

Chapter 1500

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1501 Appeal to Trademark Trial and Appeal Board

15 U.S.C. §1070. An appeal may be taken to the Trademark Trial and Appeal Board from any final decision of the examiner in charge of the registration of marks upon the payment of the prescribed fee.

37 C.F.R. §2.141 Ex parte appeals from action of trademark examining attorney.

(a) An applicant may, upon final refusal by the trademark examining attorney, appeal to the Trademark Trial and Appeal Board upon payment of the prescribed fee for each class in the application for which an appeal is taken, within six months of the date of issuance of the final action. A second refusal on the same grounds may be considered as final by the applicant for purpose of appeal.

(b) The applicant must pay an appeal fee for each class from which the appeal is taken. If the applicant does not pay an appeal fee for at least one class of goods or services before expiration of the six-month statutory filing period, the application will be abandoned. In a multiple-class application, if an appeal fee is submitted for fewer than all classes, the applicant must specify the class(es) in which the appeal is taken. If the applicant timely submits a fee sufficient to pay for an appeal in at least one class, but insufficient to cover all the classes, and the applicant has not specified the class(es) to which the fee applies, the Board will issue a written notice setting a time limit in which the applicant may either pay the additional fees or specify the class(es) being appealed. If the applicant does not submit the required fee or specify the class(es) being appealed within the set time period, the Board will apply the fee(s) to the class(es) in ascending order, beginning with the lowest numbered class.

An appeal from an examining attorney's action is taken to the Trademark Trial and Appeal Board ("Board"), not to a court. An appeal is taken by filing a

notice of appeal and paying the appeal fee within six months of the date of issuance of the action from which the appeal is taken. 15 U.S.C. §1070; 37 C.F.R. §2.142(a). See [Trademark Trial and Appeal Board Manual of Procedure](#) (“TBMP”) §1202.03.

The Trademark Act gives applicants a right to appeal to the Board after a final action by an examining attorney. 15 U.S.C. §1070. Under 37 C.F.R. §2.141(a), a second refusal on the same grounds or a repeated requirement is considered a final action for purposes of appeal as long as all refusals or requirements are repeated in that action. Appeal from a first refusal or requirement, however, is premature.

The applicant must file the notice of appeal and appeal fee within six months of the date of issuance of the final refusal. 37 C.F.R. §2.142(a); TBMP §1202.02. To expedite processing, the United States Patent and Trademark Office (“USPTO”) strongly recommends that applicants file notices of appeal through the Electronic System for Trademark Trials and Appeals (“ESTTA”) at <http://estta.uspto.gov>. If filing on paper, the applicant may use a certificate of mailing or transmission to avoid lateness. See 37 C.F.R. §§2.197 and 2.198, and TMEP §§305.02 *et seq.*, 305.03, and 306.05 *et seq.* regarding certificate of mailing, “Express Mail,” and certificate of transmission procedures. If the applicant does not timely file a notice of appeal and appeal fee, the application is abandoned. 15 U.S.C. §1062(b). If the applicant’s failure to file a proper notice of appeal was unintentional, the applicant may file a petition to revive under 37 C.F.R. §2.66 (see TMEP §§1714 *et seq.*). *Note: The unintentional delay standard of 37 C.F.R. §2.66 does not apply to applications that are abandoned due to an **incomplete** response e.g., a request for reconsideration that is not accompanied by a notice of appeal.* See TMEP §§715.03 *et seq.* regarding requests for reconsideration, and TMEP §1714.01(f)(ii) regarding situations where the unintentional delay standard does not apply.

In appropriate circumstances, after an appeal is filed either the applicant or the examining attorney can request a remand, or the Board may remand the application to the examining attorney. See TBMP §§1209 *et seq.* regarding remand during an appeal. See also TMEP §§1504.05 *et seq.* for further information.

See, generally, 37 C.F.R. §§2.142 and 2.144 and TBMP Chapter 1200 for further information about ex parte appeals to the Board, and 15 U.S.C. §1071, 37 C.F.R. §2.145, and TBMP Chapter 900 regarding appeal to a court from a decision of the Board.

1501.01 Appealable Matter

An applicant who wishes to contest a refusal based on a matter of substance (e.g., a matter arising under §§2, 3, 4, 5, 6, or 23 of the Act of 1946, 15 U.S.C. §§1052, 1053, 1054, 1055, 1056, or 1091), should file an appeal to the Board, not a petition to the Director.

If the only issue in dispute is a question regarding the applicant's compliance with a technical provision of the Trademark Act or Trademark Rules of Practice, the applicant may file a petition to the Director rather than an appeal. See 37 C.F.R. §§2.63 and 2.146. See *also* TMEP §1704 and TBMP §1201.05 regarding petitionable matter versus appealable matter.

An examining attorney's requirement that is the subject of a petition decided on the merits by the Director may not subsequently be the subject of an appeal to the Board. 37 C.F.R. §2.63(b).

1501.02 Appeal Briefs

1501.02(a) Applicant's Appeal Brief

The applicant must file an appeal brief within 60 days of the date of the appeal, or the Board may dismiss the appeal. 37 C.F.R. §2.142(b)(1). See *In re Live Earth Products Inc.*, 49 USPQ2d 1063 (TTAB 1998). If the appeal is dismissed, the applicant may file a motion with the Board to set aside the dismissal and accept a late-filed brief. Applicant may also file a motion to accept a late-filed brief when the time for filing the brief has expired but the Board has not yet issued an order dismissing the appeal. If the Board denies the motion, the applicant may file a petition to the Director under 37 C.F.R. §2.146, asking the Director to review the Board's action. The Director will reverse the Board's action only if the Board clearly erred or abused its discretion. An applicant should not file a petition to the Director until it has *first* filed a request/motion to accept the late-filed brief with the Board, and the Board has denied the request/motion. TBMP §1203.02(a). The applicant may not file a petition to revive under 37 C.F.R. §2.66 when an appeal is dismissed for failure to file a brief. TMEP §1714.01(f)(ii).

