues have been resolved or are in condition for final action, except the matter on which suspension is based.

716.01 Form of Suspension Notice

In a suspension notice, the examining attorney must specifically state that action is suspended and must omit any reference to a six-month response period. The examining attorney should also inform the applicant of the status of the application, i.e., that the mark appears to be otherwise entitled to be

approved for publication or issue, or that the application is in condition for a final action.

If the application is in condition for a final action but for the matter necessitating suspension, the notice of suspension must clearly indicate which refusals or requirements will be made final when the application is removed from suspension. When the application is removed from suspension, the examining attorney must promptly issue a final action, assuming that no new issues have arisen.

716.02 Circumstances Under Which Action May Be Suspended

Under 37 C.F.R. §2.67, an examining attorney has the discretion to suspend an application “for good and sufficient cause.” The most common reasons for suspension of an application are discussed below.

As a general rule, the USPTO will not suspend an application to give an applicant time to secure a consent agreement.

Any request to stay a deadline for responding to an Office action pending disposition of a petition to the Director should be directed to the Deputy Commissioner for Trademark Examination Policy. If such a request is sent to the examining attorney, the examining attorney should forward it to the Office of the Deputy Commissioner for Trademark Examination Policy. The examining attorney should *not* suspend action on an application pending a decision on petition to the Director. See 37 C.F.R. §2.146(g); TMEP §1705.06.

716.02(a) Applicant’s Petition to Cancel Cited Registration

If the examining attorney refuses registration under §2(d) of the Trademark Act in view of the mark in a prior registration, the applicant may file a petition to cancel the registration under 15 U.S.C. §1064 and, within a proper response period, inform the examining attorney that the petition to cancel has been filed. This will constitute a proper response to the §2(d) refusal, and may be done by telephone, if there are no other outstanding issues that require a written response. The examining attorney will then suspend further action until the termination of the cancellation proceeding, if the application is otherwise in condition for approval or final refusal. The applicant should provide the number of the cancellation proceeding, if available; however, if the applicant does not provide the cancellation number, the examining attorney may ascertain it from USPTO records.

The examining attorney should suspend further action only if the applicant states that the cancellation proceeding has already been filed or is being filed concurrently with the response to the Office action.

Although the examining attorney will determine the status of the cancellation proceeding through a routine status check (see TMEP §716.04), the applicant may call or e-mail to advise the examining attorney when the registration has been cancelled, in order to avoid any possible delay in removing the application from suspension. The examining attorney must not remove the application from suspension and withdraw the §2(d) refusal until the TRAM system shows that the registration has actually been cancelled or expired.

When an application is suspended pending resolution of a cancellation proceeding, it is possible that a settlement agreement filed in the proceeding may be contingent upon the approval of an amendment or acceptance of a consent agreement filed in the suspended application, and the consequent approval of the application for publication. The Board has no jurisdiction over the application that is pending before the examining attorney. Thus, the applicant must file the amendment or consent agreement with the examining attorney, not with the Board. The examining attorney must consider the amendment or agreement and take appropriate action, including approving the application for publication, if appropriate. See TBMP §605.03(c).

In rare circumstances, the examining attorney may issue an Office action advising an applicant of a conflicting mark in an earlier-filed application and, during the response period, the mark registers and the applicant files a petition to cancel the registration. Although the applicant may respond to the Office action by informing the examining attorney that the petition to cancel has been filed, the examining attorney may not suspend under these circumstances because the application would not be in condition for final refusal if the registration is not cancelled. The examining attorney must first issue a non-final Office action refusing registration. The applicant may then respond by requesting suspension pending the outcome of the cancellation proceeding.

See TMEP §716.02(e) regarding suspension pending cancellation of a cited registration under §8 or §71 of the Act or expiration of a cited registration for failure to renew under §9 of the Act.

716.02(b) Submission of Copy of Foreign Registration in §44(d) Application

When an applicant who claims the benefit of a prior foreign application under §44(d) of the Act, 15 U.S.C. §1126(d), is required to submit a copy of a foreign registration, the applicant may respond to the requirement by stating that the foreign application is still pending. The examining attorney should then suspend further action pending receipt of a copy of the foreign registration, if the application is otherwise in condition for approval or final refusal. See TMEP §1003.04(a).

If an applicant asserts a claim of priority under §44(d) in addition to another basis, before suspending the application, the examining attorney must inquire

whether the applicant wishes to retain §44(e) as a second basis for registration (based on the foreign registration that will issue from the foreign application on which the applicant relied for priority). See TMEP §1003.04(b) for further information.

If the applicant responds that it does want to assert a dual basis for registration and the application is otherwise in condition for publication or final refusal, the examining attorney should suspend further action pending receipt of a copy of the foreign registration.

During the suspension period, the examining attorney will issue an Office action approximately every six months after suspension to inquire as to the status of the foreign application. If the applicant does not respond to the inquiry, the application will be abandoned. See TMEP §716.05.

The examining attorney may suspend the application pending receipt of a copy of a foreign registration only in a §44(d) application. In a §44(e) application, the examining attorney will not suspend the application pending submission of a copy of the foreign registration, unless the applicant establishes that it cannot obtain a copy of the foreign registration due to extraordinary circumstances (e.g., war or natural disaster). TMEP §1004.01. However, the examining attorney may suspend a §44(e) application pending receipt of proof of renewal of the foreign registration. TMEP §1004.01(a).

716.02(c) Conflicting Marks in Pending Applications

When there are conflicting marks in pending applications, action on the application with the later effective filing date will be suspended (if the application appears to be otherwise in condition for publication or issue or for a final action) until the mark in the conflicting application with the earlier effective filing date is either registered or abandoned. 37 C.F.R. §2.83(c). See TMEP §§1208 *et seq.* for more information about conflicting marks in pending applications.

