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1601 **Types of Registrations**

1601.01 **Registrations Now Being Issued**

Currently, the United States Patent and Trademark Office (“USPTO”) issues registrations only under the Trademark Act of 1946, 15 U.S.C. §§1051 *et seq.* These are either Principal Register registrations or Supplemental Register registrations. See TMEP §801.02(a) regarding the Principal Register, and TMEP §801.02(b) regarding the Supplemental Register.

1601.01(a) **Certificate of Registration**

The USPTO issues registration certificates for all registrations resulting from applications based on §§1, 44 and 66(a) of the Trademark Act. The registration certificate includes the owner’s name and address, the mark, the goods/services, and the international class(es). The certificate is placed in a registration jacket cover under seal and is signed by the Director of the USPTO.

1601.01(b) **Duplicate Certificate of Registration**

If the owner of the registration does not receive the original certificate of registration *and* there is proof in the record that non-receipt was due to a USPTO error (*e.g.*, if the USPTO failed to properly enter a notice of change of address filed before the mailing date of the registration certificate), the USPTO will issue a duplicate certificate of registration if the owner files a written request for a duplicate certificate within one year of the registration date.

The owner of a registration may obtain a certified copy of the registration from the Certification Division of the Office of Public Records for a fee (see TMEP §111).

1601.01(c) **Registered Extension of Protection of International Registration to the United States**

Effective November 2, 2003, §66(a) of the Trademark Act, 15 U.S.C. §1141f(a), permits the holder of an international registration to file a request for extension of protection of the international registration to the United States. See TMEP §§1904 *et seq.*

Unless the request for extension of protection is refused under §68 of the Trademark Act, the USPTO will issue a certificate of extension of protection and publish notice of such certificate in the *Official Gazette*. Section 69(a) of the Trademark Act, 15 U.S.C. §1141i(a). The certificate of registration will look the same as the certificates issued for registrations resulting from applications based on §§1 and 44 of the Act. From the date of issuance of

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the certificate, the extension of protection has the same effect and validity as a registration on the Principal Register, and the holder of the international registration has the same rights and remedies as the owner of a registration on the Principal Register. Section 69(b) of the Trademark Act, 15 U.S.C. §1141i(b).

Under §66(b), unless the extension of protection is refused, the proper filing of the request for extension of protection constitutes constructive use of the mark, conferring the same rights as those specified in §7(c) of the Trademark Act, as of the earliest of the following:

- (1) The international registration date, if the request for extension of protection was made in the international application;
- (2) The date of recordal of the subsequent designation requesting an extension of protection to the United States, if the request for extension of protection to the United States was made in a subsequent designation; or
- (3) The date of priority claimed pursuant to §67 of the Trademark Act.

Upon registration, the USPTO will refer to an extension of protection to the United States as a “registration” or a “registered extension of protection.” 37 C.F.R. §7.25(c).

A registered extension of protection remains part of the international registration after registration in the United States. In this respect, the registered extension of protection differs from a registration issuing from a §44 application, which exists independent of the underlying foreign registration, pursuant to §44(f).

A registered extension of protection cannot be amended under §7 of the Trademark Act. See TMEP §1609.01(a).

1601.02 Repeal of Prior Acts

The Act of 1946 became effective on July 5, 1947. Most Acts relating to trademarks that existed prior to the Act of 1946 were repealed as of the effective date of the Act of 1946. Repealed Acts include the Act of 1881, Act of 1905, Act of 1920, and the amendment entitled “Act of June 10, 1938.” The repeal did not affect the validity of registrations granted under prior Acts. Trademark Act §46(a), 15 U.S.C. §1051 note.

1601.03 Additional Registration under Act of 1946

Marks that were registered under any previous Act may be registered again, under the Act of 1946, if the mark meets the requirements of the Act of 1946. Trademark Act §46(b), 15 U.S.C. §1051 note. However, the USPTO will not

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issue duplicate registrations for marks that are registered under the 1946 Act. See TMEP §703.

1601.04 1881 and 1905 Act Registrations

Registrations that were issued under the Acts of 1881 and 1905 may be renewed under §9 of the Act of 1946, 15 U.S.C. §1059. These registrations are subject to, and entitled to the benefits of, the provisions of the Act of 1946 as though registered on the Principal Register of the Act, except with certain limitations that are set out in §46(b). Some of these limitations can be removed if the registrant claims the benefits of the Act of 1946 under §12(c), 15 U.S.C. §1062(c). See TMEP §1603.

Marks registered under the “10-year proviso” of §5 of the Act of 1905 are deemed to have become distinctive of the goods or services under §2(f) of the Act of 1946. Trademark Act §46(b), 15 U.S.C. §1051 note.

See TMEP §1602.02 regarding the duration of and requirements for maintaining registrations issued under the Acts of 1881 and 1905.

1601.05 1920 Act Registrations

Registrations under the Act of 1920 are subject to, and entitled to the benefits of, the provisions of the Act of 1946 relating to marks registered on the Supplemental Register, and may not be renewed unless renewal is required to support a foreign registration. Trademark Act §46(b), 15 U.S.C. §1051 note.

See TMEP §1602.03 regarding the duration of and requirements for maintaining registrations issued under the Act of 1920.

1601.06 Registrations Issued Under Prior Classification Systems

Prior to September 1, 1973, the United States used its own system for classification of goods and services, which is different from the international classification system. For all registrations issued on the basis of an application filed on or before August 31, 1973, the classification under which the registration issued governs for all statutory purposes, including affidavits under §8, 15 U.S.C. §1058, and renewal applications under §9, 15 U.S.C. §1059. See 37 C.F.R. §2.85.

As of September 1, 1973, the international system for classification of goods and services is the primary classification system used by the United States, and it applies to all applications filed on or after September 1, 1973, and their resulting registrations, for all statutory purposes. See TMEP §1401.02.

A registrant whose registration issued under the U.S. classification system may voluntarily amend the registration under §7 of the Trademark Act to

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adopt the international classification set forth in the current version of the *Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks* ("Nice Agreement"). The registrant must pay the filing fee required for Section 7 amendments under 37 C.F.R. §2.6. See TMEP §1609.04.

1601.07 Form of Copies of Registrations

Before August 24, 1920, the name of the Act under which a registration was issued was not designated on the copy of the registration on file in the Trademark Search Library. Beginning with registrations issued on August 24, 1920, there is printed in the heading of each registration either the words "Act of Feb. 20, 1905" or the words "Act of Mar. 19, 1920." The first registrations under the Act of 1920 apparently were issued on August 24, 1920.

Registrations under the Act of 1881 range from Number 8,191, issued on May 17, 1881, through Number 44,357, issued on March 28, 1905. No registrations were issued between March 28, 1905, and July 4, 1905. On July 4, 1905, the first registration under the Act of 1905 was issued as Number 44,358.

The Act of 1946 provides that the certificates of registration for marks registered on the Supplemental Register shall be conspicuously different from certificates issued for marks registered on the Principal Register. Trademark Act §25, 15 U.S.C. §1093. Certificates issued under the 1946 Act are clearly marked either "Principal Register" or "Supplemental Register," with the date the application was filed.

1602 Duration and Maintenance of Registrations

The Trademark Act of 1946, 15 U.S.C. §§1051 *et seq.*, became effective on July 5, 1947, and as of that date the Trademark Acts of 1881, 1905 and 1920 were repealed insofar as they were inconsistent with the Act of 1946. Trademark Act §46(a), 15 U.S.C. §1051 note.

The duration of registrations has varied, depending upon the Act under which the registration was issued. See TMEP §§1602.01, 1602.02, 1602.03, and 1614.

1602.01 Act of 1946

Registrations Resulting From Applications Under §1 and §44

The Trademark Law Revision Act of 1988, Pub. L. No. 100-667, 102 Stat. 3935, which took effect on November 16, 1989, amended §9 of the Trademark Act of 1946 to reduce both the duration of registration and the

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term of renewal from twenty to ten years. All registrations issued or renewed on or after November 16, 1989 are issued or renewed for a ten-year period.

Thus, registrations issued under the Act of 1946 on or after November 16, 1989, remain in force for ten years, provided that affidavits of use or excusable nonuse are filed under §8 of the Act. 37 C.F.R. §2.181(a)(2). See 37 C.F.R. §2.160(a) and TMEP §1604.04 regarding the due dates for affidavits of use or excusable nonuse. Registrations issued under the Act of 1946 before November 16, 1989, remain in force for twenty years, provided that an affidavit or declaration of use or excusable nonuse was filed during the sixth year after the date of registration. 37 C.F.R. §2.181(a)(1). See TMEP §§1604 *et seq.* regarding affidavits of use under §8 of the 1946 Act.

Effective November 16, 1989, registrations under the Act of 1946 may be renewed for periods of ten years from the end of the expiring period. 37 C.F.R. §2.181(a). Before November 16, 1989, registrations under the Act of 1946 were renewed for 20-year periods. The applicable term for renewals that were processed during the transition depends on whether the USPTO granted renewal before or after November 16, 1989. If the USPTO granted renewal before November 16, 1989, the renewal term is twenty years; if the USPTO granted renewal on or after November 16, 1989, the renewal term is ten years. *In re Maytag Corp.*, 21 USPQ2d 1615 (Comm'r Pats. 1991). See TMEP §§1606 *et seq.* regarding renewal under §9 of the 1946 Act.

Registered Extensions of Protection

Section 9 of the Trademark Act does not apply to registered extensions of protection of international registrations to the United States. Renewal of an international registration and its corresponding extension of protection to the United States must be made at the International Bureau of the World Intellectual Property Organization ("IB"), in accordance with Article 7 of the Madrid Protocol. 37 C.F.R. §7.41(a). See TMEP §1614 for further information about renewal of international registrations.

Section 71 of the Act requires the periodic filing of affidavits of use in commerce or excusable nonuse for registered extensions of protection. See TMEP §1613 regarding due dates and requirements for §71 affidavits.

1602.02 Acts of 1881 and 1905

Registrations under the Act of 1905 were issued for an original term of twenty years, and were renewable for 20-year periods. Registrations under the Act of 1881 were issued for an original term of thirty years, and were renewable under the Act of 1905 for 20-year periods.

Effective November 16, 1989, registrations issued under the 1905 Act and the 1881 Act are renewable under the 1946 Act for periods of ten years. Before

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November 16, 1989, registrations issued under the 1905 Act and the 1881 Act were renewable under the 1946 Act for periods of twenty years. Trademark Act §46(b), 15 U.S.C. §1051 note; 37 C.F.R. §2.181(b).

Both a 1905 Act and 1881 Act registrant may file an affidavit or declaration under §12(c) of the Trademark Act, 15 U.S.C. §1062(c), to claim the benefits of the 1946 Act, without affecting the term of the registration. See TMEP §1603. Under §8(a)(2) of the 1946 Act, if the registrant claims the benefits of the 1946 Act, the registrant must file an affidavit or declaration of use or excusable nonuse within the sixth year after publication of the notice of the §12(c) claim in the *Official Gazette*, to avoid cancellation. See TMEP §§1604 *et seq.* regarding affidavits or declarations of use or excusable nonuse.

Under §8(a)(3) of the 1946 Act, 1905 Act and 1881 Act registrants must file affidavits of use or excusable nonuse at the end of each successive ten-year period following the date of registration, even if the registrant does not claim the benefits of the 1946 Act under §12(c) of the Act. However, this requirement does not apply to a registration renewed for a 20-year term (*i.e.*, a registration renewed prior to November 16, 1989) until a renewal application is due. See TMEP §1604.04(b).

1602.03 Act of 1920

The Act of 1920 did not specify any term of registration. However, the Act of 1946 provided that 1920 Act registrations would expire six months after July 5, 1947 (the effective date of the 1946 Act), or twenty years from the date of registration, whichever was later. A 1920 Act registration may not be renewed unless renewal is required to support a foreign registration, in which case the registration may be renewed on the Supplemental Register for a ten-year period, in the same manner as a registration issued under the 1946 Act. Trademark Act §46(b), 15 U.S.C. §1051 note; 37 C.F.R. §2.181(c). See TMEP §§1606 *et seq.* regarding renewal.

The requirement that renewal be necessary to support a foreign registration applies to all renewals of a 1920 Act registration, not just the first renewal. *Ex parte U.S. Steel Corp.*, 157 USPQ 435 (Comm'r Pats. 1968).

The application for renewal of a 1920 Act registration should identify the foreign registration(s) that the renewal is needed to support, the country, the name of the present owner, the registration number and the date of registration, and must show that the foreign registration(s) are currently in force.

Under §8(a)(3) of the 1946 Act, an affidavit or declaration of use or excusable nonuse under §8 is also required at the end of each successive ten-year period following the date of registration. However, this requirement does not apply to a registration renewed for a 20-year term (*i.e.* a registration renewed

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prior to November 16, 1989) until a renewal application is due. See TMEP §1604.04(b).

1602.04 Trademark Law Treaty Implementation Act Changes

The Trademark Law Treaty Implementation Act of 1998 (“TLTIA”), Pub. L. No. 105-30, 112 Stat. 3064, changed the requirements for filing affidavits or declarations of use or excusable nonuse under 15 U.S.C. §1058 (“§8 affidavits”), and renewal applications under 15 U.S.C. §1059, effective October 30, 1999. See *Post Registration: Changes to Requirements for Maintaining Trademark Registrations*, at 1228 TMOG 187 (Nov. 30, 1999), available at www.uspto.gov, for a discussion of these changes.

TLTIA did not change the duration of registrations. See TMEP §§1602 *et seq.* regarding the term of registrations.

1603 Bringing Prior Act Registrations Under 1946 Act, §12(c)

Owners of marks registered under the Acts of 1905 or 1881 may claim the benefits of the Act of 1946, but are not required to do so. Trademark Act §12(c), 15 U.S.C. §1062(c). The 1946 Act refers to a “registrant” claiming the benefits of the Act. The term “registrant” includes both the original registrant and a person who has acquired ownership through proper transfer of title. See 15 U.S.C. §1127. The claim must be made by the person who owns the mark at the time the claim is made.

To claim the benefits of the Act of 1946, the owner of the registration must file an affidavit or a declaration under 37 C.F.R. §2.20. The affidavit or declaration must: (1) set forth those items listed in the registration on which the mark is currently in use in commerce, specifying the nature of such commerce; and (2) state that the benefits of the Act of 1946 are claimed for the mark. The affidavit must be accompanied by the fee required by 37 C.F.R. §2.6. 37 C.F.R. §2.153. No specimen is required. Goods or services not listed in the affidavit will be deleted from the registration. The affidavit or declaration under §12(c) of the Act may be filed at any time during the life of the registration.

A claim of the benefits of the 1946 Act does *not* affect or alter the *term* of the 1905 or 1881 Act registration. These registrations still remain in force for the times indicated in TMEP §1602.02, *subject to cancellation if acceptable affidavits of use or excusable nonuse are not filed under 15 U.S.C. §1058*. The deadline for *renewal* (and the affidavit of use or excusable nonuse required during the year before the end of every ten-year period after the date of the registration) is calculated from the date of issue of the registration, *not* from the date of publication of the notice of the registrant’s claim of the benefits of the 1946 Act.

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1603.01 Notification and Printing of Mark in *Official Gazette*

If the affidavit or declaration claiming the benefits of the Act of 1946 is acceptable, the mark and accompanying notice of the claim of benefits of the 1946 Act are printed in the *Official Gazette* under the heading "Registrations Published Under Sec. 12(c)." 37 C.F.R. §2.154. The USPTO notifies the registrant of the printing of the mark in the *Official Gazette*, and also informs the registrant of the requirement for filing affidavits of use or excusable nonuse under 15 U.S.C. §1058. 37 C.F.R. §2.155.

If an affidavit or declaration claiming the benefits of the Act of 1946 is unacceptable, the USPTO notifies the registrant of the defect.

These marks are not subject to opposition on their appearance in the *Official Gazette*. 37 C.F.R. §2.156.

1603.02 Cancellation and Incontestability

If the benefits of the Act of 1946 are claimed, registrants under the Acts of 1905 and 1881 may subsequently file affidavits (or declarations) under §15 of the Act of 1946 whereby marks shall be incontestable. See TMEP §§1605 *et seq.*

Once the registrant claims the benefits of the Act of 1946, registrations under the 1905 and 1881 Acts are subject to cancellation under §14 of the Act of 1946. See TMEP §1607.

1603.03 Affidavits of Use in Commerce Required

After the benefits of the Act of 1946 are claimed for a registration issued under the Act of 1881 or the Act of 1905, the registrant must file an affidavit or declaration of use or excusable nonuse during the sixth year after the date of publication of the notice of the registrant's claim of the benefits of the 1946 Act in the *Official Gazette*, or within the six-month grace period after expiration of the sixth year, to avoid cancellation under §8(a)(2) of the Act. 15 U.S.C. §§1058(a)(2) and 1058(c)(1); 37 C.F.R. §2.160(a)(1)(ii).

An affidavit of use or excusable nonuse must also be filed within one year before the end of every ten-year period after the date of the registration, or within the six-month grace period thereafter. 15 U.S.C. §1058(a)(3); 37 C.F.R. §2.160(a)(2).

See TMEP §§1604 *et seq.* for further information about affidavits or declarations of use or excusable nonuse under 15 U.S.C. §1058.

