U. S. TRADEMARK LAW

RULES OF PRACTICE
&
FEDERAL STATUTES

U. S. PATENT & TRADEMARK OFFICE

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37 C.F.R. PART 2-RULES OF PRACTICE IN TRADEMARK CASES

AUTHORITY: 15 U.S.C. 1123, 35 U.S.C. 2, unless otherwise noted.
SOURCE: 30 FR 13193, Oct. 16, 1965, unless otherwise noted.

RULES APPLICABLE TO TRADEMARK CASES

§ 2.1 [Reserved]

§ 2.2 Definitions.

(a) *The Act* as used in this part means the Trademark Act of 1946, 60 Stat. 427, as amended, codified in 15 U.S.C. 1051 *et. seq.*

(b) *Entity* as used in this part includes both natural and juristic persons.

(c) Director as used in this chapter, except for part 10 and part 11, means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

(d) *Federal holiday within the District of Columbia* means any day, except Saturdays and Sundays, when the United States Patent and Trademark Office is officially closed for business for the entire day.

(e) The term *Office* means the United States Patent and Trademark Office.

(f) The acronym *TEAS* means the Trademark Electronic Application System, available online at http://www.uspto.gov.

(g) The acronym *ESTTA* means the Electronic System for Trademark Trials and Appeals, available at http://www.uspto.gov/.

(h) The term *international application* means an application for international registration that is filed under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.

[54 FR 37588, Sept. 11, 1989; 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 2.6 Trademark fees.

The Patent and Trademark Office requires following fees and charges:

(a) Trademark process fees.

(1) Application filing fees.
(i) For filing an application on paper, per class—$375.00
(ii) For filing an application through TEAS, per class—$325.00
(iii) For filing a TEAS Plus application under § 2.22, per class—$275.00
(iv) Additional processing fee under §§ 2.22(b) and 2.23(b), per class—$50.00
(2) For filing an amendment to allege use under section 1(c) of the Act, per class—$100.00
(3) For filing a statement of use under section 1(d)(1) of the Act, per class—$100.00
(4) For filing a request under section 1(d)(2) of the Act for a six-month extension of time for filing a statement of use under section 1(d)(1) of the Act, per class—$150.00
(5) For filing an application for renewal of a registration, per class—$400.00
(6) Additional fee for filing a renewal application during the grace period, per class—$100.00

(7) For filing to publish a mark under section 12(c), per class—$100.00
(8) For issuing a new certificate of registration upon request of registrant—$100.00
(9) For a certificate of correction of registrant's error—$100.00
(10) For filing a disclaimer to a registration—$100.00
(11) For filing an amendment to a registration—$100.00
(12) For filing an affidavit under section 8 of the Act, per class—$100.00
(13) For filing an affidavit under section 15 of the Act, per class—$200.00
(14) Additional fee for filing a section 8 affidavit during the grace period, per class—$100.00
(15) For petitions to the Director—$100.00
(16) For filing a petition to cancel, per class—$300.00
(17) For filing a notice of opposition, per class—$300.00
(18) For ex parte appeal to the Trademark Trial and Appeal Board, per class—$100.00
(19) Dividing an application, per new application created—$100.00
(20) For correcting a deficiency in a section 8 affidavit—$100.00
(21) For correcting a deficiency in a renewal application—$100.00

(b) Trademark service fees.

(1) For printed copy of registered mark, copy only. Service includes preparation of copies by the Office within two to three business days and delivery by United States Postal Service; and preparation of copies by the Office within one business day of receipt and delivery to an Office Box or by electronic means (e.g., facsimile, electronic mail)—$3.00
(2) Certified or uncertified copy of trademark application as filed processed within seven calendar days—$15.00
(3) Certified or uncertified copy of a trademark-related official record—$50.00
(4) Certified copy of a registered mark, showing title and/or status:
(i) Regular service—$15.00
(ii) Expedited local service—$30.00
(5) Certified or uncertified copy of trademark records, per document except as otherwise provided in this section—$25.00
(6) For recording each trademark assignment, agreement or other document relating to the property in a registration or application
(i) First property in a document—$40.00
(ii) For each additional property in the same document—$25.00
(7) For assignment records, abstract of title and certification, per registration—$25.00
(8) Marginal cost, paid in advance, for each hour of terminal session time, including print time, using X-Search capabilities, prorated for the actual time used. The Director may waive the payment by an individual for access to X-Search upon a showing of need or hardship, and if such waiver is in the public interest—$40.00
(9) Self-service copy charge, per page—$0.25
(10) Labor charges for services, per hour or fraction thereof—$40.00
(11) For items and services that the Director finds may be supplied, for which fees are not specified by statute or by this part, such charges as may be determined by the Director with respect to each such item or service—Actual Cost
(12) For processing each payment refused (including a check returned "unpaid") or charged back by a financial institution—$50.00
(13) Deposit accounts:
(i) For establishing a deposit account—$10.00
(ii) Service charge for each month when the balance at the end of the month is below $1,000—$25.00

[56 FR 65155, Dec. 13, 1991; 56 FR 66670, Dec. 24, 1991, as amended at 57 FR 38196, Aug. 21, 1992; 59 FR 256, Jan. 4, 1994;60 FR 41018, Aug. 11, 1995; 62 FR 40450, July 29, 1997; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 64 FR 67486, Dec. 2, 1999; 64 FR 67774, Dec. 10, 1999; 67 FR 79520, Dec.

30, 2002; 67 FR 70847, November 27, 2002, effective January 1, 2003; 68 FR 14332, March 25, 2003, effective May 1, 2003; 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003; 70 FR 2952, Jan. 19, 2005, effective Jan. 31, 2005; 70 FR 38768, July 6, 2005, effective July 18, 2005; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.7 Fastener Recordal Fees.

(a) Application fee for recordal of insignia—$20.00
(b) Renewal of insignia recordal—$20.00
(c) Surcharge for late renewal of insignia recordal—$20.00

[61 FR 55223, Oct. 25, 1996]

REPRESENTATION BY ATTORNEYS OR OTHER AUTHORIZED PERSONS

§ 2.11 Applicants may be represented by an attorney.

Representation before the Office is governed by § 11.14 of this chapter. The Office cannot aid in the selection of an attorney.

[50 FR 5171, Feb. 6, 1985; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 2.17 Recognition for representation.

(a) *Authority to practice in trademark cases*. Only an individual qualified to practice under § 11.14 of this chapter may represent an applicant, registrant, or party to a proceeding before the Office in a trademark case.

(b)(1) *Recognition of practitioner as representative*. To be recognized as a representative in a trademark case, a practitioner qualified under § 11.14 of this chapter may:

(i) File a power of attorney that meets the requirements of paragraph (c) of this section;

(ii) Sign a document on behalf of an applicant, registrant, or party to a proceeding who is not already represented by a practitioner qualified under § 11.14 of this chapter from a different firm; or

(iii) Appear in person on behalf of an applicant, registrant, or party to a proceeding who is not already represented by a practitioner qualified under § 11.14 of this chapter from a different firm.

(2) *Signature as certificate of authorization to represent*. When a practitioner qualified under § 11.14 of this chapter appears in person or signs a document pursuant to paragraph (b) of this section, his or her personal appearance or signature shall constitute a representation to the Office that he or she is authorized to represent the person or entity on whose behalf he or she acts. The Office may require further proof of authority to act in a representative capacity.

(c) *Requirements for power of attorney*. A power of attorney must:

(1) Designate by name at least one practitioner meeting the requirements of § 11.14 of this chapter; and

(2) Be signed by the individual applicant, registrant, or party to a proceeding pending before the Office, or by someone with legal authority to bind the applicant, registrant, or party (*e.g.,* a corporate officer or general partner of a partnership). In the case of joint applicants or joint registrants, all must sign. Once the applicant, registrant, or party has designated a practitioner(s) qualified to practice under § 11.14 of this chapter, that practitioner may sign an associate power of attorney appointing another qualified practitioner(s) as an additional person(s) authorized to represent the applicant, registrant, or party. If the applicant, registrant, or party revokes the original power of attorney (§ 2.19(a)), the revocation discharges any associate power signed by

the practitioner whose power has been revoked. If the practitioner who signed an associate power withdraws (§ 2.19(b)), the withdrawal discharges any associate power signed by the withdrawing practitioner upon acceptance of the request for withdrawal by the Office.

(d) *Power of attorney relating to multiple applications or registrations*. (1) The owner of an application or registration may appoint a practitioner(s) qualified to practice under § 11.14 of this chapter for up to twenty applications or registrations that have the identical owner name and attorney through TEAS.

(2) The owner of an application or registration may file a power of attorney that relates to more than one trademark application or registration, or to all existing and future applications and registrations of that owner, on paper. A person relying on such a power of attorney must:

(i) Include a copy of the previously filed power of attorney; or

(ii) Refer to the power of attorney, specifying the filing date of the previously filed power of attorney; the application serial number (if known), registration number, or inter partes proceeding number for which the original power of attorney was filed; and the name of the person who signed the power of attorney; or, if the application serial number is not known, submit a copy of the application or a copy of the mark, and specify the filing date.

(e) *Canadian attorneys and agents*. (1) A Canadian patent agent who is registered and in good standing as a patent agent under § 11.6(c) may represent parties located in Canada before the Office in trademark matters.

(2) A Canadian attorney or agent who is registered or in good standing with the Canadian Intellectual Property Office, but not registered as a patent agent under § 11.6(c), may represent parties located in Canada if he or she has been authorized to do so by the Director of the Office of Enrollment and Discipline, pursuant to § 11.14(f) of this chapter.

(f) *Non-lawyers*. A non-lawyer may not act as a representative except in the limited circumstances set forth in § 11.14(b) of this chapter. Before any non-lawyer who meets the requirements of § 11.14(b) of this chapter may take action of any kind with respect to an application, registration or proceeding, a written authorization must be filed, signed by the applicant, registrant, or party to the proceeding, or by someone with legal authority to bind the applicant, registrant, or party (*e.g.,* a corporate officer or general partner of a partnership).

(g) *Duration of power of attorney*. (1) For purposes of recognition as a representative, the Office considers a power of attorney filed while an application is pending to end when the mark registers, when ownership changes, or when the application is abandoned.

(2) The Office considers a power of attorney filed after registration to end when the mark is cancelled or expired, or when ownership changes. If the power was filed in connection with an affidavit under section 8, 12(c), 15 or 71 of the Trademark Act, renewal application under section 9 of the Act, or request for amendment or correction under section 7 of the Act, the power is deemed to end upon acceptance or final rejection of the filing.

[30 FR 13193, Oct. 16, 1965, as amended at 50 FR 5171, Feb. 6, 1985; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008; 74 FR 54898, Oct. 26, 2009, effective Dec. 28, 2009]

§ 2.18 Correspondence, with whom held.

(a) *Establishing the correspondence address*. (1) If a written power of attorney that meets the requirements of § 2.17 is filed, the Office will send correspondence to the practitioner designated in the power.

(2) If a practitioner qualified under § 11.14 of this chapter transmits a document(s) on behalf of an applicant, registrant, or party to a proceeding who is not already represented by another qualified practitioner from a different firm, the Office will send correspondence to the practitioner transmitting the documents.

(3) If an application, registration or proceeding is not being prosecuted by a practitioner qualified under § 11.14 of this chapter and the applicant, registrant, or party to the proceeding

designates a correspondence address in writing, the Office will send correspondence to the designated address if appropriate.

(4) If an application, registration or proceeding is not being prosecuted by a practitioner qualified under § 11.14 of this chapter and the applicant, registrant, or party to the proceeding has not designated a correspondence address in writing, but a domestic representative has been appointed, the Office will send correspondence to the domestic representative if appropriate.

(5) If the application, registration or proceeding is not being prosecuted by a practitioner qualified under § 11.14 of this chapter, the applicant, registrant, or party to the proceeding has not designated a correspondence address, and no domestic representative has been appointed, the Office will send correspondence directly to the applicant, registrant, or party to the proceeding.

(6) The Office will send correspondence to only one address in an ex parte matter.

(7) Once the Office has recognized a practitioner qualified under § 11.14 of this chapter as the representative of an applicant or registrant, the Office will communicate and conduct business only with that practitioner, or with another qualified practitioner from the same firm. The Office will not conduct business directly with the applicant or registrant, or with another practitioner from a different firm, unless the applicant or registrant files a revocation of the power of attorney under § 2.19(a), and/or a new power of attorney that meets the requirements of § 2.17(c). A written request to change the correspondence address does not revoke a power of attorney.

(b) *Changing the correspondence address*. (1) If a physical or e-mail correspondence address changes, the applicant, registrant, or party to a proceeding must file a written request to change the correspondence address. The request should be promptly filed.

(2) A request to change the correspondence address must be made in writing, signed by the applicant, registrant, or party to a proceeding, someone with legal authority to bind the applicant, registrant, or party (*e.g.,* a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with § 2.193(e)(9).

(3) If an applicant or registrant files a new power of attorney that meets the requirements of § 2.17(c), the Office will change the correspondence address to that of the practitioner named in the power.

(4) If a practitioner qualified under § 11.14 of this chapter transmits a document(s) on behalf of an applicant, registrant, or party to a proceeding who is not already represented by another qualified practitioner, the Office will construe this as including a request to change the correspondence address to that of the practitioner, and will send correspondence to the practitioner.

(c) *Post registration filings under sections 7, 8, 9, 12(c), 15, and 71*. (1) Even if there is no new power of attorney or written request to change the correspondence address, the Office will change the correspondence address upon the examination of an affidavit under section 8, 12(c), 15 or 71 of the Trademark Act, renewal application under section 9 of the Act, or request for amendment or correction under section 7 of the Act. If a practitioner qualified under § 11.14 of this chapter transmits the affidavit, renewal application, or section 7 request, the Office will send correspondence to the practitioner. If the owner of the registration is not represented by a qualified practitioner, the Office will send correspondence directly to the owner, or to the domestic representative if appropriate, in accordance with paragraph (a).

(2) Once the Office establishes a correspondence address upon examination of an affidavit, renewal application, or section 7 request, a written request to change the address in accordance with the requirements of paragraph (b)(2) of this section is required to change the address during the pendency of that filing.

[41 FR 758, Jan. 5 1976, as amended at 54 FR 37588, Sept. 11, 1989; 67 FR 79520, Dec. 30, 2002; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008; 74 FR 54898, Oct. 26, 2009, effective Dec. 28, 2009]

§ 2.19 Revocation or withdrawal of attorney.

(a) *Revocation*. (1) Authority to represent an applicant, registrant or party to a proceeding before the Office may be revoked at any stage in the proceedings of a trademark case, upon written notification signed by the applicant, registrant, or party to the proceeding, or by someone with legal authority to bind the applicant, registrant, or party (*e.g.,* a corporate officer or general partner of a partnership). In the case of joint applicants or joint registrants, all must sign.

(2) When a power of attorney is revoked, the Office will communicate directly with the applicant, registrant, or party to the proceeding, or with the new attorney or domestic representative if appropriate.

(3) A request to change the correspondence address does not revoke a power of attorney.

(4) A new power of attorney that meets the requirements of § 2.17(c) will be treated as a revocation of the previous power.

(b) *Withdrawal of attorney*. If the requirements of § 10.40 of this chapter are met, a practitioner authorized to represent an applicant, registrant, or party to a proceeding in a trademark case may withdraw upon application to and approval by the Director or, when applicable, upon motion granted by the Trademark Trial and Appeal Board. The practitioner should file the request to withdraw soon after the practitioner notifies the client of his/her intent to withdraw. The request must include the following:

(1) The application serial number, registration number, or proceeding number;

(2) A statement of the reason(s) for the request to withdraw; and

(3) Either

(i) A statement that the practitioner has given notice to the client that the practitioner is withdrawing from employment and will be filing the necessary documents with the Office; that the client was given notice of the withdrawal at least two months before the expiration of the response period, if applicable; that the practitioner has delivered to the client all documents and property in the practitioner's file concerning the application, registration or proceeding to which the client is entitled; and that the practitioner has notified the client of any responses that may be due, and of the deadline for response; or

(ii) If more than one qualified practitioner is of record, a statement that representation by co-counsel is ongoing.

[50 FR 5171, Feb. 6, 1985; 68 FR 14332, March 25, 2003, effective May 1, 2003; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008; 74 FR 54898, Oct. 26, 2009, effective Dec. 28, 2009]

DECLARATIONS

§ 2.20 Declarations in lieu of oaths.

Instead of an oath, affidavit, verification, or sworn statement, the language of 28 U.S.C. 1746, or the following language, may be used:

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

[31 FR 5261, Apr. 1, 1966; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999]

APPLICATION FOR REGISTRATION

§ 2.21 Requirements for receiving a filing date.

(a) The Office will grant a filing date to an application under section 1 or section 44 of the Act that is in the English language and contains all of the following:

(1) The name of the applicant;

(2) A name and address for correspondence;

(3) A clear drawing of the mark;

(4) A listing of the goods or services; and

(5) The filing fee for at least one class of goods or services, required by § 2.6.

(b) If the applicant does not submit all the elements required in paragraph (a) of this section, the Office will deny a filing date and issue a notice explaining why the filing date was denied.

[47 FR 38695, Sept. 2, 1982, as amended at 51 FR 29921, Aug. 21 1986; 54 FR 37588, Sept. 11, 1989; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.22 Filing requirements for a TEAS Plus application.

(a) A trademark/service mark application for registration on the Principal Register under section 1 and/or section 44 of the Act will be entitled to a reduced filing fee under § 2.6(a)(1)(iii) if it is filed through TEAS and includes:

(1) The applicant's name and address;

(2) The applicant's legal entity;

(3) The citizenship of an individual applicant, or the state or country of incorporation or organization of a juristic applicant;

(4) If the applicant is a partnership, the names and citizenship of the applicant's general partners;

(5) A name and address for correspondence;

(6) An e-mail address for correspondence, and an authorization for the Office to send correspondence concerning the application to the applicant or applicant's attorney by e-mail;

(7) One or more bases for filing that satisfy all the requirements of § 2.34. If more than one basis is set forth, the applicant must comply with the requirements of § 2.34 for each asserted basis;

(8) Correctly classified goods and/or services, with an identification of goods and/or services from the Office's *Acceptable Identification of Goods and Services Manual,* available through the TEAS Plus form and at http://www.uspto.gov. In an application based on section 44 of the Act, the scope of the goods and/or services covered by the section 44 basis may not exceed the scope of the goods and/or services in the foreign application or registration;

(9) If the application contains goods and/or services in more than one class, compliance with § 2.86;

(10) A filing fee for each class of goods and/or services, as required by § 2.6(a)(1)(iii);

(11) A verified statement that meets the requirements of § 2.33, dated and signed by a person properly authorized to sign on behalf of the owner pursuant to § 2.193(e)(1);

(12) A clear drawing of the mark. If the applicant does not claim standard characters, the applicant must attach a digitized image of the mark in .jpg format. If the mark includes color, the drawing must show the mark in color;

(13) If the mark is in standard characters, a mark comprised of only characters in the Office's standard character set, currently available at http://www.uspto.gov, typed in the appropriate field of the TEAS Plus form;

(14) If the mark includes color, a statement naming the color(s) and describing where the color(s) appears on the mark, and a claim that the color(s) is a feature of the mark;

(15) If the mark is not in standard characters, a description of the mark;

(16) If the mark includes non-English wording, an English translation of that wording;

(17) If the mark includes non-Latin characters, a transliteration of those characters;

(18) If the mark includes an individual's name or portrait, either (i) a statement that identifies the living individual whose name or likeness the mark comprises and written consent of the individual, or (ii) a statement that the name or portrait does not identify a living individual (*see* section 2(c) of the Act);

(19) If the applicant owns one or more registrations for the same mark, a claim of ownership of the registration(s) identified by the registration number(s), pursuant to § 2.36; and

(20) If the application is a concurrent use application, compliance with § 2.42.

(b) If an application does not meet the requirements of paragraph (a) of this section at the time of filing, the applicant must pay the fee required by § 2.6(a)(1)(iv). The application will retain its original filing date, provided that when filed, the application met the filing date requirements of § 2.21.

(c) The following types of applications cannot be filed as TEAS Plus applications under paragraph (a) of this section:

(1) Applications for certification marks (*see* § 2.45);

(2) Applications for collective marks (*see* § 2.44);

(3) Applications for collective membership marks (*see* § 2.44); and

(4) Applications for registration on the Supplemental Register (*see* § 2.47).

[Added 70 FR 38768, July 6, 2005, effective July 18, 2005; amended 74 FR 54898, Oct. 26, 2009, effective Dec. 28, 2009]

§ 2.23 Additional requirements for TEAS Plus application.

(a) In addition to the filing requirements under § 2.22(a), the applicant must:

(1) File the following communications through TEAS:

(i) Responses to Office actions (except notices of appeal under section 20 of the Trademark Act);

(ii) Requests to change the correspondence address and owner's address;

(iii) Appointment and/or revocation of power of attorney;

(iv) Appointment and/or revocation of domestic representative;

(v) Preliminary amendments;

(vi) Amendments to allege use under section 1(c) of the Act or statements of use under section 1(d) of the Act;

(vii) Request(s) for extensions of time to file a statement of use under section 1(d) of the Act; and

(viii) Request(s) to delete a section 1(b) basis.

(2) Maintain a valid e-mail correspondence address, and continue to receive communications from the Office by electronic mail.

(b) If an application does not meet the requirements of paragraph (a) of this section, the applicant must pay the fee required by § 2.6(a)(1)(iv).

[Added 70 FR 38768, July 6, 2005, effective July 18, 2005; amended 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.24 Designation and revocation of domestic representative by foreign applicant.

(a)(1) If an applicant is not domiciled in the United States, the applicant may designate a domestic representative (*i.e.,* a person residing in the United States on whom notices or process in proceedings affecting the mark may be served) by either:

(i) Setting forth the name and address of the domestic representative in the initial application; or

(ii) Filing a separate designation setting forth the name and address of the domestic representative, signed by the applicant, someone with legal authority to bind the applicant (*e.g.,* a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter.

(2) If the applicant does not file a document designating the name and address of a person residing in the United States on whom notices or process in proceedings affecting the mark may be served, or if the last person designated cannot be found at the address given in the designation, then notices or process in proceedings affecting the mark may be served on the Director.

(3) The mere designation of a domestic representative does not authorize the person designated to represent the applicant unless qualified under § 11.14 of this chapter.

(b) A request to change or revoke a designation of domestic representative must be signed by the applicant, someone with legal authority to bind the applicant (*e.g.,* a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37588 Sept. 11, 1989; 67 FR 79520, Dec. 30, 2002; 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008; 74 FR 54898, Oct. 26, 2009, effective Dec. 28, 2009]

§ 2.25 Documents not returnable.

Except as provided in § 2.27(e), documents filed in the Office by the applicant or registrant become part of the official record and will not be returned or removed.

[Amended 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.26 [Removed]

[Removed 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.27 Pending trademark application index; access to applications.

(a) An index of pending applications including the name and address of the applicant, a reproduction or description of the mark, the goods or services with which the mark is used, the class number, the dates of use, and the serial number and filing date of the application will be available for public inspection as soon as practicable after filing.

(b) Except as provided in paragraph (e) of this section, access to the file of a particular pending application will be permitted prior to publication under § 2.80 upon written request.

(c) Decisions of the Director and the Trademark Trial and Appeal Board in applications and proceedings relating thereto are published or available for inspection or publication.

(d) Except as provided in paragraph (e) of this section, the official records of applications and all proceedings relating thereto are available for public inspection and copies of the documents may be furnished upon payment of the fee required by § 2.6.

(e) Anything ordered to be filed under seal pursuant to a protective order issued or made by any court or by the Trademark Trial and Appeal Board in any proceeding involving an application or registration shall be kept confidential and shall not be made available for public inspection or copying unless otherwise ordered by the court or the Board, or unless the party protected by the order voluntarily discloses the matter subject thereto. When possible, only confidential portions of filings with the Board shall be filed under seal.

[36 FR 25406, Dec. 31, 1971, as amended at 48 FR 23134, May 23, 1983; 48 FR 27225, June 14, 1983; 68 FR 14332, March 25, 2003, effective May 1, 2003; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.32 Requirements for a complete application.

(a) The application must be in English and include the following:

(1) A request for registration;

(2) The name of the applicant(s);

(3)(i) The citizenship of the applicant(s); or

(ii) If the applicant is a corporation, association, partnership or other juristic person, the jurisdiction (usually state or nation) under the laws of which the applicant is organized; and

(iii) If the applicant is a domestic partnership, the names and citizenship of the general partners;

(iv) If the applicant is a domestic joint venture, the names and citizenship of the active members of the joint venture;

(4) The address of the applicant;

(5) One or more bases, as required by § 2.34(a);

(6) A list of the particular goods or services on or in connection with which the applicant uses or intends to use the mark. In a United States application filed under section 44 of the Act, the scope of the goods and/or services covered by the section 44 basis may not exceed the scope of the goods and/or services in the foreign application or registration;

(7) The international class of goods or services, if known. See § 6.1 of this chapter for a list of the international classes of goods and services;

(8) If the mark is not in standard characters, a description of the mark;

(9) If the mark includes non-English wording, an English translation of that wording; and

(10) If the mark includes non-Latin characters, a transliteration of those characters, and either a translation of the transliterated term in English, or a statement that the transliterated term has no meaning in English.

(b) The application must include a verified statement that meets the requirements of § 2.33.

(c) The application must include a drawing that meets the requirements of §§ 2.51 and 2.52.

(d) The application must include fee required by § 2.6 for each class of goods or services.

(e) For the requirements for a multiple class application, see § 2.86.

[64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; amended 73 FR 13780, March 14, 2008, effective May 13, 2008; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.33 Verified statement.

(a) The application must include a statement that is signed in accordance with the requirements of § 2.193 and verified (sworn to) or supported by a declaration under § 2.20 by a person properly authorized to sign on behalf of the applicant under § 2.193(e)(1).

(b)(1) In an application under section 1(a) of the Act, the verified statement must allege:

That the applicant believes it is the owner of the mark; that the mark is in use in commerce; that to the best of the declarant's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when applied to the goods or services of the other person, to cause confusion or mistake, or to deceive; that the specimen shows the mark as used on or in connection with the goods or services; and that the facts set forth in the application are true.

(2) In an application under section 1(b) or section 44 of the Act, the verified statement must allege:

That the applicant has a bona fide intention to use the mark shown in the accompanying drawing in commerce on or in connection with the specified goods or services; that the applicant

believes it is entitled to use the mark in commerce; that to the best of the declarant's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when applied to the goods or services of the other person, to cause confusion or mistake, or to deceive; and that the facts set forth in the application are true.

(c) If the verified statement is not filed within a reasonable time after it is signed, the Office may require the applicant to submit a substitute verification or declaration under § 2.20 of the applicant's continued use or bona fide intention to use the mark in commerce.

(d) [Reserved]

(e) In an application under section 66(a) of the Act, the verified statement is part of the international registration on file at the International Bureau. The verified statement must allege that:

(1) the applicant/holder has a bona fide intention to use the mark in commerce that the United States Congress can regulate on or in connection with the goods/services identified in the international application/subsequent designation;

(2) the signatory is properly authorized to execute this declaration on behalf of the applicant/holder;

(3) the signatory believes the applicant/holder to be entitled to use the mark in commerce that the United States Congress can regulate on or in connection with the goods/services identified in the international application/registration; and

(4) to the best of his/her knowledge and belief, no other person, firm, corporation, association, or other legal entity has the right to use the mark in commerce that the United States Congress can regulate, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, firm, corporation, association, or other legal entity, to cause confusion, or to cause mistake, or to deceive.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37589, Sept. 11, 1989; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 67 FR 79520, Dec. 30, 2002; 68 FR 14332, March 25, 2003, effective May 1, 2003; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009; 74 FR 54898, Oct. 26, 2009, effective Dec. 28, 2009]

§ 2.34 Bases for filing.

(a) The application must include one or more of the following five filing bases:

(1) *Use in commerce under section 1(a) of the Act*. The requirements for an application based on section 1(a) of the Act are:

(i) The trademark owner's verified statement that the mark is in use in commerce on or in connection with the goods or services listed in the application. If the verification is not filed with the initial application, the verified statement must also allege that the mark was in use in commerce on or in connection with the goods or services listed in the application as of the application filing date;

(ii) The date of the applicant's first use of the mark anywhere on or in connection with the goods or services;

(iii) The date of the applicant's first use of the mark in commerce as a trademark or service mark; and

(iv) One specimen showing how the applicant actually uses the mark in commerce.

(v) If more than one item of goods or services is specified in the application, the dates of use required in paragraphs (ii) and (iii) of this section need be for only one of the items specified in each class, provided that the particular item to which the dates apply is designated.

(2) *Intent-to-use under section 1(b) of the Act.* In an application under section 1(b) of the Act, the applicant must verify that it has a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application. If the verification is not filed with

the initial application, the verified statement must also allege that the applicant had a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application as of the filing date of the application.

(3) Registration of a mark in a foreign applicant's country of origin under section 44(e) of the Act. The requirements for an application under section 44(e) of the Act are:

(i) The applicant's verified statement that it has a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application. If the verification is not filed with the initial application, the verified statement must also allege that the applicant had a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application as of the filing date of the application.

(ii) A true copy, a photocopy, a certification, or a certified copy of a registration in the applicant's country of origin showing that the mark has been registered in that country, and that the registration is in full force and effect. The certification or copy of the foreign registration must show the name of the owner, the mark, and the goods or services for which the mark is registered. If the foreign registration is not in the English language, the applicant must submit a translation.

(iii) If the record indicates that the foreign registration will expire before the United States registration will issue, the applicant must submit a true copy, a photocopy, a certification, or a certified copy from the country of origin to establish that the foreign registration has been renewed and will be in force at the time the United States registration will issue. If the foreign registration is not in the English language, the applicant must submit a translation.

(4) Claim of priority, based upon an earlier-filed foreign application, under section 44(d) of the Act. The requirements for an application under section 44(d) of the Act are:

(i) A claim of priority, filed within six months of the filing date of the foreign application. Before publication or registration on the Supplemental Register, the applicant must either:

(A) Specify the filing date, serial number and country of the first regularly filed foreign application; or

(B) State that the application is based upon a subsequent regularly filed application in the same foreign country, and that any prior-filed application has been withdrawn, abandoned or otherwise disposed of, without having been laid open to public inspection and without having any rights outstanding, and has not served as a basis for claiming a right of priority.

(ii) Include the applicant's verified statement that it has a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application. If the verification is not filed with the initial application, the verified statement must also allege that the applicant had a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application as of the filing date of the application.

(iii) Before the application can be approved for publication, or for registration on the Supplemental Register, the applicant must establish a basis under section 1(a), section 1(b) or section 44(e) of the Act.

(5) *Extension of protection of an international registration under section 66(a) of the Act*. In an application under section 66(a) of the Act, the international application or subsequent designation requesting an extension of protection to the United States must contain a signed declaration that meets the requirements of § 2.33.

(b)(1) In an application under section 1 or section 44 of the Act, an applicant may claim more than one basis, provided the applicant satisfies all requirements for the bases claimed. However, the applicant may not claim both sections 1(a) and 1(b) for the identical goods or services in the same application.

(2) In an application under section 1 or section 44 of the Act, if an applicant claims more than one basis, the applicant must list each basis, followed by the goods or services to which that basis applies. If some or all of the goods or services are covered by more than one basis, this must be stated.

(3) A basis under section 66(a) of the Act cannot be combined with any other basis.

[64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 67 FR 79520, Dec. 30, 2002; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.35 Adding, deleting, or substituting bases.

(a) In an application under section 66(a) of the Act, an applicant may not add, substitute or delete a basis, unless the applicant meets the requirements for transformation under section 70(c) of the Act and § 7.31 of this chapter.

(b) In an application under section 1 or section 44 of the Act:

(1) Before publication for opposition, an applicant may add or substitute a basis, if the applicant meets all requirements for the new basis, as stated in § 2.34. The applicant may delete a basis at any time.

(2) After publication, an applicant may add or substitute a basis in an application that is not the subject of an *inter partes* proceeding before the Trademark Trial and Appeal Board, but only with the express permission of the Director, after consideration on petition. Republication will be required. The amendment of an application that is the subject of an *inter partes* proceeding before the Board is governed by § 2.133(a).

(3) When an applicant substitutes one basis for another, the Office will presume that there was a continuing valid basis, unless there is contradictory evidence in the record, and the application will retain the original filing date, including a priority filing date under section 44(d), if appropriate.

(4) If an applicant properly claims a section 44(d) basis in addition to another basis, the applicant will retain the priority filing date under section 44(d) no matter which basis the applicant perfects.

(5) The applicant may add or substitute a section 44(d) basis only within the six-month priority period following the filing date of the foreign application.

(6) When the applicant adds or substitutes a basis, the applicant must list each basis, followed by the goods or services to which that basis applies.

(7) When the applicant deletes a basis, the applicant must also delete any goods or services covered solely by the deleted basis.

(8) Once an applicant claims a section 1(b) basis as to any or all of the goods or services, the applicant may not amend the application to seek registration under section 1(a) of the Act for those goods or services unless the applicant files an allegation of use under section 1(c) or section 1(d) of the Act.

[64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 68 FR 14332, March 25, 2003, effective May 1, 2003; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003]

§ 2.36 Identification of prior registrations.

Prior registrations of the same or similar marks owned by the applicant should be identified in the application.

§ 2.37 Description of mark.

A description of the mark must be included if the mark is not in standard characters. In an application where the mark is in standard characters, a description may be included and must be included if required by the trademark examining attorney.

[30 FR 13193, Oct. 16, 1965; Redesignated at 64 FR 48920, Sept. 8, 1999; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 73 FR 13780, March 14, 2008, effective May 13, 2008]

§ 2.38 Use by predecessor or by related companies.

(a) If the first use of the mark was by a predecessor in title or by a related company (sections 5 and 45 of the Act), and the use inures to the benefit of the applicant, the dates of first use (§§ 2.34(a)(1)(ii) and (iii)) may be asserted with a statement that first use was by the predecessor in title or by the related company, as appropriate.

(b) If the mark is not in fact being used by the applicant but is being used by one or more related companies whose use inures to the benefit of the applicant under section 5 of the Act, such facts must be indicated in the application.

(c) The Office may require such details concerning the nature of the relationship and such proofs as may be necessary and appropriate for the purpose of showing that the use by related companies inures to the benefit of the applicant and does not affect the validity of the mark.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37589, Sept. 11, 1989; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999]

§ 2.41 Proof of distinctiveness under section 2(f).

(a) When registration is sought of a mark which would be unregistrable by reason of section 2(e) of the Act but which is said by applicant to have become distinctive in commerce of the goods or services set forth in the application, applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, affidavits, or declarations in accordance with § 2.20, depositions, or other appropriate evidence showing duration, extent and nature of use in commerce and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and affidavits, or declarations in accordance with § 2.20, letters or statements from the trade or public, or both, or other appropriate evidence tending to show that the mark distinguishes such goods or services.

(b) In appropriate cases, ownership of one or more prior registrations on the Principal Register or under the Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness. Also, if the mark is said to have become distinctive of applicant's goods by reason of substantially exclusive and continuous use in commerce thereof by applicant for the five years before the date on which the claim of distinctiveness is made, a showing by way of statements which are verified or which include declarations in accordance with § 2.20, in the application may, in appropriate cases, be accepted as prima facie evidence of distinctiveness. In each of these situations, however, further evidence may be required.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37590, Sept. 11, 1989; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.42 Concurrent use.

An application for registration as a lawful concurrent user shall specify and contain all the elements required by the preceding sections. The applicant in addition shall state in the application the area, the goods, and the mode of use for which applicant seeks registration; and also shall state, to the extent of the applicant's knowledge, the concurrent lawful use of the mark by others, setting forth their names and addresses; registrations issued to or applications filed by such others, if any; the areas of such use; the goods on or in connection with which such use is made; the mode of such use; and the periods of such use.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 34897, Aug. 22, 1989]

§ 2.43 Service mark.

In an application to register a service mark, the application shall specify and contain all the elements required by the preceding sections for trademarks, but shall be modified to relate to services instead of to goods wherever necessary.

§ 2.44 Collective mark.

(a) In an application to register a collective mark under section 1(a) of the Act, the application shall specify and contain all applicable elements required by the preceding sections for trademarks, but shall, in addition, specify the class of persons entitled to use the mark, indicating their relationship to the applicant, and the nature of the applicant's control over the use of the mark.

(b) In an application to register a collective mark under section 1(b), section 44 or section 66(a) of the Act, the application shall specify and contain all applicable elements required by the preceding sections for trademarks, but shall also specify the class of persons intended to be entitled to use the mark, indicating what their relationship to the applicant will be, and the nature of the control applicant intends to exercise over the use of the mark.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37590, Sept. 11, 1989; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.45 Certification mark.

(a) In an application to register a certification mark under section 1(a) of the Act, the application shall include all applicable elements required by the preceding sections for trademarks. In addition, the application must: specify the conditions under which the certification mark is used; allege that the applicant exercises legitimate control over the use of the mark; allege that the applicant is not engaged in the production or marketing of the goods or services to which the mark is applied; and include a copy of the standards that determine whether others may use the certification mark on their goods and/or in connection with their services.

(b) In an application to register a certification mark under section 1(b), section 44 or section 66(a) of the Act, the application shall include all applicable elements required by the preceding sections for trademarks. In addition, the application must: specify the conditions under which the certification mark is intended to be used; allege that the applicant intends to exercise legitimate control over the use of the mark; and allege that the applicant will not engage in the production or marketing of the goods or services to which the mark is applied. When the applicant files an allegation of use under § 2.76 or § 2.88, the applicant must submit a copy of the standards that determine whether others may use the certification mark on their goods and/or in connection with their services.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37590, Sept. 11, 1989; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.46 Principal Register.

All applications will be treated as seeking registration on the Principal Register unless otherwise stated in the application. Service marks, collective marks, and certification marks, registrable in accordance with the applicable provisions of section 2 of the Act, are registered on the Principal Register.

§ 2.47 Supplemental Register.

(a) In an application to register on the Supplemental Register under section 23 of the Act, the application shall so indicate and shall specify that the mark has been in use in commerce.

(b) In an application to register on the Supplemental Register under section 44 of the Act, the application shall so indicate. The statement of lawful use in commerce may be omitted.

(c) An application under section 66(a) of the Act is not eligible for registration on the Supplemental Register.

(d) A mark in an application to register on the Principal Register under section 1(b) of the Act is eligible for registration on the Supplemental Register only after an acceptable amendment to allege use under § 2.76 or statement of use under § 2.88 has been timely filed.

(e) An application for registration on the Supplemental Register must conform to the requirements for registration on the Principal Register under section 1(a) of the Act, so far as applicable.

[38 FR 18876, July 16, 1973, as amended at 54 FR 37590, Sept. 11, 1989; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.48 Office does not issue duplicate registrations.

If two applications on the same register would result in registrations that are exact duplicates, the Office will permit only one application to mature into registration, and will refuse registration in the other application.

[Added 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

DRAWING

§ 2.51 Drawing required.

(a) In an application under section 1(a) of the Act, the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services.

(b) In an application under section 1(b) of the Act, the drawing of the mark must be a substantially exact representation of the mark as intended to be used on or in connection with the goods and/or services specified in the application, and once an amendment to allege use under § 2.76 or a statement of use under § 2.88 has been filed, the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services.

(c) In an application under section 44 of the Act, the drawing of the mark must be a substantially exact representation of the mark as it appears in the drawing in the registration certificate of a mark duly registered in the applicant's country of origin.

(d) In an application under section 66(a) of the Act, the drawing of the mark must be a substantially exact representation of the mark as it appears in the international registration.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37590, Sept. 11, 1989; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003]

§ 2.52 Types of drawings and format for drawings.

A drawing depicts the mark sought to be registered. The drawing must show only one mark. The applicant must include a clear drawing of the mark when the application is filed. There are two types of drawings:

(a) *Standard character (typed) drawing*. Applicants who seek to register words, letters, numbers, or any combination thereof without claim to any particular font style, size, or color must submit a standard character drawing that shows the mark in black on a white background. An applicant may submit a standard character drawing if:

(1) The application includes a statement that the mark is in standard characters and no claim is made to any particular font style, size, or color;

(2) The mark does not include a design element;

(3) All letters and words in the mark are depicted in Latin characters;

(4) All numerals in the mark are depicted in Roman or Arabic numerals; and

(5) The mark includes only common punctuation or diacritical marks.

(b) *Special form drawing*. Applicants who seek to register a mark that includes a two or three-dimensional design; color; and/or words, letters, or numbers or the combination thereof in a particular font style or size must submit a special form drawing. The drawing should show the mark in black on a white background, unless the mark includes color.

(1) *Marks that include color*. If the mark includes color, the drawing must show the mark in color, and the applicant must name the color(s), describe where the color(s) appear on the mark, and submit a claim that the color(s) is a feature of the mark.

(2) *Three dimensional marks*. If the mark has three-dimensional features, the drawing must depict a single rendition of the mark, and the applicant must indicate that the mark is three-dimensional.

(3) *Motion marks.* If the mark has motion, the drawing may depict a single point in the movement, or the drawing may depict up to five freeze frames showing various points in the movement, whichever best depicts the commercial impression of the mark. The applicant must also describe the mark.

(4) *Broken lines to show placement*. If necessary to adequately depict the commercial impression of the mark, the applicant may be required to submit a drawing that shows the placement of the mark by surrounding the mark with a proportionately accurate broken-line representation of the particular goods, packaging, or advertising on which the mark appears. The applicant must also use broken lines to show any other matter not claimed as part of the mark. For any drawing using broken lines to indicate placement of the mark, or matter not claimed as part of the mark, the applicant must describe the mark and explain the purpose of the broken lines.

(5) *Description of mark.* A description of the mark must be included.

(c) *TEAS drawings.* A drawing filed through TEAS must meet the requirements of § 2.53.

(d) *Paper drawings.* A paper drawing must meet the requirements of § 2.54.

(e) *Sound, scent, and non-visual marks*. An applicant is not required to submit a drawing if the mark consists only of a sound, a scent, or other completely non-visual matter. For these types of marks, the applicant must submit a detailed description of the mark.

[51 FR 29921, Aug. 21, 1986, as amended at 54 FR 37591, Sept. 11, 1989; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 73 FR 13780, March 14, 2008, effective May 13, 2008; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.53 Requirements for drawings filed through the TEAS.

The drawing must meet the requirements of § 2.52. In addition, in a TEAS submission, the drawing must meet the following requirements:

(a) *Standard character drawings*. If an applicant seeks registration of a standard character mark, the applicant must enter the mark in the appropriate field on the TEAS form, and check the box to claim that the mark consists of standard characters.

(b) *Special form drawings*: If an applicant is filing a special form drawing, the applicant must attach a digitized image of the mark to the TEAS submission that meets the requirements of paragraph (c) of this section.

(c) *Requirements for digitized image:* The image must be in .jpg format and scanned at no less than 300 dots per inch and no more than 350 dots per inch with a length and width of no less than 250 pixels and no more than 944 pixels. All lines must be clean, sharp and solid, not fine or crowded, and produce a high quality image when copied.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; amended 70 FR 38768, July 6, 2005, effective July 18, 2005; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.54 Requirements for drawings submitted on paper.

The drawing must meet the requirements of § 2.52. In addition, in a paper submission, the drawing should:

(a) Be on non-shiny white paper that is separate from the application;

(b) Be on paper that is 8 to 8.5 inches (20.3 to 21.6 cm.) wide and 11 to 11.69 inches (27.9 to 29.7 cm.) long. One of the shorter sides of the sheet should be regarded as its top edge. The image must be no larger than 3.15 inches (8 cm) high by 3.15 inches (8 cm) wide;

(c) Include the caption “DRAWING PAGE” at the top of the drawing beginning one inch (2.5 cm.) from the top edge; and

(d) Depict the mark in black ink, or in color if color is claimed as a feature of the mark.

(e) Drawings must be typed or made with a pen or by a process that will provide high definition when copied. A photolithographic, printer’s proof copy, or other high quality reproduction of the mark may be used. All lines must be clean, sharp and solid, and must not be fine or crowded.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003]

SPECIMENS

§ 2.56 Specimens.

(a) An application under section 1(a) of the Act, an amendment to allege use under § 2.76, and a statement of use under § 2.88 must each include one specimen showing the mark as used on or in connection with the goods, or in the sale or advertising of the services in commerce.

(b)(1) A trademark specimen is a label, tag, or container for the goods, or a display associated with the goods. The Office may accept another document related to the goods or the sale of the goods when it is impracticable to place the mark on the goods, packaging for the goods, or displays associated with the goods.

(2) A service mark specimen must show the mark as actually used in the sale or advertising of the services.

(3) A collective trademark or collective service mark specimen must show how a member uses the mark on the member’s goods or in the sale or advertising of the member’s services.

(4) A collective membership mark specimen must show use by members to indicate membership in the collective organization.

(5) A certification mark specimen must show how a person other than the owner uses the mark to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of that person’s goods or services; or that members of a union or other organization performed the work or labor on the goods or services.

(c) A photocopy or other reproduction of a specimen of the mark as actually used on or in connection with the goods, or in the sale or advertising of the services, is acceptable. However, a photocopy of the drawing required by § 2.51 is not a proper specimen.

(d)(1) The specimen should be flat, and not larger than 8½ inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long. If a specimen of this size is not available, the applicant may substitute a suitable photograph or other facsimile.

(2) If the applicant files a specimen exceeding these size requirements (a "bulky specimen"), the Office will create a digital facsimile of the specimen that meets the requirements of the rule (*i.e.*, is flat and no larger than 8½ inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long) and put it in the record. The Office may destroy the original bulky specimen.

(3) In the absence of non-bulky alternatives, the Office may accept an audio or video cassette tape recording, CD-ROM, or other appropriate medium.

(4) For a TEAS submission, the specimen must be a digitized image in .jpg or .pdf format.

[39 FR 12248, Apr. 4, 1974, as amended at 54 FR 37591, Sept. 11, 1989; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.59 Filing substitute specimen(s).

(a) In an application under section 1(a) of the Act, the applicant may submit substitute specimens of the mark as used on or in connection with the goods, or in the sale or advertising of the services. The applicant must verify by an affidavit or declaration under § 2.20 that the substitute specimens were in use in commerce at least as early as the filing date of the application. Verification is not required if the specimen is a duplicate or facsimile of a specimen already of record in the application.

(b) In an application under section 1(b) of the Act, after filing either an amendment to allege use under § 2.76 or a statement of use under § 2.88, the applicant may submit substitute specimens of the mark as used on or in connection with the goods, or in the sale or advertising of the services. If the applicant submits substitute specimen(s), the applicant must:

(1) For an amendment to allege use under § 2.76, verify by affidavit or declaration under § 2.20 that the applicant used the substitute specimen(s) in commerce prior to filing the amendment to allege use.

(2) For a statement of use under § 2.88, verify by affidavit or declaration under § 2.20 that the applicant used the substitute specimen(s) in commerce either prior to filing the statement of use or prior to the expiration of the deadline for filing the statement of use.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37591, Sept. 11, 1989; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999]

EXAMINATION OF APPLICATION AND ACTION BY APPLICANTS

§ 2.61 Action by examiner.

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

(b) The examiner may require the applicant to furnish such information and exhibits as may be reasonably necessary to the proper examination of the application.

(c) Whenever it shall be found that two or more parties whose interests are in conflict are represented by the same attorney, each party and also the attorney shall be notified of this fact.

[30 FR 13193, Oct. 16, 1965, as amended at 37 FR 2880, Feb. 9, 1972; 54 FR 37592, Sept. 11, 1989]

§ 2.62 Procedure for filing response.

(a) *Deadline*. The applicant's response to an Office action must be received within six months from the date of issuance.

(b) *Signature.* The response must be signed by the applicant, someone with legal authority to bind the applicant (*e.g.,* a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(2).

[Amended 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009; 74 FR 54898, Oct. 26, 2009, effective Dec. 28, 2009]

§ 2.63 Reexamination.

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

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

[48 FR 23214, May 23, 1983; 68 FR 14332, March 25, 2003, effective May 1, 2003]

§ 2.64 Final action.

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

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

(c)(1) If an applicant in an application under section 1(b) of the Act files an amendment to allege use under § 2.76 during the six-month response period after issuance of a final action, the examiner shall examine the amendment. The filing of such an amendment will not extend the time for filing an appeal or petitioning the Director.

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

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

[48 FR 23134, May 23, 1983, as amended at 54 FR 37592, Sept. 11, 1989; 68 FR 14332, March 25, 2003, effective May 1, 2003; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009; 74 FR 54898, Oct. 26, 2009, effective Dec. 28, 2009]

§ 2.65 Abandonment.

(a) If an applicant fails to respond, or to respond completely, within six months after the date an action is issued, the application shall be deemed abandoned unless the refusal or requirement is expressly limited to only certain goods and/or services. If the refusal or requirement is expressly limited to only certain goods and/or services, the application will be abandoned only as to those particular goods and/or services. A timely petition to the Director pursuant to §§ 2.63(b) and 2.146 or notice of appeal to the Trademark Trial and Appeal Board pursuant to § 2.142, if appropriate, is a response that avoids abandonment of an application.

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

(c) If an applicant in an application under section 1(b) of the Act fails to timely file a statement of use under § 2.88, the application shall be deemed to be abandoned.

[48 FR 23134, May 23, 1983, as amended at 54 FR 37592, Sept. 11, 1989; 68 FR 14332, March 25, 2003, effective May 1, 2003; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.66 Revival of abandoned applications.

(a) The applicant may file a petition to revive an application abandoned because the applicant did not timely respond to an Office action or notice of allowance, if the delay was unintentional. The applicant must file the petition:

(1) Within two months of the date of issuance of the notice of abandonment; or

(2) Within two months of actual knowledge of the abandonment, if the applicant did not receive the notice of abandonment, and the applicant was diligent in checking the status of the application every six months in accordance with § 2.146(i).

(b) The requirements for filing a petition to revive an application abandoned because the applicant did not timely respond to an Office action are:

(1) The petition fee required by § 2.6;

(2) A statement, signed by someone with firsthand knowledge of the facts, that the delay in filing the response on or before the due date was unintentional; and

(3) Unless the applicant alleges that it did not receive the Office action, the proposed response.

(c) The requirements for filing a petition to revive an application abandoned because the applicant did not timely respond to a notice of allowance are:

(1) The petition fee required by § 2.6;

(2) A statement, signed by someone with firsthand knowledge of the facts, that the delay in filing the statement of use (or request for extension of time to file a statement of use) on or before the due date was unintentional;

(3) Unless the applicant alleges that it did not receive the notice of allowance and requests cancellation of the notice of allowance, the required fees for the number of requests for extensions of time to file a statement of use that the applicant should have filed under § 2.89 if the application had never been abandoned;

(4) Unless the applicant alleges that it did not receive the notice of allowance and requests cancellation of the notice of allowance, either a statement of use under § 2.88 or a request for an extension of time to file a statement of use under § 2.89; and

(5) Unless a statement of use is filed with or before the petition, or the applicant alleges that it did not receive the notice of allowance and requests cancellation of the notice of allowance, the applicant must file any further requests for extensions of time to file a statement of use under § 2.89 that become due while the petition is pending, or file a statement of use under § 2.88.

(d) In an application under section 1(b) of the Act, the Director will not grant the petition if this would permit the filing of a statement of use more than 36 months after the date of issuance of the notice of allowance under section 13(b)(2) of the Act.

(e) The Director will grant the petition to revive if the applicant complies with the requirements listed above and establishes that the delay in responding was unintentional.

(f) If the Director denies a petition, the applicant may request reconsideration, if the applicant:

(1) Files the request within two months of the date of issuance of the decision denying the petition; and

(2) Pays a second petition fee under § 2.6.

[31 FR 5261, Apr. 1, 1966, as amended at 54 FR 37592, Sept. 11, 1989; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 68 FR 14332, March 25, 2003, effective May 1, 2003; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.67 Suspension of action by the Patent and Trademark Office.

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

[37 FR 3998, Feb. 24, 1972; 68 FR 14332, March 25, 2003, effective May 1, 2003]

§ 2.68 Express abandonment (withdrawal) of application.

(a) *Written document required*. An applicant may expressly abandon an application by filing a written request for abandonment or withdrawal of the application, signed by the applicant, someone with legal authority to bind the applicant (*e.g.,* a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(2).

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

[38 FR 7958, Mar. 27, 1973, as amended at 54 FR 34897, Aug. 22, 1989; 74 FR 54898, Oct. 26, 2009, effective Dec. 28, 2009]

§ 2.69 Compliance with other laws.

When the sale or transportation of any product for which registration of a trademark is sought is regulated under an Act of Congress, the Patent and Trademark Office may make appropriate inquiry as to compliance with such Act for the sole purpose of determining lawfulness of the commerce recited in the application.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37592, Sept. 11, 1989]

AMENDMENT OF APPLICATION

§ 2.71 Amendments to correct informalities.

The applicant may amend the application during the course of examination, when required by the Office or for other reasons.

(a) The applicant may amend the application to clarify or limit, but not to broaden, the identification of goods and/or services.

(b)(1) If the declaration or verification of an application under § 2.33 is unsigned or signed by the wrong party, the applicant may submit a substitute verification or declaration under § 2.20.

(2) If the declaration or verification of a statement of use under § 2.88, or a request for extension of time to file a statement of use under § 2.89, is unsigned or signed by the wrong party, the applicant must submit a substitute verification before the expiration of the statutory deadline for filing the statement of use.

(c) The applicant may amend the dates of use, provided that the applicant supports the amendment with an affidavit or declaration under § 2.20, except that the following amendments are *not* permitted:

(1) In an application under section 1(a) of the Act, the applicant may not amend the application to specify a date of use that is subsequent to the filing date of the application;

(2) In an application under section 1(b) of the Act, after filing a statement of use under § 2.88, the applicant may not amend the statement of use to specify a date of use that is subsequent to the expiration of the deadline for filing the statement of use.

(d) The applicant may amend the application to correct the name of the applicant, if there is a mistake in the manner in which the name of the applicant is set out in the application. The amendment must be supported by an affidavit or declaration under § 2.20, signed by the applicant. However, the application cannot be amended to set forth a different entity as the applicant. An application filed in the name of an entity that did not own the mark as of the filing date of the application is void.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37592, Sept. 11, 1989; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999]

§ 2.72 Amendments to description or drawing of the mark.

(a) In an application based on use in commerce under section 1(a) of the Act, the applicant may amend the description or drawing of the mark only if:

(1) The specimens originally filed, or substitute specimens filed under § 2.59(a), support the proposed amendment; and

(2) The proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application.

(b) In an application based on a bona fide intention to use a mark in commerce under section 1(b) of the Act, the applicant may amend the description or drawing of the mark only if:

(1) The specimens filed with an amendment to allege use or statement of use, or substitute specimens filed under § 2.59(b), support the proposed amendment; and

(2) The proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application.

(c) In an application based on a claim of priority under section 44(d) of the Act, or on a mark duly registered in the country of origin of the foreign applicant under section 44(e) of the Act, the applicant may amend the description or drawing of the mark only if:

(1) The description or drawing of the mark in the foreign registration certificate supports the amendment; and

(2) The proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application.

[48 FR 23134, May 23, 1983, as amended at 54 FR 37593, Sept. 11, 1989; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999]

§ 2.73 Amendment to recite concurrent use.

An application that includes section 1(a) of the Trademark Act as a filing basis, or for which an acceptable allegation of use under § 2.76 or § 2.88 has been filed, may be amended to an application for concurrent use registration, provided that the application as amended meets the requirements of § 2.42. The trademark examining attorney will determine whether the application, as amended, is acceptable.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37593, Sept. 11, 1989; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.74 Form and signature of amendment.

(a) *Form of Amendment*. Amendments should be set forth clearly and completely. Applicant should either set forth the entire wording, including the proposed changes, or, if it would be more efficient, indicate which words should be added and which words should be deleted. The examining attorney may require the applicant to rewrite the entire amendment, if necessary for clarification of the record.

(b) *Signature*. A request for amendment of an application must be signed by the applicant, someone with legal authority to bind the applicant (*e.g.,* a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(2). If the amendment requires verification, the verification must be sworn to or supported by a declaration under § 2.20 by a person properly authorized to sign on behalf of the applicant under § 2.193(e)(1).

[Amended 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009; 74 FR 54898, Oct. 26, 2009, effective Dec. 28, 2009]

§ 2.75 Amendment to change application to different register.

(a) An application for registration on the Principal Register under section 1(a) or 44 of the Act may be changed to an application for registration on the Supplemental Register and vice versa by amending the application to comply with the rules relating to the appropriate register, as the case may be.

(b) An application under section 1(b) of the Act may be amended to change the application to a different register only after submission of an acceptable amendment to allege use under § 2.76 or statement of use under § 2.88. When such an application is changed from the Principal Register to the Supplemental Register, the effective filing date of the application is the date of the filing of the allegation of use under section 1(c) or 1(d) of the Act.

(c) In an application under section 66(a) of the Act, the applicant may not amend the application to the Supplemental Register.

[41 FR 758, Jan. 5, 1976, as amended at 54 FR 37593, Sept. 11, 1989; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003]

§ 2.76 Amendment to allege use.

(a) An application under section 1(b) of the Act may be amended to allege use of the mark in commerce under section 1(c) of the Act at any time between the filing of the application and the date the examiner approves the mark for publication. Thereafter, an allegation of use may be submitted only as a statement of use under § 2.88 after the issuance of a notice of allowance under section 13(b)(2) of the Act. If an amendment to allege use is filed outside the time period specified in this paragraph, it will be returned to the applicant.

(b) A complete amendment to allege use must include:

(1) 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 applicant (*see* § 2.193(e)(1)) that:

(i) The applicant believes it is the owner of the mark; and

(ii) The mark is in use in commerce, specifying the date of the applicant's first use of the mark and first use of the mark in commerce, and those goods or services specified in the application on or in connection with which the applicant uses the mark in commerce.

(2) One specimen of the mark as actually used in commerce. See § 2.56 for the requirements for specimens; and

(3) The fee per class required by § 2.6.

(c) An amendment to allege use may be filed only when the applicant has made use of the mark in commerce on or in connection with all of the goods or services, as specified in the application, for which applicant will seek registration in that application unless the amendment to allege use is accompanied by a request in accordance with § 2.87 to divide out from the application the goods or services to which the amendment pertains. If more than one item of goods or services is specified in the amendment to allege use, the dates of use required in paragraph (b)(1) of this section need be for only one of the items specified in each class, provided the particular item to which the dates apply is designated.

(d) The title "Allegation of Use" should appear at the top of the document.

(e) The Office will review a timely filed amendment to allege use to determine whether it meets the following minimum requirements:

(1) The fee prescribed in § 2.6;

(2) One specimen or facsimile of the mark as used in commerce; and

(3) 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 applicant that the mark is in use in commerce.

(f) A timely filed amendment to allege use which meets the minimum requirements specified in paragraph (e) of this section will be examined in accordance with §§ 2.61 through 2.69. If, as a

result of the examination of the amendment to allege use, applicant is found not entitled to registration for any reason not previously stated, applicant will be so notified and advised of the reasons and of any formal requirements or refusals. The notification shall restate or incorporate by reference all unresolved refusals or requirements previously stated. The amendment to allege use may be amended in accordance with §§ 2.59 and 2.71 through 2.75. If the amendment to allege use is acceptable in all respects, the applicant will be notified of its acceptance. The filing of such an amendment shall not constitute a response to any outstanding action by the Trademark Examining Attorney.

(g) If the amendment to allege use is filed within the permitted time period but does not meet the minimum requirements specified in paragraph (e) of this section, applicant will be notified of the deficiency. The deficiency may be corrected provided the mark has not been approved for publication. If an acceptable amendment to correct the deficiency is not filed prior to approval of the mark for publication, the amendment will not be examined.

(h) An amendment to allege use may be withdrawn for any reason prior to approval of a mark for publication.

(i) If the applicant does not file the amendment to allege use within a reasonable time after it is signed, the Office may require a substitute verification or declaration under § 2.20 stating that the mark is still in use in commerce.

(j) For the requirements for a multiple class application, see § 2.86.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37593, Sept. 11, 1989; 63 FR 48081, Sept. 9, 1998, effective Oct. 9, 1998; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 64 FR 51244, Sept. 22, 1999; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009; 74 FR 54898, Oct. 26, 2009, effective Dec. 28, 2009]

§ 2.77 Amendments between notice of allowance and statement of use.

(a) The only amendments that can be entered in an application between the issuance of the notice of allowance and the submission of a statement of use are:

(1) The deletion of specified goods or services from the identification of goods/services;

(2) The deletion of a basis in a multiple-basis application; and

(3) A change of attorney or change of address.

(b) Other amendments filed during this period will be placed in the application file and considered when the statement of use is examined.

[54 FR 37594, Sept. 11, 1989; as amended 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

PUBLICATION AND POST PUBLICATION

§ 2.80 Publication for opposition.

If, on examination or reexamination of an application for registration on the Principal Register, it appears that the applicant is entitled to have his mark registered, the mark will be published in the *Official Gazette* for opposition. The mark will also be published in the case of an application to be placed in interference or concurrent use proceedings, if otherwise registrable.

[41 FR 758, Jan. 5, 1976]

§ 2.81 Post publication.

(a) Except in an application under section 1(b) of the Act for which no amendment to allege use under § 2.76 has been submitted and accepted, if no opposition is filed within the time permitted or all oppositions filed are dismissed, and if no interference is declared and no

concurrent use proceeding is instituted, the application will be prepared for issuance of the certificate of registration as provided in § 2.151.

(b) In an application under section 1(b) of the Act for which no amendment to allege use under § 2.76 has been submitted and accepted, if no opposition is filed within the time permitted or all oppositions filed are dismissed, and if no interference is declared, a notice of allowance will issue. The notice of allowance will state the serial number of the application, the name of the applicant, the correspondence address, the mark, the identification of goods and/or services, and the issue date of the notice of allowance. Thereafter, the applicant must submit a statement of use as provided in § 2.88.

[48 FR 23135, May 23, 1983, as amended at 54 FR 37594, Sept. 11, 1989; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.82 Marks on Supplemental Register published only upon registration.

In the case of an application for registration on the Supplemental Register the mark will not be published for opposition but if it appears, after examination or reexamination, that the applicant is entitled to have the mark registered, a certificate of registration will issue as provided in § 2.151. The mark will be published in the *Official Gazette* when registered.

[30 FR 13193, Oct. 16, 1965. Redesignated at 37 FR 2880, Feb. 9, 1972, as amended at 54 FR 37594, Sept. 11, 1989]

§ 2.83 Conflicting marks.

(a) Whenever an application is made for registration of a mark which so resembles another mark or marks pending registration as to be likely to cause confusion or mistake or to deceive, the mark with the earliest effective filing date will be published in the *Official Gazette* for opposition if eligible for the Principal Register, or issued a certificate of registration if eligible for the Supplemental Register.

(b) In situations in which conflicting applications have the same effective filing date, the application with the earliest date of execution will be published in the *Official Gazette* for opposition or issued on the Supplemental Register.

(c) Action on the conflicting application which is not published in the *Official Gazette* for opposition or not issued on the Supplemental Register will be suspended by the Examiner of Trademarks until the published or issued application is registered or abandoned.

[37 FR 2880, Feb. 9, 1972, as amended at 54 FR 37594, Sept. 11, 1989]

§ 2.84 Jurisdiction over published applications.

(a) The trademark examining attorney may exercise jurisdiction over an application up to the date the mark is published in the *Official Gazette.* After publication of an application under section 1(a), 44 or 66(a) of the Act, the trademark examining attorney may, with the permission of the Director, exercise jurisdiction over the application. After publication of an application under section 1(b) of the Act, the trademark examining attorney may exercise jurisdiction over the application after the issuance of the notice of allowance under section 13(b)(2) of the Act. After publication, and prior to issuance of a notice of allowance in an application under section 1(b), the trademark examining attorney may, with the permission of the Director, exercise jurisdiction over the application.

(b) After publication, but before the certificate of registration is issued in an application under section 1(a), 44, or 66(a) of the Act, or before the notice of allowance is issued in an application

under section 1(b) of the Act, an application that is not the subject of an inter partes proceeding before the Trademark Trial and Appeal Board may be amended if the amendment does not necessitate republication of the mark or issuance of an Office action. Otherwise, an amendment to such an application may be submitted only upon petition to the Director to restore jurisdiction over the application to the trademark examining attorney for consideration of the amendment and further examination. The amendment of an application that is the subject of an inter partes proceeding before the Trademark Trial and Appeal Board is governed by § 2.133.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37595, Sept. 11, 1989; 68 FR 14332, March 25, 2003, effective May 1, 2003; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

CLASSIFICATION

§ 2.85 Classification schedules.

(a) *International classification system*. Section 6.1 of this chapter sets forth the international system of classification for goods and services, which applies for all statutory purposes to:

(1) Applications filed in the Office on or after September 1, 1973, and resulting registrations; and

(2) Registrations resulting from applications filed on or before August 31, 1973, that have been amended to adopt international classification pursuant to § 2.85(e)(3).

(b) *Prior United States classification system*. Section 6.2 of this chapter sets forth the prior United States system of classification for goods and services, which applies for all statutory purposes to registrations resulting from applications filed on or before August 31, 1973, unless:

(1) The registration has been amended to adopt international classification pursuant to § 2.85(e)(3); or

(2) The registration was issued under a classification system prior to that set forth in § 6.2.

(c) *Certification marks and collective membership marks*. Sections 6.3 and 6.4 specify the system of classification which applies to certification marks and collective membership marks in applications based on sections 1 and 44 of the Act, and to registrations resulting from applications based on sections 1 and 44. These sections do not apply to applications under section 66(a) or to registered extensions of protection.

(d) *Section 66(a) applications and registered extensions of protection*. In an application under section 66(a) of the Act or registered extension of protection, the classification cannot be changed from the classification assigned by the International Bureau of the World Intellectual Property Organization, unless the International Bureau corrects the classification. Classes cannot be added, and goods or services cannot be transferred from one class to another in a multiple-class application.

(e) *Changes to Nice Agreement*. The international classification system changes periodically, pursuant to the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks. These changes are listed in the *International Classification of Goods and Services for the Purposes of the Registration of Marks*, which is published by the World Intellectual Property Organization.

(1) If international classification changes pursuant to the Nice Agreement, the new classification applies only to applications filed on or after the effective date of the change.

(2) In a section 1 or section 44 application filed before the effective date of a change to the Nice Agreement, the applicant may amend the application to comply with the requirements of the current edition. The applicant must comply with the current edition for all goods or services identified in the application. The applicant must pay the fees for any added class(es).

(3) In a registration resulting from a section 1 or section 44 application that was filed before the effective date of a change to the Nice Agreement, the owner may amend the registration to comply with the requirements of the current edition. The owner must reclassify all goods or

services identified in the registration to the current edition. The owner must pay the fee required by § 2.6 for amendments under section 7 of the Act. The owner may reclassify registrations from multiple United States classes (§ 2.85(b)) into a single international classification, where appropriate.

(f) Classification schedules shall not limit or extend the applicant's rights, except that in a section 66(a) application, the scope of the identification of goods or services for purposes of permissible amendments (*see* § 2.71(a)) is limited by the class, pursuant to § 2.85(d).

[38 FR 14681, June 4, 1973, as amended at 39 FR 16885, May 1 1974; 47 FR 41282, Sept. 17, 1982; 63 FR 48081, Sept. 9, 1998, effective Oct. 9, 1998; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.86 Application may include multiple classes.

(a) In a single application, an applicant may apply to register the same mark for goods and/or services in multiple classes. The applicant must:

(1) Specifically identify the goods or services in each class;

(2) Submit an application filing fee for each class, as set forth in § 2.6(a)(1); and

(3) Include either dates of use (see §§ 2.34(a)(1)(ii) and (iii)) and one specimen for each class, or a statement of a bona fide intention to use the mark in commerce on or in connection with all the goods or services specified in each class. The applicant may not claim both use in commerce and a bona fide intention to use the mark in commerce for the identical goods or services in one application.

(b) An amendment to allege use under § 2.76 or a statement of use under § 2.88 must include, for each class, the required fee, dates of use, and one specimen. The applicant may not file the amendment to allege use or statement of use until the applicant has used the mark on all the goods or services, unless the applicant files a request to divide. See § 2.87 for information regarding requests to divide.

(c) The Office will issue a single certificate of registration for the mark, unless the applicant files a request to divide. See § 2.87 for information regarding requests to divide.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37954, Sept. 11, 1989; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 70 FR 2952, Jan. 19, 2005, effective Jan. 31, 2005; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.87 Dividing an application.

(a) *Application may be divided*. An application may be divided into two or more separate applications upon the payment of a fee for each new application created and submission by the applicant of a request in accordance with paragraph (d) of this section.

(b) *Fee.* In the case of a request to divide out one or more entire classes from an application, only the fee for dividing an application as set forth in § 2.6(a)(19) will be required. However, in the case of a request to divide out some, but not all, of the goods or services in a class, the applicant must submit the application filing fee as set forth in § 2.6(a)(1) for each new separate application to be created by the division, in addition to the fee for dividing an application.

(c) *Time for filing*. (1) A request to divide an application may be filed at any time between the application filing date and the date on which the trademark examining attorney approves the mark for publication; or during an opposition, concurrent use, or interference proceeding, upon motion granted by the Trademark Trial and Appeal Board.

(2) In an application under section 1(b) of the Act, a request to divide may also be filed with a statement of use under § 2.88 or at any time between the filing of a statement of use and the date on which the trademark examining attorney approves the mark for registration.

(3) In a multiple-basis application, a request to divide out goods or services having a particular basis may also be filed during the period between the issuance of the notice of allowance under section 13(b)(2) of the Act and the filing of a statement of use under § 2.88.

(d) *Form.* A request to divide an application should be made in a separate document from any other amendment or response in the application. The title "Request to Divide Application" should appear at the top of the first page of the document.

(e) *Outstanding time periods apply to newly created applications*. Any time period for action by the applicant which is outstanding in the original application at the time of the division will apply to each separate new application created by the division, except as follows:

(1) If an Office action pertaining to less than all the classes in a multiple-class application is outstanding, and the applicant files a request to divide out the goods, services, and/or class(es) to which the Office action does not pertain before the response deadline, a response to the Office action is not due in the new (child) application(s) created by the division of the application;

(2) If an Office action pertaining to less than all the bases in a multiple-basis application is outstanding, and the applicant files a request to divide out the goods/services having the basis or bases to which the Office action does not pertain before the response deadline, a response to the Office action is not due in the new (child) application(s) created by the division of the application; or

(3) In a multiple-basis application in which a notice of allowance has issued, if the applicant files a request to divide out the goods/services having the basis or bases to which the notice of allowance does not pertain before the deadline for filing the statement of use, the new (child) applications created by the division are not affected by the notice of allowance.

(f) *Signature*. The request to divide must be signed by the applicant, someone with legal authority to bind the applicant (*e.g.*, a corporate officer or general partner of a partnership), or a practitioner who meets the requirements of § 11.14, in accordance with the requirements of § 2.193(e)(2).

(g) *Section 66(a) applications - change of ownership with respect to some but not all of the goods or services*. (1) When the International Bureau of the World Intellectual Property Organization notifies the Office that an international registration has been divided as the result of a change of ownership with respect to some but not all of the goods or services, the Office will construe the International Bureau's notice as a request to divide. The Office will record the partial change of ownership in the Assignment Services Branch, and divide out the assigned goods/services from the original (parent) application. The Office will create a new (child) application serial number, and enter the information about the new application in its automated records.

(2) To obtain a certificate of registration in the name of the new owner for the goods/services that have been divided out, the new owner must pay the fee(s) for the request to divide, as required by § 2.6 and paragraph (b) of this section. The examining attorney will issue an Office action in the child application requiring the new owner to pay the required fee(s). If the owner of the child application fails to respond, the child application will be abandoned. It is not necessary for the new owner to file a separate request to divide.

(3) The Office will not divide a section 66(a) application based upon a change of ownership unless the International Bureau notifies the Office that the international registration has been divided.

[37 FR 3898, Feb. 24, 1972, as amended at 54 FR 37595, Sept. 11, 1989; 57 FR 38190, Aug. 21, 1992; 63 FR 48081, Sept. 9, 1998, effective Oct. 9, 1998; 70 FR 2952, Jan. 19, 2005, effective Jan. 31, 2005; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009; 74 FR 54898, Oct. 26, 2009, effective Dec. 28, 2009]

POST NOTICE OF ALLOWANCE

§ 2.88 Filing statement of use after notice of allowance.

(a) In an application under section 1(b) of the Act, a statement of use, required under section 1(d) of the Act, must be filed within six months after issuance of a notice of allowance under section 13(b)(2) of the Act, or within an extension of time granted under § 2.89. A statement of use that is filed prior to issuance of a notice of allowance is premature, will not be considered, and will be returned to the applicant.

(b) A complete statement of use must include:

(1) 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 applicant (*see* § 2.193(e)(1)) that:

(ii) The mark is in use in commerce, specifying the date of the applicant's first use of the mark and first use of the mark in commerce on or in connection with the goods or services identified in the notice of allowance, and setting forth or incorporating by reference those goods/services identified in the notice of allowance on or in connection with which the mark is in use in commerce. Where an applicant claims section 1(a) of the Act for some goods/services in a class and section 1(b) of the Act for other goods/services in the same class, the statement of use must include dates for the section 1(b) goods/services;

(2) One specimen of the mark as actually used in commerce. See § 2.56 for the requirements for specimens; and

(3) The fee per class required by § 2.6. The applicant must pay a filing fee sufficient to cover at least one class within the statutory time for filing the statement of use, or the application will be abandoned. If the applicant submits a fee insufficient to cover all the classes in a multiple-class application, the applicant must specify the classes to be abandoned. If the applicant submits a fee sufficient to pay for at least one class, but insufficient to cover all the classes, and the applicant has not specified the class(es) to be abandoned, the Office will issue a notice granting the applicant additional time to submit the fee(s) for the remaining class(es), or specify the class(es) to be abandoned. If the applicant does not submit the required fee(s) or specify the class(es) to be abandoned within the set time period, the Office will apply the fees paid, beginning with the lowest numbered class(es), in ascending order. The Office will delete the goods/services in the remaining class(es) not covered by the fees submitted.

(c) The statement of use may be filed only when the applicant has made use of the mark in commerce on or in connection with all of the goods or services, as specified in the notice of allowance, for which applicant will seek registration in that application, unless the statement of use is accompanied by a request in accordance with § 2.87 to divide out from the application the goods or services to which the statement of use pertains. If more than one item of goods or services is specified in the statement of use, the dates of use required in paragraph (b)(1) of this section need be for only one of the items specified in each class, provided the particular item to which the dates apply is designated.

(d) The title "Allegation of Use" should appear at the top of the first page of the document.

