

Examination Guide 3-23

Examination Procedures for Reviewing Domicile Addresses

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I. Introduction

This examination guide provides additional examination guidance on domicile addresses, including the procedures that examining attorneys and post-registration examiners will follow for evaluating domicile addresses and reviewing responses to domicile address requirements. The guide also explains the options for responding to a domicile address requirement, particularly when an applicant or registrant (i.e., owner/holder) indicates it has “no fixed physical address.”

This examination guide supersedes the current edition of the Trademark Manual of Examining Procedure (TMEP) and any other official United States Patent and Trademark Office (USPTO) trademark guidance to the extent any inconsistency exists.

II. Determining the Acceptability of Domicile Addresses

Addresses that do not identify an actual street address or that function as a mail-forwarding address are presumptively unacceptable as domicile addresses. Such addresses include post office (P.O.) boxes,¹ “care of” (c/o) addresses, commercial mail receiving agency (CMRA) addresses, registered agent (RA) addresses, private mailboxes (PMB), Army Post Office (APO) addresses, Fleet Post Office (FPO) addresses, Diplomatic Post Office (DPO) addresses, and Highway Contract Route (HCR or HC) addresses. These addresses, along with virtual office and shared workspace addresses, generally may not serve as domicile addresses

¹ A P.O. box address is acceptable for U.S. government entities and federally recognized American Indian and Alaska Native tribes. See TMEP §601.01(b)(1).

because they do not identify the location of the place the person resides and that is intended to be the person's principal home (for a natural person) or the location of a juristic entity's headquarters where the entity's senior executives or officers ordinarily direct and control the entity's activities (for a juristic entity).²

Examining attorneys and post-registration examiners are not required to confirm or research a listed domicile address in the initial application or maintenance filing, but they must require the applicant or registrant to provide an acceptable domicile address if:

- (1) it is apparent that the address is an unacceptable type of domicile address (e.g., P.O. box, c/o, PMB, APO, FPO, DPO, HCR, or HC appears in the address); or
- (2) the examining attorney receives specific guidance that the domicile address is unacceptable.

Domicile address may not be obtained by examiner's amendment. Not all applicants understand that domicile address information entered by examiner's amendment will become part of the public record. Therefore, examining attorneys may no longer obtain and enter an applicant's domicile address by examiner's amendment, even if the applicant indicates an understanding that domicile information entered in this manner will not be hidden or "masked."

Non-U.S. citizen with U.S. address. Under current TMEP §601.01(b), if an applicant or registrant is a foreign citizen or entity with a U.S. street address and is not represented by a qualified U.S. attorney, the examining attorney or post-registration examiner must issue an Office action requiring the applicant or registrant to appoint a qualified U.S. attorney or provide documentation supporting the specified U.S. street address. Upon issuance of this examination guide, in such situations, examining attorneys and post-registration examiners will not question an otherwise acceptable U.S. street address of a foreign citizen or entity provided in an application or post-registration maintenance filing unless they receive specific guidance that the address is unacceptable. Further, a requirement to appoint a qualified U.S. attorney or provide documentation supporting the specified U.S. street address made prior to issuance of this guidance may be withdrawn.

III. Evaluating a New Domicile Address Provided in Response to a Domicile Address Requirement

If the applicant or registrant responds to the requirement to provide an acceptable domicile address by stating that they filed a petition to waive the requirement, the examining attorney or post-registration examiner must proceed as indicated in Part V.

When an applicant or registrant provides a new domicile address in response to a domicile address requirement, the examining attorney or post-registration examiner must follow the steps below.

Step 1: If it is apparent that the new address is an unacceptable type of domicile address, or is a foreign address, proceed to step 3.³

Step 2: If it is not apparent that the new address is an unacceptable type of domicile address and is not a foreign address, conduct an internet search of the new domicile address to determine whether it is an acceptable or unacceptable type based on the applicant's or registrant's entity type. Examining attorneys may

² See TMEP §601.01(b)(1).

³ Examining attorneys are not required to search foreign addresses due to the unreliability of search engines in retrieving results relating to these addresses and the difficulty of verifying them.

request assistance from the Trademark Law Library with this search. Post-registration examiners may request assistance by emailing the Post Registration internal mailbox.

After completing a search, examining attorneys must upload a Note to the File indicating that they conducted a search. After registration, a Note to the File will be entered after the search is conducted.

Step 3: Take the appropriate action below, based on the relevant circumstances:

Acceptable domicile address based on the applicant's or registrant's entity type. If the new address is an acceptable type of domicile address, it may be accepted. However, consistent with existing examination procedures, the examining attorney or post-registration examiner must raise any new issues resulting from the new domicile address (e.g., if a pro se applicant or registrant provides a foreign domicile address, then U.S. counsel is required if one was not already appointed).