The date of appeal for purposes of calculating the due date of the appeal brief is the date on which the notice of appeal and filing fee is received by the USPTO. If the applicant has also filed a request for reconsideration under 37 C.F.R. §2.64, the Board will acknowledge receipt of the appeal and request, suspend further proceedings (including applicant's time for filing its appeal brief), and remand the application to the examining attorney. See TBMP §§1203.02(a) and 1204 for further information. The filing of a request for reconsideration within six months of a final Office action will automatically result in a suspension of the appeal, and an applicant need not file either its appeal brief or a request for an extension of time to file the brief. See TBMP §1204.

The applicant's brief may not exceed twenty-five double-spaced pages in length, and should meet the requirements of 37 C.F.R. §2.126. 37 C.F.R. §2.142(b)(2); TBMP §1203.01. See *In re Thomas*, 79 USPQ2d 1021 (TTAB 2006) (Board refused to consider applicant's 29-page brief).

1501.02(b) Examining Attorney's Appeal Brief

After the applicant's brief has been filed, the Board will send a notice to the examining attorney. The examining attorney has sixty days from the date of the Board's notice to file a responsive brief with the Board and send a copy to the applicant. 37 C.F.R. §2.142(b)(1). See TBMP §1203.02(b).

The examining attorney's appeal brief should be concise and contain a complete statement of reasons for the refusal(s) or requirement(s) and supporting facts.

Examining attorneys should use the format shown in Appendix A as a model when preparing an appeal brief. The purpose of this format is to promote consistency and to provide content guidelines. The substance of the appeal brief is a matter of individual discretion.

The brief may not exceed twenty-five double-spaced pages in length. 37 C.F.R. §2.142(b)(2); TBMP §1203.01. See *In re Thomas*, 79 USPQ2d 1021 (TTAB 2006) (Board refused to consider applicant's 29-page brief).

Because the record must be complete prior to appeal, the Board will normally not consider evidence submitted with the applicant's or examining attorney's brief. However, if the applicant does submit such evidence, the examining attorney should specifically object to such evidence if he or she does not want it to be considered. If the examining attorney does not object to the evidence, and discusses it in his or her brief or elsewhere in the record, the Board will treat it as of record. 37 C.F.R. §2.142(d); TBMP §1207.03; TMEP §710.01(c). See *In re Broyhill Furniture Industries, Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001).

If, during the preparation of the appeal brief, the examining attorney determines that jurisdiction should be restored for further examination (e.g., to make a new refusal, to correct informalities, or to suspend), the examining attorney should submit a request for remand instead of an appeal brief. See TMEP §1504.05(a). If the Board grants the examining attorney's request, the Board will stay further proceedings in connection with the appeal. If the Board denies the request, it will reset the time for submission of the examining attorney's appeal brief.

1501.02(c) Reply Briefs in Ex Parte Appeals

The applicant may file a brief in reply to the examining attorney's appeal brief. Reply briefs must be filed within twenty days of the date of issuance of the

examining attorney's brief. 37 C.F.R. §2.142(b)(1). The examining attorney may not file a written response to the reply brief. However, in the oral argument (if the applicant requests an oral argument), the examining attorney should respond to any significant issues raised in the applicant's reply brief.

1501.03 Withdrawal of Refusal or Requirement After Appeal

If, after considering the applicant's brief or reply brief, the examining attorney believes that the requirement or refusal should be withdrawn, the examining attorney should withdraw the requirement or refusal and approve the application for publication or issue, if it is otherwise in condition for such action. The examining attorney should notify the applicant by telephone or e-mail that the requirement or refusal is withdrawn, and should make an appropriate note in the "Notes-to-the-File" section of the record. This may be done at any time before the Board's decision on appeal. It is not necessary to notify the Board that the refusal or requirement has been withdrawn.

If there is more than one ground of refusal and one ground should be withdrawn, that refusal should be withdrawn and the appeal should go forward on the remaining ground(s). The following language should be included in the examining attorney's brief, informing the applicant of the withdrawal of the refusal or requirement:

The examining attorney acknowledges receipt of the applicant's appeal brief. The examining attorney has withdrawn [specify the refusal or requirement].

1501.04 Fee for Appeal

When filing an ex parte appeal to the Board from the refusal of the examining attorney to register a mark, the applicant must pay a fee for each class in the application for which the appeal is taken. 37 C.F.R. §2.141(b).

The fee for at least one class of goods/services must be paid before expiration of the six-month statutory filing period, or the application is abandoned. If the fee filed with the appeal is sufficient for at least one class of goods/services but insufficient for all the classes in a multiple-class application, and the applicant has not specified the class(es) to which the fee applies, the Board will notify the applicant of the defect, and will set a time limit in which the applicant may either pay the additional fee(s), or limit the appeal to the number of classes for which the fee(s) have been paid. If the applicant does not submit the required fee(s) or specify the class(es) to which the fee applies within the time set in the notice, the fee submitted will be applied to the classes in ascending order, beginning with the lowest-numbered class and including the number of classes in the application for which sufficient fees have been submitted. See 37 C.F.R. §2.141(b); TBMP §1202.04.

1501.05 Amendment During Appeal

If the applicant files an amendment after filing a timely notice of appeal, the examining attorney may not act on it without authorization from the Board, because jurisdiction over the application is with the Board after a notice of appeal is filed. In appropriate cases, the Board may remand the case to the examining attorney to consider the matter presented in the document, with appropriate instructions to the examining attorney regarding consideration of the document and disposition of the case after such consideration. TBMP §1205.

If an application is remanded to the examining attorney to consider an amendment, and the examining attorney determines that the amendment places the application in condition for publication or issue, the examining attorney should notify the applicant by telephone or e-mail that the amendment has been entered, and that the amendment renders the appeal moot. It is not necessary to notify the Board.

1501.06 Amendment After Decision on Appeal

An examining attorney may not take action in an application after the Board has rendered a decision on appeal, because the examining attorney does not have jurisdiction over the application. See *In re U.S. Catheter & Instrument Corp.*, 158 USPQ 54, 55 n.3 (TTAB 1968). After a decision on appeal, the applicant may petition the Director under 37 C.F.R. §2.142(g) to reopen prosecution of the application. If the petition is granted, jurisdiction is restored to the examining attorney to take the specified action.