(e) The Office will review a timely filed statement of use to determine whether it meets the following minimum requirements:

(1) The fee for at least a single class, required by § 2.6;

(2) One specimen of the mark as used in commerce;

(3) 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 applicant that the mark is in use in commerce. If the verification or declaration is unsigned or signed by the wrong party, the applicant must submit a substitute verification on or before the statutory deadline for filing the statement of use.

(f) A timely filed statement of use which meets the minimum requirements specified in paragraph (e) of this section will be examined in accordance with §§ 2.61 through 2.69. If, as a result of the examination of the statement of use, applicant is found not entitled to registration,

applicant will be notified and advised of the reasons and of any formal requirements or refusals. The statement of use may be amended in accordance with §§ 2.59 and 2.71 through 2.75. If the statement of use is acceptable in all respects, the applicant will be notified of its acceptance.

(g) If the statement of use does not meet the minimum requirements specified in paragraph (e) of this section, applicant will be notified of the deficiency. If the time permitted for applicant to file a statement of use has not expired, applicant may correct the deficiency. After the filing of a statement of use during a permitted time period for such filing, the applicant may not withdraw the statement to return to the previous status of awaiting submission of a statement of use, regardless of whether it is in compliance with paragraph (e) of this section.

(h) The failure to timely file a statement of use which meets the minimum requirements specified in paragraph (e) of this section shall result in the abandonment of the application.

(i)(1) The goods or services specified in a statement of use must conform to those goods or services identified in the notice of allowance. An applicant may specify the goods or services by stating "those goods or services identified in the notice of allowance" or, if appropriate, "those goods or services identified in the notice of allowance except...," followed by an identification of the goods or services to be deleted.

(2) If any goods or services specified in the notice of allowance are omitted from the identification of goods or services in the statement of use, the Office will delete the omitted goods/services from the application. The applicant may not thereafter reinsert these goods/services.

(3) The statement of use may be accompanied by a separate request to amend the identification of goods or services in the application, as stated in the notice of allowance, in accordance with § 2.71(a).

(j) The statement of use may be accompanied by a separate request to amend the drawing in the application, in accordance with §§ 2.51 and 2.72.

(k) If the statement of use is not filed within a reasonable time after the date it is signed, the Office may require a substitute verification or declaration under § 2.20 stating that the mark is still in use in commerce.

(l) For the requirements for a multiple class application, see § 2.86.

[54 FR 37595, Sept. 11, 1989; as amended 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 64 FR 51244, Sept. 22, 1999; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009; 74 FR 54898, Oct. 26, 2009, effective Dec. 28, 2009]

§ 2.89 Extensions of time for filing a statement of use.

(a) The applicant may request a six-month extension of time to file the statement of use required by § 2.88. The extension request must be filed within six months of the date of issuance of the notice of allowance under section 13(b)(2) of the Act and must include the following:

(1) A written request for an extension of time to file the statement of use;

(2) The fee per class required by § 2.6. The applicant must pay a filing fee sufficient to cover at least one class within the statutory time for filing the extension request, or the request will be denied. If the applicant timely submits a fee sufficient to pay for at least one class, but insufficient to cover all the classes, and the applicant has not specified the class(es) to which the fee applies, the Office will issue a notice granting the applicant additional time to submit the fee(s) for the remaining classes, or specify the class(es) to be abandoned. If the applicant does not submit the required fee(s) or specify the class(es) to be abandoned within the set time period, the Office will apply the fees paid, beginning with the lowest numbered class(es), in ascending order. The Office will delete the goods/services in the remaining classes not covered by the fees submitted; and

(3) A statement that the applicant still has a bona fide intention to use the mark in commerce, specifying the relevant goods or services, signed and verified (sworn to) or supported by a declaration under § 2.20 by a person properly authorized to sign on behalf of the applicant (*see*

§ 2.193(e)(1)). If the verification is unsigned or signed by the wrong party, the applicant must submit a substitute verification within six months of the date of issuance of the notice of allowance.

(b) Before the expiration of the previously granted extension of time, the applicant may request further six-month extensions of time to file the statement of use by submitting the following:

(1) A written request for an extension of time to file the statement of use;

(2) The fee per class required by § 2.6. The applicant must pay a filing fee sufficient to cover at least one class within the statutory time for filing the extension request, or the request will be denied. If the applicant submits a fee insufficient to cover all the classes in a multiple-class application, the applicant must specify the classes to be abandoned. If the applicant submits a fee sufficient to pay for at least one class, but insufficient to cover all the classes, and the applicant has not specified the class(es) to which the fee applies, the Office will issue a notice granting the applicant additional time to submit the fee(s) for the remaining classes, or specify the class(es) to be abandoned. If the applicant does not submit the required fee(s) or specify the class(es) to be abandoned within the set time period, the Office will apply the fees, beginning with the lowest numbered class(es), in ascending order. The Office will delete the remaining goods/services not covered by the fees submitted;

(3) A statement that the applicant still has a bona fide intention to use the mark in commerce, specifying the relevant goods or services, signed and verified (sworn to) or supported by a declaration under § 2.20 by a person properly authorized to sign on behalf of the applicant (*see* § 2.193(e)(1)). If the verification is unsigned or signed by the wrong party, the applicant must submit a substitute verification before the expiration of the previously granted extension; and

(4) A showing of good cause, as specified in paragraph (d) of this section.

(c) Extensions of time under paragraph (b) of this section will be granted only in six-month increments and may not aggregate more than 24 months.

(d) The showing of good cause must include a statement of the applicant's ongoing efforts to make use of the mark in commerce on or in connection with each of the relevant goods or services. Those efforts may include product or service research or development, market research, manufacturing activities, promotional activities, steps to acquire distributors, steps to obtain governmental approval, or other similar activities. In the alternative, the applicant must submit a satisfactory explanation for the failure to make efforts to use the mark in commerce.

(e)(1) At the time of the filing of a statement of use, or during any time remaining in the existing six-month period in which a statement of use is filed, applicant may file one request, in accordance with paragraph (a) or (b) of this section, for a six-month extension of time for filing a statement of use, provided that the time requested would not extend beyond 36 months from the issuance of the notice of allowance. Thereafter, applicant may not request any further extensions of time.

(2) A request for an extension of time that is filed at the time of the filing of a statement of use, or during any time remaining in the existing six-month period in which a statement of use is filed, must comply with all the requirements of paragraph (a) of this section, if it is applicant's first extension request, or paragraph (b) of this section, if it is a second or subsequent extension request. However, in a request under paragraph (b) of this section, applicant may satisfy the requirement for a showing of good cause by asserting that applicant believes that it has made valid use of the mark in commerce, as evidenced by the submitted statement of use, but that if the statement of use is found by the Patent and Trademark Office to be fatally defective, applicant will need additional time in which to file a new statement of use.

(f) The goods or services specified in a request for an extension of time for filing a statement of use must conform to those goods or services identified in the notice of allowance. Any goods or services specified in the notice of allowance which are omitted from the identification of goods or services in the request for extension of time will be presumed to be deleted and the applicant may not thereafter request that the deleted goods or services be reinserted in the application. If appropriate, an applicant may specify the goods or services by stating "those goods or services

identified in the notice of allowance" or "those goods or services identified in the notice of allowance except..." followed by an identification of the goods or services to be deleted.

(g) The applicant will be notified of the grant or denial of a request for an extension of time, and of the reasons for a denial. Failure to notify the applicant of the grant or denial of the request prior to the expiration of the existing period or requested extension does not relieve the applicant of the responsibility of timely filing a statement of use under § 2.88. If, after denial of an extension request, there is time remaining in the existing six-month period for filing a statement of use, applicant may submit a substitute request for extension of time. Otherwise, the only recourse available after denial of a request for an extension of time is a petition to the Director in accordance with § 2.66 or § 2.146. A petition from the denial of an extension request must be filed within two months of the date of issuance of the denial of the request. If the petition is granted, the term of the requested six-month extension that was the subject of the petition will run from the date of expiration of the previously existing six-month period for filing a statement of use.

(h) If the extension request is not filed within a reasonable time after it is signed, the Office may require a substitute verification or declaration under § 2.20 stating that the applicant still has a bona fide intention to use the mark in commerce.

[54 FR 37595, Sept. 11, 1989; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 64 FR 51244, Sept. 22, 1999; 65 FR 36633, June 9, 2000; 68 FR 14332, March 25, 2003, effective May 1, 2003; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009; 74 FR 54898, Oct. 26, 2009, effective Dec. 28, 2009]

INTERFERENCES AND CONCURRENT USE PROCEEDINGS

§ 2.91 Declaration of interference.

(a) An interference will not be declared between two applications or between an application and a registration except upon petition to the Director. Interferences will be declared by the Director only upon a showing of extraordinary circumstances which would result in a party being unduly prejudiced without an interference. In ordinary circumstances, the availability of an opposition or cancellation proceeding to the party will be deemed to remove any undue prejudice.

(b) Registrations and applications to register on the Supplemental Register, registrations under the Act of 1920, and registrations of marks the right to use of which has become incontestable are not subject to interference.

[37 FR 2881, Feb. 9, 1972, as amended at 54 FR 34897, Aug. 22, 1989; 68 FR 14332, March 25, 2003, effective May 1, 2003]

§ 2.92 Preliminary to interference.

An interference which has been declared by the Director will not be instituted by the Trademark Trial and Appeal Board until the Examiner of Trademarks has determined that the marks which are to form the subject matter of the controversy are registrable, and all of the marks have been published in the Official Gazette for opposition.

[37 FR 2881, Feb. 9, 1972, as amended at 54 FR 34897, Aug. 22, 1989; 68 FR 14332, March 25, 2003, effective May 1, 2003]

§ 2.93 Institution of interference.

An interference is instituted by the issuance of a notice of interference to the parties. The notice shall be sent to each applicant, in care of the applicant's attorney or other representative of record, if any, and if one of the parties is a registrant, the notice shall be sent to the registrant or

the registrant's assignee of record. The notice shall give the name and address of every adverse party and of the adverse party's attorney or other authorized representative, if any, together with the serial number and date of filing and publication of each of the applications, or the registration number and date of issuance of each of the registrations, involved.

[41 FR 759, Jan. 5, 1976, as amended at 54 FR 34897, Aug. 22, 1989; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.96 Issue; burden of proof.

The issue in an interference between applications is normally priority of use, but the rights of the parties to registration may also be determined. The party whose application involved in the interference has the latest filing date is the junior party and has the burden of proof. When there are more than two parties to an interference, a party shall be a junior party to and shall have the burden of proof as against every other party whose application involved in the interference has an earlier filing date. If the involved applications of any parties have the same filing date, the application with the latest date of execution will be deemed to have the latest filing date and that applicant will be the junior party. The issue in an interference between an application and a registration shall be the same, but in the event the final decision is adverse to the registrant, a registration to the applicant will not be authorized so long as the interfering registration remains on the register.

[48 FR 23135, May 23, 1983; 48 FR 27225, June 14, 1983]

§ 2.98 Adding party to interference.

A party may be added to an interference only upon petition to the Director by that party. If an application which is or might be the subject of a petition for addition to an interference is not added, the examiner may suspend action on the application pending termination of the interference proceeding.

[48 FR 23135, May 23, 1983; 68 FR 14332, March 25, 2003, effective May 1, 2003]

§ 2.99 Application to register as concurrent user.

(a) An application for registration as a lawful concurrent user will be examined in the same manner as other applications for registration.

(b) If it appears that the applicant is entitled to have the mark registered, subject to a concurrent use proceeding, the mark will be published in the Official Gazette as provided by § 2.80.

(c) If no opposition is filed, or if all oppositions that are filed are dismissed or withdrawn, the Trademark Trial and Appeal Board will send a notification to the applicant for concurrent use registration (plaintiff) and to each applicant, registrant or user specified as a concurrent user in the application (defendants). The notification for each defendant shall state the name and address of the plaintiff and of the plaintiff's attorney or other authorized representative, if any, together with the serial number and filing date of the application. If a party has provided the Office with an e-mail address, the notification may be transmitted via e-mail.

(d)(1) Within ten days from the date of the Board's notification, the applicant for concurrent use registration must serve copies of its application, specimens and drawing on each applicant, registrant or user specified as a concurrent user in the application for registration, as directed by the Board. If any service copy is returned to the concurrent use applicant as undeliverable, the concurrent use applicant must notify the Board within ten days of receipt of the returned copy.

(2) An answer to the notice is not required in the case of an applicant or registrant whose application or registration is specified as a concurrent user in the application, but a statement, if desired, may be filed within forty days after the issuance of the notice; in the case of any other party specified as a concurrent user in the application, an answer must be filed within forty days after the issuance of the notice.

(3) If an answer, when required, is not filed, judgment will be entered precluding the specified user from claiming any right more extensive than that acknowledged in the application(s) for concurrent use registration, but the applicant(s) will remain with the burden of proving entitlement to registration(s).

(e) The applicant for a concurrent use registration has the burden of proving entitlement thereto. If there are two or more applications for concurrent use registration involved in a proceeding, the party whose application has the latest filing date is the junior party. A party whose application has a filing date between the filing dates of the earliest involved application and the latest involved application is a junior party to every party whose involved application has an earlier filing date. If any applications have the same filing date, the application with the latest date of execution will be deemed to have the latest filing date and that applicant will be the junior party. A person specified as an excepted user in a concurrent use application but who has not filed an application shall be considered a party senior to every party that has an application involved in the proceeding.

(f) When a concurrent use registration is sought on the basis that a court of competent jurisdiction has finally determined that the parties are entitled to use the same or similar marks in commerce, a concurrent use registration proceeding will not be instituted if all of the following conditions are fulfilled:

(1) The applicant is entitled to registration subject only to the concurrent lawful use of a party to the court proceeding; and

(2) The court decree specifies the rights of the parties; and

(3) A true copy of the court decree is submitted to the examiner; and

(4) The concurrent use application complies fully and exactly with the court decree; and

(5) The excepted use specified in the concurrent use application does not involve a registration, or any involved registration has been restricted by the Director in accordance with the court decree.

If any of the conditions specified in this paragraph is not satisfied, a concurrent use registration proceeding shall be prepared and instituted as provided in paragraphs (a) through (e) of this section.

(g) Registrations and applications to register on the Supplemental Register and registrations under the Act of 1920 are not subject to concurrent use registration proceedings. Applications under section 1(b) of the Act of 1946 are subject to concurrent use registration proceedings only after the applicant files an acceptable allegation of use under § 2.76 or § 2.88. Applications based solely on section 44 or section 66(a) of the Act are not subject to concurrent use registration proceedings.

(h) The Trademark Trial and Appeal Board will consider and determine concurrent use rights only in the context of a concurrent use registration proceeding.

[48 FR 23135, May 23, 1983; 48 FR 27225, June 14, 1983, as amended at 54 FR 37596, Sept. 11, 1989; 68 FR 14332, March 25, 2003, effective May 1, 2003; 72 FR 42242, Aug. 1, 2007, effective Nov. 1, 2007; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

OPPOSITION

§ 2.101 Filing an opposition.

(a) An opposition proceeding is commenced by filing in the Office a timely notice of opposition with the required fee. The notice must include proof of service on the applicant, or its attorney or

domestic representative of record, at the correspondence address of record in the Office, as detailed in §§ 2.101(b) and 2.119.

(b) Any person who believes that he, she or it would be damaged by the registration of a mark on the Principal Register may file an opposition addressed to the Trademark Trial and Appeal Board and must serve a copy of the opposition, including any exhibits, on the attorney of record for the applicant or, if there is no attorney, on the applicant or on the applicant's domestic representative, if one has been appointed, at the correspondence address of record in the Office. The opposer must include with the opposition proof of service pursuant to § 2.119 at the correspondence address of record in the Office. If any service copy of the opposition is returned to the opposer as undeliverable, the opposer must notify the Board within ten days of receipt of the returned copy. The opposition need not be verified, but must be signed by the opposer or the opposer's attorney, as specified in § 11.1 of this chapter, or other authorized representative, as specified in § 11.14(b) of this chapter. Electronic signatures pursuant to § 2.193(c) are required for oppositions filed through ESTTA under paragraphs (b)(1) or (2) of this section.

(1) An opposition to an application based on section 1 or 44 of the Act must be filed either on paper or through ESTTA.

(2) An opposition to an application based on section 66(a) of the Act must be filed through ESTTA.

(c) The opposition must be filed within thirty days after publication (§ 2.80) of the application being opposed or within an extension of time (§ 2.102) for filing an opposition.

(d)(1) The opposition must be accompanied by the required fee for each party joined as opposer for each class in the application for which registration is opposed (see § 2.6).

(2) An otherwise timely opposition will not be accepted via ESTTA unless the opposition is accompanied by a fee that is sufficient to pay in full for each named party opposer to oppose the registration of a mark in each class specified in the opposition.

(3) If an otherwise timely opposition is submitted on paper, the following is applicable if less than all required fees are submitted:

(i) If the opposition is accompanied by no fee or a fee insufficient to pay for one person to oppose the registration of a mark in at least one class, the opposition will be refused.

(ii) If the opposition is accompanied by fees sufficient to pay for one person to oppose registration in at least one class, but fees are insufficient to oppose registration in all the classes in the application, and the particular class or classes against which the opposition is filed is not specified, the opposition will be presumed to be against the class or classes in ascending numerical order, including only the number of classes in the application for which sufficient fees have been submitted.

(iii) If persons are joined as party opposers, each must submit a fee for each class for which opposition is sought. If the fees submitted are sufficient to pay for one person to oppose registration in at least one class, but are insufficient for each named party opposer, the first-named party will be presumed to be the party opposer. Additional parties will be deemed to be party opposers only to the extent that the fees submitted are sufficient to pay the fee due for each party opposer. If persons are joined as party opposers against a multiple class application, the fees submitted are insufficient, and no specification of opposers and classes is made at the time the party is joined, the fees submitted will be applied first on behalf of the first-named opposer against as many of the classes in the application as the submitted fees are sufficient to pay. Any excess will be applied on behalf of the second-named party to the opposition against the classes in the application in ascending numerical order.

(4) The filing date of an opposition is the date of receipt in the Office of the notice of opposition, with proof of service on the applicant, or its attorney or domestic representative of record, if one has been appointed, at the correspondence address of record in the Office, and the required fee, unless the notice is filed in accordance with § 2.198.

[48 FR 3976, Jan. 28, 1983, as amended at 51 FR 28709, Aug. 11, 1986; 54 FR 37596, Sept. 11, 1989; 63 FR 48081, Sept. 9, 1998, effective Oct. 9, 1998; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 68 FR

55748, Sept. 26, 2003, effective Nov. 2, 2003; 72 FR 42242, Aug. 1, 2007, effective Nov. 1, 2007; 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008; 74 FR 54898, Oct. 26, 2009, effective Dec. 28, 2009]

§ 2.102 Extension of time for filing an opposition.

(a) Any person who believes that he, she or it would be damaged by the registration of a mark on the Principal Register may file in the Office a written request, addressed to the Trademark Trial and Appeal Board, to extend the time for filing an opposition. The written request need not be verified, but must be signed by the potential opposer or by the potential opposer's attorney, as specified in § 11.1 of this chapter, or authorized representative, as specified in § 11.14(b) of this chapter. Electronic signatures pursuant to § 2.193(c) are required for electronically filed extension requests.

(1) A written request to extend the time for filing an opposition to an application filed under section 1 or 44 of the Act must be filed either on paper or through ESTTA.

(2) A written request to extend the time for filing an opposition to an application filed under section 66(a) of the Act must be filed through ESTTA.

(b) A written request to extend the time for filing an opposition must identify the potential opposer with reasonable certainty. Any opposition filed during an extension of time should be in the name of the person to whom the extension was granted. An opposition may be accepted if the person in whose name the extension was requested was misidentified through mistake or if the opposition is filed in the name of a person in privity with the person who requested and was granted the extension of time.

(c) The time for filing an opposition shall not be extended beyond 180 days from the date of publication. Any request to extend the time for filing an opposition must be filed before thirty days have expired from the date of publication or before the expiration of a previously granted extension of time, as appropriate. Requests to extend the time for filing an opposition must be filed as follows:

(1) A person may file a first request for either a thirty-day extension of time, which will be granted upon request, or a ninety-day extension of time, which will be granted only for good cause shown.

(2) If a person was granted a thirty-day extension of time, that person may file a request for an additional sixty-day extension of time, which will be granted only for good cause shown.

(3) After receiving one or two extensions of time totaling ninety days, a person may file one final request for an extension of time for an additional sixty days. The Board will grant this request only upon written consent or stipulation signed by the applicant or its authorized representative, or a written request by the potential opposer or its authorized representative stating that the applicant or its authorized representative has consented to the request, or a showing of extraordinary circumstances. No further extensions of time to file an opposition will be granted under any circumstances.

[48 FR 3976, Jan. 28, 1983, as amended at 61 FR 36825, July 15, 1996; 63 FR 48081, Sept. 9, 1998, effective Oct. 9, 1998; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008; 74 FR 54898, Oct. 26, 2009, effective Dec. 28, 2009]

§ 2.104 Contents of opposition.

(a) The opposition must set forth a short and plain statement showing why the opposer believes he, she or it would be damaged by the registration of the opposed mark and state the grounds for opposition.

(b) Oppositions to different applications owned by the same party may be joined in a consolidated opposition when appropriate, but the required fee must be included for each party joined as opposer for each class in which registration is opposed in each application against which the opposition is filed.

[51 FR 28709, Aug. 11, 1986, as amended at 54 FR 34897, Aug. 22, 1989; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003]

§ 2.105 Notification to parties of opposition proceeding(s).

(a) When an opposition in proper form (see §§ 2.101 and 2.104), with proof of service in accordance with § 2.101(b), has been filed and the correct fee has been submitted, the Trademark Trial and Appeal Board shall prepare a notification, which shall identify the title and number of the proceeding and the application involved and shall designate a time, not less than thirty days from the mailing date of the notification, within which an answer must be filed. If a party has provided the Office with an e-mail address, the notification may be transmitted via e-mail.

(b) The Board shall forward a copy of the notification to opposer, as follows:

(1) If the opposition is transmitted by an attorney, or a written power of attorney is filed, the Board will send the notification to the attorney transmitting the opposition or to the attorney designated in the power of attorney, provided that the person is an "attorney" as defined in § 11.1 of this chapter.

(2) If opposer is not represented by an attorney in the opposition, but opposer has appointed a domestic representative, the Board will send the notification to the domestic representative, unless opposer designates in writing another correspondence address.

(3) If opposer is not represented by an attorney in the opposition, and no domestic representative has been appointed, the Board will send the notification directly to opposer, unless opposer designates in writing another correspondence address.

(c) The Board shall forward a copy of the notification to applicant, as follows:

(1) If the opposed application contains a clear indication that the application is being prosecuted by an attorney, as defined in § 11.1 of this chapter, the Board shall send the documents described in this section to applicant's attorney.

(2) If the opposed application is not being prosecuted by an attorney but a domestic representative has been appointed, the Board will send the documents described in this section to the domestic representative, unless applicant designates in writing another correspondence address.

(3) If the opposed application is not being prosecuted by an attorney, and no domestic representative has been appointed, the Board will send the documents described in this section directly to applicant, unless applicant designates in writing another correspondence address.

[48 FR 23136, May 23, 1983; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 72 FR 42242, Aug. 1, 2007, effective Nov. 1, 2007; 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 2.106 Answer.

(a) If no answer is filed within the time set, the opposition may be decided as in case of default.

(b)(1) An answer shall state in short and plain terms the applicant's defenses to each claim asserted and shall admit or deny the averments upon which the opposer relies. If the applicant is without knowledge or information sufficient to form a belief as to the truth of an averment, applicant shall so state and this will have the effect of a denial. Denials may take any of the forms specified in Rule 8(b) of the Federal Rules of Civil Procedure. An answer may contain any defense, including the affirmative defenses of unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior judgment, or any other matter constituting an avoidance or affirmative defense. When pleading special matters, the Federal Rules of Civil Procedure shall be followed. A reply to an affirmative defense need not be filed. When a defense attacks the validity of a registration pleaded in the opposition, paragraph (b)(2) of this section shall govern. A pleaded

registration is a registration identified by number and date of issuance in an original notice of opposition or in any amendment thereto made under Rule 15, Federal Rules of Civil Procedure.

(2)(i) A defense attacking the validity of any one or more of the registrations pleaded in the opposition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to the applicant when the answer to the opposition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the opposition proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned. A counterclaim need not be filed if it is the subject of another proceeding between the same parties or anyone in privity therewith.

(ii) An attack on the validity of a registration pleaded by an opposer will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration.

(iii) The provisions of §§ 2.111 through 2.115, inclusive, shall be applicable to counterclaims. A time, not less than thirty days, will be designated within which an answer to the counterclaim must be filed.

(iv) The times for pleading, discovery, testimony, briefs or oral argument will be reset or extended when necessary, upon motion by a party, to enable a party fully to present or meet a counterclaim or separate petition for cancellation of a registration.

(c) The opposition may be withdrawn without prejudice before the answer is filed. After the answer is filed, the opposition may not be withdrawn without prejudice except with the written consent of the applicant or the applicant's attorney or other authorized representative.

[30 FR 13193, Oct. 16, 1965, as amended at 46 FR 6940, Jan. 22, 1981; 48 FR 23136, May 23, 1983; 54 FR 34987, Aug. 22, 1989]

§ 2.107 Amendment of pleadings in an opposition proceeding.

(a) Pleadings in an opposition proceeding against an application filed under section 1 or 44 of the Act may be amended in the same manner and to the same extent as in a civil action in a United States district court, except that, after the close of the time period for filing an opposition including any extension of time for filing an opposition, an opposition may not be amended to add to the goods or services opposed.

(b) Pleadings in an opposition proceeding against an application filed under section 66(a) of the Act may be amended in the same manner and to the same extent as in a civil action in a United States district court, except that, once filed, the opposition may not be amended to add to the grounds for opposition or to add to the goods or services subject to opposition.

[48 FR 23136, May 1983; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003]

CANCELLATION

§ 2.111 Filing petition for cancellation.

(a) A cancellation proceeding is commenced by filing in the Office a timely petition for cancellation with the required fee. The petition must include proof of service on the owner of record for the registration, or the owner's domestic representative of record, at the correspondence address of record in the Office, as detailed in §§ 2.111(b) and 2.119.

(b) Any person who believes that he, she or it is or will be damaged by a registration may file a petition, addressed to the Trademark Trial and Appeal Board, for cancellation of the registration in whole or in part. Petitioner must serve a copy of the petition, including any exhibits, on the owner of record for the registration, or on the owner's domestic representative of record, if one has been appointed, at the correspondence address of record in the Office. The petitioner must include

with the petition for cancellation proof of service, pursuant to § 2.119, on the owner of record, or on the owner's domestic representative of record, if one has been appointed, at the correspondence address of record in the Office. If any service copy of the petition for cancellation is returned to the petitioner as undeliverable, the petitioner must notify the Board within ten days of receipt of the returned copy. The petition for cancellation need not be verified, but must be signed by the petitioner or the petitioner's attorney, as specified in § 11.1 of this chapter, or other authorized representative, as specified in § 11.14(b) of this chapter. Electronic signatures pursuant to § 2.193(c) are required for petitions submitted electronically via ESTTA. The petition for cancellation may be filed at any time in the case of registrations on the Supplemental Register or under the Act of 1920, or registrations under the Act of 1881 or the Act of 1905 which have not been published under section 12(c) of the Act, or on any ground specified in section 14(3) or (5) of the Act. In all other cases, the petition for cancellation and the required fee must be filed within five years from the date of registration of the mark under the Act or from the date of publication under section 12(c) of the Act.

(c)(1) The petition for cancellation must be accompanied by the required fee for each party joined as petitioner for each class in the registration for which cancellation is sought (see § 2.6).

(2) An otherwise timely petition for cancellation will not be accepted via ESTTA unless the petition for cancellation is accompanied by a fee that is sufficient to pay in full for each named party petitioner to petition for cancellation of the registration of a mark in each class specified in the petition for cancellation.

(3) If an otherwise timely petition for cancellation is submitted on paper, the following is applicable if less than all required fees are submitted:

(i) If the petition for cancellation is accompanied by no fee or a fee insufficient to pay for one person to petition for cancellation against at least one class in the registration, the petition for cancellation will be refused.

(ii) If the petition for cancellation is accompanied by fees sufficient to pay for one person to petition for cancellation against at least one class in the registration, but fees are insufficient for a petition for cancellation against all the classes in the registration, and the particular class or classes against which the petition for cancellation is filed is not specified, the petition for cancellation will be presumed to be against the class or classes in ascending numerical order, including only the number of classes in the registration for which sufficient fees have been submitted.

(iii) If persons are joined as party petitioners, each must submit a fee for each class for which cancellation is sought. If the fees submitted are sufficient to pay for one person to petition for cancellation of the registration in at least one class but are insufficient for each named party petitioner, the first-named party will be presumed to be the party petitioner. Additional parties will be deemed to be party petitioners only to the extent that the fees submitted are sufficient to pay the fee due for each party petitioner. If persons are joined as party petitioners against a multiple class registration, the fees submitted are insufficient, and no specification of parties and classes is made at the time the party is joined, the fees submitted will be applied first on behalf of the first-named petitioner against as many of the classes in the registration as the submitted fees are sufficient to pay. Any excess will be applied on behalf of the second-named party to the cancellation against the classes in the registration in ascending numerical order.

(4) The filing date of a petition for cancellation is the date of receipt in the Office of the petition for cancellation, with proof of service on the owner of record, or on the owner's domestic representative, if one has been appointed, at the correspondence address of record in the Office, and with the required fee, unless the petition is filed in accordance with § 2.198.

[48 FR 3976, Jan. 28, 1983; 54 FR 37596, Sept. 11, 1989; 63 FR 48081, Sept. 9, 1998, effective Oct. 9, 1998; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 72 FR 42242, Aug. 1, 2007, effective Nov. 1, 2007; 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008; 74 FR 54898, Oct. 26, 2009, effective Dec. 28, 2009]

§ 2.112 Contents of petition for cancellation.

(a) The petition for cancellation must set forth a short and plain statement showing why the petitioner believes he, she or it is or will be damaged by the registration, state the ground for cancellation, and indicate, to the best of petitioner's knowledge, the name and address of the current owner of the registration.

(b) When appropriate, petitions for cancellation of different registrations owned by the same party may be joined in a consolidated petition for cancellation. The required fee must be included for each party joined as a petitioner for each class sought to be cancelled in each registration against which the petition for cancellation is filed.

[48 FR 3997, Jan. 28, 1983, as amended at 51 FR 28710, Aug. 11, 1986; 54 FR 34897, Aug. 22, 1989; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003]

§ 2.113 Notification of cancellation proceeding.

(a) When a petition for cancellation in proper form (see §§ 2.111 and 2.112), with proof of service in accordance with § 2.111(b), has been filed and the correct fee has been submitted, the Trademark Trial and Appeal Board shall prepare a notification which shall identify the title and number of the proceeding and the registration(s) involved and shall designate a time, not less than thirty days from the mailing date of the notification, within which an answer must be filed. If a party has provided the Office with an e-mail address, the notification may be transmitted via e-mail.

(b) The Board shall forward a copy of the notification to petitioner, as follows:

(1) If the petition for cancellation is transmitted by an attorney, or a written power of attorney is filed, the Board will send the notification to the attorney transmitting the petition for cancellation or to the attorney designated in the power of attorney, provided that person is an “attorney” as defined in § 11.1 of this chapter.

(2) If petitioner is not represented by an attorney in the cancellation proceeding, but petitioner has appointed a domestic representative, the Board will send the notification to the domestic representative, unless petitioner designates in writing another correspondence address.

(3) If petitioner is not represented by an attorney in the cancellation proceeding, and no domestic representative has been appointed, the Board will send the notification directly to petitioner, unless petitioner designates in writing another correspondence address.

(c) The Board shall forward a copy of the notification to the respondent (see § 2.118). The respondent shall be the party shown by the records of the Office to be the current owner of the registration(s) sought to be cancelled, except that the Board, in its discretion, may join or substitute as respondent a party who makes a showing of a current ownership interest in such registration(s).

(d) When the party alleged by the petitioner, pursuant to § 2.112(a), as the current owner of the registration(s) is not the record owner, a courtesy copy of the petition for cancellation shall be forwarded with a copy of the notification to the alleged current owner. The alleged current owner may file a motion to be joined or substituted as respondent.

[48 FR 23136, May 23, 1983; 48 FR 27225, June 14, 1983, as amended at 54 FR 34897, Aug. 22, 1989; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 72 FR 42242, Aug. 1, 2007, effective Nov. 1, 2007; 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 2.114 Answer.

(a) If no answer is filed within the time set, the petition may be decided as in case of default.

(b)(1) An answer shall state in short and plain terms the respondent’s defenses to each claim asserted and shall admit or deny the averments upon which the petitioner relies. If the

respondent is without knowledge or information sufficient to form a belief as to the truth of an averment, respondent shall so state and this will have the effect of a denial. Denials may take any of the forms specified in Rule 8(b) of the Federal Rules of Civil Procedure. An answer may contain any defense, including the affirmative defenses of unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior judgment, or any other matter constituting an avoidance or affirmative defense. When pleading special matters, the Federal Rules of Civil Procedure shall be followed. A reply to an affirmative defense need not be filed. When a defense attacks the validity of a registration pleaded in the petition, paragraph (b)(2) of this section shall govern. A pleaded registration is a registration identified by number and date of issuance in an original petition for cancellation or in any amendment thereto made under Rule 15, Federal Rules of Civil Procedure.

(2)(i) A defense attacking the validity of any one or more of the registrations pleaded in the petition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to respondent when the answer to the petition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the cancellation proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned. A counterclaim need not be filed if it is the subject of another proceeding between the same parties or anyone in privity therewith.

(ii) An attack on the validity of a registration pleaded by a petitioner for cancellation will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration.

(iii) The provisions of §§ 2.111 through 2.115, inclusive, shall be applicable to counterclaims. A time, not less than thirty days, will be designated within which an answer to the counterclaim must be filed.

(iv) The times for pleading, discovery, testimony, briefs, or oral argument will be reset or extended when necessary, upon motion by a party, to enable a party fully to present or meet a counterclaim or separate petition for cancellation of a registration.

(c) The petition for cancellation may be withdrawn without prejudice before the answer is filed. After the answer is filed, the petition may not be withdrawn without prejudice except with the written consent of the registrant or the registrant's attorney or other authorized representative.

[30 FR 13193, Oct. 16, 1965, as amended at 46 FR 6940, Jan. 22, 1981; 46 FR 11548, Feb. 9, 1981; 51 FR 28710, Aug. 11, 1986; 54 FR 34898, Aug. 22, 1989]

§ 2.115 Amendment of pleadings in a cancellation proceeding.

Pleadings in a cancellation proceeding may be amended in the same manner and to the same extent as in a civil action in a United States district court.

[48 FR 23136, May 23, 1983]

PROCEDURE IN INTER PARTES PROCEEDINGS

§ 2.116 Federal Rules of Civil Procedure.

(a) Except as otherwise provided, and wherever applicable and appropriate, procedure and practice in inter partes proceedings shall be governed by the Federal Rules of Civil Procedure.

(b) The opposer in an opposition proceeding or the petitioner in a cancellation proceeding shall be in the position of plaintiff, and the applicant in an opposition proceeding or the respondent in a cancellation proceeding shall be in the position of defendant. A party that is a junior party in an interference proceeding or in a concurrent use registration proceeding shall be in the position of plaintiff against every party that is senior, and the party that is a senior party in an interference

proceeding or in a concurrent use registration proceeding shall be a defendant against every party that is junior.

(c) The opposition or the petition for cancellation and the answer correspond to the complaint and answer in a court proceeding.

(d) The assignment of testimony periods corresponds to setting a case for trial in court proceedings.

(e) The taking of depositions during the assigned testimony periods corresponds to the trial in court proceedings.

(f) Oral hearing corresponds to oral summation in court proceedings.

(g) The Trademark Trial and Appeal Board's standard protective order is applicable during disclosure, discovery and at trial in all opposition, cancellation, interference and concurrent use registration proceedings, unless the parties, by stipulation approved by the Board, agree to an alternative order, or a motion by a party to use an alternative order is granted by the Board. The standard protective order is available at the Office's Web site, or upon request, a copy will be provided. No material disclosed or produced by a party, presented at trial, or filed with the Board, including motions or briefs which discuss such material, shall be treated as confidential or shielded from public view unless designated as protected under the Board's standard protective order, or under an alternative order stipulated to by the parties and approved by the Board, or under an order submitted by motion of a party granted by the Board.

[30 FR 13193, Oct. 16, 1965. Redesignated and amended at 37 FR 7606, Apr. 18, 1972, as amended at 48 FR 23136, May 23, 1983; 72 FR 42242, Aug. 1, 2007, effective Aug. 31, 2007]

§ 2.117 Suspension of proceedings.

(a) Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

(b) Whenever there is pending before the Board both a motion to suspend and a motion which is potentially dispositive of the case, the potentially dispositive motion may be decided before the question of suspension is considered regardless of the order in which the motions were filed.

(c) Proceedings may also be suspended, for good cause, upon motion or a stipulation of the parties approved by the Board.

[48 FR 23136, May 23, 1983; 63 FR 48081, Sept. 9, 1998, effective Oct. 9, 1998]

§ 2.118 Undelivered Office notices.

When a notice sent by the Office to any registrant or applicant is returned to the Office undelivered, additional notice may be given by publication in the Official Gazette for the period of time prescribed by the Director.

[68 FR 14332, March 25, 2003, effective May 1, 2003; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 72 FR 42242, Aug. 1, 2007, effective Aug. 31, 2007]

§ 2.119 Service and signing of papers.

(a) Every paper filed in the United States Patent and Trademark Office in inter partes cases, including notices of appeal, must be served upon the other parties. Proof of such service must be made before the paper will be considered by the Office. A statement signed by the attorney or other authorized representative, attached to or appearing on the original paper when filed, clearly

stating the date and manner in which service was made will be accepted as prima facie proof of service.

(b) Service of papers must be on the attorney or other authorized representative of the party if there be such or on the party if there is no attorney or other authorized representative, and may be made in any of the following ways:

(1) By delivering a copy of the paper to the person served;

(2) By leaving a copy at the usual place of business of the person served, with someone in the person's employment;

(3) When the person served has no usual place of business, by leaving a copy at the person's residence, with a member of the person's family over 14 years of age and of discretion;

(4) Transmission by the "Express Mail Post Office to Addressee" service of the United States Postal Service or by first-class mail, which may also be certified or registered;

(5) Transmission by overnight courier.

(6) Electronic transmission when mutually agreed upon by the parties.

Whenever it shall be satisfactorily shown to the Director that none of the above modes of obtaining service or serving the paper is practicable, service may be by notice published in the *Official Gazette.*

(c) When service is made by first-class mail, "Express Mail," or overnight courier, the date of mailing or of delivery to the overnight courier will be considered the date of service. Whenever a party is required to take some action within a prescribed period after the service of a paper upon the party by another party and the paper is served by first-class mail, "Express Mail," or overnight courier, 5 days shall be added to the prescribed period.

(d) If a party to an inter partes proceeding is not domiciled in the United States and is not represented by an attorney or other authorized representative located in the United States, the party may designate by document filed in the United States Patent and Trademark Office the name and address of a person residing in the United States on whom may be served notices or process in the proceeding. If the party has appointed a domestic representative, official communications of the United States Patent and Trademark Office will be addressed to the domestic representative unless the proceeding is being prosecuted by an attorney at law or other qualified person duly authorized under § 11.14(c) of this subchapter. If the party has not appointed a domestic representative and the proceeding is not being prosecuted by an attorney at law or other qualified person, the Office will send correspondence directly to the party, unless the party designates in writing another address to which correspondence is to be sent. The mere designation of a domestic representative does not authorize the person designated to prosecute the proceeding unless qualified under § 11.14(a), or qualified under § 11.14(b) and authorized under § 2.17(f).

(e) Every paper filed in an inter partes proceeding, and every request for an extension of time to file an opposition, must be signed by the party filing it, or by the party's attorney or other authorized representative, but an unsigned paper will not be refused consideration if a signed copy is submitted to the Patent and Trademark Office within the time limit set in the notification of this defect by the Office.

[37 FR 7606, Apr. 18, 1972, as amended at 41 FR 760, Jan. 5, 1976; 54 FR 34898, Aug. 22, 1989; 63 FR 48081, Sept. 9, 1998, effective Oct. 9, 1998; 67 FR 79520, Dec. 30, 2002; 68 FR 14332, March 25, 2003, effective May 1, 2003; 72 FR 42242, Aug. 1, 2007, effective Nov. 1, 2007; 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008; 74 FR 54898, Oct. 26, 2009, effective Dec. 28, 2009]

§ 2.120 Discovery.

(a) *In general*. (1) Wherever appropriate, the provisions of the Federal Rules of Civil Procedure relating to disclosure and discovery shall apply in opposition, cancellation, interference and concurrent use registration proceedings except as otherwise provided in this section. The provisions of Federal Rule of Civil Procedure 26 relating to required disclosures, the conference of

the parties to discuss settlement and to develop a disclosure and discovery plan, the scope, timing and sequence of discovery, protective orders, signing of disclosures and discovery responses, and supplementation of disclosures and discovery responses, are applicable to Board proceedings in modified form, as noted in these rules and as may be detailed in any order instituting an inter partes proceeding or subsequent scheduling order. The Board will specify the deadline for a discovery conference, the opening and closing dates for the taking of discovery, and the deadlines within the discovery period for making initial disclosures and expert disclosure. The trial order setting these deadlines and dates will be included with the notice of institution of the proceeding.

(2) The discovery conference shall occur no later than the opening of the discovery period, and the parties must discuss the subjects set forth in Federal Rule of Civil Procedure 26(f) and any subjects set forth in the Board's institution order. A Board Interlocutory Attorney or Administrative Trademark Judge will participate in the conference upon request of any party made after answer but no later than ten days prior to the deadline for the conference. The participating attorney or judge may expand or reduce the number or nature of subjects to be discussed in the conference as may be deemed appropriate. The discovery period will be set for a period of 180 days. Initial disclosures must be made no later than thirty days after the opening of the discovery period. Disclosure of expert testimony must occur in the manner and sequence provided in Federal Rule of Civil Procedure 26(a)(2), unless alternate directions have been provided by the Board in an institution order or any subsequent order resetting disclosure, discovery or trial dates. If the expert is retained after the deadline for disclosure of expert testimony, the party must promptly file a motion for leave to use expert testimony. Upon disclosure by any party of plans to use expert testimony, whether before or after the deadline for disclosing expert testimony, the Board may issue an order regarding expert discovery and/or set a deadline for any other party to disclose plans to use a rebuttal expert. The parties may stipulate to a shortening of the discovery period. The discovery period may be extended upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a motion for an extension is denied, the discovery period may remain as originally set or as reset. Disclosure deadlines and obligations may be modified upon written stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a stipulation or motion for modification is denied, disclosure deadlines may remain as originally set or reset and obligations may remain unaltered. The parties are not required to prepare or transmit to the Board a written report outlining their discovery conference discussions, unless the parties have agreed to alter disclosure or discovery obligations set forth by these rules or applicable Federal Rules of Civil Procedure, or unless directed to file such a report by a participating Board Interlocutory Attorney or Administrative Trademark Judge.

(3) A party must make its initial disclosures prior to seeking discovery, absent modification of this requirement by a stipulation of the parties approved by the Board, or a motion granted by the Board, or by order of the Board. Discovery depositions must be taken, and interrogatories, requests for production of documents and things, and requests for admission must be served, on or before the closing date of the discovery period as originally set or as reset. Responses to interrogatories, requests for production of documents and things, and requests for admission must be served within thirty days from the date of service of such discovery requests. The time to respond may be extended upon stipulation of the parties, or upon motion granted by the Board, or by order of the Board. The resetting of a party's time to respond to an outstanding request for discovery will not result in the automatic rescheduling of the discovery and/or testimony periods; such dates will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board.

(b) *Discovery deposition within the United States*. The deposition of a natural person shall be taken in the Federal judicial district where the person resides or is regularly employed or at any place on which the parties agree by stipulation. The responsibility rests wholly with the party taking discovery to secure the attendance of a proposed deponent other than a party or anyone who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a

party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure. (See 35 U.S.C. 24.)

(c) *Discovery deposition in foreign countries*. (1) The discovery deposition of a natural person residing in a foreign country who is a party or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, shall, if taken in a foreign country be taken in the manner prescribed by § 2.124 unless the Trademark Trial and Appeal Board, upon motion for good cause, orders or the parties stipulate, that the deposition be taken by oral examination.

(2) Whenever a foreign party is or will be, during a time set for discovery, present within the United States or any territory which is under the control and jurisdiction of the United States, such party may be deposed by oral examination upon notice by the party seeking discovery. Whenever a foreign party has or will have, during a time set for discovery, an officer, director, managing agent, or other person who consents to testify on its behalf, present within the United States or any territory which is under the control and jurisdiction of the United States, such officer, director, managing agent, or other person who consents to testify in its behalf may be deposed by oral examination upon notice by the party seeking discovery. The party seeking discovery may have one or more officers, directors, managing agents, or other persons who consent to testify on behalf of the adverse party, designated under Rule 30(b)(6) of the Federal Rules of Civil Procedure. The deposition of a person under this paragraph shall be taken in the Federal judicial district where the witness resides or is regularly employed, or, if the witness neither resides nor is regularly employed in a Federal judicial district, where the witness is at the time of the deposition. This paragraph does not preclude the taking of a discovery deposition of a foreign party by any other procedure provided by paragraph (c)(1) of this section.

(d) *Interrogatories; request for production.* (1) The total number of written interrogatories which a party may serve upon another party pursuant to Rule 33 of the Federal Rules of Civil Procedure, in a proceeding, shall not exceed seventy-five, counting subparts, except that the Trademark Trial and Appeal Board, in its discretion, may allow additional interrogatories upon motion therefor showing good cause, or upon stipulation of the parties, approved by the Board. A motion for leave to serve additional interrogatories must be filed and granted prior to the service of the proposed additional interrogatories and must be accompanied by a copy of the interrogatories, if any, which have already been served by the moving party, and by a copy of the interrogatories proposed to be served. If a party upon which interrogatories have been served believes that the number of interrogatories exceeds the limitation specified in this paragraph, and is not willing to waive this basis for objection, the party shall, within the time for (and instead of) serving answers and specific objections to the interrogatories, serve a general objection on the ground of their excessive number. If the inquiring party, in turn, files a motion to compel discovery, the motion must be accompanied by a copy of the set(s) of the interrogatories which together are said to exceed the limitation, and must otherwise comply with the requirements of paragraph (e) of this section.

(2) The production of documents and things under the provisions of Rule 34 of the Federal Rules of Civil Procedure will be made at the place where the documents and things are usually kept, or where the parties agree, or where and in the manner which the Trademark Trial and Appeal Board, upon motion, orders.

(e) *Motion for an order to compel disclosure or discovery*. (1) If a party fails to make required initial disclosures or expert testimony disclosure, or fails to designate a person pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, or if a party, or such designated person, or an officer, director or managing agent of a party fails to attend a deposition or fails to answer any question propounded in a discovery deposition, or any interrogatory, or fails to produce and permit the inspection and copying of any document or thing, the party entitled to disclosure or seeking discovery may file a motion to compel disclosure, a designation, or attendance at a deposition, or an answer, or production and an opportunity to inspect and copy. A motion to compel initial disclosures or expert testimony disclosure must be filed prior to the close of the discovery period. A motion to compel discovery must be filed prior to the commencement of

the first testimony period as originally set or as reset. A motion to compel discovery shall include a copy of the request for designation or of the relevant portion of the discovery deposition; or a copy of the interrogatory with any answer or objection that was made; or a copy of the request for production, any proffer of production or objection to production in response to the request, and a list and brief description of the documents or things that were not produced for inspection and copying. A motion to compel initial disclosures, expert testimony disclosure, or discovery must be supported by a written statement from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion but the parties were unable to resolve their differences. If issues raised in the motion are subsequently resolved by agreement of the parties, the moving party should inform the Board in writing of the issues in the motion which no longer require adjudication.

(2) When a party files a motion for an order to compel initial disclosures, expert testimony disclosure, or discovery, the case will be suspended by the Board with respect to all matters not germane to the motion. After the motion is filed and served, no party should file any paper that is not germane to the motion, except as otherwise specified in the Board's suspension order. Nor may any party serve any additional discovery until the period of suspension is lifted or expires by or under order of the Board. The filing of a motion to compel any disclosure or discovery shall not toll the time for a party to comply with any disclosure requirement or to respond to any outstanding discovery requests or to appear for any noticed discovery deposition.

(f) *Motion for a protective order*. Upon motion by a party obligated to make initial disclosures or expert testimony disclosure or from whom discovery is sought, and for good cause, the Trademark Trial and Appeal Board may make any order which justice requires to protect a party from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the types of orders provided by clauses (1) through (8), inclusive, of Rule 26(c) of the Federal Rules of Civil Procedure. If the motion for a protective order is denied in whole or in part, the Board may, on such conditions (other than an award of expenses to the party prevailing on the motion) as are just, order that any party comply with disclosure obligations or provide or permit discovery.

(g) *Sanctions*. (1) If a party fails to participate in the required discovery conference, or if a party fails to comply with an order of the Trademark Trial and Appeal Board relating to disclosure or discovery, including a protective order, the Board may make any appropriate order, including those provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure, except that the Board will not hold any person in contempt or award expenses to any party. The Board may impose against a party any of the sanctions provided in Rule 37(b)(2) in the event that said party or any attorney, agent, or designated witness of that party fails to comply with a protective order made pursuant to Rule 26(c) of the Federal Rules of Civil Procedure. A motion for sanctions against a party for its failure to participate in the required discovery conference must be filed prior to the deadline for any party to make initial disclosures.

(2) If a party fails to make required initial disclosures or expert testimony disclosure, and such party or the party's attorney or other authorized representative informs the party or parties entitled to receive disclosures that required disclosures will not be made, the Board may make any appropriate order, as specified in paragraph (g)(1) of this section. If a party, or an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or 31(a) of the Federal Rules of Civil Procedure to testify on behalf of a party, fails to attend the party's or person's discovery deposition, after being served with proper notice, or fails to provide any response to a set of interrogatories or to a set of requests for production of documents and things, and such party or the party's attorney or other authorized representative informs the party seeking discovery that no response will be made thereto, the Board may make any appropriate order, as specified in paragraph (g)(1) of this section.

(h) *Request for admissions.* (1) Any motion by a party to determine the sufficiency of an answer or objection to a request made by that party for an admission must be filed prior to the commencement of the first testimony period, as originally set or as reset. The motion shall

include a copy of the request for admission and any exhibits thereto and of the answer or objection. The motion must be supported by a written statement from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion and has been unable to reach agreement. If issues raised in the motion are subsequently resolved by agreement of the parties, the moving party should inform the Board in writing of the issues in the motion which no longer require adjudication.

(2) When a party files a motion to determine the sufficiency of an answer or objection to a request for an admission, the case will be suspended by the Board with respect to all matters not germane to the motion. After filing and service of the motion, no party should file any paper that is not germane to the motion, except as otherwise specified in the Board's suspension order. Nor may any party thereafter serve any additional discovery until the period of suspension is lifted or expires by or under order of the Board. The filing of a motion to determine the sufficiency of an answer or objection to a request for admission shall not toll the time for a party to comply with any disclosure requirement or to respond to any outstanding discovery requests or to appear for any noticed discovery deposition.

(i) *Telephone and pretrial conferences*. (1) Whenever it appears to the Trademark Trial and Appeal Board that a stipulation or motion filed in an inter partes proceeding is of such nature that its approval or resolution by correspondence is not practical, the Board may, upon its own initiative or upon request made by one or both of the parties, address the stipulation or resolve the motion by telephone conference.

(2) Whenever it appears to the Trademark Trial and Appeal Board that questions or issues arising during the interlocutory phase of an inter partes proceeding have become so complex that their resolution by correspondence or telephone conference is not practical and that resolution would likely be facilitated by a conference in person of the parties or their attorneys with an Administrative Trademark Judge or an Interlocutory Attorney of the Board, the Board may, upon its own initiative or upon motion made by one or both of the parties, request that the parties or their attorneys, under circumstances which will not result in undue hardship for any party, meet with the Board at its offices for a disclosure, discovery or pretrial conference.

(j) *Use of discovery deposition, answer to interrogatory, admission or written disclosure*. (1) The discovery deposition of a party or of anyone who at the time of taking the deposition was an officer, director or managing agent of a party, or a person designated by a party pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, may be offered in evidence by an adverse party.

(2) Except as provided in paragraph (j)(1) of this section, the discovery deposition of a witness, whether or not a party, shall not be offered in evidence unless the person whose deposition was taken is, during the testimony period of the party offering the deposition, dead; or out of the United States (unless it appears that the absence of the witness was procured by the party offering the deposition); or unable to testify because of age, illness, infirmity, or imprisonment; or cannot be served with a subpoena to compel attendance at a testimonial deposition; or there is a stipulation by the parties; or upon a showing that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used. The use of a discovery deposition by any party under this paragraph will be allowed only by stipulation of the parties approved by the Trademark Trial and Appeal Board, or by order of the Board on motion, which shall be filed at the time of the purported offer of the deposition in evidence, unless the motion is based upon a claim that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used, in which case the motion shall be filed promptly after the circumstances claimed to justify use of the deposition became known.

(3)(i) A discovery deposition, an answer to an interrogatory, an admission to a request for admission, or a written disclosure (but not a disclosed document), which may be offered in evidence under the provisions of paragraph (j) of this section, may be made of record in the case by filing the deposition or any part thereof with any exhibit to the part that is filed, or a copy of the interrogatory and answer thereto with any exhibit made part of the answer, or a copy of the

request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto), or a copy of the written disclosure, together with a notice of reliance. The notice of reliance and the material submitted thereunder should be filed during the testimony period of the party that files the notice of reliance. An objection made at a discovery deposition by a party answering a question subject to the objection will be considered at final hearing.

(ii) A party that has obtained documents from another party through disclosure or under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of § 2.122(e).

(4) If only part of a discovery deposition is submitted and made part of the record by a party, an adverse party may introduce under a notice of reliance any other part of the deposition which should in fairness be considered so as to make not misleading what was offered by the submitting party. A notice of reliance filed by an adverse party must be supported by a written statement explaining why the adverse party needs to rely upon each additional part listed in the adverse party's notice, failing which the Board, in its discretion, may refuse to consider the additional parts.

(5) Written disclosures, an answer to an interrogatory, or an admission to a request for admission, may be submitted and made part of the record only by the receiving or inquiring party except that, if fewer than all of the written disclosures, answers to interrogatories, or fewer than all of the admissions, are offered in evidence by the receiving or inquiring party, the disclosing or responding party may introduce under a notice of reliance any other written disclosures, answers to interrogatories, or any other admissions, which should in fairness be considered so as to make not misleading what was offered by the receiving or inquiring party. The notice of reliance filed by the disclosing or responding party must be supported by a written statement explaining why the disclosing or responding party needs to rely upon each of the additional written disclosures or discovery responses listed in the disclosing or responding party's notice, and absent such statement the Board, in its discretion, may refuse to consider the additional written disclosures or responses.

(6) Paragraph (j) of this section will not be interpreted to preclude reading or use of written disclosures or documents, a discovery deposition, or answer to an interrogatory, or admission as part of the examination or cross-examination of any witness during the testimony period of any party.

(7) When a written disclosure, a discovery deposition, or a part thereof, or an answer to an interrogatory, or an admission, has been made of record by one party in accordance with the provisions of paragraph (j)(3) of this section, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.

(8) Written disclosures or disclosed documents, requests for discovery, responses thereto, and materials or depositions obtained through the disclosure or discovery process should not be filed with the Board, except when submitted with a motion relating to disclosure or discovery, or in support of or in response to a motion for summary judgment, or under a notice of reliance, when permitted, during a party's testimony period.

[48 FR 23136, May 23, 1983, as amended at 54 FR 34899, Aug. 22, 1989; 54 FR 38041, Sept. 14, 1989; 56 FR 46376, Sept. 12, 1991; 63 FR 48081, Sept. 9, 1998; 63 FR 52158, Sept. 30, 1998; 72 FR 42242, Aug. 1, 2007, effective Nov. 1, 2007]

§ 2.121 Assignment of times for taking testimony.

(a) The Trademark Trial and Appeal Board will issue a trial order setting a deadline for each party's required pretrial disclosures and assigning to each party its time for taking testimony. No testimony shall be taken except during the times assigned, unless by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. The deadlines for pretrial disclosures and the testimony periods may be rescheduled by stipulation of

the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a motion to reschedule any pretrial disclosure deadline and/or testimony period is denied, the pretrial disclosure deadline or testimony period and any subsequent remaining periods may remain as set. The resetting of the closing date for discovery will result in the rescheduling of pretrial disclosure deadlines and testimony periods without action by any party.

(b)(1) The Trademark Trial and Appeal Board will schedule a testimony period for the plaintiff to present its case in chief, a testimony period for the defendant to present its case and to meet the case of the plaintiff, and a testimony period for the plaintiff to present evidence in rebuttal.

(2) When there is a counterclaim, or when proceedings have been consolidated and one party is in the position of plaintiff in one of the involved proceedings and in the position of defendant in another of the involved proceedings, or when there is an interference or a concurrent use registration proceeding involving more than two parties, the Board will schedule testimony periods so that each party in the position of plaintiff will have a period for presenting its case in chief against each party in the position of defendant, each party in the position of defendant will have a period for presenting its case and meeting the case of each plaintiff, and each party in the position of plaintiff will have a period for presenting evidence in rebuttal.

(c) A testimony period which is solely for rebuttal will be set for fifteen days. All other testimony periods will be set for thirty days. The periods may be extended by stipulation of the parties approved by the Trademark Trial and Appeal Board, or upon motion granted by the Board, or by order of the Board. If a motion for an extension is denied, the testimony periods may remain as set.

(d) When parties stipulate to the rescheduling of a deadline for pretrial disclosures and subsequent testimony periods or to the rescheduling of the closing date for discovery and the rescheduling of subsequent deadlines for pretrial disclosures and testimony periods, a stipulation presented in the form used in a trial order, signed by the parties, or a motion in said form signed by one party and including a statement that every other party has agreed thereto, shall be submitted to the Board.

(e) A party need not disclose, prior to its testimony period, any notices of reliance it intends to file during its testimony period. However, no later than fifteen days prior to the opening of each testimony period, or on such alternate schedule as may be provided by order of the Board, the party scheduled to present evidence must disclose the name and, if not previously provided, the telephone number and address of each witness from whom it intends to take testimony, or may take testimony if the need arises, general identifying information about the witness, such as relationship to any party, including job title if employed by a party, or, if neither a party nor related to a party, occupation and job title, a general summary or list of subjects on which the witness is expected to testify, and a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness. Pretrial disclosure of a witness under this subsection does not substitute for issuance of a proper notice of examination under § 2.123(c) or § 2.124(b). If a party does not plan to take testimony from any witnesses, it must so state in its pretrial disclosure. When a party fails to make required pretrial disclosures, any adverse party or parties may have remedy by way of a motion to the Board to delay or reset any subsequent pretrial disclosure deadlines and/or testimony periods.

[48 FR 23138, May 23, 1983; 48 FR 27225, June 14, 1983, as amended at 54 FR 34899, Aug. 22, 1989; 63 FR 48081, Sept. 9, 1998, effective Oct. 9, 1998; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 72 FR 42242, Aug. 1, 2007, effective Nov. 1, 2007]

§ 2.122 Matters in evidence.

(a) *Rules of evidence*. The rules of evidence for proceedings before the Trademark Trial and Appeal Board are the Federal Rules of Evidence, the relevant provisions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the provisions of this Part of Title 37 of the Code of Federal Regulations.

(b) *Application files.* (1) The file of each application or registration specified in a notice of interference, of each application or registration specified in the notice of a concurrent use registration proceeding, of the application against which a notice of opposition is filed, or of each registration against which a petition or counterclaim for cancellation is filed forms part of the record of the proceeding without any action by the parties and reference may be made to the file for any relevant and competent purpose.

(2) The allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence. Specimens in the file of an application for registration, or in the file of a registration, are not evidence on behalf of the applicant or registrant unless identified and introduced in evidence as exhibits during the period for the taking of testimony.

(c) *Exhibits to pleadings*. Except as provided in paragraph (d)(1) of this section, an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony.

(d) *Registrations*. (1) A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by an original or photocopy of the registration prepared and issued by the United States Patent and Trademark Office showing both the current status of and current title to the registration, or by a current printout of information from the electronic database records of the USPTO showing the current status and title of the registration. For the cost of a copy of a registration showing status and title, see § 2.6(b)(4).

(2) A registration owned by any party to a proceeding may be made of record in the proceeding by that party by appropriate identification and introduction during the taking of testimony or by filing a notice of reliance, which shall be accompanied by a copy (original or photocopy) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. The notice of reliance shall be filed during the testimony period of the party that files the notice.

(e) *Printed publications and official records*. Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered. The notice shall specify the printed publication (including information sufficient to identify the source and the date of the publication) or the official record and the pages to be read; indicate generally the relevance of the material being offered; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official record of the Patent and Trademark Office need not be certified to be offered in evidence. The notice of reliance shall be filed during the testimony period of the party that files the notice.

(f) *Testimony from other proceedings*. By order of the Trademark Trial and Appeal Board, on motion, testimony taken in another proceeding, or testimony taken in a suit or action in a court, between the same parties or those in privity may be used in a proceeding, so far as relevant and material, subject, however, to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony.

[48 FR 23138, May 23, 1983, as amended at 54 FR 34899, Aug. 22, 1989; 63 FR 48081, Sept. 9, 1998, effective Oct. 9, 1998; 72 FR 42242, Aug. 1, 2007, effective Aug. 31, 2007]

§ 2.123 Trial testimony in inter partes cases.

(a)(1) The testimony of witnesses in inter partes cases may be taken by depositions upon oral examination as provided by this section or by depositions upon written questions as provided by § 2.124. If a party serves notice of the taking of a testimonial deposition upon written questions of a witness who is, or will be at the time of the deposition, present within the United States or any territory which is under the control and jurisdiction of the United States, any adverse party may, within fifteen days from the date of service of the notice, file a motion with the Trademark Trial and Appeal Board, for good cause, for an order that the deposition be taken by oral examination.

(2) A testimonial deposition taken in a foreign country shall be taken by deposition upon written questions as provided by § 2.124, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate.

(b) *Stipulations*. If the parties so stipulate in writing, depositions may be taken before any person authorized to administer oaths, at any place, upon any notice, and in any manner, and when so taken may be used like other depositions. By written agreement of the parties, the testimony of any witness or witnesses of any party, may be submitted in the form of an affidavit by such witness or witnesses. The parties may stipulate in writing what a particular witness would testify to if called, or the facts in the case of any party may be stipulated in writing.

(c) *Notice of examination of witnesses*. Before the depositions of witnesses shall be taken by a party, due notice in writing shall be given to the opposing party or parties, as provided in § 2.119(b), of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and the name and address of each witness to be examined; if the name of a witness is not known, a general description sufficient to identify the witness or the particular class or group to which the witness belongs, together with a satisfactory explanation, may be given instead. Depositions may be noticed for any reasonable time and place in the United States. A deposition may not be noticed for a place in a foreign country except as provided in paragraph (a)(2) of this section. No party shall take depositions in more than one place at the same time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other is not available.

(d) *Persons before whom depositions may be taken*. Depositions may be taken before persons designated by Rule 28 of the Federal Rules of Civil Procedure.

(e) *Examination of witnesses*. (1) Each witness before testifying shall be duly sworn according to law by the officer before whom his deposition is to be taken.

(2) The deposition shall be taken in answer to questions, with the questions and answers recorded in their regular order by the officer, or by some other person (who shall be subject to the provisions of Rule 28 of the Federal Rules of Civil Procedure) in the presence of the officer except when the officer's presence is waived on the record by agreement of the parties. The testimony shall be taken stenographically and transcribed, unless the parties present agree otherwise. In the absence of all opposing parties and their attorneys or other authorized representatives, depositions may be taken in longhand, typewriting, or stenographically. Exhibits which are marked and identified at the deposition will be deemed to have been offered into evidence, without any formal offer thereof, unless the intention of the party marking the exhibits is clearly expressed to the contrary.

(3) Every adverse party shall have full opportunity to cross-examine each witness. If pretrial disclosures or the notice of examination of witnesses served pursuant to paragraph (c) of this section are improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances. A motion to strike the testimony of a witness for lack of proper or adequate pretrial disclosure may seek exclusion of the entire testimony, when there was no pretrial disclosure, or may seek exclusion of that portion of the testimony that was not adequately disclosed in accordance with § 2.121(e). A motion to strike the testimony of a witness

for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.

(4) All objections made at the time of the examination to the qualifications of the officer taking the deposition, or to the manner of taking it, or to the evidence presented, or to the conduct of any party, and any other objection to the proceedings, shall be noted by the officer upon the deposition. Evidence objected to shall be taken subject to the objections.

(5) When the deposition has been transcribed, the deposition shall be carefully read over by the witness or by the officer to him, and shall then be signed by the witness in the presence of any officer authorized to administer oaths unless the reading and the signature be waived on the record by agreement of all parties.

(f) Certification and filing of deposition.

(1) The officer shall annex to the deposition his certificate showing:

(i) Due administration of the oath by the officer to the witness before the commencement of his deposition;

(ii) The name of the person by whom the deposition was taken down, and whether, if not taken down by the officer, it was taken down in his presence;

(iii) The presence or absence of the adverse party;

(iv) The place, day, and hour of commencing and taking the deposition;

(v) The fact that the officer was not disqualified as specified in Rule 28 of the Federal Rules of Civil Procedure.

(2) If any of the foregoing requirements in paragraph (f)(1) of this section are waived, the certificate shall so state. The officer shall sign the certificate and affix thereto his seal of office, if he has such a seal. Unless waived on the record by an agreement, he shall then securely seal in an envelope all the evidence, notices, and paper exhibits, inscribe upon the envelope a certificate giving the number and title of the case, the name of each witness, and the date of sealing. The officer or the party taking the deposition, or its attorney or other authorized representative, shall then promptly forward the package to the address set out in § 2.190. If the weight or bulk of an exhibit shall exclude it from the envelope, it shall, unless waived on the record by agreement of all parties, be authenticated by the officer and transmitted by the officer or the party taking the deposition, or its attorney or other authorized representative, in a separate package marked and addressed as provided in this section.

(g) *Form of deposition*. (1) The pages of each deposition must be numbered consecutively, and the name of the witness plainly and conspicuously written at the top of each page. A deposition must be in written form. The questions propounded to each witness must be consecutively numbered unless the pages have numbered lines. Each question must be followed by its answer.

(2) Exhibits must be numbered or lettered consecutively and each must be marked with the number and title of the case and the name of the party offering the exhibit. Entry and consideration may be refused to improperly marked exhibits.

(3) Each deposition must contain an index of the names of the witnesses, giving the pages where their examination and cross-examination begin, and an index of the exhibits, briefly describing their nature and giving the pages at which they are introduced and offered in evidence.

(h) *Depositions must be filed*. All depositions which are taken must be duly filed in the Patent and Trademark Office. On refusal to file, the Office at its discretion will not further hear or consider the contestant with whom the refusal lies; and the Office may, at its discretion, receive and consider a copy of the withheld deposition, attested by such evidence as is procurable.

(i) *Inspection of depositions*. After the depositions are filed in the Office, they may be inspected by any party to the case, but they cannot be withdrawn for the purpose of printing. They may be printed by someone specially designated by the Office for that purpose, under proper restrictions.

(j) *Effect of errors and irregularities in depositions*: Rule 32(d)(1), (2), and (3)(A) and (B) of the Federal Rules of Civil Procedure shall apply to errors and irregularities in depositions. Notice will not be taken of merely formal or technical objections which shall not appear to have wrought a

substantial injury to the party raising them; and in case of such injury it must be made to appear that the objection was raised at the time specified in said rule.

(k) *Objections to admissibility*: Subject to the provisions of paragraph (j) of this section, objection may be made to receiving in evidence any deposition, or part thereof, or any other evidence, for any reason which would require the exclusion of the evidence from consideration. Objections to the competency of a witness or to the competency, relevancy, or materiality of testimony must be raised at the time specified in Rule 32(d)(3)(A) of the Federal Rules of Civil Procedure. Such objections will not be considered until final hearing.

(l) *Evidence not considered*. Evidence not obtained and filed in compliance with these sections will not be considered.

[27 FR 7606, Apr. 18, 1972, as amended at 41 FR 760, Jan. 5 1976; 48 FR 23139, May 23, 1983; 54 FR 34899, Aug. 22, 1989; 63 FR 48081, Sept. 9, 1998, effective Oct. 9, 1998; 68 FR 14332, March 25, 2003, effective May 1, 2003; 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 72 FR 42242, Aug. 1, 2007, effective Nov. 1, 2007]

§ 2.124 Depositions upon written questions.

(a) A deposition upon written questions may be taken before any person before whom depositions may be taken as provided by Rule 28 of the Federal Rules of Civil Procedure.

(b)(1) A party desiring to take a testimonial deposition upon written questions shall serve notice thereof upon each adverse party within ten days from the opening date of the testimony period of the party who serves the notice. The notice shall state the name and address of the witness. A copy of the notice, but not copies of the questions, shall be filed with the Trademark Trial and Appeal Board.

(2) A party desiring to take a discovery deposition upon written questions shall serve notice thereof upon each adverse party and shall file a copy of the notice, but not copies of the questions, with the Board. The notice shall state the name and address, if known, of the person whose deposition is to be taken. If the name of the person is not known, a general description sufficient to identify him or the particular class or group to which he belongs shall be stated in the notice, and the party from whom the discovery deposition is to be taken shall designate one or more persons to be deposed in the same manner as is provided by Rule 30(b)(6) of the Federal Rules of Civil Procedure.

(c) Every notice given under the provisions of paragraph (b) of this section shall be accompanied by the name or descriptive title of the officer before whom the deposition is to be taken.

(d)(1) Every notice served on any adverse party under the provisions of paragraph (b) of this section shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the deposition. Within twenty days from the date of service of the notice, any adverse party may serve cross questions upon the party who proposes to take the deposition; any party who serves cross questions shall also serve every other adverse party. Within ten days from the date of service of the cross questions, the party who proposes to take the deposition may serve redirect questions on every adverse party. Within ten days from the date of service of the redirect questions, any party who served cross questions may serve recross questions upon the party who proposes to take the deposition; any party who serves recross questions shall also serve every other adverse party. Written objections to questions may be served on a party propounding questions; any party who objects shall serve a copy of the objections on every other adverse party. In response to objections, substitute questions may be served on the objecting party within ten days of the date of service of the objections; substitute questions shall be served on every other adverse party.

(2) Upon motion for good cause by any party, or upon its own initiative, the Trademark Trial and Appeal Board may extend any of the time periods provided by paragraph (d)(1) of this section. Upon receipt of written notice that one or more testimonial depositions are to be taken

upon written questions, the Trademark Trial and Appeal Board shall suspend or reschedule other proceedings in the matter to allow for the orderly completion of the depositions upon written questions.

(e) Within ten days after the last date when questions, objections, or substitute questions may be served, the party who proposes to take the deposition shall mail a copy of the notice and copies of all the questions to the officer designated in the notice; a copy of the notice and of all the questions mailed to the officer shall be served on every adverse party. The officer designated in the notice shall take the testimony of the witness in response to the questions and shall record each answer immediately after the corresponding question. The officer shall then certify the transcript and mail the transcript and exhibits to the party who took the deposition.

(f) The party who took the deposition shall promptly serve a copy of the transcript, copies of documentary exhibits, and duplicates or photographs of physical exhibits on every adverse party. It is the responsibility of the party who takes the deposition to assure that the transcript is correct (see § 2.125(b)). If the deposition is a discovery deposition, it may be made of record as provided by § 2.120(j). If the deposition is a testimonial deposition, the original, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be filed promptly with the Trademark Trial and Appeal Board.

(g) Objections to questions and answers in depositions upon written questions may be considered at final hearing.

[48 FR 23139, May 23, 1983]

§ 2.125 Filing and service of testimony.

(a) One copy of the transcript of testimony taken in accordance with § 2.123, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be served on each adverse party within thirty days after completion of the taking of that testimony. If the transcript with exhibits is not served on each adverse party within thirty days or within an extension of time for the purpose, any adverse party which was not served may have remedy by way of a motion to the Trademark Trial and Appeal Board to reset such adverse party's testimony and/or briefing periods, as may be appropriate. If the deposing party fails to serve a copy of the transcript with exhibits on an adverse party after having been ordered to do so by the Board, the Board, in its discretion, may strike the deposition, or enter judgment as by default against the deposing party, or take any such other action as may be deemed appropriate.

(b) The party who takes testimony is responsible for having all typographical errors in the transcript and all errors of arrangement, indexing and form of the transcript corrected, on notice to each adverse party, prior to the filing of one certified transcript with the Trademark Trial and Appeal Board. The party who takes testimony is responsible for serving on each adverse party one copy of the corrected transcript or, if reasonably feasible, corrected pages to be inserted into the transcript previously served.

(c) One certified transcript and exhibits shall be filed with the Trademark Trial and Appeal Board. Notice of such filing shall be served on each adverse party and a copy of each notice shall be filed with the Board.

(d) Each transcript shall comply with § 2.123(g) with respect to arrangement, indexing and form.

(e) Upon motion by any party, for good cause, the Trademark Trial and Appeal Board may order that any part of a deposition transcript or any exhibits that directly disclose any trade secret or other confidential research, development, or commercial information may be filed under seal and kept confidential under the provisions of § 2.27(e). If any party or any attorney or agent of a party fails to comply with an order made under this paragraph, the Board may impose any of the sanctions authorized by § 2.120(g).

[48 FR 23410, May 23, 1983, as amended at 54 FR 34900, Aug. 22, 1989; 63 FR 48081, Sept. 9, 1998, effective Oct. 9, 1998]

§ 2.126 Form of submissions to the Trademark Trial and Appeal Board.

(a) Submissions may be made to the Trademark Trial and Appeal Board on paper where Board practice or the rules in this part permit. A paper submission, including exhibits and depositions, must meet the following requirements:

(1) A paper submission must be printed in at least 11-point type and double-spaced, with text on one side only of each sheet;

(2) A paper submission must be 8 to 8.5 inches (20.3 to 21.6 cm.) wide and 11 to 11.69 inches (27.9 to 29.7 cm.) long, and contain no tabs or other such devices extending beyond the edges of the paper;

(3) If a paper submission contains dividers, the dividers must not have any extruding tabs or other devices, and must be on the same size and weight paper as the submission;

(4) A paper submission must not be stapled or bound;

(5) All pages of a paper submission must be numbered and exhibits shall be identified in the manner prescribed in § 2.123(g)(2);

(6) Exhibits pertaining to a paper submission must be filed on paper and comply with the requirements for a paper submission.

