Examination Guide 3-18

Changes to Procedures Regarding Certain Documents

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**Introduction**

This examination guide revises the procedures regarding: (1) issuance by the United States Patent and Trademark Office (USPTO) of courtesy paper copies of email correspondence returned to the USPTO as undeliverable; (2) requests for duplicate certificates of registration where the registrant claims non-receipt of the certificate; and (3) submission of letters of protest. This guidance supersedes any previous USPTO guidance on this topic to the extent there are any conflicts and will be incorporated in the October 2018 revision of the Trademark Manual of Examining Procedure (TMEP).

# BACKGROUND

The procedural changes addressed here reflect the USPTO’s continuing efforts to minimize the issuance of paper documents and notices to applicants and registrants, and to encourage the use of electronic communications. In addition, to better ensure that requests for a replacement registration certificate are made by an appropriate party, the USPTO is changing the procedure for requesting a replacement certificate within one year of the registration date (currently by written request) to be the same as the procedure for making a request after one year from registration (by petition to the Director). Now all requests for a replacement registration certificate must be made via a petition to the Director under 37 C.F.R. §2.146(a)(3). Furthermore, the USPTO is clarifying that a letter of protest must be filed using TEAS, must include an email address for the protestor, and if asserting likelihood of confusion of the mark in the protested application in view of a prior-registered or applied-for mark, should identify no more than five registrations or applications that could form a basis for a refusal under Trademark Act Section 2(d).

# Correspondence Returned as Undeliverable

## Current Procedure

Regarding undeliverable correspondence sent by the USPTO, TMEP §§403 and 717.01 provide that if outgoing email to a primary email correspondence address of record is returned as undeliverable, the USPTO will send a paper copy to the correspondence address of record.

## Amended Procedure

Under the new procedures in revised TMEP §403, if outgoing email to the designated email correspondence address of record is returned as undeliverable, the USPTO will no longer send a paper copy to the postal correspondence address of record. TMEP §717.01 will also be amended to indicate that if outgoing email is returned as undeliverable, the USPTO will not send a paper copy.

Therefore, in accordance with the due-diligence guidelines discussed in TMEP §108.03, applicants and registrants are strongly encouraged to monitor the status of their applications or registrations, using the Trademark Status and Document Retrieval (TSDR) system at https://tsdr.uspto.gov. The TSDR system indicates the current status of an application or registration and allows users to download copies of any documents in the record, including any outgoing actions or notices.

Revised TMEP §§403 and 717.01 appear in the Appendix below.

# Duplicate Registration Certificates

## Current Procedure

TMEP §1601.01(b), which addresses the issuance of duplicate registration certificates, allows owners to obtain a duplicate registration within one year of issuance, without paying a fee, by submitting a written request stating that the certificate was never received. A showing of good cause is not required. If more than one year has passed since issuance, the owner must file a petition to the Director under 37 C.F.R. §2.146(a)(3), accompanied by the fee required by 37 C.F.R. §2.6. The Director may exercise supervisory authority to grant the request for good cause.

## Amended Procedure

Revised TMEP §1601.01(b) will no longer distinguish between requests for duplicate registration certificates made within one year of issuance and requests made more than one year after issuance. Thus, the previous practice of issuing duplicate registration certificates without a petition if the request was made within one year of the issuance date of the registration is discontinued. Accordingly, all requests for a duplicate certificate of registration must be made by the owner of the registration in a petition to the Director under 37 C.F.R. §2.146(a)(3). The petition, which should be filed via TEAS, must be signed by a proper party, and must include the fee required by 37 C.F.R. §2.6 and a verified statement of the facts and the relief being requested.

In all cases, the Director may exercise supervisory authority to grant the request for good cause. Examples of good cause include the following:

* Registrant did not receive the registration certificate
* Registration certificate arrived damaged
* Original certificate was lost or damaged after receipt

Revised TMEP §1601.01(b) appears in the Appendix below.

# Letters of Protest

## Current Procedure

TMEP §1715.04 allows third parties who object to the registration of a mark in a pending application to submit a simple statement of the proposed legal grounds for refusing registration or issuing a requirement in a written letter of protest. Currently, letters of protest are permitted to be filed via the TEAS Letter of Protest form, by facsimile transmission, or by first-class mail. In addition, although TMEP §1715.04(b) limits the number of pages of relevant evidence that a protestor may submit, it does not limit the number of registrations or prior-pending applications that may be submitted to support an allegation that there is a likelihood of confusion between the marks submitted and the mark in the application that is the subject of the letter of protest.