A petition to reopen prosecution of the application could be granted if the appeal involved the applicant's compliance with a requirement rather than a refusal based on the nature of the mark. See *In re Hickory Mfg. Co.*, 183 USPQ 789 (Comm'r Pats. 1974). However, the Director will deny a petition to reopen prosecution if granting the petition would require further examination (e.g., to consider a claim of acquired distinctiveness under 15 U.S.C. §1052(f) or an amendment to the Supplemental Register). See *In re Petite Suites Inc.*, 21 USPQ2d 1708 (Comm'r Pats. 1991); *In re Vycom Electronics Ltd.*, 21 USPQ2d 1799 (Comm'r Pats. 1986); *In re Mack Trucks, Inc.*, 189 USPQ 642 (Comm'r Pats. 1976). See also TBMP §1218 and cases cited therein.

1501.07 Examining Attorney's Request for Reconsideration

In *In re Ferrero S.p.A.*, 22 USPQ2d 1800 (TTAB 1992), *recon. denied*, 24 USPQ2d 1061 (TTAB 1992), an augmented panel of the Board expressly overruled prior precedent and held that an examining attorney may request reconsideration of a Board decision reversing the examining attorney in an ex parte appeal.

The examining attorney's request must be filed within one month from the date of the Board's decision. 37 C.F.R. §2.144. No new evidence can be introduced with the request. The request should point out any errors of fact or law in the Board's decision.

To request reconsideration, the examining attorney must prepare a request and a supporting brief and submit the request to the managing attorney for concurrence in the decision to seek reconsideration. If the managing attorney concurs, the managing attorney will submit the request for reconsideration and brief to the Administrator for Trademark Policy and Procedure for approval.

If the Administrator approves the request, the examining attorney will file the request with the Board and send a copy to the applicant. The Board will set an appropriate time for the applicant to respond to the request. The examining attorney may not file a reply brief in response to the applicant's brief.

1502 Publication in *Trademark Official Gazette*

After examination of an application is completed and the examining attorney determines that the mark is entitled to registration on the Principal Register, the mark is published in the *Official Gazette* of the USPTO for opposition. 15 U.S.C. §1062; 37 C.F.R. §2.80. Any notice of opposition must be filed within thirty days after the date of publication, or within an extension of time granted by the Board for filing an opposition. 15 U.S.C. §1063(a); 37 C.F.R. §2.101(c); TMEP §1503.03. See TMEP §1503.01 for further information about filing a notice of opposition.

Marks that are found to be registrable on the Supplemental Register are registered when printed in the *Official Gazette*. Marks registered on the Supplemental Register cannot be opposed, but are subject to cancellation under 15 U.S.C. §1064. 15 U.S.C. §1094.

In addition, marks registered on the Principal Register under the intent-to-use provisions of §1(d) of the Act are printed in the *Official Gazette* on the date of issuance of the registration. These marks were previously published for opposition, and are not subject to opposition again. See TMEP §1105 regarding the publication of intent-to-use applications for opposition.

1502.01 Notification of Clerical Errors in *Trademark Official Gazette*

To correct a clerical error in the publication of a mark in the *Trademark Official Gazette*, the applicant or applicant's attorney must file a written request. This request should include the applicant's or attorney's telephone number and e-mail address, and should be e-mailed to

TMPPostPubQuery@uspto.gov. The request should be filed within one week after the date of publication in the *Official Gazette*.

Only purely clerical errors (e.g., a typographical error or omission, drawing printed upside down, or incorrectly stated data) can be corrected by a request(s) sent to this e-mail address. The paralegal specialists in the Office of the Deputy Commissioner for Trademark Examination Policy will review the applicant's request to verify the existence of the clerical error and determine whether the error can be corrected without jurisdiction being restored to the examining attorney or republication being required.

See TMEP §§1505 *et seq.* for information concerning post-publication amendments and when republication is required.

1503 Opposition

1503.01 Filing a Notice of Opposition

Any person who believes that he or she would be damaged by the registration of a mark on the Principal Register may oppose registration by filing a notice of opposition with the Board, and paying the required fee, within thirty days after the date of publication, or within an extension period granted by the Board for filing an opposition. See 15 U.S.C. §1063; 37 C.F.R. §§2.101 through 2.107; TBMP §§303 *et seq.*

The notice of opposition must include a concise statement of the reasons for the opposer's belief that the opposer would be damaged by the registration of the opposed mark, and must state the grounds for opposition. 37 C.F.R. §2.104(a); TBMP §§309.01 *et seq.*

A notice of opposition to an application based on §1 or §44 of the Trademark Act may be filed either on paper or through ESTTA at <http://estta.uspto.gov/>. 37 C.F.R. §2.101(b)(1). A notice of opposition to an application based on §66(a) of the Act *must* be filed through ESTTA. 37 C.F.R. §2.101(b)(2). See *In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019 (TTAB 2005).

A notice of opposition does not have to be verified, and it may be signed by either the opposer or the opposer's attorney. 37 C.F.R. §2.101(b); TBMP §309.02(b).

1503.02 Joining Persons in an Opposition

Two or more persons may join in an opposition. TBMP §303.06. Related companies are separate persons for the purpose of filing an opposition.

1503.03 Time for Opposing

An opposition must be filed within thirty days after the date of publication in the *Official Gazette*, or within an extension period granted by the Board. 15 U.S.C. §1063(a); 37 C.F.R. §2.101(c); TBMP §§306 *et seq.* The time within which to file an opposition is set by statute and may not be extended or waived. *In re Kabushiki Kaisha Hitachi Seisakusho*, 33 USPQ2d 1477 (Comm'r Pats. 1994); *In re Cooper*, 209 USPQ 670 (Comm'r Pats. 1980).

When a registration is issued, inadvertently, from an application that was the subject of a timely filed notice of opposition, the Board is without authority to cancel the registration and restore it to application status. In this situation, the Board will refer the registration file to the Office of the Deputy Commissioner for Trademark Examination Policy for appropriate action. See TBMP §216. See *also* TMEP §1609.10(a) regarding correction of USPTO errors.

1503.04 Extension of Time to Oppose

Requests for extensions of time to oppose are handled by the Board. See TBMP Chapter 200.