(b) Submissions may be made to the Trademark Trial and Appeal Board electronically via the Internet where the rules in this part or Board practice permit, according to the parameters established by the Board and published on the web site of the Office. Text in an electronic submission must be in at least 11-point type and double-spaced. Exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission.

(c) To be handled as confidential, submissions to the Trademark Trial and Appeal Board that are confidential in whole or part pursuant to § 2.125(e) must be submitted under a separate cover. Both the submission and its cover must be marked confidential and must identify the case number and the parties. A copy of the submission with the confidential portions redacted must be submitted.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 72 FR 42242, effective Aug. 31, 2007]

§ 2.127 Motions.

(a) Every motion must be submitted in written form and must meet the requirements prescribed in § 2.126. It shall contain a full statement of the grounds, and shall embody or be accompanied by a brief. Except as provided in paragraph (e)(1) of this section, a brief in response to a motion shall be filed within fifteen days from the date of service of the motion unless another time is specified by the Trademark Trial and Appeal Board, or the time is extended by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board. If a motion for an extension is denied, the time for responding to the motion remains as specified under this section, unless otherwise ordered. Except as provided in paragraph (e)(1) of this section, a reply brief, if filed, shall be filed within fifteen days from the date of service of the brief in response to the motion. The time for filing a reply brief will not be extended. The Board will consider no further papers in support of or in opposition to a motion. Neither the brief in support of a motion nor the brief in response to a motion shall exceed twenty-five pages in length in its entirety, including table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary. A reply brief shall not exceed ten pages in length in its entirety. Exhibits submitted in support of or in opposition to a motion are not considered part of the brief for purposes of determining the length of the brief.

When a party fails to file a brief in response to a motion, the Board may treat the motion as conceded. An oral hearing will not be held on a motion except on order by the Board.

(b) Any request for reconsideration or modification of an order or decision issued on a motion must be filed within one month from the date thereof. A brief in response must be filed within 15 days from the date of service of the request.

(c) Interlocutory motions, requests, and other matters not actually or potentially dispositive of a proceeding may be acted upon by a single Administrative Trademark Judge of the Trademark Trial and Appeal Board or by an Interlocutory Attorney of the Board to whom authority so to act has been delegated.

(d) When any party files a motion to dismiss, or a motion for judgment on the pleadings, or a motion for summary judgment, or any other motion which is potentially dispositive of a proceeding, the case will be suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion and no party should file any paper which is not germane to the motion except as otherwise specified in the Board's suspension order. If the case is not disposed of as a result of the motion, proceedings will be resumed pursuant to an order of the Board when the motion is decided.

(e)(1) A party may not file a motion for summary judgment until the party has made its initial disclosures, except for a motion asserting claim or issue preclusion or lack of jurisdiction by the Trademark Trial and Appeal Board. A motion for summary judgment, if filed, should be filed prior to the commencement of the first testimony period, as originally set or as reset, and the Board, in its discretion, may deny as untimely any motion for summary judgment filed thereafter. A motion under Rule 56(f) of the Federal Rules of Civil Procedure, if filed in response to a motion for summary judgment, shall be filed within thirty days from the date of service of the summary judgment motion. The time for filing a motion under Rule 56(f) will not be extended. If no motion under Rule 56(f) is filed, a brief in response to the motion for summary judgment shall be filed within thirty days from the date of service of the motion unless the time is extended by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board. If a motion for an extension is denied, the time for responding to the motion for summary judgment may remain as specified under this section. A reply brief, if filed, shall be filed within fifteen days from the date of service of the brief in response to the motion. The time for filing a reply brief will not be extended. The Board will consider no further papers in support of or in opposition to a motion for summary judgment.

(2) For purposes of summary judgment only, the Board will consider any of the following, if a copy is provided with the party's brief on the summary judgment motion: written disclosures or disclosed documents, a discovery deposition or any part thereof with any exhibit to the part that is filed, an interrogatory and answer thereto with any exhibit made part of the answer, a request for production and the documents or things produced in response thereto, or a request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto).

(f) The Board will not hold any person in contempt, or award attorneys' fees or other expenses to any party.

[48 FR 23140, May 23, 1983, as amended at 54 FR 34900, Aug. 22, 1989; 63 FR 48081, Sept. 9, 1998; 63 FR 52158, Sept. 30, 1998; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 72 FR 42242, Aug. 1, 2007, effective Nov. 1, 2007]

§ 2.128 Briefs at final hearing.

(a)(1) The brief of the party in the position of plaintiff shall be due not later than sixty days after the date set for the close of rebuttal testimony. The brief of the party in the position of defendant, if filed, shall be due not later than thirty days after the due date of the first brief. A reply brief by the party in the position of plaintiff, if filed, shall be due not later than fifteen days after the due date of the defendant's brief.

(2) When there is a counterclaim, or when proceedings have been consolidated and one party is in the position of plaintiff in one of the involved proceedings and in the position of defendant in another of the involved proceedings, or when there is an interference or a concurrent use registration proceeding involving more than two parties, the Trademark Trial and Appeal Board will set the due dates for the filing of the main brief, and the answering brief, and the rebuttal brief by the parties.

(3) When a party in the position of plaintiff fails to file a main brief, an order may be issued allowing plaintiff until a set time, not less than fifteen days, in which to show cause why the Board should not treat such failure as a concession of the case. If plaintiff fails to file a response to the order, or files a response indicating that he has lost interest in the case, judgment may be entered against plaintiff.

(b) Briefs must be submitted in written form and must meet the requirements prescribed in § 2.126. Each brief shall contain an alphabetical index of cited cases. Without prior leave of the Trademark Trial and Appeal Board, a main brief on the case shall not exceed fifty-five pages in length in its entirety, including the table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary; and a reply brief shall not exceed twenty-five pages in its entirety.

[48 FR 23140, May 23, 1983; 48 FR 27225, June 14, 1983, as amended at 54 34900, Aug. 22, 1989; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003]

§ 2.129 Oral argument; reconsideration.

(a) If a party desires to have an oral argument at final hearing, the party shall request such argument by a separate notice filed not later than ten days after the due date for the filing of the last reply brief in the proceeding. Oral arguments will be heard by at least three Administrative Trademark Judges of the Trademark Trial and Appeal Board at the time specified in the notice of hearing. If any party appears at the specified time, that party will be heard. If the Board is prevented from hearing the case at the specified time, a new hearing date will be set. Unless otherwise permitted, oral arguments in an inter partes case will be limited to thirty minutes for each party. A party in the position of plaintiff may reserve part of the time allowed for oral argument to present a rebuttal argument.

(b) The date or time of a hearing may be reset, so far as is convenient and proper, to meet the wishes of the parties and their attorneys or other authorized representatives.

(c) Any request for rehearing or reconsideration or modification of a decision issued after final hearing must be filed within one month from the date of the decision. A brief in response must be filed within fifteen days from the date of service of the request. The times specified may be extended by order of the Trademark Trial and Appeal Board on motion for good cause.

(d) When a party to an inter partes proceeding before the Trademark Trial and Appeal Board cannot prevail without establishing constructive use pursuant to section 7(c) of the Act in an application under section 1(b) of the Act, the Trademark Trial and Appeal Board will enter a judgment in favor of that party, subject to the party's establishment of constructive use. The time for filing an appeal or for commencing a civil action under section 21 of the Act shall run from the date of the entry of the judgment.

[48 FR 23141, May 23, 1983, as amended at 54 FR 29554, July 13, 1989; 54 FR 34900, Aug. 22, 1989; 54 FR 37597, Sept. 11, 1989; 72 FR 42242, Aug. 1, 2007, effective Aug. 31, 2007]

§ 2.130 New matter suggested by the trademark examining attorney.

If, while an inter partes proceeding involving an application under section 1 or 44 of the Act is pending, facts appear which, in the opinion of the trademark examining attorney, render the mark in the application unregistrable, the facts should be called to the attention of the Trademark Trial

and Appeal Board. The Board may suspend the proceeding and refer the application to the trademark examining attorney for an ex parte determination of the question of registrability. A copy of the trademark examining attorney's final action will be furnished to the parties to the inter partes proceeding following the final determination of registrability by the trademark examining attorney or the Board on appeal. The Board will consider the application for such further inter partes action as may be appropriate.

[Amended 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003]

§ 2.131 Remand after decision in inter partes proceeding.

If, during an inter partes proceeding involving an application under section 1 or 44 of the Act, facts are disclosed which appear to render the mark unregistrable, but such matter has not been tried under the pleadings as filed by the parties or as they might be deemed to be amended under Rule 15(b) of the Federal Rules of Civil Procedure to conform to the evidence, the Trademark Trial and Appeal Board, in lieu of determining the matter in the decision on the proceeding, may remand the application to the trademark examining attorney for reexamination in the event the applicant ultimately prevails in the inter partes proceeding. Upon remand, the trademark examining attorney shall reexamine the application in light of the reference by the Board. If, upon reexamination, the trademark examining attorney finally refuses registration to the applicant, an appeal may be taken as provided by §§ 2.141 and 2.142.

[48 FR 23141, May 23, 1983; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003]

§ 2.132 Involuntary dismissal for failure to take testimony.

(a) If the time for taking testimony by any party in the position of plaintiff has expired and that party has not taken testimony or offered any other evidence, any party in the position of defendant may, without waiving the right to offer evidence in the event the motion is denied, move for dismissal on the ground of the failure of the plaintiff to prosecute. The party in the position of plaintiff shall have fifteen days from the date of service of the motion to show cause why judgment should not be rendered against him. In the absence of a showing of good and sufficient cause, judgment may be rendered against the party in the position of plaintiff. If the motion is denied, testimony periods will be reset for the party in the position of defendant and for rebuttal.

(b) If no evidence other than a copy or copies of Patent and Trademark Office records is offered by any party in the position of plaintiff, any party in the position of defendant may, without waiving the right to offer evidence in the event the motion is denied, move for dismissal on the ground that upon the law and the facts the party in the position of plaintiff has shown no right to relief. The party in the position of plaintiff shall have fifteen days from the date of service of the motion to file a brief in response to the motion. The Trademark Trial and Appeal Board may render judgment against the party in the position of plaintiff, or the Board may decline to render judgment until all of the evidence is in the record. If judgment is not rendered, testimony periods will be reset for the party in the position of defendant and for rebuttal.

(c) A motion filed under paragraph (a) or (b) of this section must be filed before the opening of the testimony period of the moving party, except that the Trademark Trial and Appeal Board may in its discretion grant a motion under paragraph (a) even if the motion was filed after the opening of the testimony period of the moving party.

[48 FR 23141, May 23, 1983, as amended at 51 FR 28710, Aug. 11, 1986]

§ 2.133 Amendment of application or registration during proceedings.

(a) An application subject to an opposition may not be amended in substance nor may a registration subject to a cancellation be amended or disclaimed in part, except with the consent of the other party or parties and the approval of the Trademark Trial and Appeal Board, or upon motion granted by the Board.

(b) If, in an inter partes proceeding, the Trademark Trial and Appeal Board finds that a party whose application or registration is the subject of the proceeding is not entitled to registration in the absence of a specified restriction to the application or registration, the Board will allow the party time in which to file a motion that the application or registration be amended to conform to the findings of the Board, failing which judgment will be entered against the party.

(c) Geographic limitations will be considered and determined by the Trademark Trial and Appeal Board only in the context of a concurrent use registration proceeding.

(d) A plaintiff's pleaded registration will not be restricted in the absence of a counterclaim to cancel the registration in whole or in part, except that a counterclaim need not be filed if the registration is the subject of another proceeding between the same parties or anyone in privity therewith.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37597, Sept. 11, 1989; 72 FR 42242, Aug. 1, 2007, effective Aug. 31, 2007]

§ 2.134 Surrender or voluntary cancellation of registration.

(a) After the commencement of a cancellation proceeding, if the respondent applies for cancellation of the involved registration under section 7(e) of the Act of 1946 without the written consent of every adverse party to the proceeding, judgment shall be entered against the respondent. The written consent of an adverse party may be signed by the adverse party or by the adverse party's attorney or other authorized representative.

(b) After the commencement of a cancellation proceeding, if it comes to the attention of the Trademark Trial and Appeal Board that the respondent has permitted his involved registration to be cancelled under section 8 of the Act of 1946 or has failed to renew his involved registration under section 9 of the Act of 1946, an order may be issued allowing respondent until a set time, not less than fifteen days, in which to show cause why such cancellation or failure to renew should not be deemed to be the equivalent of a cancellation by request of respondent without the consent of the adverse party and should not result in entry of judgment against respondent as provided by paragraph (a) of this section. In the absence of a showing of good and sufficient cause, judgment may be entered against respondent as provided by paragraph (a) of this section.

[48 FR 23141, May 23, 1983, as amended at 54 FR 34900, Aug. 22, 1989; 63 FR 48081, Sept. 9, 1998, effective Oct. 9, 1998]

§ 2.135 Abandonment of application or mark.

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

[48 FR 23141, May 23, 1983, as amended at 54 FR 34900, Aug. 22, 1989]

§ 2.136 Status of application on termination of proceeding.

On termination of a proceeding involving an application, the application, if the judgment is not adverse, returns to the status it had before the institution of the proceedings. If the judgment is adverse to the applicant, the application stands refused without further action and all proceedings thereon are considered terminated.

APPEALS

§ 2.141 Ex parte appeals from action of trademark examining attorney.

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

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

[41 FR 760, Jan. 5, 1976; amended 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.142 Time and manner of ex parte appeals.

(a) Any appeal filed under the provisions of § 2.141 must be filed within six months from the date of the final refusal or the date of the action from which the appeal is taken. An appeal is taken by filing a notice of appeal in written form, as prescribed in § 2.126, and paying the appeal fee.

(b)(1) The brief of appellant shall be filed within sixty days from the date of appeal. If the brief is not filed within the time allowed, the appeal may be dismissed. The examiner shall, within sixty days after the brief of appellant is sent to the examiner, file with the Trademark Trial and Appeal Board a written brief answering the brief of appellant and shall mail a copy of the brief to the appellant. The appellant may file a reply brief within twenty days from the date of mailing of the brief of the examiner.

(2) Briefs must be submitted in written form and must meet the requirements prescribed in § 2.126. Each brief shall contain an alphabetical index of cited cases. Without prior leave of the Trademark Trial and Appeal Board, a brief shall not exceed twenty-five pages in length in its entirety, including the table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary.

(c) All requirements made by the examiner and not the subject of appeal shall be complied with prior to the filing of an appeal.

(d) The record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed. After an appeal is filed, if the appellant or the examiner desires to introduce additional evidence, the appellant or the examiner

may request the Board to suspend the appeal and to remand the application for further examination.

(e)(1) If the appellant desires an oral hearing, a request should be made by a separate notice filed not later than ten days after the due date for a reply brief. Oral argument will be heard by at least three Administrative Trademark Judges of the Trademark Trial and Appeal Board at the time specified in the notice of hearing, which may be reset if the Board is prevented from hearing the argument at the specified time or, so far as is convenient and proper, to meet the wish of the appellant or the appellant's attorney or other authorized representative.

(2) If the appellant requests an oral argument, the examiner who issued the refusal of registration or the requirement from which the appeal is taken, or in lieu thereof another examiner from the same examining division as designated by the supervisory attorney thereof, shall present an oral argument. If no request for an oral hearing is made by the appellant, the appeal will be decided on the record and briefs.

(3) Oral argument will be limited to twenty minutes by the appellant and ten minutes by the examiner. The appellant may reserve part of the time allowed for oral argument to present a rebuttal argument.

(f)(1) If, during an appeal from a refusal of registration, it appears to the Trademark Trial and Appeal Board that an issue not previously raised may render the mark of the appellant unregistrable, the Board may suspend the appeal and remand the application to the examiner for further examination to be completed within thirty days.

(2) If the further examination does not result in an additional ground for refusal of registration, the examiner shall promptly return the application to the Board, for resumption of the appeal, with a written statement that further examination did not result in an additional ground for refusal of registration.

(3) If the further examination does result in an additional ground for refusal of registration, the examiner and appellant shall proceed as provided by §§ 2.61, 2.62, 2.63 and 2.64. If the ground for refusal is made final, the examiner shall return the application to the Board, which shall thereupon issue an order allowing the appellant sixty days from the date of the order to file a supplemental brief limited to the additional ground for the refusal of registration. If the supplemental brief is not filed by the appellant within the time allowed, the appeal may be dismissed.

(4) If the supplemental brief of the appellant is filed, the examiner shall, within sixty days after the supplemental brief of the appellant is sent to the examiner, file with the Board a written brief answering the supplemental brief of appellant and shall mail a copy of the brief to the appellant. The appellant may file a reply brief within twenty days from the date of mailing of the brief of the examiner.

(5) If an oral hearing on the appeal had been requested prior to the remand of the application but not yet held, an oral hearing will be set and heard as provided in paragraph (e) of this section. If an oral hearing had been held prior to the remand or had not been previously requested by the appellant, an oral hearing may be requested by the appellant by a separate notice filed not later than ten days after the due date for a reply brief on the additional ground for refusal of registration. If the appellant files a request for an oral hearing, one will be set and heard as provided in paragraph (e) of this section.

(6) If, during an appeal from a refusal of registration, it appears to the examiner that an issue not involved in the appeal may render the mark of the appellant unregistrable, the examiner may, by written request, ask the Board to suspend the appeal and to remand the application to the examiner for further examination. If the request is granted, the examiner and appellant shall proceed as provided by §§ 2.61, 2.62, 2.63 and 2.64. After the additional ground for refusal of registration has been withdrawn or made final, the examiner shall return the application to the Board, which shall resume proceedings in the appeal and take further appropriate action with respect thereto.

(g) An application which has been considered and decided on appeal will not be reopened except for the entry of a disclaimer under section 6 of the Act of 1946 or upon order of the

Director, but a petition to the Director to reopen an application will be considered only upon a showing of sufficient cause for consideration of any matter not already adjudicated.

[48 FR 23141, May 23, 1983, as amended at 54 FR 34901, Aug. 22, 1989; 68 FR 14332, March 25, 2003, effective May 1, 2003; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 72 FR 42242, Aug. 1, 2007, effective Aug. 31, 2007]

§ 2.144 Reconsideration of decision on ex parte appeal.

Any request for rehearing or reconsideration, or modification of the decision, must be filed within one month from the date of the decision. Such time may be extended by the Trademark Trial and Appeal Board upon a showing of sufficient cause.

[41 FR 760, Jan. 5. 1976, as amended at 54 FR 29554, July 13, 1989]

§ 2.145 Appeal to court and civil action.

(a) *Appeal to U.S. Court of Appeals for the Federal Circuit*. An applicant for registration, or any party to an interference, opposition, or cancellation proceeding or any party to an application to register as a concurrent user, hereinafter referred to as inter partes proceedings, who is dissatisfied with the decision of the Trademark Trial and Appeal Board and any registrant who has filed an affidavit or declaration under section 8 of the Act or who has filed an application for renewal and is dissatisfied with the decision of the Director (§§ 2.165, 2.184), may appeal to the U.S. Court of Appeals for the Federal Circuit. The appellant must take the following steps in such an appeal:

(1) In the Patent and Trademark Office give written notice of appeal to the Director (see paragraphs (b) and (d) of this section);

(2) In the court, file a copy of the notice of appeal and pay the fee for appeal, as provided by the rules of the Court.

(b) *Notice of appeal*. (1) When an appeal is taken to the U.S. Court of Appeals for the Federal Circuit, the appellant shall give notice thereof in writing to the Director, which notice shall be filed in the Patent and Trademark Office, within the time specified in paragraph (d) of this section. The notice shall specify the party or parties taking the appeal and shall designate the decision or part thereof appealed from.

(2) In inter partes proceedings, the notice must be served as provided in § 2.119.

(3) Notices of appeal directed to the Director shall be mailed to or served by hand on the General Counsel, according to part 104 of this chapter, with a duplicate copy mailed or served by hand on the Trademark Trial and Appeal Board.

(c) *Civil action*. (1) Any person who may appeal to the U.S. Court of Appeals for the Federal Circuit (paragraph (a) of this section), may have remedy by civil action under section 21(b) of the Act. Such civil action must be commenced within the time specified in paragraph (d) of this section.

(2) Any applicant or registrant in an ex parte case who takes an appeal to the U.S. Court of Appeals for the Federal Circuit waives any right to proceed under section 21(b) of the Act.

(3) Any adverse party to an appeal taken to the U.S. Court of Appeals for the Federal Circuit by a defeated party in an inter partes proceeding may file a notice with the Office, addressed to the Office of the General Counsel, according to part 104 of this chapter, within twenty days after the filing of the defeated party's notice of appeal to the court (paragraph (b) of this section), electing to have all further proceedings conducted as provided in section 21(b) of the Act. The notice of election must be served as provided in § 2.119.

(4) In order to avoid premature termination of a proceeding, a party who commences a civil action, pursuant to section 21(b) of the Act, must file written notice thereof at the Trademark Trial and Appeal Board.

(d) *Time for appeal or civil action.* (1) The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (paragraph (b) of this section), or for commencing a civil action (paragraph (c) of this section), is two months from the date of the decision of the Trademark Trial and Appeal Board or the Director, as the case may be. If a request for rehearing or reconsideration or modification of the decision is filed within the time specified in §§ 2.127(b), 2.129(c) or 2.144, or within any extension of time granted thereunder, the time for filing an appeal or commencing a civil action shall expire two months after action on the request. In inter partes cases, the time for filing a cross-action or a notice of a cross-appeal expires

(i) 14 days after service of the notice of appeal or the summons and complaint; or

(ii) Two months from the date of the decision of the Trademark Trial and Appeal Board or the Director, whichever is later.

(2) The times specified in this section in days are calendar days. The times specified herein in months are calendar months except that one day shall be added to any two-month period which includes February 28. If the last day of time specified for an appeal, or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday.

(3) If a party to an inter partes proceeding has taken an appeal to the U.S. Court of Appeals for the Federal Circuit and an adverse party has filed notice under section 21(a)(1) of the Act electing to have all further proceedings conducted under section 21(b) of the Act, the time for filing a civil action thereafter is specified in section 21(a)(1) of the Act. The time for filing a cross-action expires 14 days after service of the summons and complaint.

(e) *Extensions of time to commence judicial review*. The Director may extend the time for filing an appeal or commencing a civil action (1) for good cause shown if requested in writing before the expiration of the period for filing an appeal or commencing a civil action, or (2) upon written request after the expiration of the period for filing an appeal or commencing a civil action upon a showing that the failure to act was the result of excusable neglect.

[47 FR 47382, Oct. 26, 1982, as amended at 53 FR 16414, May 9, 1988; 54 FR 29554, July 13, 1989; 54 FR 34901, Aug. 22, 1989; 58 FR 54503, Oct. 22, 1993; 68 FR 14332, March 25, 2003, effective May 1, 2003; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003]

PETITIONS AND ACTION BY THE DIRECTOR

§ 2.146 Petitions to the Director.

(a) Petition may be taken to the Director: (1) From any repeated or final formal requirement of the examiner in the ex parte prosecution of an application if permitted by § 2.63(b); (2) in any case for which the Act of 1946, or Title 35 of the United States Code, or this Part of Title 37 of the Code of Federal Regulations specifies that the matter is to be determined directly or reviewed by the Director; (3) to invoke the supervisory authority of the Director in appropriate circumstances; (4) in any case not specifically defined and provided for by this Part of Title 37 of the Code of Federal Regulations; (5) in an extraordinary situation, when justice requires and no other party is injured thereby, to request a suspension or waiver of any requirement of the rules not being a requirement of the Act of 1946.

(b) Questions of substance arising during the ex parte prosecution of applications, including, but not limited to, questions arising under sections 2, 3, 4, 5, 6 and 23 of the Act of 1946, are not considered to be appropriate subject matter for petitions to the Director.

(c) Every petition to the Director shall include a statement of the facts relevant to the petition, the points to be reviewed, the action or relief requested, and the fee required by § 2.6. Any brief in support of the petition shall be embodied in or accompany the petition. The petition must be signed by the petitioner, someone with legal authority to bind the petitioner (*e.g.,* a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(5). When facts are to be proved

on petition, the petitioner must submit proof in the form of affidavits or declarations in accordance with § 2.20, signed by someone with firsthand knowledge of the facts to be proved, and any exhibits.

(d) A petition must be filed within two months of the date of issuance of the action from which relief is requested, unless a different deadline is specified elsewhere in this chapter.

(e)(1) A petition from the grant or denial of a request for an extension of time to file a notice of opposition must be filed within fifteen days from the date of issuance of the grant or denial of the request. A petition from the grant of a request must be served on the attorney or other authorized representative of the potential opposer, if any, or on the potential opposer. A petition from the denial of a request must be served on the attorney or other authorized representative of the applicant, if any, or on the applicant. Proof of service of the petition must be made as provided by § 2.119. The potential opposer or the applicant, as the case may be, may file a response within fifteen days from the date of service of the petition and must serve a copy of the response on the petitioner, with proof of service as provided by § 2.119. No further document relating to the petition may be filed.

(2) A petition from an interlocutory order of the Trademark Trial and Appeal Board must be filed within thirty days after the date of issuance of the order from which relief is requested. Any brief in response to the petition must be filed, with any supporting exhibits, within fifteen days from the date of service of the petition. Petitions and responses to petitions, and any documents accompanying a petition or response under this subsection must be served on every adverse party pursuant to § 2.119.

(f) An oral hearing will not be held on a petition except when considered necessary by the Director.

(g) The mere filing of a petition to the Director will not act as a stay in any appeal or inter partes proceeding that is pending before the Trademark Trial and Appeal Board nor stay the period for replying to an Office action in an application except when a stay is specifically requested and is granted or when §§ 2.63(b) and 2.65 are applicable to an ex parte application.

(h) Authority to act on petitions, or on any petition, may be delegated by the Director.

(i) Where a petitioner seeks to reactivate an application or registration that was abandoned, cancelled or expired because documents were lost or mishandled, the Director may deny the petition if the petitioner was not diligent in checking the status of the application or registration. To be considered diligent, a petitioner must:

(1) During the pendency of an application, check the status of the application every six months between the filing date of the application and issuance of a registration;

(2) After registration, check the status of the registration every six months from the filing of an affidavit of use or excusable nonuse under section 8 or 71 of the Act, or a renewal application under section 9 of the Act, until the petitioner receives notice that the affidavit or renewal application has been accepted; and

(3) If the status check reveals that the Office has not received a document filed by the petitioner, or that the Office has issued an action or notice that the petitioner has not received, the petitioner must promptly request corrective action.

(j) If the Director denies a petition, the petitioner may request reconsideration, if the petitioner:

(1) Files the request within two months of the date of issuance of the decision denying the petition; and

(2) Pays a second petition fee under § 2.6.

[48 FR 23142, May 23, 1983; 48 FR 27225, June 14, 1983; 63 FR 48081, Sept. 9, 1998, effective Oct. 9, 1998; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 68 FR 14332, March 25, 2003, effective May 1, 2003; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009; 74 FR 54898, Oct. 26, 2009, effective Dec. 28, 2009]

§ 2.148 Director may suspend certain rules.

In an extraordinary situation, when justice requires and no other party is injured thereby, any requirement of the rules in this part not being a requirement of the statute may be suspended or waived by the Director.

[68 FR 14332, March 25, 2003, effective May 1, 2003]

CERTIFICATE

§ 2.151 Certificate.

When the Office determines that a mark is registrable, the Office will issue a certificate stating that the applicant is entitled to registration on the Principal Register or on the Supplemental Register. The certificate will state the application filing date, the act under which the mark is registered, the date of issue, and the number of the registration. A reproduction of the mark and pertinent data from the application will be sent with the certificate. A notice of the requirements of sections 8 and 71 of the Act will accompany the certificate.

[64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003]

PUBLICATION OF MARKS REGISTERED UNDER 1905 ACT

§ 2.153 Publication requirements.

The owner of a mark registered under the provisions of the Trademark Act of 1881 or 1905 may at any time prior to the expiration of the period for which the registration was issued or renewed, upon the payment of the prescribed fee, file an affidavit or declaration in accordance with § 2.20 setting forth those goods or services in the registration on or in connection with which said mark is in use in commerce, and stating that the owner claims the benefits of the Act of 1946. The affidavit or declaration must be signed by a person properly authorized to sign on behalf of the owner under § 2.193(e)(1).

[31 FR 5262, Apr. 1, 1966; amended 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009; 74 FR 54898, Oct. 26, 2009, effective Dec. 28, 2009]

§ 2.154 Publication in Official Gazette.

A notice of the claim of benefits under the Act of 1946 and a reproduction of the mark will then be published in the *Official Gazette* as soon as practicable. The published mark will retain its original registration number.

§ 2.155 Notice of publication.

The Office will send the registrant a notice of publication of the mark and of the requirement for filing the affidavit or declaration required by section 8 of the Act.

[64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999]

§ 2.156 Not subject to opposition; subject to cancellation.

The published mark is not subject to opposition, but is subject to petitions to cancel as specified in § 2.111 and to cancellation for failure to file the affidavit or declaration required by section 8 of the Act.

[64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999]

REREGISTRATION OF MARKS REGISTERED UNDER PRIOR ACTS

§ 2.158 Reregistration of marks registered under Acts of 1881, 1905, and 1920.

Trademarks registered under the Act of 1881, the Act of 1905 or the Act of 1920 may be reregistered under the Act of 1946, either on the Principal Register, if eligible, or on the Supplemental Register, but a new complete application for registration must be filed complying with the rules relating thereto, and such application will be subject to examination and other proceedings in the same manner as other applications filed under the Act of 1946. See § 2.26 for use of old drawing.

CANCELLATION FOR FAILURE TO FILE AFFIDAVIT OR DECLARATION

§ 2.160 Affidavit or declaration of continued use or excusable nonuse required to avoid cancellation of registration.

(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 per class required by section 8(a)(3) of the Act and § 2.6.

(b) For the requirements for the affidavit or declaration, see § 2.161.

[64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; amended 75 FR 35973, June 24, 2010, effective June 24, 2010]

§ 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 under § 2.193(e)(1), attesting to the 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).

(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(a)(3) of the Act, include the grace period surcharge 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 (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 or .pdf format, if transmitted through TEAS.

[41 FR 761, Jan. 5, 1976, as amended at 47 FR 41282, Sept. 17, 1982; 48 FR 3977, Jan. 28, 1983; 54 FR 37597, Sept. 11, 1989; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 67 FR 79520, Dec. 30, 2002; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009; 74 FR 54898, Oct. 26, 2009, effective Dec. 28, 2009; 75 FR 35973, June 24, 2010, effective June 24, 2010]

§ 2.162 Notice to registrant.

When a certificate of registration is originally issued, the Office includes a notice of the requirement for filing the affidavit or declaration of use or excusable nonuse under section 8 of the Act. However the affidavit or declaration must be filed within the time period required by section 8 of the Act even if this notice is not received.

[64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999]

§ 2.163 Acknowledgment of receipt of affidavit or declaration.

The Office will issue a notice as to whether an affidavit or declaration is acceptable, or the reasons for refusal.

(a) If the affidavit or declaration is filed within the time periods set forth in section 8 of the Act, deficiencies may be corrected if the requirements of § 2.164 are met.

(b) A response to the refusal must be filed within six months of the date of issuance of the Office action, or before the end of the filing period set forth in section 8(a) of the Act, whichever is later. The response must be signed by the owner, someone with legal authority to bind the owner (*e.g.,* a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(2).

(c) If no response is filed within this time period, the registration will be cancelled, unless time remains in the grace period under section 8(a)(3) of the Act. If time remains in the grace period, the owner may file a complete new affidavit.

[64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; amended 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009; 74 FR 54898, Oct. 26, 2009, effective Dec. 28, 2009; 75 FR 35973, June 24, 2010, effective June 24, 2010]

§ 2.164 Correcting deficiencies in affidavit or declaration.

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

(1) *Correcting deficiencies in affidavits or declarations timely filed within the periods set forth in sections 8(a)(1) and 8(a)(2) of the Act.* If the affidavit or declaration is timely filed within the relevant filing period set forth in section 8(a)(1) or section 8(a)(2) 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) 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(a)(3) 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) 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, the registration will be cancelled.

[64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; amended 75 FR 35973, June 24, 2010, effective June 24, 2010]

§ 2.165 Petition to Director to review refusal.

(a) A response to the examiner's initial refusal to accept an affidavit or declaration is required before filing a petition to the Director, unless the examiner directs otherwise. See § 2.163(b) for the deadline for responding to an examiner's Office action.

(b) If the examiner maintains the refusal of the affidavit or declaration, the owner may file a petition to the Director to review the action. The petition must be filed within six months of the date of issuance of the action maintaining the refusal, or the Office will cancel the registration and issue a notice of the cancellation.

(c) A decision by the Director is necessary before filing an appeal or commencing a civil action in any court.

[64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; amended 68 FR 14332, March 25, 2003, effective May 1, 2003; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.166 Affidavit of continued use or excusable nonuse combined with renewal application.

An affidavit or declaration under section 8 of the Act and a renewal application under section 9 of the Act may be combined into a single document, provided that the document meets the requirements of both sections 8 and 9 of the Act.

[64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999]

AFFIDAVIT OR DECLARATION UNDER SECTION 15

§ 2.167 Affidavit or declaration under section 15.

The affidavit or declaration in accordance with § 2.20 provided by section 15 of the Act for acquiring incontestability for a mark registered on the Principal Register or a mark registered under the Act of 1881 or 1905 and published under section 12(c) of the Act (§ 2.153) must:

(a) Be verified (sworn to) or supported by a declaration under § 2.20, signed by the owner of the registration or a person properly authorized to sign on behalf of the owner under § 2.193(e)(1);

(b) Identify the certificate of registration by the certificate number and date of registration;

(c) Recite the goods or services stated in the registration on or in connection with which the mark has been in continuous use in commerce for a period of five years after the date of registration or date of publication under section 12(c) of the Act, and is still in use in commerce;

(d) Specify that there has been no final decision adverse to the owner's claim of ownership of such mark for such goods or services, or to the owner's right to register the same or to keep the same on the register;

(e) Specify that there is no proceeding involving said rights pending in the Patent and Trademark Office or in a court and not finally disposed of;

(f) Be filed within one year after the expiration of any five-year period of continuous use following registration or publication under section 12(c). The Office will issue a notice acknowledging receipt of the affidavit or declaration.

(g) Include the required fee for each class to which the affidavit or declaration pertains in the registration. If no fee, or a fee insufficient to cover at least one class, is filed at an appropriate time, the affidavit or declaration will not be refused if the required fee(s) (See § 2.6) are filed in the Patent and Trademark Office within the time limit set forth in the notification of this defect by the Office. If insufficient fees are included to cover all classes in the registration, the particular class or classes to which the affidavit or declaration pertains should be specified.

[30 FR 13193, Oct. 16, 1965, as amended at 47 FR 41282, Sept. 17, 1982; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009; 74 FR 54898, Oct. 26, 2009, effective Dec. 28, 2009]

§ 2.168 Affidavit or declaration under section 15 combined with affidavit or declaration under sections 8 or 71, or with renewal application.

(a) The affidavit or declaration filed under section 15 of the Act may also be used as the affidavit or declaration required by section 8, if the affidavit or declaration meets the requirements of both sections 8 and 15. The affidavit or declaration filed under section 15 of the Act may also be used as the affidavit or declaration required by section 71, if the affidavit or declaration meets the requirements of both sections 71 and 15.

(b) The affidavit or declaration filed under section 15 of the Act may be combined with an application for renewal of a registration under section 9 of the Act, if the requirements of both sections 9 and 15 are met.

[64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; amended 75 FR 35973, June 24, 2010, effective June 24, 2010]

CORRECTION, DISCLAIMER, SURRENDER, ETC.

§ 2.171 New certificate on change of ownership.

(a) *Full change of ownership*. If the ownership of a registered mark changes, the new owner may request that a new certificate of registration be issued in the name of the new owner. The assignment or other document changing title must be recorded in the Office. The request for the new certificate must include the fee required by § 2.6(a)(8) and be signed by the owner of the registration, someone with legal authority to bind the owner (*e.g.,* a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter. In a registered extension of protection, the assignment must be recorded with the International Bureau of the World Intellectual Property Organization before it can be recorded in the Office (*see* § 7.22).

(b) *Partial change of ownership*.

(1) In a registration resulting from an application based on section 1 or section 44 of the Act, if ownership of a registration has changed with respect to some but not all of the goods and/or services, the owner(s) may file a request that the registration be divided into two or more separate registrations. The assignment or other document changing title must be recorded in the Office. The request to divide must include the fee required by § 2.6(a)(8) for each new registration created by the division, and be signed by the owner of the registration, someone with legal authority to bind the owner (*e.g.,* a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with § 2.193(e)(2) of this chapter.

(2)(i) When the International Bureau of the World Intellectual Property Organization notifies the Office that an international registration has been divided as the result of a change of ownership with respect to some but not all of the goods or services, the Office will construe the International Bureau's notice as a request to divide. The Office will record the partial change of ownership in the Assignment Services Branch, and 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.*

(ii) The Office will create a new registration number for the child registration, and enter the information about the new registration in its automated records. The Office will notify the new owner that the new owner must pay the fee required by § 2.6 to obtain a new registration certificate for the child registration. It is not necessary for the new owner to file a separate request to divide.

(iii) The Office will not divide a registered extension of protection unless the International Bureau notifies the Office that the international registration has been divided.

[31 FR 5262, Apr. 1, 1966; 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009; 74 FR 54898, Oct. 26, 2009, effective Dec. 28, 2009]

§ 2.172 Surrender for cancellation.

Upon application by the owner, the Director may permit any registration to be surrendered for cancellation. The application for surrender must be signed by the owner of the registration, someone with legal authority to bind the owner (*e.g.,* a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter. When a registration has more than one class, one or more entire class(es) but fewer than the total number of classes may be surrendered. Deletion of fewer than all the goods or services in a single class constitutes amendment of the registration as to that class (*see* § 2.173), not surrender.

[41 FR 761, Jan. 5, 1976; 68 FR 14332, March 25, 2003, effective May 1, 2003; 69 FR 51362, Aug. 19, 2004, effective Sept. 20, 2004; 74 FR 54898, Oct. 26, 2009, effective Dec. 28, 2009]

§ 2.173 Amendment of registration

(a) *Form of amendment*. The owner of a registration may apply to amend a registration or to disclaim part of the mark in the registration. The owner must submit a written request specifying the amendment or disclaimer. If the registration is involved in an inter partes proceeding before the Trademark Trial and Appeal Board, the request must be filed by appropriate motion to the Board.

(b) *Requirements for request*. A request for amendment or disclaimer must:

(1) Include the fee required by § 2.6;

(2) Be signed by the owner of the registration, someone with legal authority to bind the owner (*e.g.*, a corporate officer or general partner of a partnership), or a practitioner who meets the requirements of § 11.14, and verified or supported by a declaration under § 2.20; and

(3) If the amendment involves a change in the mark: a new specimen showing the mark as used on or in connection with the goods or services; an affidavit or declaration under § 2.20 stating that the specimen was in use in commerce at least as early as the filing date of the amendment; and a new drawing of the amended mark.

(c) *Registration must still contain registrable matter*. The registration as amended must still contain registrable matter, and the mark as amended must be registrable as a whole.

(d) *Amendment may not materially alter the mark*. An amendment or disclaimer must not materially alter the character of the mark.

(e) *Amendment of identification of goods*. No amendment in the identification of goods or services in a registration will be permitted except to restrict the identification or to change it in ways that would not require republication of the mark.

(f) *Conforming amendments may be required*. If the registration includes a disclaimer, description of the mark, or other miscellaneous statement, any request to amend the registration must include a request to make any necessary conforming amendments to the disclaimer, description, or other statement.

(g) *Elimination of disclaimer*. No amendment seeking the elimination of a disclaimer will be permitted, unless deletion of the disclaimed portion of the mark is also sought.

[30 FR 13193, Oct. 16, 1965, as amended at 31 FR 5262, Apr. 1, 1966; 48 FR 23141, May 23, 1983; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 69 FR 51362, Aug. 19, 2004, effective Sept. 20, 2004; 72 FR 42242, Aug. 1, 2007, effective Aug. 31, 2007; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.174 Correction of Office mistake.

Whenever Office records clearly disclose a material mistake in a registration, incurred through the fault of the Office, the Office will issue a certificate of correction stating the fact and nature of the mistake, signed by the Director or by an employee designated by the Director, without charge. Thereafter, the corrected certificate shall have the same effect as if it had been originally issued in the corrected form. In the discretion of the Director, the Office may issue a new certificate of registration without charge.

[68 FR 14332, March 25, 2003, effective May 1, 2003; 69 FR 51362, Aug. 19, 2004, effective Sept. 20, 2004; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.175 Correction of mistake by owner.

(a) Whenever a mistake has been made in a registration and a showing has been made that the mistake occurred in good faith through the fault of the owner, the Director may issue a certificate of correction. In the discretion of the Director, the Office may issue a new certificate upon payment of the required fee, provided that the correction does not involve such changes in the registration as to require republication of the mark.

(b) An application for such action must:

(1) Include the following:

(i) Specification of the mistake for which correction is sought;

(ii) Description of the manner in which it arose; and

(iii) A showing that it occurred in good faith;

(2) Be signed by the owner of the registration, someone with legal authority to bind the owner (*e.g.*, a corporate officer or general partner of a partnership), or a practitioner who meets the requirements of § 11.14 of this chapter, and verified or include a declaration in accordance with § 2.20; and

(3) Be accompanied by the required fee.

[30 FR 13193, Oct. 16, 1965, as amended at 31 FR 5262, Apr. 1, 1966; 68 FR 14332, March 25, 2003, effective May 1, 2003; 69 FR 51362, Aug. 19, 2004, effective Sept. 20, 2004; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.176 Consideration of above matters.

The matters in §§ 2.171 to 2.175 will be considered in the first instance by the Post Registration examiners, except for requests to amend registrations involved in inter partes proceedings before the Trademark Trial and Appeal Board, as specified in § 2.173(a), which shall be considered by the Board. If an action of the examiner is adverse, the owner of the registration may petition the Director to review the action under § 2.146. If the owner does not respond to an adverse action of the examiner within six months of the date of issuance, the matter will be considered abandoned.

[68 FR 14332, March 25, 2003, effective May 1, 2003; 69 FR 51362, Aug. 19, 2004, effective Sept. 20, 2004; 72 FR 42242, Aug. 1, 2007, effective Aug. 31, 2007]

TERM AND RENEWAL

§ 2.181 Term of original registrations and renewals.

(a)(1) Subject to the provisions of section 8 of the Act requiring an affidavit or declaration of continued use or excusable nonuse, registrations issued or renewed prior to November 16, 1989, whether on the Principal Register or on the Supplemental Register, remain in force for twenty years from their date of issue or the date of renewal, and may be further renewed for periods of ten years, unless previously cancelled or surrendered.

(2) Subject to the provisions of section 8 of the Act requiring an affidavit or declaration of continued use or excusable nonuse, registrations issued or renewed on or after November 16, 1989, whether on the Principal Register or on the Supplemental Register, remain in force for ten years from their date of issue or the date of renewal, and may be further renewed for periods of ten years, unless previously cancelled or surrendered.

(b) Registrations issued under the Acts of 1905 and 1881 remain in force for their unexpired terms and may be renewed in the same manner as registrations under the Act of 1946.

(c) Registrations issued under the Act of 1920 cannot be renewed unless renewal is required to support foreign registrations and in such case may be renewed on the Supplemental Register in the same manner as registrations under the Act of 1946.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37597, Sept. 11, 1989; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999]

§ 2.182 Time for filing renewal application.

An application for renewal must be filed within one year before the expiration date of the registration, or within the six-month grace period after the expiration date of the registration. If no renewal application is filed within this period, the registration will expire.

[64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999]

§ 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 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.

(f) Renewals of registrations issued under a prior classification system will be processed on the basis of that system, unless the registration has been amended to adopt international classification pursuant to § 2.85(e)(3).

[30 FR 13193, Oct. 16, 1965, as amended at 31 FR 5262, Apr. 1, 1966; 41 FR 761, Jan. 5, 1976; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 67 FR 79520, Dec. 30, 2002; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.184 Refusal of renewal.

(a) If the renewal application is not acceptable, the Office will issue a notice stating the reason(s) for refusal.

(b)(1) The registrant must file a response to the refusal of renewal within six months of the date of issuance of the Office action, or before the expiration date of the registration, whichever is later. If no response is filed within this time period, the registration will expire, unless time remains in the grace period under section 9(a) of the Act. If time remains in the grace period, the registrant may file a complete new renewal application.

(2) The response must be signed by the registrant, someone with legal authority to bind the registrant (*e.g.*, a corporate officer or general partner of a partnership), or a practitioner who meets the requirements of § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(2).

(c) If the renewal application is not filed within the time periods set forth in section 9(a) of the Act, the registration will expire.

[48 FR 23143, May 23, 1983; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009; 74 FR 54898, Oct. 26, 2009, effective Dec. 28, 2009]

§ 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.

(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.

[64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999]

§ 2.186 Petition to Director to review refusal of renewal.

(a) A response to the examiner's initial refusal of the renewal application is required before filing a petition to the Director, unless the examiner directs otherwise. See § 2.184(b) for the deadline for responding to an examiner's Office action.

(b) If the examiner maintains the refusal of the renewal application, a petition to the Director to review the refusal may be filed. The petition must be filed within six months of the date of issuance of the Office action maintaining the refusal, or the renewal application will be abandoned and the registration will expire.

(c) A decision by the Director is necessary before filing an appeal or commencing a civil action in any court.

[64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 68 FR 14332, March 25, 2003, effective May 1, 2003; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

2.188 [Reserved]

2.189 [Reserved]

§ 2.190 Addresses for trademark correspondence with the United States Patent and Trademark Office.

(a) *Trademark correspondence. In general.* All trademark-related documents filed on paper, except documents sent to the Assignment Services Division for recordation; requests for copies of trademark documents; and certain documents filed under the Madrid Protocol as specified in paragraph (e) of this section, should be addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451. All trademark-related documents may be delivered by hand, during the hours the Office is open to receive correspondence, to the Trademark Assistance Center, James Madison Building--East Wing, Concourse Level, 600 Dulany Street, Alexandria, Virginia 22314.

(b) *Electronic trademark documents*. An applicant may transmit a trademark document through TEAS, at http://www.uspto.gov.

(c) *Trademark Assignments*. Requests to record documents in the Assignment Services Division may be filed through the Office's web site, at http://www.uspto.gov/. Paper documents and cover sheets to be recorded in the Assignment Services Division should be addressed to: Mail Stop Assignment Recordation Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450. See § 3.27 of this chapter.

(d) *Requests for Copies of Trademark Documents*. Copies of trademark documents can be ordered through the Office's web site at http://www.uspto.gov/. Paper requests for certified or uncertified copies of trademark documents should be addressed to: Mail Stop Document Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450.

(e) *Certain Documents Relating to International Applications and Registrations*. International applications under § 7.11, subsequent designations under § 7.21, responses to notices of irregularity under § 7.14, requests to record changes in the International Register under § 7.23 and § 7.24, requests to note replacements under § 7.28, requests for transformation under § 7.31, and petitions to the Director to review an action of the Office's Madrid Processing Unit, when filed by mail, must be mailed to: Madrid Processing Unit, 600 Dulany Street, MDE-7B87, Alexandria, VA 22314-5793.

[Added 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003; amended 69 FR 57181, Sept. 24, 2004, effective Oct. 4, 2004; 69 FR 63320, Nov. 1, 2004; 72 FR 18907, April 16, 2007]

§ 2.191 Business to be transacted in writing.

All business with the Office should be transacted in writing. The personal appearance of applicants or their representatives at the Office is unnecessary. The action of the Office will be based exclusively on the written record. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt. The Office encourages parties to file documents through TEAS wherever possible.

[Added 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003]

§ 2.192 Business to be conducted with decorum and courtesy.

Trademark applicants, registrants, and parties to proceedings before the Trademark Trial and Appeal Board and their attorneys or agents are required to conduct their business with decorum and courtesy. Documents presented in violation of this requirement will be submitted to the Director and will be returned by the Director's direct order. Complaints against trademark examining attorneys and other employees must be made in correspondence separate from other documents.

[Added 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003]

§ 2.193 Trademark correspondence and signature requirements.

(a) *Signature required*. Each piece of correspondence that requires a signature must bear:

(1) A handwritten signature personally signed in permanent ink by the person named as the signatory, or a true copy thereof; or

(2) An electronic signature that meets the requirements of paragraph (c) of this section, personally entered by the person named as the signatory. The Office will accept an electronic signature that meets the requirements of paragraph (c) of this section on correspondence filed on paper, by facsimile transmission (§ 2.195(c)), or through TEAS or ESTTA.

(b) *Copy of original signature.* If a copy, such as a photocopy or facsimile copy of an original signature is filed, the filer should retain the original as evidence of authenticity. If a question of authenticity arises, the Office may require submission of the original.

(c) *Requirements for electronic signature*. A person signing a document electronically must:

(1) Personally enter any combination of letters, numbers, spaces and/or punctuation marks that he or she has adopted as a signature, placed between two forward slash ("/") symbols in the signature block on the electronic submission; or

(2) Sign the verified statement using some other form of electronic signature specified by the Director.

(d) *Signatory must be identified*. The name of the person who signs a document in connection with a trademark application, registration, or proceeding before the Trademark Trial and Appeal Board must be set forth in printed or typed form immediately below or adjacent to the signature, or identified elsewhere in the filing (*e.g.,* in a cover letter or other document that accompanies the filing).

(e) *Proper person to sign*. Documents filed in connection with a trademark application or registration must be signed by a proper person. Unless otherwise specified by law, the following requirements apply:

(1) *Verification of facts*. A verification in support of an application for registration, amendment to an application for registration, allegation of use under § 2.76 or § 2.88, request for extension of time to file a statement of use under § 2.89, or an affidavit under section 8, 12(c), 15, or 71 of the Trademark Act must be sworn to or supported by a declaration under § 2.20, signed by the owner or a person properly authorized to sign on behalf of the owner. A person who is properly authorized to verify facts on behalf of an owner is:

(i) A person with legal authority to bind the owner (*e.g.,* a corporate officer or general partner of a partnership);

(ii) A person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or

(iii) An attorney as defined in § 11.1 of this chapter who has an actual written or verbal power of attorney or an implied power of attorney from the owner.

(2) *Responses, amendments to applications, requests for express abandonment, requests for reconsideration of final actions, and requests to divide*. Responses to Office actions, amendments to applications, requests for express abandonment, requests for reconsideration of final actions, and requests to divide must be signed by the owner of the application or registration,

someone with legal authority to bind the owner (*e.g.* a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the following guidelines:

(i) If the owner is represented by a practitioner qualified to practice before the Office under § 11.14 of this chapter, the practitioner must sign, except where the owner is required to sign the correspondence; or

(ii) If the owner is not represented by a practitioner qualified to practice under § 11.14 of this chapter, the individual owner or someone with legal authority to bind the owner (*e.g.,* a corporate officer or general partner of a partnership) must sign. In the case of joint owners who are not represented by a qualified practitioner, all must sign.

(3) *Powers of attorney and revocations of powers of attorney*. Powers of attorney and revocations of powers of attorney must be signed by the individual applicant, registrant or party to a proceeding pending before the Office, or by someone with legal authority to bind the applicant, registrant, or party (*e.g.,* a corporate officer or general partner of a partnership). In the case of joint applicants, registrants, or parties, all must sign. Once the applicant, registrant or party has designated a qualified practitioner(s), the named practitioner may sign an associate power of attorney appointing another qualified practitioner(s) as an additional person(s) authorized to prosecute the application or registration. If the applicant, registrant, or party revokes the original power of attorney, the revocation discharges any associate power signed by the practitioner whose power has been revoked. If the practitioner who signed an associate power withdraws, the withdrawal discharges any associate power signed by the withdrawing practitioner upon acceptance of the request for withdrawal by the Office.

(4) *Petitions to revive under § 2.66*. A petition to revive under § 2.66 must be signed by someone with firsthand knowledge of the facts regarding unintentional delay.

(5) *Petitions to Director under § 2.146*. A petition to the Director under § 2.146 must be signed by the petitioner, someone with legal authority to bind the petitioner (*e.g.,* a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the following guidelines:

(i) If the petitioner is represented by a practitioner qualified to practice before the Office under § 11.14 of this chapter, the practitioner must sign; or

(ii) If the petitioner is not represented by a practitioner authorized to practice before the Office under § 11.14 of this chapter, the individual petitioner or someone with legal authority to bind the petitioner (*e.g.,* a corporate officer or general partner of a partnership) must sign. In the case of joint petitioners, all must sign.

(6) *Requests for correction, amendment or surrender of registrations*. A request for correction, amendment or surrender of a registration must be signed by the owner of the registration, someone with legal authority to bind the owner (*e.g.,* a corporate officer or general partner of a partnership), or a practitioner qualified to practice before the Office under § 11.14 of this chapter. In the case of joint owners who are not represented by a qualified practitioner, all must sign.

(7) *Renewal applications*. A renewal application must be signed by the registrant or the registrant's representative.

(8) *Designations and revocations of domestic representative*. A designation or revocation of a domestic representative must be signed by the applicant or registrant, someone with legal authority to bind the applicant or registrant (*e.g.,* a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter. In the case of joint applicants or registrants, all must sign.

(9) *Requests to change correspondence address in an application or registration*. A notice of change of correspondence address in an application or registration must be signed by the applicant or registrant, someone with legal authority to bind the applicant or registrant (*e.g.,* a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the following guidelines:

(i) If the applicant or registrant is represented by a practitioner qualified to practice before the Office under § 11.14 of this chapter, the practitioner must sign; or

(ii) If the applicant or registrant is not represented by a practitioner qualified to practice before the Office under § 11.14, the individual applicant or registrant or someone with legal authority to bind the applicant or registrant (*e.g.,* a corporate officer or general partner of a partnership) must sign. In the case of joint applicants or joint registrants, all must sign.

(10) *Cover letters.* A person transmitting paper documents to the Office may sign a cover letter or transmittal letter. The Office neither requires cover letters nor questions the authority of a person who signs a communication that merely transmits paper documents.

(f) *Signature as certification.* The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any document by any person, whether a practitioner or non-practitioner, constitutes a certification under § 11.18(b) of this chapter. Violations of § 11.18(b) of this chapter may jeopardize the validity of the application or registration, and may result in the imposition of sanctions under § 11.18(c) of this chapter. Any practitioner violating § 11.18(b) of this chapter may also be subject to disciplinary action. *See* §§ 10.23(c)(15) and 11.18(d) of this chapter.

(g) *Separate copies for separate files*. (1) Since each file must be complete in itself, a separate copy of every document to be filed in connection with a trademark application, registration, or inter partes proceeding must be furnished for each file to which the document pertains, even though the contents of the documents filed in multiple files may be identical.

(2) Parties should not file duplicate copies of correspondence in a single application, registration, or proceeding file, unless the Office requires the filing of duplicate copies. The Office may dispose of duplicate copies of correspondence.

(h) *Separate documents for separate branches of the Office*. Since different branches or sections of the Office may consider different matters, each distinct subject, inquiry or order must be contained in a separate document to avoid confusion and delay in answering correspondence.

(i) *Certified documents required by statute*. When a statute requires that a document be certified, a copy or facsimile transmission of the certification is not acceptable.

[Added 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003; 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008; 74 FR 54898, Oct. 26, 2009, effective Dec. 28, 2009]

§ 2.194 Identification of trademark application or registration.

(a) No correspondence relating to a trademark application should be filed prior to receipt of the application serial number.

(b) (1) A letter about a trademark application should identify the serial number, the name of the applicant, and the mark.

(2) A letter about a registered trademark should identify the registration number, the name of the registrant, and the mark.

[Added 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003]

§ 2.195 Receipt of trademark correspondence.

(a) *Date of receipt and Express Mail date of deposit*. Trademark correspondence received in the Office is given a filing date as of the date of receipt except as follows:

(1) The Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for correspondence transmitted electronically under paragraph (a)(2) of this section or transmitted by facsimile under paragraph (a)(3) of this section, no correspondence is received in the Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.

(2) Trademark-related correspondence transmitted electronically will be given a filing date as of the date on which the Office receives the transmission.

(3) Correspondence transmitted by facsimile will be given a filing date as of the date on which the complete transmission is received in the Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the filing date will be the next succeeding day that is not a Saturday, Sunday, or Federal holiday within the District of Columbia.

(4) Correspondence filed in accordance with § 2.198 will be given a filing date as of the date of deposit as "Express Mail" with the United States Postal Service.

(b) *Correspondence delivered by hand*. Correspondence may be delivered by hand during hours the Office is open to receive correspondence.

(c) *Facsimile transmission*. Except in the cases enumerated in paragraph (d) of this section, correspondence, including authorizations to charge a deposit account, may be transmitted by facsimile. The receipt date accorded to the correspondence will be the date on which the complete transmission is received in the Office, unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. See § 2.196. To facilitate proper processing, each transmission session should be limited to correspondence to be filed in a single application, registration or proceeding before the Office. The application serial number, registration number, or proceeding number should be entered as a part of the sender's identification on a facsimile cover sheet.

(d) Facsimile transmissions are not permitted and if submitted, will not be accorded a date of receipt, in the following situations:

(1) Applications for registration of marks;

(2) Drawings submitted under § 2.51, § 2.52, § 2.72, or § 2.173;

(3) Correspondence to be filed with the Trademark Trial and Appeal Board, except notices of ex parte appeal;

(4) Requests for cancellation or amendment of a registration under section 7(e) of the Trademark Act; and certificates of registration surrendered for cancellation or amendment under section 7(e) of the Trademark Act; and

(5) Madrid-related correspondence submitted under § 7.11, § 7.21, § 7.14, § 7.23, § 7.24, or § 7.31.

(e) *Interruptions in U.S. Postal Service*. (1) If the Director designates a postal service interruption or emergency within the meaning of 35 U.S.C. 21(a), any person attempting to file correspondence by "Express Mail Post Office to Addressee" service who was unable to deposit the correspondence with the United States Postal Service due to the interruption or emergency may petition the Director to consider such correspondence as filed on a particular date in the Office.

(2) The petition must:

(i) Be filed promptly after the ending of the designated interruption or emergency;

(ii) Include the original correspondence or a copy of the original correspondence; and

(iii) Include a statement that the correspondence would have been deposited with the United States Postal Service on the requested filing date but for the designated interruption or emergency in ''Express Mail'' service; and that the correspondence attached to the petition is the original correspondence or a true copy of the correspondence originally attempted to be deposited as Express Mail on the requested filing date.

(3) Paragraphs (e)(1) and (e)(2) of this section do not apply to correspondence that is excluded from the Express Mail procedure pursuant to § 2.198(a)(1).

[Added 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003; amended 69 FR 57181, Sept. 24, 2004, effective Oct. 4, 2004; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.196 Times for taking action: Expiration on Saturday, Sunday or Federal holiday.

Whenever periods of time are specified in this part in days, calendar days are intended. When the day, or the last day fixed by statute or by regulation under this part for taking any action or paying any fee in the Office falls on a Saturday, Sunday, or Federal holiday within the District of

Columbia, the action may be taken, or the fee paid, on the next succeeding day that is not a Saturday, Sunday, or a Federal holiday.

[Added 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003]

§ 2.197 Certificate of mailing or transmission.

(a) Except in the cases enumerated in paragraph (a)(2) of this section, correspondence required to be filed in the Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

(1) Correspondence will be considered as being timely filed if:

(i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:

(A) Addressed as set out in § 2.190 and deposited with the U.S. Postal Service with sufficient postage as first class mail; or

(B) Transmitted by facsimile to the Office in accordance with § 2.195(c); and

(ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have a reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

(2) The procedure described in paragraph (a)(1) of this section does not apply to:

(i) Applications for the registration of marks under 15 U.S.C. 1051 or 1126; and

(ii) Madrid-related correspondence filed under § 7.11, § 7.21, § 7.14, § 7.23, § 7.24 or § 7.31.

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Office, and an application is abandoned, a registration is cancelled or expired, or a proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence within two months after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and

(3) Includes a statement that attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

(c) The Office may require additional evidence to determine whether the correspondence was timely filed.

[Added 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003; amended 69 FR 57181, Sept. 24, 2004, effective Oct. 4, 2004]

§ 2.198 Filing of correspondence by "Express Mail."

(a)(1) Except for documents listed in paragraphs (a)(1)(i) through (vii) of this section, any correspondence received by the Office that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed with the Office on the date of deposit with the USPS. The Express Mail procedure does not apply to:

(i) Applications for registration of marks;

(ii) Amendments to allege use under section 1(c) of the Act;

(iii) Statements of use under section 1(d) of the Act;

(iv) Requests for extension of time to file a statement of use under section 1(d) of the Act;

(v) Affidavits of continued use under section 8 of the Act;

(vi) Renewal requests under section 9 of the Act; and

(vii) Requests to change or correct addresses.

(2) The date of deposit with USPS is shown by the "date in" on the "Express Mail" label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the date of receipt in the Office as the filing date.

(b) Correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the "Express Mail" mailing label with the "date-in" clearly marked. Persons dealing indirectly with the employees of the USPS (such as by deposit in an "Express Mail" drop box) do so at the risk of not receiving a copy of the "Express Mail" mailing label with the desired "date-in" clearly marked. The paper(s) or fee(s) that constitute the correspondence should also include the "Express Mail" mailing label number thereon. See paragraphs (c), (d) and (e) of this section.

(c) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Director to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other official USPS notation, provided that:

(1) The petition is filed within two months after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing; and

(3) The petition includes a true copy of the "Express Mail" mailing label showing the "date-in," and of any other official notation by the USPS relied upon to show the date of deposit.

(d) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Director to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:

(1) The petition is filed within two months after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) prior to the original mailing; and

(3) The petition includes a showing that establishes, to the satisfaction of the Director, that the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup on the requested filing date. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or evidence that came into being within one business day after the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

(e) If correspondence is properly addressed to the Office pursuant to § 2.190 and deposited with sufficient postage in the "Express Mail Post Office to Addressee" service of the USPS, but not received by the Office, the party who mailed the correspondence may petition the Director to consider such correspondence filed in the Office on the USPS deposit date, provided that:

(1) The petition is filed within two months after the person becomes aware that the Office has no evidence of receipt of the correspondence;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) prior to the original mailing;

(3) The petition includes a copy of the originally deposited paper(s) or fee(s) showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, a copy of the "Express Mail" mailing label showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date

other than the “date-in” on the “Express Mail” mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section that the correspondence was deposited in the “Express Mail Post Office to Addressee” service prior to the last scheduled pickup on the requested filing date; and

(4) The petition includes a statement that establishes, to the satisfaction of the Director, the original deposit of the correspondence and that the copies of the correspondence, the copy of the “Express Mail” mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence, original “Express Mail” mailing label, returned postcard receipt, and official notation entered by the USPS.

(f) The Office may require additional evidence to determine whether the correspondence was deposited as “Express Mail” with the USPS on the date in question.

[Added 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003; 68 FR 56556, Oct. 1, 2003]

§ 2.199 [Reserved]

TRADEMARK RECORDS AND FILES OF THE PATENT AND TRADEMARK OFFICE

§ 2.200 Assignment records open to public inspection.

(a)(1) Separate assignment records are maintained in the Office for patents and trademarks. The assignment records relating to trademark applications and registrations (for assignments recorded on or after January 1, 1955) are open to public inspection at the Office, and copies of those assignment records may be obtained upon request and payment of the fee set forth in § 2.6 of this chapter.

(2) All records of trademark assignments recorded before January 1, 1955, are maintained by the National Archives and Records Administration (NARA). The records are open to public inspection. Certified and uncertified copies of those assignment records are provided by NARA upon request and payment of the fees required by NARA.

(b) An order for a copy of an assignment or other document should identify the reel and frame number where the assignment or document is recorded. If a document is identified without specifying its correct reel and frame, an extra charge as set forth in § 2.6(b)(10) will be made for the time consumed in making a search for such assignment.

[Added 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003]

§ 2.201 Copies and certified copies.

(a) Non-certified copies of trademark registrations and of any trademark records or trademark documents within the jurisdiction of the Office and open to the public, will be furnished by the Office to any person entitled thereto, upon payment of the appropriate fee required by § 2.6.

(b) Certified copies of trademark registrations and of any trademark records or trademark documents within the jurisdiction of the Office and open to the public will be authenticated by the seal of the Office and certified by the Director, or in his or her name attested by an officer of the Office authorized by the Director, upon payment of the fee required by § 2.6.

[Added 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003]

§ 2.202 [Reserved]

§ 2.203 [Reserved]

§ 2.204 [Reserved]

§ 2.205 [Reserved]

FEES AND PAYMENT OF MONEY IN TRADEMARK CASES

§ 2.206 Trademark fees payable in advance.

(a) Trademark fees and charges payable to the Office are required to be paid in advance; that is, at the time of requesting any action by the Office for which a fee or charge is payable.

(b) All fees paid to the Office must be itemized in each individual trademark application or registration file, or trademark proceeding, so that the purpose for which the fees are paid is clear. The Office may return fees that are not itemized as required by this paragraph.

[Added 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003]

§ 2.207 Methods of payment.

(a) All payments of money required in trademark cases, including fees for the processing of international trademark applications and registrations that are paid through the Office, shall be made in U.S. dollars and in the form of a cashier's or certified check, Treasury note, national bank note, or United States Postal Service money order. If sent in any other form, the Office may delay or cancel the credit until collection is made. Checks and money orders must be made payable to the Director of the United States Patent and Trademark Office. (Checks made payable to the Commissioner of Patents and Trademarks will continue to be accepted.) Payments from foreign countries must be payable and immediately negotiable in the United States for the full amount of the fee required. Money sent to the Office by mail will be at the risk of the sender, and letters containing money should be registered with the United States Postal Service.

(b) Payments of money required for trademark fees may also be made by credit card, except for replenishing a deposit account. Payment of a fee by credit card must specify the amount to be charged to the credit card and such other information as is necessary to process the charge, and is subject to collection of the fee. The Office will not accept a general authorization to charge fees to a credit card. If credit card information is provided on a form or document other than a form provided by the Office for the payment of fees by credit card, the Office will not be liable if the credit card number becomes public knowledge.

[Added 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003; amended 69 FR 43751, July 22, 2004]

§ 2.208 Deposit accounts.

(a) For the convenience of attorneys, and the general public in paying any fees due, in ordering copies of records, or services offered by the Office, deposit accounts may be established in the Office upon payment of the fee for establishing a deposit account (§ 2.6(b)(13)). A minimum deposit of $1,000 is required for paying any fees due or in ordering any services offered by the Office. The Office will issue a deposit account statement at the end of each month. A remittance must be made promptly upon receipt of the statement to cover the value of items or

services charged to the account and thus restore the account to its established normal deposit. An amount sufficient to cover all fees, copies, or services requested must always be on deposit. Charges to accounts with insufficient funds will not be accepted. A service charge (§ 2.6(b)(13)) will be assessed for each month that the balance at the end of the month is below $1,000.

(b) A general authorization to charge all fees, or only certain fees to a deposit account containing sufficient funds may be filed in an individual application, either for the entire pendency of the application or with respect to a particular document filed. An authorization to charge a fee to a deposit account will not be considered payment of the fee on the date the authorization to charge the fee is effective as to the particular fee to be charged unless sufficient funds are present in the account to cover the fee.

(c) A deposit account holder may replenish the deposit account by submitting a payment to the Office. A payment to replenish a deposit account must be submitted by one of the methods set forth in paragraphs (c)(1), (c)(2), (c)(3), or (c)(4) of this section.

(1) A payment to replenish a deposit account may be submitted by electronic funds transfer through the Federal Reserve Fedwire System, which requires that the following information be provided to the deposit account holder's bank or financial institution:

(i) Name of the Bank, which is Treas NYC (Treasury New York City);

(ii) Bank Routing Code, which is 021030004;

(iii) United States Patent and Trademark Office account number with the Department of the Treasury, which is 13100001; and

(iv) The deposit account holder's company name and deposit account number.

(2) A payment to replenish a deposit account may be submitted by electronic funds transfer over the Office's Internet Web site (http://www.uspto.gov).

(3) A payment to replenish a deposit account may be addressed to: Director of the United States Patent and Trademark Office, Attn: Deposit Accounts, 2051 Jamieson Avenue, Suite 300, Alexandria, Virginia 22314.

[Added 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003; amended 69 FR 43751, July 22, 2004; 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 2.209 Refunds.

(a) The Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a trademark application, appeal or other trademark filing for which a fee was paid, will not entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested, and will not notify the payor of such amounts. If a party paying a fee or requesting a refund does not provide the banking information necessary for making refunds by electronic funds transfer (31 U.S.C. 3332 and 31 CFR part 208), or instruct the Office that refunds are to be credited to a deposit account, the Director may require such information, or use the banking information on the payment instrument to make a refund. Any refund of a fee paid by credit card will be by a credit to the credit card account to which the fee was charged.

(b) Any request for refund must be filed within two years from the date the fee was paid, except as otherwise provided in this paragraph. If the Office charges a deposit account by an amount other than an amount specifically indicated in an authorization (§ 2.208(b)), any request for refund based upon such charge must be filed within two years from the date of the deposit account statement indicating such charge, and include a copy of that deposit account statement. The time periods set forth in this paragraph are not extendable.

[Added 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003]

37 C.F.R. PART 3—ASSIGNMENT, RECORDING AND RIGHTS OF ASSIGNEE

AUTHORITY: 15 U.S.C. 1123; 35 U.S.C. 2, unless otherwise noted.
SOURCE: 57 FR 29642, July 6, 1992, unless otherwise noted

§ 3.1 Definitions

For purposes of this part, the following definitions shall apply:

Application means a national application for patent, an international patent application that designates the United States of America, or an application to register a trademark under section 1 or 44 of the Trademark Act, 15 U.S.C. 1051 or 15 U.S.C. 1126, unless otherwise indicated.

Assignment means a transfer by a party of all or part of its right, title and interest in a patent, patent application, registered mark or a mark for which an application to register has been filed.

Document means a document which a party requests to be recorded in the Office pursuant to § 3.11 and which affects some interest in an application, patent, or registration.

Office means the United States Patent and Trademark Office.

Recorded document means a document which has been recorded in the Office pursuant to § 3.11.

Registration means a trademark registration issued by the Office.

[69 FR 29865, May 26, 2004, effective June 25, 2004]

DOCUMENTS ELIGIBLE FOR RECORDING

§ 3.11 Documents which will be recorded.

(a) Assignments of applications, patents, and registrations, accompanied by completed cover sheets as specified in §§ 3.28 and 3.31, will be recorded in the Office. Other documents, accompanied by completed cover sheets as specified in §§ 3.28 and 3.31, affecting title to applications, patents, or registrations, will be recorded as provided in this part or at the discretion of the Director.

(b) Executive Order 9424 of February 18, 1944 (9 FR 1959, 3 CFR 1943-1948 Comp., p. 303) requires the several departments and other executive agencies of the Government, including Government-owned or Government-controlled corporations, to forward promptly to the Director for recording all licenses, assignments, or other interests of the Government in or under patents or patent applications. Assignments and other documents affecting title to patents or patent applications and documents not affecting title to patents or patent applications required by Executive Order 9424 to be filed will be recorded as provided in this part.

(c) A joint research agreement or an excerpt of a joint research agreement will also be recorded as provided in this part.

[62 FR 53186, Oct. 10, 1997; 68 FR 14332, March 25, 2003, effective May 1, 2003; 70 FR 1824, Jan. 11, 2005; 70 FR 54267, Sept. 14, 2005]

§ 3.16 Assignability of trademarks prior to filing of an allegation of use statement.

Before an allegation of use under either 15 U.S.C. 1051(c) or 15 U.S.C. 1051(d) is filed, an applicant may only assign an application to register a mark under 15 U.S.C. 1051(b) to a successor to the applicant's business, or portion of the business to which the mark pertains, if that business is ongoing and existing.

[64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999]

REQUIREMENTS FOR RECORDING

§ 3.25 Recording requirements for trademark applications and registrations.

(a) *Documents affecting title*. To record documents affecting title to a trademark application or registration, a legible cover sheet (see § 3.31) and one of the following must be submitted:

(1) A copy of the original document;

(2) A copy of an extract from the document evidencing the effect on title; or

(3) A statement signed by both the party conveying the interest and the party receiving the interest explaining how the conveyance affects title.

(b) *Name changes*. Only a legible cover sheet is required (see § 3.31).

(c) All documents.

(1) *For electronic submissions*: All documents must be submitted as digitized images in Tagged Image File Format (TIFF) or another form as prescribed by the Director. When printed to a paper size of either 21.6 by 27.9 cm (8½ by 11 inches) or 21.0 by 29.7 cm (DIN size A4), a 2.5 cm (one-inch) margin must be present on all sides.

(2) *For paper or facsimile submissions*: All documents should be submitted on white and non-shiny paper that is either 8½ by 11 inches (21.6 by 27.9 cm) or DIN size A4 (21.0 by 29.7 cm) with a one-inch (2.5 cm) margin on all sides in either case. Only one side of each page may be used. The Office will not return recorded documents, so original documents should not be submitted for recording.

[64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 69 FR 29865, May 26,2004, effective June 25, 2004]

§ 3.26 English language requirement.

The Office will accept and record non-English language documents only if accompanied by an English translation signed by the individual making the translation.

[62 FR 53186, Oct. 10, 1997]

§ 3.27 Mailing address for submitting documents to be recorded.

Documents and cover sheets submitted by mail for recordation should be addressed to Mail Stop Assignment Recordation Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450, unless they are filed together with new applications.

[62 FR 53186, Oct. 10, 1997; 65 FR 54604, Sept. 8, 2000; 68 FR 14332, March 25, 2003, effective May 1, 2003; 69 FR 29865, May 26,2004, effective June 25, 2004]

§ 3.28 Requests for recording.

Each document submitted to the Office for recording must include a single cover sheet (as specified in § 3.31) referring either to those patent applications and patents, or to those trademark applications and registrations, against which the document is to be recorded. If a document to be recorded includes interests in, or transactions involving, both patents and trademarks, then separate patent and trademark cover sheets, each accompanied by a copy of the document to be recorded, must be submitted. If a document to be recorded is not accompanied by a completed cover sheet, the document and the incomplete cover sheet will be returned pursuant to § 3.51 for

proper completion, in which case the document and a completed cover sheet should be resubmitted.

[64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005]

COVER SHEET REQUIREMENTS

§ 3.31 Cover sheet content.