## Amended Procedure

Revised TMEP §§1715.04 and 1715.04(b) require that a letter of protest and any accompanying evidence and index be filed electronically using the TEAS form. The protestor is also required to include an email address for receipt from the USPTO of a response accepting, denying, or dismissing the letter of protest. Revised TMEP §1715.04(b) also limits the number of registrations and prior-pending applications that may be submitted to support an allegation of a likelihood of confusion with the subject mark.

Revised TMEP §§1715.04 and 1715.04(b) appear in the Appendix below.

# APPENDIX

Revised TMEP §403:

**403 Correspondence Returned as Undeliverable**

If an email notification of the issuance of an Office action or other notice sent to the designated primary email correspondence address of record is returned as undeliverable, the time for response will not be extended. Similarly, if an Office action or notice was mailed to the postal correspondence address of record, but was returned as undeliverable, the time for response will not be reset. See TMEP §§609–609.01(a) regarding the correspondence address.

If the USPTO either entered the correspondence address of record incorrectly or failed to enter a properly authorized request to change the correspondence address filed before the date on which the action or notice was issued, the USPTO may reissue the Office action or notice with a new response period if the applicant or registrant notifies the USPTO prior to the expiration of any deadline for response.

The transmittal of correspondence or a response on letterhead bearing a new address is not an appropriate means of providing notice of, or making, changes to the correspondence address of record. A request to change the correspondence address, signed in accordance with § 2.193(e)(9), must be promptly filed. 37 C.F.R. §2.18(b). *See* TMEP §§609.02 ─ 609.02(f). To expedite processing, notices of change of correspondence address (including changes of email correspondence address) should be filed through TEAS. *See* TMEP §609.02(b).

Trademark applicants and registrants should monitor the status of their applications or registrations every six months between the filing of an application or of a maintenance submission and the issuance of a registration or notice of acceptance. See TMEP §§108.03 and 1705.05 regarding due diligence and the duty to monitor status. Should the status inquiry reveal that a document is lost, that no action has been taken regarding correspondence that was submitted, or that some other problem exists, the applicant or registrant must promptly request corrective action in accordance with the procedures in TMEP §1705.05. Failure to act diligently and follow up with appropriate action may result in denial of the requested relief.

See TMEP §717 regarding reissuing Office actions and TMEP §717.01 regarding outgoing correspondence returned as undeliverable. See TMEP §§1712 ─ 1712.02(b)(iii) regarding requesting reinstatement of applications and registrations abandoned due to USPTO error.

Revised TMEP §717.01

**717.01 Returned Office Action**

If an emailed notification of an issued Office action is returned as undeliverable, the USPTO will not send a paper copy of the Office action. See TMEP §304 regarding email and TMEP §403 for more information about returned correspondence. Trademark applicants and registrants should monitor the status of their applications and submissions in support of maintenance of registrations by checking the status every six months between the filing date of the application or maintenance submission and the issuance of a registration or notice of acceptance. See TMEP §§108.03 and 1705.05 regarding due diligence and the duty to monitor status.

If a mailed Office action is returned to the USPTO because the United States Postal Service was not able to deliver it, the returned action and envelope will be scanned into the electronic record. See TMEP §717 regarding the applicable procedure if an Office action is sent to the wrong address due to a USPTO error.

If no communication from the applicant is received within the period for response, the application will be abandoned. See TMEP §§1712 ─ 1712.02(b)(iii) regarding requesting reinstatement of applications and registrations abandoned due to USPTO error and TMEP §§1714 ─ 1714.01(f)(i) concerning filing a petition to revive an application abandoned due to unintentional delay.

Revised TMEP §1601.01(b):

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

On September 15, 2009, changes were made to the format of the registration certificate that enable the USPTO to provide duplicates of certificates issued on or after that date. For registrations issued on or after September 15, 2009, the owner of the registration may request a duplicate certificate of registration by filing a petition to the Director under 37 C.F.R. §2.146(a)(3), accompanied by the required verified statement of the facts and the petition fee required by 37 C.F.R. §2.6. See TMEP §§1705 ─ 1705.07 regarding petition requirements. The Director may exercise supervisory authority to grant the request for good cause. A separate petition must be filed for each duplicate registration certificate requested. *See* TMEP §1707. Requests for waiver of the petition fee will be considered in certain appropriate cases. *See* TMEP §1705.02. The USPTO is not able to provide duplicates of registrations issued before September 15, 2009.

The owner of a registration may obtain a certified copy of the registration from the Document Services Branch of the Public Records Division of the USPTO for a fee. *See* TMEP §111.