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1604 Affidavit of Use or Excusable Nonuse of Mark in Commerce under §8

15 U.S.C. §1058. *Duration.*

(a) *Each registration shall remain in force for 10 years, except that the registration of any mark shall be canceled by the Director for failure to comply with the provisions of subsection (b) of this section, upon the expiration of the following time periods, as applicable:*

(1) *For registrations issued pursuant to the provisions of this Act, at the end of 6 years following the date of registration.*

(2) *For registrations published under the provisions of section 12(c), at the end of 6 years following the date of publication under such section.*

(3) *For all registrations, at the end of each successive 10-year period following the date of registration.*

(b) *During the 1-year period immediately preceding the end of the applicable time period set forth in subsection (a), the owner of the registration shall pay the prescribed fee and file in the Patent and Trademark Office--*

(1) *an affidavit setting forth those goods or services recited in the registration on or in connection with which the mark is in use in commerce and such number of specimens or facsimiles showing current use of the mark as may be required by the Director; or*

(2) *an affidavit setting forth those goods or services recited in the registration on or in connection with which the mark is not in use in commerce and showing that any such nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark.*

(c)(1) *The owner of the registration may make the submissions required under this section within a grace period of 6 months after the end of the applicable time period set forth in subsection (a). Such submission is required to be accompanied by a surcharge prescribed by the Director.*

(2) *If any submission filed under this section is deficient, the deficiency may be corrected after the statutory time period and within the time prescribed after notification of the deficiency. Such submission is required to be accompanied by a surcharge prescribed by the Director.*

(d) *Special notice of the requirement for affidavits under this section shall be attached to each certificate of registration and notice of publication under section 12(c).*

(e) *The Director shall notify any owner who files 1 of the affidavits required by this section of the Director's acceptance or refusal thereof and, in the case of a refusal, the reasons therefor.*

(f) *If the registrant is not domiciled in the United States, the registrant may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by*

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leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, or if the registrant does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, such notices or process may be served on the Director.

Under 15 U.S.C. §1058, the owner of a registration must periodically file affidavits or declarations of use or excusable nonuse of the mark. The purpose of the affidavit or declaration of use or excusable nonuse (“§8 affidavit”) is to remove marks that are no longer being used in commerce from the register.

1604.01 Registrations to Which §8 Affidavit Pertains

Registered Extensions of Protection

Section 8 of the Trademark Act applies only to registrations resulting from applications under §1 or §44 of the Trademark Act. However, §71 of the Act requires periodic affidavits of use or excusable nonuse in registered extensions of protection of international registrations to the United States. See TMEP §1613 for further information about §71 affidavits.

Six-Year Section 8 Affidavits for Registrations Resulting From Applications Under §1 or §44

Under §8(a)(1) of the Trademark Act, an affidavit or declaration under §8 of the Act is required during the sixth year after the date of registration for registrations issued on either the Principal Register or the Supplemental Register, or within the six-month grace period after expiration of the sixth year. 15 U.S.C. §§1058(a)(1) and 1058(c)(1); 37 C.F.R. §2.160(a)(1)(i).

Under §8(a)(2) of the Act, an affidavit or declaration under §8 is required during the sixth year after the date of publication under §12(c) for registrations issued under the Acts of 1881 and 1905 for which the owner has claimed the benefits of the Act of 1946 under §12(c), or within the six-month grace period after the end of the sixth year. 15 U.S.C. §§1058(a)(2) and 1058(c)(1); 37 C.F.R. §2.160(a)(1)(ii); TMEP §1603.03.

Ten-Year Section 8 Affidavits Required for All Registrations Resulting From Applications Under §1 or §44

Section 8(a)(3) of the Trademark Act requires an affidavit or declaration of use or excusable nonuse at the end of each successive ten-year period following the date of registration, or within the six-month grace period after the end of the ten-year period. However, the provisions of §8(a)(3) of the Act, requiring the filing of a §8 affidavit at the end of each successive ten-year

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period after registration, do not apply to a registration issued or renewed for a twenty-year term until a renewal application is due. See TMEP §1604.04(b).

1604.02 Notice of When Affidavit Is Due

A statement noting the requirement for filing the affidavits or declarations of use or excusable nonuse under §8 of the Act is included on each certificate of registration as originally issued. 15 U.S.C. §1058(d). This is the only notice that the USPTO provides regarding this requirement. However, the owner must file the affidavit or declaration within the time periods required by §8 of the Act regardless of whether the owner receives the notice. 37 C.F.R. §2.162. The USPTO does not provide any reminder of the due date(s) of the affidavits.

1604.03 Form for Filing §8 Affidavit

To expedite processing, it is recommended that the owner file the §8 affidavit through the Trademark Electronic Application System (“TEAS”). See TMEP §301 for more information about electronic filing. Forms for filing affidavits of use or excusable nonuse under §8, combined affidavits of use and incontestability under §§8 and 15 (see TMEP §1605.05), and §8 affidavits combined with renewal applications under §9 of the Act (see TMEP §1604.19) are available through TEAS at <http://www.uspto.gov/teas/index.html>. Alternatively, the owner can call the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199 to obtain a pre-printed form that can be mailed, faxed or hand-delivered to the USPTO.

See TMEP §1604.04 regarding the deadline for filing the affidavit, and TMEP §1604.05 regarding the requirements for filing the affidavit.

1604.04 Time for Filing §8 Affidavit

37 C.F.R. §2.160(a). During the following time periods, the owner of the registration must file an affidavit or declaration of continued use or excusable nonuse, or the registration will be cancelled:

(1)(i) For registrations issued under the Trademark Act of 1946, on or after the fifth anniversary and no later than the sixth anniversary after the date of registration; or

(ii) For registrations issued under prior Acts, on or after the fifth anniversary and no later than the sixth anniversary after the date of publication under section 12(c) of the Act; and

(2) For all registrations, within the year before the end of every ten-year period after the date of registration.

(3) The affidavit or declaration may be filed within a grace period of six months after the end of the deadline set forth in paragraphs (a)(1) and (a)(2) of this section, with payment of the grace period surcharge required by section

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8(c)(1) of the Act and §2.6.

Under §§8(a) and (b) of the Trademark Act, the owner of the registration must file an affidavit or declaration of use or excusable nonuse:

- (1) on or after the fifth anniversary and no later than the sixth anniversary of the date of registration or date of publication under §12(c) of the Act; *and*
- (2) within the year before the end of every ten-year period after the date of registration. 37 C.F.R. §2.160(a).

See TMEP §1604.04(b) regarding registrations in twenty-year terms.

Under §8(c)(1) of the Act, the owner may file the affidavit or declaration within a grace period of six months after the expiration of the deadline set forth in §8(a) of the Act, accompanied by an additional grace period surcharge.

Affidavits may be filed on the registration anniversary dates at the end of the fifth and sixth years, or at the end of the ninth and tenth years.

Example: For a registration issued on Nov. 1, 2001, a six-year affidavit may be filed as early as Nov. 1, 2006, and may be filed as late as November 1, 2007, before entering the six-month grace period.

Under 37 C.F.R. §2.195(a)(2), a §8 affidavit or declaration filed through TEAS is considered to have been filed on the date the USPTO receives the transmission, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia.

Section 8 affidavits or declarations filed on paper are considered timely if they are mailed or transmitted by the due date with a certificate of mailing or facsimile transmission under 37 C.F.R. §2.197. See TMEP §§305.02 and 306.05 for certificate of mailing and certificate of facsimile transmission procedures to avoid lateness.

If the owner of the registration does not file an affidavit or declaration of use or excusable nonuse before the end of the grace period, the registration will be cancelled. 37 C.F.R. §§2.160(a) and 2.164(b). See TMEP §1604.07 regarding who may file a §8 affidavit.

1604.04(a) Premature Filing of §8 Affidavit

The affidavit cannot be filed before the periods specified in §§8(a) and (b) of the Act. The purpose of the affidavit is to show that the mark is still in use in commerce within the relevant period, which cannot be done by an affidavit

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filed before that period. *Cf. In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984). If an affidavit is filed before the period specified in §§8(a) and (b) of the Act, the USPTO will issue a notice advising the owner: that the affidavit is premature; of the appropriate time for filing the affidavit; that the fee(s) submitted will be held; and that the owner may file a new affidavit at the appropriate time or may request a refund at any time. There is no deficiency surcharge. The prematurely filed affidavit will remain in the record for informational purposes only. The owner of the registration must file a newly executed affidavit or declaration before the end of the grace period, or the registration will be cancelled and the USPTO will refund the fees.

See TMEP §1604.08(b) regarding the date of execution of a §8 affidavit.

1604.04(b) Registrations in Twenty-Year Terms

As noted in TMEP §1604.04, §8(a)(3) of the Trademark Act requires an affidavit or declaration of use or excusable nonuse at the end of each successive ten-year period following the date of registration for all registrations. However, this requirement does not apply to a registration issued or renewed for a twenty-year term (*i.e.*, a registration issued or renewed before November 16, 1989) until a renewal application is due. See notice at 1228 TMOG 187, 189 (Nov. 30, 1999).

Example: If a registration was issued or renewed on November 15, 1989, no §8(a)(3) affidavit is due between November 15, 1998 and November 15, 1999. Section 8(a)(3) of the Act does not apply until the renewal application is due, *i.e.*, between November 15, 2008 and November 15, 2009.

Should the USPTO receive a §8(a)(3) affidavit during the tenth year for a registration in a twenty-year term, the USPTO will refund the filing fee and notify the filer that the document will not be processed.

1604.05 Requirements for §8 Affidavit or Declaration of Use or Excusable Nonuse

37 C.F.R. §2.161. Requirements for a complete affidavit or declaration of continued use or excusable nonuse

A complete affidavit or declaration under section 8 of the Act must:

- (a) Be filed by the owner within the period set forth in §2.160(a);*
- (b) Include a statement that is signed and verified (sworn to) or supported by a declaration under §2.20 by a person properly authorized to sign on behalf of the owner, attesting to the continued use or excusable nonuse of the mark within the period set forth in section 8 of the Act. The verified statement must be executed on or after the beginning of the filing period specified in §2.160(a).*

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A person who is properly authorized to sign on behalf of the owner is:

- (1) a person with legal authority to bind the owner; or*
 - (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or*
 - (3) an attorney as defined in §10.1(c) of this chapter who has an actual or implied written or verbal power of attorney from the owner.*
- (c) Include the registration number;*
- (d)(1) Include the fee required by §2.6 for each class of goods or services that the affidavit or declaration covers;*
- (2) If the affidavit or declaration is filed during the grace period under section 8(c)(1) of the Act, include the late fee per class required by §2.6;*
 - (3) If at least one fee is submitted for a multi-class registration, but the class(es) to which the fee(s) should be applied are not specified, the Office will issue a notice requiring either the submission of additional fee(s) or an indication of the class(es) to which the original fee(s) should be applied. Additional fee(s) may be submitted if the requirements of §2.164 are met. If the required fee(s) are not submitted and the class(es) to which the original fee(s) should be applied are not specified, the Office will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class;*
- (e)(1) Specify the goods or services for which the mark is in use in commerce, and/or the goods or services for which excusable nonuse is claimed under §2.161(f)(2);*
- (2) If the affidavit or declaration covers less than all the goods or services, or less than all the classes in the registration, specify the goods or services being deleted from the registration;*
- (f)(1) State that the registered mark is in use in commerce on or in connection with the goods or services in the registration; or*
- (2) If the registered mark is not in use in commerce on or in connection with all the goods or services in the registration, set forth the date when use of the mark in commerce stopped and the approximate date when use is expected to resume; and recite facts to show that nonuse as to those goods or services is due to special circumstances that excuse the nonuse and is not due to an intention to abandon the mark;*
- (g) Include a specimen showing current use of the mark for each class of goods or services, unless excusable nonuse is claimed under §2.161(f)(2). The specimen must:*
- (1) Show the mark as actually used on or in connection with the goods or in the sale or advertising of the services. A photocopy or other reproduction of the specimen showing the mark as actually used is acceptable. However, a photocopy that merely reproduces the registration certificate is not a proper specimen;*
 - (2) Be flat and no larger than 8.5 inches (21.6 cm.) wide by 11.69 inches*

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(29.7 cm.) long. If a specimen exceeds these size requirements (a “bulky specimen”), the Office will create a facsimile of the specimen that meets the requirements of the rule (i.e., is flat and no larger than 8.5 inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long) and put it in the record. In the absence of non-bulky alternatives, the Office may accept an audio or video cassette tape recording, CD-ROM, or a specimen in another appropriate medium.

(3) Be a digitized image in .jpg format, if transmitted through TEAS.

1604.06 Fees for §8 Affidavit

1604.06(a) Filing Fee for Affidavit or Declaration

Under 15 U.S.C. §1058(b) and 37 C.F.R. §2.161(d)(1), an affidavit or declaration of use or excusable nonuse must include the fee required by 37 C.F.R. §2.6 for each class of goods or services that the affidavit or declaration covers. See TMEP §§1401.02, 1401.04 and 1601.06 regarding use of international classification or prior United States classification to calculate fees due.

1604.06(b) Grace Period Surcharge and Deficiency Surcharge

If the affidavit or declaration is filed during the grace period under §8(c)(1) of the Act, it must include the grace period surcharge per class required by 37 C.F.R. §2.6. 37 C.F.R. §2.161(d)(2).

Section 8(c)(2) of the Trademark Act requires a “deficiency surcharge” for correcting deficiencies in the affidavit or declaration after expiration of the deadlines specified in §8. See TMEP §§1604.17 *et seq.* regarding the deadlines and surcharge for correcting deficiencies.

Only a single deficiency surcharge is required for correcting one or more deficiencies in a multi-class registration. Similarly, only a single deficiency surcharge is required to correct several deficiencies within one §8 affidavit or one combined filing under §§8 and 9. See TMEP §1604.19 regarding combined filings under §§8 and 9.

The grace period surcharge applies only where no filing was made during the sixth year after the date of registration (or date of publication under §12(c) of the Act), or within the year before the end of any ten-year period after the date of registration. An owner who files within these periods, but corrects a deficiency after these periods have expired, will be subject to the deficiency surcharge only. On the other hand, someone who files during the grace period and cures deficiencies after expiration of the grace period will be subject to both the grace period surcharge (for the ability to file the affidavit during the grace period) *and* the deficiency surcharge (for the ability to correct a deficiency after the end of the grace period). H.R. Rep. No. 194, 105th Congress, 1st Sess. 17 (1997).

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1604.06(c) Processing Affidavit or Declaration Filed With Insufficient Fees

An affidavit or declaration that does not include a fee, or does not include sufficient fees for all the classes to which the affidavit pertains (and the grace period surcharge, where applicable), is deficient. Fee deficiencies may be cured before expiration of the deadlines set forth in §8 of the Act without payment of a deficiency surcharge, or after expiration of the deadlines set forth in §8 of the Act with the deficiency surcharge required by §8(c)(2) of the Act. See TMEP §§1604.17 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

If the affidavit or declaration was filed without sufficient fee(s), but the affidavit or declaration included an authorization to charge deficient fees to a USPTO deposit account (37 C.F.R. §2.208), the required fee(s) (and grace period surcharge, where applicable) will be charged to the deposit account. If the deposit account authorization was included with the affidavit or declaration as filed, and the deposit account had sufficient funds to cover the fee(s) in question, there is no fee deficiency and no deficiency surcharge is required.

An authorization to charge fees to a deposit account with insufficient funds to cover the fee is regarded as a deficiency.

If a check submitted as payment of a filing fee for an affidavit of use or excusable nonuse is returned unpaid, or an electronic funds transfer (“EFT”) or credit card payment is refused or charged back by a financial institution, this is regarded as a deficiency. In addition to the deficiency surcharge (where applicable), there is a \$50 fee for processing the payment that was refused. 37 C.F.R. §2.6(b)(12). See TMEP §405.06 for additional information.

If at least one fee is submitted for a multi-class registration, but the class(es) to which the fee(s) should be applied are not specified, the Post Registration examiner will issue an Office action requiring either the submission of additional fee(s) or an indication of the class(es) to which the original fee(s) should be applied. If the owner does not submit the required fee(s) or specify the class(es) to which the original fee(s) should be applied, the USPTO will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class. 37 C.F.R. §2.161(d)(3).

1604.07 Ownership, and Who May File §8 Affidavit

1604.07(a) Affidavit or Declaration Must be Filed by Owner

The affidavit or declaration of use or excusable nonuse must be filed by the owner of the registration. Filing by the owner is a minimum requirement that must be met before the expiration of the deadlines set forth in §8(a) of the Act (*i.e.*, during the sixth year after the date of registration or publication under

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§12(c) of the Trademark Act, within the year before the end of every ten-year period after the date of registration), or within the six-month grace period after expiration of these deadlines. 37 C.F.R. §2.164(b).

If it is unclear whether the party who filed the affidavit is the present owner, the Post Registration examiner will issue an Office action requiring the party to establish its ownership. If the party who filed the affidavit was the owner of the registration at the time of filing, the owner may file evidence to establish ownership even if the filing period set forth in §8 of the Act has expired. There is no deficiency, and no deficiency surcharge is required for providing evidence to establish ownership. See TMEP §1604.07(b).