If the examining attorney has cited an earlier-filed pending application, the applicant may respond by arguing that there is no likelihood of confusion between the marks. If the examining attorney is not persuaded by the applicant's arguments, the examining attorney should suspend the later-filed application pending disposition of the earlier-filed conflicting application. The suspension notice should include a statement that the applicant's arguments were not persuasive. It is not necessary to address the merits of the applicant's arguments prior to the initial suspension. See TMEP §716.03 regarding the applicant's request to remove an application from suspension.

If the examining attorney discovers that an earlier-filed pending application was abandoned, but that a petition to revive is pending, the examining attorney should suspend the later-filed application pending disposition of the petition to revive. If the petition to revive is granted, the later-filed application

will remain suspended until the mark in the earlier-filed application is registered or the earlier-filed application is again abandoned.

When an application is suspended pending the disposition of more than one earlier-filed conflicting application, and one of the conflicting applications matures into registration, the examining attorney will normally not issue a refusal of registration until all the remaining conflicting application(s) are registered or abandoned, in order to avoid issuing piecemeal refusals. However, if deemed appropriate, the examining attorney does have the discretion to issue a refusal of registration under §2(d) in this situation. Sometimes, the applicant will file an opposition to the registration of the earlier-filed conflicting mark. In this situation, it is possible that a settlement agreement filed in the Board proceeding may be contingent upon the approval of an amendment or acceptance of a consent agreement filed in the suspended application, and the consequent approval of the application for publication. The Board has no jurisdiction over the application that is pending before the examining attorney. Thus, the applicant must file the amendment or consent agreement with the examining attorney, not with the Board. The examining attorney must consider the amendment or agreement and take appropriate action. See TBMP §605.03(c).

716.02(d) Inter Partes or Court Proceeding

When an examining attorney learns that a proceeding relevant to the registrability of an applicant's mark is pending before the Trademark Trial and Appeal Board or a court, the examining attorney should call the proceeding to the applicant's attention. If the applicant is not a party to the inter partes or court proceeding, the examining attorney must explain why the proceeding is relevant to the registrability of the applicant's mark. If the examining attorney believes the proceeding may result in a decision that supports a refusal of registration of the applicant's mark, the examining attorney must issue the refusal and give the applicant an opportunity to respond before suspending the application.

When an applicant requests suspension because a proceeding relevant to the registrability of the applicant's mark is pending before the Board or a court, the applicant must submit a copy of the relevant pleadings, the docket number of the proceeding, and a written explanation of why the proceeding is relevant to the registrability of the mark. Normally, a court proceeding is not considered relevant to the registrability of a mark unless the remedy requested in the proceeding is cancellation, abandonment, or amendment of a relevant application or registration. However, when resolution of the court action requires the court to consider questions of USPTO policy or procedure, the examining attorney should not assume that the court would prefer to decide such questions absent the USPTO's decision in the consideration of an application. In these instances, action on an application should generally not be suspended. It is important to review the relevant pleadings, including

the complaint and answer, before determining whether suspension is appropriate. The Office of the Solicitor may be consulted if there is a question as to whether suspension of the application is appropriate.

A third party who wishes to request suspension of a pending application because a proceeding relevant to the registrability of the mark is pending before a court must do so by filing a letter of protest. See TMEP §1715 *et seq.* The litigation must be specifically identified and a copy of the relevant pleadings must be enclosed. The litigation must involve a federally registered mark or prior-pending application, and the protestor must allege that there is a likelihood of confusion between this mark and the mark in the application that is the subject of the letter of protest. Normally, a court proceeding is not considered relevant to the registrability of a mark unless the remedy requested in the proceeding is abandonment or amendment of the relevant application. If the letter of protest is granted, the examining attorney is informed that a request for suspension has been received based on an alleged likelihood of confusion with a registered mark or prior-pending application that is the subject of pending litigation.

Before an application is suspended, the applicant must respond to all outstanding issues raised in the examining attorney's Office action that are not related to the proceeding. The examining attorney should not suspend the application unless all matters not related to the proceeding are resolved or in condition for final action.

See TMEP §716.02(a) regarding suspension pending disposition of an applicant's petition to cancel a cited registration under 15 U.S.C. §1064, TMEP §716.02(c) regarding suspension of later-filed conflicting marks, TMEP §716.03 regarding the applicant's request to remove an application from suspension, and TBMP §605.03(c) regarding filing an amendment or consent agreement in a pending application owned by the plaintiff pursuant to a settlement agreement between the parties in an *ex parte* proceeding before the Board.

716.02(e) Suspension Pending Cancellation or Expiration of Cited Registration

When the applicant submits a timely affidavit or declaration of continued use or excusable nonuse under 15 U.S.C. §1058 ("§8 affidavit") and/or an application for renewal under 15 U.S.C. §1059, the USPTO's automated records are updated to indicate receipt of the document and the action taken on the document. The USPTO's automated records are updated 30 days after the grace period expires to indicate that a registration is cancelled or expired if:

- (1) No §8 affidavit has been filed before the end of the six-month grace period following the sixth year after the date of registration or

publication under §12(c) of the Trademark Act, 15 U.S.C. §1062(c);
or

- (2) No §8 affidavit has been filed before the end of the six-month grace period following the end of any ten-year period after the date of registration; or
- (3) No §9 renewal application has been filed before the end of the six-month grace period following the expiration of the previous term of registration.

See TMEP §§1602 *et seq.* regarding the duration of a registration, TMEP §1604.04 regarding the due dates for §8 affidavits, and TMEP §1606.03 regarding the due dates for §9 renewal applications.

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

The examining attorney must confirm the status of the cited registration to ensure that it is still active before issuing any refusal of registration under Trademark Act §2(d) or filing a brief on appeal of a §2(d) refusal.

If the examining attorney is ready to issue a *nonfinal* refusal of registration under §2(d), and TRAM shows that the registration is still active, the examining attorney must issue the refusal even if the grace period for filing a §8 affidavit and/or a §9 renewal application for the cited registration has passed and TRAM does not indicate that the registrant has filed a §8 affidavit and/or §9 renewal application. The examining attorney should not suspend the application, but should advise the applicant that the grace period for filing the §8 affidavit or §9 renewal application has passed and that it appears that the registration may be subject to cancellation under §8 and/or expiration under §9.