(a) Each patent or trademark cover sheet required by § 3.28 must contain:

(1) The name of the party conveying the interest;

(2) The name and address of the party receiving the interest;

(3) A description of the interest conveyed or transaction to be recorded;

(4) Identification of the interests involved:

(i) *For trademark assignments and trademark name changes*: Each trademark registration number and each trademark application number, if known, against which the Office is to record the document. If the trademark application number is not known, a copy of the application or a reproduction of the trademark must be submitted, along with an estimate of the date that the Office received the application; or

(ii) *For any other document affecting title to a trademark or patent application, registration or patent*: Each trademark or patent application number or each trademark registration number or patent against which the document is to be recorded, or an indication that the document is filed together with a patent application;

(5) The name and address of the party to whom correspondence concerning the request to record the document should be mailed;

(6) The date the document was executed;

(7) The signature of the party submitting the document. For an assignment document or name change filed electronically, the person who signs the cover sheet must either:

(i) Place a symbol comprised of letters, numbers, and/or punctuation marks between forward slash marks (e.g. /Thomas O'Malley III/) in the signature block on the electronic submission; or

(ii) Sign the cover sheet using some other form of electronic signature specified by the Director.

(8) For trademark assignments, the entity and citizenship of the party receiving the interest. In addition, if the party receiving the interest is a domestic partnership or domestic joint venture, the cover sheet must set forth the names, legal entities, and national citizenship (or the state or country of organization) of all general partners or active members that compose the partnership or joint venture.

(b) A cover sheet should not refer to both patents and trademarks, since any information, including information about pending patent applications, submitted with a request for recordation of a document against a trademark application or trademark registration will become public record upon recordation.

(c) Each patent cover sheet required by § 3.28 seeking to record a governmental interest as provided by § 3.11(b) must:

(1) Indicate that the document relates to a Government interest; and

(2) Indicate, if applicable, that the document to be recorded is not a document affecting title (see § 3.41(b)).

(d) Each trademark cover sheet required by § 3.28 seeking to record a document against a trademark application or registration should include, in addition to the serial number or registration number of the trademark, identification of the trademark or a description of the trademark, against which the Office is to record the document.

(e) Each patent or trademark cover sheet required by § 3.28 should contain the number of applications, patents or registrations identified in the cover sheet and the total fee.

(f) Each trademark cover sheet should include the citizenship of the party conveying the interest.

(g) The cover sheet required by § 3.28 seeking to record a joint research agreement or an excerpt of a joint research agreement as provided by § 3.11(c) must:

(1) Identify the document as a "joint research agreement" (in the space provided for the description of the interest conveyed or transaction to be recorded if using an Office-provided form);

(2) Indicate the name of the owner of the application or patent (in the space provided for the name and address of the party receiving the interest if using an Office-provided form);

(3) Indicate the name of each other party to the joint research agreement party (in the space provided for the name of the party conveying the interest if using an Office-provided form); and

(4) Indicate the date the joint research agreement was executed.

[62 FR 53186, Oct. 10, 1997; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 67 FR 79520, Dec. 30, 2002; 69 FR 29865, May 26,2004, effective June 25, 2004; 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 3.34 Correction of cover sheet errors.

(a) An error in a cover sheet recorded pursuant to § 3.11 will be corrected only if:

(1) The error is apparent when the cover sheet is compared with the recorded document to which it pertains, and

(2) A corrected cover sheet is filed for recordation.

(b) The corrected cover sheet must be accompanied by a copy of the document originally submitted for recording and by the recording fee as set forth in § 3.41.

[69 FR 29865, May 26,2004, effective June 25, 2004]

FEES

§ 3.41 Recording fees.

(a) All requests to record documents must be accompanied by the appropriate fee. Except as provided in paragraph (b) of this section, a fee is required for each application, patent and registration against which the document is recorded as identified in the cover sheet. The recording fee is set in § 1.21(h) of this chapter for patents and in § 2.6(b)(6) of this chapter for trademarks.

(b) No fee is required for each patent application and patent against which a document required by Executive Order 9424 is to be filed if:

(1) The document does not affect title and is so identified in the cover sheet (see § 3.31(c)(2)); and

(2) The document and cover sheet are either: Faxed or electronically submitted as prescribed by the Director, or mailed to the Office in compliance with § 3.27.

[62 FR 53186, Oct. 10, 1997; 63 FR 48081, Sept. 9, 1998; 63 FR 52158, Sept. 30, 1998; 69 FR 29865, May 26,2004, effective June 25, 2004]

DATE AND EFFECT OF RECORDING

§ 3.51 Recording date.

The date of recording of a document is the date the document meeting the requirements for recording set forth in this part is filed in the Office. A document which does not comply with the identification requirements of § 3.21 will not be recorded. Documents not meeting the other requirements for recording, for example, a document submitted without a completed cover sheet or without the required fee, will be returned for correction to the sender where a correspondence address is available. The returned papers, stamped with the original date of receipt by the Office, will be accompanied by a letter which will indicate that if the returned papers are corrected and resubmitted to the Office within the time specified in the letter, the Office will consider the original date of filing of the papers as the date of recording of the document. The procedure set forth in § 1.8 or § 1.10 of this chapter may be used for resubmissions of returned papers to have the benefit of the date of deposit in the United States Postal Service. If the returned papers are not corrected and resubmitted within the specified period, the date of filing of the corrected papers will be considered to be the date of recording of the document. The specified period to resubmit the returned papers will not be extended.

[62 FR 53186, Oct. 10, 1997]

§ 3.54 Effect of recording.

The recording of a document pursuant to § 3.11 is not a determination by the Office of the validity of the document or the effect that document has on the title to an application, a patent, or a registration. When necessary, the Office will determine what effect a document has, including whether a party has the authority to take an action in a matter pending before the Office.

§ 3.56 Conditional assignments.

Assignments which are made conditional on the performance of certain acts or events, such as the payment of money or other condition subsequent, if recorded in the Office, are regarded as absolute assignments for Office purposes until cancelled with the written consent of all parties or by the decree of a court of competent jurisdiction. The Office does not determine whether such conditions have been fulfilled.

§ 3.58 Governmental registers.

(a) The Office will maintain a Departmental Register to record governmental interests required to be recorded by Executive Order 9424.

This Departmental Register will not be open to public inspection but will be available for examination and inspection by duly authorized representatives of the Government. Governmental interests recorded on the Departmental Register will be available for public inspection as provided in § 1.12.

(b) The Office will maintain a Secret Register to record governmental interests required to be recorded by Executive Order 9424. Any instrument to be recorded will be placed on this Secret Register at the request of the department or agency submitting the same. No information will be given concerning any instrument in such record or register, and no examination or inspection thereof or of the index thereto will be permitted, except on the written authority of the head of the department or agency which submitted the instrument and requested secrecy, and the approval of such authority by the Director. No instrument or record other than the one specified may be examined, and the examination must take place in the presence of a designated official of the Patent and Trademark Office. When the department or agency which submitted an instrument no

longer requires secrecy with respect to that instrument, it must be recorded anew in the Departmental Register.

[Added 62 FR 53186, Oct. 10, 1997, effective Dec. 1, 1997; 68 FR 14332, March 25, 2003, effective May 1, 2003]

DOMESTIC REPRESENTATIVE

§ 3.61 Domestic representative.

If the assignee of a patent, patent application, trademark application or trademark registration is not domiciled in the United States, the assignee may designate a domestic representative in a document filed in the United States Patent and Trademark Office. The designation should state the name and address of a person residing within the United States on whom may be served process or notice of proceedings affecting the application, patent or registration or rights thereunder.

[Amended 67 FR 79520, Dec. 30, 2002]

ACTION TAKEN BY ASSIGNEE

§ 3.71 Prosecution by assignee.

(a) *Patents—conducting of prosecution*. One or more assignees as defined in paragraph (b) of this section may, after becoming of record pursuant to paragraph (c) of this section, conduct prosecution of a national patent application or a reexamination proceeding to the exclusion of either the inventive entity, or the assignee(s) previously entitled to conduct prosecution.

(b) *Patents—Assignee(s) who can prosecute*. The assignee(s) who may conduct either the prosecution of a national application for patent or a reexamination proceeding are:

(1) *A single assignee*. An assignee of the entire right, title and interest in the application or patent being reexamined who is of record, or

(2) *Partial assignee(s) together or with inventor(s)*. All partial assignees, or all partial assignees and inventors who have not assigned their right, title and interest in the application or patent being reexamined, who together own the entire right, title and interest in the application or patent being reexamined. A partial assignee is any assignee of record having less than the entire right, title and interest in the application or patent being reexamined.

(c) *Patents—Becoming of record*. An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.

(d) *Trademarks*. The assignee of a trademark application or registration may prosecute a trademark application, submit documents to maintain a trademark registration, or file papers against a third party in reliance on the assignee's trademark application or registration, to the exclusion of the original applicant or previous assignee. The assignee must establish ownership in compliance with § 3.73(b).

[65 FR 54604, Sept. 8, 2000]

§ 3.73 Establishing right of assignee to take action.

(a) The inventor is presumed to be the owner of a patent application, and any patent that may issue therefrom, unless there is an assignment. The original applicant is presumed to be the owner of a trademark application or registration, unless there is an assignment.

(b)(1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment). For trademark matters only, the documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office. For patent matters only, the submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, e.g., an officer of the assignee.

(c) For patent matters only:

(1) Establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted.

(2) If the submission under this section is by an assignee of less than the entire right, title and interest, such assignee must indicate the extent (by percentage) of its ownership interest, or the Office may refuse to accept the submission as an establishment of ownership.

[62 FR 53186, Oct. 10, 1997; 65 FR 54604, Sept. 8, 2000; 68 FR 14332, March 25, 2003, effective May 1, 2003; 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005]

ISSUANCE TO ASSIGNEE

§ 3.85 Issue of registration to assignee.

The certificate of registration may be issued to the assignee of the applicant, or in a new name of the applicant, provided that the party files a written request in the trademark application by the time the application is being prepared for issuance of the certificate of registration, and the appropriate document is recorded in the Office. If the assignment or name change document has not been recorded in the Office, then the written request must state that the document has been filed for recordation. The address of the assignee must be made of record in the application file.

37 C.F.R. PART 6—CLASSIFICATION OF GOODS AND SERVICES UNDER THE TRADEMARK ACT

AUTHORITY: Secs. 30, 41, 60 Stat. 436, 440; 15 U.S.C. 1112, 1123; 35 U.S.C. 2, unless otherwise noted

CLASSIFICATION OF GOODS AND SERVICES UNDER THE TRADEMARK ACT

§ 6.1 International schedule of classes of goods and services.

GOODS

1. Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.
2. Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.
3. Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.
4. Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting.
5. Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.
6. Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores.
7. Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs.
8. Hand tools and implements (hand-operated); cutlery; side arms; razors.
9. Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.
10. Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials.
11. Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.
12. Vehicles; apparatus for locomotion by land, air or water.
13. Firearms; ammunition and projectiles; explosives; fireworks.
14. Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.
15. Musical instruments.

16. Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks.

17. Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal.

18. Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

19. Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal.

20. Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.

21. Household or kitchen utensils and containers; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

22. Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials.

23. Yarns and threads, for textile use.

24. Textiles and textile goods, not included in other classes; bed and table covers

25. Clothing, footwear, headgear.

26. Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.

27. Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).

28. Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

29. Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.

30. Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

31. Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.

32. Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

33. Alcoholic beverages (except beers).

34. Tobacco; smokers' articles; matches.

SERVICES

35. Advertising; business management; business administration; office functions.

36. Insurance; financial affairs; monetary affairs; real estate affairs.

37. Building construction; repair; installation services.

38. Telecommunications.

39. Transport; packaging and storage of goods; travel arrangement.

40. Treatment of materials.

41. Education; providing of training; entertainment; sporting and cultural activities.

42. Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software.

43. Services for providing food and drink; temporary accommodation.

44. Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.

45. Legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals.

[38 FR 14681, June 4, 1973; 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; 66 FR 48338, Sept. 20, 2001; 72 FR 28610, May 22, 2007]

§ 6.2 Prior U.S. schedule of classes of goods and services.

GOODS

Class	Title
1	Raw or partly prepared materials.
2	Receptacles.
3	Baggage, animal equipments, portfolios, and pocket books.
4	Abrasives and polishing materials.
5	Adhesives.
6	Chemicals and chemical compositions.
7	Cordage.
8	Smokers' articles, not including tobacco products.
9	Explosives, firearms, equipments, and projectiles.
10	Fertilizers.
11	Inks and inking materials.
12	Construction materials.
13	Hardware and plumbing and steamfitting supplies.
14	Metals and metal castings and forgings.
15	Oils and greases.
16	Protective and decorative coatings.
17	Tobacco products.
18	Medicines and pharmaceutical preparations.
19	Vehicles.
20	Linoleum and oiled cloth.
21	Electrical apparatus, machines, and supplies.
22	Games, toys, and sporting goods.
23	Cutlery, machinery, and tools, and parts thereof.
24	Laundry appliances and machines.
25	Locks and safes.
26	Measuring and scientific appliances.
27	Horological instruments.
28	Jewelry and precious-metal ware.
29	Brooms, brushes, and dusters.
30	Crockery, earthenware, and porcelain.
31	Filters and refrigerators.
32	Furniture and upholstery.
33	Glassware
34	Heating, lighting, and ventilating apparatus.
35	Belting, hose, machinery packing, and nonmetallic tires.
36	Musical instruments and supplies.

37 Paper and stationery.
38 Prints and publications.
39 Clothing.
40 Fancy goods, furnishings, and notions.
41 Canes, parasols, and umbrellas.
42 Knitted, netted, and textile fabrics, and substitutes therefor.
43 Thread and yarn.
44 Dental, medical, and surgical appliances.
45 Soft drinks and carbonated waters.
46 Foods and ingredients of foods.
47 Wines.
48 Malt beverages and liquors.
49 Distilled alcoholic liquors.
50 Merchandise not otherwise classified.
51 Cosmetics and toilet preparations.
52 Detergents and soaps.

SERVICES

100 Miscellaneous.
101 Advertising and business.
102 Insurance and financial.
103 Construction and repair.
104 Communication.
105 Transportation and storage.
106 Material treatment.
107 Education and entertainment.

[24 FR 10383, Dec. 22, 1959. Redesignated at 38 FR 14681, June 4, 1973]

§ 6.3 Schedule for certification marks.

In applications for registration of certification marks based on sections 1 and 44 of the Trademark Act and registrations resulting from such applications, goods and services are classified in two classes as follows:

A. Goods.
B. Services.

[24 FR 10383, Dec. 22, 1959. Redesignated at 38 FR 14681, June 4, 1973; amended 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 6.4 Schedule for collective membership marks.

All collective membership marks in applications based on sections 1 and 44 of the Trademark Act and registrations resulting from such applications are classified as follows:

Class	Title
200	Collective Membership.

[24 FR 10383, Dec. 22, 1959. Redesignated at 38 FR 14681, June 4, 1973; amended 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

PART 7 – RULES OF PRACTICE IN FILINGS PURSUANT TO THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

AUTHORITY: 15 U.S.C. 1123, 35 U.S.C. 2, unless otherwise noted.

SUBPART A -- GENERAL INFORMATION

§ 7.1 Definitions of terms as used in this part.

(a) *The Act* means the Trademark Act of 1946, 60 Stat. 427, as amended, codified in 15 U.S.C. 1051 *et seq.*

(b) *Subsequent designation* means a request for extension of protection of an international registration to a Contracting Party made after the International Bureau registers the mark.

(c) The acronym *TEAS* means the Trademark Electronic Application System available on-line through the Office's web site at: http://www.uspto.gov.

(d) The term *Office* means the United States Patent and Trademark Office.

(e) All references to sections in this part refer to 37 Code of Federal Regulations, except as otherwise stated.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003]

§ 7.2 [Reserved]

§ 7.3 Correspondence must be in English.

International applications and registrations, requests for extension of protection and all other related correspondence with the Office must be in English. The Office will not process correspondence that is in a language other than English.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003]

§ 7.4 Receipt of correspondence.

(a) *Correspondence Filed Through TEAS.* Correspondence relating to international applications and registrations and requests for extension of protection submitted through TEAS will be accorded the date and time on which the complete transmission is received in the Office based on Eastern Time. Eastern Time means eastern standard time or eastern daylight time, as appropriate.

(b) *Correspondence Filed By Mail*. International applications under § 7.11, subsequent designations under § 7.21, responses to notices of irregularity under § 7.14, requests to record changes in the International Register under § 7.23 and § 7.24, requests to note replacement under § 7.28, requests for transformation under § 7.31, and petitions to the Director to review an action of the Office's Madrid Processing Unit, when filed by mail, must be addressed to: Madrid Processing Unit, 600 Dulany Street, MDE-7B87, Alexandria, VA 22314-5793.

(1) International applications under § 7.11, subsequent designations under § 7.21, requests to record changes in the International Register under § 7.23 and § 7.24, and petitions to the Director to review an action of the Office's Madrid Processing Unit, when filed by mail, will be accorded the date of receipt in the Office, unless they are sent by Express Mail pursuant to § 2.198, in which case they will be accorded the date of deposit with the United States Postal Service.

(2) Responses to notices of irregularity under § 7.14, requests to note replacement under § 7.28, and requests for transformation under § 7.31, when filed by mail, will be accorded the date of receipt in the Office.

(c) *Hand-Delivered Correspondence.* International applications under § 7.11, subsequent designations under § 7.21, responses to notices of irregularity under § 7.14, requests to record changes in the International Register under § 7.23 and § 7.24, requests to note replacement under § 7.28, requests for transformation under § 7.31, and petitions to the Director to review an action of the Office's Madrid Processing Unit, may be delivered by hand during the hours the Office is open to receive correspondence. Madrid-related hand-delivered correspondence must be delivered to the Trademark Assistance Center, James Madison Building--East Wing, Concourse Level, 600 Dulany Street, Alexandria, VA 22314, Attention: MPU.

(d) *Facsimile Transmission Not Permitted.* The following documents may not be sent by facsimile transmission, and will not be accorded a date of receipt if sent by facsimile transmission:

(1) International applications under § 7.11;

(2) Subsequent designations under § 7.21;

(3) Responses to notices of irregularity under § 7.14;

(4) Requests to record changes of ownership under § 7.23;

(5) Requests to record restrictions of the holder's right of disposal, or the release of such restrictions, under § 7.24; and

(6) Requests for transformation under § 7.31.

(e) *Certificate of Mailing or Transmission Procedure Does Not Apply.* The certificate of mailing or transmission procedure provided in § 2.197 does not apply to the documents specified in paragraph (d) of this section.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; amended 69 FR 57181, Sept. 24, 2004, effective Oct. 4, 2004; 69 FR 63320, Nov. 1, 2004; 72 FR 18907, April 16, 2007]

§ 7.5 [Reserved]

§ Schedule of U.S. process fees.

(a) The Office requires the following process fees:

(1) For certifying an international application based on a single basic application or registration, per class—$100.00

(2) For certifying an international application based on more than one basic application or registration, per class—$150.00

(3) For transmitting a subsequent designation under § 7.21—$100.00

(4) For transmitting a request to record an assignment or restriction, or release of a restriction, under § 7.23 or § 7.24—$100.00

(5) For filing a notice of replacement under § 7.28, per class—$100.00

(6) For filing an affidavit under § 71 of the Act, per class—$100.00

(7) Surcharge for filing an affidavit under § 71 of the Act during the grace period, per class—$100.00

(8) For correcting a deficiency in a section 71 affidavit—$100.00

(b) The fees required in paragraph (a) of this section must be paid in U.S. dollars at the time of submission of the requested action. *See* § 2.207 of this chapter for acceptable forms of payment and § 2.208 of this chapter for payments using a deposit account established in the Office.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; amended 75 FR 35973, June 24, 2010, effective June 24, 2010]

§ 7.7 Payments of fees to International Bureau.

(a) For documents filed through TEAS, the following fees may be paid either directly to the International Bureau or through the Office:

(1) International application fees;

(2) Subsequent designation fees; and

(3) Recording fee for an assignment of an international registration under § 7.23.

(b) The fees in paragraph (a) of this section may be paid as follows:

(1)(i) Directly to the International Bureau by debit to a current account with the International Bureau. In this case, an applicant or holder's submission to the Office must include the International Bureau account number; or

(ii) Directly to the International Bureau using any other acceptable method of payment. In this case, an applicant or holder's submission to the Office must include the International Bureau receipt number for payment of the fees; or

(2) Through the Office. Fees paid through the Office must be paid in U.S. dollars at the time of submission. *See* § 2.207 of this chapter for acceptable forms of payment and § 2.208 of this chapter for payments using a deposit account established in the Office.

(c) All fees for paper filings must be paid directly to the International Bureau.

(d) The International Bureau fee calculator may be viewed on the web site of the World Intellectual Property Organization, currently available at: http://www.wipo.int/madrid/en/.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; amended 69 FR 57181, Sept. 24, 2004, effective Oct. 4, 2004]

SUBPART B -- INTERNATIONAL APPLICATION ORIGINATING FROM THE UNITED STATES

§ 7.11 Requirements for international application originating from the United States.

(a) The Office will grant a date of receipt to an international application that is either filed through TEAS, or typed on the official paper form issued by the International Bureau. The international application must include all of the following:

(1) The filing date and serial number of the basic application and/or the registration date and registration number of the basic registration;

(2) The name and entity of the international applicant that is identical to the name and entity of the applicant or registrant in the basic application or basic registration, and the applicant's current address;

(3) A reproduction of the mark that is the same as the mark in the basic application and/or registration and that meets the requirements of § 2.52 of this title.

(i) If the mark in the basic application and/or registration is depicted in black and white and the basic application or registration does not include a color claim, the reproduction of the mark in the international application must be black and white.

(ii) If the mark in the basic application or registration is depicted in black and white and includes a color claim, the international application must include both a black and white reproduction of the mark **and** a color reproduction of the mark.

(iii) If the mark in the basic application and/or registration is depicted in color, the reproduction of the mark in the international application must be in color.

(iv) If the international application is filed on paper, the mark must be no more than 3.15 inches (8 cm) high by 3.15 inches (8 cm) wide, and must appear in the box designated by the International Bureau on the International Bureau's official form;

(4) A color claim as set out in § 7.12, if appropriate;

(5) A description of the mark that is the same as the description of the mark in the basic application or registration, as appropriate;

(6) An indication of the type of mark if the mark in the basic application and/or registration is a three-dimensional mark, a sound mark, a collective mark or a certification mark;

(7) A list of the goods and/or services that is identical to or narrower than the list of goods and/or services in each claimed basic application or registration and classified according to the *Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks*;

(8) A list of the designated Contracting Parties. If the goods and/or services in the international application are not the same for each designated Contracting Party, the application must list the goods and/or services in the international application that pertain to each designated Contracting Party;

(9) The certification fee required by § 7.6;

(10) If the application is filed through TEAS, the international application fees for all classes, and the fees for all designated Contracting Parties identified in the international application (*see* § 7.7);

(11) A statement that the applicant is entitled to file an international application in the Office, specifying that applicant: is a national of the United States; has a domicile in the United States; or has a real and effective industrial or commercial establishment in the United States. Where an applicant's address is not in the United States, the applicant must provide the address of its U.S. domicile or establishment; and

(12) If the international application is filed through TEAS, an e-mail address for receipt of correspondence from the Office.

(b) For requirements for certification, *see* § 7.13.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; amended 69 FR 57181, Sept. 24, 2004, effective Oct. 4, 2004; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

§ 7.12 Claim of color.

(a) If color is claimed as a feature of the mark in the basic application and/or registration, the international application must include a statement that color is claimed as a feature of the mark and set forth the same name(s) of the color(s) claimed in the basic application and/or registration.

(b) If color is not claimed as a feature of the mark in the basic application and/or registration, color may not be claimed as a feature of the mark in the international application.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003]

§ 7.13 Certification of international application.

(a) When an international application contains all the elements set forth in § 7.11(a), the Office will certify to the International Bureau that the information contained in the international application corresponds to the information contained in the basic application(s) and/or basic registration(s) at the time of certification, and will then forward the international application to the International Bureau.

(b) When an international application does not meet the requirements of § 7.11(a), the Office will not certify or forward the international application. If the international applicant paid the international application fees (*see* § 7.7) through the Office, the Office will refund the international fees. The Office will not refund the certification fee.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003]

§ 7.14 Correcting irregularities in international application.

(a) *Response period.* Upon receipt of a notice of irregularities in an international application from the International Bureau, the applicant must respond to the International Bureau within the period set forth in the notice.

(b) *Classification and Identification of Goods and Services.* Responses to International Bureau notices of irregularities in the classification or identification of goods or services in an international application must be submitted through the Office for forwarding to the International Bureau. The Office will review an applicant's response to a notice of irregularities in the identification of goods or services to ensure that the response does not identify goods or services that are broader than the scope of the goods or services in the basic application or registration.

(c) *Fees.* If the International Bureau notice of irregularities requires the payment of fees, the fees for correcting irregularities in the international application must be paid directly to the International Bureau.

(d) *Other Irregularities Requiring Response from Applicant.* Except for responses to irregularities mentioned in paragraph (b) of this section and payment of fees for correcting irregularities mentioned in paragraph (c) of this section, all other responses may be submitted through the Office in accordance with § 7.14(e), or filed directly at the International Bureau. The Office will forward timely responses to the International Bureau, but will not review the responses or respond to any irregularities on behalf of the international applicant.

(e) *Procedure for response*. To be considered timely, a response must be received by the International Bureau before the end of the response period set forth in the International Bureau's notice. Receipt in the Office does not fulfill this requirement. Any response submitted through the Office for forwarding to the International Bureau should be submitted as soon as possible, but at least one month before the end of the response period in the International Bureau's notice. The Office will not process any response received in the Office after the International Bureau's response deadline.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; amended 69 FR 57181, Sept. 24, 2004, effective Oct. 4, 2004; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

SUBPART C -- SUBSEQUENT DESIGNATION SUBMITTED THROUGH THE OFFICE

§ 7.21 Subsequent designation.

(a) A subsequent designation may be filed directly with the International Bureau, or, if it meets the requirements of paragraph (b) of this section, submitted through the Office.

(b) The Office will grant a date of receipt to a subsequent designation that is either filed through TEAS, or typed on the official paper form issued by the International Bureau. The subsequent designation must contain all of the following:

(1) The international registration number;

(2) The serial number of the U.S. application or registration number of the U.S. registration that formed the basis of the international registration;

(3) The name and address of the holder of the international registration;

(4) A statement that the holder is entitled to file a subsequent designation in the Office, specifying that holder: is a national of the United States; has a domicile in the United States; or has a real and effective industrial or commercial establishment in the United States. Where a holder's address is not in the United States, the holder must provide the address of its U.S. domicile or establishment;

(5) A list of goods and/or services that is identical to or narrower than the list of goods and/or services in the international registration;

(6) A list of the designated Contracting Parties. If the goods and/or services in the subsequent designation are not the same for each designated Contracting Party, the holder must list the

goods and/or services covered by the subsequent designation that pertain to each designated Contracting Party;

(7) The U.S. transmittal fee required by § 7.6;

(8) If the subsequent designation is filed through TEAS, the subsequent designation fees (*see* § 7.7); and

(9) If the subsequent designation is filed through TEAS, an e-mail address for receipt of correspondence from the Office.

(c) If the subsequent designation is accorded a date of receipt, the Office will then forward the subsequent designation to the International Bureau.

(d) If the subsequent designation fails to contain all the elements set forth in paragraph (b) of this section, the Office will not forward the subsequent designation to the International Bureau. The Office will notify the holder of the reason(s). If the holder paid the subsequent designation fees (*see* § 7.7) through the Office, the Office will refund the subsequent designation fees. The Office will not refund the transmittal fee.

(e) Correspondence to correct any irregularities in a subsequent designation must be made directly with the International Bureau.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; amended 69 FR 57181, Sept. 24, 2004, effective Oct. 4, 2004]

SUBPART D -- RECORDING CHANGES TO INTERNATIONAL REGISTRATION

§ 7.22 Recording changes to international registration.

Except as provided in §§ 7.23 and 7.24, requests to record changes to an international registration must be filed with the International Bureau. If a request to record an assignment or restriction of a holder's right of disposal of an international registration or the release of such a restriction meets the requirements of § 7.23 or 7.24, the Office will forward the request to the International Bureau. Section 10 of the Act and part 3 of this chapter are not applicable to assignments or restrictions of international registrations.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003]

§ 7.23 Requests for recording assignments at the International Bureau.

A request to record an assignment of an international registration may be submitted through the Office for forwarding to the International Bureau only if the assignee cannot obtain the assignor's signature for the request to record the assignment.

(a) A request to record an assignment submitted through the Office must include all of the following:

(1) The international registration number;

(2) The name and address of the holder of the international registration;

(3) The name and address of the assignee of the international registration;

(4) A statement that the assignee: is a national of the United States; has a domicile in the United States; or has a real and effective industrial or commercial establishment in the United States. Where an assignee's address is not in the United States, the assignee must provide the address of its U.S. domicile or establishment;

(5) A statement that the assignee could not obtain the assignor's signature for the request to record the assignment;

(6) An indication that the assignment applies to the designation to the United States;

(7) A statement that the assignment applies to all the goods and/or services in the international registration, or if less, a list of the goods and/or services in the international registration that have been assigned that pertain to the designation to the United States; and

(8) The U.S. transmittal fee required by § 7.6.

(b) If a request to record an assignment contains all the elements set forth in paragraph (a) of this section, the Office will forward the request to the International Bureau. Forwarding the request to the International Bureau is not a determination by the Office of the validity of the assignment or the effect that the assignment has on the title of the international registration.

(c) If the request fails to contain all the elements set forth in paragraph (a) of this section, the Office will not forward the request to the International Bureau. The Office will notify the assignee(s) of the reason(s). If the assignee paid the fees to record the assignment (*see* § 7.7) through the Office, the Office will refund the recording fee. The Office will not refund the transmittal fee.

(d) Correspondence to correct any irregularities in a request to record an assignment must be made directly with the International Bureau.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; amended 69 FR 57181, Sept. 24, 2004, effective Oct. 4, 2004]

§ 7.24 Requests to record security interest or other restriction of holder's rights of disposal or release of such restriction submitted through the Office.

(a) A party who obtained a security interest or other restriction of a holder's right to dispose of an international registration, or the release of such a restriction, may submit a request to record the restriction or release through the Office for forwarding to the International Bureau only if:

(1) the restriction or release

(i) is the result of a court order; or

(ii) is the result of an agreement between the holder of the international registration and the party restricting the holder's right of disposal, and the signature of the holder cannot be obtained for the request to record the restriction or release;

(2) the party who obtained the restriction is a national of, is domiciled in, or has a real and effective industrial or commercial establishment in the United States; and

(3) the restriction or release applies to the holder's right to dispose of the international registration in the United States.

(b) A request to record a restriction or the release of a restriction must be submitted by the party who obtained the restriction of the holder's right of disposal and include all the following:

(1) The international registration number;

(2) The name and address of the holder of the international registration;

(3) The name and address of the party who obtained the restriction;

(4) A statement that the party who submitted the request: is a national of the United States; has a domicile in the United States; or has a real and effective industrial or commercial establishment in the United States. Where a party's address is not in the United States, the party must provide the address of its U.S. domicile or establishment;

(5) (i) A statement that the restriction is the result of a court order, or

(ii) where the restriction is the result of an agreement between the holder of the international registration and the party restricting the holder's right of disposal, a statement that the signature of the holder of the international registration could not be obtained for the request to record the restriction or release of the restriction;

(6) A summary of the main facts concerning the restriction;

(7) An indication that the restriction, or the release of the restriction, of the holder's right of disposal of the international registration applies to the designation to the United States; and

(8) The U.S. transmittal fee required by § 7.6.

(c) If a request to record a restriction, or the release of a restriction, contains all the elements set forth in paragraph (b) of this section, the Office will forward the request to the International Bureau. Forwarding the request to the International Bureau is not a determination by the Office of the validity of the restriction, or its release, or the effect that the restriction has on the holder's right to dispose of the international registration.

(d) If the request fails to contain all the elements set forth in paragraph (b) of this section, the Office will not forward the request. The Office will notify the party who submitted the request of the reason(s). The Office will not refund the transmittal fee.

(e) Correspondence to correct any irregularities in a request to record a restriction of a holder's right to dispose of an international registration or the release of such a restriction must be made directly with the International Bureau.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003]

SUBPART E -- EXTENSION OF PROTECTION TO THE UNITED STATES

§ 7.25 Sections of part 2 applicable to extension of protection.

(a) Except for §§ 2.22-2.23, 2.130-2.131, 2,160-2.166, 2.173, and 2.181-2.186, all sections in parts 2, 10, and 11 of this chapter shall apply to an extension of protection of an international registration to the United States, including sections related to proceedings before the Trademark Trial and Appeal Board, unless otherwise stated.

(b) The Office will refer to a request for an extension of protection to the United States as an application under section 66(a) of the Act, and references to applications and registrations in part 2 of this chapter include extensions of protection to the United States.

(c) Upon registration in the United States under section 69 of the Act, an extension of protection to the United States is referred to as a registration, a registered extension of protection, or a section 66(a) registration.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; amended 69 FR 57181, Sept. 24, 2004, effective Oct. 4, 2004; 70 FR 38768, July 6, 2005, effective July 18, 2005; 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008; 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009; 75 FR 35973, June 24, 2010, effective June 24, 2010]

§ 7.26 Filing date of extension of protection for purposes of examination in the Office.

(a) If a request for extension of protection of an international registration to the United States is made in an international application and the request includes a declaration of a bona fide intention to use the mark in commerce as set out in § 2.33(e) of this chapter, the filing date of the extension of protection to the United States is the international registration date.

(b) If a request for extension of protection of an international registration to the United States is made in a subsequent designation and the request includes a declaration of a bona fide intention to use the mark in commerce as set out in § 2.33(e), the filing date of the extension of protection to the United States is the date that the International Bureau records the subsequent designation.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003]

§ 7.27 Priority claim of extension of protection for purposes of examination in the Office.

An extension of protection of an international registration to the United States is entitled to a claim of priority under section 67 of the Act if:

(a) The request for extension of protection contains a claim of priority;

(b) The request for extension of protection specifies the filing date, serial number and the country of the application that forms the basis for the claim of priority; and

(c) The date of the international registration or the date of recording of the subsequent designation at the International Bureau of the request for extension of protection to the United States is not later than six months after the filing date of the application that forms the basis for the claim of priority.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003]

§ 7.28 Replacement of U.S. registration by registered extension of protection.

(a) A registered extension of protection affords the same rights as those afforded to a previously issued U.S. registration if:

(1) Both registrations are owned by the same person and identify the same mark; and

(2) All the goods and/or services listed in the U.S. registration are also listed in the registered extension of protection.

(b) The holder of an international registration with a registered extension of protection to the United States that meets the requirements of paragraph (a) of this section may file a request to note replacement of the U.S. registration with the extension of protection. If the request contains all of the following, the Office will take note of the replacement in its automated records:

(1) The serial number or registration number of the extension of protection;

(2) The registration number of the replaced U.S. registration; and

(3) The fee required by § 7.6.

(c) If the request to note replacement is denied, the Office will notify the holder of the reason(s) for refusal.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003]

§ 7.29 Effect of replacement on U.S. registration.

A U.S. registration that has been replaced by a registered extension of protection under section 74 of the Act and § 7.28 will remain in force, unless cancelled, expired or surrendered, as long as:

(a) The owner of the replaced U.S. registration continues to file affidavits or declarations of use in commerce or excusable nonuse under section 8 of the Act; and

(b) The replaced U.S. registration is renewed under section 9 of the Act.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003]

§ 7.30 Effect of cancellation or expiration of international registration.

When the International Bureau notifies the Office of the cancellation or expiration of an international registration, in whole or in part, the Office shall cancel, in whole or in part, the corresponding pending or registered extension of protection to the United States. The date of cancellation of an extension of protection or relevant part shall be the date of cancellation or expiration of the corresponding international registration or relevant part.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003]

§ 7.31 Requirements for transformation of an extension of protection to the United States into a U.S. application.

If the International Bureau cancels an international registration in whole or in part, under Article 6(4) of the Madrid Protocol, the holder of that international registration may file a request to transform the corresponding pending or registered extension of protection to the United States into an application under section 1 or 44 of the Act.

(a) The holder of the international registration must file a request for transformation within three months of the date of cancellation of the international registration and include:

(1) The serial number or registration number of the extension of protection to the United States;

(2) The name and address of the holder of the international registration;

(3) The application filing fee for at least one class of goods or services required by § 2.6(a)(1) of this chapter; and

(4) An e-mail address for receipt of correspondence from the Office.

(b) If the request for transformation contains all the elements set forth in paragraph (a) of this section, the extension of protection shall be transformed into an application under section 1 and/or 44 of the Act and accorded the same filing date and the same priority that was accorded to the extension of protection.

(c) The application under section 1 and/or 44 of the Act that results from a transformed extension of protection will be examined under part 2 of this chapter.

(d) A request for transformation that fails to contain all the elements set forth in paragraph (a) of this section will not be accepted.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; amended 69 FR 57181, Sept. 24, 2004, effective Oct. 4, 2004]

SUBPART F -- AFFIDAVIT UNDER SECTION 71 OF THE ACT FOR EXTENSION OF PROTECTION TO THE UNITED STATES

§ 7.36 Affidavit or declaration of use in commerce or excusable nonuse required to avoid cancellation of an extension of protection to the United States.

(a) Subject to the provisions of section 71 of the Act, a registered extension of protection shall remain in force for the term of the international registration upon which it is based unless the international registration expires or is cancelled under section 70 of the Act due to cancellation of the international registration by the International Bureau.

(b) During the following time periods, the holder of an international registration must file an affidavit or declaration of use or excusable nonuse, or the registered extension of protection will be cancelled under section 71 of the Act:

(1) On or after the fifth anniversary and no later than the sixth anniversary after the date of registration in the United States; and

(2) Within the year before the end of every ten-year period after the date of registration in the United States.

(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 (b)(1) and (b)(2) of this section, with payment of the grace period surcharge per class required by section 71(a)(3) of the Act and § 7.6.

(c) For the requirements for the affidavit or declaration, see § 7.37.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; amended 75 FR 35973, June 24, 2010, effective June 24, 2010]

§ 7.37 Requirements for a complete affidavit or declaration of use in commerce or excusable nonuse.

A complete affidavit or declaration under section 71 of the Act must:

(a) Be filed by the holder of the international registration within the period set forth in § 7.36(b);

(b) Include a statement that is signed and verified (sworn to) or supported by a declaration under § 2.20 of this chapter by a person properly authorized to sign on behalf of the holder, attesting to the use in commerce or excusable nonuse of the mark within the period set forth in section 71 of the Act. The verified statement must be executed on or after the beginning of the filing period specified in § 7.36(b). A person who is properly authorized to sign on behalf of the holder is:

(1) A person with legal authority to bind the holder; or

(2) A person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the holder; or

(3) An attorney as defined in § 11.1 of this chapter who has an actual written or verbal power of attorney or an implied power of attorney from the holder.

(c) Include the U.S. registration number;

(d)(1) Include the fee required by § 7.6 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 71(a)(3) of the Act, include the grace period surcharge per class required by § 7.6;

(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. If the required fee(s) are not submitted within the time period set out in the Office action 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 § 7.37(f)(2);

(2) Specify the goods or services being deleted from the registration, if the affidavit or declaration covers less than all the goods or services or less than all the classes in 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; and

(g) Include a specimen showing current use of the mark for each class of goods or services, unless excusable nonuse is claimed under § 7.37(f)(2). The specimen must meet the requirements of § 2.56 of this chapter.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; amended 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008; 75 FR 35973, June 24, 2010, effective June 24, 2010]

§ 7.38 Notice to holder of extension of protection.

The registration certificate for an extension of protection to the United States includes a notice of the requirement for filing the affidavit or declaration of use or excusable nonuse under section 71 of the Act. However, the affidavit or declaration must be filed within the time period required by section 71 of the Act regardless of whether this notice is received.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003]

§ 7.39 Acknowledgment of receipt of and correcting deficiencies in affidavit or declaration of use in commerce or excusable nonuse.

The Office will issue a notice as to whether an affidavit or declaration is acceptable, or the reasons for refusal.

(a) A response to the refusal must be filed within six months of the date of issuance of the Office action, or before the end of the filing period set forth in section 71(a) of the Act, whichever is later. The response must be signed by the holder, someone with legal authority to bind the holder (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(2).

(b) If no response is filed within this time period, the extension of protection will be cancelled, unless time remains in the grace period under section 71(a)(3) of the Act. If time remains in the grace period, the holder may file a complete, new affidavit.

(c) If the affidavit or declaration is filed within the time periods set forth in section 71 of the Act, deficiencies may be corrected, as follows:

(1) *Correcting deficiencies in affidavits or declarations timely filed within the periods set forth in sections 71(a)(1) and 71(a)(2) of the Act*. If the affidavit or declaration is timely filed within the relevant filing period set forth in section 71(a)(1) or section 71(a)(2) 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 71(c) of the Act and § 7.6.

(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 71(a)(3) 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 71(c) of the Act and § 7.6.

(d) If the affidavit or declaration is not filed within the time periods set forth in section 71 of the Act, the registration will be cancelled.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; amended 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009; 75 FR 35973, June 24, 2010, effective June 24, 2010]

§ 7.40 Petition to Director to review refusal.

(a) A response to the examiner's initial refusal to accept an affidavit or declaration is required before filing a petition to the Director, unless the examiner directs otherwise. *See* § 7.39(b) for the deadline for responding to an examiner's Office action.

(b) If the examiner maintains the refusal of the affidavit or declaration, the holder may file a petition to the Director to review the examiner's action. The petition must be filed within six months of the date of issuance of the action maintaining the refusal, or the Office will cancel the registration.

(c) A decision by the Director is necessary before filing an appeal or commencing a civil action in any court.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003; amended 73 FR 67759, Nov. 17, 2008, effective Jan. 16, 2009]

SUBPART G--RENEWAL OF INTERNATIONAL REGISTRATION AND EXTENSION OF PROTECTION

§ 7.41 Renewal of international registration and extension of protection.

(a) Any request to renew an international registration and its extension of protection to the United States must be made at the International Bureau in accordance with Article 7 of the Madrid Protocol.

(b) A request to renew an international registration or extension of protection to the United States submitted through the Office will not be processed.

[Added 68 FR 55748, Sept. 26, 2003, effective Nov. 2, 2003]

37 C.F.R. PART 10—REPRESENTATION OF OTHERS BEFORE THE PATENT AND TRADEMARK OFFICE

AUTHORITY: 5 U.S.C. 500; 15 U.S.C. 1123; 35 U.S.C. 2, 6, 32, 41.
SOURCE: 50 FR 5172, Feb. 6, 1985, unless otherwise noted.

§ 10.1 Definitions.

This part governs solely the practice of patent, trademark, and other law before the Patent and Trademark Office. Nothing in this part shall be construed to preempt the authority of each State to regulate the practice of law, except to the extent necessary for the Patent and Trademark Office to accomplish its federal objectives. Unless otherwise clear from the context, the following definitions apply to this part:

(a) "*Affidavit*" means affidavit, declaration under 35 U.S.C. 25 (see § 1.68 and § 2.20 of this subchapter), or statutory declaration under 28 U.S.C. 1746.

(b) "*Application*" includes an application for a design, plant, or utility patent, an application to reissue any patent, and an application to register a trademark.

(c) "*Attorney*" or "*lawyer*" means an individual who is a member in good standing of the bar of any United States court or the highest court of any State. A "*non-lawyer*" is a person who is not an attorney or lawyer.

(d) "*Canon*" is defined in § 10.20(a).

(e) "*Confidence*" is defined in § 10.57(a).

(f) "*Differing interests*" include every interest that may adversely affect either the judgment or the loyalty of a practitioner to a client, whether it be a conflicting, inconsistent, diverse, or other interest.

(g) "*Director*" means the Director of Enrollment and Discipline.

(h) "*Disciplinary Rule*" is defined in § 10.20(b).

(i) "*Employee of a tribunal*" includes all employees of courts, the Office, and other adjudicatory bodies.

(j) "*Giving information*" within the meaning of § 10.23(c) (2) includes making (1) a written statement or representation or (2) an oral statement or representation.

(k) "*Law firm*" includes a professional legal corporation or a partnership.

(l) "*Legal counsel*" means practitioner.

(m)"*Legal profession*" includes the individuals who are lawfully engaged in practice of patent, trademark, and other law before the Office.

(n) "*Legal service*" means any legal service which may lawfully be performed by a practitioner before the Office.

(o) "*Legal System*" includes the Office and courts and adjudicatory bodies which review matters on which the Office has acted.

(p) "*Office*" means Patent and Trademark Office.

(q) "*Person*" includes a corporation, an association, a trust, a partnership, and any other organization or legal entity.

(r) "*Practitioner*" means (1) an attorney or agent registered to practice before the Office in patent cases or (2) an individual authorized under 5 U.S.C. 500(b) or otherwise as provided by this subchapter, to practice before the Office in trademark cases or other non-patent cases. A "*suspended or excluded practitioner*" is a practitioner who is suspended or excluded under 10.156. A "*non-practitioner*" is an individual who is not a practitioner.

(s) A "*proceeding before the Office*" includes an application, a reexamination, a protest, a public use proceeding, a patent interference, an *inter partes* trademark proceeding, or any other proceeding which is pending before the Office.

(t) "*Professional legal corporation*" means a corporation authorized by law to practice law for profit.

(u) "*Registration*" means registration to practice before the Office in patent cases.
(v) "*Respondent*" is defined in § 10.134(a)(1).
(w) "*Secret*" is defined in § 10.57(a).
(x) "*Solicit*" is defined in § 10.33.
(y) "*State*" includes the District of Columbia, Puerto Rico, and other federal territories and possessions.
(z) "*Tribunal*" includes courts, the Office, and other adjudicatory bodies.
(aa) "*United States*" means the United States of America, its territories and possessions.

[Added 50 FR 5172, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.2 - 10.3 [Reserved]

[69 FR 35428, June 24, 2004, effective July 26, 2004]

§ 10.4 [Reserved]

(a) The Commissioner shall appoint a Committee on Discipline. The Committee on Discipline shall consist of at least three employees of the Office, none of whom reports directly or indirectly to the Director or the Solicitor. Each member of the Committee on Discipline shall be a member in good standing of the bar of a State.
(b) The Committee on Discipline shall meet at the request of the Director and after reviewing evidence presented by the Director shall, by majority vote, determine whether there is probable cause to bring charges under § 10.132 against a practitioner. When charges are brought against a practitioner, no member of the Committee on Discipline, employee under the direction of the Director, or associate solicitor or assistant solicitor in the Office of Solicitor shall participate in rendering a decision on the charges.
(c) No discovery shall be authorized of, and no member of the Committee on Discipline shall be required to testify about, deliberations of the Committee on Discipline.

[Removed 73 FR 59514, Oct. 9, 2008]

INDIVIDUALS ENTITLED TO PRACTICE BEFORE THE PATENT AND TRADEMARK OFFICE

§ 10.5 -10 [Reserved]

[69 FR 35428, June 24, 2004, effective July 26, 2004]

§ 10.11 Removing names from the register.

A letter may be addressed to any individual on the register, at the address of which separate notice was last received by the Director, for the purpose of ascertaining whether such individual desires to remain on the register. The name of any individual failing to reply and give any information requested by the Director within a time limit specified will be removed from the register and the names of individuals so removed will be published in the Official Gazette. The name of any individual so removed may be reinstated on the register as may be appropriate and upon payment of the fee set forth in Sec. 1.21(a)(3) of this subchapter.

[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985; amended 69 FR 35428, June 24, 2004, effective July 26, 2004]

§ 10.14 [Reserved]

[73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 10.15 [Reserved]

[73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 10.18 [Reserved]

[73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

PATENT AND TRADEMARK OFFICE CODE OF PROFESSIONAL RESPONSIBILITY

§ 10.20 Canons and Disciplinary Rules.

(a) Canons are set out in §§ 10.21, 10.30, 10.46, 10.56, 10.61, 10.76, 10.83, 10.100, and 10.110. Canons are statements of axiomatic norms, expressing in general terms the standards of professional conduct expected of practitioners in their relationships with the public, with the legal system, and with the legal profession.

(b) Disciplinary Rules are set out in §§ 10.22-10.24, 10.31-10.40, 10.47-10.57, 10.62-10.68, 10.77, 10.78, 10.84, 10.85, 10.87-10.89, 10.92, 10.93, 10.101-10.103, 10.111, and 10.112. Disciplinary Rules are mandatory in character and state the minimum level of conduct below which no practitioner can fall without being subjected to disciplinary action.

[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.21 Canon 1.

A practitioner should assist in maintaining the integrity and competence of the legal profession.

[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.22 Maintaining integrity and competence of the legal profession.

(a) A practitioner is subject to discipline if the practitioner has made a materially false statement in, or if the practitioner has deliberately failed to disclose a material fact requested in connection with, the practitioner's application for registration or membership in the bar of any United States court or any State court or his or her authority to otherwise practice before the Office in trademark and other non-patent cases.

(b) A practitioner shall not further the application for registration or membership in the bar of any United States court, State court, or administrative agency of another person known by the practitioner to be unqualified in respect to character, education, or other relative attribute.

[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.23 Misconduct.

(a) A practitioner shall not engage in disreputable or gross misconduct.

(b) A practitioner shall not:

(1) Violate a Disciplinary Rule.

(2) Circumvent a Disciplinary Rule through actions of another.

(3) Engage in illegal conduct involving moral turpitude.

(4) Engage in conduct involving dishonesty, fraud, deceit, or misrepresentation.

(5) Engage in conduct that is prejudicial to the administration of justice.

(6) Engage in any other conduct that adversely reflects on the practitioner's fitness to practice before the Office.

(c) Conduct which constitutes a violation of paragraphs (a) and (b) of this section includes, but is not limited to:

(1) Conviction of a criminal offense involving moral turpitude, dishonesty, or breach of trust.

(2) Knowingly giving false or misleading information or knowingly participating in a material way in giving false or misleading information, to:

(i) A client in connection with any immediate, prospective, or pending business before the Office.

(ii) The Office or any employee of the Office.

(3) Misappropriation of, or failure to properly or timely remit, funds received by a practitioner or the practitioner's firm from a client to pay a fee which the client is required by law to pay to the Office.

(4) Directly or indirectly improperly influencing, attempting to improperly influence, offering or agreeing to improperly influence, or attempting to offer or agree to improperly influence an official action of any employee of the Office by:

(i) Use of threats, false accusations, duress, or coercion,

(ii) An offer of any special inducement or promise of advantage, or

(iii) Improperly bestowing of any gift, favor, or thing of value.

(5) Suspension or disbarment from practice as an attorney or agent on ethical grounds by any duly constituted authority of a State or the United States or, in the case of a practitioner who resides in a foreign country or is registered under § 11.6(c), by any duly constituted authority of:

(i) A State,

(ii) The United States, or

(iii) The country in which the practitioner resides.

(6) Knowingly aiding or abetting a practitioner suspended or excluded from practice before the Office in engaging in unauthorized practice before the Office under § 11.58.

(7) Knowingly withholding from the Office information identifying a patent or patent application of another from which one or more claims have been copied. See §§ 1.604(b) and 1.607(c) of this subchapter.

(8) Failing to inform a client or former client or failing to timely notify the Office of an inability to notify a client or former client of correspondence received from the Office or the client's or former client's opponent in an *inter partes* proceeding before the Office when the correspondence (i) could have a significant effect on a matter pending before the Office, (ii) is received by the practitioner on behalf of a client or former client and (iii) is correspondence of which a reasonable practitioner would believe under the circumstances the client or former client should be notified.

(9) Knowingly misusing a ''Certificate of Mailing or Transmission" under § 1.8 of this chapter.

(10) Knowingly violating or causing to be violated the requirements of § 1.56 or § 1.555 of this subchapter.

(11) Except as permitted by § 1.52(c) of this chapter, knowingly filing or causing to be filed an application containing any material alteration made in the application papers after the signing of the accompanying oath or declaration without identifying the alteration at the time of filing the application papers.

(12) Knowingly filing, or causing to be filed, a frivolous complaint alleging a violation by a practitioner of the Patent and Trademark Office Code of Professional Responsibility.

(13) Knowingly preparing or prosecuting or providing assistance in the preparation or prosecution of a patent application in violation of an undertaking signed under § 11.10(b).

(14) Knowingly failing to advise the Director in writing of any change which would preclude continued registration under § 11.6.

(15) Signing a paper filed in the Office in violation of the provisions of § 11.18 or making a scandalous or indecent statement in a paper filed in the Office.

(16) Willfully refusing to reveal or report knowledge or evidence to the Director contrary to § 10.24 or § 11.22(b).

(17) Representing before the Office in a patent case either a joint venture comprising an inventor and an invention developer or an inventor referred to the registered practitioner by an invention developer when (i) the registered practitioner knows, or has been advised by the Office, that a formal complaint filed by a federal or state agency, based on any violation of any law relating to securities, unfair methods of competition, unfair or deceptive acts or practices, mail fraud, or other civil or criminal conduct, is pending before a federal or state court or federal or state agency, or has been resolved unfavorably by such court or agency, against the invention developer in connection with invention development services and (ii) the registered practitioner fails to fully advise the inventor of the existence of the pending complaint or unfavorable resolution thereof prior to undertaking or continuing representation of the joint venture or inventor. “Invention developer” means any person, and any agent, employee, officer, partner, or independent contractor thereof, who is not a registered practitioner and who advertises invention development services in media of general circulation or who enters into contracts for invention development services with customers as a result of such advertisement. “Invention development services” means acts of invention development required or promised to be performed, or actually performed, or both, by an invention developer for a customer. “Invention development” means the evaluation, perfection, marketing, brokering, or promotion of an invention on behalf of a customer by an invention developer, including a patent search, preparation of a patent application, or any other act done by an invention developer for consideration toward the end of procuring or attempting to procure a license, buyer, or patent for an invention. “Customer” means any individual who has made an invention and who enters into a contract for invention development services with an invention developer with respect to the invention by which the inventor becomes obligated to pay the invention developer less than $5,000 (not to include any additional sums which the invention developer is to receive as a result of successful development of the invention). “Contract for invention development services” means a contract for invention development services with an invention developer with respect to an invention made by a customer by which the inventor becomes obligated to pay the invention developer less than $5,000 (not to include any additional sums which the invention developer is to receive as a result of successful development of the invention).

(18) In the absence of information sufficient to establish a reasonable belief that fraud or inequitable conduct has occurred, alleging before a tribunal that anyone has committed a fraud on the Office or engaged in inequitable conduct in a proceeding before the Office.

(19) Action by an employee of the Office contrary to the provisions set forth in § 11.10(d).

(20) Knowing practice by a Government employee contrary to applicable Federal conflict of interest laws, or regulations of the Department, agency, or commission employing said individual.

(d) A practitioner who acts with reckless indifference to whether a representation is true or false is chargeable with knowledge of its falsity. Deceitful statements of half-truths or concealment of material facts shall be deemed actual fraud within the meaning of this part.

[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985; amended 50 FR 25073, June 17, 1985; 50 FR 25980, June 24, 1985; paras. (c)(13), (19) & (20), 53 FR 33950, Oct. 4, 1988, effective Nov. 4, 1988; corrected 53 FR 41278, Oct. 20, 1988; paras. (c)(10) & (c)(11), 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (c)(a) amended, 58 FR 54494, Oct. 2, 1993, effective Nov. 22, 1993; para. (c)(9) amended,

61 FR 56439, Nov. 1, 1996, effective Dec. 2, 1996; 62 FR 53186, Oct. 10, 1997; 65 FR 54604, Sept. 8, 2000; 73 FR 59514, Oct. 9, 2008]

§ 10.24 Disclosure of information to authorities.

(a) A practitioner possessing unprivileged knowledge of a violation of a Disciplinary Rule shall report such knowledge to the Director.

(b) A practitioner possessing unprivileged knowledge or evidence concerning another practitioner, employee of the Office, or a judge shall reveal fully such knowledge or evidence upon proper request of a tribunal or other authority empowered to investigate or act upon the conduct of practitioners, employees of the Office, or judges.

[Added 50 FR 5176, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.30 Canon 2.

A practitioner should assist the legal profession in fulfilling its duty to make legal counsel available.

[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.31 Communications concerning a practitioner's services.

(a) No practitioner shall with respect to any prospective business before the Office, by word, circular, letter, or advertising, with intent to defraud in any manner, deceive, mislead, or threaten any prospective applicant or other person having immediate or prospective business before the Office.

(b) A practitioner may not use the name of a Member of either House of Congress or of an individual in the service of the United States in advertising the practitioner's practice before the Office.

(c) Unless authorized under § 11.14(b), a non-lawyer practitioner shall not hold himself or herself out as authorized to practice before the Office in trademark cases.

(d) Unless a practitioner is an attorney, the practitioner shall not hold himself or herself out:

(1) To be an attorney or lawyer or

(2) As authorized to practice before the Office in non-patent and trademark cases.

[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985; amended 73 FR 59514, Oct. 9, 2008]

§ 10.32 Advertising.

(a) Subject to § 10.31, a practitioner may advertise services through public media, including a telephone directory, legal directory, newspaper, or other periodical, radio, or television, or through written communications not involving solicitation as defined by § 10.33.

(b) A practitioner shall not give anything of value to a person for recommending the practitioner's services, except that a practitioner may pay the reasonable cost of advertising or written communication permitted by this section and may pay the usual charges of a not-for-profit lawyer referral service or other legal service organization.

(c) Any communication made pursuant to this section shall include the name of at least one practitioner responsible for its content.

[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.33 Direct contact with prospective clients.

A practitioner may not solicit professional employment from a prospective client with whom the practitioner has no family or prior professional relationship, by mail, in-person, or otherwise, when a significant motive for the practitioner's doing so is the practitioner's pecuniary gain under circumstances evidencing undue influence, intimidation, or overreaching. The term "solicit" includes contact in person, by telephone or telegraph, by letter or other writing, or by other communication directed to a specific recipient, but does not include letters addressed or advertising circulars distributed generally to persons not specifically known to need legal services of the kind provided by the practitioner in a particular manner, but who are so situated that they might in general find such services useful.

[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.34 Communications of fields of practice.

A registered practitioner may state or imply that the practitioner is a specialist as follows:

(a) A registered practitioner who is an attorney may use the designation "Patents," "Patent Attorney," "Patent Lawyer," "Registered Patent Attorney," or a substantially similar designation.

(b) A registered practitioner who is not an attorney may use the designation "Patents," "Patent Agent," "Registered Patent Agent," or a substantially similar designation, except that any practitioner who was registered prior to November 15, 1938, may refer to himself or herself as a "patent attorney."

[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.35 Firm names and letterheads.

(a) A practitioner shall not use a firm name, letterhead, or other professional designation that violates § 10.31. A trade name may be used by a practitioner in private practice if it does not imply a current connection with a government agency or with a public or charitable legal services organization and is not otherwise in violation of § 10.31.

(b) Practitioners may state or imply that they practice in a partnership or other organization only when that is the fact.

[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.36 Fees for legal services.

(a) A practitioner shall not enter into an agreement for, charge, or collect an illegal or clearly excessive fee.

(b) A fee is clearly excessive when, after a review of the facts, a practitioner of ordinary prudence would be left with a definite and firm conviction that the fee is in excess of a reasonable fee. Factors to be considered as guides in determining the reasonableness of a fee include the following:

(1) The time and labor required, the novelty and difficulty of the questions involved, and the skill requisite to perform the legal service properly.

(2) The likelihood, if apparent to the client, that the acceptance of the particular employment will preclude other employment by the practitioner.

(3) The fee customarily charged for similar legal services.

(4) The amount involved and the results obtained.

(5) The time limitations imposed by the client or by the circumstances.

(6) The nature and length of the professional relationship with the client.

(7) The experience, reputation, and ability of the practitioner or practitioners performing the services.

(8) Whether the fee is fixed or contingent.

[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.37 Division of fees among practitioners.

(a) A practitioner shall not divide a fee for legal services with another practitioner who is not a partner in or associate of the practitioner's law firm or law office, unless:

(1) The client consents to employment of the other practitioner after a full disclosure that a division of fees will be made.

(2) The division is made in proportion to the services performed and responsibility assumed by each.

(3) The total fee of the practitioners does not clearly exceed reasonable compensation for all legal services rendered to the client.

(b) This section does not prohibit payment to a former partner or associate pursuant to a separation or retirement agreement.

[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.38 Agreements restricting the practice of a practitioner.

(a) A practitioner shall not be a party to or participate in a partnership or employment agreement with another practitioner that restricts the right of a practitioner to practice before the Office after the termination of a relationship created by the agreement, except as a condition to payment of retirement benefits.

(b) In connection with the settlement of a controversy or suit, a practitioner shall not enter into an agreement that restricts the practitioner's right to practice before the Office.

[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.39 Acceptance of employment.

A practitioner shall not accept employment on behalf of a person if the practitioner knows or it is obvious that such person wishes to:

(a) Bring a legal action, commence a proceeding before the Office, conduct a defense, assert a position in any proceeding pending before the Office, or otherwise have steps taken for the person, merely for the purpose of harassing or maliciously injuring any other person.

(b) Present a claim or defense in litigation or any proceeding before the Office that it is not warranted under existing law, unless it can be supported by good faith argument for an extension, modification, or reversal of existing law.

[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.40 Withdrawal from employment.

(a) A practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office (see §§ 1.36 and 2.19 of this subchapter). In any event, a practitioner shall not withdraw from employment until the practitioner has taken reasonable steps to avoid foreseeable prejudice to the rights of the client, including giving due notice to his or her

client, allowing time for employment of another practitioner, delivering to the client all papers and property to which the client is entitled, and complying with applicable laws and rules. A practitioner who withdraws from employment shall refund promptly any part of a fee paid in advance that has not been earned.

(b) *Mandatory withdrawal*. A practitioner representing a client before the Office shall withdraw from employment if:

(1) The practitioner knows or it is obvious that the client is bringing a legal action, commencing a proceeding before the Office, conducting a defense, or asserting a position in litigation or any proceeding pending before the Office, or is otherwise having steps taken for the client, merely for the purpose of harassing or maliciously injuring any person;

(2) The practitioner knows or it is obvious that the practitioner's continued employment will result in violation of a Disciplinary Rule;

(3) The practitioner's mental or physical condition renders it unreasonably difficult for the practitioner to carry out the employment effectively; or

(4) The practitioner is discharged by the client.

(c) *Permissive withdrawal.* If paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matters pending before the Office unless such request or such withdrawal is because:

(1) The petitioner's client:

(i) Insists upon presenting a claim or defense that is not warranted under existing law and cannot be supported by good faith argument for an extension, modification, or reversal of existing law;

(ii) Personally seeks to pursue an illegal course of conduct;

(iii) Insists that the practitioner pursue a course of conduct that is illegal or that is prohibited under a Disciplinary Rule;

(iv) By other conduct renders it unreasonably difficult for the practitioner to carry out the employment effectively;

(v) Insists, in a matter not pending before a tribunal, that the practitioner engage in conduct that is contrary to the judgment and advice of the practitioner but not prohibited under the Disciplinary Rule; or

(vi) Has failed to pay one or more bills rendered by the practitioner for an unreasonable period of time or has failed to honor an agreement to pay a retainer in advance of the performance of legal services.

(2) The practitioner's continued employment is likely to result in a violation of a Disciplinary Rule;

(3) The practitioner's inability to work with co-counsel indicates that the best interests of the client likely will be served by withdrawal;

(4) The practitioner's mental or physical condition renders it difficult for the practitioner to carry out the employment effectively;

(5) The practitioner's client knowingly and freely assents to termination of the employment; or

(6) The practitioner believes in good faith, in a proceeding pending before the Office, that the Office will find the existence of other good cause for withdrawal.

[Added 50 FR 5178, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.46 Canon 3.

A practitioner should assist in preventing the unauthorized practice of law.

[Added 50 FR 5178, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.47 Aiding unauthorized practice of law.

(a) A practitioner shall not aid a non-practitioner in the unauthorized practice of law before the Office.

(b) A practitioner shall not aid a suspended or excluded practitioner in the practice of law before the Office.

(c) A practitioner shall not aid a non-lawyer in the unauthorized practice of law.

[Added 50 FR 5178, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.48 Sharing legal fees.

A practitioner or a firm of practitioners shall not share legal fees with a non-practitioner except that:

(a) An agreement by a practitioner with the practitioner's firm, partner, or associate may provide for the payment of money, over a reasonable period of time after the practitioner's death, to the practitioner's estate or to one or more specified persons.

(b) A practitioner who undertakes to complete unfinished legal business of a deceased practitioner may pay to the estate of the deceased practitioner that proportion of the total compensation which fairly represents the services rendered by the deceased practitioner.

(c) A practitioner or firm of practitioners may include non-practitioner employees in a compensation or retirement plan, even though the plan is based in whole or in part on a profit-sharing arrangement, providing such plan does not circumvent another Disciplinary Rule.

[Added 50 FR 5178, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.49 Forming a partnership with a non-practitioner.

A practitioner shall not form a partnership with a non–practitioner if any of the activities of the partnership consist of the practice of patent, trademark, or other law before the Office.

[Added 50 FR 5178, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.56 Canon 4.

A practitioner should preserve the confidences and secrets of a client.

[Added 50 FR 5178, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.57 Preservation of confidences and secrets of a client.

(a) "Confidence" refers to information protected by the attorney-client or agent-client privilege under applicable law. "Secret" refers to the other information gained in the professional relationship that the client has requested be held inviolate or the disclosure of which would be embarrassing or would be likely to be detrimental to the client.

(b) Except when permitted under paragraph (c) of this section, a practitioner shall not knowingly:

(1) Reveal a confidence or secret of a client.

(2) Use a confidence or secret of a client to the disadvantage of the client.

(3) Use a confidence or secret of a client for the advantage of the practitioner or of a third person, unless the client consents after full disclosure.

(c) A practitioner may reveal:

(1) Confidences or secrets with the consent of the client affected but only after a full disclosure to the client.

(2) Confidences or secrets when permitted under Disciplinary Rules or required by law or court order.

(3) The intention of a client to commit a crime and the information necessary to prevent the crime.

(4) Confidences or secrets necessary to establish or collect the practitioner's fee or to defend the practitioner or the practitioner's employees or associates against an accusation of wrongful conduct.

(d) A practitioner shall exercise reasonable care to prevent the practitioner's employees, associates, and others whose services are utilized by the practitioner from disclosing or using confidences or secrets of a client, except that a practitioner may reveal the information allowed by paragraph (c) of this section through an employee.

[Added 50 FR 5178, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.61 Canon 5.

A practitioner should exercise independent professional judgment on behalf of a client.

[Added 50 FR 5179, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.62 Refusing employment when the interest of the practitioner may impair the practitioner's independent professional judgment.

(a) Except with the consent of a client after full disclosure, a practitioner shall not accept employment if the exercise of the practitioner's professional judgment on behalf of the client will be or reasonably may be affected by the practitioner's own financial, business, property, or personal interests.

(b) A practitioner shall not accept employment in a proceeding before the Office if the practitioner knows or it is obvious that the practitioner or another practitioner in the practitioner's firm ought to sign an affidavit to be filed in the Office or be called as a witness, except that the practitioner may undertake the employment and the practitioner or another practitioner in the practitioner's firm may testify:

(1) If the testimony will relate solely to an uncontested matter.

(2) If the testimony will relate solely to a matter of formality and there is no reason to believe that substantial evidence will be offered in opposition to the testimony.

(3) If the testimony will relate solely to the nature and value of legal services rendered in the case by the practitioner or the practitioner's firm to the client.

(4) As to any matter, if refusal would work a substantial hardship on the client because of the distinctive value of the practitioner or the practitioner's firm as counsel in the particular case.

[Added 50 FR 5179, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.63 Withdrawal when the practitioner becomes a witness.

(a) If, after undertaking employment in a proceeding in the Office, a practitioner learns or it is obvious that the practitioner or another practitioner in the practitioner's firm ought to sign an affidavit to be filed in the Office or be called as a witness on behalf of a practitioner's client, the practitioner shall withdraw from the conduct of the proceeding and the practitioner's firm, if any, shall not continue representation in the proceeding, except that the practitioner may continue the

representation and the practitioner or another practitioner in the practitioner's firm may testify in the circumstances enumerated in paragraphs (1) through (4) of § 10.62(b).

(b) If, after undertaking employment in a proceeding before the Office, a practitioner learns or it is obvious that the practitioner or another practitioner in the practitioner's firm may be asked to sign an affidavit to be filed in the Office or be called as a witness other than on behalf of the practitioner's client, the practitioner may continue the representation until it is apparent that the practitioner's affidavit or testimony is or may be prejudicial to the practitioner's client.

[Added 50 FR 5179, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.64 Avoiding acquisition of interest in litigation or proceeding before the Office.

(a) A practitioner shall not acquire a proprietary interest in the subject matter of a proceeding before the Office which the practitioner is conducting for a client, except that the practitioner may:

(1) Acquire a lien granted by law to secure the practitioner's fee or expenses; or

(2) Contract with a client for a reasonable contingent fee; or

(3) In a patent case, take an interest in the patent as part or all of his or her fee.

(b) While representing a client in connection with a contemplated or pending proceeding before the Office, a practitioner shall not advance or guarantee financial assistance to a client, except that a practitioner may advance or guarantee the expenses of going forward in a proceeding before the Office including fees required by law to be paid to the Office, expenses of investigation, expenses of medical examination, and costs of obtaining and presenting evidence, provided the client remains ultimately liable for such expenses. A practitioner may, however, advance any fee required to prevent or remedy an abandonment of a client's application by reason of an act or omission attributable to the practitioner and not to the client, whether or not the client is ultimately liable for such fee.

[Added 50 FR 5179, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.65 Limiting business relations with a client.

A practitioner shall not enter into a business transaction with a client if they have differing interests therein and if the client expects the practitioner to exercise professional judgment therein for the protection of the client, unless the client has consented after full disclosure.

[Added 50 FR 5179, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.66 Refusing to accept or continue employment if the interests of another client may impair the independent professional judgment of the practitioner.

(a) A practitioner shall decline proffered employment if the exercise of the practitioner's independent professional judgment in behalf of a client will be or is likely to be adversely affected by the acceptance of the proffered employment, or if it would be likely to involve the practitioner in representing differing interests, except to the extent permitted under paragraph (c) of this section.

(b) A practitioner shall not continue multiple employment if the exercise of the practitioner's independent professional judgment in behalf of a client will be or is likely to be adversely affected by the practitioner's representation of another client, or if it would be likely to involve the practitioner in representing differing interests, except to the extent permitted under paragraph (c) of this section.

(c) In the situations covered by paragraphs (a) and (b) of this section, a practitioner may represent multiple clients if it is obvious that the practitioner can adequately represent the interest of each and if each consents to the representation after full disclosure of the possible effect of

such representation on the exercise of the practitioner's independent professional judgment on behalf of each.

(d) If a practitioner is required to decline employment or to withdraw from employment under a Disciplinary Rule, no partner, or associate, or any other practitioner affiliated with the practitioner or the practitioner's firm, may accept or continue such employment unless otherwise ordered by the Director or Commissioner.

[Added 50 FR 5179, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.67 Settling similar claims of clients.

A practitioner who represents two or more clients shall not make or participate in the making of an aggregate settlement of the claims of or against the practitioner's clients, unless each client has consented to the settlement after being advised of the existence and nature of all the claims involved in the proposed settlement, of the total amount of the settlement, and of the participation of each person in the settlement.

[Added 50 FR 5179, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.68 Avoiding influence by others than the client.

(a) Except with the consent of the practitioner's client after full disclosure, a practitioner shall not:

(1) Accept compensation from one other than the practitioner's client for the practitioner's legal services to or for the client.

(2) Accept from one other than the practitioner's client any thing of value related to the practitioner's representation of or the practitioner's employment by the client.

(b) A practitioner shall not permit a person who recommends, employs, or pays the practitioner to render legal services for another, to direct or regulate the practitioner's professional judgment in rendering such legal services.

(c) A practitioner shall not practice with or in the form of a professional corporation or association authorized to practice law for a profit, if a non-practitioner has the right to direct or control the professional judgment of a practitioner.

[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.76 Canon 6.

A practitioner should represent a client competently.

[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.77 Failing to act competently.

A practitioner shall not:

(a) Handle a legal matter which the practitioner knows or should know that the practitioner is not competent to handle, without associating with the practitioner another practitioner who is competent to handle it.

(b) Handle a legal matter without preparation adequate in the circumstances.

(c) Neglect a legal matter entrusted to the practitioner.

[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.78 Limiting liability to client.

A practitioner shall not attempt to exonerate himself or herself from, or limit his or her liability to, a client for his or her personal malpractice.

[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.83 Canon 7.

A practitioner should represent a client zealously within the bounds of the law.

[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.84 Representing a client zealously.

(a) A practitioner shall not intentionally:

(1) Fail to seek the lawful objectives of a client through reasonable available means permitted by law and the Disciplinary Rules, except as provided by paragraph (b) of this section. A practitioner does not violate the provisions of this section, however, by acceding to reasonable requests of opposing counsel which do not prejudice the rights of the client, by being punctual in fulfilling all professional commitments, by avoiding offensive tactics, or by treating with courtesy and consideration all persons involved in the legal process.

(2) Fail to carry out a contract of employment entered into with a client for professional services, but a practitioner may withdraw as permitted under §§ 10.40, 10.63, and 10.66.

(3) Prejudice or damage a client during the course of a professional relationship, except as required under this part.

(b) In representation of a client, a practitioner may:

(1) Where permissible, exercise professional judgment to waive or fail to assert a right or position of the client.

(2) Refuse to aid or participate in conduct that the practitioner believes to be unlawful, even though there is some support for an argument that the conduct is legal.

[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.85 Representing a client within the bounds of the law.

(a) In representation of a client, a practitioner shall not:

(1) Initiate or defend any proceeding before the Office, assert a position, conduct a defense, delay a trial or proceeding before the Office, or take other action on behalf of the practitioner's client when the practitioner knows or when it is obvious that such action would serve merely to harass or maliciously injure another.

(2) Knowingly advance a claim or defense that is unwarranted under existing law, except that a practitioner may advance such claim or defense if it can be supported by good faith argument for an extension, modification, or reversal of existing law.

(3) Conceal or knowingly fail to disclose that which the practitioner is required by law to reveal.

(4) Knowingly use perjured testimony or false evidence.

(5) Knowingly make a false statement of law or fact.

(6) Participate in the creation or preservation of evidence when the practitioner knows or it is obvious that the evidence is false.

(7) Counsel or assist a client in conduct that the practitioner knows to be illegal or fraudulent.

(8) Knowingly engage in other illegal conduct or conduct contrary to a Disciplinary Rule.

(b) A practitioner who receives information clearly establishing that:

(1) A client has, in the course of the representation, perpetrated a fraud upon a person or tribunal shall promptly call upon the client to rectify the same, and if the client refuses or is unable to do so the practitioner shall reveal the fraud to the affected person or tribunal.

(2) A person other than a client has perpetrated a fraud upon a tribunal shall promptly reveal the fraud to the tribunal.

