

# 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 the Examiner of Trademarks. Every applicant for the registration of a mark may, upon final refusal by the Examiner of Trademarks, 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. An appeal which includes insufficient fees to cover all classes in the application should specify the particular class or classes in which appeal is taken. A second refusal on*

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*the same grounds may be considered as final by the applicant for purpose of appeal.*

An appeal from an examining attorney's action is taken to the Trademark Trial and Appeal 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 mailing date 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 Trademark Trial and Appeal Board after a *final* action by an examining attorney. 15 U.S.C. §1070. Under 37 C.F.R. §2.141, an applicant may consider a second refusal on the same grounds or a repeated requirement to be final for the purpose of appeal. Appeal from a first refusal or requirement, however, is premature.

The applicant must file the notice of appeal and appeal fee within six months from the mailing date of final refusal. 37 C.F.R. §2.142(a); TBMP §1202.02. If the applicant does not timely file a notice of appeal and appeal fee, the application is abandoned. 15 U.S.C. §1062(b). See 37 C.F.R. §§2.197 and 2.198, and TMEP §§305.02, 305.03 and 306.05 *et seq.* regarding certificate of mailing, certificate of transmission and "Express Mail" procedures to avoid lateness. 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.*)

When an applicant files a notice of appeal, Office personnel must refer the notice and application record to the Trademark Trial and Appeal Board. In appropriate circumstances, the Board will remand the application to the examining attorney. See TBMP §§1204 and 1209. Where the Board initiated the remand, the examining attorney must take action upon the remanded issue within 30 days. See 37 C.F.R. §2.142(f)(1).

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. 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 that request/motion has been denied. TBMP §1203.02(a). The applicant cannot 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 the notice of appeal and filing fee is received by the Office. If the applicant has also filed a request for reconsideration under 37 C.F.R. §2.142, the appeal is

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considered suspended until the examining attorney acts upon the request for reconsideration, returns the file to the Board, and the Board resets the time for applicant to file its appeal brief. See TBMP §1204.

See 37 C.F.R. §§2.142 and 2.144 and TBMP Chapter 1200 for further information about *ex parte* appeals to the Trademark Trial and Appeal Board.

See 37 C.F.R. §2.145 and TBMP Chapter 900 regarding appeal to a court from the decision of the Trademark Trial and Appeal 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 and 23 of the Act of 1946, 15 U.S.C. §§1052, 1053, 1054, 1055, 1056 or 1091), should file an appeal to the Trademark Trial and Appeal 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 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           Examining Attorney's Appeal Brief**

After the appellant'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 appellant. 37 C.F.R. §2.142(b). See TBMP §1203.02(b).

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

If the applicant submits new evidence with its brief, the examining attorney should object, because the record must be complete prior to appeal. 37 C.F.R. §2.142(d); TMEP §710.01(c). The examining attorney should raise objections to evidence as soon as possible, and continue the objection in his or her brief, or the Board may

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consider the objection to be waived. TBMP §1207.03. 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.

Either the applicant or the examining attorney can request a remand. A request for remand to introduce 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 request for remand to introduce additional evidence with a showing of good cause, no evidence should be submitted to the Board following a notice of appeal. See TBMP §1207.01.

### **1501.02(a)      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 from the date of mailing of the examining attorney's brief. 37 C.F.R. §2.142(b)(1). It is not appropriate for the examining attorney to 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 appellant's brief or reply brief, the examining attorney believes that the requirement or refusal is not tenable, 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 that the requirement or refusal is withdrawn, and should make an appropriate note to the file. 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 is no longer tenable, that refusal should be withdrawn and the appeal should go forward on the remaining ground(s). The following language is appropriate for informing the appellant of the withdrawal of the refusal or requirement in such a case:

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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 Trademark Trial and Appeal 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.

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, 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. See 37 C.F.R. §2.85(e); TBMP §1202.04.