If the examining attorney is ready to issue a *final* refusal of registration under §2(d), and the grace period for filing a §8 affidavit and/or a §9 renewal application for the cited registration has *not passed*, the examining attorney must issue the final refusal. The examining attorney should not suspend action, because the cited registration is still active and the registrant has until the end of the grace period to submit the §8 affidavit and/or a §9 renewal application. Similarly, if the examining attorney is ready to issue a denial of a request for reconsideration of a final refusal of registration under §2(d), and the grace period for filing a §8 affidavit and/or a §9 renewal application for the cited registration has *not passed*, the examining attorney must issue the denial.

If the grace period for filing a §8 affidavit and/or a §9 renewal application for the cited registration has passed, and the examining attorney is ready to issue a *final* refusal of registration under §2(d), or a denial of a request for reconsideration of a final refusal of registration under §2(d), the examining attorney should not issue the action until the USPTO's automated records indicate that the registrant has filed the §8 affidavit or §9 renewal application, and the USPTO has accepted the §8 affidavit or granted renewal. Instead, the examining attorney should suspend action for six months pending final disposition of the cited registration.

If the grace period for filing a §8 affidavit and/or a §9 renewal application for the cited registration has passed, and the examining attorney is ready to write an appeal brief, the examining attorney should request a remand so that the application can be suspended pending final disposition of the cited registration. The Board will issue an order suspending the appeal and remanding the case to the examining attorney. If the cited registration is cancelled or expires, the examining attorney should withdraw the §2(d) refusal and notify the applicant that it has been withdrawn. If an appropriate affidavit or renewal application is filed for the cited registration, the examining attorney should notify the Board; the Board will resume proceedings and reset the time for filing the examining attorney's appeal brief. Similarly, if the cited registration is cancelled or expires, but the §2(d) refusal is only one of the issues on appeal, the examining attorney should notify the Board of the status of the cited registration. The Board will resume proceedings and reset the time for filing a brief. See TBMP §1213 regarding the suspension of an ex parte appeal pending cancellation of the cited registration under §8 or §9 of the Act.

The examining attorney cannot withdraw a refusal of registration under §2(d) until the TRAM system shows that the registration has actually been cancelled or expired. If the examining attorney determines that 30 days have passed since the expiration of the grace period, but the TRAM system does not indicate that the registration has been cancelled or expired, the examining attorney should contact the Supervisor of the Post Registration Section and request that the database be updated to show that the registration is cancelled or expired.

See TMEP §1611 for information about how a registrant who has not timely filed a §8 affidavit or §9 renewal application may expedite the cancellation or expiration of its own registration.

716.03 Applicant's Request to Remove Application from Suspension

If an examining attorney suspends action on an application, and the applicant believes the suspension is improper, the applicant may file a request to remove the application from suspension. The applicant should state the

reasons for the belief that the suspension is improper and attach any relevant evidence.

If persuaded by the request, the examining attorney should remove the application from suspension, resume examination of the application, and take appropriate action.

If not persuaded by the request, the examining attorney must issue a new suspension action *that addresses the applicant's arguments and explains the reasons why the request is not granted*. The applicant's recourse is to file a petition to the Director to review the examining attorney's action continuing the suspension. The Director will reverse the examining attorney's action only if there is clear procedural error (see TMEP §706.01) or abuse of discretion. See TMEP Chapter 1700 for information about petitions.

716.04 Suspended Docket Checked

A legal instruments examiner ("LIE") will review each case in the suspended docket at least every six months to determine whether continued suspension is appropriate. If the LIE determines that the application should remain suspended, he or she should perform the appropriate TRAM transaction to report the suspension check. If suspension is no longer necessary, the LIE will notify the examining attorney and the examining attorney will take the appropriate action.

716.05 Inquiry by Examining Attorney Regarding Suspended Application

In certain circumstances, if the application has been suspended for six months or more, the examining attorney will issue an Office action inquiring as to the status of the matter on which suspension was based, unless the information is available to the examining attorney in the USPTO's databases. If the applicant does not respond to the Office action, the application will be abandoned for failure to respond. To expedite processing, the USPTO recommends that the applicant's response to a suspension inquiry be filed through TEAS, at <http://www.uspto.gov>, using the "Response to Suspension Inquiry or Letter of Suspension" form.

For example, if action is suspended pending the receipt of a copy of a foreign registration or proof of renewal of a foreign registration, the examining attorney will inquire every six months during the suspension period as to the status of the foreign application or registration. Similarly, for applications that are suspended pending the outcome of a civil action, the examining attorney will inquire every six months as to the status of the proceeding. If the foreign application or the civil action is still pending, a statement by the applicant to this effect is a proper response.

The examining attorney should *not* issue any inquiry about the status of a proceeding pending in the USPTO (e.g., an inter partes proceeding).

716.06 Suspension After Final Action

If the examining attorney determines that action on an application should be suspended after issuance of a final refusal, the examining attorney must issue a suspension notice. This may occur, for example, when the applicant files a petition to cancel a cited registration. See TMEP §716.02(a). The examining attorney should not “withdraw the finality” of the refusal in order to suspend; however, in the suspension notice, the examining attorney should inform the applicant that the refusal of registration is continued but that it is not necessary to respond to the final refusal until the application is removed from suspension.

If the application is eventually removed from suspension and the grounds for refusal remain operative, the examining attorney should issue an “Examiner’s Subsequent Final Refusal,” thereby reissuing the final refusal, and the applicant will have six months to respond. It is inappropriate to remove the case from suspension and immediately declare the application abandoned.

717 Reissuing an Office Action

Sometimes, an Office action must be reissued because the action has been returned as undeliverable and/or because the applicant notifies the USPTO that the applicant did not receive the Office action. In these situations, the USPTO will not extend the deadline for response, unless the Office action was sent to the wrong address due to a USPTO error.