[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.87 Communicating with one of adverse interest.

During the course of representation of a client, a practitioner shall not:

(a) Communicate or cause another to communicate on the subject of the representation with a party the practitioner knows to be represented by another practitioner in that matter unless the practitioner has the prior consent of the other practitioner representing such other party or is authorized by law to do so. It is not improper, however, for a practitioner to encourage a client to meet with an opposing party for settlement discussions.

(b) Give advice to a person who is not represented by a practitioner other than the advice to secure counsel, if the interests of such person are to have a reasonable possibility of being in conflict with the interests of the practitioner's client.

[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.88 Threatening criminal prosecution.

A practitioner shall not present, participate in presenting, or threaten to present criminal charges solely to obtain an advantage in any prospective or pending proceeding before the Office.

[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.89 Conduct in proceedings.

(a) A practitioner shall not disregard or advise a client to disregard any provision of this Subchapter or a decision of the Office made in the course of a proceeding before the Office, but the practitioner may take appropriate steps in good faith to test the validity of such provision or decision.

(b) In presenting a matter to the Office, a practitioner shall disclose:

(1) Controlling legal authority known to the practitioner to be directly adverse to the position of the client and which is not disclosed by opposing counsel or an employee of the Office.

(2) Unless privileged or irrelevant, the identities of the client the practitioner represents and of the persons who employed the practitioner.

(c) In appearing in a professional capacity before a tribunal, a practitioner shall not:

(1) State or allude to any matter that the practitioner has no reasonable basis to believe is relevant to the case or that will not be supported by admissible evidence.

(2) Ask any question that the practitioner has no reasonable basis to believe is relevant to the case and that is intended to degrade a witness or other person.

(3) Assert the practitioner's personal knowledge of the facts in issue, except when testifying as a witness.

(4) Assert the practitioner's personal opinion as to the justness of a cause, as to the credibility of a witness, as to the culpability of a civil litigant, or as to the guilt or innocence of an accused; but the practitioner may argue, on the practitioner's analysis of the evidence, for any position or conclusion with respect to the matters stated herein.

(5) Engage in undignified or discourteous conduct before the Office (see § 1.3 of the subchapter).

(6) Intentionally or habitually violate any provision of this subchapter or established rule of evidence.

[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.92 Contact with witnesses.

(a) A practitioner shall not suppress any evidence that the practitioner or the practitioner's client has a legal obligation to reveal or produce.

(b) A practitioner shall not advise or cause a person to be secreted or to leave the jurisdiction of a tribunal for the purpose of making the person unavailable as a witness therein.

(c) A practitioner shall not pay, offer to pay, or acquiesce in payment of compensation to a witness contingent upon the content of the witness' affidavit, testimony or the outcome of the case. But a practitioner may advance, guarantee, or acquiesce in the payment of:

(1) Expenses reasonably incurred by a witness in attending, testifying, or making an affidavit.

(2) Reasonable compensation to a witness for the witness' loss of time in attending, testifying, or making an affidavit.

(3) A reasonable fee for the professional services of an expert witness.

[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.93 Contact with officials.

(a) A practitioner shall not give or lend anything of value to a judge, official, or employee of a tribunal under circumstances which might give the appearance that the gift or loan is made to influence official action.

(b) In an adversary proceeding, including any *inter partes* proceeding before the Office, a practitioner shall not communicate, or cause another to communicate, as to the merits of the cause with a judge, official, or Office employee before whom the proceeding is pending, except:

(1) In the course of official proceedings in the cause.

(2) In writing if the practitioner promptly delivers a copy of the writing to opposing counsel or to the adverse party if the adverse party is not represented by a practitioner.

(3) Orally upon adequate notice to opposing counsel or to the adverse party if the adverse party is not represented by a practitioner.

(4) As otherwise authorized by law.

[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.100 Canon 8.

A practitioner should assist in improving the legal system.

[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.101 Action as a public official.

(a) A practitioner who holds public office shall not:

(1) Use the practitioner's public position to obtain, or attempt to obtain, a special advantage in legislative matters for the practitioner or for a client under circumstances where the practitioner knows or it is obvious that such action is not in the public interest.

(2) Use the practitioner's public position to influence, or attempt to influence, a tribunal to act in favor of the practitioner or of a client.

(3) Accept any thing of value from any person when the practitioner knows or it is obvious that the offer is for the purpose of influencing the practitioner's action as a public official.

(b) A practitioner who is an officer or employee of the United States shall not practice before the Office in patent cases except as provided in §§ 10.10(c) and 10.10(d).

[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985; para. (b) amended, 54 FR 6520, Feb. 13, 1989]

§ 10.102 Statements concerning officials.

(a) A practitioner shall not knowingly make false statements of fact concerning the qualifications of a candidate for election or appointment to a judicial office or to a position in the Office.

(b) A practitioner shall not knowingly make false accusations against a judge, other adjudicatory officer, or employee of the Office.

[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.103 Practitioner candidate for judicial office.

A practitioner who is a candidate for judicial office shall comply with applicable provisions of law.

[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.110 Canon 9.

A practitioner should avoid even the appearance of professional impropriety.

[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.111 Avoiding even the appearance of impropriety.

(a) A practitioner shall not accept private employment in a matter upon the merits of which he or she has acted in a judicial capacity.

(b) A practitioner shall not accept private employment in a matter in which he or she had personal responsibility while a public employee.

(c) A practitioner shall not state or imply that the practitioner is able to influence improperly or upon irrelevant grounds any tribunal, legislative body, or public official.

[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.112 Preserving identity of funds and property of client.

(a) All funds of clients paid to a practitioner or a practitioner's firm, other than advances for costs and expenses, shall be deposited in one or more identifiable bank accounts maintained in the United States or, in the case of a practitioner having an office in a foreign country or registered under § 11.6(c), in the United States or the foreign country.

(b) No funds belonging to the practitioner or the practitioner's firm shall be deposited in the bank accounts required by paragraph (a) of this section except as follows:

(1) Funds reasonably sufficient to pay bank charges may be deposited therein.

(2) Funds belonging in part to a client and in part presently or potentially to the practitioner or the practitioner's firm must be deposited therein, but the portion belonging to the practitioner or the practitioner's firm may be withdrawn when due unless the right of the practitioner or the practitioner's firm to receive it is disputed by the client, in which event the disputed portion shall not be withdrawn until the dispute is finally resolved.

(c) A practitioner shall:

(1) Promptly notify a client of the receipt of the client's funds, securities, or other properties.

(2) Identify and label securities and properties of a client promptly upon receipt and place them in a safe deposit box or other place of safekeeping as soon as practicable.

(3) Maintain complete records of all funds, securities, and other properties of a client coming into the possession of the practitioner and render appropriate accounts to the client regarding the funds, securities, or other properties.

(4) Promptly pay or deliver to the client as requested by a client the funds, securities, or other properties in the possession of the practitioner which the client is entitled to receive.

[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985; amended 70 FR 56119, Sept. 26, 2005, effective Nov. 25, 2005]

§ 10.130-10.145 [Reserved]

[Removed 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 10.149 -10.161 [Reserved]

[73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 10.170 [Reserved]

[73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

PART 11--REPRESENTATION OF OTHERS BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE

AUTHORITY: 5 U.S.C. 500, 15 U.S.C. 1123, 35 U.S.C. 2(b)(2), 32.

Subpart A--General Provisions

General Information

§ 11.1 Definitions.

This part governs solely the practice of patent, trademark, and other law before the United States Patent and Trademark Office. Nothing in this part shall be construed to preempt the authority of each State to regulate the practice of law, except to the extent necessary for the United States Patent and Trademark Office to accomplish its Federal objectives. Unless otherwise clear from the context, the following definitions apply to this part:

Attorney or lawyer means an individual who is a member in good standing of the highest court of any State, including an individual who is in good standing of the highest court of one State and not under an order of any court or Federal agency suspending, enjoining, restraining, disbarring or otherwise restricting the attorney from practice before the bar of another State or Federal agency. A *non-lawyer* means a person who is not an attorney or lawyer.

Belief or believes means that the person involved actually supposed the fact in question to be true. A person's belief may be inferred from circumstances.

Conviction or convicted means any confession to a crime; a verdict or judgment finding a person guilty of a crime; any entered plea, including *nolo contendre* or Alford plea, to a crime; or receipt of deferred adjudication (whether judgment or sentence has been entered or not) for an accused or pled crime.

Crime means any offense declared to be a felony or misdemeanor by Federal or State law in the jurisdiction where the act occurs.

Data sheet means a form used to collect the name, address, and telephone information from individuals recognized to practice before the Office in patent matters.

Disqualified means any action that prohibits a practitioner from participating in or appearing before the program or agency, regardless of how long the prohibition lasts or the specific terminology used.

Federal agency means any authority of the executive branch of the Government of the United States.

Federal program means any program established by an Act of Congress or administered by a Federal agency.

Fiscal year means the time period from October 1st through the ensuing September 30th.

Fraud or fraudulent means conduct having a purpose to deceive and not merely negligent misrepresentation or failure to apprise another of relevant information.

Good moral character and reputation means the possession of honesty and truthfulness, trustworthiness and reliability, and a professional commitment to the legal process and the administration of justice, as well as the condition of being regarded as possessing such qualities.

Knowingly, known, or knows means actual knowledge of the fact in question. A person's knowledge may be inferred from circumstances.

Matter means any litigation, administrative proceeding, lobbying activity, application, claim, investigation, controversy, arrest, charge, accusation, contract, negotiation, estate or family relations practice issue, request for a ruling or other determination, or any other matter covered by the conflict of interest rules of the appropriate Government entity.

Mandatory Disciplinary Rule is a rule identified in § 10.20(b) of this chapter as a Disciplinary Rule.

OED means the Office of Enrollment and Discipline.

OED Director means the Director of the Office of Enrollment and Discipline.

OED Director's representatives means attorneys within the USPTO Office of General Counsel who act as representatives of the OED Director.

Office means the United States Patent and Trademark Office.

Practitioner means:

(1) An attorney or agent registered to practice before the Office in patent matters,

(2) An individual authorized under 5 U.S.C. 500(b) or otherwise as provided by § 10.14(b), (c), and (e) of this subchapter, to practice before the Office in trademark matters or other non-patent matters, or

(3) An individual authorized to practice before the Office in a patent case or matters under § 11.9(a) or (b).

Proceeding before the Office means an application for patent, an application for reissue, a reexamination, a protest, a public use matter, an *inter partes* patent matter, correction of a patent, correction of inventorship, an application to register a trademark, an *inter partes* trademark matter, an appeal, a petition, and any other matter that is pending before the Office.

Reasonable or reasonably when used in relation to conduct by a practitioner means the conduct of a reasonably prudent and competent practitioner.

Registration means registration to practice before the Office in patent proceedings.

Roster means a list of individuals who have been registered as either a patent attorney or patent agent.

Serious Crime means:

(1) Any criminal offense classified as a felony under the laws of the United States, any state or any foreign country where the crime occurred; or

(2) Any crime a necessary element of which, as determined by the statutory or common law definition of such crime in the jurisdiction where the crime occurred, includes interference with the administration of justice, false swearing, misrepresentation, fraud, willful failure to file income tax returns, deceit, bribery, extortion, misappropriation, theft, or an attempt or a conspiracy or solicitation of another to commit a “serious crime.”

Significant evidence of rehabilitation means satisfactory evidence that is significantly more probable than not that there will be no recurrence in the foreseeable future of the practitioner's prior disability or addiction.

State means any of the 50 states of the United States of America, the District of Columbia, and any Commonwealth or territory of the United States of America.

Substantial when used in reference to degree or extent means a material matter of clear and weighty importance.

Suspend or suspension means a temporary debarring from practice before the Office or other jurisdiction.

United States means the United States of America, and the territories and possessions the United States of America.

USPTO Director means the Director of the United States Patent and Trademark Office, or an employee of the Office delegated authority to act for the Director of the United States Patent and Trademark Office in matters arising under this part.

[Added 69 FR 35428, June 24, 2004, effective July 26, 2004; amended 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.2 Director of the Office of Enrollment and Discipline.

(a) *Appointment*. The USPTO Director shall appoint a Director of the Office of Enrollment and Discipline (OED Director). In the event of a vacancy in the office of the OED Director, the USPTO Director may designate an employee of the Office to serve as acting OED Director. The OED Director shall be an active member in good standing of the bar of the highest court of a State.

(b) *Duties*. The OED Director shall:

(1) Supervise staff as may be necessary for the performance of the OED Director's duties.

(2) Receive and act upon applications for registration, prepare and grade the examination provided for in § 11.7(b), maintain the register provided for in § 11.5, and perform such other duties in connection with enrollment and recognition of attorneys and agents as may be necessary.

(3) Conduct investigations into the moral character and reputation of any individual seeking to be registered as an attorney or agent, or of any individual seeking limited recognition, deny registration or recognition of individuals failing to demonstrate possession of good moral character and reputation, and perform such other duties in connection with enrollment matters and investigations as may be necessary.

(4) Conduct investigations of matters involving possible grounds for discipline of practitioners coming to the attention of the OED Director. Except in matters meriting summary dismissal, no disposition under § 11.22(h) shall be recommended or undertaken by the OED Director until the accused practitioner shall have been afforded an opportunity to respond to a reasonable inquiry by the OED Director.

(5) With the consent of a panel of three members of the Committee on Discipline, initiate disciplinary proceedings under § 11.32 and perform such other duties in connection with investigations and disciplinary proceedings as may be necessary.

(6) Oversee the preliminary screening of information and close investigations as provided for in § 11.22.

(7) [Reserved]

(c) *Petition to OED Director regarding enrollment or recognition*. Any petition from any action or requirement of the staff of OED reporting to the OED Director shall be taken to the OED Director accompanied by payment of the fee set forth in § 1.21(a)(5)(i) of this chapter. Any such petition not filed within sixty days from the mailing date of the action or notice from which relief is requested will be dismissed as untimely. The filing of a petition will neither stay the period for taking other action which may be running, nor stay other proceedings. The petitioner may file a single request for reconsideration of a decision within thirty days of the date of the decision. Filing a request for reconsideration stays the period for seeking review of the OED Director's decision until a final decision on the request for reconsideration is issued. A final decision by the OED Director may be reviewed in accordance with the provisions of paragraph (d) of this section.

(d) *Review of OED Director's decision regarding enrollment or recognition*. A party dissatisfied with a final decision of the OED Director regarding enrollment or recognition may seek review of the decision upon petition to the USPTO Director accompanied by payment of the fee set forth in § 1.21(a)(5)(ii) of this chapter. Any such petition to the USPTO Director waives a right to seek reconsideration from the OED Director. Any petition not filed within thirty days after the final decision of the OED Director may be dismissed as untimely. Briefs or memoranda, if any, in support of the petition shall accompany the petition. The petition will be decided on the basis of the record made before the OED Director. The USPTO Director in deciding the petition will consider no new evidence. Copies of documents already of record before the OED Director shall not be submitted with the petition. An oral hearing will not be granted except when considered necessary by the USPTO Director. Any request for reconsideration of the decision of the USPTO Director may be dismissed as untimely if not filed within thirty days after the date of said decision.

(e) *Petition to USPTO Director in disciplinary matters*. Petition may be taken to the USPTO Director to invoke the supervisory authority of the USPTO Director in appropriate circumstances in disciplinary matters. Any such petition must contain a statement of the facts involved and the

point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support of the petition must accompany the petition. Where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition. The OED Director may be directed by the USPTO Director to file a reply to the petition, supplying a copy to the petitioner. An oral hearing will not be granted except when considered necessary by the USPTO Director. The mere filing of a petition will not stay an investigation, disciplinary proceeding or other proceedings. Any petition under this part not filed within thirty days of the mailing date of the action or notice from which relief is requested may be dismissed as untimely. Any request for reconsideration of the decision of the USPTO Director may be dismissed as untimely if not filed within thirty days after the date of said decision.

[Added 69 FR 35428, June 24, 2004, effective July 26, 2004; amended 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.3 Suspension of rules.

(a) In an extraordinary situation, when justice requires, any requirement of the regulations of this Part which is not a requirement of statute may be suspended or waived by the USPTO Director or the designee of the USPTO Director, *sua sponte,* or on petition by any party, including the OED Director or the OED Director's representative, subject to such other requirements as may be imposed.

(b) No petition under this section shall stay a disciplinary proceeding unless ordered by the USPTO Director or a hearing officer.

[Added 69 FR 35428, June 24, 2004, effective July 26, 2004; amended 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

Subpart B--Recognition To Practice Before the USPTO

Patents, Trademarks, and Other Non-Patent Law

§ 11.4 [Reserved]

§ 11.5 Register of attorneys and agents in patent matters; practice before the Office.

(a) A register of attorneys and agents is kept in the Office on which are entered the names of all individuals recognized as entitled to represent applicants having prospective or immediate business before the Office in the preparation and prosecution of patent applications. Registration in the Office under the provisions of this part shall entitle the individuals so registered to practice before the Office only in patent matters.

(b) *Practice before the Office.* Practice before the Office includes, but is not limited to, law-related service that comprehends any matter connected with the presentation to the Office or any of its officers or employees relating to a client's rights, privileges, duties, or responsibilities under the laws or regulations administered by the Office for the grant of a patent or registration of a trademark, or for enrollment or disciplinary matters. Such presentations include preparing necessary documents in contemplation of filing the documents with the Office, corresponding and communicating with the Office, and representing a client through documents or at interviews, hearings, and meetings, as well as communicating with and advising a client concerning matters pending or contemplated to be presented before the Office. Nothing in this section proscribes a practitioner from employing or retaining non-practitioner assistants under the supervision of the

practitioner to assist the practitioner in matters pending or contemplated to be presented before the Office.

(1) *Practice before the Office in patent matters*. Practice before the Office in patent matters includes, but is not limited to, preparing and prosecuting any patent application, consulting with or giving advice to a client in contemplation of filing a patent application or other document with the Office, drafting the specification or claims of a patent application; drafting an amendment or reply to a communication from the Office that may require written argument to establish the patentability of a claimed invention; drafting a reply to a communication from the Office regarding a patent application; and drafting a communication for a public use, interference, reexamination proceeding, petition, appeal to or any other proceeding before the Board of Patent Appeals and Interferences, or other proceeding. Registration to practice before the Office in patent cases sanctions the performance of those services which are reasonably necessary and incident to the preparation and prosecution of patent applications or other proceeding before the Office involving a patent application or patent in which the practitioner is authorized to participate. The services include:

(i) Considering the advisability of relying upon alternative forms of protection which may be available under state law, and

(ii) Drafting an assignment or causing an assignment to be executed for the patent owner in contemplation of filing or prosecution of a patent application for the patent owner, where the practitioner represents the patent owner after a patent issues in a proceeding before the Office, and when drafting the assignment the practitioner does no more than replicate the terms of a previously existing oral or written obligation of assignment from one person or party to another person or party.

(2) *Practice before the Office in trademark matters*. Practice before the Office in trademark matters includes, but is not limited to, consulting with or giving advice to a client in contemplation of filing a trademark application or other document with the Office; preparing and prosecuting an application for trademark registration; preparing an amendment which may require written argument to establish the registrability of the mark; and conducting an opposition, cancellation, or concurrent use proceeding; or conducting an appeal to the Trademark Trial and Appeal Board.

[Added 69 FR 35428, June 24, 2004, effective July 26, 2004; amended 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.6 Registration of attorneys and agents.

(a) *Attorneys*. Any citizen of the United States who is an attorney and who fulfills the requirements of this part may be registered as a patent attorney to practice before the Office. When appropriate, any alien who is an attorney, who lawfully resides in the United States, and who fulfills the requirements of this part may be registered as a patent attorney to practice before the Office, provided that such registration is not inconsistent with the terms upon which the alien was admitted to, and resides in, the United States and further provided that the alien may remain registered only:

(1) If the alien continues to lawfully reside in the United States and registration does not become inconsistent with the terms upon which the alien continues to lawfully reside in the United States, or

(2) If the alien ceases to reside in the United States, the alien is qualified to be registered under paragraph (c) of this section. See also § 11.9(b).

(b) *Agents*. Any citizen of the United States who is not an attorney, and who fulfills the requirements of this part may be registered as a patent agent to practice before the Office. When appropriate, any alien who is not an attorney, who lawfully resides in the United States, and who fulfills the requirements of this part may be registered as a patent agent to practice before the Office, provided that such registration is not inconsistent with the terms upon which the alien was

admitted to, and resides in, the United States, and further provided that the alien may remain registered only:

(1) If the alien continues to lawfully reside in the United States and registration does not become inconsistent with the terms upon which the alien continues to lawfully reside in the United States or

(2) If the alien ceases to reside in the United States, the alien is qualified to be registered under paragraph (c) of this section. See also § 11.9(b).

(c) *Foreigners*. Any foreigner not a resident of the United States who shall file proof to the satisfaction of the OED Director that he or she is registered and in good standing before the patent office of the country in which he or she resides and practices, and who is possessed of the qualifications stated in § 11.7, may be registered as a patent agent to practice before the Office for the limited purpose of presenting and prosecuting patent applications of applicants located in such country, provided that the patent office of such country allows substantially reciprocal privileges to those admitted to practice before the Office. Registration as a patent agent under this paragraph shall continue only during the period that the conditions specified in this paragraph obtain. Upon notice by the patent office of such country that a patent agent registered under this section is no longer registered or no longer in good standing before the patent office of such country, and absent a showing of cause why his or her name should not be removed from the register, the OED Director shall promptly remove the name of the patent agent from the register and publish the fact of removal. Upon ceasing to reside in such country, the patent agent registered under this section is no longer qualified to be registered under this section, and the OED Director shall promptly remove the name of the patent agent from the register and publish the fact of removal.

(d) *Interference matters*. The Chief Administrative Patent Judge or Vice Chief Administrative Patent Judge of the Board of Patent Appeals and Interferences shall determine whether and the circumstances under which an attorney who is not registered may take testimony for an interference under 35 U.S.C. 24, or under § 1.672 of this subchapter.

[Added 69 FR 35428, June 24, 2004, effective July 26, 2004]

§ 11.7 Requirements for registration.

(a) No individual will be registered to practice before the Office unless he or she has:

(1) Applied to the USPTO Director in writing by completing an application for registration form supplied by the OED Director and furnishing all requested information and material; and

(2) Established to the satisfaction of the OED Director that he or she:

(i) Possesses good moral character and reputation;

(ii) Possesses the legal, scientific, and technical qualifications necessary for him or her to render applicants valuable service; and

(iii) Is competent to advise and assist patent applicants in the presentation and prosecution of their applications before the Office.

(b)(1) To enable the OED Director to determine whether an individual has the qualifications specified in paragraph (a)(2) of this section, the individual shall:

(i) File a complete application for registration each time admission to the registration examination is requested. A complete application for registration includes:

(A) An application for registration form supplied by the OED Director wherein all requested information and supporting documents are furnished,

(B) Payment of the fees required by § 1.21(a)(1) of this subchapter,

(C) Satisfactory proof of scientific and technical qualifications,

and

(D) For aliens, provide proof that recognition is not inconsistent with the terms of their visa or entry into the United States;

(ii) Pass the registration examination, unless the taking and passing of the examination is waived as provided in paragraph (d) of this section. Unless examination is waived pursuant to

paragraph (d) of this section, each individual seeking registration must take and pass the registration examination to enable the OED Director to determine whether the individual possesses the legal and competence qualifications specified in paragraphs (a)(2)(ii) and (a)(2)(iii) of this section. An individual failing the examination may, upon receipt of notice of failure from OED, reapply for admission to the examination. An individual failing the examination must wait thirty days after the date the individual last took the examination before retaking the examination. An individual reapplying shall:

(A) File a completed application for registration form wherein all requested information and supporting documents are furnished,

(B) Pay the fees required by § 1.21(a)(1) of this subchapter, and

(C) For aliens, provide proof that recognition is not inconsistent with the terms of their visa or entry into the United States; and

(iii) Provide satisfactory proof of possession of good moral character and reputation.

(2) An individual failing to file a complete application for registration will not be admitted to the examination and will be notified of the incompleteness. Applications for registration that are incomplete as originally submitted will be considered only when they have been completed and received by OED, provided that this occurs within sixty days of the mailing date of the notice of incompleteness. Thereafter, a new and complete application for registration must be filed. Only an individual approved as satisfying the requirements of paragraphs (b)(1)(i)(A), (b)(1)(i)(B), (b)(1)(i)(C) and (b)(1)(i)(D) of this section may be admitted to the examination.

(3) If an individual does not reapply until more than one year after the mailing date of a notice of failure, that individual must again comply with paragraph (b)(1)(i) of this section.

(c) Each individual seeking registration is responsible for updating all information and answers submitted in or with the application for registration based upon anything occurring between the date the application for registration is signed by the individual, and the date he or she is registered or recognized to practice before the Office in patent matters. The update shall be filed within thirty days after the date of the occasion that necessitates the update.

(d) *Waiver of the Registration Examination for Former Office Employees*.

(1) *Former patent examiners who by July 26, 2004, had not actively served four years in the patent examining corps, and were serving in the corps at the time of their separation*. The OED Director may waive the taking of a registration examination in the case of any individual meeting the requirements of paragraph (b)(1)(i)(C) of this section who is a former patent examiner but by July 26, 2004, had not served four years in the patent examining corps, if the individual demonstrates that he or she:

(i) Actively served in the patent examining corps of the Office and was serving in the corps at the time of separation from the Office;

(ii) Received a certificate of legal competency and negotiation authority;

(iii) After receiving the certificate of legal competency and negotiation authority, was rated at least fully successful in each quality performance element of his or her performance plan for the last two complete fiscal years as a patent examiner; and

(iv) Was not under an oral or written warning regarding the quality performance elements at the time of separation from the patent examining corps.

(2) *Former patent examiners who on July 26, 2004, had actively served four years in the patent examining corps, and were serving in the corps at the time of their separation*. The OED Director may waive the taking of a registration examination in the case of any individual meeting the requirements of paragraph (b)(1)(i)(C) of this section who is a former patent examiner and by July 26, 2004, had served four years in the patent examining corps, if the individual demonstrates that he or she:

(i) Actively served for at least four years in the patent examining corps of the Office by July 26, 2004, and was serving in the corps at the time of separation from the Office;

(ii) Was rated at least fully successful in each quality performance element of his or her performance plan for the last two complete fiscal years as a patent examiner in the Office; and

(iii) Was not under an oral or written warning regarding the quality performance elements at the time of separation from the patent examining corps.

(3) *Certain former Office employees who were not serving in the patent examining corps upon their separation from the Office*. The OED Director may waive the taking of a registration examination in the case of a former Office employee meeting the requirements of paragraph (b)(1)(i)(C) of this section who by petition demonstrates possession of the necessary legal qualifications to render to patent applicants and others valuable service and assistance in the preparation and prosecution of their applications or other business before the Office by showing that he or she has:

(i) Exhibited comprehensive knowledge of patent law equivalent to that shown by passing the registration examination as a result of having been in a position of responsibility in the Office in which he or she:

(A) Provided substantial guidance on patent examination policy, including the development of rule or procedure changes, patent examination guidelines, changes to the Manual of Patent Examining Procedure, development of training or testing materials for the patent examining corps, or development of materials for the registration examination or continuing legal education; or

(B) Represented the Office in patent cases before Federal courts; and

(ii) Was rated at least fully successful in each quality performance element of his or her performance plan for said position for the last two complete rating periods in the Office, and was not under an oral or written warning regarding such performance elements at the time of separation from the Office.

(4) To be eligible for consideration for waiver, an individual formerly employed by the Office within the scope of one of paragraphs (d)(1), (d)(2) or (d)(3) of this section must file a complete application for registration and pay the fee required by § 1.21(a)(1)(i) of this subchapter within two years of the individual's date of separation from the Office. All other individuals formerly employed by the Office, including former examiners, filing an application for registration or fee more than two years after separation from the Office, are required to take and pass the registration examination. The individual or former examiner must pay the examination fee required by § 1.21(a)(1)(ii) of this subchapter within thirty days after notice of non-waiver.

(e) *Examination results*. Notification of the examination results is final. Within sixty days of the mailing date of a notice of failure, the individual is entitled to inspect, but not copy, the questions and answers he or she incorrectly answered. Review will be under supervision. No notes may be taken during such review. Substantive review of the answers or questions may not be pursued by petition for regrade. An individual who failed the examination has the right to retake the examination an unlimited number of times upon payment of the fees required by § 1.21(a)(1)(i) and (ii) of this subchapter, and a fee charged by a commercial entity administering the examination.

(f) *Application for reciprocal recognition*. An individual seeking reciprocal recognition under § 11.6(c), in addition to satisfying the provisions of paragraphs (a) and (b) of this section, and the provisions of § 11.8(c), shall pay the application fee required by §1.21(a)(1)(i) of this subchapter upon filing an application for registration.

(g) *Investigation of good moral character and reputation*.

(1) Every individual seeking recognition shall answer all questions in the application for registration and request(s) for comments issued by OED; disclose all relevant facts, dates and information; and provide verified copies of documents relevant to his or her good moral character and reputation. An individual who is an attorney shall submit a certified copy of each of his or her State bar applications and moral character determinations, if available.

(2)(i) If the OED Director receives information from any source that reflects adversely on the good moral character or reputation of an individual seeking registration or recognition, the OED Director shall conduct an investigation into the good moral character and reputation of that individual. The investigation will be conducted after the individual has passed the registration examination, or after the registration examination has been waived for the individual, as applicable. An individual failing to timely answer questions or respond to an inquiry by OED shall

be deemed to have withdrawn his or her application, and shall be required to reapply, pass the examination, and otherwise satisfy all the requirements of this section. No individual shall be certified for registration or recognition by the OED Director until, to the satisfaction of the OED Director, the individual demonstrates his or her possession of good moral character and reputation.

(ii) The OED Director, in considering an application for registration by an attorney, may accept a State bar's character determination as meeting the requirements set forth in paragraph (g) of this section if, after review, the Office finds no substantial discrepancy between the information provided with his or her application for registration and the State bar application and moral character determination, provided that acceptance is not inconsistent with other rules and the requirements of 35 U.S.C. 2(b)(2)(D).

(h) *Good moral character and reputation*. Evidence showing lack of good moral character and reputation may include, but is not limited to, conviction of a felony or a misdemeanor identified in paragraph (h)(1) of this section, drug or alcohol abuse; lack of candor; suspension or disbarment on ethical grounds from a State bar; and resignation from a State bar while under investigation.

(1) *Conviction of felony or misdemeanor*. An individual who has been convicted of a felony or a misdemeanor involving moral turpitude, breach of trust, interference with the administration of justice, false swearing, misrepresentation, fraud, deceit, bribery, extortion, misappropriation, theft, or conspiracy to commit any felony or misdemeanor, is presumed not to be of good moral character and reputation in the absence of a pardon or a satisfactory showing of reform and rehabilitation, and shall file with his or her application for registration the fees required by § 1.21(a)(1)(ii) and (a)(10) of this subchapter. The OED Director shall determine whether individuals convicted of said felony or misdemeanor provided satisfactory proof of reform and rehabilitation.

(i) An individual who has been convicted of a felony or a misdemeanor identified in paragraph (h)(1) of this section shall not be eligible to apply for registration during the time of any sentence (including confinement or commitment to imprisonment), deferred adjudication, and period of probation or parole as a result of the conviction, and for a period of two years after the date of completion of the sentence, deferred adjudication, and period of probation or parole, whichever is later.

(ii) The following presumptions apply to the determination of good moral character and reputation of an individual convicted of said felony or misdemeanor:

(A) The court record or docket entry of conviction is conclusive evidence of guilt in the absence of a pardon or a satisfactory showing of reform or rehabilitation; and

(B) An individual convicted of a felony or any misdemeanor identified in paragraph (h)(1) of this section is conclusively deemed not to have good moral character and reputation, and shall not be eligible to apply for registration for a period of two years after completion of the sentence, deferred adjudication, and period of probation or parole, whichever is later.

(iii) The individual, upon applying for registration, shall provide satisfactory evidence that he or she is of good moral character and reputation.

(iv) Upon proof that a conviction has been set aside or reversed, the individual shall be eligible to file a complete application for registration and the fee required by § 1.21(a)(1)(ii) of this subchapter and, upon passing the registration examination, have the OED Director determine, in accordance with paragraph (h)(1) of this section, whether, absent the conviction, the individual possesses good moral character and reputation.

(2) *Good moral character and reputation involving drug or alcohol abuse*. An individual's record is reviewed as a whole to see if there is a drug or alcohol abuse issue. An individual appearing to abuse drugs or alcohol may be asked to undergo an evaluation, at the individual's expense, by a qualified professional approved by the OED Director. In instances where, before an investigation commences, there is evidence of a present abuse or an individual has not established a record of recovery, the OED Director may request the individual to withdraw his or her application, and require the individual to satisfactorily demonstrate that he or she is complying with treatment and undergoing recovery.

(3) Moral character and reputation involving lack of candor. An individual's lack of candor in disclosing facts bearing on or relevant to issues concerning good moral character and reputation when completing the application or any time thereafter may be found to be

cause to deny registration on moral character and reputation grounds.

(4) *Moral character and reputation involving suspension, disbarment, or resignation from a profession*. (i) An individual who has been disbarred or suspended from practice of law or other profession, or has resigned in lieu of a disciplinary proceeding (excluded or disbarred on consent) shall be ineligible to apply for registration as follows:

(A) An individual who has been disbarred from practice of law or other profession, or has resigned in lieu of a disciplinary proceeding (excluded or disbarred on consent) shall be ineligible to apply for registration for a period of five years from the date of disbarment or

resignation.

(B) An individual who has been suspended on ethical grounds from the practice of law or other profession shall be ineligible to apply for registration until expiration of the period of suspension.

(C) An individual who was not only disbarred, suspended or resigned in lieu of a disciplinary proceeding, but also convicted in a court of a felony, or of a crime involving moral turpitude or breach of trust, shall be ineligible to apply for registration until the conditions in paragraphs (h)(1) and (h)(4) of this section are fully satisfied.

(ii) An individual who has been disbarred or suspended, or who resigned in lieu of a disciplinary proceeding shall file an application for registration and the fees required by § 1.21(a)(1)(ii) and (a)(10) of this subchapter; provide a full and complete copy of the proceedings that led to the disbarment, suspension, or resignation; and provide satisfactory proof that he or she possesses good moral character and reputation. The following presumptions shall govern the determination of good moral character and reputation of an individual who has been licensed to practice law or other profession in any jurisdiction and has been disbarred, suspended on ethical grounds, or allowed to resign in lieu of discipline, in that jurisdiction:

(A) A copy of the record resulting in disbarment, suspension or resignation is *prima facie* evidence of the matters contained in the record, and the imposition of disbarment or suspension, or the acceptance of the resignation of the individual shall be deemed conclusive that the individual has committed professional misconduct.

(B) The individual is ineligible for registration and is deemed not to have good moral character and reputation during the period of the imposed discipline.

(iii) The only defenses available with regard to an underlying disciplinary matter resulting in disbarment, suspension on ethical grounds, or resignation in lieu of a disciplinary proceeding are set out below, and must be shown to the satisfaction of the OED Director:

(A) The procedure in the disciplinary court was so lacking in notice or opportunity to be heard as to constitute a deprivation of due process;

(B) There was such infirmity of proof establishing the misconduct as to give rise to the clear conviction that the Office could not, consistently with its duty, accept as final the conclusion on that subject; or

(C) The finding of lack of good moral character and reputation by the Office would result in grave injustice.

(i) *Factors that may be taken into consideration when evaluating rehabilitation of an individual seeking a moral character and reputation determination*. The factors enumerated below are guidelines to assist the OED Director in determining whether an individual has demonstrated rehabilitation from an act of misconduct or moral turpitude. The factors include:

(1) The nature of the act of misconduct, including whether it involved moral turpitude, whether there were aggravating or mitigating circumstances, and whether the activity was an isolated event or part of a pattern;

(2) The age and education of the individual at the time of the misconduct and the age and education of the individual at the present time;

(3) The length of time that has passed between the misconduct and the present, absent any involvement in any further acts of moral turpitude, the amount of time and the extent of

rehabilitation being dependent upon the nature and seriousness of the act of misconduct under consideration;

(4) Restitution by the individual to any person who suffered monetary losses through acts or omissions of the individual;

(5) Expungement of a conviction;

(6) Successful completion or early discharge from probation or parole;

(7) Abstinence from the use of controlled substances or alcohol for not less than two years if the specific misconduct was attributable in part to the use of a controlled substance or alcohol, where abstinence may be demonstrated by, but is not necessarily limited to, enrolling in and complying with a self-help or professional treatment program;

(8) If the specific misconduct was attributable in part to a medically recognized mental disease, disorder or illness, proof that the individual sought professional assistance, and complied with the treatment program prescribed by the professional, and submitted letters from the treating psychiatrist/psychologist verifying that the medically recognized mental disease, disorder or illness will not impede the individual's ability to competently practice before the Office;

(9) Payment of the fine imposed in connection with any criminal conviction;

(10) Correction of behavior responsible in some degree for the misconduct;

(11) Significant and conscientious involvement in programs designed to provide social benefits or to ameliorate social problems; and

(12) Change in attitude from that which existed at the time of the act of misconduct in question as evidenced by any or all of the following:

(i) Statements of the individual;

(ii) Statements from persons familiar with the individual's previous misconduct and with subsequent attitudes and behavioral patterns;

(iii) Statements from probation or parole officers or law enforcement officials as to the individual's social adjustments; and

(iv) Statements from persons competent to testify with regard to neuropsychiatry or emotional disturbances.

(j) *Notice to Show Cause*. The OED Director shall inquire into the good moral character and reputation of an individual seeking registration, providing the individual with the opportunity to create a record on which a decision is made. If, following inquiry and consideration of the record, the OED Director is of the opinion that the individual seeking registration has not satisfactorily established that he or she possesses good moral character and reputation, the OED Director shall issue to the individual a notice to show cause why the individual's application for registration should not be denied.

(1) The individual shall be given no less than ten days from the date of the notice to reply. The notice shall be given by certified mail at the address appearing on the application if the address is in the United States, and by any other reasonable means if the address is outside the United States.

(2) Following receipt of the individual's response, or in the absence of a response, the OED Director shall consider the individual's response, if any, and the record, and determine whether, in the OED Director's opinion, the individual has sustained his or her burden of satisfactorily demonstrating that he or she possesses good moral character and reputation.

(k) *Reapplication for registration*. An individual who has been refused registration for lack of good moral character or reputation may reapply for registration two years after the date of the decision, unless a shorter period is otherwise ordered by the USPTO Director. An individual, who has been notified that he or she is under investigation for good moral character and reputation may elect to withdraw his or her application for registration, and may reapply for registration two years after the date of withdrawal. Upon reapplication for registration, the individual shall pay the fees required by § 1.21(a)(1)(ii) and (a)(10) of this subchapter, and has the burden of showing to the satisfaction of the OED Director his or her possession of good moral character and reputation as prescribed in paragraph (b) of this section. Upon reapplication for registration, the individual

also shall complete successfully the examination prescribed in paragraph (b) of this section, even though the individual has previously passed a registration examination.

[Added 69 FR 35428, June 24, 2004, effective July 26, 2004]

§ 11.8 Oath and registration fee.

(a) After an individual passes the examination, or the examination is waived, the OED Director shall promptly publish a solicitation for information concerning the individual's good moral character and reputation. The solicitation shall include the individual's name, and business or communication postal address.

(b) An individual shall not be registered as an attorney under § 11.6(a), registered as an agent under § 11.6(b) or (c), or granted limited recognition under § 11.9(b) unless within two years of the mailing date of a notice of passing registration examination or of waiver of the examination the individual files with the OED Director a completed Data Sheet, an oath or declaration prescribed by the USPTO Director, and the registration fee set forth in § 1.21(a)(2) of this subchapter. An individual seeking registration as an attorney under § 11.6(a) must provide a certificate of good standing of the bar of the highest court of a State that is no more than six months old.

(c) An individual who does not comply with the requirements of paragraph (b) of this section within the two-year period will be required to retake the registration examination.

(d) *Annual practitioner maintenance fee*. A registered patent attorney or agent shall annually pay to the USPTO Director a practitioner maintenance fee in the amount set forth in § 1.21(a)(7) of this subchapter. Individuals granted limited recognition under paragraph (b) of § 11.9 shall annually pay to the USPTO Director a practitioner maintenance fee in the amount set forth in § 1.21(a)(8) of this subchapter. Adequate notice shall be published and sent to practitioners in advance of the due date for payment of the annual practitioner maintenance fee. Payment shall be for the fiscal year in which the annual practitioner maintenance fee is assessed. Payment shall be due by the last day of the payment period. Persons newly registered or granted limited recognition shall not be liable for the annual practitioner maintenance fee during the fiscal year in which they are first registered or granted limited recognition. Failure to comply with the provisions of this paragraph (d) shall require the OED Director to subject a practitioner to a delinquency fee penalty set forth in § 11.11(b)(1), and further financial penalties and administrative suspension as set forth in § 11.11(b)(2) and (b)(3).

[Added 69 FR 35428, June 24, 2004, effective July 26, 2004; amended 73 FR 67750, Nov. 17, 2008, effective Dec. 17, 2008]

§ 11.9 Limited recognition in patent matters.

(a) Any individual not registered under § 11.6 may, upon a showing of circumstances which render it necessary or justifiable, and that the individual is of good moral character and reputation, be given limited recognition by the OED Director to prosecute as attorney or agent a specified patent application or specified patent applications. Limited recognition under this paragraph shall not extend further than the application or applications specified. Limited recognition shall not be granted while individuals who have passed the examination or for whom the examination has been waived are awaiting registration to practice before the Office in patent matters.

(b) A nonimmigrant alien residing in the United States and fulfilling the provisions of § 11.7(a) and (b) may be granted limited recognition if the nonimmigrant alien is authorized by the Bureau of Citizenship and Immigration Services to be employed or trained in the United States in the capacity of representing a patent applicant by presenting or prosecuting a patent application. Limited recognition shall be granted for a period consistent with the terms of authorized employment or training. Limited recognition shall not be granted or extended to a non-United

States citizen residing abroad. If granted, limited recognition shall automatically expire upon the nonimmigrant alien's departure from the United States.

(c) An individual not registered under § 11.6 may, if appointed by an applicant, prosecute an international patent application only before the United States International Searching Authority and the United States International Preliminary Examining Authority, provided that the individual has the right to practice before the national office with which the international application is filed as provided in PCT Art. 49, Rule 90 and § 1.455 of this subchapter, or before the International Bureau when the USPTO is acting as Receiving Office pursuant to PCT Rules 83.1 bis and 90.1.

[Added 69 FR 35428, June 24, 2004, effective July 26, 2004]

§ 11.10 Restrictions on practice in patent matters.

(a) Only practitioners who are registered under § 11.6 or individuals given limited recognition under § 11.9(a) or (b) are permitted to prosecute patent applications of others before the Office; or represent others in any proceedings before the Office.

(b) *Post employment agreement of former Office employee*. No individual who has served in the patent examining corps or elsewhere in the Office may practice before the Office after termination of his or her service, unless he or she signs a written undertaking agreeing:

(1) To not knowingly act as agent or attorney for, or otherwise represent, or assist in any manner the representation of, any other person:

(i) Before the Office,

(ii) In connection with any particular patent or patent application,

(iii) In which said employee participated personally and substantially as an employee of the Office; and

(2) To not knowingly act within two years after terminating employment by the Office as agent or attorney for, or otherwise represent, or assist in any manner the representation of any other person:

(i) Before the Office,

(ii) In connection with any particular patent or patent application,

(iii) If such patent or patent application was pending under the employee's official responsibility as an officer or employee within a period of one year prior to the termination of such responsibility.

(3) The words and phrases in paragraphs (b)(1) and (b)(2) of this section are construed as follows:

(i) *Represent and representation* mean acting as patent attorney or patent agent or other representative in any appearance before the Office, or communicating with an employee of the Office with intent to influence.

(ii) *Assist in any manner* means aid or help another person on a particular patent or patent application involving representation.

(iii) *Particular patent or patent application* means any patent or patent application, including, but not limited to, a provisional, substitute, international, continuation, divisional, continuation-in-part, or reissue patent application, as well as any protest, reexamination, petition, appeal, or interference based on the patent or patent application.

(iv) *Participate personally and substantially*. (A) Basic requirements. The restrictions of § 11.10(a)(1) apply only to those patents and patent applications in which a former Office employee had ``personal and substantial participation,'' exercised ``through decision, approval, disapproval, recommendation, the rendering of advice, investigation or otherwise.'' To *participate personally* means directly, and includes the participation of a subordinate when actually directed by the former Office employee in the patent or patent application. *Substantially* means that the employee's involvement must be of significance to the matter, or form a basis for a reasonable appearance of such significance. It requires more than official responsibility, knowledge, perfunctory involvement, or involvement on an administrative or peripheral issue. A finding of substantiality should be based not only on the effort devoted to a patent or patent application, but

also on the importance of the effort. While a series of peripheral involvements may be insubstantial, the single act of approving or participation in a critical step may be substantial. It is essential that the participation be related to a ``particular patent or patent application.'' (See paragraph (b)(3)(iii) of this section.)

(B) Participation on ancillary matters. An Office employee's participation on subjects not directly involving the substantive merits of a patent or patent application may not be ``substantial,'' even if it is time-consuming. An employee whose official responsibility is the review of a patent or patent application solely for compliance with administrative control or budgetary considerations and who reviews a particular patent or patent application for such a purpose should not be regarded as having participated substantially in the patent or patent application, except when such considerations also are the subject of the employee's proposed representation.

(C) Role of official responsibility in determining substantial participation. *Official responsibility* is defined in paragraph (b)(3)(v) of this section. “Personal and substantial participation'' is different from “official responsibility.” One's responsibility may, however, play a role in determining the ``substantiality'' of an Office employee's participation.

(v) *Official responsibility* means the direct administrative or operating authority, whether intermediate or final, and either exercisable alone or with others, and either personally or through subordinates, to approve, disapprove, or otherwise direct Government actions.

(A) Determining official responsibility. Ordinarily, those areas assigned by statute, regulation, Executive Order, job description, or delegation of authority determine the scope of an employee's ``official responsibility''. All particular matters under consideration in the Office are under the ``official responsibility'' of the Director of the Office, and each is under that of any intermediate supervisor having responsibility for an employee who actually participates in the patent or patent application within the scope of his or her duties. A patent examiner would have ``official responsibility'' for the patent applications assigned to him or her.

(B) Ancillary matters and official responsibility. *Administrative* authority as used in paragraph (v) of this section means authority for planning, organizing and controlling a patent or patent application rather than authority to review or make decisions on ancillary aspects of a patent or patent application such as the regularity of budgeting procedures, public or community relations aspects, or equal employment opportunity considerations. Responsibility for such an ancillary consideration does not constitute official responsibility for the particular patent or patent application, except when such a consideration is also the subject of the employee's proposed representation.

(C) Duty to inquire. In order for a former employee, e.g., former patent examiner, to be barred from representing or assisting in representing another as to a particular patent or patent application, he or she need not have known, while employed by the Office, that the patent or patent application was pending under his or her official responsibility. The former employee has a reasonable duty of inquiry to learn whether the patent or patent application had been under his or her official responsibility. Ordinarily, a former employee who is asked to represent another on a patent or patent application will become aware of facts sufficient to suggest the relationship of the prior matter to his or her former office, e.g., technology center, group or art unit. If so, he or she is under a duty to make further inquiry. It would be prudent for an employee to maintain a record of only patent application numbers of the applications actually acted upon by decision or recommendation, as well as those applications under the employee's official responsibility which he or she has not acted upon.

(D) Self-disqualification. A former employee, e.g., former patent examiner, cannot avoid the restrictions of this section through self-disqualification with respect to a patent or patent application for which he or she otherwise had official responsibility. However, an employee who through self-disqualification does not participate personally and substantially in a particular patent or patent application is not subject to the lifetime restriction of paragraph (b)(1) of this section.

(vi) Pending means that the matter was in fact referred to or under consideration by persons within the employee's area of official responsibility.

(4) Measurement of the two-year restriction period. The two-year period under paragraph (b)(2) of this section is measured from the date when the employee's official responsibility in a particular area ends, not from the termination of service in the Office, unless the two occur simultaneously. The prohibition applies to all particular patents or patent applications subject to such official responsibility in the one-year period before termination of such responsibility.

(c) *Former employees of the Office*. This section imposes restrictions generally parallel to those imposed in 18 U.S.C. 207(a) and (b)(1). This section, however, does not interpret these statutory provisions or any other post-employment restrictions that may apply to former Office employees, and such former employees should not assume that conduct not prohibited by this section is otherwise permissible. Former employees of the Office, whether or not they are practitioners, are encouraged to contact the Department of Commerce for information concerning applicable post-employment restrictions.

(d) An employee of the Office may not prosecute or aid in any manner in the prosecution of any patent application before the Office.

(e) Practice before the Office by Government employees is subject to any applicable conflict of interest laws, regulations or codes of professional responsibility.

[Added 69 FR 35428, June 24, 2004, effective July 26, 2004]

§ 11.11 Administrative suspension, inactivation, resignation, and readmission.

(a) A registered attorney or agent must notify the OED Director of his or her postal address for his or her office, up to three e-mail addresses where he or she receives e-mail, and business telephone number, as well as every change to any of said addresses or telephone numbers within thirty days of the date of the change. A registered attorney or agent shall, in addition to any notice of change of address and telephone number filed in individual patent applications, separately file written notice of the change of address or telephone number to the OED Director. A registered practitioner who is an attorney in good standing with the bar of the highest court of one or more States shall provide the OED Director with the State bar identification number associated with each membership. The OED Director shall publish from the roster a list containing the name, postal business addresses, business telephone number, registration number, and registration status as an attorney or agent of each registered practitioner recognized to practice before the Office in patent cases.

(b) *Administrative suspension*. (1) Whenever it appears that a registered patent attorney, a registered patent agent or a person granted limited recognition under § 11.9(b) has failed to comply with § 11.8(d), the OED Director shall publish and send a notice to the attorney, agent or person granted limited recognition advising of the noncompliance, the consequence of being administratively suspended under paragraph (b)(5) of this section if noncompliance is not timely remedied, and the requirements for reinstatement under paragraph (f) of this section. The notice shall be published and sent to the attorney, agent or person granted limited recognition by mail to the last postal address furnished under paragraph (a) of this section or by e-mail addressed to the last e-mail addresses furnished under paragraph (a) of this section. The notice shall demand compliance and payment of a delinquency fee set forth in § 1.21(a)(9)(i) of this subchapter within sixty days after the date of such notice.

(2) In the event a registered patent attorney, registered patent agent or person granted limited recognition fails to comply with the notice of paragraph (b)(1) of this section within the time allowed, the OED Director shall publish and send in the manner provided for in paragraph (b)(1) of this section to the attorney, agent, or person granted limited recognition a Rule to Show Cause why his or her registration or recognition should not be administratively suspended, and he or she no longer be permitted to practice before the Office in patent matters or in any way hold himself or herself out as being registered or authorized to practice before the Office in patent matters. The OED Director shall file a copy of the Rule to Show Cause with the USPTO Director.

(3) Within 30 days of the OED Director's sending the Rule to Show Cause identified in § 11.11(b)(2), the registered patent attorney, registered patent agent or person granted limited recognition may file a response to the Rule to Show Cause with the USPTO Director. The response must set forth the factual and legal bases why the person should not be administratively suspended. The registered patent attorney, registered patent agent or person granted limited recognition shall serve the OED Director with a copy of the response at the time it is filed with the USPTO Director. Within ten days of receiving a copy of the response, the OED Director may file a reply with the USPTO Director that includes documents demonstrating that the notice identified in § 11.11(b)(1) was published and sent to the practitioner in accordance with § 11.11(b)(1). A copy of the reply by the OED Director shall be served on the registered patent attorney, registered patent agent or person granted limited recognition. When acting on the Rule to Show Cause, if the USPTO Director determines that there are no genuine issues of material fact regarding the Office's compliance with the notice requirements under this section or the failure of the person to pay the requisite fees, the USPTO Director shall enter an order administratively suspending the registered patent attorney, registered patent agent or person granted limited recognition. Otherwise, the USPTO Director shall enter an appropriate order dismissing the Rule to Show Cause. Nothing herein shall permit an administratively suspended registered patent attorney, registered patent agent or person granted limited recognition to seek a stay of the administrative suspension during the pendency of any review of the USPTO Director's final decision.

(4) An administratively suspended attorney, agent or person granted limited recognition remains responsible for paying his or her annual practitioner maintenance fee required by § 11.8(d).

(5) An administratively suspended attorney, agent or person granted limited recognition is subject to investigation and discipline for his or her conduct prior to, during, or after the period he or she was administratively suspended.

(6) An administratively suspended attorney, agent or person granted limited recognition is prohibited from practicing before the Office in patent cases while administratively suspended. An attorney, agent or person granted limited recognition who knows he or she has been administratively suspended under this section will be subject to discipline for failing to comply with the provisions of this paragraph.

(c) *Administrative Inactivation*. (1) Any registered practitioner who shall become employed by the Office shall comply with § 10.40 of this subchapter for withdrawal from the applications, patents, and trademark matters wherein he or she represents an applicant or other person, and notify the OED Director in writing of said employment on the first day of said employment. The name of any registered practitioner employed by the Office shall be endorsed on the roster as administratively inactive. The practitioner shall not be responsible for payments of the annual practitioner maintenance fee each complete fiscal year while the practitioner is in administratively inactive status. Upon separation from the Office, the practitioner may request reactivation by completing and filing an application, Data Sheet, signing a written undertaking required by § 11.10, and paying the fee set forth in § 1.21(a)(1)(i) of this subchapter. Upon restoration to active status, the practitioner shall be responsible for paying the annual practitioner maintenance fee for the fiscal year in which the practitioner is restored to active status. An administratively inactive practitioner remains subject to the provisions of the Mandatory Disciplinary Rules identified in § 10.20(b) of this subchapter, and to proceedings and sanctions under §§ 11.19 through 11.58 for conduct that violates a provision of the Mandatory Disciplinary Rules identified in § 10.20(b) of this subchapter prior to or during employment at the Office. If, within 30 days after separation from the Office, the practitioner does not request active status or another status, the practitioner will be endorsed on the roster as voluntarily inactive and be subject to the provisions of paragraph (d) of this section.

(2) Any registered practitioner who is a judge of a court of record, full-time court commissioner, U.S. bankruptcy judge, U.S. magistrate judge, or a retired judge who is eligible for temporary judicial assignment and is not engaged in the practice of law may request, in writing, that his or her name be endorsed on the roster as administratively inactive. Upon acceptance of the request,

the OED Director shall endorse the name of the practitioner as administratively inactive. The practitioner shall not be responsible for payment of the annual practitioner maintenance fee for each complete fiscal year the practitioner is in administratively inactive status. Following separation from the bench, the practitioner may request restoration to active status by completing and filing an application, Data Sheet, signing a written undertaking required by § 11.10, and paying the fee set forth in § 1.21(a)(1)(i) of this subchapter. Upon restoration to active status, the practitioner shall be responsible for paying the annual practitioner maintenance fee for the fiscal year in which the practitioner is restored to active status.

(d) *Voluntary Inactivation*. (1) Except as provided in paragraph (d)(4) of this section, any registered practitioner may voluntarily enter inactive status by filing a request, in writing, that his or her name be endorsed on the roster as voluntarily inactive. Upon acceptance of the request, the OED Director shall endorse the name as voluntarily inactive.

(2) A registered practitioner in voluntary inactive status shall be responsible for payment of the annual practitioner maintenance fee for voluntary inactive status set forth in § 1.21(a)(7)(ii) of this subchapter for each complete fiscal year the practitioner continues to be in voluntary inactive status.

(3) A registered practitioner who seeks or enters into voluntary inactive status is subject to investigation and discipline for his or her conduct prior to, during, or after the period of his or her inactivation.

(4) A registered practitioner who is in arrears in paying annual practitioner maintenance fees or under administrative suspension for annual practitioner maintenance fee delinquency is ineligible to seek or enter into voluntary inactive status.

(5) A registered practitioner in voluntary inactive status is prohibited from practicing before the Office in patent cases while in voluntary inactive status. A practitioner in voluntary inactive status will be subject to discipline for failing to comply with the provisions of this paragraph. Upon acceptance of the request for voluntary inactive status, the practitioner must comply with the provisions of § 10.40 of this subchapter.

(6) Any registered practitioner whose name has been endorsed as voluntarily inactive pursuant to paragraph (d)(1) of this section and is not under investigation, not subject to a disciplinary proceeding, and not in arrears for the annual practitioner maintenance fee for voluntary inactive status may be restored to active status on the register as may be appropriate provided that the practitioner files a written request for restoration, a completed application for registration on a form supplied by the OED Director furnishing all requested information and material, including information and material pertaining to the practitioner's moral character and reputation under § 11.7(a)(2)(i) during the period of inactivation, a declaration or affidavit attesting to the fact that the practitioner has read the most recent revisions of the patent laws and the rules of practice before the Office, and pays the fees set forth in §§ 1.21(a)(7)(iii) and (iv) of this subchapter.

(e) *Resignation*. A registered practitioner or a practitioner recognized under § 11.14(c), who is neither under investigation under § 11.22 for a possible violation of the Mandatory Disciplinary Rules identified in § 10.20(b) of Part 10 of this subchapter, subject to discipline under §§ 11.24 or 11.25, nor a practitioner against whom no probable cause has been found by a panel of the Committee on Discipline under § 11.23(b), may resign by notifying the OED Director in writing that he or she desires to resign. Upon acceptance in writing by the OED Director of such notice, that registered practitioner or practitioner under § 11.14 shall no longer be eligible to practice before the Office but shall continue to file a change of address for five years thereafter in order that he or she may be located in the event information regarding the practitioner's conduct comes to the attention of the OED Director or any grievance is made about his or her conduct while he or she engaged in practice before the Office. The name of any registered practitioner whose resignation is accepted shall be removed from the register, endorsed as resigned, and notice thereof published in the Official Gazette. Upon acceptance of the resignation by the OED Director, the practitioner must comply with the provisions of § 10.40 of this subchapter.

(f) *Administrative reinstatement*. (1) Any registered practitioner who has been administratively suspended pursuant to paragraph (b) of this section, or who has resigned pursuant to paragraph (e) of this section, may be reinstated on the register provided the practitioner has applied for reinstatement on an application form supplied by the OED Director, demonstrated compliance with the provisions of §§ 11.7(a)(2)(i) and (iii), and paid the fees set forth in §§ 1.21(a)(7)(i), (a)(9)(i) and (a)(9)(ii) of this subchapter. Any person granted limited recognition who has been administratively suspended pursuant to paragraph (b) of this section may have their recognition reactivated provided the practitioner has applied for reinstatement on an application form supplied by the OED Director, demonstrated compliance with the provisions of §§ 11.7(a)(2)(i) and (iii), and paid the fees set forth in §§ 1.21(a)(8)(i), (a)(9)(i) and (a)(9)(ii) of this subchapter. A practitioner who has resigned or was administratively suspended for two or more years before the date the Office receives a completed application from the person who resigned or was administratively suspended must also pass the registration examination under § 11.7(b)(1)(ii). Any reinstated practitioner is subject to investigation and discipline for his or her conduct that occurred prior to, during, or after the period of his or her administrative suspension or resignation.

(2) Any registered practitioner whose registration has been administratively inactivated pursuant to paragraph (c) of this section may be reinstated to the register as may be appropriate provided within two years after his or her employment with the Office ceases or within two years after his or her employment in a judicial capacity ceases the following is filed with the OED Director: a request for reinstatement, a completed application for registration on a form supplied by the OED Director furnishing all requested information and material, and the fee set forth in § 1.21(a)(9)(ii) of this subchapter. Any registered practitioner inactivated or reinstated is subject to investigation and discipline for his or her conduct before, during, or after the period of his or her inactivation.

[Added 69 FR 35428, June 24, 2004, effective July 26, 2004; amended 73 FR 67750, Nov. 17, 2008, effective Dec. 17, 2008]

§ 11.2 [Reserved]

§ 11.13 [Reserved]

§ 11.14 Individuals who may practice before the Office in trademark and other non-patent matters.

(a) *Attorneys*. Any individual who is an attorney as defined in § 11.1 may represent others before the Office in trademark and other non-patent matters. An attorney is not required to apply for registration or recognition to practice before the Office in trademark and other non-patent matters. Registration as a patent practitioner does not itself entitle an individual to practice before the Office in trademark matters.

(b) *Non-lawyers*. Individuals who are not attorneys are not recognized to practice before the Office in trademark and other non-patent matters, except that individuals not attorneys who were recognized to practice before the Office in trademark matters under this chapter prior to January 1, 1957, will be recognized as agents to continue practice before the Office in trademark matters. Except as provided in the preceding sentence, registration as a patent agent does not itself entitle an individual to practice before the Office in trademark matters.

(c) *Foreigners*. Any foreign attorney or agent not a resident of the United States who shall file a written application for reciprocal recognition under paragraph (f) of this section and prove to the satisfaction of the OED Director that he or she is registered or in good standing before the patent or trademark office of the country in which he or she resides and practices and is possessed of good moral character and reputation, may be recognized for the limited purpose of representing

parties located in such country before the Office in the presentation and prosecution of trademark matters, provided: the patent or trademark office of such country allows substantially reciprocal privileges to those permitted to practice in trademark matters before the Office. Recognition under this paragraph shall continue only during the period that the conditions specified in this paragraph obtain.

(d) Recognition of any individual under this section shall not be construed as sanctioning or authorizing the performance of any act regarded in the jurisdiction where performed as the unauthorized practice of law.

(e) No individual other than those specified in paragraphs (a), (b), and (c) of this section will be permitted to practice before the Office in trademark matters on behalf of a client. Any individual may appear in a trademark or other non-patent matter in his or her own behalf. Any individual may appear in a trademark matter for:

(1) A firm of which he or she is a member,

(2) A partnership of which he or she is a partner, or

(3) A corporation or association of which he or she is an officer and which he or she is authorized to represent, if such firm, partnership, corporation, or association is a party to a trademark proceeding pending before the Office.

(f) *Application for reciprocal recognition*. An individual seeking reciprocal recognition under paragraph (c) of this section, in addition to providing evidence satisfying the provisions of paragraph (c) of this section, shall apply in writing to the OED Director for reciprocal recognition, and shall pay the application fee required by § 1.21(a)(1)(i) of this subchapter.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.15 Refusal to recognize a practitioner.

Any practitioner authorized to appear before the Office may be suspended, excluded, or reprimanded in accordance with the provisions of this Part. Any practitioner who is suspended or excluded under this Part shall not be entitled to practice before the Office in patent, trademark, or other non-patent matters while suspended or excluded.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.16 - 11.17 [Reserved]

§ 11.18 Signature and certificate for correspondence filed in the Office.

(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, and all documents filed with a hearing officer in a disciplinary proceeding, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Office must bear a signature, personally signed or inserted by such practitioner, in compliance with § 1.4(d)(1), § 1.4(d)(2), or § 2.193(a) of this chapter.

(b) By presenting to the Office or hearing officer in a disciplinary proceeding (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or knowingly and willfully makes any false, fictitious, or fraudulent statements or representations, or knowingly and willfully makes or uses any false writing or document knowing

the same to contain any false, fictitious, or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001 and any other applicable criminal statute, and violations of the provisions of this section may jeopardize the probative value of the paper; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances,

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office;

(ii) The other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions or actions as deemed appropriate by the USPTO Director, which may include, but are not limited to, any combination of--

(1) Striking the offending paper;

(2) Referring a practitioner's conduct to the Director of Enrollment and Discipline for appropriate action;

(3) Precluding a party or practitioner from submitting a paper, or presenting or contesting an issue;

(4) Affecting the weight given to the offending paper; or

(5) Terminating the proceedings in the Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008; amended 74 FR 54898, Oct. 26, 2009, effective Dec. 28, 2009]

Subpart C – Investigations and Disciplinary Proceedings; Jurisdiction, Sanctions, Investigations, and Proceedings

§ 11.19 Disciplinary jurisdiction; Jurisdiction to transfer to disability inactive status.

(a) All practitioners engaged in practice before the Office; all practitioners administratively suspended; all practitioners registered to practice before the Office in patent cases; all practitioners inactivated; all practitioners authorized under § 11.6(d) to take testimony; and all practitioners transferred to disability inactive status, reprimanded, suspended, or excluded from the practice of law by a duly constituted authority, including by the USPTO Director, are subject to the disciplinary jurisdiction of the Office. Practitioners who have resigned shall also be subject to such jurisdiction with respect to conduct undertaken prior to the resignation and conduct in regard to any practice before the Office following the resignation.

(b) *Grounds for discipline; Grounds for transfer to disability inactive status*. The following, whether done individually by a practitioner or in concert with any other person or persons and whether or not done in the course of providing legal services to a client, or in a matter pending before the Office, constitute grounds for discipline or grounds for transfer to disability inactive status.

(1) Grounds for discipline include:

(i) Conviction of a serious crime;

(ii) Discipline on ethical grounds imposed in another jurisdiction or disciplinary disqualification from participating in or appearing before any Federal program or agency;

(iii) Failure to comply with any order of a Court disciplining a practitioner, or any final decision of the USPTO Director in a disciplinary matter;

(iv) Violation of a Mandatory Disciplinary Rule identified in § 10.20(b) of Part 10 of this Subchapter; or

(v) Violation of the oath or declaration taken by the practitioner. See § 11.8.

(2) Grounds for transfer to disability inactive status include:

(i) Being transferred to disability inactive status in another jurisdiction;

(ii) Being judicially declared incompetent, being judicially ordered to be involuntarily committed after a hearing on the grounds of insanity, incompetency or disability, or being placed by court order under guardianship or conservatorship; or

(iii) Filing a motion requesting a disciplinary proceeding be held in abeyance because the practitioner is suffering from a disability or addiction that makes it impossible for the practitioner to adequately defend the charges in the disciplinary proceeding.

(c) Petitions to disqualify a practitioner in *ex parte* or *inter partes* matters in the Office are not governed by §§ 11.19 through 11.60 and will be handled on a case-by-case basis under such conditions as the USPTO Director deems appropriate.

(d) The OED Director may refer the existence of circumstances suggesting unauthorized practice of law to the authorities in the appropriate jurisdiction(s).

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.20 Disciplinary sanctions; Transfer to disability inactive status.

(a) *Types of discipline*. The USPTO Director, after notice and opportunity for a hearing, and where grounds for discipline exist, may impose on a practitioner the following types of discipline:

(1) Exclusion from practice before the Office;

(2) Suspension from practice before the Office for an appropriate period of time;

(3) Reprimand or censure; or

(4) *Probation*. Probation may be imposed *in lieu* of or in addition to any other disciplinary sanction. Any conditions of probation shall be stated in writing in the order imposing probation. The order shall also state whether, and to what extent, the practitioner shall be required to notify clients of the probation. The order shall establish procedures for the supervision of probation. Violation of any condition of probation shall–be cause for the probation to be revoked, and the disciplinary sanction to be imposed for the remainder of the probation period. Revocation of probation shall occur only after an order to show cause why probation should not be revoked is resolved adversely to the practitioner.

(b) *Conditions imposed with discipline*. When the USPTO Director imposes discipline, the practitioner may be required to make restitution either to persons financially injured by the practitioner's conduct or to an appropriate client's security trust fund, or both, as a condition of probation or of reinstatement. Such restitution shall be limited to the return of unearned practitioner fees or misappropriated client funds. Any other reasonable condition may also be imposed, including a requirement that the practitioner take and pass a professional responsibility examination.

(c) *Transfer to disability inactive status*. The USPTO Director, after notice and opportunity for a hearing may, and where grounds exist to believe a practitioner has been transferred to disability inactive status in another jurisdiction, or has been judicially declared incompetent; judicially ordered to be involuntarily committed after a hearing on the grounds of incompetency or disability, or placed by court order under guardianship or conservatorship, transfer the practitioner to disability inactive status.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.21 Warnings.

A warning is neither public nor a disciplinary sanction. The OED Director may conclude an investigation with the issuance of a warning. The warning shall contain a brief statement of facts and Mandatory Disciplinary Rules identified in § 10.20(b) of Part 10 of this Subchapter relevant to the facts.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.22 Investigations.

(a) The OED Director is authorized to investigate possible grounds for discipline. An investigation may be initiated when the OED Director receives a grievance, information or evidence from any source suggesting possible grounds for discipline. Neither unwillingness nor neglect by a grievant to prosecute a charge, nor settlement, compromise, or restitution with the grievant, shall in itself justify abatement of an investigation.

(b) Any person possessing information or evidence concerning possible grounds for discipline of a practitioner may report the information or evidence to the OED Director. The OED Director may request that the report be presented in the form of an affidavit or declaration.

(c) Information or evidence coming from any source which presents or alleges facts suggesting possible grounds for discipline of a practitioner will be deemed a grievance.

(d) *Preliminary screening of information or evidence*. The OED Director shall examine all information or evidence concerning possible grounds for discipline of a practitioner.

(e) *Notification of investigation*. The OED Director shall notify the practitioner in writing of the initiation of an investigation into whether a practitioner has engaged in conduct constituting possible grounds for discipline.

(f) *Request for information and evidence by OED Director*.

(1) In the course of the investigation, the OED Director may request information and evidence regarding possible grounds for discipline of a practitioner from:

(i) The grievant,

(ii) The practitioner, or

(iii) Any person who may reasonably be expected to provide information and evidence needed in connection with the grievance or investigation.

(2) The OED Director may request information and evidence regarding possible grounds for discipline of a practitioner from a non-grieving client either after obtaining the consent of the practitioner or upon a finding by a Contact Member of the Committee on Discipline, appointed in accordance with § 11.23(d), that good cause exists to believe that the possible ground for discipline alleged has occurred with respect to non-grieving clients. Neither a request for, nor disclosure of, such information shall constitute a violation of any of the Mandatory Disciplinary Rules identified in § 10.20(b) of this subchapter.

(g) Where the OED Director makes a request under paragraph (f)(2) of this section to a Contact Member of the Committee on Discipline, such Contact Member shall not, with respect to the practitioner connected to the OED Director's request, participate in the Committee on Discipline panel that renders a probable cause determination under paragraph (b)(1) of this section concerning such practitioner, and that forwards the probable cause finding and recommendation to the OED Director under paragraph (b)(2) of this section.

(h) *Disposition of investigation*. Upon the conclusion of an investigation, the OED Director may:

(1) Close the investigation without issuing a warning, or taking disciplinary action;

(2) Issue a warning to the practitioner;

(3) Institute formal charges upon the approval of the Committee on Discipline; or

(4) Enter into a settlement agreement with the practitioner and submit the same for approval of the USPTO Director.

(i) *Closing investigation without issuing a warning or taking disciplinary action*. The OED Director shall terminate an investigation and decline to refer a matter to the Committee on Discipline if the OED Director determines that:

(1) The information or evidence is unfounded;

(2) The information or evidence relates to matters not within the jurisdiction of the Office;

(3) As a matter of law, the conduct about which information or evidence has been obtained does not constitute grounds for discipline, even if the conduct may involve a legal dispute; or

(4) The available evidence is insufficient to conclude that there is probable cause to believe that grounds exist for discipline.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.23 Committee on Discipline.

(a) The USPTO Director shall appoint a Committee on Discipline. The Committee on Discipline shall consist of at least three employees of the Office. None of the Committee members shall report directly or indirectly to the OED Director or any employee designated by the USPTO Director to decide disciplinary matters. Each Committee member shall be a member in good standing of the bar of the highest court of a State. The Committee members shall select a Chairperson from among themselves. Three Committee members will constitute a panel of the Committee.

(b) *Powers and duties of the Committee on Discipline*. The Committee shall have the power and duty to:

(1) Meet in panels at the request of the OED Director and, after reviewing evidence presented by the OED Director, by majority vote of the panel, determine whether there is probable cause to bring charges under § 11.32 against a practitioner; and

(2) Prepare and forward its own probable cause findings and recommendations to the OED Director.

(c) No discovery shall be authorized of, and no member of the Committee on Discipline shall be required to testify about deliberations of, the Committee on Discipline or of any panel.

(d) The Chairperson shall appoint the members of the panels and a Contact Member of the Committee on Discipline.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.24 Reciprocal discipline.

(a) *Notification of OED Director*. Within thirty days of being publicly censured, publicly reprimanded, subjected to probation, disbarred or suspended by another jurisdiction, or being disciplinarily disqualified from participating in or appearing before any Federal program or agency, a practitioner subject to the disciplinary jurisdiction of the Office shall notify the OED Director in writing of the same. A practitioner is deemed to be disbarred if he or she is disbarred, excluded on consent, or has resigned in lieu of a disciplinary proceeding. Upon receiving notification from any source or otherwise learning that a practitioner subject to the disciplinary jurisdiction of the Office has been so publicly censured, publicly reprimanded, subjected to probation, disbarred, suspended or disciplinarily disqualified, the OED Director shall obtain a certified copy of the record or order regarding the public censure, public reprimand, probation, disbarment, suspension or disciplinary disqualification and file the same with the USPTO Director. The OED Director shall, in addition, without Committee on Discipline authorization, file with the USPTO Director a complaint complying with § 11.34 against the practitioner predicated upon the public censure, public reprimand, probation, disbarment, suspension or disciplinary disqualification. The OED Director

shall request the USPTO Director to issue a notice and order as set forth in paragraph (b) of this section.

(b) *Notification served on practitioner*. Upon receipt of a certified copy of the record or order regarding the practitioner being so publicly censured, publicly reprimanded, subjected to probation, disbarred, suspended or disciplinarily disqualified together with the complaint, the USPTO Director shall issue a notice directed to the practitioner in accordance with § 11.35 and to the OED Director containing:

(1) A copy of the record or order regarding the public censure, public reprimand, probation, disbarment, suspension or disciplinary disqualification;

(2) A copy of the complaint; and

(3) An order directing the practitioner to file a response with the USPTO Director and the OED Director, within forty days of the date of the notice establishing a genuine issue of material fact predicated upon the grounds set forth in paragraphs (d)(1)(i) through (d)(1)(iv) of this section that the imposition of the identical public censure, public reprimand, probation, disbarment, suspension or disciplinary disqualification would be unwarranted and the reasons for that claim.

(c) *Effect of stay in another jurisdiction*. In the event the public censure, public reprimand, probation, disbarment, suspension imposed by another jurisdiction or disciplinary disqualification imposed in the Federal program or agency has been stayed, any reciprocal discipline imposed by the USPTO may be deferred until the stay expires.