If the affidavit or declaration was filed in the name of the wrong party, and there is time remaining in the filing period or grace period, the true owner must file a complete new affidavit or declaration, together with the filing fee per class required by 37 C.F.R. §2.6, and, if applicable, a specimen of use for each class. If the new affidavit or declaration is filed during the grace period, the owner must include the grace period surcharge per class with the new affidavit or declaration.

If the affidavit or declaration was filed in the name of the wrong party, and there is no time remaining in the grace period, the registration will be cancelled. 15 U.S.C. §1058; 37 C.F.R. §2.164(b). Filing in the name of another entity is not a deficiency that can be corrected after the expiration of the grace period. See *In re Precious Diamonds, Inc.*, 635 F.2d 845, 208 USPQ 410 (C.C.P.A. 1980); *In re Media Central IP Corp.*, 65 USPQ2d 1637 (Dir USPTO 2002); *In re ACE III Communications, Inc.*, 62 USPQ2d 1049 (Dir USPTO 2001); *In re Caldon Company Limited Partnership*, 37 USPQ2d 1539 (Comm'r Pats. 1995); *In re Weider*, 212 USPQ 947 (Comm'r Pats. 1981). See also TMEP §1604.07(f) regarding mistakes in setting forth the name of the owner.

1604.07(b) Establishing Ownership

When the affidavit is filed by someone other than the original owner of the registration, the examiner cannot accept the affidavit unless there is a clear chain of title from the original owner to the party who filed the affidavit. 37 C.F.R. §3.73(b); TMEP §502.01.

When the affidavit is filed, the examiner will check the records of the Assignment Services Division of the USPTO, available at <http://assignments.uspto.gov/assignments>. If the records of the Assignment Services Division show a clear chain of title in the party who filed the affidavit, no inquiry will be issued. The examiner will enter the change of ownership into the Trademark Reporting and Monitoring ("TRAM") System, if necessary.

If the records of the Assignment Services Division do not show a clear chain of title in the party who filed the affidavit, the examiner will issue an Office

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action requiring the party to establish its ownership of the registration. To establish ownership, the party must: (1) record papers that show each change of ownership in the Assignment Services Division of the USPTO, and include a statement in the response to the Office action that the papers have been recorded; or (2) submit documentary evidence of a chain of title from the original owner to the party who filed the affidavit. 37 C.F.R. §3.73(b)(1); TMEP §502.01.

“Documentary evidence of a chain of title from the original owner to the assignee” (37 C.F.R. §3.73(b)(1)(i)) normally consists of the same type of documents that would be recorded in the Assignment Services Division, e.g., assignment documents, certificates of merger, or certificates of change of name. In the alternative, an affidavit or declaration containing sufficient facts to support the transfer of title may be accepted.

The owner may submit evidence of ownership even if the filing period set forth in §8 of the Act has expired. Where the party who filed the affidavit was the owner of the registration at the time of filing, there is no deficiency, and no deficiency surcharge is required for providing evidence to establish ownership.

1604.07(c) Acceptance Notice Issued in Name of Owner of Record

The notification of acceptance of a §8 affidavit is issued in the name of the owner of record, as shown in the automated records of the Trademark Operation (*i.e.*, the TRAM System, Trademark Applications and Registrations Retrieval (“TARR”) database, X-Search and Trademark Electronic Search System (“TESS”).

When a party other than the original owner files a §8 affidavit, the USPTO will accept the affidavit if the new owner submits documentary evidence of the chain of title (*see* TMEP §1604.07(b)), even if the new owner does not record the documents of ownership in the Assignment Services Division. 37 C.F.R. §3.73. However, the USPTO will not issue the notice of acceptance of the §8 affidavit in the name of the new owner unless the new owner (1) records the appropriate document in the Assignment Services Division; and (2) notifies the Post Registration examiner that the document has been recorded. 37 C.F.R. §3.85. *See* TMEP §§504 *et seq.* regarding the circumstances in which the ownership field in the trademark database will be automatically updated after recordation of a document with the Assignment Services Division, even if the new owner does not notify the Trademark Operation that the document has been recorded.

See TMEP §502.01 regarding establishing ownership of a registration, and TMEP §502.03 regarding issuance of a new certificate in the name of a new owner.

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1604.07(d) Changes of Legal Entity

The procedures for establishing ownership, as discussed in TMEP §1604.07(b), also apply to changes of name and changes of legal entity. See TMEP §1604.07(e) regarding changes of name.

A change in the state of incorporation is a change of legal entity, creating a new party.

The death of a partner, or other change in the membership of a partnership, creates a change in legal entity, unless the partnership agreement provides for continuation of the partnership and the relevant state law permits this.

A merger of companies into a new company normally constitutes a change of legal entity.

Affidavits may be accepted from trustees, executors, administrators, and the like, when supported by a court order or other evidence of the person's authority to act on behalf of the present owner. If there is a court order, a copy of the order should be submitted.

1604.07(e) Changes of Name

A mere change of the name of a party is not a change of entity and will not require an inquiry regarding ownership if there is clear title in the party who filed the §8 affidavit. Therefore, if the owner records a change of name with the Assignment Services Division and subsequently files the §8 affidavit in its former name, the examiner will not issue an inquiry regarding ownership.

However, if it is unclear from the records of the Assignment Services Division whether the party who filed the affidavit is the owner of record, the owner must either record evidence of the change of name in the Assignment Services Division or submit proof of the change of name, as discussed in TMEP §1604.07(b). For a corporation, this is done by recording or submitting a certificate of change of name issued by the Secretary of State (or other authorized body) of the state of incorporation.

See TMEP §1604.07(c) regarding issuance of the notice of acceptance of the affidavit in the name of the new owner.

1604.07(f) Correction of Mistake in Setting Forth the Name of the Owner

If the affidavit or declaration was filed by the owner of the registration, but there is a mistake in the manner in which the name of the owner is set out in the affidavit, the mistake can be corrected. *In re Atlanta Blue Print Co.*, 19 USPQ2d 1078 (Comm'r Pats. 1990). No deficiency surcharge is required in this situation.

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However, if the affidavit or declaration was mistakenly filed in the name of a person or legal entity who did not own the mark as of the filing date, a new affidavit or declaration cannot be filed in the name of the true owner unless there is time remaining in the grace period. See TMEP §1604.07(a). *In re Media Central IP Corp.*, 65 USPQ2d 1637 (Dir USPTO 2002); *In re ACE III Communications, Inc.*, 62 USPQ2d 1049 (Dir USPTO 2001).

See TMEP §1201.02(c) for examples of correctable and non-correctable errors.

1604.08 Execution of Affidavit or Declaration

1604.08(a) Persons Who May Sign Affidavit or Declaration

Under 37 C.F.R. §2.161(b), the §8 affidavit or declaration must include a statement that is signed and verified (sworn to) or supported by a declaration under 37 C.F.R. §2.20 by a person properly authorized to sign on behalf of the owner. A “person who is properly authorized to sign on behalf of the owner” is: (1) a person with legal authority to bind the owner; (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or (3) an attorney as defined in 37 C.F.R. §10.1(c) who has an actual written or verbal power of attorney or an implied power of attorney from the owner.

Generally, the USPTO does not question the authority of the person who signs a verification, unless there is an inconsistency in the record as to the signatory’s authority to sign. See TMEP §804.04.

1604.08(b) Date of Execution of Affidavit or Declaration

Under 37 C.F.R. §2.161(b), the verified statement must be executed on or after the beginning of the relevant filing period specified in §8 of the Act (*i.e.*, on or after the fifth anniversary of the date of registration or publication under §12(c), or on or after the beginning of the one-year period before the end of each ten-year period after the date of registration). Because the purpose of the affidavit is to attest to the use or excusable nonuse of the mark within the time periods specified in §8 of the Act, the affidavit cannot be executed before these time periods begin.

An affidavit filed within the period specified in §8 of the Act, but executed before that period, is deficient. The owner of the registration will be required to submit a substitute or supplemental affidavit or declaration attesting to use in commerce (or excusable nonuse) on or in connection with the goods or services within the relevant period specified in §8 of the Act.

If the prematurely executed §8 affidavit was filed during the relevant period specified in §§8(a) or 8(b) of the Act (*i.e.*, during the sixth year after the date of registration or publication under §12(c) of the Trademark Act, or within one

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year before the end of any ten-year period after the date of registration), the substitute affidavit may be filed before expiration of the relevant period for no fee, or after expiration of the relevant period with the deficiency surcharge required under §8(c)(2) of the Act. If the prematurely executed §8 affidavit was filed during the grace period, the substitute affidavit may be filed before expiration of the grace period for no fee, or after expiration of the grace period with the deficiency surcharge. See TMEP §1604.04 regarding the deadlines for filing §8 affidavits, and TMEP §§1604.17 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

Date of Execution Omitted. If the §8 affidavit is signed, but the date of execution is omitted, the examiner must require that the owner of the registration set forth the date of execution for the record. If the affidavit was executed within the relevant filing period, no deficiency fee is required. If there are no other outstanding issues, the owner may provide the examiner with the date by telephone; and the examiner must make an appropriate note to file. If the affidavit was not executed within the relevant filing period, the affidavit is deficient, and the owner must submit a substitute or supplemental affidavit, as discussed above.

1604.08(c) Signature of Electronically Transmitted Affidavit or Declaration

See TMEP §804.05 regarding signature of an affidavit or declaration filed through TEAS.

1604.08(d) Form and Wording of Verification

The format of the verification may be: (1) the classical form for verifying, which includes an oath (jurat) (see TMEP §804.01(a)); or (2) a declaration under 37 C.F.R. §2.20 or 28 U.S.C. §1746 instead of an oath (see TMEP §804.01(b)).

1604.09 Goods and/or Services Set Forth in §8 Affidavit or Declaration

1604.09(a) Goods and/or Services Must be Specified or Expressly Incorporated by Reference

Under 15 U.S.C. §1058(b) and 37 C.F.R. §2.161(e)(1), the affidavit or declaration must specify the goods/services recited in the registration on or in connection with which the mark is in use in commerce, and/or the goods/services for which excusable nonuse is claimed. See TMEP §1604.10 regarding use in commerce and TMEP §1604.11 regarding excusable nonuse. The affidavit or declaration may incorporate by reference the identification set forth in the registration certificate (*e.g.*, “all goods/services listed in the registration” or “all goods/services listed in the registration

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except... [specifying the goods/services not covered by the affidavit or declaration]”). Incorporation by reference is recommended, to avoid inadvertent omissions.

If the owner is alleging use with respect to some of the goods/services and excusable nonuse for other goods/services, the owner must clearly indicate which goods/services are in use and which goods/services are not in use.

1604.09(b) Deletion of Goods and/or Services

If the owner of the registration intends to delete goods/services from the registration, this should be expressly stated in the affidavit or declaration. 37 C.F.R. §2.161(e)(2).

1604.09(c) Failure to List All Goods and/or Services Recited in Registration

An affidavit or declaration that fails to list or incorporate by reference all the goods/services to which the affidavit pertains, and does not include a statement of intent to delete the omitted goods/services, is deficient.

If the owner did not intend to delete the goods/services, the owner may file a substitute or supplemental affidavit or declaration adding the omitted goods/services. The owner must verify that the mark was in use in commerce on or in connection with the goods/services during the relevant filing period specified in §8 of the Act. This substitute affidavit may be filed before expiration of the relevant deadline set forth in §8 of the Act for no fee, or after expiration of the deadline set forth in §8 of the Act with the deficiency surcharge required by §8(c)(2) of the Act. See TMEP §§1604.17 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

If the owner does not file a substitute or supplemental affidavit or declaration that the mark was in use in commerce on or in connection with the omitted goods/services within the period for response to the Office action (see TMEP §1604.16), the omitted goods/services will be deleted from the registration.

1604.09(d) New Goods and/or Services Cannot be Added

Goods and/or services that are not listed in the registration may not be set forth in the §8 affidavit.

1604.10 Use in Commerce

The §8 affidavit must state that the mark is in use in commerce on or in connection with the goods and/or services listed in the registration, unless excusable nonuse is claimed. 37 C.F.R. §2.161(f)(1). See TMEP §1604.11

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regarding excusable nonuse. The §8 affidavit does not have to specify the type of commerce (*e.g.*, interstate) in which the mark is used. The USPTO presumes that someone who states that the mark is in use in commerce is stating that the mark is in use in a type of commerce that Congress can regulate, unless there is contradictory evidence in the record. See TMEP §§901 *et seq.* regarding use in commerce.

A §8 affidavit that does not state that the mark is in use in commerce is deficient. The owner must submit a substitute affidavit or declaration stating that the mark was in use in commerce on or in connection with the goods and/or services listed in the registration during the relevant period specified in §8 of the Trademark Act, as follows:

- (1) If the §8 affidavit was filed during the sixth year after the date of registration or publication under §12(c) of the Act, the substitute affidavit must state that the mark was in use in commerce on or in connection with the goods/services before the expiration of the sixth year after the date of registration or publication under §12(c), if accurate; or
- (2) If the §8 affidavit was filed within one year before the end of any ten-year period after the date of registration, the substitute affidavit must state that the mark was in use in commerce on or in connection with the goods/services within one year before the end of the ten-year period after the date of registration, if accurate; or
- (3) If the §8 affidavit was filed during the grace period, the substitute affidavit must state that the mark was in use in commerce on or in connection with the goods/services before the expiration of the grace period, if accurate.

If the §8 affidavit was filed during the relevant period specified in §8(a) or §8(b) of the Act (*i.e.*, during the sixth year after the date of registration or publication under §12(c) of the Act, or within one year before the end of any ten-year period after the date of registration), the substitute affidavit may be filed before expiration of the relevant period for no fee, or after expiration of the relevant period with the deficiency surcharge required under §8(c)(2) of the Act. If the §8 affidavit was filed during the grace period, the substitute affidavit may be filed before expiration of the grace period for no fee, or after expiration of the grace period with the deficiency surcharge. See TMEP §1604.04 regarding the deadlines for filing §8 affidavits, and TMEP §§1604.17 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

While a substitute affidavit may be filed after the expiration of the period specified in §8 of the Act, the substitute affidavit must attest to use within the time period specified in §8 of the Act. Therefore, if the substitute affidavit does not state that the mark was in use in commerce on or in connection with

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the goods/services within the relevant period specified in §8 of the Act, the USPTO will not accept the §8 affidavit, and the registration will be cancelled.

1604.11 “Excusable Nonuse” of Mark

Extract from 37 C.F.R. §2.161. A complete affidavit or declaration under section 8 of the Act must:

...

(f) . . .

(2) If the registered mark is not in use in commerce on or in connection with all the goods or services in the registration, set forth the date when use of the mark in commerce stopped and the approximate date when use is expected to resume; and recite facts to show that nonuse as to those goods or services is due to special circumstances that excuse the nonuse and is not due to an intention to abandon the mark[.]

The purpose of Section 8 of the Trademark Act is to remove from the register those registrations which have become deadwood. See *Morehouse Manufacturing Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (C.C.P.A. 1969). It is not intended, however, to cancel registrations due to a temporary interruption in the use of the mark due to circumstances beyond the control of the owner of the registration. *In re Moorman Mfg. Co.*, 203 USPQ 712 (Comm’r Pats. 1979). Thus, if the mark is not in use in commerce but the owner believes the registration should not be cancelled, the owner may file an affidavit or declaration showing that nonuse is due to special circumstances that excuse the nonuse, and is not due to any intention to abandon the mark. 15 U.S.C. §1058(b)(2). *Ex parte Kelley-How-Thomson Co.*, 118 USPQ 40 (Comm’r Pats. 1958).

Requirements for Affidavit

Since "showing" implies proof, merely stating that special circumstances exist and there is no intention to abandon the mark is not sufficient. *In re Conusa Corp.*, 32 USPQ2d 1857 (Comm’r Pats. 1993); *In re Moorman Mfg. Co.*, *supra*; *Ex parte Astra Pharmaceutical Products, Inc.*, 118 USPQ 368 (Comm’r Pats. 1958) ; *Ex parte Denver Chemical Mfg. Co.*, 118 USPQ 106 (Comm’r Pats. 1958). The affidavit must state when use in commerce stopped and give the approximate date when use is expected to resume. 37 C.F.R. §2.161(f)(2). It should also specify the reason for nonuse, the specific steps being taken to put the mark back in use, and any other relevant facts.

Sufficient facts must be set forth to demonstrate clearly that nonuse is due to some special circumstance beyond the owner's control or "forced by outside causes." *In re Conusa Corp.*, *supra*; *In re Moorman Mfg. Co.*, *supra*; *Ex parte Kelley-How-Thomson Co.*, *supra*.

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The goods/services for which excusable nonuse is claimed must be specified. See TMEP §1604.09 *et seq.* regarding proper specification of the goods and services.

In a multi-class application, there must be a recitation of facts as to nonuse for each class to which the affidavit pertains, or it must be clear that the facts recited apply to all the classes.

Presumption of Abandonment

If the mark has not been in use for three consecutive years and the owner has done nothing to try to resume use of the mark, the Office may presume that the owner has abandoned the mark. See 15 U.S.C. §1127; *Stromgren Supports Inc. v. Bike Athletic Co.*, 43 USPQ2d 1100 (TTAB 1997).