If there was a USPTO error, the USPTO will issue an Office action notifying the applicant that it may view and print the Office action via the TDR portal on the USPTO website at <http://www.uspto.gov>. The applicant will be given a new response period.

If there was no USPTO error, the USPTO will issue an Office action notifying the applicant that it may view and print the original Office action via the TDR portal on the USPTO website, but that the deadline for applicant’s response will not be extended.

A “USPTO error in sending the Office action to the wrong address” means that the USPTO either entered the correspondence address incorrectly or failed to enter a proper notice of change of address filed *before* the date on which the action was issued. The transmittal of a response on letterhead bearing a new address is *not* a proper notice of change of address. The applicant must specifically instruct the USPTO to change the correspondence address. 37 C.F.R. §2.18(b). Applicants and attorneys have a duty to maintain a current and accurate correspondence address. This also applies to e-mail addresses, if the applicant has authorized the USPTO to send

correspondence by e-mail. 37 C.F.R. §2.18(b)(1). See TMEP §§609.02 *et seq.* regarding changes of address.

See TMEP §717.01 regarding Office actions returned as undeliverable, and TMEP §717.02 regarding non-receipt of Office actions.

717.01 Returned Office Action

If an Office action is returned to the USPTO because the United States Postal Service was not able to deliver it, or because an outgoing e-mail communication was undeliverable, USPTO personnel will review the record to determine whether the correspondence address was entered correctly and/or whether the applicant has filed a notice of change of address. See TMEP §717 regarding the reissuance of an Office action sent to the wrong address due to a USPTO error.

If the USPTO is ultimately unsuccessful in delivering or redelivering the Office action, the returned action and envelope should be scanned into the TICRS database. If no communication from the applicant is received within the period for response, the application will be abandoned.

If outgoing e-mail is returned as undeliverable, the USPTO will send a paper copy to the correspondence address of record. See TMEP §§304 *et seq.* regarding e-mail.

See TMEP §403 for more information about returned correspondence.

717.02 Non-Receipt of Office Action

If an applicant notifies the USPTO that the applicant did not receive an action, either before or after the expiration of the response period, the examining attorney must check to determine whether the action was sent to the correspondence address of record. See TMEP §§609 *et seq.*

If the Office action was sent to the correspondence address of record, and there is time remaining in the response period, the examining attorney should direct the applicant to view the full record on the TDR portal on the USPTO website, and advise the applicant that the deadline for response runs from the original issuance date, and that a response must be received in the USPTO before this deadline to avoid abandonment. If the response period has expired, the examining attorney should advise the applicant that the application is abandoned, and that the applicant may file a petition to revive under 37 C.F.R. §2.66. See TMEP §§1714 *et seq.* regarding petitions to revive. In either situation, the examining attorney should make an appropriate note in the “Notes-to-the-File” section of the record.

If there is evidence in the record that the USPTO sent the Office action to the wrong address due to a USPTO error (see TMEP §717), the USPTO will

reissue the action and provide the applicant with a new response period. The examining attorney should first ensure that the correspondence address has been corrected, and then e-mail the internal TM Clerical Support mailbox, stating that the action was sent to the wrong address, and requesting that the action be reissued with a new response period. The deadline for response will run from the new issuance date. If the application had been abandoned, it will be reinstated. See TMEP §1712.01 regarding reinstatement of applications that are abandoned due to USPTO error.

718 Abandonment

An abandoned application is an application for registration that is removed from the USPTO docket of pending applications because of express abandonment or because the applicant failed to take appropriate action within the specified response period.

718.01 Express Abandonment by Applicant or Applicant's Attorney

37 C.F.R. §2.68. Express abandonment (withdrawal) of application.

(a) Written document required. An applicant may expressly abandon an application by filing a written request for abandonment or withdrawal of the application, 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 qualified to practice under §11.14 of this chapter, in accordance with the requirements of §2.193(e)(2).

(b) Rights in the mark not affected. Except as provided in §2.135, the fact that an application has been expressly abandoned shall not, in any proceeding in the Office, affect any rights that the applicant may have in the mark in the abandoned application.

37 C.F.R. §2.135. Abandonment of application or mark. After the commencement of an opposition, concurrent use, or interference proceeding, if the applicant files a written abandonment of the application or of the mark without the written consent of every adverse party to the proceeding, judgment shall be entered against the applicant. The written consent of an adverse party may be signed by the adverse party or by the adverse party's attorney or other authorized representative.

To expedite processing, the USPTO recommends that letters of express abandonment be filed through TEAS, at <http://www.uspto.gov>. Generally, all express abandonments filed via TEAS are processed electronically and the TRAM database is automatically updated to indicate that the application has been expressly abandoned. TRAM generates a notice to the applicant that the application is abandoned. However, in the later stages after the

application has been approved for publication, the TEAS system will not automatically process an incoming express abandonment, and the express abandonment must be reviewed manually. The Office is generally unable to withdraw a mark from publication or issue unless the express abandonment is received and processed at least twenty days before the scheduled publication date or registration issuance date.

Paper letters of express abandonment are reviewed by examining attorneys.

All letters of express abandonment must be signed by the individual applicant, someone with legal authority to bind a juristic applicant (e.g., an officer of a corporation or general partner of a partnership), or a qualified practitioner. 37 C.F.R. §2.68(a). See TMEP §§608.01 and 611.02. The same principles that govern the signature of responses to Office actions (see TMEP §§712 and 712.01) apply to the signature of express abandonments. For express abandonments filed on paper, the examining attorney must ensure that the letter of express abandonment is signed by a proper party. If the applicant is represented by a qualified practitioner, the practitioner must personally sign the letter of express abandonment. 37 C.F.R. §§2.193(e)(2)(i) and 11.18(a). If the applicant is *pro se*, the letter of express abandonment must be personally 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 juristic applicants, and TMEP §§611.05 *et seq.* and 712.03 regarding documents signed by unauthorized parties.