A request for an extension of time must be filed within thirty days after the date of publication in the *Official Gazette*, or within an extension period granted by the Board. 15 U.S.C. §1063(a); 37 C.F.R. §2.102(c); TBMP §§202 *et seq.* The time within which to file a request for extension of time to oppose is set by statute and may not be extended or waived. *In re Kabushiki Kaisha Hitachi Seisakusho*, 33 USPQ2d 1477 (Comm'r Pats. 1994); *In re Cooper*, 209 USPQ 670 (Comm'r Pats. 1980).

A request for extension of time to oppose an application based on §1 or §44 of the Trademark Act may be filed either on paper or through ESTTA, at <http://estta.uspto.gov/>. 37 C.F.R. §2.102(a)(1). A request for extension of time to oppose a §66(a) application *must* be filed through ESTTA. 37 C.F.R. §2.102(a)(2). See *In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019 (TTAB 2005).

For additional information regarding filing a request for an extension of time to oppose, see TBMP Chapters 200 and 300.

When a registration is issued, inadvertently, from an application that was the subject of an unexpired extension of time to oppose on the date of registration, the Board is without authority to cancel the registration and restore it to application status. See TBMP §216. In this situation, a request to have the registration cancelled as inadvertently issued should be directed to the Office of the Deputy Commissioner for Trademark Examination Policy. See TMEP §1609.10(a) regarding correction of USPTO errors.

1503.05 Opposition to §66(a) Applications

Section 68(a)(2) of the Trademark Act, 15 U.S.C. §1141h(a)(2), provides that a request for extension of protection is subject to opposition under §13 of the Trademark Act, 15 U.S.C. §1063. The USPTO must notify the International Bureau of the World Intellectual Property Organization (“IB”) within 18 months of the date the IB sends the request for extension of protection to the USPTO of: (1) a notification of refusal based on the filing of an opposition; or (2) a notification of the possibility that an opposition may be filed after expiration of the 18-month period. See TMEP §§1904.03 *et seq.* and 1904.04.

An opposition to a §66(a) application, or a request for extension of time to oppose a §66(a) application, must be filed through ESTTA. 37 C.F.R. §§2.101(b)(2) and 2.102(a)(2). See *In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019 (TTAB 2005).

Once filed, an opposition to a §66(a) application may not be amended to add to the grounds for opposition or to add to the goods or services opposed. 37 C.F.R. §2.107(b).

1504 Jurisdiction over Application

1504.01 Jurisdiction of Examining Attorney

As a general rule, until publication of the mark in the *Official Gazette*, the examining attorney has jurisdiction over the application and can issue a refusal or a requirement without the approval of the Director. See TMEP §1504.03 regarding action by the examining attorney after publication.

In addition, for applications under §1(b) of the Act, 15 U.S.C. §1051(b), the examining attorney has jurisdiction after issuance of the notice of allowance under §13(b) of the Trademark Act, 15 U.S.C. §1063(b). 37 C.F.R. §2.84(a). See TMEP §1107 regarding amendment of a §1(b) application during the period between issuance of a notice of allowance and filing of a statement of use.

There is a time period during which an examining attorney cannot issue an action in an application because the USPTO is unable to withdraw the mark from its scheduled publication in the *Official Gazette*. The USPTO is generally unable to withdraw a mark within the twenty-day period before the scheduled publication date. See TMEP §§1505 *et seq.* regarding the processing of amendments filed during this period.

1504.02 Jurisdiction of Trademark Trial and Appeal Board

The Board has jurisdiction over an application upon the filing of the notice of appeal. The Board may, in response to an examining attorney’s request, on its own initiative, or upon request from the applicant, suspend the appeal and

remand the application to the examining attorney. If an examining attorney wants to issue a new refusal or requirement during an appeal, the examining attorney must file a request for remand with the Board. 37 C.F.R. §2.142(f)(6). See TBMP §§1209.01 and 1209.02; TMEP §1504.05(a). See TMEP §715.04(a) and (b) regarding the examining attorney's action when an application is remanded after the filing of an appeal.

The Board also has jurisdiction over any application in which a notice of opposition has been filed or a concurrent use proceeding has commenced. The Board will approve or disapprove any amendments proposed during an inter partes proceeding. See 37 C.F.R. §2.133; TMEP §1505.01(f); TBMP §§514 *et seq.*

In an application under §1 or §44 of the Act, if an examining attorney wants to issue a new refusal or requirement during an inter partes proceeding, the examining attorney must request that the Board suspend the proceedings and remand the application for further examination. 37 C.F.R. §2.130; TBMP §515. In a §66(a) application, the examining attorney may not request a remand during an opposition. TMEP §1504.05(a); TBMP §515.

A request for an extension of time to file an opposition does not vest jurisdiction in the Board. In this situation, any request by the examining attorney for jurisdiction should be addressed to the Director. See TMEP §§1504.03 and 1504.04(a).

The Board has no jurisdiction over a pending application that has been suspended pending disposition of the applicant's petition to cancel a registration cited under §2(d) of the Trademark Act (see TMEP §716.02(a)), or disposition of the applicant's opposition to an earlier-filed application cited as a potential bar to registration under §2(d) (see TMEP §§716.02(c) and 1208.02(c)). In either situation, if the applicant wants to amend its pending application, or submit a consent agreement, the applicant must file the amendment or the consent agreement with the examining attorney, not with the Board. See 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 a Board proceeding.

1504.03 Action By Examining Attorney After Publication

If it is found necessary, e.g., through internal quality review, for an examining attorney to refuse registration or to make a requirement after a mark has been published for opposition, jurisdiction over the application must be restored to the examining attorney.

With the exception of applications that are the subject of inter partes proceedings before the Board (see TMEP §1504.05(a)), the examining attorney can telephone an applicant and issue an examiner's amendment without restoration of jurisdiction. However, if the examining attorney issues

an Office action, even if merely asking for additional information, the examining attorney must request jurisdiction, because the request for additional information is a “requirement.”