### **1501.05 Amendment During Appeal**

If the applicant files an amendment after filing a timely notice of appeal, the Board must act on the amendment, 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 paper, with appropriate instructions to the examining attorney regarding consideration of the paper 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 that the amendment has been entered, and that the amendment renders the appeal moot.

### **1501.06 Amendment After Decision on Appeal**

An examining attorney may not take action in an application after the Trademark Trial and Appeal Board has rendered a decision on appeal, because the examining attorney does not have jurisdiction of the application. See *In re U.S. Catheter & Instrument Corp.*, 158 USPQ 54 (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. For example, the Director may reopen prosecution to

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permit the applicant to comply with a requirement for a new drawing, if this would place the application in condition for publication of the mark without further examination. 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).

### **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 Trademark Trial and Appeal 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.

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 United States Patent and Trademark Office 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 Trademark Trial and Appeal Board for filing an opposition. 15 U.S.C. §1063; 37 C.F.R. §2.101(c); TMEP §1503.03. See 37 C.F.R. §§2.197 and 2.198 and TMEP §§305.02, 305.03 and 306.05 *et seq.* regarding certificate of mailing, certificate of transmission and "Express Mail" procedures to avoid lateness.

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.

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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 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 directed to the Photocomposition Coordinators in the Publication and Issue Section of the Office. The request should be filed within one week after the date of publication in the *Official Gazette*.

The Photocomposition Coordinators can only correct errors that are purely clerical (e.g., a typographical error or omission, drawing printed upside down, or incorrectly stated data). The Photocomposition Coordinator will review the applicant's request and verify the existence of the clerical error, determine whether the error can be corrected without jurisdiction being restored to the examining attorney or republication being required, and coordinate the appropriate correction procedure.

### **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 Trademark Trial and Appeal 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 of §44 of the Trademark Act may be filed either on paper or through the Electronic System for Trademark Trials and Appeals ("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).

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### 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; 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).

See TBMP §216 regarding the handling of a registration that is issued, inadvertently, after the timely filing of a notice of opposition.

### 1503.04 Extension of Time to Oppose

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

A written 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; 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).

The request for extension of time to oppose should specify the period of extension desired, and be addressed to the Trademark Trial and Appeal Board. 37 C.F.R. §2.102(c); TBMP §203.01.

No more than three requests to extend the time for filing an opposition may be filed, as follows:

- (1) A first request of thirty days will be granted on request, without a showing of cause. Alternatively, a first request of ninety days will be granted upon a showing of good cause. 37 C.F.R. §2.102(c)(1).
- (2) If the first request was for thirty days, a second request for sixty days will be granted upon a showing of good cause. 37 C.F.R. §2.102(c)(2).
- (3) After receiving extensions totaling ninety days, a final request for sixty days will be granted with the consent of the applicant or upon a showing of extraordinary circumstances. 37 C.F.R. §2.102(c)(3).

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The Board will not grant an extension of time to oppose aggregating more than 180 days from the date of publication. 37 C.F.R. §2.102(c).

The request for extension of time to oppose must be signed by either the potential opposer or the potential opposer's attorney. TBMP §203.03.

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).

An extension of time to oppose is a personal privilege, and the right to oppose will be granted only to the person who requested the extension of time. TBMP §303.05(a). Therefore, great care should be taken to ensure that an extension request clearly and accurately identifies the potential opposer. See 37 C.F.R. §2.102(b) and TBMP §206.03 regarding the misidentification of the name of a party filing an opposition or extension request, and TBMP §§206.02 and 303.05(b) regarding notices of opposition and extension requests filed by persons who are in privity by reason of having the same right or interest, such as related companies under 15 U.S.C. §1055.

See TBMP §216 regarding the handling of a registration that is issued, inadvertently, from an application that was the subject of an unexpired extension of time to oppose on the date of registration.

### **1503.05            Opposition Fee**

The opposer must pay a fee for each international class in the application that is being opposed. 37 C.F.R. §2.6; TBMP §308.

When two or more persons are joined in an opposition, a fee must be paid by each person for each class. See TBMP §303.06 regarding joining persons in an opposition.