An application cannot be expressly abandoned by examiner's amendment.

When an applicant files a letter of express abandonment on paper that meets the requirements of 37 C.F.R. §2.68(a), the examining attorney should perform a TRAM transaction expressly abandoning the application, effective as of the filing date of the letter of express abandonment. TRAM will generate a letter notifying the applicant that the application is abandoned.

If it is unclear whether a document is a letter of abandonment, the examining attorney should contact the applicant to inquire about his or her intention before abandoning the application.

If an applicant files an express abandonment of an application that is not the subject of an inter partes proceeding before the Trademark Trial and Appeal Board, and wants to withdraw the abandonment to resume prosecution of the application, the applicant must petition the Director under 37 C.F.R. §2.146(a)(3) to request withdrawal of the express abandonment, within two months of the effective date of abandonment. 37 C.F.R. §2.146(d). However, such a petition will be granted only in an extraordinary situation. *In re Glaxo Group Ltd.*, 33 USPQ2d 1535 (Comm'r Pats. 1993).

If the applicant files a written request to abandon the application after the commencement of an opposition proceeding, the request for abandonment must be filed with the Board, and must include the written consent of every adverse party to the proceeding. If the applicant files a request for abandonment without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant. 37 C.F.R. §2.135. If an applicant whose application is the subject of an opposition proceeding files an express abandonment of the application after the commencement of the opposition proceeding, but before receipt of the Board's notice of the filing of the opposition, the Board will allow the applicant an opportunity to withdraw the abandonment because the abandonment, if not withdrawn, may result in entry of judgment against the applicant in the opposition. TBMP §602.01. It is not necessary to obtain consent of a potential opposer during an extension of time to oppose. TBMP §218.

In a §66(a) application, an applicant may file a letter of express abandonment either with the USPTO or with the IB.

718.02 Failure by Applicant to Take Required Action During Statutory Period

15 U.S.C. §1062(b). If the applicant is found not entitled to registration, the examiner shall advise the applicant thereof and of the reason therefor. The applicant shall have a period of six months in which to reply or amend his application, which shall then be reexamined. This procedure may be repeated until (1) the examiner finally refuses registration of the mark or (2) the applicant fails for a period of six months to reply or amend or appeal, whereupon the application shall be deemed to have been abandoned, unless it can be shown to the satisfaction of the Director that the delay in responding was unintentional, whereupon such time may be extended.

Under 15 U.S.C. §1062(b) and 37 C.F.R. §2.65(a), an application becomes abandoned if the applicant fails to respond, or fails to respond completely, within the six-month statutory response period. See TMEP §§718.03 *et seq.* regarding incomplete responses. When an applicant is granted additional time to perfect its response under 37 C.F.R. §2.65(b) (TMEP §718.03(b)), but fails to respond or responds late, the date of abandonment is not affected. It remains the day after the date on which the six-month response period ends, since the grant of additional time to *perfect* a response does not extend the statutory six-month response period.

The examining attorney has no authority to accept a late response. If an applicant files a late response, the examining attorney must immediately send a notice to the applicant stating that the response was untimely; that the application is abandoned; and that the applicant may file a petition to revive

under 37 C.F.R. §2.66 if the failure to timely respond was unintentional. See TMEP §§1714 *et seq.* regarding petitions to revive.

See TMEP §718.02(a) regarding partial abandonment.

718.02(a) Partial Abandonment

General Rule. Trademark Rule 2.65(a), 37 C.F.R. §2.65(a), provides that if a refusal or requirement is expressly limited to certain goods/services, and the applicant fails to file a response to the refusal or requirement, the application shall be abandoned only as to those particular goods/services. See notice at 68 Fed. Reg. 55748 (Sept. 26, 2003).

Office Action Must State That Refusal Applies Only to Certain Goods, Services or Classes. If the examining attorney issues a refusal or requirement that applies only to certain goods/services/class(es), this must be expressly stated in the Office action. Partial abandonment applies only where the Office action expressly states that a refusal or requirement is limited to only certain goods/services/class(es). Unless the action includes a **clear and explicit** statement that the refusal or requirement applies to only certain goods/services/class(es), the refusal or requirement will apply to all the goods/services/class(es), and failure to respond to the action will result in abandonment of the entire application.

Incomplete Response to Partial Refusal or Requirement. Partial abandonment may also occur when an applicant fails to file a complete response to a final refusal or final requirement that is expressly limited to only certain goods/services/class(es). If an applicant files an incomplete response to a nonfinal action that is limited to only certain goods/services/class(es), the examining attorney should generally issue an action making all outstanding requirements and refusals final rather than partially abandoning the application. See TMEP §§718.03 *et seq.* regarding incomplete responses. When an examining attorney holds an application abandoned for failure to file a complete response, the applicant's recourse is to file a petition to the Director under 37 C.F.R. §2.146 to reverse the holding. See TMEP §1713.01.

Failure to Respond to Partial Refusal or Requirement. When an applicant fails to respond to a refusal or requirement that is expressly limited to only certain goods/services/class(es), the examining attorney should issue an examiner's amendment deleting (abandoning) the goods/services/classes to which the refusal or requirement pertained. The examiner's amendment should clearly set forth the changes that will be made to the identification of goods/services in the application. No prior authorization from the applicant or the applicant's qualified practitioner is needed to issue an examiner's amendment in this situation. TMEP §707.02. If the failure to respond to the partial refusal or requirement was unintentional, the applicant may file a petition to revive the deleted goods/services/classes under 37 C.F.R. §2.66,

within two months of the issuance date of the examiner's amendment. See TMEP §§1714 *et seq.* regarding petitions to revive.