(d) *Hearing and discipline to be imposed*. (1) The USPTO Director shall hear the matter on the documentary record unless the USPTO Director determines that an oral hearing is necessary. After expiration of the forty days from the date of the notice pursuant to provisions of paragraph (b) of this section, the USPTO Director shall consider any timely filed response and shall impose the identical public censure, public reprimand, probation, disbarment, suspension or disciplinary disqualification unless the practitioner clearly and convincingly demonstrates, and the USPTO Director finds there is a genuine issue of material fact that:

(i) The procedure elsewhere was so lacking in notice or opportunity to be heard as to constitute a deprivation of due process;

(ii) There was such infirmity of proof establishing the conduct as to give rise to the clear conviction that the Office could not, consistently with its duty, accept as final the conclusion on that subject;

(iii) The imposition of the same public censure, public reprimand, probation, disbarment, suspension or disciplinary disqualification by the Office would result in grave injustice; or

(iv) Any argument that the practitioner was not publicly censured, publicly reprimanded, placed on probation, disbarred, suspended or disciplinarily disqualified.

(2) If the USPTO Director determines that there is no genuine issue of material fact, the USPTO Director shall enter an appropriate final order. If the USPTO Director is unable to make such determination because there is a genuine issue of material fact, the USPTO Director shall enter an appropriate order:

(i) Referring the complaint to a hearing officer for a formal hearing and entry of an initial decision in accordance with the other rules in this part, and

(ii) Directing the practitioner to file an answer to the complaint in accordance with § 11.36.

(e) *Adjudication in another jurisdiction or Federal agency or program*. In all other respects, a final adjudication in another jurisdiction or Federal agency or program that a practitioner, whether or not admitted in that jurisdiction, has been guilty of misconduct shall establish a prima facie case by clear and convincing evidence that the practitioner violated 37 CFR 10.23, as further identified under 37 CFR 10.23(c)(5), (or any successor regulation identifying such public censure, public reprimand, probation, disbarment, suspension or disciplinary disqualification as a basis for a disciplinary proceeding in this Office).

(f) *Reciprocal discipline - action where practice has ceased*. Upon request by the practitioner, reciprocal discipline may be imposed *nunc pro tunc* only if the practitioner promptly notified the OED Director of his or her censure, public reprimand, probation, disbarment, suspension or disciplinary disqualification in another jurisdiction, and establishes by clear and convincing

evidence that the practitioner voluntarily ceased all activities related to practice before the Office and complied with all provisions of § 11.58. The effective date of any public censure, public reprimand, probation, suspension, disbarment or disciplinary disqualification imposed *nunc pro tunc* shall be the date the practitioner voluntarily ceased all activities related to practice before the Office and complied with all provisions of § 11.58.

(*g*) *Reinstatement following reciprocal discipline proceeding*. A practitioner may petition for reinstatement under conditions set forth in § 11.60 no sooner than completion of the period of reciprocal discipline imposed, and compliance with all provisions of § 11.58.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.25 Interim suspension and discipline based upon conviction of committing a serious crime.

(a) *Notification of OED Director*. Upon being convicted of a crime in a court of the United States or any State, or violating a criminal law of a foreign country, a practitioner subject to the disciplinary jurisdiction of the Office shall notify the OED Director in writing of the same within thirty days from the date of such conviction. Upon being advised or learning that a practitioner subject to the disciplinary jurisdiction of the Office has been convicted of a crime, the OED Director shall make a preliminary determination whether the crime constitutes a serious crime warranting interim suspension. If the crime is a serious crime, the OED Director shall file with the USPTO Director proof of the conviction and request the USPTO Director to issue a notice and order set forth in paragraph (b)(2) of this section. The OED Director shall in addition, without Committee on Discipline authorization, file with the USPTO Director a complaint against the practitioner complying with § 11.34 predicated upon the conviction of a serious crime. If the crime is not a serious crime, the OED Director shall process the matter in the same manner as any other information or evidence of a possible violation of a Mandatory Disciplinary Rule identified in § 10.20(b) of this subchapter coming to the attention of the OED Director.

(b) *Interim suspension and referral for disciplinary proceeding*. All proceedings under this section shall be handled as expeditiously as possible.

(1) The USPTO Director has authority to place a practitioner on interim suspension after hearing the request for interim suspension on the documentary record.

(2) *Notification served on practitioner*. Upon receipt of a certified copy of the court record, docket entry or judgment demonstrating that the practitioner has been so convicted together with the complaint, the USPTO Director shall forthwith issue a notice directed to the practitioner in accordance with §§ 11.35(a), (b) or (c), and to the OED Director, containing:

(i) A copy of the court record, docket entry, or judgment of conviction;

(ii) A copy of the complaint; and

(iii) An order directing the practitioner to file a response with the USPTO Director and the OED Director, within forty days of the date of the notice, establishing that there is a genuine issue of material fact that the crime did not constitute a serious crime, the practitioner is not the individual found guilty of the crime, or that the conviction was so lacking in notice or opportunity to be heard as to constitute a deprivation of due process.

(3) *Hearing and final order on request for interim suspension*. The request for interim suspension shall be heard by the USPTO Director on the documentary record unless the USPTO Director determines that the practitioner's response establishes a genuine issue of material fact that: the crime did not constitute a serious crime, the practitioner is not the person who committed the crime, or that the conviction was so lacking in notice or opportunity to be heard as to constitute a deprivation of due process. If the USPTO Director determines that there is no genuine issue of material fact regarding the defenses set forth in the preceding sentence, the USPTO Director shall enter an appropriate final order regarding the OED Director's request for interim suspension regardless of the pendency of any criminal appeal. If the USPTO Director is unable to make such determination because there is a genuine issue of material fact, the USPTO Director

shall enter a final order dismissing the request and enter a further order referring the complaint to a hearing officer for a hearing and entry of an initial decision in accordance with the other rules in this part and directing the practitioner to file an answer to the complaint in accordance with § 11.36.

(4) *Termination*. The USPTO Director has authority to terminate an interim suspension. In the interest of justice, the USPTO Director may terminate an interim suspension at any time upon a showing of extraordinary circumstances, after affording the OED Director an opportunity to respond to the request to terminate interim suspension.

(5) *Referral for disciplinary proceeding*. Upon entering a final order imposing interim suspension, the USPTO Director shall refer the complaint to a hearing officer to conduct a formal disciplinary proceeding. The formal disciplinary proceeding, however, shall be stayed by the hearing officer until all direct appeals from the conviction are concluded. Review of the initial decision of the hearing officer shall be pursuant to § 11.55.

(c) Proof of conviction and guilt -- (1) *Conviction in the United States*. For purposes of a hearing for interim suspension and a hearing on the formal charges in a complaint filed as a consequence of the conviction, a certified copy of the court record, docket entry, or judgment of conviction in a court of the United States or any State shall establish a prima facie case by clear and convincing evidence that the practitioner was convicted of a serious crime and that the conviction was not lacking in notice or opportunity to be heard as to constitute a deprivation of due process.

(2) *Conviction in a foreign country*. For purposes of a hearing for interim suspension and on the formal charges filed as a result of a finding of guilt, a certified copy of the court record, docket entry, or judgment of conviction in a court of a foreign country shall establish a *prima facie* case by clear and convincing evidence that the practitioner was convicted of a serious crime and that the conviction was not lacking in notice or opportunity to be heard as to constitute a deprivation of due process. However, nothing in this paragraph shall preclude the practitioner from demonstrating by clear and convincing evidence in any hearing on a request for interim suspension there is a genuine issue of material fact to be considered when determining if the elements of a serious crime were committed in violating the criminal law of the foreign country and whether a disciplinary sanction should be entered.

(d) *Crime determined not to be serious crime*. If the USPTO Director determines that the crime is not a serious crime, the complaint shall be referred to the OED Director for investigation under § 11.22 and processing as is appropriate.

(e) *Reinstatement* -- (1) *Upon reversal or setting aside a finding of guilt or a conviction*. If a practitioner suspended solely under the provisions of paragraph (b) of this section demonstrates that the underlying finding of guilt or conviction of serious crimes has been reversed or vacated, the order for interim suspension shall be vacated and the practitioner shall be placed on active status unless the finding of guilt was reversed or the conviction was set aside with respect to less than all serious crimes for which the practitioner was found guilty or convicted. The vacating of the interim suspension will not terminate any other disciplinary proceeding then pending against the practitioner, the disposition of which shall be determined by the hearing officer before whom the matter is pending, on the basis of all available evidence other than the finding of guilt or conviction.

(2) *Following conviction of a serious crime.* Any practitioner convicted of a serious crime and disciplined in whole or in part in regard to that conviction, may petition for reinstatement under conditions set forth in § 11.60 no sooner than five years after being discharged following completion of service of his or her sentence, or after completion of service under probation or parole, whichever is later.

(f) *Notice to clients and others of interim suspension*. An interim suspension under this section shall constitute a suspension of the practitioner for the purpose of § 11.58.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.26 Settlement.

Before or after a complaint under § 11.34 is filed, a settlement conference may occur between the OED Director and the practitioner. Any offers of compromise and any statements made during the course of settlement discussions shall not be admissible in subsequent proceedings. The OED Director may recommend to the USPTO Director any settlement terms deemed appropriate, including steps taken to correct or mitigate the matter forming the basis of the action, or to prevent recurrence of the same or similar conduct. A settlement agreement shall be effective only upon entry of a final decision by the USPTO Director.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.27 Exclusion on consent.

(a) *Required affidavit*. The OED Director may confer with a practitioner concerning possible violations by the practitioner of the Rules of Professional Conduct whether or not a disciplinary proceeding has been instituted. A practitioner who is the subject of an investigation or a pending disciplinary proceeding based on allegations of grounds for discipline, and who desires to resign, may only do so by consenting to exclusion and delivering to the OED Director an affidavit declaring the consent of the practitioner to exclusion and stating:

(1) That the practitioner's consent is freely and voluntarily rendered, that the practitioner is not being subjected to coercion or duress, and that the practitioner is fully aware of the implications of consenting to exclusion;

(2) That the practitioner is aware that there is currently pending an investigation into, or a proceeding involving allegations of misconduct, the nature of which shall be specifically set forth in the affidavit to the satisfaction of the OED Director;

(3) That the practitioner acknowledges that, if and when he or she applies for reinstatement under § 11.60, the OED Director will conclusively presume, for the limited purpose of determining the application for reinstatement, that:

(i) The facts upon which the investigation or complaint is based are true, and

(ii) The practitioner could not have successfully defended himself or herself against the allegations in the investigation or charges in the complaint.

(b) *Action by the USPTO Director*. Upon receipt of the required affidavit, the OED Director shall file the affidavit and any related papers with the USPTO Director for review and approval. Upon such approval, the USPTO Director will enter an order excluding the practitioner on consent and providing other appropriate actions. Upon entry of the order, the excluded practitioner shall comply with the requirements set forth in § 11.58.

(c) When an affidavit under paragraph (a) of this section is received after a complaint under § 11.34 has been filed, the OED Director shall notify the hearing officer. The hearing officer shall enter an order transferring the disciplinary proceeding to the USPTO Director, who may enter an order excluding the practitioner on consent.

(d) *Reinstatement*. Any practitioner excluded on consent under this section may not petition for reinstatement for five years. A practitioner excluded on consent who intends to reapply for admission to practice before the Office must comply with the provisions of § 11.58, and apply for reinstatement in accordance with § 11.60. Failure to comply with the provisions of § 11.58 constitutes grounds for denying an application for reinstatement.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.28 Incapacitated practitioners in a disciplinary proceeding.

(a) Holding in abeyance a disciplinary proceeding because of incapacitation due to a current disability or addiction -- (1) Practitioner's motion. In the course of a disciplinary proceeding under

§ 11.32, but before the date set by the hearing officer for a hearing, the practitioner may file a motion requesting the hearing officer to enter an order holding such proceeding in abeyance based on the contention that the practitioner is suffering from a disability or addiction that makes it impossible for the practitioner to adequately defend the charges in the disciplinary proceeding.

(i) Content of practitioner's motion. The practitioner's motion shall, in addition to any other requirement of § 11.43, include or have attached thereto:

(A) A brief statement of all material facts;

(B) Affidavits, medical reports, official records, or other documents and the opinion of at least one medical expert setting forth and establishing any of the material facts on which the practitioner is relying;

(C) A statement that the practitioner acknowledges the alleged incapacity by reason of disability or addiction;

(D) Written consent that the practitioner be transferred to disability inactive status if the motion is granted; and

(E) A written agreement by the practitioner to not practice before the Office in patent, trademark or other non-patent cases while on disability inactive status.

(ii) Response. The OED Director's response to any motion hereunder shall be served and filed within thirty days after service of the practitioner's motion unless such time is shortened or enlarged by the hearing officer for good cause shown, and shall set forth the following:

(A) All objections, if any, to the actions requested in the motion;

(B) An admission, denial or allegation of lack of knowledge with respect to each of the material facts in the practitioner's motion and accompanying documents; and

(C) Affidavits, medical reports, official records, or other documents setting forth facts on which the OED Director intends to rely for purposes of disputing or denying any material fact set forth in the practitioner's papers.

(2) Disposition of practitioner's motion. The hearing officer shall decide the motion and any response thereto. The motion shall be granted upon a showing of good cause to believe the practitioner to be incapacitated as alleged. If the required showing is made, the hearing officer shall enter an order holding the disciplinary proceeding in abeyance. In the case of addiction to drugs or intoxicants, the order may provide that the practitioner will not be returned to active status absent satisfaction of specified conditions. Upon receipt of the order, the OED Director shall transfer the practitioner to disability inactive status, give notice to the practitioner, cause notice to be published, and give notice to appropriate authorities in the Office that the practitioner has been placed on disability inactive status. The practitioner shall comply with the provisions of § 11.58, and shall not engage in practice before the Office in patent, trademark and other non-patent law until a determination is made of the practitioner's capability to resume practice before the Office in a proceeding under paragraph (c) or paragraph (d) of this section. A practitioner on disability inactive status must seek permission from the OED Director to engage in an activity authorized under § 11.58(e). Permission will be granted only if the practitioner has complied with all the conditions of §§ 11.58(a) through 11.58(d) applicable to disability inactive status. In the event that permission is granted, the practitioner shall fully comply with the provisions of § 11.58(e).

(b) Motion for reactivation. Any practitioner transferred to disability inactive status in a disciplinary proceeding may file with the hearing officer a motion for reactivation once a year beginning at any time not less than one year after the initial effective date of inactivation, or once during any shorter interval provided by the order issued pursuant to paragraph (a)(2) of this section or any modification thereof. If the motion is granted, the disciplinary proceeding shall resume under such schedule as may be established by the hearing officer.

(c) Contents of motion for reactivation. A motion by the practitioner for reactivation alleging that a practitioner has recovered from a prior disability or addiction shall be accompanied by all available medical reports or similar documents relating thereto. The hearing officer may require the practitioner to present such other information as is necessary.

(d) OED Director's motion to resume disciplinary proceeding held in abeyance. (1) The OED Director, having good cause to believe a practitioner is no longer incapacitated, may file a motion

requesting the hearing officer to terminate a prior order holding in abeyance any pending proceeding because of the practitioner's disability or addiction. The hearing officer shall decide the matter presented by the OED Director's motion hereunder based on the affidavits and other admissible evidence attached to the OED Director's motion and the practitioner's response. The OED Director bears the burden of showing by clear and convincing evidence that the practitioner is able to defend himself or herself. If there is any genuine issue as to one or more material facts, the hearing officer will hold an evidentiary hearing.

(2) The hearing officer, upon receipt of the OED Director's motion under paragraph (d)(1) of this section, may direct the practitioner to file a response. If the hearing officer requires the practitioner to file a response, the practitioner must present clear and convincing evidence that the prior self-alleged disability or addiction continues to make it impossible for the practitioner to defend himself or herself in the underlying proceeding being held in abeyance.

(e) Action by the hearing officer. If, in deciding a motion under paragraph (b) or (d) of this section, the hearing officer determines that there is good cause to believe the practitioner is not incapacitated from defending himself or herself, or is not incapacitated from practicing before the Office, the hearing officer shall take such action as is deemed appropriate, including the entry of an order directing the reactivation of the practitioner and resumption of the disciplinary proceeding.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.29 Reciprocal transfer or initial transfer to disability inactive status.

(a) *Notification of OED Director*. (1) Transfer to disability inactive status in another jurisdiction as grounds for reciprocal transfer by the Office. Within thirty days of being transferred to disability inactive status in another jurisdiction, a practitioner subject to the disciplinary jurisdiction of the Office shall notify the OED Director in writing of the transfer. Upon notification from any source that a practitioner subject to the disciplinary jurisdiction of the Office has been transferred to disability inactive status in another jurisdiction, the OED Director shall obtain a certified copy of the order. The OED Director shall file with the USPTO Director:

(i) The order;

(ii) A request that the practitioner be transferred to disability inactive status, including the specific grounds therefor; and

(iii) A request that the USPTO Director issue a notice and order as set forth in paragraph (b) of this section.

(2) *Involuntary commitment, adjudication of incompetency or court ordered placement under guardianship or conservatorship as grounds for initial transfer to disability inactive status*. Within thirty days of being judicially declared incompetent, being judicially ordered to be involuntarily committed after a hearing on the grounds of incompetency or disability, or being placed by court order under guardianship or conservatorship in another jurisdiction, a practitioner subject to the disciplinary jurisdiction of the Office shall notify the OED Director in writing of such judicial action. Upon notification from any source that a practitioner subject to the disciplinary jurisdiction of the Office has been subject to such judicial action, the OED Director shall obtain a certified copy of the order. The OED Director shall file with the USPTO Director:

(i) The order;

(ii) A request that the practitioner be transferred to disability inactive status, including the specific grounds therefor; and

(iii) A request that the USPTO Director issue a notice and order as set forth in paragraph (b) of this section.

(b) *Notice served on practitioner*. Upon receipt of a certified copy of an order or declaration issued by another jurisdiction demonstrating that a practitioner subject to the disciplinary jurisdiction of the Office has been transferred to disability inactive status, judicially declared incompetent, judicially ordered to be involuntarily committed after a judicial hearing on the

grounds of incompetency or disability, or placed by court order under guardianship or conservatorship, together with the OED Director's request, the USPTO Director shall issue a notice, comporting with § 11.35, directed to the practitioner containing:

A copy of the order or declaration from the other jurisdiction,

A copy of the OED Director's request; and

(3) An order directing the practitioner to file a response with the USPTO Director and the OED Director, within 30 days from the date of the notice, establishing a genuine issue of material fact supported by an affidavit and predicated upon the grounds set forth in § 11.29(d) (1) through (4) that a transfer to disability inactive status would be unwarranted and the reasons therefor.

(c) *Effect of stay of transfer, judicially declared incompetence, judicially ordered involuntarily commitment on the grounds of incompetency or disability, or court-ordered placement under guardianship or conservatorship*. In the event the transfer, judicially declared incompetence, judicially ordered involuntary commitment on the grounds of incompetency or disability, or court-ordered placement under guardianship or conservatorship in the other jurisdiction has been stayed there, any reciprocal transfer or transfer by the Office may be deferred until the stay expires.

(d) *Hearing and transfer to disability inactive status*. The request for transfer to disability inactive status shall be heard by the USPTO Director on the documentary record unless the USPTO Director determines that there is a genuine issue of material fact, in which case the USPTO Director may deny the request. Upon the expiration of 30 days from the date of the notice pursuant to the provisions of paragraph (b) of this section, the USPTO Director shall consider any timely filed response and impose the identical transfer to disability inactive status based on the practitioner's transfer to disability status in another jurisdiction, or shall transfer the practitioner to disability inactive status based on judicially declared incompetence, judicially ordered involuntary commitment on the grounds of incompetency or disability, or court-ordered placement under guardianship or conservatorship, unless the practitioner demonstrates by clear and convincing evidence, or the USPTO Director finds there is a genuine issue of material fact by clear and convincing evidence that:

(1) The procedure was so lacking in notice or opportunity to be heard as to constitute a deprivation of due process;

(2) There was such infirmity of proof establishing the transfer to disability status, judicial declaration of incompetence, judicial order for involuntary commitment on the grounds of incompetency or disability, or placement by court order under guardianship or conservatorship that the USPTO Director could not, consistent with Office's duty, accept as final the conclusion on that subject;

(3) The imposition of the same disability status or transfer to disability status by the USPTO Director would result in grave injustice; or

(4) The practitioner is not the individual transferred to disability status, judicially declared incompetent, judicially ordered for involuntary commitment on the grounds of incompetency or disability, or placed by court order under guardianship or conservatorship.

(5) If the USPTO Director determines that there is no genuine issue of material fact with regard to any of the elements of paragraphs (d)(1) through (4) of this section, the USPTO Director shall enter an appropriate final order. If the USPTO Director is unable to make that determination because there is a genuine issue of material fact, the USPTO Director shall enter an appropriate order dismissing the OED Director's request for such reason.

(e) *Adjudication in other jurisdiction*. In all other aspects, a final adjudication in another jurisdiction that a practitioner be transferred to disability inactive status, is judicially declared incompetent, is judicially ordered to be involuntarily committed on the grounds of incompetency or disability, or is placed by court order under guardianship or conservatorship shall establish the disability for purposes of a reciprocal transfer to or transfer to disability status before the Office.

(f) A practitioner who is transferred to disability inactive status under this section shall be deemed to have been refused recognition to practice before the Office for purposes of 35 U.S.C. 32.

(g) *Order imposing reciprocal transfer to disability inactive status or order imposing initial transfer to disability inactive status*. An order by the USPTO Director imposing reciprocal transfer to disability inactive status, or transferring a practitioner to disability inactive status shall be effective immediately, and shall be for an indefinite period until further order of the USPTO Director. A copy of the order transferring a practitioner to disability inactive status shall be served upon the practitioner, the practitioner's guardian, and/or the director of the institution to which the practitioner has been committed in the manner the USPTO Director may direct. A practitioner reciprocally transferred or transferred to disability inactive status shall comply with the provisions of § 11.58, and shall not engage in practice before the Office in patent, trademark and other non-patent law unless and until reinstated to active status.

(h) *Confidentiality of proceeding; Orders to be public* -- (1) *Confidentiality of proceeding*. All proceedings under this section involving allegations of disability of a practitioner shall be kept confidential until and unless the USPTO Director enters an order reciprocally transferring or transferring the practitioner to disability inactive status.

(2) *Orders to be Public*. The OED Director shall publicize any reciprocal transfer to disability inactive status or transfer to disability inactive status in the same manner as for the imposition of public discipline.

(i) *Employment of practitioners on disability inactive status*. A practitioner on disability inactive status must seek permission from the OED Director to engage in an activity authorized under § 11.58(e). Permission will be granted only if the practitioner has complied with all the conditions of §§ 11.58(a) through 11.58(d) applicable to disability inactive status. In the event that permission is granted, the practitioner shall fully comply with the provisions of § 11.58(e).

(j) *Reinstatement from disability inactive status*. (1) *Generally*. No practitioner reciprocally transferred or transferred to disability inactive status under this section may resume active status except by order of the OED Director.

(2) *Petition*. A practitioner reciprocally transferred or transferred to disability inactive status shall be entitled to petition the OED Director for transfer to active status once a year, or at whatever shorter intervals the USPTO Director may direct in the order transferring or reciprocally transferring the practitioner to disability inactive status or any modification thereof.

(3) *Examination*. Upon the filing of a petition for transfer to active status, the OED Director may take or direct whatever action is deemed necessary or proper to determine whether the incapacity has been removed, including a direction for an examination of the practitioner by qualified medical or psychological experts designated by the OED Director. The expense of the examination shall be paid and borne by the practitioner.

(4) *Required disclosure, waiver of privilege*. With the filing of a petition for reinstatement to active status, the practitioner shall be required to disclose the name of each psychiatrist, psychologist, physician and hospital or other institution by whom or in which the practitioner has been examined or treated for the disability since the transfer to disability inactive status. The practitioner shall furnish to the OED Director written consent to the release of information and records relating to the incapacity if requested by the OED Director.

(5) *Learning in the law, examination*. The OED Director may direct that the practitioner establish proof of competence and learning in law, which proof may include passing the registration examination.

(6) *Granting of petition for transfer to active status*. The OED Director shall grant the petition for transfer to active status upon a showing by clear and convincing evidence that the incapacity has been removed.

(7) *Reinstatement in other jurisdiction*. If a practitioner is reciprocally transferred to disability inactive status on the basis of a transfer to disability inactive status in another jurisdiction, the OED Director may dispense with further evidence that the disability has been removed and may

immediately direct reinstatement to active status upon such terms as are deemed proper and advisable.

(8) *Judicial declaration of competency*. If a practitioner is transferred to disability inactive status on the basis of a judicially declared incompetence, judicially ordered involuntary commitment on the grounds of incompetency or disability, or court-ordered placement under guardianship or conservatorship has been declared to be competent, the OED Director may dispense with further evidence that the incapacity to practice law has been removed and may immediately direct reinstatement to active status.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§§ 11.30 - 11.31 [Reserved]

§ 11.32 Instituting a disciplinary proceeding.

If after conducting an investigation under § 11.22(a), the OED Director is of the opinion that grounds exist for discipline under §§ 11.19(b)(3) through (5), the OED Director, after complying where necessary with the provisions of 5 U.S.C. 558(c), shall convene a meeting of a panel of the Committee on Discipline. The panel of the Committee on Discipline shall then determine as specified in § 11.23(b) whether a disciplinary proceeding shall be instituted. If the panel of the Committee on Discipline determines that probable cause exists to bring charges under §§ 11.19(b)(3) through (5), the OED Director shall institute a disciplinary proceeding by filing a complaint under § 11.34.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.33 [Reserved]

§ 11.34 Complaint.

(a) A complaint instituting a disciplinary proceeding under §§ 11.25(b)(4) or 11.32 shall:

(1) Name the practitioner who may then be referred to as the “respondent”;

(2) Give a plain and concise description of the respondent’s alleged grounds for discipline;

(3) State the place and time, not less than thirty days from the date the complaint is filed, for filing an answer by the respondent;

(4) State that a decision by default may be entered if an answer is not timely filed by the respondent; and

(5) Be signed by the OED Director.

(b) A complaint will be deemed sufficient if it fairly informs the respondent of any grounds for discipline, and where applicable, the Mandatory Disciplinary Rules identified in § 10.20(b) of this subchapter that form the basis for the disciplinary proceeding so that the respondent is able to adequately prepare a defense.

(c) The complaint shall be filed in the manner prescribed by the USPTO Director.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.35 Service of complaint.

(a) A complaint may be served on a respondent in any of the following methods:

(1) By delivering a copy of the complaint personally to the respondent, in which case the individual who gives the complaint to the respondent shall file an affidavit with the OED Director indicating the time and place the complaint was delivered to the respondent.

(2) By mailing a copy of the complaint by "Express Mail," first-class mail, or any delivery service that provides ability to confirm delivery or attempted delivery to:

(i) A respondent who is a registered practitioner at the address provided to OED pursuant to § 11.11, or

(ii) A respondent who is a nonregistered practitioner at the last address for the respondent known to the OED Director.

(3) By any method mutually agreeable to the OED Director and the respondent.

(4) In the case of a respondent who resides outside the United States, by sending a copy of the complaint by any delivery service that provides ability to confirm delivery or attempted delivery, to:

(i) A respondent who is a registered practitioner at the address provided to OED pursuant to § 11.11; or

(ii) A respondent who is a nonregistered practitioner at the last address for the respondent known to the OED Director.

(b) If a copy of the complaint cannot be delivered to the respondent through any one of the procedures in paragraph (a) of this section, the OED Director shall serve the respondent by causing an appropriate notice to be published in the Official Gazette for two consecutive weeks, in which case, the time for filing an answer shall be thirty days from the second publication of the notice. Failure to timely file an answer will constitute an admission of the allegations in the complaint in accordance with paragraph (d) of § 11.36, and the hearing officer may enter an initial decision on default.

(c) If the respondent is known to the OED Director to be represented by an attorney under § 11.40(a), a copy of the complaint shall be served on the attorney in lieu of service on the respondent in the manner provided for in paragraph (a) or (b) of this section.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.36 Answer to complaint.

(a) *Time for answer.* An answer to a complaint shall be filed within the time set in the complaint but in no event shall that time be less than thirty days from the date the complaint is filed.

(b) *With whom filed*. The answer shall be filed in writing with the hearing officer at the address specified in the complaint. The hearing officer may extend the time for filing an answer once for a period of no more than thirty days upon a showing of good cause, provided a motion requesting an extension of time is filed within thirty days after the date the complaint is served on respondent. A copy of the answer, and any exhibits or attachments thereto, shall be served on the OED Director.

(c) *Content.* The respondent shall include in the answer a statement of the facts that constitute the grounds of defense and shall specifically admit or deny each allegation set forth in the complaint. The respondent shall not deny a material allegation in the complaint that the respondent knows to be true or state that respondent is without sufficient information to form a belief as to the truth of an allegation, when in fact the respondent possesses that information. The respondent shall also state affirmatively in the answer special matters of defense and any intent to raise a disability as a mitigating factor. If respondent intends to raise a special matter of defense or disability, the answer shall specify the defense or disability, its nexus to the misconduct, and the reason it provides a defense or mitigation. A respondent who fails to do so cannot rely on a special matter of defense or disability. The hearing officer may, for good cause, allow the respondent to file the statement late, grant additional hearing preparation time, or make other appropriate orders.

(d) *Failure to deny allegations in complaint.* Every allegation in the complaint that is not denied by a respondent in the answer shall be deemed to be admitted and may be considered proven. The hearing officer at any hearing need receive no further evidence with respect to that allegation.

(e) *Default judgment*. Failure to timely file an answer will constitute an admission of the allegations in the complaint and may result in entry of default judgment.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.37 [Reserved]

§ 11.38 Contested case.

Upon the filing of an answer by the respondent, a disciplinary proceeding shall be regarded as a contested case within the meaning of 35 U.S.C. 24. Evidence obtained by a subpoena issued under 35 U.S.C. 24 shall not be admitted into the record or considered unless leave to proceed under 35 U.S.C. 24 was previously authorized by the hearing officer.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.39 Hearing officer; appointment; responsibilities; review of interlocutory orders; stays.

(a) *Appointment*. A hearing officer, appointed by the USPTO Director under 5 U.S.C. 3105 or 35 U.S.C. 32, shall conduct disciplinary proceedings as provided by this Part.

(b) *Independence of the Hearing Officer.* (1) A hearing officer appointed in accordance with paragraph (a) of this section shall not be subject to first level or second level supervision by either the USPTO Director or OED Director, or his or her designee.

(2) A hearing officer appointed in accordance with paragraph (a) of this section shall not be subject to supervision of the person(s) investigating or prosecuting the case.

(3) A hearing officer appointed in accordance with paragraph (a) of this section shall be impartial, shall not be an individual who has participated in any manner in the decision to initiate the proceedings, and shall not have been employed under the immediate supervision of the practitioner.

(4) A hearing officer appointed in accordance with paragraph (a) of this section shall be admitted to practice law and have suitable experience and training conducting hearings, reaching a determination, and rendering an initial decision in an equitable manner.

(c) *Responsibilities*. The hearing officer shall have authority, consistent with specific provisions of these regulations, to:

(1) Administer oaths and affirmations;

(2) Make rulings upon motions and other requests;

(3) Rule upon offers of proof, receive relevant evidence, and examine witnesses;

(4) Authorize the taking of a deposition of a witness in lieu of personal appearance of the witness before the hearing officer;

(5) Determine the time and place of any hearing and regulate its course and conduct;

(6) Hold or provide for the holding of conferences to settle or simplify the issues;

(7) Receive and consider oral or written arguments on facts or law;

(8) Adopt procedures and modify procedures for the orderly disposition of proceedings;

(9) Make initial decisions under §§ 11.25 and 11.54; and

(10) Perform acts and take measures as necessary to promote the efficient, timely, and impartial conduct of any disciplinary proceeding.

(d) *Time for making initial decision*. The hearing officer shall set times and exercise control over a disciplinary proceeding such that an initial decision under § 11.54 is normally issued within

nine months of the date a complaint is filed. The hearing officer may, however, issue an initial decision more than nine months after a complaint is filed if there exist circumstances, in his or her opinion, that preclude issuance of an initial decision within nine months of the filing of the complaint.

(e) *Review of interlocutory orders*. The USPTO Director will not review an interlocutory order of a hearing officer except:

(1) When the hearing officer shall be of the opinion:

(i) That the interlocutory order involves a controlling question of procedure or law as to which there is a substantial ground for a difference of opinion, and

(ii) That an immediate decision by the USPTO Director may materially advance the ultimate termination of the disciplinary proceeding, or

(2) In an extraordinary situation where the USPTO Director deems that justice requires review.

(f) *Stays pending review of interlocutory order*. If the OED Director or a respondent seeks review of an interlocutory order of a hearing officer under paragraph (b)(2) of this section, any time period set by the hearing officer for taking action shall not be stayed unless ordered by the USPTO Director or the hearing officer.

(g) The hearing officer shall engage in no *ex parte* discussions with any party on the merits of the complaint, beginning with appointment and ending when the final agency decision is issued.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.40 Representative for OED Director or respondent.

(a) A respondent may represent himself or herself, or be represented by an attorney before the Office in connection with an investigation or disciplinary proceeding. The attorney shall file a written declaration that he or she is an attorney within the meaning of § 11.1 and shall state:

(1) The address to which the attorney wants correspondence related to the investigation or disciplinary proceeding sent, and

(2) A telephone number where the attorney may be reached during normal business hours.

(b) The Deputy General Counsel for Intellectual Property and Solicitor, and attorneys in the Office of the Solicitor shall represent the OED Director. The attorneys representing the OED Director in disciplinary proceedings shall not consult with the USPTO Director, the General Counsel, the Deputy General Counsel for General Law, or an individual designated by the USPTO Director to decide disciplinary matters regarding the proceeding. The General Counsel and the Deputy General Counsel for General Law shall remain screened from the investigation and prosecution of all disciplinary proceedings in order that they shall be available as counsel to the USPTO Director in deciding disciplinary proceedings unless access is appropriate to perform their duties. After a final decision is entered in a disciplinary proceeding, the OED Director and attorneys representing the OED Director shall be available to counsel the USPTO Director, the General Counsel, and the Deputy General Counsel for General Law in any further proceedings.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.41 Filing of papers.

(a) The provisions of §§ 1.8 and 2.197 of this subchapter do not apply to disciplinary proceedings. All papers filed after the complaint and prior to entry of an initial decision by the hearing officer shall be filed with the hearing officer at an address or place designated by the hearing officer.

(b) All papers filed after entry of an initial decision by the hearing officer shall be filed with the USPTO Director. A copy of the paper shall be served on the OED Director. The hearing officer or

the OED Director may provide for filing papers and other matters by hand, by "Express Mail," or by other means.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.42 Service of papers.

(a) All papers other than a complaint shall be served on a respondent who is represented by an attorney by:

(1) Delivering a copy of the paper to the office of the attorney; or

(2) Mailing a copy of the paper by first-class mail, "Express Mail," or other delivery service to the attorney at the address provided by the attorney under § 11.40(a)(1); or

(3) Any other method mutually agreeable to the attorney and a representative for the OED Director.

(b) All papers other than a complaint shall be served on a respondent who is not represented by an attorney by:

(1) Delivering a copy of the paper to the respondent; or

(2) Mailing a copy of the paper by first-class mail, "Express Mail," or other delivery service to the respondent at the address to which a complaint may be served or such other address as may be designated in writing by the respondent; or

(3) Any other method mutually agreeable to the respondent and a representative of the OED Director.

(c) A respondent shall serve on the representative for the OED Director one copy of each paper filed with the hearing officer or the OED Director. A paper may be served on the representative for the OED Director by:

(1) Delivering a copy of the paper to the representative; or

(2) Mailing a copy of the paper by first-class mail, "Express Mail," or other delivery service to an address designated in writing by the representative; or

(3) Any other method mutually agreeable to the respondent and the representative.

(d) Each paper filed in a disciplinary proceeding shall contain therein a certificate of service indicating:

(1) The date on which service was made; and

(2) The method by which service was made.

(e) The hearing officer or the USPTO Director may require that a paper be served by hand or by "Express Mail."

(f) Service by mail is completed when the paper mailed in the United States is placed into the custody of the U.S. Postal Service.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.43 Motions.

Motions, including all prehearing motions commonly filed under the Federal Rules of Civil Procedure, shall be filed with the hearing officer. The hearing officer will determine whether replies to responses will be authorized and the time period for filing such a response. No motion shall be filed with the hearing officer unless such motion is supported by a written statement by the moving party that the moving party or attorney for the moving party has conferred with the opposing party or attorney for the opposing party in an effort in good faith to resolve by agreement the issues raised by the motion and has been unable to reach agreement. If, prior to a decision on the motion, the parties resolve issues raised by a motion presented to the hearing officer, the parties shall promptly notify the hearing officer.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.44 Hearings.

(a) The hearing officer shall preside over hearings in disciplinary proceedings. The hearing officer shall set the time and place for the hearing. In cases involving an incarcerated respondent, any necessary oral hearing may be held at the location of incarceration. Oral hearings will be stenographically recorded and transcribed, and the testimony of witnesses will be received under oath or affirmation. The hearing officer shall conduct the hearing as if the proceeding were subject to 5 U.S.C. 556. A copy of the transcript of the hearing shall become part of the record. A copy of the transcript shall be provided to the OED Director and the respondent at the expense of the Office.

(b) If the respondent to a disciplinary proceeding fails to appear at the hearing after a notice of hearing has been given by the hearing officer, the hearing officer may deem the respondent to have waived the right to a hearing and may proceed with the hearing in the absence of the respondent.

(c) A hearing under this section will not be open to the public except that the hearing officer may grant a request by a respondent to open his or her hearing to the public and make the record of the disciplinary proceeding available for public inspection, *provided*, a protective order is entered to exclude from public disclosure information which is privileged or confidential under applicable laws or regulations.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.45 Amendment of pleadings.

The OED Director may, without Committee on Discipline authorization, but with the authorization of the hearing officer, amend the complaint to include additional charges based upon conduct committed before or after the complaint was filed. If amendment of the complaint is authorized, the hearing officer shall authorize amendment of the answer. Any party who would otherwise be prejudiced by the amendment will be given reasonable opportunity to meet the allegations in the complaint or answer as amended, and the hearing officer shall make findings on any issue presented by the complaint or answer as amended.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§§ 11.46 - 11.48 [Reserved]

§ 11.49 Burden of proof.

In a disciplinary proceeding, the OED Director shall have the burden of proving the violation by clear and convincing evidence and a respondent shall have the burden of proving any affirmative defense by clear and convincing evidence.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.50 Evidence.

(a) *Rules of evidence*. The rules of evidence prevailing in courts of law and equity are not controlling in hearings in disciplinary proceedings. However, the hearing officer shall exclude evidence that is irrelevant, immaterial, or unduly repetitious.

(b) *Depositions*. Depositions of witnesses taken pursuant to § 11.51 may be admitted as evidence.

(c) *Government documents*. Official documents, records, and papers of the Office, including, but not limited to, all papers in the file of a disciplinary investigation, are admissible without extrinsic evidence of authenticity. These documents, records, and papers may be evidenced by a copy certified as correct by an employee of the Office.

(d) *Exhibits*. If any document, record, or other paper is introduced in evidence as an exhibit, the hearing officer may authorize the withdrawal of the exhibit subject to any conditions the hearing officer deems appropriate.

(e) *Objections*. Objections to evidence will be in short form, stating the grounds of objection. Objections and rulings on objections will be a part of the record. No exception to the ruling is necessary to preserve the rights of the parties.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.51 Depositions.

(a) Depositions for use at the hearing in lieu of personal appearance of a witness before the hearing officer may be taken by respondent or the OED Director upon a showing of good cause and with the approval of, and under such conditions as may be deemed appropriate by, the hearing officer. Depositions may be taken upon oral or written questions, upon not less than ten days' written notice to the other party, before any officer authorized to administer an oath or affirmation in the place where the deposition is to be taken. The parties may waive the requirement of ten days' notice and depositions may then be taken of a witness at a time and place mutually agreed to by the parties. When a deposition is taken upon written questions, copies of the written questions will be served upon the other party with the notice, and copies of any written cross-questions will be served by hand or "Express Mail" not less than five days before the date of the taking of the deposition unless the parties mutually agree otherwise. A party on whose behalf a deposition is taken shall file a copy of a transcript of the deposition signed by a court reporter with the hearing officer and shall serve one copy upon the opposing party. Expenses for a court reporter and preparing, serving, and filing depositions shall be borne by the party at whose instance the deposition is taken. Depositions may not be taken to obtain discovery, except as provided for in paragraph (b) of this section.

(b) When the OED Director and the respondent agree in writing, a deposition of any witness who will appear voluntarily may be taken under such terms and conditions as may be mutually agreeable to the OED Director and the respondent. The deposition shall not be filed with the hearing officer and may not be admitted in evidence before the hearing officer unless he or she orders the deposition admitted in evidence. The admissibility of the deposition shall lie within the discretion of the hearing officer who may reject the deposition on any reasonable basis including the fact that demeanor is involved and that the witness should have been called to appear personally before the hearing officer.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.52 Discovery.

Discovery shall not be authorized except as follows:

(a) After an answer is filed under § 11.36 and when a party establishes that discovery is reasonable and relevant, the hearing officer, under such conditions as he or she deems appropriate, may order an opposing party to:

(1) Answer a reasonable number of written requests for admission or interrogatories;

(2) Produce for inspection and copying a reasonable number of documents; and

(3) Produce for inspection a reasonable number of things other than documents.

(b) Discovery shall not be authorized under paragraph (a) of this section of any matter which:

(1) Will be used by another party solely for impeachment;

(2) Is not available to the party under 35 U.S.C. 122;

(3) Relates to any other disciplinary proceeding;

(4) Relates to experts except as the hearing officer may require under paragraph (e) of this section;

(5) Is privileged; or

(6) Relates to mental impressions, conclusions, opinions, or legal theories of any attorney or other representative of a party.

(c) The hearing officer may deny discovery requested under paragraph (a) of this section if the discovery sought:

(1) Will unduly delay the disciplinary proceeding;

(2) Will place an undue burden on the party required to produce the discovery sought; or

(3) Consists of information that is available:

(i) Generally to the public;

(ii) Equally to the parties; or

(iii) To the party seeking the discovery through another source.

(d) Prior to authorizing discovery under paragraph (a) of this section, the hearing officer shall require the party seeking discovery to file a motion (§ 11.43) and explain in detail, for each request made, how the discovery sought is reasonable and relevant to an issue actually raised in the complaint or the answer.

(e) The hearing officer may require parties to file and serve, prior to any hearing, a pre-hearing statement that contains:

(1) A list (together with a copy) of all proposed exhibits to be used in connection with a party's case-in-chief;

(2) A list of proposed witnesses;

(3) As to each proposed expert witness:

(i) An identification of the field in which the individual will be qualified as an expert;

(ii) A statement as to the subject matter on which the expert is expected to testify; and

(iii) A statement of the substance of the facts and opinions to which the expert is expected to testify;

(4) Copies of memoranda reflecting respondent's own statements to administrative representatives.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.53 Proposed findings and conclusions; post-hearing memorandum.

Except in cases in which the respondent has failed to answer the complaint or amended complaint, the hearing officer, prior to making an initial decision, shall afford the parties a reasonable opportunity to submit proposed findings and conclusions and a post-hearing memorandum in support of the proposed findings and conclusions.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.54 Initial decision of hearing officer.

(a) The hearing officer shall make an initial decision in the case. The decision will include:

(1) A statement of findings of fact and conclusions of law, as well as the reasons or bases for those findings and conclusions with appropriate references to the record, upon all the material issues of fact, law, or discretion presented on the record, and

(2) An order of default judgment, of suspension or exclusion from practice, of reprimand, or an order dismissing the complaint. The hearing officer shall transmit a copy of the decision to the

OED Director and to the respondent. After issuing the decision, the hearing officer shall transmit the entire record to the OED Director. In the absence of an appeal to the USPTO Director, the decision of the hearing officer, including a default judgment, will, without further proceedings, become the decision of the USPTO Director thirty days from the date of the decision of the hearing officer.

(b) The initial decision of the hearing officer shall explain the reason for any default judgment, reprimand, suspension, or exclusion. In determining any sanction, the following four factors must be considered if they are applicable:

(1) Whether the practitioner has violated a duty owed to a client, to the public, to the legal system, or to the profession;

(2) Whether the practitioner acted intentionally, knowingly, or negligently;

(3) The amount of the actual or potential injury caused by the practitioner's misconduct; and

(4) The existence of any aggravating or mitigating factors.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.55 Appeal to the USPTO Director.

(a) Within thirty days after the date of the initial decision of the hearing officer under §§ 11.25 or 11.54, either party may appeal to the USPTO Director. The appeal shall include the appellant's brief. If more than one appeal is filed, the party who files the appeal first is the appellant for purpose of this rule. If appeals are filed on the same day, the respondent is the appellant. If an appeal is filed, then the OED Director shall transmit the entire record to the USPTO Director. Any cross-appeal shall be filed within fourteen days after the date of service of the appeal pursuant to § 11.42, or thirty days after the date of the initial decision of the hearing officer, whichever is later. The cross-appeal shall include the cross-appellant's brief. Any appellee or cross-appellee brief must be filed within thirty days after the date of service pursuant to § 11.42 of an appeal or cross-appeal. Any reply brief must be filed within fourteen days after the date of service of any appellee or cross-appellee brief.

(b) An appeal or cross-appeal must include exceptions to the decisions of the hearing officer and supporting reasons for those exceptions. Any exception not raised will be deemed to have been waived and will be disregarded by the USPTO Director in reviewing the initial decision.

(c) All briefs shall:

(1) Be filed with the USPTO Director at the address set forth in § 1.1(a)(3)(ii) of this subchapter and served on the opposing party;

(2) Include separate sections containing a concise statement of the disputed facts and disputed points of law; and

(3) Be typed on 8 1/2 by 11-inch paper, and comply with Rule 32(a)(4)-(6) of the Federal Rules of Appellate Procedure.

(d) An appellant's, cross-appellant's, appellee's, and cross-appellee's brief shall be no more than thirty pages in length, and comply with Rule 28(a)(2), (3), and (5) through (10) of the Federal Rules of Appellate Procedure. Any reply brief shall be no more than fifteen pages in length, and shall comply with Rule 28(a)(2), (3), (8), and (9) of the Federal Rules of Appellate Procedure.

(e) The USPTO Director may refuse entry of a nonconforming brief.

(f) The USPTO Director will decide the appeal on the record made before the hearing officer.

(g) Unless the USPTO Director permits, no further briefs or motions shall be filed.

(h) The USPTO Director may order reopening of a disciplinary proceeding in accordance with the principles that govern the granting of new trials. Any request to reopen a disciplinary proceeding on the basis of newly discovered evidence must demonstrate that the newly discovered evidence could not have been discovered by due diligence.

(i) In the absence of an appeal by the OED Director, failure by the respondent to appeal under the provisions of this section shall result in the initial decision being final and effective thirty days from the date of the initial decision of the hearing officer.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.56 Decision of the USPTO Director.

(a) The USPTO Director shall decide an appeal from an initial decision of the hearing officer. On appeal from the initial decision, the USPTO Director has authority to conduct a de novo review of the factual record. The USPTO Director may affirm, reverse, or modify the initial decision or remand the matter to the hearing officer for such further proceedings as the USPTO Director may deem appropriate. In making a final decision, the USPTO Director shall review the record or the portions of the record designated by the parties. The USPTO Director shall transmit a copy of the final decision to the OED Director and to the respondent.

(b) A final decision of the USPTO Director may dismiss a disciplinary proceeding, reverse or modify the initial decision, reprimand a practitioner, or may suspend or exclude the practitioner from practice before the Office. A final decision suspending or excluding a practitioner shall require compliance with the provisions of § 11.58. The final decision may also condition the reinstatement of the practitioner upon a showing that the practitioner has taken steps to correct or mitigate the matter forming the basis of the action, or to prevent recurrence of the same or similar conduct.

(c) The respondent or the OED Director may make a single request for reconsideration or modification of the decision by the USPTO Director if filed within twenty days from the date of entry of the decision. No request for reconsideration or modification shall be granted unless the request is based on newly discovered evidence or error of law or fact, and the requestor must demonstrate that any newly discovered evidence could not have been discovered any earlier by due diligence. Such a request shall have the effect of staying the effective date of the order of discipline in the final decision. The decision by the USPTO Director is effective on its date of entry.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.57 Review of final decision of the USPTO Director.

(a) Review of the final decision by USPTO Director in a disciplinary case may be had, subject to § 11.55(d), by a petition filed in accordance with 35 U.S.C. 32. The Respondent must serve the USPTO Director with the petition. Respondent must serve the petition in accordance with Rule 4 of the Federal Rules of Civil Procedure and § 104.2 of this Title.

(b) Except as provided for in § 11.56(c), an order for discipline in a final decision will not be stayed except on proof of exceptional circumstances.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.58 Duties of disciplined or resigned practitioner, or practitioner on disability inactive status.

(a) An excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status shall not engage in any practice of patent, trademark and other non-patent law before the Office. An excluded, suspended or resigned practitioner will not be automatically reinstated at the end of his or her period of exclusion or suspension. An excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status must comply with the provisions of this section and § 11.60 to be reinstated. Failure to comply with the provisions of this section may constitute both grounds for denying reinstatement or readmission; and cause for further action, including seeking further exclusion, suspension, and for revocation of any pending probation.

(b) Unless otherwise ordered by the USPTO Director, any excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status shall:

(1) Within thirty days after the date of entry of the order of exclusion, suspension, acceptance of resignation, or transfer to disability inactive status:

(i) File a notice of withdrawal as of the effective date of the exclusion, suspension, acceptance of resignation, or transfer to disability inactive status in each pending patent and trademark application, each pending reexamination and interference proceeding, and every other matter pending in the Office, together with a copy of the notices sent pursuant to paragraphs (b) and (c) of this section;

(ii) Provide notice to all State and Federal jurisdictions and administrative agencies to which the practitioner is admitted to practice and all clients the practitioner represents having immediate or prospective business before the Office in patent, trademark and other non-patent matters of the order of exclusion, suspension, acceptance of resignation, or transferred to disability inactive status and of the practitioner's consequent inability to act as a practitioner after the effective date of the order; and that, if not represented by another practitioner, the client should act promptly to substitute another practitioner, or to seek legal advice elsewhere, calling attention to any urgency arising from the circumstances of the case;

(iii) Provide notice to the practitioner(s) for all opposing parties (or, to the parties in the absence of a practitioner representing the parties) in matters pending before the Office of the practitioner's exclusion, suspension, resignation, or transfer to disability inactive status and, that as a consequence, the practitioner is disqualified from acting as a practitioner regarding matters before the Office after the effective date of the suspension, exclusion, resignation or transfer to disability inactive status, and state in the notice the mailing address of each client of the excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status who is a party in the pending matter;

(iv) Deliver to all clients having immediate or prospective business before the Office in patent, trademark or other non-patent matters any papers or other property to which the clients are entitled, or shall notify the clients and any co-practitioner of a suitable time and place where the papers and other property may be obtained, calling attention to any urgency for obtaining the papers or other property;

(v) Relinquish to the client, or other practitioner designated by the client, all funds for practice before the Office, including any legal fees paid in advance that have not been earned and any advanced costs not expended;

(vi) Take any necessary and appropriate steps to remove from any telephone, legal, or other directory any advertisement, statement, or representation which would reasonably suggest that the practitioner is authorized to practice patent, trademark, or other non-patent law before the Office; and

(vii) Serve all notices required by paragraphs (b)(1)(ii) and (b)(1)(iii) of this section by certified mail, return receipt requested, unless mailed abroad. If mailed abroad, all notices shall be served with a receipt to be signed and returned to the practitioner.

(2) Within forty-five days after entry of the order of suspension, exclusion, or of acceptance of resignation, the practitioner shall file with the OED Director an affidavit of compliance certifying that the practitioner has fully complied with the provisions of the order, this section, and with the Mandatory Disciplinary Rules identified in § 10.20(b) of this subchapter for withdrawal from representation. Appended to the affidavit of compliance shall be:

(i) A copy of each form of notice, the names and addresses of the clients, practitioners, courts, and agencies to which notices were sent, and all return receipts or returned mail received up to the date of the affidavit. Supplemental affidavits shall be filed covering subsequent return receipts and returned mail. Such names and addresses of clients shall remain confidential unless otherwise ordered by the USPTO Director;

(ii) A schedule showing the location, title and account number of every bank account designated as a client or trust account, deposit account in the Office, or other fiduciary account,

and of every account in which the practitioner holds or held as of the entry date of the order any client, trust, or fiduciary funds for practice before the Office;

(iii) A schedule describing the practitioner's disposition of all client and fiduciary funds for practice before the Office in the practitioner's possession, custody or control as of the date of the order or thereafter;

(iv) Such proof of the proper distribution of said funds and the closing of such accounts as has been requested by the OED Director, including copies of checks and other instruments;

(v) A list of all other State, Federal, and administrative jurisdictions to which the practitioner is admitted to practice; and

(vi) An affidavit describing the precise nature of the steps taken to remove from any telephone, legal, or other directory any advertisement, statement, or representation which would reasonably suggest that the practitioner is authorized to practice patent, trademark, or other non-patent law before the Office. The affidavit shall also state the residence or other address of the practitioner to which communications may thereafter be directed, and list all State and Federal jurisdictions, and administrative agencies to which the practitioner is admitted to practice. The OED Director may require such additional proof as is deemed necessary. In addition, for the period of discipline, an excluded or suspended practitioner, or a practitioner transferred to disability inactive status shall continue to file a statement in accordance with § 11.11, regarding any change of residence or other address to which communications may thereafter be directed, so that the excluded or suspended practitioner, or practitioner transferred to disability inactive status may be located if a grievance is received regarding any conduct occurring before or after the exclusion or suspension. The practitioner shall retain copies of all notices sent and shall maintain complete records of the steps taken to comply with the notice requirements.

(3) Not hold himself or herself out as authorized to practice law before the Office.

(4) Not advertise the practitioner's availability or ability to perform or render legal services for any person having immediate or prospective business before the Office as to that business.

(5) Not render legal advice or services to any person having immediate or prospective business before the Office as to that business.

(6) Promptly take steps to change any sign identifying the practitioner's or the practitioner's firm's office and the practitioner's or the practitioner's firm's stationery to delete therefrom any advertisement, statement, or representation which would reasonably suggest that the practitioner is authorized to practice law before the Office.

(c) An excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status after entry of the order of exclusion or suspension, acceptance of resignation, or transfer to disability inactive status shall not accept any new retainer regarding immediate or prospective business before the Office, or engage as a practitioner for another in any new case or legal matter regarding practice before the Office. The excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status shall be granted limited recognition for a period of thirty days. During the thirty-day period of limited recognition, the excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status shall conclude work on behalf of a client on any matters that were pending before the Office on the date of entry of the order of exclusion or suspension, or acceptance of resignation. If such work cannot be concluded, the excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status shall so advise the client so that the client may make other arrangements.

(d) *Required records*. An excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status shall keep and maintain records of the various steps taken under this section, so that in any subsequent proceeding proof of compliance with this section and with the exclusion or suspension order will be available. The OED Director will require the practitioner to submit such proof as a condition precedent to the granting of any petition for reinstatement.

(e) An excluded, suspended or resigned practitioner, or practitioner on disability inactive status who aids another practitioner in any way in the other practitioner's practice of law before the

Office, may, under the direct supervision of the other practitioner, act as a paralegal for the other practitioner or perform other services for the other practitioner which are normally performed by laypersons, provided:

(1) The excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status is a salaried employee of:

(i) The other practitioner;

(ii) The other practitioner's law firm; or

(iii) A client-employer who employs the other practitioner as a salaried employee;

(2) The other practitioner assumes full professional responsibility to any client and the Office for any work performed by the excluded, suspended or resigned practitioner for the other practitioner;

(3) The excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status does not:

(i) Communicate directly in writing, orally, or otherwise with a client of the other practitioner in regard to any immediate or prospective business before the Office;

(ii) Render any legal advice or any legal services to a client of the other practitioner in regard to any immediate or prospective business before the Office; or

(iii) Meet in person or in the presence of the other practitioner in regard to any immediate or prospective business before the Office, with:

(A) Any Office employee in connection with the prosecution of any patent, trademark, or other case;

(B) Any client of the other practitioner, the other practitioner's law firm, or the client-employer of the other practitioner; or

(C) Any witness or potential witness whom the other practitioner, the other practitioner's law firm, or the other practitioner's client-employer may or intends to call as a witness in any proceeding before the Office. The term "witness" includes individuals who will testify orally in a proceeding before, or sign an affidavit or any other document to be filed in, the Office.

(f) When an excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status acts as a paralegal or performs services under paragraph (e) of this section, the practitioner shall not thereafter be reinstated to practice before the Office unless:

(1) The practitioner shall have filed with the OED Director an affidavit which:

(i) Explains in detail the precise nature of all paralegal or other services performed by the excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status, and

(ii) Shows by clear and convincing evidence that the excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status has complied with the provisions of this section and all Mandatory Disciplinary Rules identified in § 10.20(b) of this subchapter; and

(2) The other practitioner shall have filed with the OED Director a written statement which:

(i) Shows that the other practitioner has read the affidavit required by paragraph (d)(1) of this section and that the other practitioner believes every statement in the affidavit to be true, and

(ii) States why the other practitioner believes that the excluded, suspended or resigned practitioner, or practitioner transferred to disability inactive status has complied with paragraph (c) of this section.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.59 Dissemination of disciplinary and other information.

(a) The OED Director shall inform the public of the disposition of each matter in which public discipline has been imposed, and of any other changes in a practitioner's registration status. Public discipline includes exclusion, as well as exclusion on consent; suspension; and public reprimand. Unless otherwise ordered by the USPTO Director, the OED Director shall give notice of public discipline and the reasons for the discipline to disciplinary enforcement agencies in the

State where the practitioner is admitted to practice, to courts where the practitioner is known to be admitted, and the public. If public discipline is imposed, the OED Director shall cause a final decision of the USPTO Director to be published. Final decisions of the USPTO Director include default judgments. See § 11.54(a)(2). If a private reprimand is imposed, the OED Director shall cause a redacted version of the final decision to be published.

(b) *Records available to the public*. Unless the USPTO Director orders that the proceeding or a portion of the record be kept confidential, the OED Director's records of every disciplinary proceeding where a practitioner is reprimanded, suspended, or excluded, including when said sanction is imposed by default judgment, shall be made available to the public upon written request, except that information may be withheld as necessary to protect the privacy of third parties or as directed in a protective order issued pursuant to § 11.44(c). The record of a proceeding that results in a practitioner's transfer to disability inactive status shall not be available to the public.

(c) *Access to records of exclusion by consent*. Unless the USPTO Director orders that the proceeding or a portion of the record be kept confidential, an order excluding a practitioner on consent under § 11.27 and the affidavit required under paragraph (a) of § 11.27 shall be available to the public, except that information in the order or affidavit may be withheld as necessary to protect the privacy of third parties or as directed in a protective order under § 11.44(c). The affidavit required under paragraph (a) of § 11.27 shall not be used in any other proceeding except by order of the USPTO Director or upon written consent of the practitioner.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.60 Petition for reinstatement.

(a) *Restrictions on reinstatement*. An excluded, suspended or resigned practitioner shall not resume practice of patent, trademark, or other non-patent law before the Office until reinstated by order of the OED Director or the USPTO Director.

(b) *Petition for reinstatement.* An excluded or suspended practitioner shall be eligible to apply for reinstatement only upon expiration of the period of suspension or exclusion and the practitioner's full compliance with § 11.58. An excluded practitioner shall be eligible to apply for reinstatement no earlier than at least five years from the effective date of the exclusion. A resigned practitioner shall be eligible to petition for reinstatement and must show compliance with § 11.58 no earlier than at least five years from the date the practitioner's resignation is accepted and an order is entered excluding the practitioner on consent.

(c) *Review of reinstatement petition.* An excluded, suspended or resigned practitioner shall file a petition for reinstatement accompanied by the fee required by § 1.21(a)(10) of this subchapter. The petition for reinstatement shall be filed with the OED Director. An excluded or suspended practitioner who has violated any provision of § 11.58 shall not be eligible for reinstatement until a continuous period of the time in compliance with § 11.58 that is equal to the period of suspension or exclusion has elapsed. A resigned practitioner shall not be eligible for reinstatement until compliance with § 11.58 is shown. If the excluded, suspended or resigned practitioner is not eligible for reinstatement, or if the OED Director determines that the petition is insufficient or defective on its face, the OED Director may dismiss the petition. Otherwise the OED Director shall consider the petition for reinstatement. The excluded, suspended or resigned practitioner seeking reinstatement shall have the burden of proof by clear and convincing evidence. Such proof shall be included in or accompany the petition, and shall establish:

(1) That the excluded, suspended or resigned practitioner has the good moral character and reputation, competency, and learning in law required under § 11.7 for admission;

(2) That the resumption of practice before the Office will not be detrimental to the administration of justice or subversive to the public interest; and

(3) That the suspended practitioner has complied with the provisions of § 11.58 for the full period of suspension, that the excluded practitioner has complied with the provisions of § 11.58

for at least five continuous years, or that the resigned practitioner has complied with § 11.58 upon acceptance of the resignation.

(d) *Petitions for reinstatement - Action by the OED Director granting reinstatement.* (1) If the excluded, suspended or resigned practitioner is found to have complied with paragraphs (c)(1) through (c)(3) of this section, the OED Director shall enter an order of reinstatement, which shall be conditioned on payment of the costs of the disciplinary proceeding to the extent set forth in paragraphs (d)(2) and (3) of this section.

(2) *Payment of costs of disciplinary proceedings*. Prior to reinstatement to practice, the excluded or suspended practitioner shall pay the costs of the disciplinary proceeding. The costs imposed pursuant to this section include all of the following:

(i) The actual expense incurred by the OED Director or the Office for the original and copies of any reporter's transcripts of the disciplinary proceeding, and any fee paid for the services of the reporter;

(ii) All expenses paid by the OED Director or the Office which would qualify as taxable costs recoverable in civil proceedings; and

(iii) The charges determined by the OED Director to be "reasonable costs" of investigation, hearing, and review. These amounts shall serve to defray the costs, other than fees for services of attorneys and experts, of the Office of Enrollment and Discipline in the preparation or hearing of the disciplinary proceeding, and costs incurred in the administrative processing of the disciplinary proceeding.

(3) An excluded or suspended practitioner may be granted relief, in whole or in part, only from an order assessing costs under this section or may be granted an extension of time to pay these costs, in the discretion of the OED Director, upon grounds of hardship, special circumstances, or other good cause.

(e) *Petitions for reinstatement - Action by the OED Director denying reinstatement*. If the excluded, suspended or resigned practitioner is found unfit to resume the practice of patent law before the Office, the OED Director shall first provide the excluded, suspended or resigned practitioner with an opportunity to show cause in writing why the petition should not be denied. Failure to comply with § 11.12(c) shall constitute unfitness. If unpersuaded by the showing, the OED Director shall deny the petition. The OED Director may require the excluded, suspended or resigned practitioner, in meeting the requirements of § 11.7, to take and pass an examination under § 11.7(b), ethics courses, and/or the Multistate Professional Responsibility Examination. The OED Director shall provide findings, together with the record. The findings shall include on the first page, immediately beneath the caption of the case, a separate section entitled "Prior Proceedings" which shall state the docket number of the original disciplinary proceeding in which the exclusion or suspension was ordered.

(f) *Resubmission of petitions for reinstatement.* If a petition for reinstatement is denied, no further petition for reinstatement may be filed until the expiration of at least one year following the denial unless the order of denial provides otherwise.

(*g*) *Reinstatement proceedings open to public*. Proceedings on any petition for reinstatement shall be open to the public. Before reinstating any excluded or suspended practitioner, the OED Director shall publish a notice of the excluded or suspended practitioner's petition for reinstatement and shall permit the public a reasonable opportunity to comment or submit evidence with respect to the petition for reinstatement.

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.61 Savings clause.

(a) A disciplinary proceeding based on conduct engaged in prior to [INSERT DATE 30 DAYS AFTER DATE OF PUBLICATION IN THE FEDERAL REGISTER] may be instituted subsequent to such effective date, if such conduct would continue to justify suspension or exclusion under the provisions of this part.

(b) No practitioner shall be subject to a disciplinary proceeding under this part based on conduct engaged in before the effective date hereof if such conduct would not have been subject to disciplinary action before [INSERT DATE 30 DAYS AFTER DATE OF PUBLICATION IN THE FEDERAL REGISTER].

(c) Sections 11.24, 11.25, 11.28 and 11.34 through 11.57 shall apply to all proceedings in which the complaint is filed on or after the effective date of these regulations. Section 11.26 and 11.27 shall apply to matters pending on or after [INSERT DATE 30 DAYS AFTER DATE OF PUBLICATION IN THE FEDERAL REGISTER].

(d) Sections 11.58 through 11.60 shall apply to all cases in which an order of suspension or exclusion is entered or resignation is accepted on or after [INSERT DATE 30 DAYS AFTER DATE OF PUBLICATION IN THE FEDERAL REGISTER].

[Added 73 FR 47650, Aug 14. 2008, effective Sept. 15, 2008]

§ 11.62 – 11.99 [Reserved]

Trademark Act of 1946, as Amended

PUBLIC LAW 79-489, CHAPTER 540, APPROVED JULY 5, 1946; 60 STAT. 427

The headings used for sections and subsections or paragraphs in the following reprint of the Act are not part of the Act but have been added for convenience in using this reprint. Prior trademark statutes may be found in Title 15, Chapter 3, of the U.S. Code and in the Statutes at Large. The present Act forms Chapter 22 of Title 15 of the U.S. Code and the U.S. Code citations have been placed at the beginning of each section and subsection. Included are an amendment to repeal § 40 by the Act of May 24, 1949, 63 Stat. 109; and amendments made to § 7(a) by the Act of August 17, 1950, Public Law 81-710, 64 Stat. 459; to § 21 by the Act of July 19, 1952, Public Law 82-593, 66 Stat. 792; to §§ 17, 20, 21, 24 and 31 by the Act of August 8, 1958, Public Law 85-609, 72 Stat. 540; to § 44(d) by the Act of October 3, 1961, Public Law 87-333, 75 Stat. 748; to §§ 1(a)(1), 2(d), 6, 7(a), 7(d), 7(e), 7(f), 9, 10, 12(a), 12(c), 13, 14, 15, 16, 21, 23, 24, 29, 30, 32, 33, 35, 44(b), 44(e) and 45 by the Act of October 9, 1962, Public Law 87-772, 76 Stat. 769; to § 31 by the Act of July 24, 1965, Public Law 89-83, 79 Stat. 260; to § 29 and the terms "Patent Office" and "Commissioner of Patents" by the Act of January 2, 1975, Public Law 93-596, 88 Stat. 1949; to §§ 13, 21 and 35 by the Act of January 2, 1975, Public Law 93-600, 88 Stat. 1955; to § 42 by the Act of October 3, 1978, Public Law 95-410, 92 Stat. 903; to § 17 by the Act of October 15, 1980, Public Law 96-455, 94 Stat. 2024; to § 31 by the Act of December 12, 1980, Public Law 96-517, 94 Stat. 3018; to §§ 21 and 39 by the Act of April 2, 1982, Public Law 97-164, 96 Stat. 25; to §§ 8(a), 8(b), 11, 13, 14, 15, 16 and 31 by the Act of August 27, 1982, Public Law 97-247, 96 Stat. 317; to § 31(a) by the Act of September 8, 1982, Public Law 97-256, 96 Stat. 816; to add § 39(a) by the Act of October 12, 1982, Public Law 97-296, 96 Stat. 1316; to §§ 34, 35 and 36 by the Act of October 12, 1984, Public Law 98-473, 98 Stat. 2179; to §§ 14(c), 21 and 45 by the Act of November 8, 1984, Public Law 98-620, 98 Stat. 3335; to §§ 1, 2(d), 2(e), 2(f), 3, 4, 5, 6(b), 7, 8(a), 9(a), 9(c), 10, 12(a), 13, 14, 15, 16, 18, 19, 21, 23, 24, 26, 27, 29, 30, 32(2), 33, 34, 35(a), 36, 39, 43(a), 44 and 45 and to add § 51 by the Act of November 16, 1988, Public Law 100-667, 102 Stat. 3935; to § 31(a) by the Act of December 10, 1991, Public Law 102-204, 105 Stat. 1640; to § 32(1), to add § 40, and to §§ 43(a) and 45 by the Act of October 27, 1992, Public Law 102-542, 106 Stat. 3567; to §§ 2(e), 2(f) and 23(a) by the Act of December 8, 1993, Public Law 103-182, 107 Stat. 2057; to §§ 2(a) and 45 by the Act of December 8, 1994, Public Law 103-465, 108 Stat. 4982; to §§ 43 and 45 by the Act of January 16, 1996, Public Law 104-98, 109 Stat. 985; to §§ 34(d)(9) and 35 by Public Law No. 104-153, 110 Stat. 1386, July 2, 1996; to §§ 1(d)(1), 2, 7(a), 14, 23(c), 26, 31, 32(1), 33(b), 39(a) and 42 by Public Law 105-330, 112 Stat. 3069, effective October 30, 1998; to §§ 2, 10, 13(a), 14, 24, 32, 34(a), 35(a), 36, 40, 43(a), 43(c)(2) and 45 by Public Law 106-43, 113 Stat. 218, effective August 5, 1999; to §§ 1(a), 1(b), 12(b), 8, 9, 10, 44(d) and 44(e) by Public Law 105-330, 112 Stat. 3064, effective October 30, 1999; to §§ 1, 2, 6, 7, 8, 9, 10, 12, 13, 15, 16, 17, 18, 21, 23, 24, 30, 31, 32, 34, 35, 37, 41, 43, 44, 45, and 47(b) by Public Law 106-113, 113 Stat. 1501A, Nov. 29, 1999; to add Title XII, by Public Law 107-273, 116 Stat. 1758, effective Nov. 2, 2003; by Public Law 108-482, 118 Stat. 3916, effective Dec. 23, 2004; by Public Law 109-312, 120 Stat. 1730, Oct. 6, 2006.

TITLE I - THE PRINCIPAL REGISTER

§ 1 (15 U.S.C. § 1051). Application for registration; verification

(a)(1) The owner of a trademark used in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by

the Director, and such number of specimens or facsimiles of the mark as used as may be required by the Director.

(2) The application shall include specification of the applicant's domicile and citizenship, the date of the applicant's first use of the mark, the date of the applicant's first use of the mark in commerce, the goods in connection with which the mark is used, and a drawing of the mark.

(3) The statement shall be verified by the applicant and specify that—

(A) the person making the verification believes that he or she, or the juristic person in whose behalf he or she makes the verification, to be the owner of the mark sought to be registered;

(B) to the best of the verifier's knowledge and belief, the facts recited in the application are accurate;

(C) the mark is in use in commerce; and

(D) to the best of the verifier's knowledge and belief, no other person has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive, except that, in the case of every application claiming concurrent use, the applicant shall—

(i) state exceptions to the claim of exclusive use; and

(ii) shall specify, to the extent of the verifier's knowledge—

(I) any concurrent use by others;

(II) the goods on or in connection with which and the areas in which each concurrent use exists;

(III) the periods of each use; and

(IV) the goods and area for which the applicant desires registration.

(4) The applicant shall comply with such rules or regulations as may be prescribed by the Director. The Director shall promulgate rules prescribing the requirements for the application and for obtaining a filing date herein.

(b)(1) A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director.

(2) The application shall include specification of the applicant's domicile and citizenship, the goods in connection with which the applicant has a bona fide intention to use the mark, and a drawing of the mark.

(3) The statement shall be verified by the applicant and specify—

(A) that the person making the verification believes that he or she, or the juristic person in whose behalf he or she makes the verification, to be entitled to use the mark in commerce;

(B) the applicant's bona fide intention to use the mark in commerce;

(C) that, to the best of the verifier's knowledge and belief, the facts recited in the application are accurate; and

(D) that, to the best of the verifier's knowledge and belief, no other person has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive.

Except for applications filed pursuant to section 1126 of this title, no mark shall be registered until the applicant has met the requirements of subsections (c) and (d) of this section.

(4) The applicant shall comply with such rules or regulations as may be prescribed by the Director. The Director shall promulgate rules prescribing the requirements for the application and for obtaining a filing date herein.

(c) At any time during examination of an application filed under subsection (b) of this section, an applicant who has made use of the mark in commerce may claim the benefits of such use for purposes of this chapter, by amending his or her application to bring it into conformity with the requirements of subsection (a) of this section.

(d) (1) Within six months after the date on which the notice of allowance with respect to a mark is issued under section 1063(b)(2) of this title to an applicant under subsection (b) of this section, the applicant shall file in the Patent and Trademark Office, together with such number of specimens or facsimiles of the mark as used in commerce as may be required by the Director and payment of the prescribed fee, a verified statement that the mark is in use in commerce and specifying the date of the applicant's first use of the mark in commerce and those goods or services specified in the notice of allowance on or in connection with which the mark is used in commerce. Subject to examination and acceptance of the statement of use, the mark shall be registered in the Patent and Trademark Office, a certificate of registration shall be issued for those goods or services recited in the statement of use for which the mark is entitled to registration, and notice of registration shall be published in the Official Gazette of the Patent and Trademark Office. Such examination may include an examination of the factors set forth in subsections (a) through (e) of section 1052 of this title. The notice of registration shall specify the goods or services for which the mark is registered.

(2) The Director shall extend, for one additional 6-month period, the time for filing the statement of use under paragraph (1), upon written request of the applicant before the expiration of the 6-month period provided in paragraph (1). In addition to an extension under the preceding sentence, the Director may, upon a showing of good cause by the applicant, further extend the time for filing the statement of use under paragraph (1) for periods aggregating not more than 24 months, pursuant to written request of the applicant made before the expiration of the last extension granted under this paragraph. Any request for an extension under this paragraph shall be accompanied by a verified statement that the applicant has a continued bona fide intention to use the mark in commerce and specifying those goods or services identified in the notice of allowance on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce. Any request for an extension under this paragraph shall be accompanied by payment of the prescribed fee. The Director shall issue regulations setting forth guidelines for determining what constitutes good cause for purposes of this paragraph.

(3) The Director shall notify any applicant who files a statement of use of the acceptance or refusal thereof and, if the statement of use is refused, the reasons for the refusal. An applicant may amend the statement of use.

(4) The failure to timely file a verified statement of use under paragraph (1) or an extension request under paragraph (2) shall result in abandonment of the application, unless it can be shown to the satisfaction of the Director that the delay in responding was unintentional, in which case the time for filing may be extended, but for a period not to exceed the period specified in paragraphs (1) and (2) for filing a statement of use.

(e) If the applicant is not domiciled in the United States the applicant 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 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.

(Amended Oct. 9, 1962, 76 Stat. 769; Jan. 2, 1975, 88 Stat. 1949; Nov. 16, 1988, 102 Stat. 3935; Oct. 30, 1998, 112 Stat. 3064; Nov. 29, 1999, 113 Stat. 1501A; Nov. 2, 2002, 116 Stat. 1906.)