If it is necessary to issue an Office action after publication, the examining attorney must check the status of the application to determine whether the Board has received a notice of opposition. If the Board has not received a notice of opposition, the examining attorney should prepare a request to restore jurisdiction, directed to the Director. See TMEP §1504.04(a). If a notice of opposition has been filed, jurisdiction is with the Board, and the examining attorney should file a request for remand, directed to the Board. See TMEP §1504.05(a).

If a request for an extension of time to file an opposition has been filed, the Board does not have jurisdiction, so the examining attorney must file a request for jurisdiction addressed to the Director.

See TMEP §§1505 *et seq.* regarding amendments proposed by applicants after publication.

1504.04 Restoration of Jurisdiction to Examining Attorney by Director

If it is necessary to refuse registration or to make a requirement after publication and prior to the filing of a notice of opposition or issuance of a notice of allowance, the examining attorney must request that the Director restore jurisdiction so that the examining attorney may take the specified action on the application. See TMEP §1106.02 regarding action by the examining attorney after issuance of a notice of allowance.

Normally, the Director will restore jurisdiction to the examining attorney only if there has been a clear error (see TMEP §706.01). After publication of a mark, a restoration of jurisdiction to the examining attorney is possible only in the case of an application for registration on the Principal Register. A mark found registrable on the Supplemental Register is not published for opposition but is published only when it has registered.

The examining attorney does not have to request jurisdiction to act in a §1(b) application *after* issuance of the notice of allowance. If, after the notice of allowance issues, the examining attorney determines that he or she must issue a new refusal or requirement, the examining attorney must request cancellation of the notice of allowance. However, the examining attorney should not make a refusal or requirement that could or should have been made during initial examination of the application unless the initial failure to make the refusal or requirement was a clear error, and must consult with the managing attorney or senior attorney before taking the action. See TMEP §706.01 regarding “clear error” and TMEP §§1106.02 and 1106.03.

The provisions with respect to requesting jurisdiction over published §66(a) applications are similar to those for applications under §§1(a) and 44 of the Trademark Act. 37 C.F.R. §2.84. However, when deciding whether to grant requests for jurisdiction of §66(a) applications, the Director must consider the time limits for notifying the IB of a refusal of a §66(a) application, set forth in Article 5(2) of the Madrid Protocol and §68(c) of the Trademark Act, 15 U.S.C. §1141h(c). See TMEP §1904.03(a) for further information.

1504.04(a) Request for Jurisdiction

The examining attorney's request for jurisdiction should be in the form of a memorandum to the Director, accompanied by the Office action that the examining attorney proposes to send to the applicant. The request should be signed by the examining attorney, the managing attorney, and the Administrator for Trademark Policy and Procedure.

In the Office action, the examining attorney should apologize for the untimeliness of the action because, at this point, except for possible opposition issues, the applicant is expecting issuance of a registration or notice of allowance. The action should provide a detailed explanation of the basis for the refusal or requirement, citing appropriate case law, even when addressing basic and well-established propositions.

1504.05 Remand to Examining Attorney by Trademark Trial and Appeal Board

The Board, on its own initiative or in response to a request, may remand an application to the examining attorney for consideration of specific facts or issues. See TBMP §§1209 *et seq.* regarding remand during an appeal, and TBMP §515 regarding remand during an inter partes proceeding. A request for remand by the examining attorney to submit additional evidence must include a showing of good cause (which may take the form of a satisfactory explanation as to why the evidence was not filed prior to appeal), and be accompanied by the additional evidence sought to be introduced. See TBMP §1207.02. Absent a remand, no evidence should be submitted to the Board following a notice of appeal, except with or in response to an applicant's timely filed request for reconsideration. 37 C.F.R. §2.142(d); TBMP §1207.01. See TBMP §1207.04 and TMEP §715.03 regarding the submission of evidence with or in response to a request for reconsideration.

On remand, the examining attorney may address only those issues for which the application was remanded. Issues other than those for which the application was remanded may be considered only if the examining attorney requests and is granted an expanded remand. TBMP §1209.02.

The following are examples of circumstances when the Board may remand an application to the examining attorney during an ex parte appeal:

- (1) When evidence that the applicant or the examining attorney wants to include in the record was not previously available (e.g., a recent article, newly issued registration, or recent decision);
- (2) When a new attorney for the applicant, or a new examining attorney, wants to supplement the record made by his or her predecessor;
- (3) When the applicant and the examining attorney agree to a remand; or
- (4) When the examining attorney requests a remand to issue a new requirement or new ground for refusal of registration. See TBMP §1209.02 and TMEP §1504.05(a) regarding an examining attorney's request for remand.

See also TBMP §1207.02.

Where the Board initiates a remand, the examining attorney must take action upon the remanded issue within thirty days of the Board's remand order. 37 C.F.R. §2.142(f)(1); TBMP §1209.01.

1504.05(a) Request for Remand

If it is found necessary to issue a new requirement or new ground for refusal of registration during an ex parte appeal, the examining attorney must request the Board to remand the application so that the examining attorney may take the specified action. 37 C.F.R. §2.142(f)(6); TBMP §1209.02.

In an application under §1 or §44 of the Trademark Act, if it is found necessary to refuse registration or to make a requirement or refusal during an inter partes proceeding before the Board, the examining attorney must request the Board to remand the application so that the examining attorney may take the specified action. 37 C.F.R. §2.130. In a §66(a) application, the examining attorney may not request a remand during an inter partes proceeding.

A request for remand should succinctly explain the specific reasons why remand is requested. That is, the request should be a brief statement of the reason for the request and an explanation of the action the examining attorney intends to take.

1505 Amendments Filed by Applicants After Publication

Applicants sometimes submit amendments after publication. For processing purposes, an "amendment after publication" includes any amendment filed during the time period in which the USPTO is unable to withdraw a mark from its scheduled publication in the *Official Gazette*, or from the scheduled issuance of its registration. The USPTO is generally unable to withdraw a

mark unless the amendment is received and processed at least twenty days before the scheduled publication date or registration issue date.

The following sections discuss the USPTO's procedures and policies for the disposition of amendments after publication.