Failure to Perfect Appeal of Partial Refusal or Requirement. Partial abandonment can also occur when a partial refusal or requirement is upheld on appeal, and the applicant fails to perfect an appeal to, or an appeal is dismissed by, the Court of Appeals for the Federal Circuit or civil court, or when an applicant withdraws or fails to prosecute an appeal of a partial refusal to the Board. In these situations, the examining attorney should issue an examiner's amendment deleting (abandoning) the goods/services/class(es) to which the appeal pertained. No prior authorization from the applicant or the applicant's qualified practitioner is needed to issue an examiner's amendment in this situation.

Use of Headings in Office Actions Encouraged. When issuing a partial refusal or requirement, the examining attorney is encouraged to use the heading "Partial Refusal" or "Partial Requirement," so the record is clear that the refusal or requirement applies only to certain goods/services/class(es).

Use of Abandonment Advisory in Office Actions. When issuing a partial refusal or requirement, the examining attorney should advise the applicant that if the applicant does not respond to the Office action within the response period, certain goods/services/class(es) will be deleted from the application (abandoned) and the application will proceed forward with only the remaining goods/services/class(es).

Requirements for Amendment of Identification of Goods/Services. See TMEP §1402.13 regarding an examining attorney's requirement for amendment of an identification of goods/services that includes some terminology that is indefinite and some terminology that is acceptable, and the processing of applications in which an applicant fails to respond to such a requirement.

Requirements for Fees to Cover All Classes in a Multiple-Class Application. If the fees paid in a multiple-class application are sufficient to cover one class but insufficient to cover all the classes, the examining attorney will require that the applicant submit the additional fees or specify the classes to which the original fee(s) should be applied. Under such circumstances, it is not appropriate to give a partial-abandonment advisory. If the applicant does not respond to the Office action, the entire application will be abandoned.

718.03 Incomplete Response

37 C.F.R. §2.65.

(a) If an applicant fails to respond, or to respond completely, within six months after the date an action is issued, the application shall be deemed abandoned unless the refusal or requirement is expressly limited to only certain goods and/or services. If the refusal or requirement is expressly limited to only

certain goods and/or services, the application will be abandoned only as to those particular goods and/or services. A timely petition to the Director pursuant to §§2.63(b) and 2.146 or notice of appeal to the Trademark Trial and Appeal Board pursuant to §2.142, if appropriate, is a response that avoids abandonment of an application.

(b) When action by the applicant filed within the six-month response period is a bona fide attempt to advance the examination of the application and is substantially a complete response to the examiner's action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, opportunity to explain and supply the omission may be given before the question of abandonment is considered.

Under 15 U.S.C. §1062(b) and 37 C.F.R. §2.65(a), an applicant must respond completely to each issue raised in the examining attorney's Office action to avoid abandonment. A response is incomplete if it: (1) does not address one or more of the requirements or refusals made in the Office action; (2) is unsigned; (3) is signed by an unauthorized person; or (4) is a response to a final action that does not overcome all refusals or satisfy all requirements, where the response period has expired, and the applicant has not timely filed a notice of appeal. See TMEP §715.03(a).

Unsigned Responses. If a response is unsigned, the examining attorney must obtain a properly signed copy before acting on the merits of the response, regardless of whether the Office action was final or nonfinal. The examining attorney should issue a notice of incomplete response, granting the applicant additional time to perfect the response pursuant to 37 C.F.R. §2.65(b). See TMEP §718.03(b). The applicant must submit a properly signed copy of the response, or, if all issues raised are proper subject matter for an examiner's amendment, the individual applicant, someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner of a partnership), or the applicant's previously recognized qualified practitioner may authorize the examining attorney to enter an examiner's amendment. If all issues raised are not proper subject matter for an examiner's amendment, the applicant may *not* ratify the unsigned response through an examiner's amendment. See TMEP §712.02. If the applicant fails to submit a properly signed response within the time granted under 37 C.F.R. §2.65(b), the examining attorney should hold the application abandoned for failure to file a complete response. See TMEP §718.03(a). *Note: A new qualified practitioner may not authorize an examiner's amendment, because a telephone call from a qualified practitioner does not satisfy the "appearance" requirements of 37 C.F.R. §2.17(b). See TMEP §604.01.*

Responses Signed by Unauthorized Persons. If a response is signed by an unauthorized party (e.g., a foreign attorney who is not a member in good standing of the bar of the highest court of a state in the United States or a corporate employee who does not have legal authority to bind the applicant),

the examining attorney must obtain a properly signed copy before acting on the merits of the response, regardless of whether the Office action was final or nonfinal. The examining attorney should issue a notice of incomplete response, granting the applicant additional time to perfect the response pursuant to 37 C.F.R. §2.65(b), and send the notice to the correspondence address of record. The applicant must submit a response signed by the individual applicant, someone with legal authority to bind a juristic applicant (see TMEP §§611.06 *et seq.* and 712.01 *et seq.*), or by a qualified practitioner (see TMEP §§602 *et seq.*). 37 C.F.R. §2.62(b). Where a response was signed by an unauthorized party, it is not acceptable for the applicant to ratify the response through an examiner's amendment. See TMEP §§611.05 *et seq.* and 712.03 for further information. If the applicant fails to submit a properly signed response within the time granted under 37 C.F.R. §2.65(b), the examining attorney should hold the application abandoned for failure to file a complete response. See TMEP §718.03(a) regarding holdings of abandonment.

Properly Signed but Incomplete Responses to Nonfinal Actions. When an applicant files an incomplete response to a nonfinal action (i.e., does not address one or more of the requirements or refusals made in the Office action), the examining attorney should not hold the application abandoned. Instead, the examining attorney has the discretion to: (1) issue a final action, if the application is in condition for final action; or (2) issue a notice of incomplete response granting the applicant additional time to complete the response, if the response meets the requirements of 37 C.F.R. §2.65(b) (see TMEP §718.03(b)). If the application is not in condition for final action, and the response does not meet the requirements of 37 C.F.R. §2.65(b), the examining attorney should issue another nonfinal action, explaining why the response was incomplete, and continuing all outstanding refusals and requirements.