Examples of Special Circumstances That Excuse Nonuse

In addition to a showing that there is no intention to abandon the mark, the owner must show that nonuse is due to special circumstances beyond the owner's control that excuse nonuse. The following examples provide general guidelines as to what is considered to be a special circumstance that excuses nonuse:

- *Decreased Demand.* Decreased demand for the product sold under the mark, resulting in its discontinuance for an indefinite period, does not excuse nonuse. The purpose of the affidavit requirement is to eliminate registrations of marks that are in nonuse due to ordinary changes in social or economic conditions. See *In re Conusa Corp.*, *supra*; *In re Parmalat S.p.A.*, 32 USPQ2d 1860 (Comm'r Pats. 1991); *Ex parte Astra Pharmaceutical Products, Inc.*, *supra*; *Ex parte Denver Chemical Mfg. Co.*, *supra*.
- *Trade Embargo or Other Circumstance Beyond Owner's Control.* Nonuse may be considered excusable where the owner of the registration is willing and able to continue use of the mark in commerce, but is unable to do so due to a trade embargo.
- *Sale of a Business.* Temporary nonuse due to the sale of a business might be considered excusable.
- *Retooling.* The mark might be out of use temporarily because of an interruption of production for retooling of a plant or equipment, with production possible again at a scheduled time. However, nonuse due to retooling is excusable only if the owner shows that the plant or equipment being retooled was essential to the production of the goods and that alternative equipment was unavailable on the market. *In re New England Mutual Life Insurance Co.*, 33 USPQ2d 1532 (Comm'r Pats. 1991).

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- *Orders on Hand.* If the product is of a type that cannot be produced quickly or in large numbers (e.g., airplanes), yet there are orders on hand and activity toward filling them, nonuse might be considered excusable.
- *Illness, Fire and Other Catastrophes.* Illness, fire and other catastrophes may create situations of temporary nonuse, with the owner being able to outline arrangements and plans for resumption of use. Such nonuse is often excusable. However, a mere statement that the owner is ill and cannot conduct his or her business will not in itself excuse nonuse; the owner must show that the business is an operation that could not continue without his or her presence. *New England Mutual Life Insurance, supra.*
- *Negotiations With Distributors.* A recitation of efforts to negotiate agreements that would allow for resumption of use of the mark, or a statement that samples of the goods have been shipped to potential distributors, may establish lack of intention to abandon the mark, but does not establish the existence of special circumstances that excuse the nonuse. *In re Parmalat, supra; In re Moorman, supra.*
- *Use in Foreign Country.* Use of the mark in a foreign country has no bearing on excusable nonuse of a mark in commerce that can be regulated by the United States Congress. *In re Conusa, supra.*
- *Use of Mark on Different Goods/Services.* Use of the mark on goods/services other than those recited in the registration does not establish either special circumstances or lack of intention to abandon the mark. *Ex parte Kelley-How-Thomson Co., supra.*
- *Use of Mark in Another Form.* Use of a mark as an essential part of a materially different composite mark does not excuse the failure to use the mark at issue. *In re Continental Distilling Corp., 254 F.2d 139, 117 USPQ 300 (C.C.P.A. 1958).*

Supplementary Evidence or Explanation

If the Post Registration examiner determines that the facts set forth do not establish excusable nonuse, the owner may file supplementary evidence or explanation, within the response period set forth in the Office action. If the affidavit included a claim of excusable nonuse when filed, no deficiency surcharge will be required for supplementing this claim with additional evidence or an explanation.

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1604.12 Specimen Showing Current Use of Mark in Commerce

1604.12(a) Specimen for Each Class Required

A §8 affidavit must include a specimen or facsimile showing current use of the mark for each class of goods or services, unless excusable nonuse is claimed. 15 U.S.C. §1058(b); 37 C.F.R. §2.161(g).

See TMEP §§904.04 *et seq.* regarding trademark specimens, and TMEP §§1301.04 *et seq.* regarding service mark specimens.

The specimen must show use of essentially the same mark as the mark shown in the registration, and must be used on or in connection with the goods/services listed in the registration. A specimen that shows use of a materially different mark (see TMEP §1604.13), or shows use of the mark on other goods or services, is unacceptable. An affidavit or declaration that does not include an acceptable specimen for each class of goods/services is deficient.

If the specimen is deficient, the owner must file a substitute specimen, together with an affidavit or declaration that the substitute specimen was in use in commerce on or in connection with the goods or services during the relevant period specified in §8 of the Act. See TMEP §1604.12(c) regarding substitute specimens.

Under 37 C.F.R. §2.161(g)(2), the specimen must be flat and no larger than 8½ inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long. If a specimen exceeds these size requirements, the USPTO will create a facsimile of the specimen that meets the requirements of the rule (*i.e.*, is flat and no larger than 8½ inches wide by 11.69 inches long), put it in the record, and destroy the original bulky specimen. If the copy of the specimen created by the USPTO does not adequately depict the mark, the Post Registration examiner will require a substitute specimen that meets the size requirements of the rule, and an affidavit or declaration verifying the use of the substitute specimen.

The USPTO will not return specimens filed with a §8 affidavit or declaration.

1604.12(b) Specimens in Electronically Filed Affidavits

If the owner files the §8 affidavit through TEAS, the owner must submit a digitized image in .jpg format. 37 C.F.R. §2.161(g)(3).

Sometimes there is no visible specimen in the record due to a technical problem. In this situation, the Post Registration examiner should ask the owner to submit by mail or fax: (1) the specimen (or a facsimile of the specimen) that was attached to the original electronically filed affidavit; and (2) a statement by the person who transmitted the affidavit to the USPTO that

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the specimen being submitted by mail (or fax) is a true copy of the specimen submitted with the electronically filed affidavit. This statement does not have to be verified. Alternatively, the owner may submit a new specimen, together with an affidavit or declaration that the substitute specimen was in use in commerce on or in connection with the goods/services during the relevant period specified in §8 of the Act. No deficiency surcharge is required. See TMEP §1604.12(c) regarding the requirements for an affidavit supporting use of substitute specimens.

1604.12(c) Substitute Specimens

If a specimen for any class is omitted or is deficient, the owner must file a substitute specimen, together with an affidavit or declaration that the substitute specimen was in use in commerce on or in connection with the goods or services during the relevant period specified in §8 of the Act, as follows:

- (1) If the §8 affidavit was filed during the sixth year after the date of registration or publication under §12(c) of the Act, the affidavit supporting use of the substitute specimen must state that the substitute specimen was in use in commerce before the expiration of the sixth year after the date of registration or publication under §12(c), if accurate; or
- (2) If the §8 affidavit was filed within one year before the end of any ten-year period after the date of registration, the affidavit supporting use of the substitute specimen must state that the substitute specimen was in use in commerce within one year before the end of the ten-year period after the date of registration, if accurate; or
- (3) If the §8 affidavit was filed during the grace period, the affidavit supporting use of the substitute specimen must state that the substitute specimen was in use in commerce before the expiration of the grace period, if accurate.

If the §8 affidavit was filed during the relevant period specified in §§8(a) or 8(b) of the Act (*i.e.*, during the sixth year after the date of registration or publication under §12(c) of the Trademark Act, or within one year before the end of any ten-year period after the date of registration), the substitute specimen may be filed before expiration of the relevant period for no fee, or after expiration of the relevant period with the deficiency surcharge required under §8(c)(2) of the Act. If the §8 affidavit was filed during the grace period, the substitute specimen may be filed before expiration of the grace period for no fee, or after expiration of the grace period with the deficiency surcharge. See TMEP §1604.04 regarding the deadlines for filing §8 affidavits, and TMEP §§1604.17 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

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While a substitute specimen and supporting affidavit may be filed after the expiration of the period specified in §8 of the Act, the supporting affidavit must attest to use of the specimen within the time period specified in §8 of the Act. Therefore, if the affidavit supporting the substitute specimen does not state that the specimen was in use in commerce prior to the end of the relevant period specified in §8 of the Act, the §8 affidavit will not be accepted, and the registration will be cancelled as to any class for which a proper specimen was not provided.

1604.13 Differences in the Mark As Used on the Specimen and the Mark as Registered

The mark to which the §8 affidavit pertains must be essentially the same as the mark that appears in the registration. Where the specimen reflects a change in the mark since the registration issued, acceptance of the affidavit will depend on the degree of change. A *material* alteration of the mark will result in refusal of the affidavit on the ground that the registered mark is no longer in use. *In re International Nickel Co., Inc.*, 282 F.2d 952, 127 USPQ 331 (C.C.P.A. 1960); *In re Continental Distilling Corp.*, 254 F.2d 139, 117 USPQ 300 (C.C.P.A. 1958); *Ex parte Richards*, 153 USPQ 853 (Comm'r Pats. 1967). See also *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986); *In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984).

Mere changes in background or styling, or modernization, are not ordinarily considered to be material changes in the mark. See *Ex parte Petersen & Pegau Baking Co.*, 100 USPQ 20 (Comm'r Pats. 1953) (change in matter determined to be mere background and type face held not a material alteration of "PETER PAN" mark). Whether the change in a mark as used on the specimen is a material change is a question of fact that the Post Registration examiner must determine on a case-by-case basis.

Generally, the standard used to determine whether a change is material under §8 is the same as the standard used to determine whether the mark in a registration may be amended under 15 U.S.C. §1057(e). If the mark could be amended under §7(e) because the character of the mark had not been materially altered, then the specimen filed with the §8 affidavit should be accepted. In determining whether a change constitutes a material alteration, the USPTO will always compare the mark in the specimen to the mark as originally registered. See TMEP §§807.14 *et seq.* and 1609.02(a) for additional information about material alteration.

However, where the registered mark is currently used as one of several elements in a composite mark, the decision as to whether to accept the specimen requires consideration of whether the registered mark makes an impression apart from the other elements of the composite mark. If the display of the composite is such that the essence of the registered mark

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makes a separate impression, then the specimen may be sufficient for purposes of the §8 requirement. In many cases, word elements are severable from design elements, because words tend to dominate in forming a commercial impression. *In re DeWitt International Corporation*, 21 USPQ2d 1620 (Comm'r Pats. 1991). If the mark, as used on the §8 specimen, creates a separate impression apart from any other material on the specimen, then the specimen may be accepted as evidence of current use of the registered mark.

If the examiner determines that the mark on the specimen is a material alteration of the registered mark, a substitute specimen may be filed. If the substitute specimen is filed after expiration of the relevant filing period specified in §8 of the Act, the owner must pay the deficiency surcharge required by §8(c)(2) of the Act and 37 C.F.R. §2.6. See TMEP §1604.12(c) regarding substitute specimens, and 37 C.F.R. §2.164 and TMEP §§1604.17 *et seq.* regarding the procedures for correcting deficiencies in a §8 affidavit.

1604.13(a) Possible Amendment of Mark in Registration

If the USPTO accepts the §8 affidavit, and there is a difference between the mark on the specimen filed with the affidavit and the mark in the registration, the mark as originally registered remains the mark of record. If the owner wants to change the mark in the registration to agree with the mark currently used, the owner must file a separate request for amendment under §7(e) of the Act, and pay the fee required by 37 C.F.R. §2.6. See *Ex parte Petersen & Pegau Baking Co.*, 100 USPQ 20 (Comm'r Pats. 1953). See TMEP §§1609.02 *et seq.* regarding amendment of a registered mark under §7(e).

Amending the mark in a registration under §7(e) to agree with the mark as shown on a §8 specimen is not mandatory.

1604.14 Designation of Domestic Representative by Foreign Owner

Under 15 U.S.C. §1058(f) and 37 C.F.R. §2.161(h), if the owner of the registration is not domiciled in the United States, the affidavit or declaration may include the name and address of a United States resident upon whom notices or process in proceedings affecting the registration may be served. The USPTO encourages parties who do not reside in the United States to designate domestic representatives. To expedite processing, the Office recommends that designations of domestic representative be filed through TEAS, at <http://www.uspto.gov/teas/index.html>. See TMEP §604.

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1604.15 Office Actions and Notices Regarding Affidavit

Upon receipt of a §8 affidavit, the prosecution history of the registration in the USPTO's automated database is updated to indicate that the affidavit has been filed. This information is reflected in TRAM and TARR.

When a §8 affidavit is filed through TEAS, the USPTO immediately issues a confirmation of filing via e-mail that includes the date of receipt and a summary of the submission. This confirmation is evidence of filing should any question arise as to the filing date of the affidavit. If a §8 affidavit is filed on paper, no acknowledgment of receipt of the affidavit is sent before it is examined, unless the applicant includes a stamped, self-addressed postcard with the affidavit (see TMEP §303.02(c)).

If, on examination, the USPTO determines that the affidavit or declaration is acceptable, the USPTO sends a notice of acceptance. If the affidavit or declaration is not acceptable, the USPTO issues an action stating the reasons for refusal. 37 C.F.R. §2.163.

The propriety of the original registration is not re-examined in connection with the affidavit under §8.

1604.16 Response to Office Action

Under 37 C.F.R. §2.163(b), a response to a refusal must be filed within six months of the mailing date of the Office action, or before the end of the relevant filing period set forth in §8(a) or §8(b) of the Act, whichever is later. If no response is received within that time, the registration will be cancelled.

The owner may file a petition to the Director under 37 C.F.R. §§2.146(a)(3) and 2.146(a)(5) to waive 37 C.F.R. §2.163(b) so that a late response to an Office action can be accepted. However, the Director will waive a rule only in an extraordinary situation, where justice requires and no other party is injured. See TMEP §1708. The failure to receive an Office action has been found to be an extraordinary circumstance that warrants a waiver of 37 C.F.R. §2.163(b). The "unintentional delay" standard of 37 C.F.R. §2.66 does not apply to the failure to respond to an Office action issued in connection with a §8 affidavit. TMEP §1714.01(f)(ii).

See TMEP §§1604.17 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

1604.17 Correction of Deficiencies in §8 Affidavit

37 C.F.R. §2.164. Correcting deficiencies in affidavit or declaration.

(a) If the owner of the registration files an affidavit or declaration within the time periods set forth in section 8 of the Act, deficiencies may be corrected, as follows:

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(1) *Correcting deficiencies in affidavits or declarations timely filed within the periods set forth in sections 8(a) and 8(b) of the Act. If the owner timely files the affidavit or declaration within the relevant filing period set forth in section 8(a) or section 8(b) of the Act, deficiencies may be corrected before the end of this filing period without paying a deficiency surcharge. Deficiencies may be corrected after the end of this filing period with payment of the deficiency surcharge required by section 8(c)(2) of the Act and §2.6.*

(2) *Correcting deficiencies in affidavits or declarations filed during the grace period. If the affidavit or declaration is filed during the six-month grace period provided by section 8(c)(1) of the Act, deficiencies may be corrected before the expiration of the grace period without paying a deficiency surcharge. Deficiencies may be corrected after the expiration of the grace period with payment of the deficiency surcharge required by section 8(c)(2) of the Act and §2.6.*

(b) *If the affidavit or declaration is not filed within the time periods set forth in section 8 of the Act, or if it is filed within that period by someone other than the owner, the registration will be cancelled. These deficiencies cannot be cured.*

1604.17(a) Correcting Deficiencies in Affidavits or Declarations Timely Filed Within the Periods Set Forth in §§8(a) and 8(b) of the Act

If the owner of the registration timely files the affidavit or declaration during the periods set forth in §§8(a) and 8(b) of the Act (*i.e.*, during the sixth year after the date of registration or publication under §12(c) of the Trademark Act, or within one year before the end of any ten-year period after the date of registration), deficiencies may be corrected within the relevant period without paying a deficiency surcharge. Deficiencies may be corrected after the expiration of the relevant period with payment of the deficiency surcharge required by §8(c)(2) of the Act. 37 C.F.R. §2.164(a)(1).

Any deficiency must be cured within the set period for response to the Post Registration examiner's Office action, *i.e.*, within six months of the mailing date of the action, or before the end of the relevant filing period set forth in §8 of the Act, whichever is later. 37 C.F.R. §2.163(b). See TMEP §1604.16.

1604.17(b) Correcting Deficiencies in Affidavits or Declarations Filed During the Grace Period

If the owner of the registration files the affidavit or declaration during the six-month grace period under §8(c)(1) of the Act, deficiencies may be corrected before the expiration of the grace period without paying a deficiency surcharge, or after the expiration of the grace period with the deficiency surcharge required by §8(c)(2) of the Act. 37 C.F.R. §2.164(a)(2).

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Any deficiency must be cured within six months of the mailing date of the Post Registration examiner's Office action. 37 C.F.R. §2.163(b). See TMEP §1604.16.

1604.17(c) Defects That Cannot be Cured After Expiration of the Grace Period

The registration will be cancelled if an affidavit or declaration of use or excusable nonuse is not filed before expiration of the grace period set forth in §8(c)(1) of the Act, or if the affidavit or declaration is filed by someone other than the current owner of the registration. 37 C.F.R. §2.164(b). Untimely filing and filing in the name of the wrong party cannot be cured after expiration of the grace period, even with a deficiency surcharge. *In re Media Central IP Corp.*, 65 USPQ2d 1637 (Dir USPTO 2002); *In re ACE III Communications, Inc.*, 62 USPQ2d 1049 (Dir USPTO 2001). See TMEP §1604.04 regarding the deadline for filing the affidavit, and TMEP §§1604.07 *et seq.* regarding ownership.