1505.01 Procedures for Processing Amendments Filed by the Applicant After Publication

1505.01(a) Form and Timing of Amendments

All amendments filed after publication must be submitted in writing. Unless a notice of opposition has been filed, the Office prefers that amendments filed after publication but before issuance of a registration or notice of allowance be filed electronically. In TEAS, the Post-Publication Amendment form can be accessed at <http://www.uspto.gov>. If it is not possible to file the amendment electronically, it should be faxed to Post Publication Amendments/Corrections at 571-270-9007, unless the amendment includes a special form drawing. See 37 C.F.R. §2.195(d)(2) (prohibiting fax transmission of drawing). An amendment filed on paper that includes a special form drawing should be mailed to the following address:

Commissioner for Trademarks
Petitions Office
P.O. Box 1451
Alexandria, Virginia 22313-1451

Requests to correct minor typographical errors entered by the USPTO, inquiries regarding the procedure for submitting a post-publication amendment, or questions regarding the status of a pending post-publication amendment can be e-mailed to TMPostPubQuery@uspto.gov.

Any amendment filed during the pendency of an inter partes opposition proceeding should be filed directly with the Board. See 37 C.F.R. §2.133 and TMEP §1505.01(f).

The USPTO cannot process any amendment filed during the time periods in which the mark cannot be withdrawn from publication in the *Official Gazette* or from issuance of a registration. If a request for amendment relates to a mark that cannot be withdrawn from publication, it will be processed in accordance with the procedures set forth in TMEP §§1505.01(b) through 1505.02(f). If a request for amendment relates to a mark that cannot be withdrawn from issuance of a registration, or that has already registered, the applicant will be instructed to resubmit its request to the Post Registration Section as a request to amend or correct the registration under §7 of the Trademark Act. 15 U.S.C. §1057; 37 C.F.R. §§2.6, 2.173(a), 2.174, and 2.175.

See TMEP §§1107 and 1107.01 regarding amendments to a §1(b) application filed between the issuance of a notice of allowance and the submission of a statement of use, and TMEP §§1609 *et seq.* regarding amendment of a registration under §7(e) of the Trademark Act.

**1505.01(b) Processing Amendments to §§1(a), 44, and 66(a)
Applications in Cases Where No Opposition Has Been
Filed and a Registration Certificate Has Not Yet Issued**

Amendments filed after publication will be reviewed by paralegal specialists in the Office of the Deputy Commissioner for Trademark Examination Policy. If necessary, the application will be withdrawn from issue to ensure that the mark does not register before the amendment has been considered. The paralegal specialists will consult with an attorney, if necessary.

1505.01(b)(i) Acceptable Amendments

If an amendment is acceptable and does not require republication of the mark, the paralegal specialist will enter the amendment and the mark will continue on to the scheduled issue date. See TMEP §1505.03(b) for examples of amendments that do not require republication.

If the amendment is acceptable and republication is required, the paralegal specialist must telephone or e-mail the applicant and inform the applicant that the amendment is acceptable, but requires republication of the mark. If the applicant wishes to pursue the request, the paralegal specialist must make a note in the “Notes-to-the-File” section of the record that the proposed amendment has been accepted, that republication is required, and that the applicant has agreed to the republication. The paralegal specialist will then enter the amendment and set a new publication date. A new notice of publication will be issued. See TMEP §1505.03(a) for examples of amendments that require republication.

1505.01(b)(ii) Unacceptable Amendments

If the paralegal specialist determines that an amendment is unacceptable, the paralegal specialist must provide written notification to the applicant, explaining why the amendment is unacceptable and advising the applicant that: (1) the application will be returned to processing without entry of the requested amendment; and (2) applicant’s only recourse is to file a petition to the Director requesting that jurisdiction be restored to the examining attorney to consider the merits of the amendment. 37 C.F.R. §§2.84 and 2.146. Any petition to the Director must be filed within six weeks of the publication date to ensure that it is timely processed. Thereafter, any request for amendment must be filed pursuant to §7 of the Trademark Act, 15 U.S.C. §1057.

1505.01(c) Processing Amendments to §1(b) Applications In Cases Where No Opposition Has Been Filed and No Notice of Allowance Has Issued

Amendments filed after publication and before issuance of a notice of allowance will be reviewed by paralegal specialists in the Office of the Deputy Commissioner for Trademark Examination Policy. If necessary, the application will be withdrawn from issue to ensure that the notice of allowance does not issue before the amendment has been considered.

1505.01(c)(i) Acceptable Amendments

If the amendment is acceptable and republication is not required, the paralegal specialist will enter the amendment and schedule the mark for issuance of a notice of allowance. See TMEP §1505.03(b) for examples of amendments that do not require republication.

If the amendment is acceptable and republication is required, a paralegal specialist must telephone or e-mail the applicant and inform the applicant that the amendment is acceptable, but requires republication of the mark. If the applicant wishes to pursue the request, the paralegal specialist must make a note in the “Notes-to-the-File” section of the record indicating that the proposed amendment has been accepted, that republication is required, and that the applicant has agreed to the republication. The paralegal specialist will then enter the amendment and set a new publication date. A new notice of publication will be issued. See TMEP §1505.03(a) for examples of amendments that require republication.

1505.01(c)(ii) Unacceptable Amendments

If the paralegal specialist determines that the amendment is unacceptable, the paralegal specialist must provide written notification to the applicant explaining why the amendment is unacceptable and advising the applicant that: (1) the request to amend the application may be resubmitted with the statement of use; or (2) the applicant may file a petition to the Director under 37 C.F.R. §§2.84 and 2.146 requesting that jurisdiction be restored to the examining attorney to consider the merits of the amendment.

See TMEP §§1107 *et seq.* regarding amendments after issuance of the notice of allowance but before the filing of the statement of use.

1505.01(d) Processing Amendments Filed Between Issuance of the Notice of Allowance and Filing of Statement of Use

The only amendments that will be entered in a §1(b) application between the issuance of a notice of allowance and the submission of a statement of use are those outlined in TMEP §1107. See 37 C.F.R. §2.77. All other

amendments will be placed in the record for consideration by the examining attorney during examination of the statement of use. An applicant may file a petition to the Director under 37 C.F.R. §2.146 to waive 37 C.F.R. §2.77 to permit the examining attorney to examine the amendment prior to the filing of a statement of use. See TMEP Chapter 1700 regarding petitions and TMEP §§1107 *et seq.* for further information about amendments filed between the issuance of a notice of allowance and the submission of a statement of use.