Unacceptable domicile address and no arguments or evidence submitted. If the new address is an unacceptable type of domicile address and the applicant or registrant did not provide any arguments or evidence as to why the address complies with the requirement for a domicile address, the requirement must be maintained and/or made final, as appropriate.

Unacceptable domicile address and arguments or evidence submitted. If the new address is an unacceptable type of domicile address based on the applicant's or registrant's entity type and the applicant or registrant provides any arguments or evidence in the form of documentation, see Part IV.

IV. Reviewing an Applicant's or Registrant's Arguments or Evidence

Examining attorneys and post-registration examiners must evaluate any arguments, including any explanations, or evidence regarding a domicile address on a case-by-case basis, whether included in the initial application or maintenance filing, or in a response.

A. General Arguments (Excluding "No Fixed Physical Address" Explanation)

Any assertion that the domicile address is in fact the applicant's or registrant's principal place of business (for a juristic entity) or the place the person resides and that is intended to be the person's principal home (for a natural person) must be made in a formal written response.

Only in rare cases may an otherwise unacceptable type of domicile address be accepted based on the applicant's or registrant's arguments. If uncertain about whether the provided domicile address should be accepted, the examining attorney should consult their managing or senior attorney. Post-registration examiners should consult their lead.

When a requirement for an acceptable domicile address is maintained or made final, the requirement may be satisfied by providing a new, acceptable domicile address. Alternatively, the applicant or registrant may file a petition to the Director to waive the domicile address requirement because of an extraordinary situation. See Part V.

B. "No Fixed Physical Address" Explanation

A detailed explanation that the applicant or registrant has "no fixed physical address" is no longer considered sufficient to satisfy the requirement for an acceptable domicile address. Because the applicant or registrant is essentially requesting a waiver of the domicile address rule, the appropriate mechanism for considering these explanations/arguments is a petition to the Director.

i. Handling Applications or Maintenance Filings with a "No Fixed Physical Address" Explanation

"No fixed physical address" explanation in the initial application or maintenance filing. If the applicant or registrant provides an unacceptable type of domicile address and asserts it has "no fixed physical address" in the initial application or maintenance filing, a requirement for an acceptable domicile address must be issued. However, the "Domicile Address" field in the electronic forms has been updated to allow a juristic applicant or registrant to provide the name, title, and domicile address of an individual with legal authority to bind the applicant or registrant when the entity itself has no fixed physical address. Therefore, if the address provided in this field is an acceptable domicile address type for an individual, the examining attorney or post-registration examiner will not issue a requirement for an acceptable domicile address.

"No fixed physical address" explanation in applications not yet approved for publication or maintenance filings not yet accepted and/or acknowledged. If an applicant or registrant provides, or has provided, a statement that it has "no fixed physical address," and the application has not been approved for publication or the maintenance filing has not been accepted and/or acknowledged, the explanation cannot be accepted and the requirement for a domicile address must be maintained and/or made final, as appropriate, in accordance with the following guidance:

*If the applicant or registrant was advised in the most recent Office action that it could provide a detailed explanation and the applicant or registrant does not respond to the domicile address requirement, the domicile address requirement **must be made final** if the application is otherwise in condition for final action. After registration, the examiner must issue a subsequent action maintaining the domicile address requirement and advising the registrant of the option to petition the Director if the maintenance filing is otherwise in condition for an action providing the petition option. If the applicant or registrant subsequently provides a "no fixed physical address" explanation in a response, the examining attorney or post-registration examiner must proceed as provided below.*

*If the applicant or registrant was advised in the most recent Office action that it could provide a detailed explanation and the applicant or registrant responds by providing a detailed explanation, the examining attorney or post-registration examiner must maintain the domicile address requirement in a **new non-final action**, explain that the detailed explanation does not satisfy the requirement, and inform the applicant or registrant of the response options in section IV.B.ii.*

*After the applicant or registrant has been advised of the updated response options, if the applicant or registrant continues to respond only by submitting arguments, the domicile address requirement **must be made final** if the application is otherwise in condition for final action. After registration, the examiner must issue a subsequent action maintaining the domicile address requirement and advising the registrant of the option to petition the Director if the maintenance filing is otherwise in condition for an action providing the petition option.*

"No fixed physical address" explanation in approved applications or accepted and/or acknowledged maintenance filings. It is not necessary to withdraw the application from publication if an application with a detailed explanation that the applicant has "no fixed physical address" was approved for publication prior to the issuance of this guidance. Similarly, it is not necessary to rescind an acceptance and/or acknowledgement of a maintenance filing with a detailed explanation that the registrant has "no fixed physical address" made prior to the issuance of this guidance. Additionally, if the application is withdrawn from publication for another reason, or the acceptance and/or acknowledgment of a maintenance filing is rescinded for another reason, examining attorneys and post-registration examiners are not required to raise a new domicile address requirement when a "no fixed physical address" explanation was previously accepted.