1604.18 Petition Under 37 C.F.R. §2.146

The action of an examiner on a §8 affidavit may not be appealed to the Trademark Trial and Appeal Board, but the owner may file a petition for review of the examiner's action under 37 C.F.R. §§2.146(a)(2) and 2.165(b). A petition fee is required by 37 C.F.R. §§2.6 and 2.146(c). See TMEP Chapter 1700 regarding petitions.

1604.18(a) Response to Examiner's Refusal Required Before Petition

A response to the examiner's initial refusal to accept an affidavit or declaration is required before filing a petition, unless the examiner directs otherwise or there is no time remaining to respond to the examiner's refusal. 37 C.F.R. §2.165(a).

If the examiner continues the refusal to accept the affidavit or declaration, the owner may file a petition for review of the examiner's action under 37 C.F.R. §2.146(a)(2) within six months of the mailing date of the action continuing the refusal. If no petition is filed within six months, the registration will be cancelled. 37 C.F.R. §2.165(b).

1604.18(b) Decision on Petition is Final Action of the Office

The decision on a petition under 37 C.F.R. §2.146 is the final action of the USPTO. In the absence of a request for reconsideration (see TMEP §1604.18(c)), or an appeal to an appropriate court (see TMEP §1604.18(d))

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within two months of the mailing date of the decision on petition, the registration will be cancelled.

1604.18(c) Request for Reconsideration of Denial of Petition

Under Trademark Rule 2.146(j), if a petition is denied, the petitioner may file a request for reconsideration within two months of the mailing date of the decision denying the petition. A second petition fee must be paid with the request for reconsideration. See TMEP §1705.08 regarding requests for reconsideration of petition decisions.

1604.18(d) Appeal to Federal Court

The owner of the registration may appeal to the United States Court of Appeals for the Federal Circuit or commence a civil action for review of the decision denying a petition. 15 U.S.C. §§1071(a)(1) and (b)(1); 37 C.F.R. §§2.145(a) and 2.145(c).

The deadline for filing an appeal or commencing a civil action is two months from the mailing date of the decision on petition. 15 U.S.C. §§1071(a)(2) and (b)(1); 37 C.F.R. §2.145(d)(1). Under 37 C.F.R. §2.145(d)(2), one day is added to any two-month period that includes February 28.

Under 37 C.F.R. §2.165(c), a decision on petition is necessary before the owner can file an appeal or commence a civil action in any court.

1604.19 Section 8 Affidavit or Declaration of Use or Excusable Nonuse Combined with Renewal Application

Under 37 C.F.R. §2.166, an affidavit or declaration under §8 of the Act and a renewal application under §9 of the Act may be combined into a single document, if the document meets the requirements of both §§8 and 9 of the Act. 37 C.F.R. §2.166.

The filing fee for the combined §8 and §9 filing is the sum of the cost of the individual filings. For example, if the filing fee for the §8 affidavit is \$100 per class, and the filing fee for the renewal application is \$400 per class, then the filing fee for the combined §8 and §9 document is \$500 per class.

If the combined §8 and §9 document is filed during the grace period, the filing fees per class and the grace period surcharge per class must be paid for *both* the §8 affidavit and the §9 renewal application.

Example: A registration expires on January 19, 2005. A combined §8 and §9 document is filed January 21, 2005, during the six-month grace period. The proper fees are as follows:
(1) filing fee for the §8 affidavit, per class; (2) grace period surcharge for the §8 affidavit, per class; (3) filing fee for the §9

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renewal application, per class; *and* (4) grace period surcharge for the §9 renewal application, per class.

Failure to include the proper fees is a deficiency that may require a deficiency surcharge. See TMEP §§1604.17 *et seq.* and 1606.13 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies.

Only a single deficiency surcharge is required for curing one or more deficiencies in a combined §8 and §9 filing, even if both the §8 affidavit and the §9 renewal application are deficient. Similarly, only a single deficiency surcharge is required to correct several deficiencies within one document.

To expedite processing, it is recommended that the combined §8 and §9 filing be submitted through TEAS, at <http://www.uspto.gov/teas/index.html>. When the combined filing is submitted electronically, the USPTO immediately issues a confirmation of filing via e-mail that includes the date of receipt and a summary of the submission. This confirmation is evidence of filing should any question arise as to the filing date. See TMEP §301 for additional information about electronic filing.

Alternatively, the owner of the registration can call the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199 to obtain a pre-printed form that can be mailed, faxed or hand-delivered to the USPTO.

See TMEP §1605.05 regarding a combined filing under §§8 and 15 of the Act.

1605 Affidavit of Incontestability Under §15

Section 15 of the Trademark Act, 15 U.S.C. §1065, provides a procedure by which the exclusive right to use a registered mark in commerce on or in connection with the goods or services covered by the registration can become “incontestable,” if the owner of the registration files an affidavit stating that the mark has been in continuous use in commerce for a period of five years after the date of registration. To expedite processing, it is recommended that the owner file the §15 affidavit through TEAS, available at <http://www.uspto.gov>. See TMEP §1605.02.

Under §33(b) of the Act, 15 U.S.C. §1115(b), if the right to use the mark has become incontestable under §15, then the registration is conclusive evidence of the validity of the registered mark and its registration, of the registrant’s ownership of the mark, and of the owner’s exclusive right to use the registered mark in commerce, subject to certain defenses and exceptions. Sections 15 and 33(b) apply only to registrations issued on the Principal Register.

Filing an affidavit of incontestability under §15 of the Trademark Act (“§15 affidavit”) is optional. An eligible registrant may choose to claim the benefits of incontestability and file an appropriate affidavit, or may elect to retain the

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registration without those benefits. The requirements for maintaining and renewing a federal registration are not affected.

The USPTO does not “accept” §15 affidavits. *Arman’s Systems, Inc. v. Armand’s Subway, Inc.*, 215 USPQ 1048, 1050 n.2. (TTAB 1982). The Post Registration examiner reviews the affidavit to determine whether it is consistent with the requirements of the statute and rules (e.g., whether it is signed, whether it was filed at an appropriate time, and whether the §15 claims are properly set forth).

When a §15 affidavit complies with the requirements of the statute and rules, the USPTO updates its records to acknowledge receipt of the affidavit and sends a notice of acknowledgment to the owner of the registration. Acknowledging receipt of the affidavit provides notice to the public that an affidavit of incontestability has been filed; it is not a determination by the USPTO that the registration is in fact incontestable. The question of whether the registration is incontestable is determined by a court in a proceeding involving the mark.

If the §15 affidavit does not comply with the statute and rules, the USPTO issues a written action notifying the registrant of any inconsistency or error, but does not require correction. The USPTO does *not* update its records to acknowledge receipt of a noncompliant affidavit. The registrant has the option of filing a new §15 affidavit, with a new filing fee.

A fee is required for each class in the registration to which the §15 affidavit or declaration pertains. 37 C.F.R. §§2.6 and 2.167(g). If insufficient fees are included with the affidavit, the examiner will issue an Office action allowing applicant additional time to submit the required fees. 37 C.F.R. §2.167(g).

The limitation of grounds that a third party can raise in a petition to cancel a registered mark under 15 U.S.C. §1064 filed more than five years from the date of registration does *not* depend on the filing of a §15 affidavit. TMEP §1605.06.

See TMEP §1605.05 regarding a combined affidavit or declaration under §§8 and 15 of the Act, and TMEP §1216.02 regarding the effect of “incontestability” in *ex parte* examination.

1605.01 Registrations to Which §15 Affidavit Pertains

The provisions of §15 of the Trademark Act apply only to registrations issued on the Principal Register under the Act of 1946 and to registrations issued under the Acts of 1905 and 1881 that have been “published” under §12(c) of the Act. See TMEP §1603 regarding §12(c).

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A §15 affidavit may be filed for a registered extension of protection of an international registration to the United States. Section 73 of the Trademark Act, 15 U.S.C. §1141m.

Section 15 affidavits may not be filed for marks registered on the Supplemental Register of the Act of 1946, marks registered under the Act of 1920, or marks registered under the Acts of 1905 and 1881 for which the benefits of the Act of 1946 have not been claimed under §12(c). If a §15 affidavit is filed for a registration that is not eligible for the benefits of §15, the USPTO will not review it and will refund the filing fee.

1605.02 Form for Filing Affidavit of Incontestability

To expedite processing, it is recommended that the owner file the §15 affidavit through TEAS, available at <http://www.uspto.gov/teas/index.html>. When the affidavit is submitted electronically, the USPTO immediately issues a confirmation of filing via e-mail that includes the date of receipt and a summary of the submission. This confirmation is evidence of filing should any question arise as to the filing date. See TMEP §301 for additional information about electronic filing.

Alternatively, the owner can call the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199 to obtain a pre-printed form that can be mailed, faxed or hand-delivered to the USPTO.

1605.03 Time for Filing Affidavit of Incontestability

A §15 affidavit may not be filed until the federally registered mark has been in continuous use in commerce for at least five consecutive years after the date of registration. This may be any five-year period after the date of registration for marks registered under the Act of 1946, or after the date of publication under §12(c) for marks registered under the Acts of 1905 and 1881.

The registrant may file the affidavit within one year after the five-year period that is selected. 37 C.F.R. §2.167(f). The affidavit must be both executed and filed within that one-year period. If the affidavit is filed too early, the USPTO will not review it and will refund the filing fee. A new affidavit with fee can be submitted during the statutory filing period.

Under 37 C.F.R. §2.195(a)(2), an affidavit filed through TEAS is considered to have been filed on the date the USPTO receives the transmission, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. See TMEP §301 for more information about electronic filing.

If the affidavit is filed on paper, the owner may use certificate of mailing or certificate of facsimile transmission procedures to avoid lateness. See TMEP §§305.02 and 306.05.

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See TMEP §1605.05 regarding a combined affidavit under §§8 and 15 of the Act.

1605.04 Requirements for Affidavit or Declaration of Incontestability

Section 15 of the Act refers to the affidavit or declaration merely as “setting forth” the specified information. See 15 U.S.C. §1065(3). Therefore, no showing or proof beyond the owner’s verified statement is required.

Must be Filed by Owner. In order to be effective, the §15 affidavit or declaration must be filed by the person who is the owner of the registration at the time the affidavit is filed. If the affidavit was filed by the wrong party, the true owner may file a new affidavit, with a new filing fee.

Fee. A fee is required for each class in the registration to which the §15 affidavit or declaration pertains. See 37 C.F.R. §§2.6 and 2.167(g). If insufficient fees are included with the affidavit, the examiner will issue an Office action allowing applicant additional time to submit the required fees. 37 C.F.R. §2.167(g).

Goods/Services Must be Recited. The §15 affidavit must specify the goods or services recited in the registration on or in connection with which the mark has been in continuous use for the five-year period after the date of registration or publication under §12(c) and is still in use in commerce. 15 U.S.C. §1065(3); 37 C.F.R. §2.167(c). More than one affidavit may be filed at different times for different goods/services in the same registration.

Mark Must be In Use in Commerce. Regardless of the basis for registration, the use on which the §15 affidavit is based must be use in commerce. This applies to foreign as well as domestic registrants. It is not necessary to specify the type of commerce (e.g., interstate) in which the mark is used. The USPTO presumes that someone who states that the mark is in use in commerce is stating that the mark is in use in a type of commerce that the U.S. Congress can regulate, unless there is contradictory evidence in the record. See TMEP §§901 *et seq.* regarding use in commerce.

No Adverse Decision or Pending Proceeding Involving Rights in the Mark. The §15 affidavit must state that there has been no final decision adverse to the owner’s claim of ownership of the mark for the goods or services, or to the owner’s right to register the mark or to keep the mark on the register. It must also state that there is no proceeding involving these rights pending in the USPTO or in a court and not finally disposed of. 15 U.S.C. §§1065(1) - 1065(3); 37 C.F.R. §§2.167(d) and (e). If the USPTO finds facts contrary to either of the foregoing statements, the USPTO will not acknowledge receipt of the §15 affidavit. See TMEP §1605. (The USPTO does not consider a proceeding involving the mark in which the owner is the plaintiff, and there is no counterclaim involving the owner’s rights in the mark, to be a “proceeding

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involving these rights” that would preclude the filing or acknowledgment of a §15 affidavit.)

If the USPTO finds that there is a proceeding pending that involves the owner’s right to register the mark or to keep the mark on the register, the USPTO will not acknowledge the affidavit, even if the proceeding was instituted after the owner filed the §15 affidavit but before the affidavit was reviewed by the examiner. If a pending proceeding is later dismissed, the owner may file a new affidavit, with a new filing fee.

Verification. The §15 affidavit must be signed and verified (sworn to) or supported by a declaration under 37 C.F.R. §2.20 by a person properly authorized to sign on behalf of the owner of the registration. A “person who is properly authorized to sign on behalf of the owner” is: (1) a person with legal authority to bind the owner; (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or (3) an attorney as defined in 37 C.F.R. §10.1(c) who has an actual written or verbal power of attorney or an implied power of attorney from the owner. Generally, the USPTO does not question the authority of the person who signs a §15 affidavit, unless there is an inconsistency in the record as to the signatory’s authority to sign.

See TMEP §§301 and 804.05 regarding signature of electronically filed affidavits or declarations.

Affidavit May not be Amended or Corrected. The owner may not amend or correct a §15 affidavit, but may file a new affidavit.

1605.05 Combining §15 Affidavit With §8 Affidavit

Under 37 C.F.R. §2.168(a), the affidavit or declaration filed under §15 of the Act may be combined with the affidavit or declaration required by §8 of the Act, if the combined affidavit or declaration meets the requirements of both §§8 and 15.

The filing fee for the combined §8 and §15 affidavit or declaration is the sum of the cost of the individual filings. For example, if the filing fee for the §8 affidavit is \$100 per class, and the filing fee for the §15 affidavit is \$200 per class, then the filing fee for the combined affidavit or declaration under §§8 and 15 is \$300 per class.

If the combined §8 and §15 affidavit is filed during the §8 grace period, the grace period surcharge per class for the §8 affidavit must be paid. There is no grace period surcharge for a §15 affidavit.

If a combined §8 and §15 affidavit is filed, and the §8 affidavit is deficient, the deficiency may be corrected before expiration of the relevant deadline set forth in §8 of the Act for no fee, or after expiration of the relevant deadline

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with the deficiency surcharge required by §8(c)(2) of the Act. See TMEP §§1604.17 *et seq.* for information about the procedures, deadlines, and surcharge for correcting deficiencies in a §8 affidavit. There is no deficiency surcharge for a §15 affidavit.

To expedite processing, it is recommended that the owner file the combined §8 and §15 affidavit through TEAS, available at <http://www.uspto.gov/teas/index.html>. When the combined affidavit is submitted electronically, the USPTO immediately issues a confirmation of filing via e-mail that includes the date of receipt and a summary of the submission. This confirmation is evidence of filing should any question arise as to the filing date. See TMEP §301 for additional information about electronic filing. Alternatively, the owner can call the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199 to obtain a pre-printed form that can be mailed, faxed or hand-delivered to the USPTO.

1605.06 Section 14 Limitation is Independent of §15 Affidavit

Section 14 of the Trademark Act, 15 U.S.C. §1064, limits the grounds that a third party can raise in a petition to cancel a mark registered on the Principal Register when the petition is filed more than five years from the date of registration or publication under §12(c). This limitation of grounds does *not* depend on the filing of a §15 affidavit. *Trademark Trial and Appeal Board Manual of Procedure* ("TBMP") §307.02(b).

1606 Renewal of Registration Under Trademark Act §9

15 U.S.C. §1059. Renewal.

(a) Subject to the provisions of section 8, each registration may be renewed for periods of 10 years at the end of each successive 10-year period following the date of registration upon payment of the prescribed fee and the filing of a written application, in such form as may be prescribed by the Director. Such application may be made at any time within 1 year before the end of each successive 10-year period for which the registration was issued or renewed, or it may be made within a grace period of 6 months after the end of each successive 10-year period, upon payment of a fee and surcharge prescribed therefor. If any application filed under this section is deficient, the deficiency may be corrected within the time prescribed after notification of the deficiency, upon payment of a surcharge prescribed therefor.

(b) If the Director refuses to renew the registration, the Director shall notify the registrant of the Director's refusal and the reasons therefor.

(c) If the registrant is not domiciled in the United States the registrant may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by

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leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, or if the registrant does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, such notices or process may be served on the Director.

1606.01 Which Registrations Must be Renewed Under §9

1606.01(a) Registrations Based on Applications Under §1 or §44 Must Be Renewed Under §9

Section 9 of the Trademark Act, 15 U.S.C. §1059, requires that registrations resulting from applications based on §1 or §44 of the Trademark Act be renewed periodically. See TMEP §§1606.02 *et seq.* for information about the requirements for renewal under §9.

1606.01(b) Section 9 Does Not Apply to Extensions of Protection of International Registrations to the United States

Section 9 of the Trademark Act does not apply to registered extensions of protection of international registrations to the United States. Renewal of international registrations must be made at the IB, in accordance with Article 7 of the Madrid Protocol. 37 C.F.R. §7.41(a). See TMEP §1614 for further information about renewal of international registrations.

1606.01(c) Renewal of Registrations Issued Under Prior U.S. Trademark Acts Must Be Renewed Under §9

An application for renewal of a registration issued under a prior Act, where required, must meet all the requirements of 15 U.S.C. §1059 and 37 C.F.R. §2.183. See TMEP §1602.02 regarding the renewal of registrations issued under the Acts of 1881 and 1905, and TMEP §1602.03 regarding the renewal of registrations issued under the Act of 1920.