§ 2 (15 U.S.C. § 1052). Trademarks registrable on the principal register; concurrent registration

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of title 19) enters into force with respect to the United States.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: *Provided*, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this chapter; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and

effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.

(e) Consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 1054 of this title, (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, (4) is primarily merely a surname, or (5) comprises any matter that, as a whole, is functional.

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before the date of the enactment of the North American Free Trade Agreement Implementation Act. A mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 43(c), may be refused registration only pursuant to a proceeding brought under section 13. A registration for a mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 43(c), may be canceled pursuant to a proceeding brought under either section 14 or section 24.

(Amended Oct. 9, 1962, 76 Stat. 769; Jan. 2, 1975, 88 Stat. 1949; Nov. 16, 1988, 102 Stat. 3037; Dec. 8, 1993, 107 Stat. 2057; Dec. 8, 1994, 108 Stat. 4982; Oct. 30, 1998, 112 Stat. 3069; Aug. 5, 1999, 113 Stat. 218; Nov. 29, 1999, 113 Stat. 1501A-583; Oct. 6, 2006, 120 Stat. 1730.)

§ 3 (15 U.S.C. § 1053). Service marks registrable

Subject to the provisions relating to the registration of trademarks, so far as they are applicable, service marks shall be registrable, in the same manner and with the same effect as are trademarks, and when registered they shall be entitled to the protection provided herein in the case of trademarks. Applications and procedure under this section shall conform as nearly as practicable to those prescribed for the registration of trademarks.

(Amended Nov. 16, 1988, 102 Stat. 3938.)

§ 4 (15 U.S.C. § 1054). Collective marks and certification marks registrable

Subject to the provisions relating to the registration of trademarks, so far as they are applicable, collective and certification marks, including indications of regional origin, shall be registrable under this chapter, in the same manner and with the same effect as are trademarks, by persons, and nations, States, municipalities, and the like, exercising legitimate control over the use of the marks

sought to be registered, even though not possessing an industrial or commercial establishment, and when registered they shall be entitled to the protection provided in this chapter in the case of trademarks, except in the case of certification marks when used so as to represent falsely that the owner or a user thereof makes or sells the goods or performs the services on or in connection with which such mark is used. Applications and procedure under this section shall conform as nearly as practicable to those prescribed for the registration of trademarks.

(Amended Nov. 16, 1988, 102 Stat. 3938.)

§ 5 (15 U.S.C. § 1055). Use by related companies

Where a registered mark or a mark sought to be registered is or may be used legitimately by related companies, such use shall inure to the benefit of the registrant or applicant for registration, and such use shall not affect the validity of such mark or of its registration, provided such mark is not used in such manner as to deceive the public. If first use of a mark by a person is controlled by the registrant or applicant for registration of the mark with respect to the nature and quality of the goods or services, such first use shall inure to the benefit of the registrant or applicant, as the case may be.

(Amended Nov. 16, 1988, 102 Stat. 3938.)

§ 6 (15 U.S.C. § 1056). Disclaimers

(a) The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable. An applicant may voluntarily disclaim a component of a mark sought to be registered.

(b) No disclaimer, including those made under subsection (e) of section 1057 of this title, shall prejudice or affect the applicant's or registrant's rights then existing or thereafter arising in the disclaimed matter, or his right of registration on another application if the disclaimed matter be or shall have become distinctive of his goods or services.

(Amended Oct. 9, 1962, 76 Stat. 769; Nov. 16, 1988, 102 Stat. 3938; Nov. 29, 1999, 113 Stat. 1501A-583.)

§ 7 (15 U.S.C. § 1057). Certificates of registration

(a) *Issuance and form*. Certificates of registration of marks registered upon the principal register shall be issued in the name of the United States of America, under the seal of the United States Patent and Trademark Office, and shall be signed by the Director or have his signature placed thereon, and a record thereof shall be kept in the United States Patent and Trademark Office. The registration shall reproduce the mark, and state that the mark is registered on the principal register under this chapter, the date of the first use of the mark, the date of the first use of the mark in commerce, the particular goods or services for which it is registered, the number and date of the registration, the term thereof, the date on which the application for registration was received in the United States Patent and Trademark Office, and any conditions and limitations that may be imposed in the registration.

(b) *Certificate as prima facie evidence.* A certificate of registration of a mark upon the principal register provided by this chapter shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner's ownership of the mark, and of the owner's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate.

(c) *Application to register mark considered constructive use*. Contingent on the registration of a mark on the principal register provided by this chapter, the filing of the application to register such mark shall constitute constructive use of the mark, conferring a right of priority, nationwide in effect, on or in connection with the goods or services specified in the registration against any other person except for a person whose mark has not been abandoned and who, prior to such filing—

(1) has used the mark;

(2) has filed an application to register the mark which is pending or has resulted in registration of the mark; or

(3) has filed a foreign application to register the mark on the basis of which he or she has acquired a right of priority, and timely files an application under section 1126(d) to register the 125mark which is pending or has resulted in registration of the mark.

(d) *Issuance to assignee*. A certificate of registration of a mark may be issued to the assignee of the applicant, but the assignment must first be recorded in the United States Patent and Trademark Office. In case of change of ownership the Director shall, at the request of the owner and upon a proper showing and the payment of the prescribed fee, issue to such assignee a new certificate of registration of the said mark in the name of such assignee, and for the unexpired part of the original period.

(e) *Surrender, cancellation, or amendment by owner.* Upon application of the owner the Director may permit any registration to be surrendered for cancellation, and upon cancellation appropriate entry shall be made in the records of the United States Patent and Trademark Office. Upon application of the owner and payment of the prescribed fee, the Director for good cause may permit any registration to be amended or to be disclaimed in part: *Provided*, That the amendment or disclaimer does not alter materially the character of the mark. Appropriate entry shall be made in the records of the United States Patent and Trademark Office and upon the certificate of registration.

(f) *Copies of United States Patent and Trademark Office records as evidence*. Copies of any records, books, papers, or drawings belonging to the United States Patent and Trademark Office relating to marks, and copies of registrations, when authenticated by the seal of the United States Patent and Trademark Office and certified by the Director, or in his name by an employee of the Office duly designated by the Director, shall be evidence in all cases wherein the originals would be evidence; and any person making application therefor and paying the prescribed fee shall have such copies.

(g) *Correction of Patent and Trademark Office mistake*. Whenever a material mistake in a registration, incurred through the fault of the United States Patent and Trademark Office, is clearly disclosed by the records of the Office a certificate stating the fact and nature of such mistake shall be issued without charge and recorded and a printed copy thereof shall be attached to each printed copy of the registration and such corrected registration shall thereafter have the same effect as if the same had been originally issued in such corrected form, or in the discretion of the Director a new certificate of registration may be issued without charge. All certificates of correction heretofore issued in accordance with the rules of the United States Patent and Trademark Office and the registrations to which they are attached shall have the same force and effect as if such certificates and their issue had been specifically authorized by statute.

(h) *Correction of applicant's mistake.* Whenever a mistake has been made in a registration and a showing has been made that such mistake occurred in good faith through the fault of the applicant, the Director is authorized to issue a certificate of correction or, in his discretion, a new certificate upon the payment of the prescribed fee: *Provided*, That the correction does not involve such changes in the registration as to require republication of the mark.

(Amended Aug. 17, 1950, 64 Stat. 459; Oct. 9, 1962, 76 Stat. 769; Jan. 2, 1975, 88 Stat. 1949; Nov. 16, 1988, 102 Stat. 3938; Oct. 30, 1998, 112 Stat. 3069; Nov. 29, 1999, 113 Stat. 1501A-583; Mar. 17, 2010, 124 Stat. 66.)

§ 8 (15 U.S.C. § 1058). Duration, affidavits and fees

(a) *Time Periods for Required Affidavits*. Each registration shall remain in force for 10 years, except that the registration of any mark shall be canceled by the Director unless the owner of the registration files in the United States Patent and Trademark Office affidavits that meet the requirements of subsection (b), within the following time periods:

(1) Within the 1-year period immediately preceding the expiration of 6 years following the date of registration under this Act or the date of the publication under section 12(c).

(2) Within the 1-year period immediately preceding the expiration of 10 years following the date of registration, and each successive 10-year period following the date of registration.

(3) The owner may file the affidavit required under this section within the 6-month grace period immediately following the expiration of the periods established in paragraphs (1) and (2), together with the fee described in subsection (b) and the additional grace period surcharge prescribed by the Director.

(b) *Requirements for Affidavit.* The affidavit referred to in subsection (a) shall—

(1)(A) state that the mark is in use in commerce;

(B) set forth the goods and services recited in the registration on or in connection with which the mark is in use in commerce;

(C) be accompanied by such number of specimens or facsimiles showing current use of the mark in commerce as may be required by the Director; and

(D) be accompanied by the fee prescribed by the Director; or

(2)(A) set forth the goods and services recited in the registration on or in connection with which the mark is not in use in commerce;

(B) include a showing that any nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark; and

(C) be accompanied by the fee prescribed by the Director.

(c) *Deficient Affidavit.* If any submission filed within the period set forth in subsection (a) is deficient, including that the affidavit was not filed in the name of the owner of the registration, the deficiency may be corrected after the statutory time period, within the time prescribed after notification of the deficiency. Such submission shall be accompanied by the additional deficiency surcharge prescribed by the Director.

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

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

(f) *Designation of Resident for Service of Process and Notices.* If the owner is not domiciled in the United States, the owner 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 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 last designated address, or if the owner 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.

(Jan. 2, 1975, 88 Stat. 1949; Aug. 27, 1982, 96 Stat. 320; Nov. 16, 1988, 102 Stat. 3939; Oct. 30, 1998, 112 Stat. 3066; Nov. 29, 1999, 113 Stat. 1536, 1501A-583; Nov. 2, 2002, 116 Stat. 1906; Mar. 17, 2010, 124 Stat. 66.)

§ 9 (15 U.S.C. § 1059). Renewal of registration

(a) Subject to the provisions of section 1058 of this title, 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 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.

(Amended Oct. 9, 1962, 76 Stat. 770; Nov. 16, 1988, 102 Stat. 3939; Oct. 30, 1998, 112 Stat. 3067; Nov. 29, 1999, 113 Stat. 1501A-583; Nov. 2, 2002, 116 Stat. 1907.)

§ 10 (15 U.S.C. § 1060). Assignment

(a)(1) A registered mark or a mark for which an application to register has been filed shall be assignable with the good will of the business in which the mark is used, or with that part of the good will of the business connected with the use of and symbolized by the mark. Notwithstanding the preceding sentence, no application to register a mark under section 1051(b) of this title shall be assignable prior to the filing of an amendment under section 1051(c) of this title to bring the application into conformity with section 1051(a) of this title or the filing of the verified statement of use under section 1051(d) of this title, except for an assignment to a successor to the business of the applicant, or portion thereof, to which the mark pertains, if that business is ongoing and existing.

(2) In any assignment authorized by this section, it shall not be necessary to include the good will of the business connected with the use of and symbolized by any other mark used in the business or by the name or style under which the business is conducted.

(3) Assignments shall be by instruments in writing duly executed. Acknowledgment shall be prima facie evidence of the execution of an assignment, and when the prescribed information reporting the assignment is recorded in the United States Patent and Trademark Office, the record shall be prima facie evidence of execution.

(4) An assignment shall be void against any subsequent purchaser for valuable consideration without notice, unless the prescribed information reporting the assignment is recorded in the United States Patent and Trademark Office within 3 months after the date of the assignment or prior to the subsequent purchase.

(5) The United States Patent and Trademark Office shall maintain a record of information on assignments, in such form as may be prescribed by the Director.

(b) An assignee not domiciled in the United States 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 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 assignee 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 upon the Director.

(Amended Oct. 9, 1962, 76 Stat. 770; Jan. 2, 1975, 88 Stat. 1949; Nov. 16, 1988, 102 Stat. 3937; Aug. 5, 1999, 113 Stat. 218; Oct. 30, 1998, 112 Stat. 3068, effective Oct. 30, 1999; Aug. 5, 1999, 113 Stat. 218; Nov. 29, 1999, 113 Stat. 1501A-583; Nov. 2, 2002, 116 Stat. 1907.)

§ 11 (15 U.S.C. § 1061). Acknowledgments and verifications

Acknowledgments and verifications required hereunder may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States or before any official authorized to administer oaths in the foreign country concerned whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States, or apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States, and shall be valid if they comply with the laws of the state or country where made.

(Amended Aug. 27, 1982, 96 Stat. 321.)

§ 12 (15 U.S.C. § 1062). Publication

(a) Upon the filing of an application for registration and payment of the prescribed fee, the Director shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made and, if on such examination it shall appear that the applicant is entitled to registration, or would be entitled to registration upon the acceptance of the statement of use required by section 1051(d) of this title, the Director shall cause the mark to be published in the Official Gazette of the Patent and Trademark Office: *Provided*, That in the case of an applicant claiming concurrent use, or in the case of an application to be placed in an interference as

provided for in section 1066 of this title, the mark, if otherwise registrable, may be published subject to the determination of the rights of the parties to such proceedings.

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

(c) A registrant of a mark registered under the provision of the Act of March 3, 1881, or the Act of February 20, 1905, may, at any time prior to the expiration of the registration thereof, upon the payment of the prescribed fee file with the Director an affidavit setting forth those goods stated in the registration on which said mark is in use in commerce and that the registrant claims the benefits of this chapter for said mark. The Director shall publish notice thereof with a reproduction of said mark in the Official Gazette, and notify the registrant of such publication and of the requirement for the affidavit of use or nonuse as provided for in subsection (b) of section 1058 of this title. Marks published under this subsection shall not be subject to the provisions of section 1063 of this chapter.

(Amended Oct. 9, 1962, 76 Stat. 770; Jan. 2, 1975, 88 Stat. 1949; Nov. 16, 1988, 102 Stat. 3940; Oct. 30, 1998, 112 Stat. 3066; Nov. 29, 1999, 113 Stat. 1501A-583.)

§ 13 (15 U.S.C. § 1063). Opposition

(a) Any person who believes that he would be damaged by the registration of a mark upon the principal register, including the registration of any mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 1062 of this title of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Director for good cause when requested prior to the expiration of an extension. The Director shall notify the applicant of each extension of the time for filing opposition. An opposition may be amended under such conditions as may be prescribed by the Director.

(b) Unless registration is successfully opposed—

(1) a mark entitled to registration on the principal register based on an application filed under section 1051(a) of this title or pursuant to section 1126 shall be registered in the Patent and Trademark Office, a certificate of registration shall be issued, and notice of the registration shall be published in the Official Gazette of the Patent and Trademark Office; or

(2) a notice of allowance shall be issued to the applicant if the applicant applied for registration under section 1051(b) of this title.

(Amended Oct. 9, 1962, 76 Stat. 771; Jan. 2, 1975, 88 Stat. 1949; Jan. 2, 1975, 88 Stat. 1955; Aug. 27, 1982, 96 Stat. 320; Nov. 16, 1988, 102 Stat. 3940; Aug. 5, 1999, 113 Stat. 218; Nov. 29, 1999, 113 Stat. 1501A-583; Oct. 6, 2006, 120 Stat. 1730.)

§ 14 (15 U.S.C. § 1064). Cancellation

A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged, including as a result of a likelihood of dilution by blurring or dilution by tarnishment under section 1125(c) of this title, by the registration of a mark on the principal register established by this chapter, or under the Act of March 3, 1881, or the Act of February 20, 1905:

(1) Within five years from the date of the registration of the mark under this chapter.

(2) Within five years from the date of publication under section 1062(c) of this title of a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905.

(3) At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 1054 of this title or of subsection (a), (b), or (c) of section 1052 of this title for a registration under this chapter, or contrary to similar prohibitory provisions of such said prior Acts for a registration under such Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. If the registered mark becomes the generic name for less than all of the goods or services for which it is registered, a petition to cancel the registration for only those goods or services may be filed. A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.

(4) At any time if the mark is registered under the Act of March 3, 1881, or the Act of February 20, 1905, and has not been published under the provisions of subsection (c) of section 1062 of this title.

(5) At any time in the case of a certification mark on the ground that the registrant (A) does not control, or is not able legitimately to exercise control over, the use of such mark, or (B) engages in the production or marketing of any goods or services to which the certification mark is applied, or (C) permits the use of the certification mark for purposes other than to certify, or (D) discriminately refuses to certify or to continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies:

Provided, That the Federal Trade Commission may apply to cancel on the grounds specified in paragraphs (3) and (5) of this section any mark registered on the principal register established by this chapter, and the prescribed fee shall not be required. Nothing in paragraph (5) shall be deemed to prohibit the registrant from using its certification mark in advertising or promoting recognition of the certification program or of the goods or services meeting the certification standards of the registrant. Such uses of the certification mark shall not be grounds for cancellation under paragraph (5), so long as the registrant does not itself produce, manufacture, or sell any of the certified goods or services to which its identical certification mark is applied.

(Amended Oct. 9, 1962, 76 Stat. 771; Aug. 27, 1982, 96 Stat. 320; Nov. 8, 1984, 98 Stat. 3335; Nov. 16, 1988, 102 Stat. 3940; Oct. 30, 1998, 112 Stat. 3069; Aug. 5, 1999, 113 Stat. 218; Oct. 6, 2006, 120 Stat. 1730.)

§ 15 (15 U.S.C. § 1065). Incontestability of right to use mark under certain conditions

Except on a ground for which application to cancel may be filed at anytime under paragraphs (3) and (5) of section 1064 of this title, and except to the extent, if any, to which the use of a mark registered on the principal register infringes a valid right acquired under the law of any State or Territory by use of a mark or trade name continuing from a date prior to the date of registration under this chapter of such registered mark, the right of the owner to use such registered mark in commerce for the goods or services on or in connection with which such registered mark has been in continuous use for five consecutive years subsequent to the date of such registration and is still in use in commerce, shall be incontestable: *Provided*, That—

(1) there has been no final decision adverse to the owner's claim of ownership of such mark for such goods or services, or to the owner's right to register the same or to keep the same on the register; and

(2) there is no proceeding involving said rights pending in the United States Patent and Trademark Office or in a court and not finally disposed of; and

(3) an affidavit is filed with the Director within one year after the expiration of any such five-year period setting forth those goods or services stated in the registration on or in connection with which such mark has been in continuous use for such five consecutive years and is still in use in commerce, and the other matters specified in paragraphs (1) and (2) of this section; and

(4) no incontestable right shall be acquired in a mark which is the generic name for the goods or services or a portion thereof, for which it is registered.

Subject to the conditions above specified in this section, the incontestable right with reference to a mark registered under this chapter shall apply to a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905, upon the filing of the required affidavit with the Director within one year after the expiration of any period of five consecutive years after the date of publication of a mark under the provisions of subsection (c) of section 1062 of this title.

The Director shall notify any registrant who files the above-prescribed affidavit of the filing thereof.

(Amended Oct. 9, 1962, 76 Stat. 771; Jan. 2, 1975, 88 Stat. 1949; Aug. 27, 1982, 96 Stat. 320; Nov. 16, 1988, 102 Stat. 3941; Nov. 29, 1999, 113 Stat. 1501A-583; Mar. 17, 2010, 124 Stat. 66.)

§ 16 (15 U.S.C. § 1066). Interference

Upon petition showing extraordinary circumstances, the Director may declare that an interference exists when application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when used on or in connection with the goods or services of the applicant to cause confusion or mistake or to deceive. No interference shall be declared between an application and the registration of a mark the right to the use of which has become incontestable.

(Amended Oct. 9, 1962, 76 Stat. 771; Aug. 27, 1982, 96 Stat. 321; Nov. 16, 1988, 102 Stat. 3941; Nov. 29, 1999, 113 Stat. 1501A-583.)

§ 17 (15 U.S.C. § 1067). Interference, opposition, and proceedings for concurrent use registration or for cancellation; notice; Trademark Trial and Appeal Board

(a) In every case of interference, opposition to registration, application to register as a lawful concurrent user, or application to cancel the registration of a mark, the Director shall give notice to all parties and shall direct a Trademark Trial and Appeal Board to determine and decide the respective rights of registration.

(b) The Trademark Trial and Appeal Board shall include the Director, Deputy Director of the United States Patent and Trademark Office, the Commissioner for Patents, the Commissioner for Trademarks, and administrative trademark judges who are appointed by the Director.

(c) Authority of the Secretary. The Secretary of Commerce may, in his or her discretion, deem the appointment of an administrative trademark judge who, before the date of the enactment of this subsection, held office pursuant to an appointment by the Director to take effect on the date on which the Director initially appointed the administrative trademark judge.

(d) Defense to Challenge of Appointment. It shall be a defense to a challenge to the appointment of an administrative trademark judge on the basis of the judge's having been originally appointed by the Director that the administrative trademark judge so appointed was acting as a de facto officer.

(Amended Aug. 8, 1958, 72 Stat. 540; Jan. 2, 1975, 88 Stat. 1949; 94 Stat. 2024; Nov. 29, 1999, 113 Stat. 1536, 1501A-580; Nov. 2, 2002, 116 Stat. 1902; Aug. 12, 2008, 122 Stat. 3014.)

§ 18 (15 U.S.C. § 1068). Refusal, cancellation, or restriction of registration; concurrent use

In such proceedings the Director may refuse to register the opposed mark, may cancel the registration, in whole or in part, may modify the application or registration by limiting the goods or services specified therein, may otherwise restrict or rectify with respect to the register the registration of a registered mark, may refuse to register any or all of several interfering marks, or may register the mark or marks for the person or persons entitled thereto, as the rights of the parties under this chapter may be established in the proceedings: Provided, That in the case of the registration of any mark based on concurrent use, the Director shall determine and fix the conditions and limitations provided for in subsection (d) of section 1052 of this title. However, no final judgment shall be entered in favor of an applicant under section 1051(b) of this title before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 1057(c) of this title.

(Amended Nov. 16, 1988, 102 Stat. 3941; Nov. 29, 1999, 113 Stat. 1501A-583.)

§ 19 (15 U.S.C. § 1069). Applicability, in inter partes proceeding, of equitable principles of laches, estoppel and acquiescence

In all inter partes proceedings equitable principles of laches, estoppel, and acquiescence, where applicable, may be considered and applied.

(Amended Jan. 2, 1975, 88 Stat. 1949; Nov. 16, 1988, 102 Stat. 3941.)

§ 20 (15 U.S.C. § 1070). Appeal from examiner to Trademark Trial and Appeal Board

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

(Amended Aug. 8, 1958, 72 Stat. 540.)

§ 21 (15 U.S.C. § 1071). Appeal to courts

(a) *Persons entitled to appeal; United States Court of Appeals for the Federal Circuit; waiver of civil action; election of civil action by adverse party; procedure*.

(1) An applicant for registration of a mark, party to an interference proceeding, party to an opposition proceeding, party to an application to register as a lawful concurrent user, party to a cancellation proceeding, a registrant who has filed an affidavit as provided in section 1058 or section 71 of this title, or an applicant for renewal, who is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, may appeal to the United States Court of Appeals for the Federal Circuit thereby waiving his right to proceed under subsection (b) of this section: *Provided*, That such appeal shall be dismissed if any adverse party to the proceeding, other than the Director, shall, within twenty days after the appellant has filed notice of appeal according to paragraph (2) of this subsection, files notice with the Director that he elects to have all further proceedings conducted as provided in subsection (b) of this section. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under subsection (b) of this section, in default of which the decision appealed from shall govern the further proceedings in the case.

(2) When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the United States Patent and Trademark Office a written notice of appeal directed to the Director, within such time after the date of the decision from which the appeal is taken as the Director prescribes, but in no case less than 60 days after that date.

(3) The Director shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the United States Patent and Trademark Office. The court may request that the Director forward the original or certified copies of such documents during pendency of the appeal. In an ex parte case, the Director shall submit to that court a brief explaining the grounds for the decision of the United States Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Director and the parties in the appeal.

(4) The United States Court of Appeals for the Federal Circuit shall review the decision from which the appeal is taken on the record before the United States Patent and Trademark Office. Upon its determination the court shall issue its mandate and opinion to the Director, which shall be entered of record in the United States Patent and Trademark Office and shall govern the further proceedings in the case. However, no final judgment shall be entered in favor of an applicant under section 1051(b) of this title before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 1057(c) of this title.

(b) *Civil action; persons entitled to; jurisdiction of court; status of Director; procedure*.

(1) Whenever a person authorized by subsection (a) of this section to appeal to the United States Court of Appeals for the Federal Circuit is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, said person may, unless appeal has been taken to said United States Court of Appeals for the Federal Circuit, have remedy by a civil action if commenced within such time after such decision, not less than sixty days, as the Director appoints or as provided in subsection (a) of this section. The court may adjudge that an applicant is entitled to a registration upon the application involved, that a registration involved should be canceled, or such other matter as the issues in the proceeding require, as the facts in the case

may appear. Such adjudication shall authorize the Director to take any necessary action, upon compliance with the requirements of law. However, no final judgment shall be entered in favor of an applicant under section 1051(b) of this title before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 1057(c) of this title.

(2) The Director shall not be made a party to an inter partes proceeding under this subsection, but he shall be notified of the filing of the complaint by the clerk of the court in which it is filed and shall have the right to intervene in the action.

(3) In any case where there is no adverse party, a copy of the complaint shall be served on the Director, and, unless the court finds the expenses to be unreasonable, all the expenses of the proceeding shall be paid by the party bringing the case, whether the final decision is in favor of such party or not. In suits brought hereunder, the record in the United States Patent and Trademark Office shall be admitted on motion of any party, upon such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of any party to take further testimony. The testimony and exhibits of the record in the United States Patent and Trademark Office, when admitted, shall have the same effect as if originally taken and produced in the suit.

(4) Where there is an adverse party, such suit may be instituted against the party in interest as shown by the records of the United States Patent and Trademark Office at the time of the decision complained of, but any party in interest may become a party to the action. If there are adverse parties residing in a plurality of districts not embraced within the same State, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs.

(Amended July 19, 1952, 66 Stat. 814; Aug. 8, 1958, 72 Stat. 540; Oct. 9, 1962, 76 Stat. 771; Jan. 2, 1975, 88 Stat. 1949; Jan. 2, 1975, 88 Stat. 1955; Apr. 2, 1982, 96 Stat. 49; Nov. 8, 1984, 98 Stat. 3363; Nov. 16, 1988, 102 Stat. 3942; Nov. 29, 1999, 113 Stat. 1501A-583; Mar. 17, 2010, 124 Stat. 66.)

§ 22 (15 U.S.C. § 1072). Registration as notice

Registration of a mark on the principal register provided by this chapter or under the Act of March 3, 1881, or the Act of February 20, 1905, shall be constructive notice of the registrant's claim of ownership thereof.

TITLE II - THE SUPPLEMENTAL REGISTER

§ 23 (15 U.S.C. § 1091). Filing and registration for foreign use

(a) In addition to the principal register, the Director shall keep a continuation of the register provided in paragraph (b) of section 1 of the Act of March 19, 1920, entitled "An Act to give effect to certain provisions of the convention for the protection of trademarks and commercial names, made and signed in the city of Buenos Aires, in the Argentine Republic, August 20, 1910, and for other purposes," to be called the supplemental register. All marks capable of distinguishing applicant's goods or services and not registrable on the principal register herein provided, except those declared to be unregistrable under subsections (a), (b), (c), (d), and (e)(3) of section 1052 of this title, which are in lawful use in commerce by the owner thereof, on or in connection with any goods or services may be registered on the supplemental register upon the payment of the

prescribed fee and compliance with the provisions of subsections (a) and (e) of section 1051 of this title so far as they are applicable. Nothing in this section shall prevent the registration on the supplemental register of a mark, capable of distinguishing the applicant's goods or services and not registrable on the principal register under this chapter, that is declared to be unregistrable under section 1052(e)(3) of this title, if such mark has been in lawful use in commerce by the owner thereof, on or in connection with any goods or services, since before December 8, 1993.

(b) Upon the filing of an application for registration on the supplemental register and payment of the prescribed fee the Director shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made and if on such examination it shall appear that the applicant is entitled to registration, the registration shall be granted. If the applicant is found not entitled to registration the provisions of subsection (b) of section 1062 of this title shall apply.

(c) For the purposes of registration on the supplemental register, a mark may consist of any trademark, symbol, label, package, configuration of goods, name, word, slogan, phrase, surname, geographical name, numeral, device, any matter that as a whole is not functional, or any combination of any of the foregoing, but such mark must be capable of distinguishing the applicant's goods or services.

(Amended Oct. 9, 1962, 76 Stat. 773; Nov. 16, 1988, 102 Stat. 3942; Dec. 8, 1993, 107 Stat. 2057; Oct. 30, 1998, 112 Stat. 3069; Nov. 29, 1999, 113 Stat. 1501A-583; Nov. 2, 2002, 116 Stat. 1908.)

§ 24 (15 U.S.C. § 1092). Cancellation

Marks for the supplemental register shall not be published for or be subject to opposition, but shall be published on registration in the Official Gazette of the Patent and Trademark Office. Whenever any person believes that such person is or will be damaged by the registration of a mark on the supplemental register--

(1) for which the effective filing date is after the date on which such person's mark became famous and which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title; or

(2) on grounds other than dilution by blurring or dilution by tarnishment, such person may at any time, upon payment of the prescribed fee and the filing of a petition stating the ground therefor, apply to the Director to cancel such registration.

The Director shall refer such application to the Trademark Trial and Appeal Board, which shall give notice thereof to the registrant. If it is found after a hearing before the Board that the registrant is not entitled to registration, or that the mark has been abandoned, the registration shall be canceled by the Director. However, no final judgment shall be entered in favor of an applicant under section 1051(b) of this title before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 1057(c).

(Amended Aug. 8, 1958, 72 Stat. 540; Oct. 9, 1962, 76 Stat. 773; Jan. 2, 1975, 88 Stat. 1949; Nov. 16, 1988, 102 Stat. 3943; Aug. 5, 1999, 113 Stat. 218; Nov. 29, 1999, 113 Stat. 1501A-583; Oct. 6, 2006, 120 Stat. 1730.)

§ 25 (15 U.S.C. § 1093). Supplemental registration certificate

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.

§ 26 (15 U.S.C. § 1094). General provisions

The provisions of this chapter shall govern so far as applicable applications for registration and registrations on the supplemental register as well as those on the principal register, but applications for and registrations on the supplemental register shall not be subject to or receive the advantages of sections 1051(b), 1052(e), 1052(f), 1057(b), 1057(c), 1062(a), 1063 to 1068, inclusive, 1072, 1115 and 1124 of this title.

(Amended Nov. 16, 1988, 102 Stat. 3943; Oct. 30, 1998, 112 Stat. 3069.)

§ 27 (15 U.S.C. § 1095). Principal registration not precluded by supplemental registration

Registration of a mark on the supplemental register, or under the Act of March 19, 1920, shall not preclude registration by the registrant on the principal register established by this chapter. Registration of a mark on the supplemental register shall not constitute an admission that the mark has not acquired distinctiveness.

(Amended Nov. 16, 1988, 102 Stat. 3943.)

§ 28 (15 U.S.C. § 1096). Department of Treasury; supplemental registration not filed

Registration on the supplemental register or under the Act of March 19, 1920, shall not be filed in the Department of the Treasury or be used to stop importations.

TITLE III - NOTICE OF REGISTRATION

§ 29 (15 U.S.C. § 1111). Notice of registration; display with mark; recovery of profits and damages in infringement suit

Notwithstanding the provisions of section 1072 of this title, a registrant of a mark registered in the Patent and Trademark Office, may give notice that his mark is registered by displaying with the mark the words "Registered in U.S. Patent and Trademark Office" or "Reg. U.S. Pat. & Tm. Off." or the letter R enclosed within a circle, thus ®; and in any suit for infringement under this chapter by such a registrant failing to give such notice of registration, no profits and no damages shall be recovered under the provisions of this chapter unless the defendant had actual notice of the registration.

(Amended Oct. 9, 1962, 76 Stat. 773; Jan. 2, 1975, 88 Stat. 1949; Nov. 16, 1988, 102 Stat. 1343.)

**Note: The amendment of the wording of this term by Public Law 93-596 became effective on January 2, 1975. However, the amendment provides that any registrant may continue to give notice of his registration in accordance with § 29 of the Trademark Act of 1946, as amended Oct. 9, 1962, as an alternative to notice in accordance with § 29 of the Trademark Act as amended by Public Law 93-596, regardless of whether his mark was registered before or after January 2, 1975.*

TITLE IV - CLASSIFICATION

§ 30 (15 U.S.C. § 1112). Classification of goods and services; registration in plurality of classes

The Director may establish a classification of goods and services, for convenience of Patent and Trademark Office administration, but not to limit or extend the applicant's or registrant's rights. The applicant may apply to register a mark for any or all of the goods or services on or in connection with which he or she is using or has a bona fide intention to use the mark in commerce: Provided, That if the Director by regulation permits the filing of an application for the registration of a mark for goods or services which fall within a plurality of classes, a fee equaling the sum of the fees for filing an application in each class shall be paid, and the Director may issue a single certificate of registration for such mark.

(Amended Oct. 9, 1962, 76 Stat. 773; Jan. 2, 1975, 88 Stat. 1949; Nov. 16, 1988, 102 Stat. 3943; Nov. 29, 1999, 113 Stat. 1501A-583.)

TITLE V - FEES AND CHARGES

§ 31 (15 U.S.C. § 1113). Fees

(a) The Director shall establish fees for the filing and processing of an application for the registration of a trademark or other mark and for all other services performed by and materials furnished by the Patent and Trademark Office related to trademarks and other marks. Fees established under this subsection may be adjusted by the Director once each year to reflect, in the aggregate, any fluctuations during the preceding 12 months in the Consumer Price Index, as determined by the Secretary of Labor. Changes of less than 1 percent may be ignored. No fee established under this section shall take effect until at least 30 days after notice of the fee has been published in the Federal Register and in the Official Gazette of the Patent and Trademark Office.

(b) The Director may waive the payment of any fee for any service or material related to trademarks or other marks in connection with an occasional request made by a department or agency of the Government, or any officer thereof. The Indian Arts and Crafts Board will not be charged any fee to register Government trademarks of genuineness and quality for Indian products or for products of particular Indian tribes and groups.

(Amended Aug. 8, 1958, 72 Stat. 540; July 24, 1965, 79 Stat. 260; Jan. 2, 1975, 88 Stat. 1949; Dec. 12, 1980, 94 Stat. 3018; Aug. 27, 1982, 96 Stat. 319; Sept. 8, 1982, 96 Stat. 256; Dec. 10, 1991, 105 Stat. 1640; Oct. 30, 1998, 112 Stat. 3069; Nov. 29, 1999, 113 Stat. 1501A-554.)

TITLE VI - REMEDIES

§ 32 (15 U.S.C. § 1114). Remedies; infringement; innocent infringers

(1) Any person who shall, without the consent of the registrant—

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b) reproduce, counterfeit, copy or colorably imitate a registered mark and apply such reproduction, counterfeit, copy or colorable imitation to labels, signs, prints, packages,

wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive,

shall be liable in a civil action by the registrant for the remedies hereinafter provided. Under subsection (b) hereof, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive.

As used in this paragraph, the term "any person" includes the United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, or other persons acting for the United States and with the authorization and consent of the United States, and any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. The United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, other persons acting for the United States and with the authorization and consent of the United States, and any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

(2) Notwithstanding any other provision of this chapter, the remedies given to the owner of a right infringed under this chapter or to a person bringing an action under section 1125(a) or (d) of this title shall be limited as follows:

(A) Where an infringer or violator is engaged solely in the business of printing the mark or violating matter for others and establishes that he or she was an innocent infringer or innocent violator, the owner of the right infringed or person bringing the action under section 1125(a) of this title shall be entitled as against such infringer or violator only to an injunction against future printing.

(B) Where the infringement or violation complained of is contained in or is part of paid advertising matter in a newspaper, magazine, or other similar periodical or in an electronic communication as defined in section 2510(12) of title 18, United States Code, the remedies of the owner of the right infringed or person bringing the action under section 1125(a) of this title as against the publisher or distributor of such newspaper, magazine, or other similar periodical or electronic communication shall be limited to an injunction against the presentation of such advertising matter in future issues of such newspapers, magazines, or other similar periodicals or in future transmissions of such electronic communications. The limitations of this subparagraph shall apply only to innocent infringers and innocent violators.

(C) Injunctive relief shall not be available to the owner of the right infringed or person bringing the action under section 1125(a) of this title with respect to an issue of a newspaper, magazine, or other similar periodical or an electronic communication containing infringing matter or violating matter where restraining the dissemination of such infringing matter or violating matter in any particular issue of such periodical or in an electronic communication would delay the delivery of such issue or transmission of such electronic communication after the regular time for such delivery or transmission, and such delay would be due to the method by which publication and distribution of such periodical or transmission of such electronic communication is customarily conducted in accordance with sound business practice, and not due to any method or device adopted to evade this section or to prevent or delay the issuance of an injunction or restraining order with respect to such infringing matter or violating matter.

(D)(i)(I) A domain name registrar, a domain name registry, or other domain name registration authority that takes any action described under clause (ii) affecting a domain name shall not be liable for monetary relief or, except as provided in subclause (II), for

injunctive relief, to any person for such action, regardless of whether the domain name is finally determined to infringe or dilute the mark.

(II) A domain name registrar, domain name registry, or other domain name registration authority described in subclause (I) may be subject to injunctive relief only if such registrar, registry, or other registration authority has—

(aa) not expeditiously deposited with a court, in which an action has been filed regarding the disposition of the domain name, documents sufficient for the court to establish the court's control and authority regarding the disposition of the registration and use of the domain name;

(bb) transferred, suspended, or otherwise modified the domain name during the pendency of the action, except upon order of the court; or

(cc) willfully failed to comply with any such court order.

(ii) An action referred to under clause (i)(I) is any action of refusing to register, removing from registration, transferring, temporarily disabling, or permanently canceling a domain name—

(I) in compliance with a court order under section 43(d); or

(II) in the implementation of a reasonable policy by such registrar, registry, or authority prohibiting the registration of a domain name that is identical to, confusingly similar to, or dilutive of another's mark.

(iii) A domain name registrar, a domain name registry, or other domain name registration authority shall not be liable for damages under this section for the registration or maintenance of a domain name for another absent a showing of bad faith intent to profit from such registration or maintenance of the domain name.

(iv) If a registrar, registry, or other registration authority takes an action described under clause (ii) based on a knowing and material misrepresentation by any other person that a domain name is identical to, confusingly similar to, or dilutive of a mark, the person making the knowing and material misrepresentation shall be liable for any damages, including costs and attorney's fees, incurred by the domain name registrant as a result of such action. The court may also grant injunctive relief to the domain name registrant, including the reactivation of the domain name or the transfer of the domain name to the domain name registrant.

(v) A domain name registrant whose domain name has been suspended, disabled, or transferred under a policy described under clause (ii)(II) may, upon notice to the mark owner, file a civil action to establish that the registration or use of the domain name by such registrant is not unlawful under this chapter. The court may grant injunctive relief to the domain name registrant, including the reactivation of the domain name or transfer of the domain name to the domain name registrant.

(E) As used in this paragraph—(i) the term "violator" means a person who violates section 1125(a) of this title; and

(ii) the term "violating matter" means matter that is the subject of a violation under section 1125(a) of this title.

(Amended Oct. 9, 1962, 76 Stat. 773; Nov. 16, 1988, 102 Stat. 3943; Oct. 27, 1992, 106 Stat. 3567; Oct. 30, 1998, 112 Stat. 3069; Aug. 5, 1999, 113 Stat. 218; Nov. 29, 1999, 113 Stat. 1501A-549.)

§ 33 (15 U.S.C. § 1115). Registration as evidence of right to exclusive use; defenses

(a) Any registration issued under the Act of March 3, 1881, or the Act of February 20, 1905, or of a mark registered on the principal register provided by this chapter and owned by a party to an action shall be admissible in evidence and shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration subject to any conditions or limitations stated therein, but shall not preclude another person from proving any legal or equitable defense or defect, including those set forth in subsection (b) of this section, which might have been asserted if such mark had not been registered.

(b) To the extent that the right to use the registered mark has become incontestable under section 1065 of this title, the registration shall be conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce. Such conclusive evidence shall relate to the exclusive right to use the mark on or in connection with the goods or services specified in the affidavit filed under the provisions of section 1065 of this title, or in the renewal application filed under the provisions of section 1059 of this title if the goods or services specified in the renewal are fewer in number, subject to any conditions or limitations in the registration or in such affidavit or renewal application. Such conclusive evidence of the right to use the registered mark shall be subject to proof of infringement as defined in section 1114 of this title, and shall be subject to the following defenses or defects:

(1) That the registration or the incontestable right to use the mark was obtained fraudulently; or

(2) That the mark has been abandoned by the registrant; or

(3) That the registered mark is being used, by or with the permission of the registrant or a person in privity with the registrant, so as to misrepresent the source of the goods or services on or in connection with which the mark is used; or

(4) That the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin; or

(5) That the mark whose use by a party is charged as an infringement was adopted without knowledge of the registrant's prior use and has been continuously used by such party or those in privity with him from a date prior to (A) the date of constructive use of the mark established pursuant to section 1057(c) of this title, (B) the registration of the mark under this Act if the application for registration is filed before the effective date of the Trademark Law Revision Act of 1988, or (C) publication of the registered mark under subsection (c) of section 1062 of this title: Provided, however, That this defense or defect shall apply only for the area in which such continuous prior use is proved; or

(6) That the mark whose use is charged as an infringement was registered and used prior to the registration under this Act or publication under subsection (c) of section 1062 of this title of the registered mark of the registrant, and not abandoned: Provided, however, That this defense or defect shall apply only for the area in which the mark was used prior to such registration or such publication of the registrant's mark; or

(7) That the mark has been or is being used to violate the antitrust laws of the United States; or

(8) That the mark is functional; or

(9) That equitable principles, including laches, estoppel, and acquiescence, are applicable.

(Amended Oct. 9, 1962, 76 Stat. 774; Nov. 16, 1988, 102 Stat. 3944; Oct. 30, 1998, 112 Stat. 3069; Nov. 2, 2002, 116 Stat. 1908.)

§ 34 (15 U.S.C. § 1116). Injunctions; enforcement; notice of filing suit given Director

(a) The several courts vested with jurisdiction of civil actions arising under this chapter shall have power to grant injunctions, according to the principles of equity and upon such terms as the court may deem reasonable, to prevent the violation of any right of the registrant of a mark registered in the Patent and Trademark Office or to prevent a violation under subsection (a), (c), or (d) of section 1125 of this title. Any such injunction may include a provision directing the defendant to file with the court and serve on the plaintiff within thirty days after the service on the defendant of such injunction, or such extended period as the court may direct, a report in writing under oath setting forth in detail the manner and form in which the defendant has complied with the injunction. Any such injunction granted upon hearing, after notice to the defendant, by any district court of the United States, may be served on the parties against whom such injunction is granted anywhere in the United States where they may be found, and shall be operative and may be enforced by proceedings to punish for contempt, or otherwise, by the court by which such injunction was granted, or by any other United States district court in whose jurisdiction the defendant may be found.

(b) The said courts shall have jurisdiction to enforce said injunction, as herein provided, as fully as if the injunction had been granted by the district court in which it is sought to be enforced. The clerk of the court or judge granting the injunction shall, when required to do so by the court before which application to enforce said injunction is made, transfer without delay to said court a certified copy of all papers on file in his office upon which said injunction was granted.

(c) It shall be the duty of the clerks of such courts within one month after the filing of any action, suit, or proceeding involving a mark registered under the provisions of this chapter to give notice thereof in writing to the Director setting forth in order so far as known the names and addresses of the litigants and the designating number or numbers of the registration or registrations upon which the action, suit, or proceeding has been brought, and in the event any other registration be subsequently included in the action, suit, or proceeding by amendment, answer, or other pleading, the clerk shall give like notice thereof to the Director, and within one month after the judgment is entered or an appeal is taken, the clerk of the court shall give notice thereof to the Director, and it shall be the duty of the Director on receipt of such notice forthwith to endorse the same upon the file wrapper of the said registration or registrations and to incorporate the same as a part of the contents of said file wrapper.

(d) (1) (A) In the case of a civil action arising under section 1114(1)(a) of this title or section 220506 of title 36, United States Code, with respect to a violation that consists of using a counterfeit mark in connection with the sale, offering for sale, or distribution of goods or services, the court may, upon ex parte application, grant an order under subsection (a) of this section pursuant to this subsection providing for the seizure of goods and counterfeit marks involved in such violation and the means of making such marks, and records documenting the manufacture, sale, or receipt of things involved in such violation.

(B) As used in this subsection the term “counterfeit mark” means—

(i) a counterfeit of a mark that is registered on the principal register in the United States Patent and Trademark Office for such goods or services sold, offered for sale, or distributed and that is in use, whether or not the person against whom relief is sought knew such mark was so registered; or

(ii) a spurious designation that is identical with, or substantially indistinguishable from, a designation as to which the remedies of this Act are made available by reason of section 220506 of title 36, United States Code;

but such term does not include any mark or designation used on or in connection with goods or services of which the manufacturer or producer was, at the time of the manufacture or production in question authorized to use the mark or designation for the type of goods or services so manufactured or produced, by the holder of the right to use such mark or designation.

(2) The court shall not receive an application under this subsection unless the applicant has given such notice of the application as is reasonable under the circumstances to the United States attorney for the judicial district in which such order is sought. Such attorney may participate in the proceedings arising under such application if such proceedings may affect evidence of an offense against the United States. The court may deny such application if the court determines that the public interest in a potential prosecution so requires.

(3) The application for an order under this subsection shall—

(A) be based on an affidavit or the verified complaint establishing facts sufficient to support the findings of fact and conclusions of law required for such order; and

(B) contain the additional information required by paragraph (5) of this subsection to be set forth in such order.

(4) The court shall not grant such an application unless—

(A) the person obtaining an order under this subsection provides the security determined adequate by the court for the payment of such damages as any person may be entitled to recover as a result of a wrongful seizure or wrongful attempted seizure under this subsection; and

(B) the court finds that it clearly appears from specific facts that—

(i) an order other than an ex parte seizure order is not adequate to achieve the purposes of section 1114 of this title;

(ii) the applicant has not publicized the requested seizure;

(iii) the applicant is likely to succeed in showing that the person against whom seizure would be ordered used a counterfeit mark in connection with the sale, offering for sale, or distribution of goods or services;

(iv) an immediate and irreparable injury will occur if such seizure is not ordered;

(v) the matter to be seized will be located at the place identified in the application;

(vi) the harm to the applicant of denying the application outweighs the harm to the legitimate interests of the person against whom seizure would be ordered of granting the application; and

(vii) the person against whom seizure would be ordered, or persons acting in concert with such person, would destroy, move, hide, or otherwise make such matter inaccessible to the court, if the applicant were to proceed on notice to such person.

(5) An order under this subsection shall set forth—

(A) the findings of fact and conclusions of law required for the order;

(B) a particular description of the matter to be seized, and a description of each place at which such matter is to be seized;

(C) the time period, which shall end not later than seven days after the date on which such order is issued, during which the seizure is to be made;

(D) the amount of security required to be provided under this subsection; and

(E) a date for the hearing required under paragraph (10) of this subsection.

(6) The court shall take appropriate action to protect the person against whom an order under this subsection is directed from publicity, by or at the behest of the plaintiff, about such order and any seizure under such order.

(7) Any materials seized under this subsection shall be taken into the custody of the court. For seizures made under this section, the court shall enter an appropriate protective order with respect to discovery and use of any records or information that has been seized. The protective order shall provide for appropriate procedures to ensure that confidential, private, proprietary, or privileged information contained in such records is not improperly disclosed or used.

(8) An order under this subsection, together with the supporting documents, shall be sealed until the person against whom the order is directed has an opportunity to contest such order, except that any person against whom such order is issued shall have access to such order and supporting documents after the seizure has been carried out.

(9) The court shall order that service of a copy of the order under this subsection shall be made by a Federal law enforcement officer (such as a United States marshal or an officer or agent of the United States Customs Service, Secret Service, Federal Bureau of Investigation, or Post Office) or may be made by a State or local law enforcement officer, who, upon making service, shall carry out the seizure under the order. The court shall issue orders, when appropriate, to protect the defendant from undue damage from the disclosure of trade secrets or other confidential information during the course of the seizure, including, when appropriate, orders restricting the access of the applicant (or any agent or employee of the applicant) to such secrets or information.

(10) (A) The court shall hold a hearing, unless waived by all the parties, on the date set by the court in the order of seizure. That date shall be not sooner than ten days after the order is issued and not later than fifteen days after the order is issued, unless the applicant for the order shows good cause for another date or unless the party against whom such order is directed consents to another date for such hearing. At such hearing the party obtaining the order shall have the burden to prove that the facts supporting findings of fact and conclusions of law necessary to support such order are still in effect. If that party fails to meet that burden, the seizure order shall be dissolved or modified appropriately.

(B) In connection with a hearing under this paragraph, the court may make such orders modifying the time limits for discovery under the Rules of Civil Procedure as may be necessary to prevent the frustration of the purposes of such hearing.

(11) A person who suffers damage by reason of wrongful seizure under this subsection has a cause of action against the applicant for the order under which such seizure was made, and shall be entitled to recover such relief as may be appropriate, including damages for lost profits, cost of materials, loss of goodwill, and punitive damages in instances where the seizure was sought in bad faith, and, unless the court finds extenuating circumstances, to recover a reasonable attorney's fee. The court in its discretion may award prejudgment interest on relief recovered under this paragraph, at an annual interest rate established under

section 6621(a)(2) of the Internal Revenue Code of 1986, commencing on the date of service of the claimant's pleading setting forth the claim under this paragraph and ending on the date such recovery is granted, or for such shorter time as the court deems appropriate.

(Amended Jan. 2, 1975, 88 Stat. 1949; Oct. 12, 1984, 98 Stat. 2179; Nov. 16, 1988, 102 Stat. 3945; July 2, 1996, 110 Stat. 1386; Aug. 5, 1999, 113 Stat. 218; Nov. 29, 1999, 113 Stat. 1501A-548; Nov. 2, 2002, 116 Stat. 1908; Oct. 13, 2008, 122 Stat. 4258)

§ 35 (15 U.S.C. § 1117). Recovery of profits, damages, and costs

(a) When a violation of any right of the registrant of a mark registered in the Patent and Trademark Office, a violation under section 1125(a) or (d) of this title or a willful violation under section 1125(c) of this title, shall have been established in any civil action arising under this Act, the plaintiff shall be entitled, subject to the provisions of sections 1111 and 1114 and subject to the principles of equity, to recover (1) defendant's profits, (2) any damages sustained by the plaintiff, and (3) the costs of the action. The court shall assess such profits and damages or cause the same to be assessed under its direction. In assessing profits the plaintiff shall be required to prove defendant's sale only; defendant must prove all elements of cost or deduction claimed. In assessing damages the court may enter judgment, according to the circumstances of the case, for any sum above the amount found as actual damages, not exceeding three times such amount. If the court shall find that the amount of the recovery based on profits is either inadequate or excessive the court may in its discretion enter judgment for such sum as the court shall find to be just, according to the circumstances of the case. Such sum in either of the above circumstances shall constitute compensation and not a penalty. The court in exceptional cases may award reasonable attorney fees to the prevailing party.

(b) In assessing damages under subsection (a) for any violation of section 32(1)(a) of this Act or section 220506 of title 36, United States Code, in a case involving use of a counterfeit mark or designation (as defined in section 34(d) of this Act), the court shall, unless the court finds extenuating circumstances, enter judgment for three times such profits or damages, whichever amount is greater, together with a reasonable attorney's fee, if the violation consists of--

(1) intentionally using a mark or designation, knowing such mark or designation is a counterfeit mark (as defined in section 34(d) of this Act), in connection with the sale, offering for sale, or distribution of goods or services; or

(2) providing goods or services necessary to the commission of a violation specified in paragraph (1), with the intent that the recipient of the goods or services would put the goods or services to use in committing the violation.

In such a case, the court may award prejudgment interest on such amount at an annual interest rate established under section 6621(a)(2) of the Internal Revenue Code of 1986, beginning on the date of the service of the claimant's pleadings setting forth the claim for such entry of judgment and ending on the date such entry is made, or for such shorter time as the court considers appropriate.

(c) In a case involving the use of a counterfeit mark (as defined in section 1116(d) of this title) in connection with the sale, offering for sale, or distribution of goods or services, the plaintiff may elect, at any time before final judgment is rendered by the trial court, to recover, instead of actual damages and profits under subsection (a) of this section, an award of statutory damages for any such use in connection with the sale, offering for sale, or distribution of goods or services in the amount of -

(1) not less than $1,000 or more than $200,000 per counterfeit mark per type of goods or services sold, offered for sale, or distributed, as the court considers just; or

(2) if the court finds that the use of the counterfeit mark was willful, not more than $2,000,000 per counterfeit mark per type of goods or services sold, offered for sale, or distributed, as the court considers just.

(d) In a case involving a violation of section 1125(d)(1) of this title, the plaintiff may elect, at any time before final judgment is rendered by the trial court, to recover, instead of actual damages and profits, an award of statutory damages in the amount of not less than $1,000 and not more than $100,000 per domain name, as the court considers just.

(e) In the case of a violation referred to in this section, it shall be a rebuttable presumption that the violation is willful for purposes of determining relief if the violator, or a person acting in concert with the violator, knowingly provided or knowingly caused to be provided materially false contact information to a domain name registrar, domain name registry, or other domain name registration authority in registering, maintaining, or renewing a domain name used in connection with the violation. Nothing in this subsection limits what may be considered a willful violation under this section.

(Amended Oct. 9, 1962, 76 Stat. 774; Jan. 2, 1975, 88 Stat. 1949; Jan. 2, 1975, 88 Stat. 1955; Oct. 12, 1984, 98 Stat. 2182; Nov. 16, 1988, 102 Stat. 3945; July 2, 1996, 110 Stat. 1386; Aug. 5, 1999, 113 Stat. 218; Nov. 29, 1999, 113 Stat. 1501A-549; Nov. 2, 2002, 116 Stat. 1906, 1908; Dec. 23, 2004, 118 Stat. 3916; Oct. 13, 2008, 122 Stat. 4259.)

§ 36 (15 U.S.C. § 1118). Destruction of infringing articles

In any action arising under this chapter, in which a violation of any right of the registrant of a mark registered in the Patent and Trademark Office, a violation under section 1125(a) of this title, or a willful violation under section 1125(c) of this title, shall have been established, the court may order that all labels, signs, prints, packages, wrappers, receptacles, and advertisements in the possession of the defendant, bearing the registered mark or, in the case of a violation of section 1125(a) of this title or a willful violation under section 1125(c) of this title, the word, term, name, symbol, device, combination thereof, designation, description, or representation that is the subject of the violation, or any reproduction, counterfeit, copy, or colorable imitation thereof, and all plates, molds, matrices, and other means of making the same, shall be delivered up and destroyed. The party seeking an order under this section for destruction of articles seized under section 1161(d) of this title shall give ten days' notice to the United States attorney for the judicial district in which such order is sought (unless good cause is shown for lesser notice) and such United States attorney may, if such destruction may affect evidence of an offense against the United States, seek a hearing on such destruction or participate in any hearing otherwise to be held with respect to such destruction.

(Amended Jan. 2, 1975, 88 Stat. 1949; Oct. 12, 1984, 98 Stat. 2182; Nov. 16, 1988, 102 Stat. 3945; Aug. 5, 1999, 113 Stat. 218.)

§ 37 (15 U.S.C. § 1119). Power of court over registration; certification of decrees and orders

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.

(Amended Jan. 2, 1975, 88 Stat. 1949; Nov. 29, 1999, 113 Stat. 1501A-583.)

§ 38 (15 U.S.C. § 1120). Fraud; civil liability

Any person who shall procure registration in the Patent and Trademark Office of a mark by a false or fraudulent declaration or representation, oral or in writing, or by any false means, shall be liable in a civil action by any person injured thereby for any damages sustained in consequence thereof.

(Amended Jan. 2, 1975, 88 Stat. 1949.)

§ 39 (15 U.S.C. § 1121). Jurisdiction of Federal courts; State, local, and other agency requirements

(a) The district and territorial courts of the United States shall have original jurisdiction, the courts of appeal of the United States (other than the United States Court of Appeals for the Federal Circuit) and the United States Court of Appeals for the District of Columbia shall have appellate jurisdiction, of all actions arising under this chapter, without regard to the amount in controversy or to diversity or lack of diversity of the citizenship of the parties.

(b) No State or other jurisdiction of the United States or any political subdivision or any agency thereof may require alteration of a registered mark, or require that additional trademarks, service marks, trade names, or corporate names that may be associated with or incorporated into the registered mark be displayed in the mark in a manner differing from the display of such additional trademarks, service marks, trade names, or corporate names contemplated by the registered mark as exhibited in the certificate of registration issued by the United States Patent and Trademark Office.

(Amended Apr. 2, 1982, 96 Stat. 46; Nov. 16, 1988, 102 Stat. 3946; Oct. 30, 1998, 112 Stat. 3069.)

§ 40 (15 U.S.C. § 1122). Liability of States, instrumentalities of States and State officials

(a) WAIVER OF SOVEREIGN IMMUNITY BY THE UNITED STATES- The United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, other persons acting for the United States and with the authorization and consent of the United States, shall not be immune from suit in Federal or State court by any person, including any governmental or nongovernmental entity, for any violation under this chapter.

(b) WAIVER OF SOVEREIGN IMMUNITY BY STATES- Any State, instrumentality of a State or any officer or employee of a State or instrumentality of a State acting in his or her official capacity, shall not be immune, under the eleventh amendment of the Constitution of the United States or under any other doctrine of sovereign immunity, from suit in Federal court by any person, including any governmental or nongovernmental entity for any violation under this chapter.

(c) In a suit described in subsection (a) or (b) for a violation described therein, remedies (including remedies both at law and in equity) are available for the violation to the same extent as such remedies are available for such a violation in a suit against any person other than the United States or any agency or instrumentality thereof, or any individual, firm, corporation, or other person acting for the United States and with authorization and consent of the United States, or a State, instrumentality of a State, or officer or employee of a State or instrumentality of a State acting in his or her official capacity. Such remedies include injunctive relief under section 1116 of this title, actual damages, profits, costs and attorney's fees under section 1117 f this title, destruction of infringing articles under section 1118 f this title, the remedies provided for under sections 1114, 1119, 1120, 1124 and 1125 of this title, and for any other remedies provided under this chapter.

(Added Oct. 27, 1992, 106 Stat. 3567; amended Aug. 5, 1999, 113 Stat. 218.)

§ 41 (15 U.S.C. § 1123). Rules and regulations

The Director shall make rules and regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office under this chapter.

(Amended Jan. 2, 1975, 88 Stat. 1949; Nov. 29, 1999, 113 Stat. 1501A-583.)

TITLE VII - IMPORTATION FORBIDDEN OF GOODS BEARING INFRINGING MARKS OR NAMES

§ 42 (15 U.S.C. § 1124). Importation of goods bearing infringing marks or names forbidden

Except as provided in subsection (d) of section 526 of the Tariff Act of 1930, no article of imported merchandise which shall copy or simulate the name of any domestic manufacture, or manufacturer, or trader, or of any manufacturer or trader located in any foreign country which, by treaty, convention, or law affords similar privileges to citizens of the United States, or which shall copy or simulate a trademark registered in accordance with the provisions of this chapter or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the United States, or that it is manufactured in any foreign country or locality other than the country or locality in which it is in fact manufactured, shall be admitted to entry at any customhouse of the United States; and, in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer or trader, and any foreign manufacturer or trader, who is entitled under the provisions of a treaty, convention, declaration, or agreement between the United States and any foreign country to the advantages afforded by law to citizens of the United States in respect to trademarks and commercial names, may require his name and residence, and the name of the locality in which his goods are manufactured, and a copy of the certificate of registration of his trademark, issued in accordance with the provisions of this chapter, to be recorded in books which shall be kept for this purpose in the Department of the Treasury, under such regulations as the Secretary of the Treasury shall prescribe, and may furnish to the Department facsimiles of his name, the name of the locality in which his goods are manufactured, or of his registered trademark, and thereupon the Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of customs.

(Amended Oct. 3, 1978, 92 Stat. 903; Oct. 30, 1998, 112 Stat. 3069.)

Note: Copies of regulations referred to in this section may be obtained from the Department of the Treasury.

TITLE VIII - FALSE DESIGNATIONS OF ORIGIN, FALSE DESCRIPTIONS. AND DILUTION FORBIDDEN

§ 43 (15 U.S.C. § 1125). False designations of origin; false description or representation

(a) (1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

> (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

(2) As used in this subsection, the term "any person" includes any State, instrumentality of a State or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

(3) In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.

(b) Any goods marked or labeled in contravention of the provisions of this section shall not be imported into the United States or admitted to entry at any customhouse of the United States. The owner, importer, or consignee of goods refused entry at any customhouse under this section may have any recourse by protest or appeal that is given under the customs revenue laws or may have the remedy given by this chapter in cases involving goods refused entry or seized.

(c) Dilution by Blurring; Dilution by Tarnishment.--

(1) Injunctive relief.--Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

(2) Definitions.--(A) For purposes of paragraph (1), a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following:

(i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.

(ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.

(iii) The extent of actual recognition of the mark.

(iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

(B) For purposes of paragraph (1), `dilution by blurring' is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark. In determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the following:

(i) The degree of similarity between the mark or trade name and the famous mark.

(ii) The degree of inherent or acquired distinctiveness of the famous mark.

(iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.

(iv) The degree of recognition of the famous mark.

(v) Whether the user of the mark or trade name intended to create an association with the famous mark.

(vi) Any actual association between the mark or trade name and the famous mark.

(C) For purposes of paragraph (1), `dilution by tarnishment' is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.

(3) Exclusions.--The following shall not be actionable as dilution by blurring or dilution by tarnishment under this subsection:

(A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person's own goods or services, including use in connection with--

(i) advertising or promotion that permits consumers to compare goods or services; or

(ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.

(B) All forms of news reporting and news commentary.

(C) Any noncommercial use of a mark.

(4) Burden of proof.--In a civil action for trade dress dilution under this Act for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that--

(A) the claimed trade dress, taken as a whole, is not functional and is famous; and

(B) if the claimed trade dress includes any mark or marks registered on the principal register, the unregistered matter, taken as a whole, is famous separate and apart from any fame of such registered marks.

(5) Additional remedies.--In an action brought under this subsection, the owner of the famous mark shall be entitled to injunctive relief as set forth in section 34. The owner of the famous mark shall also be entitled to the remedies set forth in sections 35(a) and 36, subject to the discretion of the court and the principles of equity if--

(A) the mark or trade name that is likely to cause dilution by blurring or dilution by tarnishment was first used in commerce by the person against whom the injunction is sought after the date of enactment of the Trademark Dilution Revision Act of 2006; and

(B) in a claim arising under this subsection--

(i) by reason of dilution by blurring, the person against whom the injunction is sought willfully intended to trade on the recognition of the famous mark; or

(ii) by reason of dilution by tarnishment, the person against whom the injunction is sought willfully intended to harm the reputation of the famous mark.

(6) Ownership of valid registration a complete bar to action.--The ownership by a person of a valid registration under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register under this Act shall be a complete bar to an action against that person, with respect to that mark, that--

(A)(i) is brought by another person under the common law or a statute of a State; and

(ii) seeks to prevent dilution by blurring or dilution by tarnishment; or

(B) asserts any claim of actual or likely damage or harm to the distinctiveness or reputation of a mark, label, or form of advertisement.

(7) Savings clause.--Nothing in this subsection shall be construed to impair, modify, or supersede the applicability of the patent laws of the United States."

(d)(1)(A) A person shall be liable in a civil action by the owner of a mark, including a personal name which is protected as a mark under this section, if, without regard to the goods or services of the parties, that person—

(i) has a bad faith intent to profit from that mark, including a personal name which is protected as a mark under this section; and

(ii) registers, traffics in, or uses a domain name that—

(I) in the case of a mark that is distinctive at the time of registration of the domain name, is identical or confusingly similar to that mark;

(II) in the case of a famous mark that is famous at the time of registration of the domain name, is identical or confusingly similar to or dilutive of that mark; or

(III) is a trademark, word, or name protected by reason of section 706 of title 18, United States Code, or section 220506 of title 36.

(B)(i) In determining whether a person has a bad faith intent described under subparagraph (A), a court may consider factors such as, but not limited to—

(I) the trademark or other intellectual property rights of the person, if any, in the domain name;

(II) the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;

(III) the person's prior use, if any, of the domain name in connection with the bona fide offering of any goods or services;

(IV) the person's bona fide noncommercial or fair use of the mark in a site accessible under the domain name;

(V) the person's intent to divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site;

(VI) the person's offer to transfer, sell, or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person's prior conduct indicating a pattern of such conduct;

(VII) the person's provision of material and misleading false contact information when applying for the registration of the domain name, the person's intentional failure to maintain accurate contact information, or the person's prior conduct indicating a pattern of such conduct;

(VIII) the person's registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties; and

(IX) the extent to which the mark incorporated in the person's domain name registration is or is not distinctive and famous within the meaning of subsection (c)(1) of this section.

(ii) Bad faith intent described under subparagraph (A) shall not be found in any case in which the court determines that the person believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful.

(C) In any civil action involving the registration, trafficking, or use of a domain name under this paragraph, a court may order the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark.

(D) A person shall be liable for using a domain name under subparagraph (A) only if that person is the domain name registrant or that registrant's authorized licensee.

(E) As used in this paragraph, the term "traffics in" refers to transactions that include, but are not limited to, sales, purchases, loans, pledges, licenses, exchanges of currency, and any other transfer for consideration or receipt in exchange for consideration.

(2)(A) The owner of a mark may file an in rem civil action against a domain name in the judicial district in which the domain name registrar, domain name registry, or other domain name authority that registered or assigned the domain name is located if—

(i) the domain name violates any right of the owner of a mark registered in the Patent and Trademark Office, or protected under subsection (a) or (c) of this section; and

(ii) the court finds that the owner—

(I) is not able to obtain in personam jurisdiction over a person who would have been a defendant in a civil action under paragraph (1); or

(II) through due diligence was not able to find a person who would have been a defendant in a civil action under paragraph (1) by—

(aa) sending a notice of the alleged violation and intent to proceed under this paragraph to the registrant of the domain name at the postal and e-mail address provided by the registrant to the registrar; and

(bb) publishing notice of the action as the court may direct promptly after filing the action.

(B) The actions under subparagraph (A)(ii) shall constitute service of process.

(C) In an in rem action under this paragraph, a domain name shall be deemed to have its situs in the judicial district in which—

(i) the domain name registrar, registry, or other domain name authority that registered or assigned the domain name is located; or

(ii) documents sufficient to establish control and authority regarding the disposition of the registration and use of the domain name are deposited with the court.

(D)(i) The remedies in an in rem action under this paragraph shall be limited to a court order for the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark. Upon receipt of written notification of a filed, stamped copy of a complaint filed by the owner of a mark in a United States district court under this paragraph, the domain name registrar, domain name registry, or other domain name authority shall—

(I) expeditiously deposit with the court documents sufficient to establish the court's control and authority regarding the disposition of the registration and use of the domain name to the court; and

(II) not transfer, suspend, or otherwise modify the domain name during the pendency of the action, except upon order of the court.

(ii) The domain name registrar or registry or other domain name authority shall not be liable for injunctive or monetary relief under this paragraph except in the case of bad faith or reckless disregard, which includes a willful failure to comply with any such court order.

(3) The civil action established under paragraph (1) and the in rem action established under paragraph (2), and any remedy available under either such action, shall be in addition to any other civil action or remedy otherwise applicable.

(4) The in rem jurisdiction established under paragraph (2) shall be in addition to any other jurisdiction that otherwise exists, whether in rem or in personam.

(Amended Nov. 16, 1988, 102 Stat. 3946; Oct. 27, 1992, 106 Stat. 3567; Jan. 16, 1996, 109 Stat. 985; Aug. 5, 1999, 113 Stat. 218; Nov. 29, 1999, 113 Stat. 1501A-545; Oct. 6, 2006, 120 Stat. 1730.)

TITLE IX - INTERNATIONAL CONVENTIONS

§ 44 (15 U.S.C. § 1126). International conventions; register of marks

(a) The Director shall keep a register of all marks communicated to him by the international bureaus provided for by the conventions for the protection of industrial property, trademarks, trade and commercial names, and the repression of unfair competition to which the United States is or may become a party, and upon the payment of the fees required by such conventions and the fees required in this Act may place the marks so communicated upon such register. This register shall show a facsimile of the mark or trade or commercial name; the name, citizenship, and address of the registrant; the number, date, and place of the first registration of the mark, including the dates on which application for such registration was filed and granted and the term of such registration; a list of goods or services to which the mark is applied as shown by the registration in the country of origin, and such other data as may be useful concerning the mark. This register shall be a continuation of the register provided in section 1(a) of the Act of March 19, 1920.

Note: The United States is not at present a party to the parts of the international conventions providing for international bureaus for the registration or communication of trademarks.

(b) Any person whose country of origin is a party to any convention or treaty relating to trademarks, trade or commercial names, or the repression of unfair competition, to which the United States is also a party, or extends reciprocal rights to nationals of the United States by law, shall be entitled to the benefits of this section under the conditions expressed herein to the extent necessary to give effect to any provision of such convention, treaty or reciprocal law, in addition to the rights to which any owner of a mark is otherwise entitled by this chapter.

Notes: International Convention for the Protection of Industrial Property of 1883 (Paris); revised at Washington in 1911, 204 O.G. 1011, July 21, 1914 (37 Stat. 1645; Treaty Series 579); at the Hague in 1925, 407 O.G. 298, June 9, 1931 (47 Stat. 1789; Treaty Series 834; 2 Bevans 524); at London in 1934, 613 O.G. 23, August 3, 1948 (53 Stat. 1748; Treaty Series 941; 3 Bevans 223); at Lisbon in 1958, 775 O.G. 321, February 13, 1962 (53 Stat. 1748; 13 U.S.T. 1; TIAS 9431); and at Stockholm July 14, 1967, 852 O.G. 511, July 16, 1968 (21 U.S.T. 1583; TIAS 6923). A list of the member countries together with an indication of the latest Act by which each country is bound and the date from which each is considered to be bound appears annually (January issue) in "Industrial Property," a monthly review of the World Intellectual Property Organization (WIPO), Geneva, Switzerland.
General Inter-American Convention for Trade-Mark and Commercial Protection (Pan-American Trade-Mark Convention) of 1929, 46 Stat. 2907; Pan-American Trade-Mark Convention of 1923, 44 Stat. 2494; Pan-American Trade-Mark Convention of 1910, 39 Stat. 1675.

List of the States which are parties to the above conventions may be found in "Treaties in Force," a list of treaties and other international agreements in force on the first day of January of each year, compiled annually by the Office of the Legal Adviser, U.S. Department of State.

(c) No registration of a mark in the United States by a person described in subsection (b) of this section shall be granted until such mark has been registered in the country of origin of the applicant, unless the applicant alleges use in commerce. For the purposes of this section, the country of origin of the applicant is the country in which he has a bona fide and effective industrial or commercial establishment, or if he has not such an establishment the country in which he is domiciled, or if he has not a domicile in any of the countries described in subsection (b) of this section, the country of which he is a national.

(d) An application for registration of a mark under sections 1051, 1053, 1054, or 1091 of this title or under subsection (e) of this section filed by a person described in subsection (b) of this section who has previously duly filed an application for registration of the same mark in one of the countries described in subsection (b) of this section shall be accorded the same force and effect as would be accorded to the same application if filed in the United States on the same date on which the application was first filed in such foreign country: *Provided*, That—

(1) the application in the United States is filed within 6 months from the date on which the application was first filed in the foreign country;

(2) the application conforms as nearly as practicable to the requirements of this chapter, including a statement that the applicant has a bona fide intention to use the mark in commerce;

(3) the rights acquired by third parties before the date of the filing of the first application in the foreign country shall in no way be affected by a registration obtained on an application filed under this subsection;

(4) nothing in this subsection shall entitle the owner of a registration granted under this section to sue for acts committed prior to the date on which his mark was registered in this country unless the registration is based on use in commerce.

In like manner and subject to the same conditions and requirements, the right provided in this section may be based upon a subsequent regularly filed application in the same foreign country, instead of the first filed foreign application: *Provided*, That any foreign application filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served, nor thereafter shall serve, as a basis for claiming a right of priority.

Note: Section 3 of Public Law 333, 87th Cong., approved October 3, 1961, 75 Stat. 748, the provision which added the last paragraph above provided that "This Act shall take effect on the date when the Convention of Paris for the Protection of Industrial Property of March 20, 1883, as revised at Lisbon October 31, 1958, comes into force with respect to the United States and is applied only to applications thereafter filed in the United States by persons entitled to the benefit of said convention, as revised at the time of such filing." This provision became effective Jan. 4, 1962.

(e) A mark duly registered in the country of origin of the foreign applicant may be registered on the principal register if eligible, otherwise on the supplemental register herein provided. Such applicant shall submit, within such time period as may be prescribed by the Director, a true copy, a photocopy, a certification, or a certified copy of the registration in the country of origin of the applicant. The application must state the applicant's bona fide intention to use the mark in commerce, but use in commerce shall not be required prior to registration.

(f) The registration of a mark under the provisions of subsections (c), (d), and (e) of this section by a person described in subsection (b) of this section shall be independent of the registration in the country of origin and the duration, validity, or transfer in the United States of such registration shall be governed by the provisions of this chapter.

(g) Trade names or commercial names of persons described in subsection (b) of this section shall be protected without the obligation of filing or registration whether or not they form parts of marks.

(h) Any person designated in subsection (b) of this section as entitled to the benefits and subject to the provisions of this chapter shall be entitled to effective protection against unfair competition, and the remedies provided herein for infringement of marks shall be available so far as they may be appropriate in repressing acts of unfair competition.

(i) Citizens or residents of the United States shall have the same benefits as are granted by this section to persons described in subsection (b) of this section.

(Amended Oct. 3, 1961, 75 Stat. 748; Oct. 9, 1962, 76 Stat. 774; Nov. 16, 1988, 102 Stat. 3946; Oct. 30, 1998, 112 Stat. 3068; Nov. 29, 1999, 113 Stat. 1501A-583; Nov. 2, 2002, 116 Stat. 1908.)

TITLE X - CONSTRUCTION AND DEFINITIONS

§ 45 (15 U.S.C. § 1127).

In the construction of this chapter, unless the contrary is plainly apparent from the context—

United States. The United States includes and embraces all territory which is under its jurisdiction and control.

Commerce. The word "commerce" means all commerce which may lawfully be regulated by Congress.

Principal Register, Supplemental Register. The term "principal register" refers to the register provided for by sections 1051 to 1072 of this title, and the term "supplemental register" refers to the register provided for by sections 1091 to 1096 of this title.