Revised TMEP §1715.04:

**1715.04 Information for Parties Filing Letter of Protest**

Third parties who object to the registration of a mark in a pending application must never contact an examining attorney directly, either by telephone or in writing. Instead, they may submit a letter of protest.

Letters of protest are not part of the official application record. In order to ensure their proper routing and processing, the Office requires that letters of protest be filed electronically via the Trademark Electronic Application System (TEAS). Letters of protest filed on paper will not be considered. A separate letter of protest, including relevant evidence, must be filed for each individual application that is being protested. See TMEP §§1715.04(a), (b) regarding the nature and format of evidence to be included with a Letter of Protest. In TEAS, the Letter of Protest form can be accessed by clicking on the link entitled "Petition Forms" at https://www.uspto.gov/Teas.

The letter of protest must include an email address for receiving an acknowledgment of the submission and a response accepting, denying, or dismissing the letter of protest.

Generally, the protestor should expect to receive the response within 60 days of filing the letter. The protestor should monitor the application status by checking the TSDR database at https://tsdr.uspto.gov to determine whether an action accepting the letter of protest has been taken. This information will be in the public record only if the letter of protest is accepted. If a protestor has not received a response within three months of submitting a letter of protest, the protestor should contact the Petitions Office to confirm receipt of the letter of protest.

Protestors should continue to monitor the status of the application being protested because the application may be approved for publication, republication, or issuance of a registration even after a letter of protest is accepted. Ongoing monitoring will ensure protestors the opportunity to take other action such as filing a notice of opposition. A protestor may file a second letter of protest after publication only if a substantially different basis for filing the letter of protest is raised or significant additional evidence is provided that clearly establishes a prima facie case for refusal of registration.

Revised TMEP §1715.04(b):

**1715.04(b) Amount and Format of Evidence for Letter of Protest**

The letter of protest should include only a simple statement of the proposed legal grounds for refusing registration or issuing a requirement, with succinct, factual, objective evidence to support the refusal or requirement, and should not include arguments. The letter of protest process is intended to provide an opportunity for the protestor to efficiently and effectively provide relevant evidence in support of the proposed legal grounds for refusing registration identified in the letter of protest. It is inappropriate for the protestor to "dump" evidence and leave it to the Office to determine its possible relevance. Therefore, evidence submitted with the letter of protest should be succinct, not duplicative, and be limited to the most relevant evidence.

When the basis of the letter of protest is the existence of federally registered marks, or prior-pending applications, with which the protestor alleges that there is, or would be, a likelihood of confusion with the mark in the protested application, the protestor should not identify more than the five most relevant registrations or applications that could form a basis for refusal. If the protestor identifies more than five registrations or applications, only the first five identified registrations or applications will be considered.

Where numerous examples of third-party registrations or web pages exist regarding the relatedness of the goods and/or services, or to support any other refusal, it is not necessary to provide them all. The most relevant ten to fifteen examples should be submitted. More than fifteen examples of evidence generally will be considered duplicative and unnecessary and may result in the letter of protest being denied without consideration on the merits. Copies of third-party registrations must come from the electronic records of the Office and show the current status and title of the registration. When submitting printouts from the Internet as evidence, the printout must include the date the evidence was published or accessed and the complete URL address of the website. *See* *In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1593 (TTAB 2018); *In re Mueller Sports Med., Inc.*, 126 USPQ2d 1584, 1586 (TTAB 2018); *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010). Similarly, copies of pages from books or articles must include sufficient information regarding the source.

It should be a rare situation in which more than 75 pages of evidence is necessary to support the proposed legal grounds for refusal. Therefore, a letter of protest accompanied by more than 75 pages of evidence will be denied without consideration on the merits unless it complies with the following requirements. First, the letter of protest must contain a detailed explanation about why more than 75 pages of evidence is necessary. Second, the letter of protest must be accompanied by a separate itemized index.

The index must be provided on plain paper (not letterhead) via an attachment to the TEAS Letter of Protest form, and contain a concise factual description of each category or form of evidence included. If any item of evidence attached to the letter of protest consists of multiple pages, the index must specifically identify the page on which the evidence appears and must highlight the relevant portion of the page. To maintain the integrity of the ex parte examination process, the index must not identify the protestor or its representatives or contain any arguments or persuasive language.

Although an index is required for evidentiary submissions exceeding 75 pages, the Office strongly encourages the use of an index in all letters of protest that contain multiple forms of evidence because it aids in the consideration of the details of all the evidence provided by the protestor.