1505.01(e) Processing Amendments in Cases Where a Request for Extension of Time to Oppose Has Been Filed or Granted

An amendment of an application that is under an extension of time to file an opposition should be processed in accordance with the procedures set forth in TMEP §§1505.01(b) through (d). The Director retains jurisdiction of such an application until an opposition is actually filed.

It is not necessary for the paralegal specialist to notify the Board of the action taken on the amendment.

The Board will not suspend the potential opposer's time to file a notice of opposition in this situation. See notice at 68 Fed. Reg. 55748, 55760 (Sept. 26, 2003).

1505.01(f) Processing Amendments in Cases Where an Opposition Has Been Filed

If the applicant files an amendment after a notice of opposition has been filed, the Board will act on the amendment under 37 C.F.R. §2.133. The Board has jurisdiction over any application in which an opposition has been filed. See TBMP §§514 *et seq.* for further information about amendment of an application during an opposition.

1505.02 Types of Amendments After Publication

The following subsections discuss the most common types of amendments after publication. Note that there are some restrictions on amendments to §66(a) applications, as discussed below. In addition, only certain amendments are permitted in §1(b) applications between the issuance of the notice of allowance and filing of the statement of use. See 37 C.F.R. §2.77; TMEP §§1107 and 1107.01.

1505.02(a) Amendments to the Identification of Goods or Services

If an applicant proposes to amend the identification of goods/services after publication by *restricting* or *deleting* items in the existing identification, and the amendment is otherwise proper, the USPTO will approve the amendment, and the mark will not be republished. Amendments to add goods/services or

to broaden the scope of an identification are not permitted at any time. See 37 C.F.R. §2.71(a); TMEP §§1402.07 *et seq.*

1505.02(b) Amendments to Classification

In an application under §1 or §44, if the applicant proposes to amend the classification after publication, and the amendment is consistent with the current version of the *Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks*, the USPTO will approve the amendment. Republication is not required.

The international classification of goods/services in a §66(a) application cannot be changed from the classification given to the goods/services by the IB. 37 C.F.R. §2.85(d). See TMEP §1401.03(d).

1505.02(c) Amendments to Marks

In an application under §1 or §44, if the applicant proposes to amend the mark after publication, the amendment is not a material alteration of the mark, and the specimen of record or foreign registration (if applicable) supports use of the mark as amended, the USPTO will approve the amendment and will not republish the mark. If the applicant proposes to amend the mark and the amendment represents a material alteration to the mark, the USPTO will not approve the amendment. See 37 C.F.R. §2.72; TMEP §§807.13 *et seq.* and 807.14 *et seq.*

The mark in a §66(a) application cannot be amended. TMEP §807.13(b).

1505.02(d) Amendments to the Dates of Use

If, in an application under §1(a), the applicant proposes to amend the dates of use to adopt a date of use that is after the filing date of the application, the USPTO will not approve the amendment. See 37 C.F.R. §2.71(c)(1). If, in an application under §1(a), the applicant proposes to amend the dates of use to adopt a date of use that is later than the date originally stated, but before the application filing date, the USPTO will approve the amendment and will republish the mark to provide notice to parties who may have commenced use of a similar mark during the intervening period. If the applicant proposes to amend the dates of use to adopt a date that is before the date originally stated, the USPTO will approve the amendment and will not republish the mark. See TMEP §903.04 for further information about amending the dates of use in a pending application, and TMEP §1609.07 regarding amendment of the dates of use after registration.

1505.02(e) Amendments Adding or Deleting Disclaimers

If an applicant proposes to amend an application after publication to insert a disclaimer, and the amendment is otherwise proper, the USPTO will approve the amendment and will not republish the mark. Likewise, if the USPTO requests the insertion of a disclaimer after publication and the applicant agrees to the disclaimer, the USPTO will enter the disclaimer and will not republish the mark.

If an applicant proposes to amend the application to delete a disclaimer after publication and before issuance of the notice of allowance or registration certificate, and the USPTO determines that the amendment is acceptable, the USPTO will approve the amendment in accordance with the procedures in TMEP §1505.01(c)(i), and will republish the mark. If the amendment deleting the disclaimer is unacceptable, the USPTO will follow the procedures in TMEP §1505.01(c)(ii). The applicant may then resubmit the amendment with the statement of use, or petition the Director to restore jurisdiction of the application to the examining attorney to consider the amendment. See 37 C.F.R. §2.84(a). If the examining attorney eventually approves the amendment, the USPTO will republish the mark.

Republishing is generally required when a disclaimer is deleted after publication (e.g., if printed through a clerical error or originally required by the examining attorney and later determined to be unnecessary).

Exception: If the applicant proposes to amend the mark after publication to delete matter that was the subject of a disclaimer (e.g., generic wording), the USPTO determines that the amendment is not a material alteration of the mark, and the applicant also requests that the disclaimer be deleted, the USPTO will approve the amendment and will not republish the mark.

1505.02(f) Amendment of the Basis

In an application that is not the subject of an inter partes proceeding before the Board, if an applicant wants to add or substitute a basis after publication, the applicant must petition the Director to allow the examining attorney to consider the amendment. If the Director grants the petition, and the examining attorney accepts the added or substituted basis, the mark must be republished. 37 C.F.R. §2.35(b)(2); TMEP §806.03(j). See TMEP §§806.03 *et seq.* regarding amendment of the basis. See 37 C.F.R. §2.133(a) and TBMP §514 regarding the amendment of the basis of an application that is the subject of an inter partes proceeding before the Board.

In a §66(a) application, the applicant cannot change the basis, unless the applicant meets the requirements for transformation under §70(c) of the Act, 15 U.S.C. §1141j(c), and 37 C.F.R. §7.31. 37 C.F.R. §2.35(a). See TMEP §§1904.09 *et seq.* regarding transformation.

In a multiple-basis application, the applicant may delete a basis at any time prior to registration. 37 C.F.R. §2.35(b)(1). No petition is required. See TMEP §806.04(a) regarding the deletion of a §1(b) basis after publication or issuance of the notice of allowance.