The opposition must be accompanied by the required fee for each party joined as opposer for each class in the application for which registration is opposed. 37 C.F.R. §§2.101(d)(1) and (2).

### **1503.06            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. The United States Patent and Trademark Office ("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

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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. In addition, for applications under §1(b) of the Act, 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 §1504.03 regarding action by the examining attorney after publication, and 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.

#### **1504.02 Jurisdiction of Trademark Trial and Appeal Board**

The Trademark Trial and Appeal 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 or on its own initiative, suspend the appeal and remand the case 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).

The Board also has jurisdiction over any application in which a notice of opposition has been filed. The Board will approve or disapprove any amendments proposed during an opposition proceeding. See 37 C.F.R. §2.133; TMEP §1505.02(d); 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 opposition, the examining attorney must file a "Request for Remand" with the Board. In a §66(a) application, the examining

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attorney may not request a remand during an opposition. 37 C.F.R. §2.130; TMEP §1504.05(a).

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).

### **1504.03            Action By Examining Attorney After Publication**

If it is found necessary, e.g., through internal quality review by the Office, 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. It is not necessary for the examining attorney to notify the Board that he or she proposes to take action on the application.

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 of the mark for opposition and prior to the filing of a notice of opposition (see TMEP §1504.02), the examining attorney must request that the Director restore jurisdiction so that the examining attorney may take the specified action on the application. As noted in TMEP §1504.01, however, the examining attorney does not have to request jurisdiction to act in a §1(b) application after issuance of the notice of allowance.

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Normally, the Director will restore jurisdiction to the examining attorney only if there has been a clear error.

After actual 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 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. See TMEP §1904.03(a).

### **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 Trademark Trial and Appeal Board, on its own initiative or in response to a request, may remand an application to the examining attorney for consideration of specific facts. See TBMP §1209 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 request for remand for additional evidence with a showing of good cause, no evidence should be submitted to the Board following a notice of appeal. See TBMP §1207.01.

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

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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's attorney 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; or
- (3) When the applicant and the examining attorney agree to a remand.

See TBMP §1207.02.

The examining attorney should take action on the application within thirty days of the Board's remand order.

### **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 during an *inter partes* proceeding before the Trademark Trial and Appeal Board, the examining attorney must request the Board to remand the application so that the examining attorney may take the specified action. In a §66(a) application, the examining attorney may not request a remand during an *inter partes* proceeding. 37 C.F.R. §2.130.

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 will sometimes submit amendments after publication. The Office has established the following procedures and policies for the disposition of such amendments. An "amendment after publication" includes any amendment filed after the Office is unable to delete the mark from its scheduled publication in the *Official Gazette*. The Office is generally unable to delete a mark unless the amendment is filed at least twenty days before the scheduled publication date.

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### **1505.01            Approval of Amendments After Publication**

#### **1505.01(a)            Amendments to the Identification of Goods or Services**

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

Amendments to an identification to add goods or services or to broaden its scope are not permitted at any time. See 37 C.F.R. §2.71(a); TMEP §§1402.06 and 1402.07 *et seq.*

#### **1505.01(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 Office 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. See TMEP §1401.03(d).

#### **1505.01(c)            Amendments to Drawings**

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 Office 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 Office will not approve the amendment. See 37 C.F.R. §2.72; TMEP §§807.13 and 807.14 *et seq.*

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

#### **1505.01(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 Office 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 filing date, the Office will approve the amendment and will republish the mark to provide notice to parties who

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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 Office will approve the amendment and will not republish the mark.

See TMEP §903.05 for more information about amending the dates of use in a pending application, and TMEP §1609.07 regarding amendment of the dates of use after registration.