Person, juristic person. The term "person" and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this Act includes a juristic person as well as a natural person. The term "juristic person" includes a firm, corporation, union, association, or other organization capable of suing and being sued in a court of law.

The term "person" also includes the United States, any agency or instrumentality thereof, or any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States. The United States, any agency or instrumentality thereof, and any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

The term "person" also includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any non-governmental entity.

Applicant, registrant. The terms "applicant" and "registrant" embrace the legal representatives, predecessors, successors and assigns of such applicant or registrant.

Director. The term "Director" means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

Related company. The term "related company" means any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used.

Trade name, commercial name. The terms "trade name" and "commercial name" mean any name used by a person to identify his or her business or vocation.

Trademark. The term "trademark" includes any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

Service mark. The term "service mark" means any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names, and other distinctive features of radio or television programs may be

registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.

Certification mark. The term "certification mark" means any word, name, symbol, or device, or any combination thereof—

(1) used by a person other than its owner, or

(2) which its owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register on the principal register established by this chapter,

to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.

Collective mark. The term "collective mark" means a trademark or service mark—

(1) used by the members of a cooperative, an association, or other collective group or organization, or

(2) which such cooperative, association, or other collective group or organization has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

and includes marks indicating membership in a union, an association, or other organization.

Mark. The term "mark" includes any trademark, service mark, collective mark, or certification mark.

Use in commerce. The term "use in commerce" means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this chapter, a mark shall be deemed to be in use in commerce—

(1) on goods when—

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and

(B) the goods are sold or transported in commerce, and

(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

Abandonment of mark. A mark shall be deemed to be "abandoned" if either of the following occurs:

(1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. "Use" of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

(2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark. Purchaser motivation shall not be a test for determining abandonment under this paragraph.

Colorable imitation. The term "colorable imitation" includes any mark which so resembles a registered mark as to be likely to cause confusion or mistake or to deceive.

Registered mark. The term "registered mark" means a mark registered in the United States Patent and Trademark Office under this chapter or under the Act of March 3, 1881, or the Act of February 20, 1905, or the Act of March 19, 1920. The phrase "marks registered in the Patent and Trademark Office" means registered marks.

Prior acts. The term "Act of March 3, 1881," "Act of February 20, 1905," or "Act of March 19, 1920," means the respective Act as amended.

Counterfeit. A "counterfeit" is a spurious mark which is identical with, or substantially indistinguishable from, a registered mark.

Domain name. The term "domain name" means any alphanumeric designation which is registered with or assigned by any domain name registrar, domain name registry, or other domain name registration authority as part of an electronic address on the Internet.

Internet. The term "Internet" has the meaning given that term in section 230(f)(1) of the Communications Act of 1934 (47 U.S.C. 230(f)(1)).

Singular and plural. Words used in the singular include the plural and vice versa.

Intent of Chapter. The intent of this chapter is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce; to protect registered marks used in such commerce from interference by State, or territorial legislation; to protect persons engaged in such commerce against unfair competition; to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks; and to provide rights and remedies stipulated by treaties and conventions respecting trademarks, trade names, and unfair competition entered into between the United States and foreign nations.

(Amended Oct. 9, 1962, 76 Stat. 774; Jan. 2, 1975, 88 Stat. 1949; Nov. 8, 1984, 98 Stat. 3335, Nov. 16, 1988, 102 Stat. 3946; Oct. 27, 1992, 106 Stat. 3568; Dec. 8, 1994, 108 Stat. 4981; Jan. 16, 1996, 109 Stat. 986; Aug. 5, 1999, 113 Stat. 219-220; Nov. 29, 1999, 113 Stat. 1501A-550, 1501A-583; Oct. 6, 2006, 120 Stat. 1730.)

TITLE XI - REPEAL OF PREVIOUS ACTS

§ 46(a) (15 U.S.C. § 1051 note). Time of taking effect - Repeal of prior acts

This Act shall be in force and take effect one year from its enactment, but except as otherwise herein specifically provided shall not affect any suit, proceeding, or appeal then pending. All Acts and parts of Acts inconsistent herewith are hereby repealed effective one year from the enactment hereof, including the following Acts insofar as they are inconsistent herewith: The Act of Congress approved March 3, 1881, entitled "An Act to authorize the registration of trademarks and protect the same"; the Act approved August 5, 1882, entitled "An Act relating to the registration of trademarks"; the Act of February 20, 1905 (U.S.C., title 15, secs. 81 to 109, inclusive), entitled "An Act to authorize the registration of trademarks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same", and the amendments thereto by the Acts of May 4, 1906 (U.S.C., title 15, secs. 131 and 132; 34 Stat. 169), March 2, 1907 (34 Stat. 1251, 1252), February 18, 1909 (35 Stat. 627, 628), February 18, 1911 (36 Stat. 918), January 8, 1913 (37 Stat. 649), June 7, 1924 (43 Stat. 647), March 4, 1925 (43 Stat. 1268, 1269), April 11, 1930 (46 Stat. 155), June 10, 1938 (Public, Numbered 586, Seventy-fifth Congress, ch. 332, third session); the Act of March 19, 1920 (U.S.C., title 15, secs. 121 to 128, inclusive),

entitled "an Act to give effect to certain provisions of the convention for the protection of trademarks and commercial names made and signed in the city of Buenos Aires, in the Argentine Republic, August 20, 1910, and for other purposes", and the amendments thereto, including the Act of June 10, 1938 (Public, Numbered 586, Seventy-fifth Congress, ch. 332, third session): *Provided*, That this repeal shall not affect the validity of registrations granted or applied for under any of said Acts prior to the effective date of this Act, or rights or remedies thereunder except as provided in sections 8, 12, 14, 15, and 47 of this Act; but nothing contained in this Act shall be construed as limiting, restricting, modifying, or repealing any statute in force on the effective date of this Act which does not relate to trademarks, or as restricting or increasing the authority of any Federal departments or regulatory agency except as may be specifically provided in this Act.

§ 46(b) (15 U.S.C. § 1051 note). Existing registrations under prior acts

Acts of 1881 and 1905. Registrations now existing under the Act of March 3, 1881, or the Act of February 20, 1905, shall continue in full force and effect for the unexpired terms thereof and may be renewed under the provisions of section 9 of this Act. Such registrations and the renewals thereof shall be subject to and shall be entitled to the benefits of the provisions of this Act to the same extent and with the same force and effect as though registered on the principal register established by this Act except as limited in sections 8, 12, 14, and 15 of this Act. Marks registered under the "10-year proviso" of section 5 of the Act of February 20, 1905, as amended, shall be deemed to have become distinctive of the registrant's goods in commerce under paragraph (f) of section 2 of this Act and may be renewed under section 9 hereof as marks coming within said paragraph.

Act of 1920. Registrations now existing under the Act of March 19, 1920, shall expire 6 months after the effective date of this Act, or twenty years from the dates of their registrations, whichever date is later. Such registrations shall be subject to and entitled to the benefits of the provisions of this Act relating to marks registered on the supplemental register established by this Act, and may not be renewed unless renewal is required to support foreign registrations. In that event renewal may be effected on the supplemental register under the provisions of section 9 of this Act.

Subject to registration under this Act. Marks registered under previous Acts may, if eligible, also be registered under this Act.

§ 47(a) (15 U.S.C. § 1051 note). Applications pending on effective date of Act

All applications for registration pending in the Patent and Trademark Office at the effective date of this Act may be amended, if practicable, to bring them under the provisions of this Act. The prosecution of such applications so amended and the grant of registrations thereon shall be proceeded with in accordance with the provisions of this Act. If such amendments are not made, the prosecution of said applications shall be proceeded with and registrations thereon granted in accordance with the Acts under which said applications were filed, and said Acts are hereby continued in force to this extent for this purpose only, notwithstanding the foregoing general repeal thereof.

§ 47(b) (15 U.S.C. § 1051 note). Appeals pending on effective date of Act

In any case in which an appeal is pending before the United States Court of Customs and Patent Appeals or any United States Circuit Court of Appeals or the United States Court of Appeals for the District of Columbia or the United States Supreme Court at the effective date of this Act, the court, if it be of the opinion that the provisions of this Act are applicable to the subject matter of the appeal, may apply such provision or may remand the case to the Director or to the district court

for the taking of additional evidence or a new trial or for reconsideration of the decision on the record as made, as the appellate court may deem proper.

(Amended Nov. 29, 1999, 113 Stat. 1501A-583)

§ 48 (15 U.S.C. § 1051 note). Prior acts not repealed

Section 4 of the Act of January 5, 1905 (U.S.C., title 36, section 4), as amended, entitled "An Act to incorporate the National Red Cross," and section 7 of the Act of June 15, 1916 (U.S.C., title 36, section 27), entitled "An Act to incorporate the Boy Scouts of America, and for other purposes," and the Act of June 20, 1936 (U.S.C., title 22, section 248), entitled "An Act to prohibit the commercial use of the coat of arms of the Swiss Confederation," are not repealed or affected by this Act.

Note: The first and third of the laws referred to in this section have been repealed and replaced by §§ 706 and 708, respectively, of U.S.C., Title 18, Crimes and Criminal Procedure, enacted June 25, 1948, effective September 1, 1948.

§ 49 (15 U.S.C. § 1051 note). Preservation of existing rights

Nothing herein shall adversely affect the rights or the enforcement of rights in marks acquired in good faith prior to the effective date of this Act.

§ 50 (15 U.S.C. § 1051 note). Severability

If any provision of this Act or the application of such provision to any person or circumstance is held invalid, the remainder of the Act shall not be affected thereby.

§ 51 (15 U.S.C. § 1058 note). Applications pending on effective date of the Trademark Law Revision Act of 1988

All certificates of registration based upon applications for registration pending in the Patent and Trademark Office on the effective date of the Trademark Law Revision Act of 1988 shall remain in force for a period of 10 years.

TITLE XII—THE MADRID PROTOCOL

Sec. 60 (15 U.S.C. § 1141). Definitions

In this subchapter:

(1) *Basic application*.—The term 'basic application' means the application for the registration of a mark that has been filed with an Office of a Contracting Party and that constitutes the basis for an application for the international registration of that mark.

(2) *Basic registration*.—The term 'basic registration' means the registration of a mark that has been granted by an Office of a Contracting Party and that constitutes the basis for an application for the international registration of that mark.

(3) *Contracting party*.—The term 'Contracting Party' means any country or inter-governmental organization that is a party to the Madrid Protocol.

(4) *Date of recordal*.—The term 'date of recordal' means the date on which a request for extension of protection, filed after an international registration is granted, is recorded on the International Register.

(5) *Declaration of bona fide intention to use the mark in commerce*.—The term 'declaration of bona fide intention to use the mark in commerce' means a declaration that is signed by the applicant for, or holder of, an international registration who is seeking extension of protection of a mark to the United States and that contains a statement that—

(A) the applicant or holder has a bona fide intention to use the mark in commerce;

(B) the person making the declaration believes himself or herself, or the firm, corporation, or association in whose behalf he or she makes the declaration, to be entitled to use the mark in commerce; and

(C) no other person, firm, corporation, or association, to the best of his or her knowledge and belief, has the right to use such mark in commerce either in the identical form of the mark or in such near resemblance to the mark as to be likely, when used on or in connection with the goods of such other person, firm, corporation, or association, to cause confusion, mistake, or deception.

(6) *Extension of protection*.—The term 'extension of protection' means the protection resulting from an international registration that extends to the United States at the request of the holder of the international registration, in accordance with the Madrid Protocol.

(7) *Holder of an international registration*.—A 'holder' of an international registration is the natural or juristic person in whose name the international registration is recorded on the International Register.

(8) *International application*.—The term 'international application' means an application for international registration that is filed under the Madrid Protocol.

(9) *International bureau*.—The term 'International Bureau' means the International Bureau of the World Intellectual Property Organization.

(10) *International register*.—The term 'International Register' means the official collection of data concerning international registrations maintained by the International Bureau that the Madrid Protocol or its implementing regulations require or permit to be recorded.

(11) *International registration*.—The term 'international registration' means the registration of a mark granted under the Madrid Protocol.

(12) *International registration date*.—The term 'international registration date' means the date assigned to the international registration by the International Bureau.

(13) *Madrid protocol*.—The term 'Madrid Protocol' means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid, Spain, on June 27, 1989.

(14) *Notification of refusal*.—The term 'notification of refusal' means the notice sent by the United States Patent and Trademark Office to the International Bureau declaring that an extension of protection cannot be granted.

(15) *Office of a contracting party*.—The term 'Office of a Contracting Party' means—

(A) the office, or governmental entity, of a Contracting Party that is responsible for the registration of marks; or

(B) the common office, or governmental entity, of more than 1 Contracting Party that is responsible for the registration of marks and is so recognized by the International Bureau.

(16) *Office of origin*.—The term 'office of origin' means the Office of a Contracting Party with which a basic application was filed or by which a basic registration was granted.

(17) *Opposition period*.—The term 'opposition period' means the time allowed for filing an opposition in the United States Patent and Trademark Office, including any extension of time granted under section 13.

[Added Nov. 2, 2003, 116 Stat. 1758, 1913]

Sec. 61 (15 U.S.C. § 1141a). International applications based on United States applications or registrations

(a) *In General*.—The owner of a basic application pending before the United States Patent and Trademark Office, or the owner of a basic registration granted by the United States Patent and Trademark Office may file an international application by submitting to the United States Patent and Trademark Office a written application in such form, together with such fees, as may be prescribed by the Director.

(b) *Qualified Owners*.—A qualified owner, under subsection (a) of this section, shall—

(1) be a national of the United States;

(2) be domiciled in the United States; or

(3) have a real and effective industrial or commercial establishment in the United States.

[Added Nov. 2, 2003, 116 Stat. 1758, 1915]

Sec. 62 (15 U.S.C. § 1141b). Certification of the international application

(a) *Certification Procedure*.—Upon the filing of an application for international registration and payment of the prescribed fees, the Director shall examine the international application for the purpose of certifying that the information contained in the international application corresponds to the information contained in the basic application or basic registration at the time of the certification.

(b) *Transmittal*.—Upon examination and certification of the international application, the Director shall transmit the international application to the International Bureau.

[Added Nov. 2, 2003, 116 Stat. 1758, 1915]

Sec. 63 (15 U.S.C. § 1141c). Restriction, abandonment, cancellation, or expiration of a basic application or basic registration

With respect to an international application transmitted to the International Bureau under section 1141b of this title, the Director shall notify the International Bureau whenever the basic application or basic registration which is the basis for the international application has been restricted, abandoned, or canceled, or has expired, with respect to some or all of the goods and services listed in the international registration—

(1) within 5 years after the international registration date; or

(2) more than 5 years after the international registration date if the restriction, abandonment, or cancellation of the basic application or basic registration resulted from an action that began before the end of that 5-year period.

[Added Nov. 2, 2003, 116 Stat. 1758, 1915]

Sec. 64 (15 U.S.C. § 1141d). Request for extension of protection subsequent to International registration

The holder of an international registration that is based upon a basic application filed with the United States Patent and Trademark Office or a basic registration granted by the Patent and Trademark Office may request an extension of protection of its international registration by filing such a request—

(1) directly with the International Bureau; or

(2) with the United States Patent and Trademark Office for transmittal to the International Bureau, if the request is in such form, and contains such transmittal fee, as may be prescribed by the Director.

[Added Nov. 2, 2003, 116 Stat. 1758, 1916]

Sec. 65 (15 U.S.C. § 1141e). Extension of protection of an international registration to the United States under the Madrid Protocol

(a) *In General*.—Subject to the provisions of section 68, the holder of an international registration shall be entitled to the benefits of extension of protection of that international registration to the United States to the extent necessary to give effect to any provision of the Madrid Protocol.

(b) *If the United States Is Office of Origin*.—Where the United States Patent and Trademark Office is the office of origin for a trademark application or registration, any international registration based on such application or registration cannot be used to obtain the benefits of the Madrid Protocol in the United States.

[Added Nov. 2, 2003, 116 Stat. 1758, 1916]

Sec. 66 (15 U.S.C. § 1141f). Effect of filing a request for extension of protection of an international registration to the United States

(a) *Requirement for Request for Extension of Protection*.—A request for extension of protection of an international registration to the United States that the International Bureau transmits to the United States Patent and Trademark Office shall be deemed to be properly filed in the United States if such request, when received by the International Bureau, has attached to it a declaration of bona fide intention to use the mark in commerce that is verified by the applicant for, or holder of, the international registration.

(b) *Effect of Proper Filing*.—Unless extension of protection is refused under section 68, the proper filing of the request for extension of protection under subsection (a) shall constitute constructive use of the mark, conferring the same rights as those specified in section 7(c), as of the earliest of the following:

(1) The international registration date, if the request for extension of protection was filed in the international application.

(2) The date of recordal of the request for extension of protection, if the request for extension of protection was made after the international registration date.

(3) The date of priority claimed pursuant to section 1141g of this title.

[Added Nov. 2, 2003, 116 Stat. 1758, 1916]

Sec. 67 (15 U.S.C. § 1141g). Right of priority for request for extension of protection to the United States.

The holder of an international registration with a request for an extension of protection to the United States shall be entitled to claim a date of priority based on a right of priority within the meaning of Article 4 of the Paris Convention for the Protection of Industrial Property if—

(1) the request for extension of protection contains a claim of priority; and

(2) the date of international registration or the date of the recordal of the request for extension of protection to the United States is not later than 6 months after the date of the first regular national filing (within the meaning of Article 4(A)(3) of the Paris Convention for the Protection of Industrial Property) or a subsequent application (within the meaning of Article 4(C)(4) of the Paris Convention for the Protection of Industrial Property).

[Added Nov. 2, 2003, 116 Stat. 1758, 1917]

Sec. 68 (15 U.S.C. § 1141h). Examination of and opposition to request for extension of protection; notification of refusal

(a) *Examination and Opposition*.—

(1) A request for extension of protection described in section 1141f(a) of this title shall be examined as an application for registration on the Principal Register under this Act, and if on such examination it appears that the applicant is entitled to extension of protection under this title, the Director shall cause the mark to be published in the Official Gazette of the United States Patent and Trademark Office.

(2) Subject to the provisions of subsection (c) of this section, a request for extension of protection under this title shall be subject to opposition under section 1063 of this title.

(3) Extension of protection shall not be refused on the ground that the mark has not been used in commerce.

(4) Extension of protection shall be refused to any mark not registrable on the Principal Register.

(b) *Notification of Refusal.*—If, a request for extension of protection is refused under subsection (a) of this section, the Director shall declare in a notification of refusal (as provided in subsection (c) of this section) that the extension of protection cannot be granted, together with a statement of all grounds on which the refusal was based.

(c) *Notice to International Bureau*.—

(1) Within 18 months after the date on which the International Bureau transmits to the Patent and Trademark Office a notification of a request for extension of protection, the Director shall transmit to the International Bureau any of the following that applies to such request:

(A) A notification of refusal based on an examination of the request for extension of protection.

(B) A notification of refusal based on the filing of an opposition to the request.

(C) A notification of the possibility that an opposition to the request may be filed after the end of that 18-month period.

(2) If the Director has sent a notification of the possibility of opposition under paragraph (1)(C), the Director shall, if applicable, transmit to the International Bureau a notification of refusal on the basis of the opposition, together with a statement of all the grounds for the opposition, within 7 months after the beginning of the opposition period or within 1 month after the end of the opposition period, whichever is earlier.

(3) If a notification of refusal of a request for extension of protection is transmitted under paragraph (1) or (2), no grounds for refusal of such request other than those set forth in such notification may be transmitted to the International Bureau by the Director after the expiration of the time periods set forth in paragraph (1) or (2), as the case may be.

(4) If a notification specified in paragraph (1) or (2) is not sent to the International Bureau within the time period set forth in such paragraph, with respect to a request for extension of protection, the request for extension of protection shall not be refused and the Director shall issue a certificate of extension of protection pursuant to the request.

(d) *Designation of Agent for Service of Process*.—In responding to a notification of refusal with respect to a mark, the holder of the international registration of the mark may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person residing in the United States on whom notices or process in proceedings affecting the mark may be served. Such notices or process may be served upon the person designated by leaving with that person, or mailing to that person, a copy thereof at the address specified in the last designation filed. If the person designated cannot be found at the address given in the last designation, or if the holder does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person residing in the United States for service of notices or process in proceedings affecting the mark, the notice or process may be served on the Director.

[Added Nov. 2, 2003, 116 Stat. 1758, 1917]

Sec. 69 (15 U.S.C. § 1141i). Effect of extension of protection.

(a) *Issuance of Extension of Protection*.—Unless a request for extension of protection is refused under section 1141h of this title, the Director shall issue a certificate of extension of protection pursuant to the request and shall cause notice of such certificate of extension of protection to be published in the Official Gazette of the United States Patent and Trademark Office.

(b) *Effect of Extension of Protection*.—From the date on which a certificate of extension of protection is issued under subsection (a) of this section—

(1) such extension of protection shall have the same effect and validity as a registration on the Principal Register; and

(2) the holder of the international registration shall have the same rights and remedies as the owner of a registration on the Principal Register.

[Added Nov. 2, 2003, 116 Stat. 1758, 1918]

Sec. 70 (15 U.S.C. § 1141j). Dependence of extension of protection to the United States on the underlying international registration

(a) *Effect of Cancellation of International Registration*.—If the International Bureau notifies the United States Patent and Trademark Office of the cancellation of an international registration with respect to some or all of the goods and services listed in the international registration, the Director shall cancel any extension of protection to the United States with respect to such goods and services as of the date on which the international registration was canceled.

(b) *Effect of Failure To Renew International Registration*.—If the International Bureau does not renew an international registration, the corresponding extension of protection to the United States shall cease to be valid as of the date of the expiration of the international registration.

(c) *Transformation of an Extension of Protection Into a United States Application*.—The holder of an international registration canceled in whole or in part by the International Bureau at the request of the office of origin, under article 6(4) of the Madrid Protocol, may file an application, under section 1051 or 1126 of this title, for the registration of the same mark for any of the goods and services to which the cancellation applies that were covered by an extension of protection to the United States based on that international registration. Such an application shall be treated as if it had been filed on the international registration date or the date of recordal of the request for extension of protection with the International Bureau, whichever date applies, and, if the extension of protection enjoyed priority under section 1141g of this title, shall enjoy the same priority. Such an application shall be entitled to the benefits conferred by this subsection only if the application is filed not later than 3 months after the date on which the international registration was canceled, in whole or in part, and only if the application complies with all the requirements of this Act which apply to any application filed pursuant to section 1051 or 1126 of this title.

[Added Nov. 2, 2003, 116 Stat. 1758, 1918]

Sec. 71 (15 U.S.C. § 1141k). Duration, affidavits and fees

(a) *Time Periods for Required Affidavits.* Each extension of protection for which a certificate has been issued under section 69 shall remain in force for the term of the international registration upon which it is based, except that the extension of protection of any mark shall be canceled by the Director unless the holder of the international registration files in the United States Patent and Trademark Office affidavits that meet the requirements of subsection (b), within the following time periods:

(1) Within the 1-year period immediately preceding the expiration of 6 years following the date of issuance of the certificate of extension of protection.

(2) Within the 1-year period immediately preceding the expiration of 10 years following the date of issuance of the certificate of extension of protection, and each successive 10-year period following the date of issuance of the certificate of extension of protection.

(3) The holder may file the affidavit required under this section within a grace period of 6 months after the end of the applicable time period established in paragraph (1) or (2), together

with the fee described in subsection (b) and the additional grace period surcharge prescribed by the Director.

(b) *Requirements for Affidavit.* The affidavit referred to in subsection (a) shall—

(1)(A) state that the mark is in use in commerce;

(B) set forth the goods and services recited in the extension of protection on or in connection with which the mark is in use in commerce;

(C) be accompanied by such number of specimens or facsimiles showing current use of the mark in commerce as may be required by the Director; and

(D) be accompanied by the fee prescribed by the Director; or

(2)(A) set forth the goods and services recited in the extension of protection on or in connection with which the mark is not in use in commerce;

(B) include a showing that any nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark; and

(C) be accompanied by the fee prescribed by the Director.

(c) *Deficient Affidavit.* If any submission filed within the period set forth in subsection (a) is deficient, including that the affidavit was not filed in the name of the holder of the international registration, the deficiency may be corrected after the statutory time period, within the time prescribed after notification of the deficiency. Such submission shall be accompanied by the additional deficiency surcharge prescribed by the Director.

(d) *Notice of Requirement.* Special notice of the requirement for such affidavit shall be attached to each certificate of extension of protection.

(e) *Notification of Acceptance or Refusal.* The Director shall notify the holder of the international registration who files any affidavit required by this section of the Director's acceptance or refusal thereof and, in the case of a refusal, the reasons therefor.

(f) *Designation of Resident for Service of Process and Notices.* If the holder of the international registration of the mark is not domiciled in the United States, the holder 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 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 last designated address, or if the holder 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.

(Amended Mar. 17, 2010, 124 Stat. 66.)

Sec. 72 (15 U.S.C. § 1141*l*). Assignment of an extension of protection

An extension of protection may be assigned, together with the goodwill associated with the mark, only to a person who is a national of, is domiciled in, or has a bona fide and effective industrial or

commercial establishment either in a country that is a Contracting Party or in a country that is a member of an intergovernmental organization that is a Contracting Party.

[Added Nov. 2, 2003, 116 Stat. 1758, 1920]

Sec. 73 (15 U.S.C. § 1141m). Incontestability

The period of continuous use prescribed under section 1065 of this title for a mark covered by an extension of protection issued under this title may begin no earlier than the date on which the Director issues the certificate of the extension of protection under section 1141i of this title, except as provided in section 1141n of this title.

[Added Nov. 2, 2003, 116 Stat. 1758, 1920]

Sec. 74 (15 U.S.C. § 1141n). Rights of extension of protection

When a United States registration and a subsequently issued certificate of extension of protection to the United States are owned by the same person, identify the same mark, and list the same goods or services, the extension of protection shall have the same rights that accrued to the registration prior to issuance of the certificate of extension of protection.

[Added Nov. 2, 2003, 116 Stat. 1758, 1920]

Sec. 13403 (15 U.S.C. § 1141 note). Effective date

This subtitle and the amendments made by this subtitle shall take effect on the later of—

(1) the date on which the Madrid Protocol (as defined in section 60 of the Trademark Act of 1946) enters into force with respect to the United States; or

(2) the date occurring 1 year after the date of enactment of this Act.

[Added Nov. 2, 2003, 116 Stat. 1758, 1920]

UNITED STATES CODE, TITLE 35, PATENTS

PART 1-UNITED STATES PATENT AND TRADEMARK OFFICE

CHAPTER 1-ESTABLISHMENT, OFFICERS AND EMPLOYEES, FUNCTIONS

35 U.S.C. § 1. Establishment.

(a) ESTABLISHMENT—The United States Patent and Trademark Office is established as an agency of the United States, within the Department of Commerce. In carrying out its functions, the United States Patent and Trademark Office shall be subject to the policy direction of the Secretary of Commerce, but otherwise shall retain responsibility for decisions regarding the management and administration of its operations and shall exercise independent control of its budget allocations and expenditures, personnel decisions and processes, procurements, and other administrative and management functions in accordance with this title and applicable provisions of law. Those operations designed to grant and issue patents and those operations which are designed to facilitate the registration of trademarks shall be treated as separate operating units within the Office.

(b) OFFICES—The United States Patent and Trademark Office shall maintain its principal office in the metropolitan Washington, D.C., area, for the service of process and papers and for the purpose of carrying out its functions. The United States Patent and Trademark Office shall be deemed, for purposes of venue in civil actions, to be a resident of the district in which its principal office is located, except where jurisdiction is otherwise provided by law. The United States Patent and Trademark Office may establish satellite offices in such other places in the United States as it considers necessary and appropriate in the conduct of its business.

(c) REFERENCE—For purposes of this title, the United States Patent and Trademark Office shall also be referred to as the “Office” and the “Patent and Trademark Office.”

(July 19, 1952, ch. 950, § 1, 66 Stat. 792; Jan. 2, 1975, 88 Stat. 1949; Nov. 29, 1999, 113 Stat. 1501A-572.)

35 U.S.C. § 2. Powers and duties.

(a) IN GENERAL—The United States Patent and Trademark Office, subject to the policy direction of the Secretary of Commerce—

(1) shall be responsible for the granting and issuing of patents and the registration of trademarks; and

(2) shall be responsible for disseminating to the public information with respect to patents and trademarks.

(b) SPECIFIC POWERS—The Office—

(1) shall adopt and use a seal of the Office, which shall be judicially noticed and with which letters patent, certificates of trademark registrations, and papers issued by the Office shall be authenticated;

(2) may establish regulations, not inconsistent with law, which—

(A) shall govern the conduct of proceedings in the Office;

(B) shall be made in accordance with section 553 of title 5;

(C) shall facilitate and expedite the processing of patent applications, particularly those which can be filed, stored, processed, searched, and retrieved electronically, subject to the provisions of section 122 relating to the confidential status of applications;

(D) may govern the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office;

(E) shall recognize the public interest in continuing to safeguard broad access to the United States patent system through the reduced fee structure for small entities under section 41(h)(1) of this title; and

(F) provide for the development of a performance-based process that includes quantitative and qualitative measures and standards for evaluating cost-effectiveness and is consistent with the principles of impartiality and competitiveness;

(3) may acquire, construct, purchase, lease, hold, manage, operate, improve, alter, and renovate any real, personal, or mixed property, or any interest therein, as it considers necessary to carry out its functions;

(4)(A) may make such purchases, contracts for the construction, maintenance, or management and operation of facilities, and contracts for supplies or services, without regard to the provisions of subtitle I and chapter 33 of title 40, title III of the Federal Property and Administrative Services Act of 1949 (41 U.S.C. 251 *et seq*.), and the McKinney-Vento Homeless Assistance Act (42 U.S.C. 11301 *et seq*.); and

(B) may enter into and perform such purchases and contracts for printing services, including the process of composition, platemaking, presswork, silk screen processes, binding, microform, and the products of such processes, as it considers necessary to carry out the functions of the Office, without regard to sections 501 through 517 and 1101 through 1123 of title 44;

(5) may use, with their consent, services, equipment, personnel, and facilities of other departments, agencies, and instrumentalities of the Federal Government, on a reimbursable basis, and cooperate with such other departments, agencies, and instrumentalities in the establishment and use of services, equipment, and facilities of the Office;

(6) may, when the Director determines that it is practicable, efficient, and cost-effective to do so, use, with the consent of the United States and the agency, instrumentality, Patent and Trademark Office, or international organization concerned, the services, records, facilities, or personnel of any State or local government agency or instrumentality or foreign patent and trademark office or international organization to perform functions on its behalf;

(7) may retain and use all of its revenues and receipts, including revenues from the sale, lease, or disposal of any real, personal, or mixed property, or any interest therein, of the Office;

(8) shall advise the President, through the Secretary of Commerce, on national and certain international intellectual property policy issues;

(9) shall advise Federal departments and agencies on matters of intellectual property policy in the United States and intellectual property protection in other countries;

(10) shall provide guidance, as appropriate, with respect to proposals by agencies to assist foreign governments and international intergovernmental organizations on matters of intellectual property protection;

(11) may conduct programs, studies, or exchanges of items or services regarding domestic and international intellectual property law and the effectiveness of intellectual property protection domestically and throughout the world;

(12)(A) shall advise the Secretary of Commerce on programs and studies relating to intellectual property policy that are conducted, or authorized to be conducted, cooperatively with foreign intellectual property offices and international intergovernmental organizations; and

(B) may conduct programs and studies described in subparagraph (A); and

(13)(A) in coordination with the Department of State, may conduct programs and studies cooperatively with foreign intellectual property offices and international intergovernmental organizations; and

(B) with the concurrence of the Secretary of State, may authorize the transfer of not to exceed $100,000 in any year to the Department of State for the purpose of making special payments to international intergovernmental organizations for studies and programs for advancing international cooperation concerning patents, trademarks, and other matters.

(c) CLARIFICATION OF SPECIFIC POWERS—(1) The special payments under subsection (b)(13)(B) shall be in addition to any other payments or contributions to international organizations described in subsection (b)(13)(B) and shall not be subject to any limitations imposed by law on the amounts of such other payments or contributions by the United States Government.

(2) Nothing in subsection (b) shall derogate from the duties of the Secretary of State or from the duties of the United States Trade Representative as set forth in section 141 of the Trade Act of 1974 (19 U.S.C. 2171).

(3) Nothing in subsection (b) shall derogate from the duties and functions of the Register of Copyrights or otherwise alter current authorities relating to copyright matters.

(4) In exercising the Director's powers under paragraphs (3) and (4)(A) of subsection (b), the Director shall consult with the Administrator of General Services.

(5) In exercising the Director's powers and duties under this section, the Director shall consult with the Register of Copyrights on all copyright and related matters.

(d) CONSTRUCTION—Nothing in this section shall be construed to nullify, void, cancel, or interrupt any pending request-for-proposal let or contract issued by the General Services Administration for the specific purpose of relocating or leasing space to the United States Patent and Trademark Office.

(July 19, 1952, ch. 950, § 1, 66 Stat. 792; Jan. 2, 1975, 88 Stat. 1949; Nov. 29, 1999, 113 Stat. 1501A-573; Nov. 2, 2002, 116 Stat. 1758.)

35 U.S.C. § 3. Officers and employees.

(a) UNDER SECRETARY AND DIRECTOR—(1) IN GENERAL- The powers and duties of the United States Patent and Trademark Office shall be vested in an Under Secretary of Commerce

for Intellectual Property and Director of the United States Patent and Trademark Office (in this title referred to as the "Director"), who shall be a citizen of the United States and who shall be appointed by the President, by and with the advice and consent of the Senate. The Director shall be a person who has a professional background and experience in patent or trademark law.

(2) DUTIES—

(A) IN GENERAL—The Director shall be responsible for providing policy direction and management supervision for the Office and for the issuance of patents and the registration of trademarks. The Director shall perform these duties in a fair, impartial, and equitable manner.

(B) CONSULTING WITH THE PUBLIC ADVISORY COMMITTEES—The Director shall consult with the Patent Public Advisory Committee established in section 5 on a regular basis on matters relating to the patent operations of the Office, shall consult with the Trademark Public Advisory Committee established in section 5 on a regular basis on matters relating to the trademark operations of the Office, and shall consult with the respective Public Advisory Committee before submitting budgetary proposals to the Office of Management and Budget or changing or proposing to change patent or trademark user fees or patent or trademark regulations which are subject to the requirement to provide notice and opportunity for public comment under section 553 of title 5, as the case may be.

(3) OATH—The Director shall, before taking office, take an oath to discharge faithfully the duties of the Office.

(4) REMOVAL—The Director may be removed from office by the President. The President shall provide notification of any such removal to both Houses of Congress.

(b) OFFICERS AND EMPLOYEES OF THE OFFICE—

(1) DEPUTY UNDER SECRETARY AND DEPUTY DIRECTOR—The Secretary of Commerce, upon nomination by the Director, shall appoint a Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office who shall be vested with the authority to act in the capacity of the Director in the event of the absence or incapacity of the Director. The Deputy Director shall be a citizen of the United States who has a professional background and experience in patent or trademark law.

(2) COMMISSIONERS—

(A) APPOINTMENT AND DUTIES—The Secretary of Commerce shall appoint a Commissioner for Patents and a Commissioner for Trademarks, without regard to chapter 33, 51, or 53 of title 5. The Commissioner for Patents shall be a citizen of the United States with demonstrated management ability and professional background and experience in patent law and serve for a term of 5 years. The Commissioner for Trademarks shall be a citizen of the United States with demonstrated management ability and professional background and experience in trademark law and serve for a term of 5 years. The Commissioner for Patents and the Commissioner for Trademarks shall serve as the chief operating officers for the operations of the Office relating to patents and trademarks, respectively, and shall be responsible for the management and direction of all aspects of the activities of the Office that affect the administration of patent and trademark operations, respectively. The Secretary may reappoint a Commissioner to subsequent terms of 5 years as long as the performance of the Commissioner as set forth in the performance agreement in subparagraph (B) is satisfactory.

(B) SALARY AND PERFORMANCE AGREEMENT—The Commissioners shall be paid an annual rate of basic pay not to exceed the maximum rate of basic pay for the Senior

Executive Service established under section 5382 of title 5, including any applicable locality-based comparability payment that may be authorized under section 5304(h)(2)(C) of title 5. The compensation of the Commissioners shall be considered, for purposes of section 207(c)(2)(A) of title 18, to be the equivalent of that described under clause (ii) of section 207(c)(2)(A) of title 18. In addition, the Commissioners may receive a bonus in an amount of up to, but not in excess of, 50 percent of the Commissioners' annual rate of basic pay, based upon an evaluation by the Secretary of Commerce, acting through the Director, of the Commissioners' performance as defined in an annual performance agreement between the Commissioners and the Secretary. The annual performance agreements shall incorporate measurable organization and individual goals in key operational areas as delineated in an annual performance plan agreed to by the Commissioners and the Secretary. Payment of a bonus under this subparagraph may be made to the Commissioners only to the extent that such payment does not cause the Commissioners' total aggregate compensation in a calendar year to equal or exceed the amount of the salary of the Vice President under section 104 of title 3.

(C) REMOVAL- The Commissioners may be removed from office by the Secretary for misconduct or nonsatisfactory performance under the performance agreement described in subparagraph (B), without regard to the provisions of title 5. The Secretary shall provide notification of any such removal to both Houses of Congress.

(3) OTHER OFFICERS AND EMPLOYEES—The Director shall—

(A) appoint such officers, employees (including attorneys), and agents of the Office as the Director considers necessary to carry out the functions of the Office; and

(B) define the title, authority, and duties of such officers and employees and delegate to them such of the powers vested in the Office as the Director may determine.

The Office shall not be subject to any administratively or statutorily imposed limitation on positions or personnel, and no positions or personnel of the Office shall be taken into account for purposes of applying any such limitation.

(4) TRAINING OF EXAMINERS—The Office shall submit to the Congress a proposal to provide an incentive program to retain as employees patent and trademark examiners of the primary examiner grade or higher who are eligible for retirement, for the sole purpose of training patent and trademark examiners.

(5) NATIONAL SECURITY POSITIONS—The Director, in consultation with the Director of the Office of Personnel Management, shall maintain a program for identifying national security positions and providing for appropriate security clearances, in order to maintain the secrecy of certain inventions, as described in section 181, and to prevent disclosure of sensitive and strategic information in the interest of national security.

(c) CONTINUED APPLICABILITY OF TITLE 5—Officers and employees of the Office shall be subject to the provisions of title 5, relating to Federal employees.

(d) ADOPTION OF EXISTING LABOR AGREEMENTS—The Office shall adopt all labor agreements which are in effect, as of the day before the effective date of the Patent and Trademark Office Efficiency Act, with respect to such Office (as then in effect).

(e) CARRYOVER OF PERSONNEL—

(1) FROM PTO- Effective as of the effective date of the Patent and Trademark Office Efficiency Act, all officers and employees of the Patent and Trademark Office on the day

before such effective date shall become officers and employees of the Office, without a break in service.

(2) OTHER PERSONNEL- Any individual who, on the day before the effective date of the Patent and Trademark Office Efficiency Act, is an officer or employee of the Department of Commerce (other than an officer or employee under paragraph (1)) shall be transferred to the Office, as necessary to carry out the purposes of this Act, if—

(A) such individual serves in a position for which a major function is the performance of work reimbursed by the Patent and Trademark Office, as determined by the Secretary of Commerce;

(B) such individual serves in a position that performed work in support of the Patent and Trademark Office during at least half of the incumbent's work time, as determined by the Secretary of Commerce; or

(C) such transfer would be in the interest of the Office, as determined by the Secretary of Commerce in consultation with the Director.

Any transfer under this paragraph shall be effective as of the same effective date as referred to in paragraph (1), and shall be made without a break in service.

(f) TRANSITION PROVISIONS—

(1) INTERIM APPOINTMENT OF DIRECTOR—On or after the effective date of the Patent and Trademark Office Efficiency Act, the President shall appoint an individual to serve as the Director until the date on which a Director qualifies under subsection (a). The President shall not make more than one such appointment under this subsection.

(2) CONTINUATION IN OFFICE OF CERTAIN OFFICERS—(A) The individual serving as the Assistant Commissioner for Patents on the day before the effective date of the Patent and Trademark Office Efficiency Act may serve as the Commissioner for Patents until the date on which a Commissioner for Patents is appointed under subsection (b).

(B) The individual serving as the Assistant Commissioner for Trademarks on the day before the effective date of the Patent and Trademark Office Efficiency Act may serve as the Commissioner for Trademarks until the date on which a Commissioner for Trademarks is appointed under subsection (b).

(July 19, 1952, ch. 950, § 1, 66 Stat. 792; Sept. 6, 1958, 72 Stat. 1793; Sept. 23, 1959, 73 Stat. 650; Aug. 14, 1964, 78 Stat. 425; Jan. 2, 1975, 88 Stat. 1949; Jan. 2, 1975, 88 Stat. 1956; Aug. 27, 1982, 96 Stat. 319; Oct. 15, 1982, 96 Stat. 1760; Nov. 8, 1984, 98 Stat. 3392; Oct. 28, 1998, 112 Stat. 2860; Aug. 5, 1999, 113 Stat. 221; Nov. 29, 1999, 113 Stat. 1501A-575; Nov. 2, 2002, 116 Stat. 1904.)

35 U.S.C. § 4. Restrictions on officers and employees as to interest in patents

Officers and employees of the Patent and Trademark Office shall be incapable, during the period of their appointments and for one year thereafter, of applying for a patent and of acquiring, directly or indirectly, except by inheritance or bequest, any patent or any right or interest in a patent, issued or to be issued by the Office. In patents applied for thereafter they shall not be entitled to any priority date earlier than one year after the termination of their appointment.

(July 19, 1952, ch. 950, § 1, 66 Stat. 793; Jan. 2, 1975, 88 Stat. 1949; Jan. 2, 1975, 88 Stat. 1949.)

35 U.S.C. § 5. Patent and Trademark Office Public Advisory Committees.

(a) ESTABLISHMENT OF PUBLIC ADVISORY COMMITTEES—

(1) APPOINTMENT—The United States Patent and Trademark Office shall have a Patent Public Advisory Committee and a Trademark Public Advisory Committee, each of which shall have nine voting members who shall be appointed by the Secretary of Commerce and serve at the pleasure of the Secretary of Commerce. Members of each Public Advisory Committee shall be appointed for a term of 3 years, except that of the members first appointed, three shall be appointed for a term of 1 year, and three shall be appointed for a term of 2 years. In making appointments to each Committee, the Secretary of Commerce shall consider the risk of loss of competitive advantage in international commerce or other harm to United States companies as a result of such appointments.

(2) CHAIR—The Secretary shall designate a chair of each Advisory Committee, whose term as chair shall be for 3 years.

(3) TIMING OF APPOINTMENTS—Initial appointments to each Advisory Committee shall be made within 3 months after the effective date of the Patent and Trademark Office Efficiency Act. Vacancies shall be filled within 3 months after they occur.

(b) BASIS FOR APPOINTMENTS- Members of each Advisory Committee—

(1) shall be citizens of the United States who shall be chosen so as to represent the interests of diverse users of the United States Patent and Trademark Office with respect to patents, in the case of the Patent Public Advisory Committee, and with respect to trademarks, in the case of the Trademark Public Advisory Committee;

(2) shall include members who represent small and large entity applicants located in the United States in proportion to the number of applications filed by such applicants, but in no case shall members who represent small entity patent applicants, including small business concerns, independent inventors, and nonprofit organizations, constitute less than 25 percent of the members of the Patent Public Advisory Committee, and such members shall include at least one independent inventor; and

(3) shall include individuals with substantial background and achievement in finance, management, labor relations, science, technology, and office automation.

In addition to the voting members, each Advisory Committee shall include a representative of each labor organization recognized by the United States Patent and Trademark Office. Such representatives shall be nonvoting members of the Advisory Committee to which they are appointed.

(c) MEETINGS—Each Advisory Committee shall meet at the call of the chair to consider an agenda set by the chair.

(d) DUTIES—Each Advisory Committee shall—

(1) review the policies, goals, performance, budget, and user fees of the United States Patent and Trademark Office with respect to patents, in the case of the Patent Public Advisory Committee, and with respect to Trademarks, in the case of the Trademark Public Advisory Committee, and advise the Director on these matters;

(2) within 60 days after the end of each fiscal year—

(A) prepare an annual report on the matters referred to in paragraph (1);

(B) transmit the report to the Secretary of Commerce, the President, and the Committees on the Judiciary of the Senate and the House of Representatives; and

(C) publish the report in the Official Gazette of the United States Patent and Trademark Office.

(e) COMPENSATION—Each member of each Advisory Committee shall be compensated for each day (including travel time) during which such member is attending meetings or conferences of that Advisory Committee or otherwise engaged in the business of that Advisory Committee, at the rate which is the daily equivalent of the annual rate of basic pay in effect for level III of the Executive Schedule under section 5314 of title 5. While away from such member's home or regular place of business such member shall be allowed travel expenses, including per diem in lieu of subsistence, as authorized by section 5703 of title 5.

(f) ACCESS TO INFORMATION—Members of each Advisory Committee shall be provided access to records and information in the United States Patent and Trademark Office, except for personnel or other privileged information and information concerning patent applications required to be kept in confidence by section 122.

(g) APPLICABILITY OF CERTAIN ETHICS LAWS—Members of each Advisory Committee shall be special Government employees within the meaning of section 202 of title 18.

(h) INAPPLICABILITY OF FEDERAL ADVISORY COMMITTEE ACT—The Federal Advisory Committee Act (5 U.S.C. App.) shall not apply to each Advisory Committee.

(i) OPEN MEETINGS—The meetings of each Advisory Committee shall be open to the public, except that each Advisory Committee may by majority vote meet in executive session when considering personnel, privileged, or other confidential information.

(j) INAPPLICABILITY OF PATENT PROHIBITION—Section 4 shall not apply to voting members of the Advisory Committees.

(Added Nov. 29, 1999, 113 Stat. 1501A-578; amended Nov. 2, 2002, 116 Stat. 1904.)

35 U.S.C. § 6. Board of Patent Appeals and Interferences. (35 U.S.C. § 6 pertains to patents.)

35 U.S.C. § 7. Library.

The Director shall maintain a library of scientific and other works and periodicals, both foreign and domestic, in the Patent and Trademark Office to aid the officers in the discharge of their duties.

(July 19, 1952, ch. 950, § 1, 66 Stat. 793; Jan. 2, 1975, 88 Stat. 1949; Jan. 2, 1975, 88 Stat. 1949; Nov. 29, 1999, 113 Stat. 1501A-580.)

35 U.S.C. § 8. Classification of patents. (35 U.S.C. § 8 pertains to patents.)

35 U.S.C. § 9. Certified copies of records.

The Director may furnish certified copies of specifications and drawings of patents issued by the Patent and Trademark Office, and of other records available either to the public or to the person applying therefor.

(July 19, 1952, ch. 950, 66 Stat. 794; Pub. L. 93-596, Sec. 1, Jan. 2, 1975, 88 Stat. 1949; Nov. 29, 1999, 113 Stat. 1501A-580.)

35 U.S.C. § 10. Publications.

(a) The Director may publish in printed, typewritten, or electronic form, the following:

1. Patents, including specifications and drawings, together with copies of the same. The Patent and Trademark Office may print the headings of the drawings for patents for the purpose of photolithography.

2. Certificates of trademark registrations, including statements and drawings, together with copies of the same.

3. The Official Gazette of the United States Patent and Trademark Office.

4. Annual indexes of patents and patentees, and of trademarks and registrants.

5. Annual volumes of decisions in patent and trademark cases.

6. Pamphlet copies of the patent laws and rules of practice, laws and rules relating to trademarks, and circulars or other publications relating to the business of the Office.

(b) The Director may exchange any of the publications specified in items 3, 4, 5, and 6 of subsection (a) of this section for publications desirable for use of the Patent and Trademark Office.

(July 19, 1952, ch. 950, § 1, 66 Stat. 794; Jan. 2, 1975, 88 Stat. 1949; Nov. 29, 1999, 113 Stat. 1501A-580.)

35 U.S.C. § 11. Exchange of copies of patents. (35 U.S.C. § 11 pertains to patents.)

35 U.S.C. § 12. Copies of patents and applications for public libraries. (35 U.S.C. § 12 pertains to patents.)

35 U.S.C. § 13. Annual report to Congress.

The Director shall report to the Congress, not later than 180 days after the end of each fiscal year, the moneys received and expended by the Office, the purposes for which the moneys were spent, the quality and quantity of the work of the Office, the nature of training provided to examiners, the evaluation of the Commissioner of Patents and the Commissioner of Trademarks by the Secretary of Commerce, the compensation of the Commissioners, and other information relating to the Office.

(July 19, 1952, ch. 950, § 1, 66 Stat. 794; Nov. 29, 1999, 113 Stat. 1501A-581.)

CHAPTER 2—PROCEEDINGS IN THE PATENT AND TRADEMARK OFFICE

35 U.S.C. § 21. Filing date and day for taking action.

(a) The Director may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service or would have been deposited with the United States Postal Service but for postal service interruptions or emergencies designated by the Director.

(b) When the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or a federal holiday within the District of

Columbia, the action may be taken, or the fee paid, on the next succeeding secular or business day.

(July 19, 1952, ch. 950, § 1, 66 Stat. 794; Jan. 2, 1975, 88 Stat. 1949; Aug. 27, 1982, 96 Stat. 321; Nov. 29, 1999, 113 Stat. 1501A-582.)

Note—For holidays, see 5 U.S.C. § 6103 and District of Columbia Code, sec. 28-2701:

5 U.S.C. § 6103. Holidays.

(a) The following are legal public holidays:

New Year's Day, January 1.
Birthday of Martin Luther King, Jr., the third Monday in January.
Washington's Birthday, the third Monday in February.
Memorial Day, the last Monday in May.
Independence Day, July 4.
Labor Day, the first Monday in September.
Columbus Day, the second Monday in October.
Veterans Day, November 11.
Thanksgiving Day, the fourth Thursday in November.
Christmas Day, December 25.

(b) For the purpose of statutes relating to pay and leave of employees, with respect to a legal public holiday and any other day declared to be a holiday by Federal statute or Executive order, the following rules apply:

(1) Instead of a holiday that occurs on a Saturday, the Friday immediately before is a legal public holiday for—

(A) Employees whose basic workweek is Monday through Friday; and

(B) the purpose of section 6309 (Leave of Absence, etc.) of this title.

(2) Instead of a holiday that occurs on a regular weekly nonworkday of an employee whose basic workweek is other than Monday through Friday, except the regular weekly nonworkday administratively scheduled for the employee instead of Sunday, the workday immediately before that regular weekly nonworkday is a legal public holiday for the employee.

This subsection, except subparagraph (B) of paragraph (1), does not apply to an employee whose basic workweek is Monday through Saturday.

(c) January 20 of each fourth year after 1965, Inauguration Day, is a legal public holiday for the purpose of statutes relating to pay and leave of employees as defined by section 2105 of this title and individuals employed by the government of the District of Columbia employed in the District of Columbia, Montgomery and Prince Georges Counties in Maryland, Arlington and Fairfax Counties in Virginia, and the cities of Alexandria and Falls Church in Virginia. When January 20 of any fourth year after 1965 falls on Sunday, the next succeeding day selected for the public observance of the inauguration of the President is a legal public holiday for the purpose of this subsection.

(Amended June 28, 1968, 82 Stat. 250; Sept. 18, 1975, 89 Stat. 479; Nov. 2, 1983, 97 Stat. 917.)

District of Columbia Code—Section 28-2701.

Holidays designated—Time for performing acts extended. The following days in each year, namely, New Year's Day, January 1; Dr. Martin Luther King, Jr.'s Birthday, the third Monday in January; Washington's Birthday, the third Monday in February; Memorial Day, the last Monday in May; Independence Day, July 4; Labor Day, the first Monday in September; Columbus Day, the second Monday in October; Veteran's Day, November 11; Thanksgiving Day, the fourth Thursday in November; Christmas Day, December 25; every Saturday, after twelve o'clock noon; any day appointed by the President of the United States as a day of public feasting or thanksgiving; and the day of the inauguration of the President, in every fourth year, are holidays in the District for all purposes. When a day set apart as a legal holiday, other than the day of the inauguration of a President, falls on a Saturday, the next preceding day is a holiday. When a day set apart as a legal holiday falls on a Sunday, the next succeeding day is a holiday. In such cases, when a Sunday and a holiday or holidays fall on successive days, all commercial papers falling due on any of these days shall, for all purposes of presenting for payment or acceptance, be deemed to mature and be presentable for payment or acceptance on the next secular business day succeeding. Every Saturday is a holiday in the District for (1) every bank or banking institution having an office or banking house located within the District, (2) every Federal savings and loan association whose main office is in the District, and (3) every building association, building and loan association, or savings and loan association, incorporated or unincorporated, organized and operating under the laws of and having an office located within the District. An act which would otherwise be required, authorized, or permitted to be performed on Saturday in the District at the office or banking house of, or by, any such bank or bank institution, Federal savings and loan association, building association, building and loan association, or savings and loan association, if Saturday were not a holiday, shall or may be so performed on the next succeeding business day, and liability or loss of rights of any kind may not result from such delay.

Note.—As to the observance of holidays which fall on Saturday, see 5 U.S.C. § 6103, which provides:

"(b)(1) Instead of a holiday that occurs on a Saturday, the Friday immediately before is a legal public holiday...."

35 U.S.C. § 22. Printing of papers filed.

The Director may require papers filed in the Patent and Trademark Office to be printed, typewritten, or on an electronic medium.

(July 19, 1952, ch. 950, § 1, 66 Stat. 795; Jan. 2, 1975, 88 Stat. 1949; Nov. 29, 1999, 113 Stat. 1501A-582.)

35 U.S.C. § 23. Testimony in Patent and Trademark Office cases.

The Director may establish rules for taking affidavits and depositions required in cases in the Patent and Trademark Office. Any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where he resides, may take such affidavits and depositions.

(July 19, 1952, ch. 950, § 1, 66 Stat. 795; Jan. 2, 1975, 88 Stat. 1949; Nov. 29, 1999, 113 Stat. 1501A-582.)

35 U.S.C. § 24. Subpoenas, witnesses.

The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent and Trademark Office, shall, upon the application of any party

thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent and Trademark Office.

Every witness subpoenaed and in attendance shall be allowed the fees and traveling expenses allowed to witnesses attending the United States district courts.

A judge of a court whose clerk issued a subpoena may enforce obedience to the process or punish disobedience as in other like cases, on proof that a witness, served with such subpoena, neglected or refused to appear or to testify. No witness shall be deemed guilty of contempt for disobeying such subpoena unless his fees and traveling expenses in going to, and returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret matter except upon appropriate order of the court which issued the subpoena.

(July 19, 1952, ch. 950, § 1, 66 Stat. 795; Jan. 2, 1975, 88 Stat. 1949.)

35 U.S.C. § 25. Declaration in lieu of oath.

(a) The Director may by rule prescribe that any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be under oath may be subscribed to by a written declaration in such form as the Director may prescribe, such declaration to be in lieu of the oath otherwise required.

(b) Whenever such written declaration is used, the document must warn the declarant that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. section 1001).

(Added Mar. 26, 1964, 78 Stat. 171; amended Jan. 2, 1975, 88 Stat. 1949; Nov. 29, 1999, 113 Stat. 1501A-582.)

Note—18 U.S.C. § 1001 provides: "Whoever in any matter within the jurisdiction of any department or agency of the United States knowingly and willfully falsifies, conceals or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statements or entry, shall be fined not more than $10,000 or imprisoned not more than five years, or both." (June 25, 1948, 62 Stat. 749.)

35 U.S.C. § 26. Effect of defective execution.

Any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be executed in a specified manner may be provisionally accepted by the Director despite a defective execution, provided a properly executed document is submitted within such time as may be prescribed.

(Added Mar. 26, 1964, 78 Stat. 171; amended Jan. 2, 1975, 88 Stat. 1949.)

CHAPTER 3—PRACTICE BEFORE PATENT AND TRADEMARK OFFICE

35 U.S.C. § 31. [Repealed]

(Nov. 29, 1999, 113 Stat. 1501A-580.)

35 U.S.C. § 32. Suspension or exclusion from practice.

The Director may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before the Patent and Trademark Office, any person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who does not comply with the regulations established under section 2(b)(2)(D) of this title, or who shall, by word, circular, letter, or advertising, with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the Office. The reasons for any such suspension or exclusion shall be duly recorded. The Director shall have the discretion to designate any attorney who is an officer or employee of the United States Patent and Trademark Office to conduct the hearing required by this section. The United States District Court for the District of Columbia, under such conditions and upon such proceedings as it by its rules determines, may review the action of the Director upon the petition of the person so refused recognition or so suspended or excluded.

(July 19, 1952, ch. 950, § 1, 66 Stat. 795; Jan. 2, 1975, 88 Stat. 1949; Nov. 29, 1999, 113 Stat. 1501A-581.)

35 U.S.C. § 33. Unauthorized representation as practitioner.

Whoever, not being recognized to practice before the Patent and Trademark Office, holds himself out or permits himself to be held out as so recognized, or as being qualified to prepare or prosecute applications for patent, shall be fined not more than $1,000 for each offense.

(July 19, 1952, ch. 950, § 1, 66 Stat. 796; Jan. 2, 1975, 88 Stat. 1949.)

CHAPTER 4—PATENT FEES, FUNDING, SEARCH SYSTEMS

35 U.S.C. § 41(i). Patent and trademark search systems.

(i)(1) The Director shall maintain, for use by the public, paper, microform, or electronic collections of United States patents, foreign patent documents, and United States trademark registrations arranged to permit search for and retrieval of information. The Director may not impose fees directly for the use of such collections, or for the use of the public patent or trademark search rooms or libraries.

(2) The Director shall provide for the full deployment of the automated search systems of the Patent and Trademark Office so that such systems are available for use by the public, and shall assure full access by the public to, and dissemination of, patent and trademark information, using a variety of automated methods, including electronic bulletin boards and remote access by users to mass storage and retrieval systems.

(3) The Director may establish reasonable fees for access by the public to the automated search systems of the Patent and Trademark Office. If such fees are established, a limited amount of free access shall be made available to users of the systems for purposes of education and training. The Director may waive the payment by an individual of fees authorized by this subsection upon a showing of need or hardship, and if such a waiver is in the public interest.

(4) The Director shall submit to the Congress an annual report on the automated search systems of the Patent and Trademark Office and the access by the public to such systems. The Director shall also publish such report in the Federal Register. The Director shall provide an opportunity for the submission of comments by interested persons on each such report.

(Added Pub. L. 102-204, § 5(d)(1), 105 Stat. 1637, Dec. 10, 1991)

35 U.S.C. § 41 note. Adjustment of trademark fees.

(a) FEE FOR FILING APPLICATION. During fiscal years 2005 and 2006, under such conditions as may be prescribed by the Director, the fee under section 31(a) of the Trademark Act of 1946 (15 U.S.C. 1113(a)) for: (1) the filing of a paper application for the registration of a trademark shall be $375; (2) the filing of an electronic application shall be $325; and (3) the filing of an electronic application meeting certain additional requirements prescribed by the Director shall be $275. During fiscal years 2005 and 2006, the provisions of the second and third sentences of section 31(a) of the Trademark Act of 1946 shall apply to the fees established under this section.

(b) REFERENCE TO TRADEMARK ACT OF 1946. For purposes of this section, the "Trademark Act of 1946" refers to the Act entitled "An Act to provide for the registration and protection of trademarks used in commerce, to carry out the provisions of certain international conventions, and for other purposes."

(Pub. L. 108-447, Sec. 2, Div. B, Title VIII, Sec. 802, 118 Stat. 2809, 2929, Dec. 8, 2004.)

35 U.S.C. § 42. Patent and Trademark Office funding.

(a) All fees for services performed by or materials furnished by the Patent and Trademark Office will be payable to the Director.

(b) All fees paid to the Director and all appropriations for defraying the costs of the activities of the Patent and Trademark Office will be credited to the Patent and Trademark Office Appropriation Account in the Treasury of the United States.

(c) To the extent and in the amounts provided in advance in appropriations Acts, fees authorized in this title or any other Act to be charged or established by the Director shall be collected by and shall be available to the Director to carry out the activities of the Patent and Trademark Office. All fees available to the Director under section 31 of the Trademark Act of 1946 shall be used only for the processing of trademark registrations and for other activities, services, and materials relating to trademarks and to cover a proportionate share of the administrative costs of the Patent and Trademark Office.

(d) The Director may refund any fee paid by mistake or any amount paid in excess of that required.

(e) The Secretary of Commerce shall, on the day each year on which the President submits the annual budget to the Congress, provide to the Committees on the Judiciary of the Senate and the House of Representatives—

(1) a list of patent and trademark fee collections by the Patent and Trademark Office during the preceding fiscal year;

(2) a list of activities of the Patent and Trademark Office during the preceding fiscal year which were supported by patent fee expenditures, trademark fee expenditures, and appropriations;

(3) budget plans for significant programs, projects, and activities of the Office, including out-year funding estimates;

(4) any proposed disposition of surplus fees by the Office; and

(5) such other information as the committees consider necessary.

(July 19, 1952, c. 950, 66 Stat. 796; Nov. 14, 1975, Pub. L. 94-131, § 4, 89 Stat. 690; Dec. 12, 1980, Pub. L. 96-517, § 3, 94 Stat. 3018; Aug. 27, 1982, Pub. L. 97-247, § 3(g), 96 Stat. 319; Sept. 13, 1982, Pub. L. 97-258, § 3(i), 96 Stat. 1065; Nov. 10, 1998, Pub. L. 105-358, 112 Stat. 3272.)

NOTES OF OTHER STATUTES

SOME U.S. CODE (AND C.F.R.) SECTIONS PROTECTING SPECIFIC NAMES, TERMS AND MARKS

(This is a partial listing of some of the names, terms, initials and marks which are protected under the United States Code (and Code of Federal Regulations). Almost all of these sections protect symbols, emblems, seals, insignia and badges, as well as the referenced name. Many sections also protect other names and initials. Some sections protect characters in addition to names. See the sections for specific information. See also the next listing which provides other important Code sections, many of which also protect certain names, terms, initials and marks, e.g. 18 U.S.C. § 709. For further information on other sections, see the Index to the United States Code, and the Index to the Code of Federal Regulations, especially under the terms "decorations, medals and badges," "coats of arms," "character," "insignia," "names," "seals" and "symbols." Other sections also exist which are not indexed under these terms.)

- American Ex-Prisoners of War, 36 U.S.C. § 20907
- American Legion, 36 U.S.C. § 21705
- The American National Theater and Academy, 36 U.S.C. § 21904
- American Symphony Orchestra League, 36 U.S.C. § 22306
- American Veterans, 36 U.S.C. § 22706
- American War Mothers, 36 U.S.C. § 22505
- AMVETS (*see* American Veterans)
- Big Brothers [and other names], 36 U.S.C. § 30106
- Big Sisters [and other names], 36 U.S.C. § 30106
- Blinded Veterans Association, 36 U.S.C. § 30306
- Blue Star Mothers of America, Inc., 36 U.S.C. § 30507
- Board for Fundamental Education, 36 U.S.C. § 30706
- Boy Scouts of America, 36 U.S.C. § 30905
- Centers for Medicare and Medicaid Services (see Social Security)
- Central Intelligence Agency, 50 U.S.C. § 403m
- Central Liquidity Facility, 18 U.S.C. § 709
- CIA (see Central Intelligence Agency)
- Citius Altius Fortius (see Olympic)
- Civil Air Patrol, 36 U.S.C. § 40306
- CMS (see Social Security)
- Coast Guard [and other names], 14 U.S.C. § 639
- Commodity Credit Corporation, 15 U.S.C. § 714m
- DEA (see Drug Enforcement Administration)
- Department of Housing & Urban Development [and other names], 18 U.S.C. § 709
- Disabled American Veterans, 36 U.S.C. § 50305
- Drug Enforcement Administration, 18 U.S.C. § 709
- Fastener Quality Act, 15 U.S.C. §§ 5401 *et seq*.
- FFA (see Future Farmers of America)
- The Foundation of the Federal Bar Association, 36 U.S.C. § 70506
- 4-H Club [also specific reference to emblem consisting of a green four-leaf clover with stem and the letter H in white or gold on each leaflet], 18 U.S.C. § 707
- F.B.I. (see Federal Bureau of Investigation)
- Federal Bureau of Investigation, 18 U.S.C. § 709
- Federal Deposit Insurance Corporation [and other names], 18 U.S.C. § 709

- Federal Home Loan Mortgage Corporation, 12 U.S.C. § 1457
- Future Farmers of America, 36 U.S.C. § 70907
- Geneva Cross (see Red Cross)
- Girl Scouts of America, 36 U.S.C. § 80305
- Give a Hoot, Don't Pollute (see Woodsy Owl)
- The Golden Eagle [also specific reference to insignia of an American Golden Eagle (colored gold) and a family group (colored midnight blue) enclosed within a circle (colored white with a midnight blue border)], 18 U.S.C. § 715
- Government National Mortgage Association, 12 U.S.C. § 1723a; 18 U.S.C. § 709
- HUD (See Department of Housing & Urban Development)
- Ladies of the Grand Army of the Republic, 36 U.S.C. § 130106
- Life Saving Service (see Coast Guard),
- Lighthouse Service (see Coast Guard),
- Little League; Little Leaguer, 36 U.S.C. § 130506
- Marine Corps, 10 U.S.C. § 7881
- Medicaid (see Social Security)
- Medicare (see Social Security)
- The Military Chaplains Association of the United States of America, 36 U.S.C. § 140304
- NASA (see National Aeronautics and Space Administration)
- National Aeronautics and Space Administration [also flags, logo, seal], 42 U.S.C. § 2459b; 14 C.F.R. §§ 1221.101, 1221.107
- National Conference of State Societies, Washington, District of Columbia, 36 U.S.C. § 150507
- National Conference on Citizenship, 36 U.S.C. § 150707
- National Credit Union [and other names and acronyms], 18 U.S.C. § 709
- National Music Council, 36 U.S.C. § 152306
- National Safety Council, 36 U.S.C. § 152506
- National Society, Daughters of the American Colonists, 36 U.S.C. § 152907
- National Society of the Daughters of the American Revolution, 36 U.S.C. § 153104
- National Women's Relief Corps, Auxiliary of the Grand Army of the Republic, 36 U.S.C. § 153706
- Naval Sea Cadet Corps, 36 U.S.C. § 154106,
- NCOA (see Non Commissioned Officers Association of the United States of America)
- Non Commissioned Officers Association of the United States of America [and other names], 36 U.S.C. § 154707
- Olympiad (see Olympic)
- Olympic [and other names] [also specific reference to (1) the symbol of the International Olympic Committee, consisting of five interlocking rings, and (2) the emblem consisting of an escutcheon having a blue chief and vertically extending red and white bars on the base with five interlocked rings displayed on the chief], 36 U.S.C. § 220506
- OPIC (see Overseas Private Investment)
- Overseas Private Investment, 18 U.S.C. § 709
- Paralyzed Veterans of America, 36 U.S.C. § 170105
- Pearl Harbor Survivors Association, 36 U.S.C. § 170307
- Peace Corps, 22 U.S.C. § 2518
- Red Crescent emblem, or the designation "Red Crescent," 18 U.S.C. § 706a
- Red Cross [and other names] [also specific reference to the emblem of the Greek red cross on a white ground], 18 U.S.C. § 706
- Reserve Officers Association of the United States, 36 U.S.C. § 190106
- SSA (see Social Security)
- Secret Service [and other names], 18 U.S.C. § 709

- Smokey Bear, 18 U.S.C. § 711; 16 U.S.C. § 580p; 36 C.F.R. § 261.22
- Social Security [and other names, symbols and emblems], 42 U.S.C. § 1320b-10
- Sons of Union Veterans of the Civil War, 36 U.S.C. § 200306
- Swiss Confederation [with specific reference to the coat of arms, consisting of an upright white cross with equal arms and lines on a red ground], 18 U.S.C. § 708
- Third Protocol Emblem, 18 U.S.C. § 706a
- U.D. (see Secret Service)
- USCG (see Coast Guard)
- USCGR (see Coast Guard)
- USMC (see Marine Corps)
- USO (see United Service Organizations, Incorporated)
- U.S.S.S. (see Secret Service)
- United Service Organizations, Incorporated, 36 U.S.C. § 220106
- United States Capitol Historical Society, 36 U.S.C. § 220306
- United States Mint, 18 U.S.C. § 709
- United States Railway Association, 45 U.S.C. § 711
- United States Coast Guard (see Coast Guard)
- United States Olympic Committee (see Olympic)
- 369th Veterans Association, 36 U.S.C. § 210307
- Veterans of Foreign Wars of the United States, 36 U.S.C. § 230105
- Veterans of World War I of the United States of America, Incorporated, 36 U.S.C. § 230306
- Vietnam Veterans of America [and other names], 36 U.S.C. § 230507
- Woodsy Owl, 18 U.S.C. § 711a, 16 U.S.C. § 580p; 36 C.F.R. § 261.22

SOME SECTIONS OF THE UNITED STATES CODE WHICH RELATE TO TRADEMARKS

(*This is a partial listing of sections relating to trademarks.*)

- 7 U.S.C. § 136, The Federal Insecticide, Fungicide and Rodenticide Act, relating to the requirements for labeling of economic poisons.
- 7 U.S.C. §§ 1551-1610, The Federal Seed Act, relating to requirements for labeling of seeds in interstate commerce.
- 15 U.S.C. § 1, Sherman Act (Sec. 1), as amended by Miller-Tydings Act, relating to restraint of trade.
- 15 U.S.C. § 45, relating to unfair methods of competition.
- 15 U.S.C. § 52, relating to false advertisements.
- 15 U.S.C. § 68, The Wool Products Labeling Act, relating to the labeling of wool products.
- 15 U.S.C. § 69, The Fur Products Labeling Act, relating to the labeling of fur and fur products.
- 15 U.S.C. § 70, the Textile Fiber Products Identification Act, relating to the use of trademarks and names in the advertising or labeling of textile fiber products.
- 15 U.S.C. § 297, relating to use of marks, trade names, words and labeling in connection with the importation, exportation or carriage in interstate commerce of merchandise made of gold or silver or their alloys.
- 15 U.S.C. §§ 1261-1273, relating to the labeling of hazardous substances.
- 15 U.S.C. § 1511, relating to jurisdiction of Department of Commerce over Patent and Trademark Office.
- 15 U.S.C. §§ 5401 *et seq.*, relating to the recordation of insignia of manufacturers and private label distributors to ensure the traceability of a fastener to its manufacturer or private label distributor. (*See* notice at 1192 TMOG 19 (Nov. 5, 1996)).
- 18 U.S.C. § 701, relating to use of insignia of departments and independent offices of the United States.
- 18 U.S.C. § 704, relating to decorations or medals authorized by Congress for the armed forces of the United States.
- 18 U.S.C. § 705, relating to the unauthorized use on merchandise of any badge, medal, emblem, or other insignia or any colorable imitation thereof of any veteran's organization incorporated by enactment of Congress or of any organization formally recognized by any such veteran's organization as an auxiliary thereof.
- 18 U.S.C. § 709, relating to false advertising or misuse of names to indicate Federal agency. Also, prohibitions against using certain terms and initials within the financial, insurance, agricultural, housing, protection, investigatory and other fields.
- 18 U.S.C. § 712, relating to misuse by collecting agencies or private detective agencies of names, emblems, and insignia to indicate Federal agency.
- 18 U.S.C. § 713, relating to the use of likenesses of the great seal of the United States, and of the seals of the President and Vice President.
- 18 U.S.C. § 1001, relating to statements, representations, writings or documents made to any department or agency of the United States.
- 18 U.S.C. § 1158, relating to counterfeiting or imitating Government trademarks for Indian products.
- 18 U.S.C. § 2320, relating to criminal penalties for trafficking in counterfeit goods and services.
- 19 U.S.C. § 1337(a), Tariff Act of 1930, relating to unfair practices in import trade.
- 19 U.S.C. § 1526(a), Tariff Act of 1930, barring importation into the United States of merchandise of foreign manufacture bearing a trademark registered in the Patent and Trademark Office by a person domiciled in the United States if copy of the registration

certificate has been filed with the Secretary of the Treasury unless written consent of the trademark owner has been secured.

- 19 U.S.C. § 2111 *et seq*., providing authority for trade agreements and also annual reports to Congress on barriers to trade include the treatment of intellectual property rights among acts, policies, and practices that constitute barriers to trade.
- 19 U.S.C. § 2411, relating to foreign countries' provision for adequate and effective protection of the intellectual property rights of U.S. nationals.
- 19 U.S.C. § 2462(c), relating to the consideration of intellectual property rights as a factor for foreign countries to receive benefits under the Generalized System of Preferences (GSP).
- 21 U.S.C. §§ 603-623, The Meat Inspecting Act, relating to the inspection and labeling of meat and products.
- 21 U.S.C. §§ 301, 321-392, The Federal Food, Drug, and Cosmetic Act, relating to the requirements for labeling of food, drugs, and cosmetics; avoiding trademarks in establishing official names.
- 21 U.S.C. § 457, Poultry Products Inspection Act, relating to requirements for labeling of poultry products in interstate commerce.
- 27 U.S.C. §§ 201-219a, The Federal Alcohol Administration Act, relating to certificates of label approval of alcoholic beverages.
- 28 U.S.C. § 1254, relating to review of cases by the Supreme Court.
- 28 U.S.C. § 1295, relating to jurisdiction of United States Court of Appeals for the Federal Circuit.
- 28 U.S.C. § 1338, relating to jurisdiction of District Courts in trademark suits.
- 29 U.S.C. §§ 655, 657, 665, Williams-Steiger Occupational Safety and Health Act of 1970, relating to letters OSHA.
- 42 U.S.C. § 1320b-10, relating to misuse of Social Security or Medicare names, symbols, emblems.
- 48 U.S.C. § 734, Puerto Rico, relating to statutes applicable to.
- 48 U.S.C. §§ 1405(q), 1574(c) and 1643, Virgin Islands, relating to statutes applicable to, and to the non-applicability of certain provisions of the Trademark Act to the Virgin Islands.
- 48 U.S.C. § 1421(c), Guam, relating to statutes applicable to (see also Public Law 87-845, October 18, 1962, 4-CZC-471, Canal Zone Code, relating to the application of U.S. patent, trademark and copyright laws in the Canal Zone.)
- 50 U.S.C. Appendix 43, Trading with the Enemy Act, amending, providing for disposition of vested trademarks.

District of Columbia Code

Section 22-3401, relating to use of District of Columbia and other related names and initials used in connection with investigatory or collection services. (Oct. 16, 1962, 76 Stat. 1071)