1505.02(g) Amendments to the Applicant's Name, Citizenship, or Entity Type

If an applicant proposes to amend an application after publication to correct an inadvertent error in the manner in which its name, entity type, or citizenship is set forth, and the amendment is otherwise proper, the USPTO will approve the amendment and will not republish the mark. See TMEP §1201.02(c) for examples of correctable and non-correctable errors in identifying the applicant.

1505.03 Republication for Opposition

The following sections list examples of post-publication amendments that require republication of the mark and those that do not require republication. If a mark that is the subject of a request for an extension of time to oppose will be republished, the paralegal specialist or the examining attorney who orders the republication must notify the Board that the mark will be republished. See TBMP §214 regarding the effect of republication on marks that are republished during the original thirty-day opposition period or within a granted extension period.

1505.03(a) When Republication is Required

Republication is required after entry of any acceptable post-publication amendment that expands the applicant's rights or would otherwise require notice to third parties. The following list, though not exhaustive, provides examples of amendments that would require republication of the mark:

- Amendment adds or substitutes a basis (37 C.F.R. §2.35(b)(2));
- Unnecessary §2(f) claim is deleted;
- Unnecessary disclaimer is deleted;
- A product, service, or class was deleted by USPTO error and is reinserted into the application;
- A product, service, or class was deleted due to partial abandonment (see TMEP §718.02(a)) and is reinserted upon granting of petition to revive;
- Identification of goods/services is amended to an identification that is narrower in scope than the published identification, but results in a

material difference in the nature of the goods or services (e.g., the mark published for “shoes” in Class 25 and the applicant then amends to “orthopedic shoes” in Class 10);

- An incorrect mark was published due to USPTO error;
- The effective filing date (see TMEP §§206 *et seq.*) changes to a later date;
- The priority filing date under §44(d) (see TMEP §1003) is corrected to a later date;
- In a §1(a) application, either the date(s) of first use or the date(s) of first use in commerce is amended to a date(s) that is later than the date(s) stated (but earlier than the filing date of the application);
- In a §1(b) application for which an amendment to allege use has been filed, either the date(s) of first use or the date(s) of first use in commerce is amended to a date(s) that is later than the date(s) stated (but earlier than the filing date of the amendment to allege use);
- Application is amended to indicate which goods/services are based on §1(a) and which are based on §1(b) in a multiple-basis application that published without such an indication;
- Application is amended to the Principal Register from the Supplemental Register;
- Application is amended from a trademark or service mark to certification mark or vice versa;
- An application with a §44(e) basis is amended to rely on a different foreign registration after publication.

1505.03(b) When Republication is Not Required

Republication is not required after entry of **acceptable** post-publication amendments in the following situations:

- The mark is amended, and the USPTO determines that the amendment is not a material alteration of the mark;
- A multiple-basis application is amended to delete a §1(b) basis;
- The priority filing date under §44(d) (see TMEP §1003) is corrected to an earlier date;

- Identification of goods/services is amended to adopt an identification that is narrower in scope than the published identification and there is no material difference in the nature of the goods or services (e.g., republication is not required if the mark published for “shoes” in Class 25 and the applicant amends to “shoes, namely, running shoes” in Class 25);
- An application that published on the Principal Register is amended to the Supplemental Register;
- The filing date (*see* TMEP §§206 *et seq.*) is amended to an earlier date (*Note:* The filing date change must be approved by the Office of the Deputy Commissioner for Trademark Examination Policy.);
- The date(s) of first use or date(s) of first use in commerce is amended to adopt a date(s) that is earlier than the date(s) originally stated;
- The goods/services were published in the wrong class;
- A disclaimer is added;
- A §2(f) claim is added;
- The applicant’s name, citizenship, or entity type is amended to correct an inadvertent error;
- In a §1(b) application for which a statement of use has been filed, either the date(s) of first use or the date(s) of first use in commerce is amended to a date(s) that is later than the date(s) stated (but earlier than the statutory deadline for filing the statement of use);
- An amendment to show the dates of use in one or more classes for a multiple-class application that published without the dates showing in those classes, when the dates of use appeared on the allegation of use and are the same as or earlier than those that published for the other classes.
- A statement of concurrent use is added.

1506 Concurrent Use Registration Proceeding

A concurrent use registration proceeding is an inter partes proceeding in which the Board determines whether one or more applicants are entitled to concurrent registration. A concurrent registration is one with conditions and limitations, fixed by the Board, as to the mode or place of use of the applicant’s mark or the goods/services on or in connection with which the mark is used. The Board conducts these proceedings after the mark has

been published, and the Board determines whether or not concurrent use registrations should issue. See TBMP Chapter 1100.

See TMEP §§1207.04 *et seq.* regarding the procedure to be followed by examining attorneys in relation to concurrent use.

1507 Interference

An interference is a proceeding in which the Board determines which, if any, of the owners of conflicting applications (or of one or more applications and one or more registrations that are in conflict) is entitled to registration. See 15 U.S.C. §§1066 and 1068.

An interference can be declared only upon petition to the Director. However, the Director will grant such a petition only if the petitioner can show extraordinary circumstances that would result in a party being unduly prejudiced in the absence of an interference. 37 C.F.R. §2.91(a). The availability of an opposition or cancellation proceeding ordinarily precludes the possibility of undue prejudice to a party. Thus, a petitioner must show that there is some extraordinary circumstance that would make the remedy of opposition or cancellation inadequate or prejudicial to the party's rights. Interferences are generally limited to situations where a party would otherwise be required to engage in successive or a series of opposition or cancellation proceedings, and where the issues are substantially the same. See *In re Family Inns of America, Inc.*, 180 USPQ 332 (Comm'r Pats. 1974).

The following matters are not subject to interference: (1) registrations on the Supplemental Register; (2) applications for registration on the Supplemental Register; (3) registrations under the Act of 1920; and (4) registrations of marks that have become incontestable. 37 C.F.R. §2.91(b).

See TMEP §§1208.03 *et seq.* and TBMP Chapter 1000 for more information about interferences.