### **1505.01(e) Amendments Adding or Deleting Disclaimers**

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

If the applicant proposes to amend the application to delete a disclaimer after publication and before issuance of the notice of allowance, the applicant must petition the Director to restore jurisdiction of the application to the examining attorney to consider the amendment. If a notice of allowance has issued, however, the examining attorney has jurisdiction to consider the amendment, and a petition to the Director to restore jurisdiction is unnecessary. See 37 C.F.R. §2.84(a). If the examining attorney eventually approves the amendment, the Office will republish the mark. Republication is always 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). See TMEP §1107 regarding processing an amendment to a §1(b) application filed between the issuance of a notice of allowance and the submission of a statement of use.

### **1505.01(f) Amendment of the Basis**

In an application that is not the subject of an *inter partes* proceeding before the Trademark Trial and Appeal Board, if an applicant wants to add or substitute a basis after publication, the applicant must first 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.

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 regarding transformation.

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See 37 C.F.R. §2.133(a), TMEP §1505.02(d), and TBMP §514 regarding the amendment of the basis of an application that is the subject of an *inter partes* proceeding before the Trademark Trial and Appeal Board. No petition is necessary in this situation.

In a multi-basis application, the applicant may delete a basis at any time prior to registration. 37 C.F.R. §2.35(b)(1). See TMEP §806.04(a) regarding the deletion of a §1(b) basis after publication or issuance of the notice of allowance.

### **1505.02                    Procedures for Processing Amendments Filed by the Applicant After Publication**

#### **1505.02(a)              Form and Timing of Amendments**

All amendments after publication must be submitted in writing. Unless a notice of opposition has been filed, correspondence that is filed after publication but before issuance of a registration or notice of allowance should be directed to the examining attorney. If republication or issuance of an Office action is not necessary, an application under §1(a), §44, or §66(a) that is not the subject of an *inter partes* proceeding before the Trademark Trial and Appeal Board may be amended before the certificate of registration is printed.

If the amendment would require republication or issuance of an Office action, an applicant who wants to amend an application must file a petition to the Director to restore jurisdiction of the application to the examining attorney for consideration of the amendment and further examination. 37 C.F.R. §2.84(b). The petition should be directed to the Office of the Commissioner for Trademarks. See TMEP §1504.04 regarding requests for jurisdiction in §66(a) applications.

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 regarding amendment of a registration under §7(e) of the Trademark Act, 15 U.S.C. §1057(e).

Any amendment filed during the pendency of a Board *inter partes* proceeding should be filed with the Board. See 37 C.F.R. 2.133.

#### **1505.02(b)              Processing Amendments in Cases Where No Opposition Has Been Filed**

Except for amendments to allege use filed in connection with §1(b) applications (see TMEP §1104.04 regarding timely amendments to allege use located after publication, and TMEP §1104.03(c) regarding amendments to allege use filed during the blackout period), Office personnel will route amendments filed after publication to the examining attorney.

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If the examining attorney approves the amendment and republication is required, the examining attorney should send the applicant a letter advising the applicant that the amendment will be entered, that the mark will be republished, and that the applicant will receive a notice of the new publication date.

If the examining attorney determines that the amendment cannot be approved, the examining attorney should send the applicant a letter notifying the applicant that the amendment cannot be approved. The examining attorney will explain the reason(s) why the amendment cannot be approved and advise the applicant that the applicant's 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. The examining attorney will then return the application to processing for issue without entry of the amendment.

### **1505.02(c) 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 §1505.02(b). The Director retains jurisdiction of such an application until an opposition is actually filed.

It is not necessary for the examining attorney to notify the Trademark Trial and Appeal 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).

### **1505.02(d) 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 Trademark Trial and Appeal Board will act on the amendment under 37 C.F.R. §2.133. The Board has jurisdiction in any application once an opposition has been filed. See TBMP §§514 *et seq.* for further information about amendment of an application during an opposition.

## **1506 Concurrent Use Registration Proceeding**

A concurrent use registration proceeding is an *inter partes* proceeding in which the Trademark Trial and Appeal Board determines whether one or more applications is entitled to a concurrent registration, that is, a registration 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

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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 Trademark Trial and Appeal 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). 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). Interference normally is considered to be a duplication of remedies for situations that can ordinarily be handled expeditiously by opposition or cancellation proceedings.

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.