A written disagreement with the examining attorney's refusal or requirement may be a complete response to a nonfinal action with respect to that refusal or requirement.

Exception - TEAS Responses Consisting Only of a Signature.

Occasionally, the USPTO receives a response to an Office action filed through TEAS which consists only of a signature. This is generally due to user error. If an examining attorney receives a TEAS response to a *nonfinal* action that consists only of a signature, the examining attorney should not issue a notice of incomplete response granting the applicant additional time to complete the response. Instead, the examining attorney must issue a final action, if the application is in condition for a final action. If the application is not in condition for final action (e.g., because an earlier-filed conflicting application has matured into a registration), the examining attorney should issue another nonfinal action, with a

six-month response clause, explaining why the response was incomplete, continuing all outstanding refusals and requirements, and addressing any new issues.

Properly Signed but Incomplete Responses to Final Actions. See TMEP §715.03(a) regarding properly signed but incomplete responses to final actions and TEAS responses to final actions consisting only of a signature.

Non-Responsive Communications. An inquiry, a request to extend the response period, or a communication on a matter unrelated to the preceding Office action should be treated as a non-responsive communication, not as an incomplete response. See TMEP §719 for further information.

Failure to Respond to Notice of Incomplete Response. If the examining attorney issues a notice of incomplete response, and the applicant fails to respond or submits an unsatisfactory response to the notice, the examining attorney will abandon the application for incomplete response. See TMEP 718.03(b).

See TMEP §717.02 regarding the procedure for handling an applicant's claim that the applicant did not receive the Office action.

718.03(a) Holding of Abandonment for Failure to Respond Completely

Generally, the examining attorney should not hold an application abandoned when an applicant files an incomplete response to a nonfinal action. See TMEP §718.03. However, the examining attorney may hold an application abandoned if the applicant files an incomplete response to a final action, and the time for responding to that action has expired. In such cases, the examining attorney should issue an "Abandoned Due to Incomplete Response" action, without a six-month response clause (see TMEP §705.08), stating that the application is abandoned due to an incomplete response, and explaining why. See TMEP §718.03(c) regarding an applicant's request for reconsideration of an examining attorney's holding of abandonment for failure to file a complete response, and TMEP §1713.01 regarding a petition to the Director for review of the examining attorney's holding of abandonment for failure to file a complete response.

If the examining attorney acts on an incomplete response to a final action before the response period has expired, the examining attorney cannot abandon the application. Instead, the examining attorney should issue an Office action using the "Request for Reconsideration Denied – No Appeal Filed - Time Remaining" (or, if appropriate, "SU - Request for Reconsideration Denied – No Appeal Filed - Time Remaining") selection, without a six-month response clause, explaining why the response is incomplete, and advising the applicant that to avoid abandonment, a proper response must be filed within the period for response to the previous Office action. See TMEP §715.03(a).

If there are less than 30 days remaining in the response period, and the response meets the requirements of 37 C.F.R. §2.65(b), the examining attorney has discretion to issue an “Examiner’s Action Continuing Final Refusal – 30 day Letter,” giving the applicant an additional 30 days to perfect the response. See TMEP §715.03(a).

718.03(b) Granting Additional Time to Perfect Response

Under 37 C.F.R. §2.65(b), the examining attorney has discretion to give an applicant additional time to perfect the response if:

- (1) the response was filed within the six-month period;
- (2) the response was a bona fide attempt to advance the examination;
- (3) the response was a substantially complete response to the examining attorney’s action; and
- (4) consideration of some matter or compliance with some requirement was inadvertently omitted.

If the examining attorney decides that the response meets all four criteria, he or she should issue a notice of incomplete response explaining why the response is incomplete and granting the applicant 30 days, or to the end of the response period set forth in the action, whichever is longer, to complete the response. The examining attorney must not include a six-month response clause in the action.

If the examining attorney grants the applicant additional time to complete a response under 37 C.F.R. §2.65(b), the time for filing an appeal to the Trademark Trial and Appeal Board (or a petition to the Director under 37 C.F.R. §2.63(b)) is not extended. The applicant must file a notice of appeal (or petition) within six months of the issuance date of the final action. 15 U.S.C. §1062(b); 37 C.F.R. §§2.64(b) and 2.142(a).

If the applicant fails to complete the response within the time granted pursuant to 37 C.F.R. §2.65(b), the examining attorney must hold the application abandoned for failure to file a complete response. See TMEP §718.03(a). In this situation, the applicant cannot file a petition to revive due to unintentional delay, pursuant to 37 C.F.R. §2.66. The applicant’s recourse is to file a petition to the Director under 37 C.F.R. §2.146 to reverse the examining attorney’s holding of abandonment. The Director will reverse the examining attorney’s action on petition only if there is clear procedural error (see TMEP §706.01) or abuse of discretion. See TMEP §1713.01.

If an applicant does not receive an action granting additional time to complete a response, or if the applicant is unable to respond to the action due to some other extraordinary circumstance, the applicant may file a petition to the Director to exercise supervisory authority under 37 C.F.R. §2.146. If the

petition is granted, the USPTO will send a notice to the applicant directing the applicant to view the action on the TDR portal on the USPTO website at <http://portal.uspto.gov/external/portal/tow>. The applicant will receive a new 30-day period in which to perfect the response. This does *not* extend the time for filing a notice of appeal to the Board (or petition to the Director under 37 C.F.R. §2.63). 15 U.S.C. §1062(b); 37 C.F.R. §2.142(a).

718.03(c) Reconsideration of Holding of Abandonment

If an examining attorney holds an application abandoned for failure to file a complete response, the applicant may file a request for reconsideration of the examining attorney's holding, arguing that the response was complete. While the examining attorney has no authority to act on an application when no response was filed within the statutory response period, the examining attorney does have the authority to reverse his or her holding as to whether or not a response received during the statutory period was a complete response. If the examining attorney reverses his or her holding of abandonment for failure to file a complete response, the TRAM System must be updated to withdraw the abandonment and show the correct status of the application.