1606.02 Requirements for Renewal Under §9

37 C.F.R. §2.183. Requirements for a complete renewal application.

A complete renewal application must include:

- (a) A request for renewal of the registration, signed by the registrant or the registrant's representative;*
- (b) The fee required by §2.6 for each class;*
- (c) The additional fee required by §2.6 for each class if the renewal application is filed during the six-month grace period set forth in section 9(a) of*

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the Act;

(d) If the renewal application covers less than all the goods or services in the registration, a list of the particular goods or services to be renewed.

(e) If at least one fee is submitted for a multi-class registration, but the class(es) to which the fee(s) should be applied are not specified, the Office will issue a notice requiring either the submission of additional fee(s) or an indication of the class(es) to which the original fee(s) should be applied. Additional fee(s) may be submitted if the requirements of §2.185 are met. If the required fee(s) are not submitted and the class(es) to which the original fee(s) should be applied are not specified, the Office will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class.

1606.03 Time for Filing §9 Renewal Application

The application for renewal must be filed within one year before the expiration of the registration, or within the six-month grace period after the expiration of the registration with an additional grace period surcharge. If no renewal application is filed before the end of the grace period, the registration will expire. 15 U.S.C. §1059(a); 37 C.F.R. §2.182. See TMEP §§1602 *et seq.* as to the term of a registration.

A renewal application may be filed on the anniversary dates of the statutory period.

Example: For a registration issued on November 5, 1998, an application for renewal may be filed as early as November 5, 2007, and as late as November 5, 2008, before entering the six-month grace period.

Under 37 C.F.R. §2.195(a)(2), a renewal application filed through TEAS is considered to have been filed on the date the USPTO receives the transmission, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. When the renewal application is submitted electronically, the USPTO immediately issues a confirmation of filing via e-mail that includes the date of receipt and a summary of the submission. This confirmation is evidence of filing should any question arise as to the filing date. See TMEP §301 for additional information about electronic filing.

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

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1606.03(a) Premature Filing of §9 Renewal Application

A renewal application may not be filed before the period specified in §9 of the Act. *In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984). If an application for renewal is filed more than one year before the expiration date of the registration, the USPTO will advise the registrant: that the renewal application is premature; of the appropriate time period for filing a renewal application; that the fees submitted will be held; and that the registrant may file a new renewal application at the appropriate time or may request a refund at any time. The prematurely filed renewal application will be placed in the record for informational purposes only. A timely renewal application must be filed before the end of the grace period, or the registration will expire and the fees will be refunded. There is no deficiency surcharge for filing a timely substitute renewal application.

1606.04 Form for Filing §9 Renewal Application

To expedite processing, it is recommended that the owner file the renewal application through TEAS. See TMEP §301 for more information about electronic filing.

Because the deadlines for filing renewal applications coincide with the deadlines for filing affidavits of use or excusable nonuse under 15 U.S.C. §1058(a)(3) at the end of each ten-year period following the date of registration, the USPTO has created a form for filing a §8 affidavit combined with a renewal application. See TMEP §1604.19 for more information about combined filings under §§8 and 9 of the Act.

The form for the combined filing is available through TEAS at <http://www.uspto.gov/teas/index.html>. Alternatively, the owner can call the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199 to obtain a pre-printed form that can be mailed, faxed, or hand-delivered.

The USPTO's §9 renewal form cannot be used to renew an international registration. See TMEP §1614 for information about renewal of international registrations.

1606.05 Fees for §9 Renewal Applications

1606.05(a) Fee for Filing Application for Renewal Under §9

A renewal application must include the fee required by 37 C.F.R. §2.6 for each class of goods/services for which renewal is sought. 15 U.S.C. §1059(a); 37 C.F.R. §2.183(b). See TMEP §§1401.02, 1401.04 and 1601.06 regarding use of international classification or prior United States classification for calculation of fees due. See TMEP §1606.05(c) regarding renewal applications filed with insufficient fees.

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1606.05(b) Grace Period Surcharge and Deficiency Surcharge

If the renewal application is filed during the six-month grace period, there is an additional grace period surcharge for each class for which renewal is sought. 15 U.S.C. §1059(a); 37 C.F.R. §§2.6 and 2.183(c).

Under §9(a) of the Trademark Act, a deficiency surcharge is required for correcting a deficiency after expiration of the relevant deadline specified in §9 of the Act. If the renewal application is filed within one year before the expiration of the registration, a deficiency surcharge is required for correcting deficiencies after the expiration date of the registration. If the renewal application is filed during the grace period, a deficiency surcharge is required for correcting deficiencies after expiration of the grace period. See TMEP §§1606.13 *et seq.* for further information regarding the procedures, deadlines and surcharge for correcting deficiencies.

Only a single deficiency surcharge is required for correcting one or more deficiencies in a multi-class registration. Similarly, only a single deficiency surcharge is required to correct several deficiencies within one renewal application or one combined filing under §§8 and 9. See TMEP §1604.19 regarding combined filings under §§8 and 9.

The grace period surcharge applies only if no filing was made within the year before the expiration of the registration. Someone who files within one year before the expiration of the registration, but corrects a deficiency after expiration of the registration, will be subject to the deficiency surcharge only. On the other hand, someone who files during the grace period and cures a deficiency after the grace period expires will be subject to both the grace period surcharge (for the ability to file the renewal application during the grace period) *and* the deficiency surcharge (for the ability to correct a deficiency after the expiration of the grace period). H.R. Rep. No. 194, 105th Congress, 1st Sess. 17 (1997).

1606.05(c) Processing §9 Renewal Application Filed With Insufficient Fees

A renewal application that does not include a fee, or does not include sufficient fees to cover the filing fee for all the classes to which the application pertains (and the grace period surcharge, where applicable), is deficient. If the renewal application is filed within one year before the expiration date of the registration, the deficiency may be corrected before the expiration date of the registration for no fee, or after the expiration date of the registration with the deficiency surcharge required by §9(a) of the Act. If the renewal application is filed during the grace period, the deficiency may be corrected before expiration of the grace period for no fee, or after expiration of the grace period with the deficiency surcharge required by §9(a) of the Act. See TMEP

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§§1606.13 *et seq.* for information about the procedures, deadlines and surcharge for correcting deficiencies.

If the renewal application was filed without sufficient fee(s), but included an authorization to charge additional fees to a USPTO deposit account, the required fee (and grace period surcharge, where applicable) will be charged to the deposit account. If the deposit account authorization was included with the renewal application as filed, and the deposit account had sufficient funds to cover the fee(s) in question, there is no fee deficiency and no deficiency surcharge is required.

An authorization to charge fees to a deposit account with insufficient funds to cover the fee is regarded as a deficiency.

If a check submitted as payment of a filing fee for a renewal application is returned unpaid, or an EFT or credit card payment is refused or charged back by a financial institution, this is also regarded as a deficiency. In addition to the deficiency surcharge (where applicable), there is a \$50 fee for processing the payment that was refused. 37 C.F.R. §2.6(b)(12). See TMEP §405.06.

If at least one fee is submitted for a multi-class registration, but the class(es) to which the fee(s) should be applied are not specified, the Post Registration examiner will issue a notice requiring either the submission of additional fee(s) or an indication of the class(es) to which the original fee(s) should be applied. If the required fee(s) are not submitted and the class(es) to which the original fee(s) should be applied are not specified, the USPTO will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class. 37 C.F.R. §2.183(e).

1606.06 Ownership, and Who May File §9 Renewal Application

The Trademark Act and the Trademark Rules of Practice do not require that a renewal application be filed by the owner of the registration.

Therefore, if the renewal applicant is not the owner of record, the USPTO does not require that the renewal applicant show continuity of title from the original registrant before granting renewal.

However, registrations are renewed in the name of the party who is the owner of record of the registration, as shown in the automated records of the Trademark Operation (*i.e.*, TRAM, TARR, X-Search and TESS). The registration will be renewed in the name of the new owner only if the owner: (1) records an assignment or other document of title with the Assignment Services Division; and (2) notifies the Post Registration examiner at the time the renewal application is filed that the document has been recorded with the Assignment Services Division. See TMEP §§504 *et seq.* regarding the circumstances in which the ownership field in the trademark databases will be automatically updated after recordation of a document with the Assignment

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Services Division, even if the new owner does not notify the Trademark Operation that the document has been recorded.

See TMEP §502.03 regarding issuance of a new certificate in the name of a new owner.

1606.07 Execution of §9 Renewal Application

Under 37 C.F.R. §2.183(a), a renewal application must be signed by “the registrant or the registrant’s representative.” Verification is not required.

Generally, the USPTO does not question the authority of the person who signs a renewal application unless there is an inconsistency in the record as to the signatory’s authority to sign.

The Trademark Act and the Trademark Rules of Practice do not require that a renewal application be executed within any particular time period. Therefore, the USPTO will accept undated renewal applications, and will not issue any inquiry or requirement regarding the date of execution of a renewal application.

1606.08 Goods and/or Services Set Forth in §9 Renewal Application

1606.08(a) Listing of Goods and/or Services Required Only for Partial Renewal

Neither the Trademark Act nor the Trademark Rules of Practice requires a listing of the goods and/or services in the registration if the renewal application covers all the goods/services in the registration. Under 37 C.F.R. §2.183(e), the renewal application must include a list of the goods/services only if the renewal application covers less than all the goods/services in the registration.

1606.08(b) No Goods or Services Listed

If no goods or services are specified in the renewal application, it will be presumed that renewal is sought for all the goods/services in the registration.

1606.08(c) Some Goods and/or Services Listed

If the renewal application lists only some of the goods/services set forth in the registration, it will be presumed that renewal is sought for only the goods/services listed, and the goods/services omitted from the renewal application will be deleted from the registration.

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1606.08(d) Goods and/or Services Not Listed in Registration May Not Be Listed in Renewal Application

Goods/services that are not listed in the registration may not be listed in the renewal application.

1606.09 Affidavit of Use in Commerce or Excusable Nonuse Not Required

The Trademark Act does not require that a renewal application include an affidavit or declaration of use in commerce, a specimen of use, or a showing that any nonuse is due to special circumstances that excuse the nonuse, and not due to any intention to abandon the mark. See notice at 1228 TMOG 187 (Nov. 30, 1999). See also TMEP §§1604 *et seq.* regarding affidavits of use or excusable nonuse under 15 U.S.C. §1058.

1606.10 Designation of Domestic Representative by Foreign Applicant for Renewal Under §9

A renewal applicant who is not domiciled in the United States may set forth the name and address of a United States resident on whom notices or process in proceedings affecting the registration may be served. The USPTO encourages parties who do not reside in the United States to designate domestic representatives. 15 U.S.C. §1059(c); 37 C.F.R. §2.183(d). See TMEP §604.

1606.11 Office Actions and Notices Regarding §9 Renewal Application

Upon receipt of a §9 renewal application, the prosecution history of the registration in the USPTO's automated database is updated to show that the renewal application has been filed. This information is reflected in TRAM and TARR.

When a renewal application is filed through TEAS, the USPTO immediately issues a confirmation of filing via e-mail that includes the date of receipt and a summary of the submission. This confirmation is evidence of filing should any question arise as to the filing date of the renewal application. For renewal applications filed on paper, no acknowledgment of receipt of the application is sent before it is examined.

If the renewal application is examined and found acceptable, the USPTO sends the registrant a notice that renewal has been granted. The USPTO does not issue an Updated Registration Certificate ("URC") for renewed registrations.

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If the renewal application is not acceptable, the USPTO issues an action stating the reasons for refusal. 15 U.S.C. §1059(b); 37 C.F.R. §2.184(a).

The propriety of the original registration is not re-examined on renewal.

1606.12 Response to Office Action

If the renewal application is not acceptable, the USPTO will notify the renewal applicant of the reason(s) for refusal. 15 U.S.C. §1059(b); 37 C.F.R. §2.184(a). Under 37 C.F.R. §2.184(b), a response to a refusal of renewal must be filed within six months of the mailing date of the Post Registration examiner's Office action, or before the expiration date of the registration, whichever is later, or the registration will expire.

The registrant may file a petition under 37 C.F.R. §§2.146(a)(3) and 2.146(a)(5) to waive 37 C.F.R. §2.184(b) and accept a late response to an Office action. However, a rule will be waived only in an extraordinary situation, where justice requires and no other party is injured. See TMEP §1708. The failure to receive an Office action has been found to be an extraordinary circumstance that warrants a waiver of 37 C.F.R. §2.184(b). The "unintentional delay" standard of 37 C.F.R. §2.66 does not apply to a registrant's failure to respond to an Office action issued in connection with a renewal application. TMEP §1714.01(f)(ii).

The renewal applicant may correct deficiencies if the requirements of 37 C.F.R. §2.185 are met. See TMEP §§1606.13 *et seq.* for information about the procedures, deadlines and surcharge for correcting deficiencies.

1606.13 Correction of Deficiencies in §9 Renewal Applications

37 C.F.R. §2.185. Correcting Deficiencies in Renewal Application.

(a) If the renewal application is filed within the time periods set forth in section 9(a) of the Act, deficiencies may be corrected, as follows:

(1) Correcting deficiencies in renewal applications filed within one year before the expiration date of the registration. If the renewal application is filed within one year before the expiration date of the registration, deficiencies may be corrected before the expiration date of the registration without paying a deficiency surcharge. Deficiencies may be corrected after the expiration date of the registration with payment of the deficiency surcharge required by section 9(a) of the Act and §2.6.

(2) Correcting deficiencies in renewal applications filed during the grace period. If the renewal application is filed during the six-month grace period, deficiencies may be corrected before the expiration of the grace period without paying a deficiency surcharge. Deficiencies may be corrected after the expiration of the grace period with payment of the deficiency surcharge required by section 9(a) of the Act and §2.6.

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(b) If the renewal application is not filed within the time periods set forth in section 9(a) of the Act, the registration will expire. This deficiency cannot be cured.

1606.13(a) Correcting Deficiencies in §9 Renewal Applications Filed Within the Year Before the Expiration Date of the Registration

If the renewal application is filed within one year before the expiration date of the registration, deficiencies may be corrected before the expiration date without paying a deficiency surcharge, or after the expiration date with payment of the deficiency surcharge required by §9(a) of the Act. 37 C.F.R. §2.185(a)(1).

Any deficiency must be cured within the set period for response to the Post Registration examiner's Office action, *i.e.*, within six months of the mailing date of the action, or before the expiration date of the registration, whichever is later. 37 C.F.R. §2.184(b). See TMEP §1606.12.

1606.13(b) Correcting Deficiencies in Renewal Applications Filed During the Grace Period

If the renewal application is filed during the grace period, deficiencies may be corrected before the expiration of the grace period without paying a deficiency surcharge, or after the expiration of the grace period with the deficiency surcharge required by §9(a) of the Act. 37 C.F.R. §2.185(a)(2).

Any deficiency must be cured within six months of the mailing date of the Office action. 37 C.F.R. §2.184(b). See TMEP §1606.12.

1606.13(c) Late Filing Cannot be Cured

If the renewal application is not filed before the end of the grace period, the registration will expire. Filing after the expiration of the grace period is not a deficiency that can be cured, even with a deficiency surcharge. 37 C.F.R. §§2.182 and 2.185(b).

1606.14 Petition Under 37 C.F.R. §2.146

The action of an examiner on a §9 renewal application may not be appealed to the Trademark Trial and Appeal Board, but the registrant may file a petition for review of the examiner's action under 37 C.F.R. §§2.146(a)(2) and 2.186(b). A petition fee is required by 37 C.F.R. §§2.6 and 2.146(c). See TMEP Chapter 1700 regarding petitions.

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1606.14(a) Response to Examiner's Refusal Required Before Petition

A response to the examiner's initial refusal to accept a renewal application is required before filing a petition, unless the examiner directs otherwise or there is no time remaining to respond to the examiner's refusal. 37 C.F.R. §2.186(a).

If the examiner continues the refusal of the renewal application, the registrant may file a petition for review of the action under 37 C.F.R. §2.146(a)(2) within six months of the mailing date of the action continuing the refusal. If no petition is filed within six months, the registration will expire. 37 C.F.R. §2.186(b).

1606.14(b) Decision on Petition is Final Action of the Office

The decision on a petition under 37 C.F.R. §2.146 is the final action of the USPTO. In the absence of a request for reconsideration of the decision (see TMEP §1606.14(c)), or an appeal to federal court (see TMEP §1606.14(d)) within two months of the mailing date of the decision on petition, the registration will expire.

1606.14(c) Request for Reconsideration of Denial of Petition

Under Trademark Rule 2.146(j), if a petition is denied, the petitioner may file a request for reconsideration within two months of the mailing date of the decision denying the petition. A second petition fee must be paid with the request for reconsideration. See TMEP §1705.08 regarding requests for reconsideration of petition decisions.

1606.14(d) Appeal to Federal Court

The registrant may appeal to the United States Court of Appeals for the Federal Circuit or commence a civil action for review of the decision on petition. 15 U.S.C. §§1071(a)(1) and (b)(1); 37 C.F.R. §§2.145(a) and 2.145(c).