Companion applications not yet approved for publication or companion maintenance filings not yet accepted and/or acknowledged that contain an unacceptable domicile address, with or without an explanation, must be evaluated in accordance with this guidance and cannot be accepted merely because the same address was accepted in approved or published companion applications or accepted and/or acknowledged companion maintenance filings.

ii. Response Options for Applicants or Registrants with "No Fixed Physical Address"

An applicant or registrant who asserts it has "no fixed physical address" is limited to the following response options:

Individual applicant or registrant. An individual who has claimed not to have a permanent legal place of residence because they have "no fixed physical address" may satisfy the domicile address requirement by providing an acceptable domicile address in the "Domicile Address" field of a response form, such as when an applicant or registrant has subsequently obtained a permanent legal place of residence at a fixed physical address.

Juristic applicant or registrant. A juristic applicant or registrant that has claimed it has no fixed physical address may satisfy the domicile address requirement by providing: (1) a new acceptable domicile address such as when an applicant or registrant has subsequently obtained a fixed physical address that is the applicant's or registrant's principal place of business; or (2) the full name, title, and acceptable domicile address of a person with legal authority to bind the juristic applicant or registrant⁴ (e.g., one of the officers, if a corporation, or one of the partners, if a partnership) if the applicant or registrant does not have a fixed physical address for its principal place of business. The name, title, and domicile address may be included in the "Domicile Address" field to keep it hidden from public view. Alternatively, the applicant or registrant may provide the name, title, and address in the body of the response or the name and title in the response and the individual's address in the "Domicile Address" field. Only information in the "Domicile Address" field is masked. The examining attorney or post-registration examiner may presume that the person identified directs and controls the entity's activities if the person's title indicates they have legal authority to bind the juristic applicant or registrant.⁵

Option to file a petition to waive the domicile address requirement. Alternatively, the applicant or registrant may file a petition to the Director to waive the domicile address

⁴ See 37 C.F.R. §§2.2(o)-(p), 2.11(b), 2.189; TMEP §§611.06-06(h), 803.05.

⁵ See TMEP §§611.06-06(h).

requirement based on an extraordinary situation. However, filing a petition to waive the requirement is not considered a response to an Office action. The applicant must still file a response to avoid abandonment of the application.⁶ See Part V for more information about the petition process and requirements.

iii. Guidelines for Reviewing Responses

Name, title, and domicile address of individual with legal authority to bind the juristic entity. If a juristic applicant or registrant provides the name, title, and domicile address of an appropriate individual who has legal authority to bind the applicant or registrant, the new address must be searched, consistent with the guidance in Part III, to determine acceptability.

However, if a juristic applicant indicates the new domicile address provided is that of an individual, but does not provide a full name and/or title, or provides a title that does not clearly indicate the individual has legal authority to bind the applicant (e.g., manager for a corporate entity), the domicile address requirement must be maintained, or made final if the application is otherwise in condition for final action, as appropriate. Similarly, if a juristic registrant indicates the new domicile address provided is that of an individual, but does not provide a full name and/or title, or provides a title that does not clearly indicate the individual has legal authority to bind the registrant, the domicile address requirement must be maintained in a subsequent post-registration action providing the petition option, if the maintenance filing is otherwise in condition for an action providing the petition option.

In all cases, the examining attorney or post-registration examiner must also raise any other issues resulting from the new domicile address (e.g., if the applicant or registrant provides a foreign domicile address for the individual, then the applicant or registrant must be represented by a qualified U.S. attorney).

Protecting hidden or masked information. If an Office action is issued that questions the validity of the domicile address or the name and title of an individual named by the applicant or registrant, and the applicant or registrant provided this information in the hidden "Domicile Address" field, the examining attorney or post-registration examiner must not list the address or name in the Office action. The examining attorney or post-registration examiner may, however, reference the title if the title provided indicates the individual does not have legal authority to bind the applicant or registrant.

Evidence in the form of documentation. If a juristic applicant or registrant submits documentation such as an annual report identifying its principal office or business address as a P.O. box or RA address, such documentation does not establish that the address is the applicant's or registrant's domicile address. Certain states allow for a registered agent's address to be identified as a business address or do not verify whether the address is the applicant's or registrant's actual principal place of business. Examining attorneys and post-registration examiners must not accept such documentation as satisfying a domicile address requirement when the address is an unacceptable type of domicile address.