The applicant may also contact the managing attorney or senior attorney and request review of the examining attorney's action. If the managing attorney or senior attorney believes that the holding of abandonment was improper, he or she will direct the examining attorney to reverse the holding of abandonment.

If the examining attorney does not reverse the holding of abandonment, the applicant may petition the Director to reverse the holding. A petition to reverse a holding of abandonment is not the same as a petition to revive an abandoned application. The Director will reverse the examining attorney's holding of abandonment only if there is clear procedural error (see TMEP §706.01) or abuse of discretion. The "unintentional delay" standard does not apply. See TMEP §1713.01.

718.04 Failure to File Statement of Use

Under 15 U.S.C. §1051(d)(4), an application under §1(b) of the Act is abandoned if the applicant fails to timely file a statement of use or request for an extension of time to file a statement of use. 37 C.F.R. §§2.65(c) and 2.88(h); TMEP §§1108.01 and 1109.04.

The ITU/Divisional Unit will abandon the application if the applicant fails to file a statement of use or request for an extension of time to file a statement of use within six months of the issuance date of the notice of allowance, or within a previously granted extension period. The USPTO will send a computer-generated notice of abandonment to the applicant.

If the failure to timely file the statement of use or extension request was unintentional, the applicant may file a petition to revive under 15 U.S.C. §1051(d)(4) and 37 C.F.R. §2.66. See TMEP §§1714 *et seq.*

718.05 Failure to Perfect Appeal

An application may become abandoned because of withdrawal of, or failure to prosecute, an appeal to the Trademark Trial and Appeal Board. 15 U.S.C. §1062(b); TBMP §1203.02(a); TMEP §1501.

An application may also become abandoned because of failure to perfect an appeal, or dismissal of an appeal, to the Court of Appeals for the Federal Circuit or civil court.

See TMEP §718.02(a) regarding partial abandonment due to failure to perfect an appeal.

718.06 Notice of Abandonment for Failure to Respond

If no response is received by the USPTO within six months of the issuance date of an Office action, the application is sent to the examining attorney to be abandoned or partially abandoned, as appropriate. The examining attorney must check the record to ensure that there is no response and that the Office action was sent to the correspondence address of record. See TMEP §§717 *et seq.* regarding reissuing an Office action that was sent to the wrong address due to a USPTO error. The examining attorney must also check to see whether the Office action contained a partial refusal or requirement. See TMEP §718.02(a) regarding partial abandonment.

An application is considered to be abandoned as of the day after the date on which a response was due, even though the examining attorney performs the TRAM transaction that reports the abandonment at a later date. The USPTO sends a computer-generated notice of abandonment to the correspondence address listed in the application.

Applications that are abandoned after *ex parte* appeals or *inter partes* proceedings are considered abandoned as of the date of the action by the Board that caused the application to abandon (e.g., affirming the examining attorney's refusal or sustaining an opposition). However, the TRAM transaction reporting the abandonment is not performed until a month after expiration of the period for appeal from the Board's decision.

718.07 Revival or Reinstatement of Abandoned Application - New Search Required

When an abandoned application is revived or reinstated, the examining attorney must conduct a new search of USPTO records for conflicting marks.

If the search shows that the same examining attorney handled a later-filed conflicting application that has been approved for publication, the examining attorney should request jurisdiction (TMEP §1504.04(a)) and suspend the later-filed application pending disposition of the earlier-filed (revived) application. 37 C.F.R. §2.83(c); TMEP §1208.02(c).

If the new search shows that the same examining attorney handled a later-filed conflicting application that has been approved for registration, the examining attorney should withdraw the application from issue (if possible) and suspend it. However, if a later-filed conflicting application is already registered, the USPTO is without authority to cancel the registration. The examining attorney must refuse registration of the earlier-filed (revived) application under 15 U.S.C. §1052(d). In this situation, an applicant may file a petition to cancel the registration under Section 14 of the Trademark Act, 15 U.S.C. §1064.

If the later-filed conflicting application is being handled by a different examining attorney, the examining attorney handling the earlier-filed (revived) application should e-mail the other examining attorney to notify him or her of the revival or reinstatement. The examining attorney handling the later-filed application will follow the procedures set forth above.

See TMEP §§1714 *et seq.* regarding petitions to revive, TMEP §1712.01 regarding reinstatement of applications abandoned due to USPTO error, and TMEP §1713.01 regarding petitions to reverse an examining attorney's holding of abandonment.

719 Non-Responsive Communications

An inquiry, a request to extend the response period, or a communication on a matter unrelated to the outstanding Office action should be treated as a “non-responsive communication,” not as an incomplete response to an outstanding Office action. If the applicant files a non-responsive communication while an Office action is outstanding, the examining attorney should send the applicant a letter acknowledging receipt of the communication, noting that the communication is non-responsive, and advising the applicant that a response to the outstanding Office action must be received within six months of the issuance date of the outstanding Office action to avoid abandonment. The examining attorney should perform the TRAM transaction indicating that an acknowledgment of receipt of a non-responsive communication has been sent to the applicant. If no response to the Office action is received within six months of the issuance date, the application must be abandoned for failure to respond.

Fraud Upon the USPTO

If an examining attorney suspects the possibility of fraud upon the USPTO in the ex parte examination of a trademark application, the following procedure must be followed.

- (1) The examining attorney must bring the matter to the attention of the managing attorney.
- (2) If the managing attorney concurs with the examining attorney as to the possibility of fraud upon the USPTO, the managing attorney will bring the matter to the attention of the Administrator for Trademark Policy and Procedure.
- (3) If the Administrator believes that the matter warrants further action, he or she will make an appropriate recommendation to the Commissioner for Trademarks.

Under no circumstances should any USPTO communication pertaining to fraud be made, either orally or in writing, by anyone in the Trademark Examining Operation, except as set forth in paragraphs 1 and 2 above.

These issues may ultimately be referred to the Office of Enrollment and Discipline.