The deadline for filing an appeal or commencing a civil action is two months from the mailing date of the decision on petition. 15 U.S.C. §§1071(a)(2) and (b)(1); 37 C.F.R. §2.145(d)(1). Under 37 C.F.R. §2.145(d)(2), one day is added to any two-month period that includes February 28.

Under 37 C.F.R. §2.186(c), a decision on petition is necessary before the registrant can file an appeal or commence a civil action in any court.

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1606.15 Section 9 Renewal Application Combined with Affidavit or Declaration of Use or Excusable Nonuse

A renewal application and an affidavit or declaration under §8 of the Act may be combined into a single document, if the document meets the requirements of both §§8 and 9 of the Act. 37 C.F.R. §2.166. See TMEP §1604.19 for further information about combined filings under §§8 and 9.

1607 Cancellation of Registrations Under §§14 and 37 of the Trademark Act

A petition to cancel a registration owned by another party may be filed with the Trademark Trial and Appeal Board under §14 of the Trademark Act, 15 U.S.C. §1064. See TBMP §§303, 307, 308, and 309, for the requirements and fees for filing a petition to cancel a registration. The petition can be filed through the Electronic System for Trademark Trials and Appeals (“ESTTA”) at <http://estta.uspto.gov/>.

See TMEP §1608 regarding the voluntary surrender of one’s own registration for cancellation.

Registrations can also be cancelled under §37 of the Trademark Act, 15 U.S.C. §1119, pursuant to the final order of the court in an action involving a registered mark. The party who has prevailed in the civil action must submit a certified copy of the court order or decree to the Office of the Solicitor of the USPTO. See TMEP §1610.

1608 Surrender of Registration for Cancellation

The owner of a registration may voluntarily surrender his or her registration for cancellation, under §7(e) of the Trademark Act, 15 U.S.C. §1057(e). There is no fee.

A request to surrender a registration must be signed by the owner or owner’s attorney. 37 C.F.R. §2.172.

Filing a §8 affidavit or §9 renewal application for fewer than the total number of classes in the registration is regarded as a surrender of the registration as to the class(es) that are omitted.

Unless the registration is the subject of a cancellation proceeding before the Trademark Trial and Appeal Board, a request for surrender is handled by the Post Registration Section of the USPTO. See TBMP §602.02(a) as to the voluntary surrender of a registration that is the subject of a cancellation proceeding before the Board.

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If the registration is surrendered in its entirety, the USPTO updates its records accordingly, and sends the owner of record a notice that the registration is cancelled.

If fewer than all classes are surrendered, the USPTO enters a notation in the record, and updates its automated records to indicate that specified classes have been cancelled under §7(e) of the Act. A certified copy of the updated registration certificate may be obtained from the Certification Division of the Office of Public Records for a fee. See TMEP §111.

A request to surrender a registered extension of protection of an international registration to the United States may be filed either directly with the IB or with the USPTO. See TMEP §§1906 *et seq.* regarding requests to record changes at the IB, and TMEP §1906.01(e) regarding renunciation, limitation or cancellation of an international registration.

1609 Amendment and Correction of Registrations

1609.01 Amendment of Registration - In General

1609.01(a) Registered Extension of Protection Cannot be Amended Under §7

An extension of protection of an international registration remains part of the international registration even after registration in the United States. TMEP §1601.01(c). All requests to record changes to an international registration must be filed at the IB. The holder of a registered extension of protection cannot file an amendment under §7 of the Trademark Act. The USPTO will not accept an amendment of a registered extension of protection that has not been recorded in the International Register. See TMEP §§1906.01 *et seq.* regarding requests to record changes at the IB.

1609.01(b) Amendment of Registration Resulting From §1 or §44 Application

Under §7(e) of the Trademark Act, a registration based on an application under §1 or §44 of the Trademark Act may be amended “for good cause.” Any request for amendment of a mark must be accompanied by the required fee. 15 U.S.C. §1057(e); 37 C.F.R. §§2.6 and 2.173(a).

The request for amendment must be signed and verified (sworn to) or supported by a declaration under 37 C.F.R. §2.20, by the owner of the registration or a person properly authorized to sign on behalf of the owner. 37 C.F.R. §§2.173(a) and 2.175(b). The following persons are authorized to sign on behalf of the owner: (1) a person with legal authority to bind the owner; (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or (3) an attorney as defined in 37 C.F.R. §10.1(c) who has an actual written or verbal power of attorney or

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an implied power of attorney from the owner. Generally, the USPTO does not question the authority of the person who signs a verification on behalf of the owner, unless there is an inconsistency in the record as to the signatory's authority to sign.

Applications to amend registrations that are not the subject of *inter partes* proceedings before the Trademark Trial and Appeal Board are handled by the Post Registration Section of the Office. Amendment of a registration that is the subject of an *inter partes* proceeding is governed by 37 C.F.R. §2.133. See TBMP §§514.01 *et seq.*

If the request for amendment is granted, the USPTO sends an updated registration certificate showing the amendment to the owner of record, and updates USPTO records accordingly.

1609.02 **Amendment of Mark**

Mark in Registered Extension of Protection Cannot be Amended

As noted in TMEP §1609.01(a), the holder of a registered extension of protection of an international registration to the United States cannot file an amendment under §7 of the Trademark Act. Because a registered extension of protection remains part of the international registration, all requests to record changes to such a registration must be filed at the IB. However, the Madrid Protocol and the *Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to That Agreement* ("Common Regs.") do not permit amendment of the mark in an international registration. If the holder of the international registration wants to change the mark in any way, even slightly, the holder must file a new international application. The IB's *Guide to International Registration*, Para. B.II.69.02 (2004), provides as follows:

[T]here is no provision for a mark that is recorded in the International Register to be amended in any way, either on renewal or at any other time. If the holder wishes to protect the mark in a form which differs, even slightly, from the mark as recorded, he must file a new international application. This is true even if the mark has been allowed to be changed in the basic application, the registration resulting from the basic application or the basic registration....

Therefore, the mark in a registered extension of protection cannot be amended.

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Amendment of Mark in Registration Based on §1 or §44 Application

Under 15 U.S.C. §1057(e), upon application by the owner and payment of the prescribed fee, a registration based on an application under §1 or §44 of the Trademark Act may be amended for good cause, if the amendment does not materially alter the character of the mark. See TMEP §§807.14 *et seq.* and 1609.02(a) regarding material alteration.

1609.02(a) Determining What Constitutes Material Alteration of Mark

Section 7(e) of the Trademark Act prohibits an amendment that materially alters the character of the mark. “Material alteration” is the standard for evaluating amendments to marks at all relevant stages of processing, both during examination of the application and after registration. See 37 C.F.R. §§2.72 and 2.173(a); TMEP §§807.14 *et seq.*

In determining whether a proposed amendment is a material alteration of a registered mark, the USPTO will always compare the proposed amendment to the mark *as originally registered*.

The general test of whether an alteration is material is whether, if the mark in an application for registration had been published, the change would require republication in order to present the mark fairly for purposes of opposition. If republication would be required, the amendment is a material alteration.

An amendment of a registered mark is acceptable if the modified mark contains the essence of the original mark (*i.e.*, the mark as originally registered), and the mark as amended creates essentially the same impression as the original mark. *In re Umax Data System, Inc.*, 40 USPQ2d 1539 (Comm’r Pats. 1996). For example, in marks consisting of word(s) combined with a design, if the word is the essence of the mark and the design is merely background embellishment or display that is not integrated into the mark in any significant way, the removal or change of the design will not be a material alteration of the mark. See *Ex parte Petersen & Pegau Baking Co.*, 100 USPQ 20 (Comm’r Pats. 1953). On the other hand, if a design is integrated into a mark and is a distinctive feature necessary for recognition of the mark, then a change in the design would materially alter the mark. See *In re Dillard Department Stores, Inc.*, 33 USPQ2d 1052 (Comm’r Pats. 1993) (proposed deletion of highly stylized display features of mark “IN•VEST•MENTS” held to be a material alteration); *Ex parte Kadane-Brown, Inc.*, 79 USPQ 307 (Comm’r Pats. 1948) (proposed amendment of “BLUE BONNET” mark to delete a star design and to change the picture of the girl held a material alteration).

When a mark is solely a picture or design, an alteration must be evaluated by determining whether the new form has the same meaning as the original mark, *i.e.*, whether the form as altered would be likely to be recognized as the

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same mark. See *Ex parte Black & Decker Mfg. Co.*, 136 USPQ 379 (Comm'r Pats. 1963) (proposed amendment to delete circle found to be a material alteration, where the circle was determined to be a prominent element of a design mark).

Marks entirely comprised of words can sometimes be varied as to their style of lettering, size, and other elements of form without resulting in a material alteration of the mark. See *Ex parte Squire Dingee Co.*, 81 USPQ 258, *recon. denied*, 81 USPQ 543 (Comm'r Pats. 1949) (amendment from block lettering to script not a material alteration). However, changing from special form to standard characters, or the reverse, may be a material alteration. TMEP §807.03(d).

A generic or purely informational term may be deleted if the essence of the mark in appearance or meaning is not changed, but a word or feature that is necessary to the significance of the mark may not be deleted. Likewise, a unique or prominent design feature may not be deleted. See *In re Richards-Wilcox Mfg. Co.*, 181 USPQ 735 (Comm'r Pats. 1974) (proposed amendment to block lettering from mark comprising a diamond design surrounding the word "FYER-WALL" with an inverted channel bracket around the letters "RW" held a material alteration). See also TMEP §807.14(a) regarding amendments deleting matter from a mark.

1609.02(b) New Drawing Required

When applying for an amendment to a registration that involves a change in the mark, the owner of the registration must submit a new drawing displaying the amended mark. 37 C.F.R. §2.173(a). See TMEP §§807 *et seq.* regarding drawings.

1609.02(c) Supporting Specimen and Declaration

The owner of the registration must submit one specimen showing use of the proposed mark as amended on or in connection with the goods or services, and must include an affidavit or a declaration under 37 C.F.R. §2.20 stating that the specimen was in use in commerce at least as early as the date the §7 amendment was filed. 37 C.F.R. §2.173(a). The affidavit or declaration must be signed and verified (sworn to) or supported by a declaration under 37 C.F.R. §2.20 by the owner or a person properly authorized to sign on behalf of the owner of the registration. A "person properly authorized to sign on behalf of the owner" is: (1) a person with legal authority to bind the owner; (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or (3) an attorney as defined in 37 C.F.R. §10.1(c) who has an actual written or verbal power of attorney or an implied power of attorney from the owner. Generally, the USPTO does not question the authority of the person who signs an affidavit or declaration

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requesting an amendment under §7 of the Act, unless there is an inconsistency in the record as to the signatory's authority to sign.

A specimen showing use of the proposed mark as amended on or in connection with the goods or services is required even if the mark originally registered under 15 U.S.C. §1126(e), based on a foreign registration. See TMEP §§904 *et seq.* regarding specimens, and TMEP §1015 regarding the independence of a §44 registration from the underlying foreign registration.

1609.02(d) Amendment of Black and White Drawing of Mark for Which Color is Claimed to Substitute Color Drawing

Prior to November 2, 2003, the USPTO did not publish marks or issue registrations in color. An applicant who wanted to show color in a mark was required to submit a black and white drawing, with a statement describing the color(s). Effective November 2, 2003, the USPTO accepts color drawings. Black and white drawings with a color claim, or drawings that show color by use of lining patterns, are no longer permitted. 37 C.F.R. §2.52(b)(1).

Color drawings must be accompanied by a color claim naming the colors that are a feature of the mark, and a separate statement describing where the color(s) appear on the mark. 37 C.F.R. §2.52(b)(1); TMEP §807.07(a).

In a registration based on an application filed before November 2, 2003, if the application included a black and white drawing with a statement claiming color, the owner may file a request under §7 of the Trademark Act to substitute a color drawing for the black and white drawing. The request must include: (1) a color drawing showing the same colors claimed in the registration; (2) a color claim naming the color(s) that are a feature of the mark; (3) a description of where the color(s) appear in the mark; and (4) the fee required by 37 C.F.R. §2.6. 37 C.F.R. §2.173(a). No specimen is required if the owner is merely substituting a color drawing for a legally equivalent black and white drawing, and is not amending the mark.

1609.03 Amendment of Identification of Goods or Services

Identification of Goods/Services in Registered Extension of Protection Cannot be Amended Under §7

The identification of goods/services in a registered extension of protection of an international registration to the United States cannot be amended under §7 of the Trademark Act. TMEP §1609.01(a). All requests to record changes to an international registration must be filed at the IB. See TMEP §§1906.01 *et seq.* regarding requests to record changes at the IB. Note that the IB does not permit amendments that expand the list of goods/services in an international registration. See TMEP §1906.01(i).

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Amendment of Registration Based on §1 or §44 Application

In registrations based on applications under §§1 and 44 of the Trademark Act, amendments may be made to the identification of goods/services to restrict the identification or otherwise to change it in ways that would not require republication of the mark. However, goods/services may not be added to a registration by amendment. See 37 C.F.R. §2.173(b). Changed circumstances (e.g., new technology) will not render acceptable an amendment that is not otherwise permissible. See *In re Capp Enterprises, Inc.*, 32 USPQ2d 1855 (Comm'r Pats. 1993); *In re Fortex Industries Inc.*, 18 USPQ2d 1224 (Comm'r Pats. 1990); *In re Carter Hawley Hale Stores, Inc.*, 200 USPQ 179 (Comm'r Pats. 1978). For example, if the goods in the registration are identified as "phonograph records," the identification of goods cannot be amended to "compact discs."

In a multiple-class registration, deletion of less than all the goods or services in a single class constitutes an amendment, whereas deletion of an entire class constitutes a surrender of the registration for cancellation as to the class deleted. See 37 C.F.R. §2.172. See TMEP §1608 regarding surrender.

1609.04 Amendment of Classification

Classification of Goods/Services in Registered Extension of Protection Cannot be Amended Under §7

The classification of goods/services in a registered extension of protection of an international registration to the United States cannot be amended under §7 of the Trademark Act. TMEP §1609.01(a). All requests to record changes to an international registration must be filed at the IB. See TMEP §§1906.01 *et seq.* regarding requests to record changes at the IB. See *also* TMEP §1401.03(d) regarding amendment of the classification in a pending application under §66(a) of the Trademark Act.

Amendment of Registration Based on §1 or §44 Application

In a registration that issued based on an application under §1 or §44 of the Trademark Act, the classification of the goods/services may be amended under §7 of the Trademark Act, if the requested international classification is consistent with the current version of the *Nice Agreement*. In such a case, the USPTO will amend the international classification of goods/services and issue an updated registration certificate with the new classification noted.

The owner of a registration may reclassify registrations from multiple U.S. classes into a single international classification. For example, goods in U.S. classes 21 and 26 often fall into only International Class 9. Hence, an owner

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can request an amendment from U.S. classes 21 and 26 into International Class 9.

The amendment must include the fee required by 37 C.F.R. §2.6 for §7 amendments.

The owner must reclassify all the goods/services in the registration to the international classification system.

1609.05 Disclaimer of Mark

A registered mark may be amended to disclaim part of the mark. 37 C.F.R. §2.173(a). However, no amendment seeking the elimination of a disclaimer will be permitted. 37 C.F.R. §2.173(b).

An amended registration must still contain registrable matter, and the mark as amended must be registrable as a whole. The disclaimer must not materially alter the character of the mark. 37 C.F.R. §2.173(a).

1609.06 Territorial Restrictions

A registration cannot be restricted territorially by amendment under §7(e) of the Act. *In re Forbo*, 4 USPQ2d 1415 (Comm'r Pats. 1984). Generally, a concurrent use restriction cannot be removed from a registration by an amendment under §7(e). However, removal of a concurrent use restriction by amendment under §7(e) may be permitted where an entity that was the *only* exception to the owner's right to exclusive use of its registered mark assigns its rights in the mark to the owner of the registration, so that all rights in the mark are merged in the owner. *In re Alfred Dunhill Ltd.*, 4 USPQ2d 1383 (Comm'r Pats. 1987); TBMP §§1101.02 and 1114.

1609.07 Dates of Use

The USPTO will accept an amendment changing the dates of use, even if the amended dates are later than the dates originally set forth in the registration. See *In re Pamex Foods, Inc.*, 209 USPQ 275 (Comm'r Pats. 1980); *Grand Bag & Paper Co., Inc. v. Tidy-House Paper Products, Inc.*, 109 USPQ 395 (Comm'r Pats. 1956). However, the USPTO will not enter an amendment if the amended dates are later than the dates that would have been accepted during examination. Therefore, the USPTO will not enter the following amendments:

- If the application for the registration was based on use in commerce under 15 U.S.C. §1051(a), the registration cannot be amended to specify a date of use that is later than the application filing date (see 37 C.F.R. §2.71(c)(1));

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- If the application for the registration was based on intent-to-use under 15 U.S.C. §1051(b), and a statement of use under 15 U.S.C. §1051(d) was filed, the registration cannot be amended to specify a date of use that is later than the statutory deadline for filing the statement of use (i.e., within six months of the mailing date of the notice of allowance or before the expiration of an extension of time for filing a statement of use) (see 37 C.F.R. §2.71(c)(2));
- If the application for the registration was based on intent-to-use under 15 U.S.C. §1051(b), and an amendment to allege use under 15 U.S.C. §1051(c) was filed, the registration cannot be amended to specify a date of use that is later than the filing date of the amendment to allege use (see TMEP §903.05); and
- The date of first use in commerce may not be earlier than the date of first use anywhere (see TMEP §903.04).