V. Petition to Waive the Domicile Address Requirement

An applicant or registrant may file a petition to the Director to waive the domicile address requirement of Trademark Rule 2.189 when an applicant or registrant has an extraordinary situation.⁷ A single petition may cover multiple pending trademark applications and/or registrations with pending post-registration maintenance filings.

⁶ See 37 C.F.R. §2.146(g); TMEP §1705.06.

⁷ See 37 C.F.R. §§2.146(a)(5), 2.148; TMEP §1708.

For example, if an individual applicant or registrant cannot provide their domicile address because they do not have a fixed permanent legal place of residence or a juristic entity cannot provide a domicile address because it does not have a fixed physical address for its principal place of business, the applicant or registrant may petition the Director to request a waiver of the domicile address requirement.

The petition must include a verified statement of facts explaining that the applicant or registrant does not have a fixed physical address for their permanent legal place of residence or principal place of business, as appropriate. The applicant or registrant must still provide the state, or foreign equivalent, and country of their domicile (if an individual), or the state, or foreign equivalent, and country of the domicile of a person with legal authority to bind the applicant or registrant and who directs and controls the entity's activities (if a juristic entity), to determine whether the applicant or registrant must be represented by a qualified U.S. attorney.⁸

A. Checking the Record for a Petition

Prior to issuing or maintaining a domicile address requirement, the examining attorney or post-registration examiner must check the record to ensure that a petition to the Director to waive the domicile address requirement has not been filed or granted. The petition will be uploaded into all referenced records. The examining attorney or post-registration examiner must carefully review the record for a notice of pending petitions. The final petition decision will also be uploaded to all relevant records.

If a petition to the Director to waive the domicile address requirement has been granted, a requirement for a domicile address must not subsequently issue. If a petition to the Director is pending, see Part V.B.

If an applicant or registrant asserts in a response that it has filed a petition to waive the domicile address requirement or was granted a waiver of the requirement, but a petition, Note to the File, or other notice of a pending petition does not appear in the record, the examining attorney or post-registration examiner must contact the Petitions Office to inquire whether a petition was filed or decided.

B. When an Application May Be Suspended or a Post-registration Filing May Be Held Based on a Pending Petition

Petition pending prior to issuing a first Office action. If the application appears to be otherwise in condition for publication (i.e., the domicile address is the only issue), the examining attorney must suspend the application pending a decision on the petition to waive the domicile address requirement. The examining attorney may not approve the application for publication. Permission to suspend is not required from the Petitions Office. However, the application must not be suspended if the application is not otherwise in condition for publication. In this situation, the examining attorney must issue all applicable refusals and/or requirements, including the domicile address requirement, in the first Office action.

Petition pending prior to issuing a final Office action. If a petition to the Director to waive the domicile address requirement is pending after a domicile address requirement has been issued, and the application is otherwise in condition for issuance of a final Office action, the examining attorney may suspend the application only if: (1) the applicant has

⁸ See 37 C.F.R. §2.11(b); TMEP §601.

requested suspension, and (2) the Petitions Office has provided permission to suspend.⁹ The mere filing of a petition does not constitute a response to an outstanding Office action. The applicant must file a timely response to avoid abandonment of the application.

In this situation, the examining attorney must use the "Request to Suspend Action Pending Petition Decision" to request permission to suspend action pending a decision on a petition to waive the domicile address requirement. If permission is granted, the Petitions Office staff will add a Note to the File granting permission to suspend and inform the examining attorney via email that they may issue a suspension action noting the pending petition as a reason for suspension. Once the petition decision is issued, a petitions attorney or paralegal will notify the examining attorney via email.

Holding a post-registration filing. Post-registration examiners will hold action on a post-registration filing pending a petition decision. Once the petition decision is issued, a petitions attorney or paralegal will notify the lead that a decision has issued and the post-registration examiner may proceed with appropriate action on the post-registration filing.

Petition pending after issuing a final Office action or subsequent post-registration action providing the petition option. If a petition to the Director is pending after a final domicile address requirement has been issued, and the application appears to be otherwise in condition for publication (i.e., the domicile address is the only issue), the examining attorney may suspend the application pending a decision on the petition. Similarly, if a petition to the Director is pending after a continued domicile address requirement has been issued in a post-registration filing, and the filing appears to be otherwise in condition for acceptance and/or acknowledgement, the post-registration examiner should hold the filing pending a decision on the petition. Permission to suspend is not required from the Petitions Office.

⁹ See TMEP §§716.02, 1705.06.