1609.08 Effect of Amendment of Registration on Limitation of Grounds for Cancellation of a Registration

Section 14 of the Trademark Act, 15 U.S.C. §1064, limits the grounds that a third party can raise in a petition to cancel a mark registered on the Principal Register when the petition is filed more than five years after the date of registration.

Ordinarily, the five-year period runs from the date of the registration of the mark for a registration issued on the Principal Register under the Act of 1946, and from the date of publication under §12(c) of the Act for registrations issued under prior Acts and published under §12(c) of the Act of 1946.

However, when a registration has been amended, the five-year period runs from the date of the amendment, to the extent that the amendment of the registration has in any way enlarged the owner's rights, as though the registration had issued on the date of the amendment. See TBMP §307.02(c)(2).

1609.09 Amendment From Supplemental to Principal Register Not Permitted

A registration on the Supplemental Register may not be amended to the Principal Register. If the owner of a registration wishes to seek registration on the Principal Register of a mark for which it owns a registration on the Supplemental Register, the owner must file a new application. Under 15 U.S.C. §1062(a), a mark must be published for opposition before it can be registered on the Principal Register.

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1609.10 Correction of Mistake in Registration

The USPTO may make a correction to a registration in appropriate cases, upon written request by the owner of the registration. See §7(g) of the Trademark Act, 37 C.F.R. §2.174, and TMEP §1609.10(a) regarding correction of USPTO errors; and §7(h) of the Act, 37 C.F.R. §2.175, and TMEP §1609.10(b) regarding correction of errors by the owner of a registration.

Requests for correction of registrations are handled by the Post Registration Section.

If the request for correction is granted, the USPTO sends an updated registration certificate to the owner of record, and updates USPTO records to show the correction.

1609.10(a) Correction of Office Error

If a clerical error occurred through the fault of the USPTO, the USPTO will correct the error without charge. 15 U.S.C. §1057(g); 37 C.F.R. §2.174. Section 7(g) gives the Director the discretion to issue a certificate of correction of the existing registration, or to issue a new certificate of registration without charge.

The owner of the registration should submit a written request, specifying the error to be corrected. This request should be signed by the owner of the registration or the owner's attorney, and directed to the Post Registration Section of the Office.

The USPTO will issue a certificate of correction if the change is non-material, such as a slight misspelling in the mark or the identification of goods/services, or an error in entering the owner's name or address.

A USPTO error in classification may be corrected if the requested classification is consistent with the current version of the *Nice Agreement*. Republication is not required.

If correction of a USPTO error would result in a material change (e.g., a material change of the mark or a broadening of the identification of goods/services), the USPTO will not issue a certificate of correction under §7(g). Section 12(a) of the Trademark Act requires examination and publication prior to registration. Therefore, if the error results in a material change to the registration, the error can be corrected only by cancelling the registration as inadvertently issued and republishing it with the correct information. The USPTO will give the owner the option of either (1) keeping the registration as issued, or (2) having the registration cancelled as inadvertently issued and republished. If the owner chooses to have the mark

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republished, and registration is not successfully opposed, the USPTO will issue a new certificate of registration with a new registration date.

In some cases, further examination may be required to correct a USPTO error that would materially change the registration, *e.g.*, where a proposed amendment to the mark or the identification of goods/services was filed prior to registration, but not timely made of record and reviewed by the examining attorney. In this situation, the registration will be cancelled as inadvertently issued and returned to examination. The examining attorney will examine the amendment using standard examination procedures. If the examining attorney approves the amendment, the mark will be republished.

A request to have a registration cancelled as inadvertently issued should be directed to the Office of the Commissioner for Trademarks.

1609.10(b) Correction of Registrant's Error

Error in Registered Extension of Protection Must be Corrected at International Bureau

An extension of protection of an international registration remains part of the international registration even after registration in the United States. TMEP §1601.01(c). All requests to record changes to an international registration must be filed at the IB. See TMEP §§1906.01 *et seq.* regarding requests to record changes at the IB.

Registration Based on Application under §1 or §44

Under §7(h) of the Trademark Act, if a mistake in a registration occurs in good faith through the fault of the owner of the registration, the Director may correct the error upon written request and payment of the fee required by 37 C.F.R. §2.6, *provided* the correction does not result in a change that would require republication of the mark.

The owner of the registration must file a written request specifying the error, explaining how the error occurred, and showing that it occurred in good faith. The request must be verified by the owner or a person who is properly authorized to sign on behalf of the owner. 37 C.F.R. §2.175(b). A "person properly authorized to sign on behalf of the owner" is: (1) a person with legal authority to bind the owner; (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or (3) an attorney as defined in 37 C.F.R. §10.1(c) who has an actual written or verbal power of attorney or an implied power of attorney from the owner. The request for correction should be directed to the Post Registration Section of the Office.

As noted above, the owner of a registration cannot correct a mistake if the changes would require republication of the mark. 15 U.S.C. §1057(h);

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37 C.F.R. §2.175(a). Thus, a correction cannot be made if it would materially alter the mark, or broaden the identification of goods/services. See TMEP §§807.14 and 1609.02(a) regarding material alteration, and TMEP §1609.03 regarding changes to the identification of goods/services.

A registration can be corrected to cure an inadvertent error in the manner in which the owner's name is set forth. However, the registration cannot be corrected to substitute another entity as the owner. See TMEP §1201.02(c) for examples of correctable and non-correctable errors in identifying the owner of an application or registration.

Section 7(h) gives the Director the discretion to issue a certificate of correction of the existing registration or to issue a new certificate of registration. See *In re Pamex Foods, Inc.*, 209 USPQ 275, 277-78 (Comm'r Pats. 1980). In either case, if the mistake was made by the owner of the registration, a fee is required. See 15 U.S.C. §1057(h); 37 C.F.R. §§2.6 and 2.175(b).

1609.11 Change of Owner's Address Can Be Filed Through TEAS

It is not necessary to file a §7 amendment to change the address of the owner of a registration. This can be done through TEAS, at www.uspto.gov/teas/index.html.

Note: The owner's address often differs from the correspondence address. The correspondence address can also be changed through TEAS, using a different form. See TMEP §603.02(c) for information about changing the correspondence address after registration.

1610 Court Orders Concerning Registrations

The USPTO must rectify the register and make appropriate entry upon its records in response to a court order certified to the Office pursuant to 15 U.S.C. §1119. That section provides:

In any action involving a registered mark the court may determine the right to registration, order the cancellation of registrations, in whole or in part, restore cancelled registrations, and otherwise rectify the register with respect to the registrations of any party to the action. Decrees and orders shall be certified by the court to the Director, who shall make appropriate entry upon the records of the Patent and Trademark Office, and shall be controlled thereby.

Any such order affecting a registration must be *certified* to the Office, and should be addressed to the Office of the Solicitor, Mail Stop 8, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria,

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Virginia 22313-1450. 37 C.F.R. §1.1(a)(3)(iii). An uncertified copy of the court order is unacceptable. Once the Office receives the certified order, appropriate action will typically be taken by the Office without the necessity of any submission by an interested party. However, if it would be helpful for purposes of determining the scope or effect of an order, the Office may, at the Director's discretion, issue a show cause order directing the registrant and parties to the action from which the order arose to respond and provide information or arguments regarding the order.

1611 Updating Automated Records to Show the Status of Registrations

USPTO records will be automatically updated to indicate the status of registrations as follows:

- (1) When the owner of a registration timely files a §8 affidavit and/or §9 renewal application, Office records are updated to indicate receipt of the document and the action taken on it. This information appears in TRAM and TARR.
- (2) If no §8 affidavit is filed before the end of the grace period (see TMEP §1604.04 regarding the deadline for filing a §8 affidavit), Office records are automatically updated to indicate that the registration is cancelled, and this information appears in TRAM and TARR. However, Office records are not updated to show that the registration is cancelled until three months *after* the expiration of the grace period.
- (3) If no §9 renewal application is filed before the end of the grace period (see TMEP §1606.03 regarding the deadline for filing a renewal application), Office records are automatically updated to indicate that the registration is expired, and this information appears in TRAM and TARR. However, Office records are not updated to show that the registration is expired until three months *after* the expiration of the grace period.

The reason the USPTO waits until three months *after* the expiration of the grace period before updating its records to show that the registration is cancelled or expired is to avoid inadvertent cancellation or expiration of a registration due to a delay in entering a timely filed §8 affidavit or renewal application into the record.

If a the owner of a registration who has not timely filed a §8 affidavit or §9 renewal application wants to expedite cancellation or expiration of its own registration, the owner may request in writing that the Office expedite the processing of the cancellation or expiration of the registration. The request should be signed by the owner or the owner's attorney, and should specifically state that no §8 affidavit or renewal application was filed on or

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before the end of the grace period. Such a request should be directed to the Post Registration Section; if it is sent to the examining attorney, the examining attorney should forward it to the Supervisor of the Post Registration Section.

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

1612 Powers of Attorney and Designations of Domestic Representative Filed After Registration

To expedite processing, the USPTO recommends that powers of attorney, requests to revoke powers of attorney, and designations of domestic representative be filed through TEAS, at <http://www.uspto.gov/teas/index.html>. When these documents are filed through TEAS, the data is automatically entered into the USPTO's automated TRAM system. Requests to withdraw as attorney cannot be filed through TEAS after registration.

The USPTO considers a power of attorney to end with registration.

When the owner of a registration files a new power of attorney or designation of domestic representative *on paper*, the USPTO scans an image of the power or designation into the record, but does not update the TRAM database unless the owner concurrently files a §8 or §15 affidavit, §9 renewal application, or request to amend or correct a registration under §7 of the Trademark Act. Likewise, when the owner of a registration files a *paper* request to revoke a power of attorney, or an attorney files a request to withdraw as attorney of record, the USPTO scans an image of the document into the record but does not change the attorney of record in TRAM.

When the owner of a registration files a §8 or §15 affidavit, §9 renewal application, or request to amend or correct a registration through an attorney, the USPTO will update TRAM to indicate the name of the attorney who filed the document, and any designation of domestic representative. If the owner does not have an attorney, the USPTO will update TRAM to indicate the owner's address as shown in the affidavit, renewal application or amendment.

See TMEP §§602.01 *et seq.* regarding powers of attorney, TMEP §604 regarding designations of domestic representative by parties not domiciled in the United States, and TMEP §603.02(c) regarding changes of correspondence address filed after registration.

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1613 Affidavit of Use in Commerce or Excusable Nonuse Under §71 of the Trademark Act

Under §71 of the Trademark Act, 15 U.S.C. §1141k, a registered extension of protection to the United States will be cancelled unless the holder of the international registration periodically files affidavits of use in commerce or excusable nonuse (“§71 affidavits”). The affidavits must include (1) a verified statement by the holder that the mark is in use in commerce, and a specimen of use, or (2) a verified statement setting forth that any nonuse is due to special circumstances that excuse such nonuse and is not due to any intention to abandon the mark. These affidavits must be filed:

- (1) Between the fifth and sixth year after the date on which the USPTO issues the certificate of extension of protection; and
- (2) Within the six-month period preceding the end of every ten-year period after the date on which the USPTO issues the certificate of extension of protection, or within a three-month grace period with an additional surcharge.

Section 71 provides a 3-month grace period for filing the ten-year §71 affidavit with an additional surcharge. There is *no grace period* for filing the six-year §71 affidavit. Unlike §8(c)(2) of the Trademark Act, §71 does not provide for correction of deficiencies after expiration of the statutory filing period. The requirements for a §71 affidavit are set forth in 37 C.F.R. §7.37.

Since the §71 affidavit cannot be filed until five years after the USPTO registers an extension of protection, the USPTO will not accept these affidavits until after November 2, 2008.

1614 Renewal of Registered Extension of Protection

The holder of a registered extension of protection of an international registration to the United States must renew the international registration with the IB. 37 C.F.R. §7.41(a). Renewal of international registrations is governed by Article 7 of the Madrid Protocol and Rules 29 - 31 of the Common Regs. See TMEP §1905.

Under §70(b) of the Trademark Act, 15 U.S.C. §1141j(b), and Article 3^{ter}(2) of the Protocol, if the international registration is not renewed, the IB will notify the USPTO that the registration has expired. The corresponding extension of protection to the United States will expire as of the expiration date of the international registration. The USPTO will cancel the extension of protection.

Section 9 of the Trademark Act does not require renewal of a registered extension of protection with the USPTO. However, the holder must file affidavits of use or excusable nonuse under §71 of the Trademark Act. See TMEP §1613.

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1615 Division of Registrations

§2.171(b). When ownership of a registration has changed with respect to some, but not all, of the goods and/or services, the registrant(s) may file a request that the registration be divided into two or more separate registrations. The fee required by §2.6(a)(8) must be paid for each new registration created by the division, and the change of ownership must be recorded in the Office.

A registration can be divided only if ownership of the registration has changed with respect to some, but not all, of the goods/services. 37 C.F.R. §2.171(b). Requests to divide registrations are processed in the Post Registration Section.

See TMEP §1615.01 regarding division of registrations based on applications under §§1 and 44 of the Trademark Act, and TMEP §1615.02 regarding division of registered extensions of protection.

1615.01 Division of Registration Based on Application Under §1 or §44 of the Trademark Act

If ownership of a registration has changed with respect to some but not all of the goods/services, the owner may file a request that a registration be divided into two or more separate registrations. 37 C.F.R. §2.171(b).

The party requesting division must: (1) record the assignment with the Assignment Services Division of the USPTO; (2) file a request to divide; and (3) pay the fee required by 37 C.F.R. §2.6(a)(8) for each new registration created by the division. 37 C.F.R. §2.171(b). If the request does not meet these requirements, the Post Registration examiner will issue an Office action granting the party who filed the request six months in which to comply with the requirements of the rule. If there is no response, the request to divide will be dismissed.

A party who requests division of a registration issued under the old U.S. classification system (see TMEP §1401.02) must agree to adopt the international classification system for both the parent and child registration. See TMEP §1609.04 regarding amendment of classification.

Once the registration is divided, the USPTO will create a new registration number for the child and send new registration certificates to both the assignor and assignee.

A registration may be divided more than once.

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1615.02 Division of Registered Extension of Protection

When ownership of an international registration changes with respect to some but not all of the goods/services for all designated Contracting Parties, the IB will create a separate new international registration for the goods/services that have been transferred, and notify the USPTO accordingly. See the IB's *Guide to International Registration*, Para. B.II.65.01 (2004).

To obtain a new certificate(s) of registration of the extension of protection in the United States in this situation, the new owner(s) must:

- (1) file a request to divide with the USPTO, and
- (2) pay the fee required by 37 C.F.R. §2.6(a)(8) for each new registration created by the division. 37 C.F.R. §2.171(b). No application filing fee pursuant to 37 C.F.R. §2.6(a)(1) is required.

When the IB notifies the USPTO of the division of an international registration resulting from a change of ownership with respect to some but not all of the goods/services, the USPTO will record the partial change of ownership in the Assignment Services Division, divide out the assigned goods/services from the registered extension of protection (parent registration), issue an updated certificate for the parent registration, and publish notice of the parent registration in the *Official Gazette*.

The USPTO will create a new registration number for the child, and enter the information about the new registration in its automated records. However, the USPTO will not issue a new registration certificate for the child registration or publish notice of the child registration until the assignee submits a request to divide under 37 C.F.R. §2.171(b), and pays the required fee.

The USPTO will not divide a registered extension of protection to the United States unless the IB notifies the USPTO that the international registration has been divided.

A registration may be divided more than once.

See TMEP §1110.08 regarding division of a pending §66(a) application after ownership has changed with respect to some but not all of the goods/services, and TMEP §501.07 regarding assignment of extensions of protection.

1616 Replacement

If a U.S. national registration and a subsequently issued certificate of extension of protection of an international registration to the United States are (1) owned by the same person, (2) identify the same mark, and (3) list the same goods/services, the extension of protection shall have the same rights as those accrued to the U.S. national registration at the time the certificate of

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extension of protection issues. Section 74 of the Trademark Act, 15 U.S.C. §1141n; Article 4^{bis} of the Madrid Protocol; 37 C.F.R. §7.28(a).

Legally, replacement takes place automatically, by operation of law. However, the USPTO will note the replacement in its records (and notify the IB accordingly) only if the holder of a registered extension of protection files a request that it do so. A request to note replacement of a U.S. national registration with a registered extension of protection must include:

- (1) The serial number or registration number of the extension of protection to the United States;
- (2) The registration number of the replaced U.S. registration; and
- (3) The fee required by 37 C.F.R. §7.6.

37 C.F.R. §7.28(b).

The holder cannot file the request to note replacement of the U.S. national registration until the registration based on the request for extension of protection issues.

“Replacement” does not invalidate the U.S. national registration. The U.S. national registration remains on the register, with all the rights attaching to such a registration, as long as the holder renews the registration under §9 of the Trademark Act and files the necessary affidavits of use or excusable nonuse under §8 of the Trademark Act. 37 C.F.R. §7.29. It is up to the holder to decide whether to maintain the replaced U.S. national registration.