

# Chapter 1500 Post-Examination Procedures

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## **1501 Appeal to Trademark Trial and Appeal Board**

### **15 U.S.C. §1070**

An appeal may be taken to the Trademark Trial and Appeal Board from any final decision of the examiner in charge of the registration of marks upon the payment of the prescribed fee.

#### ***37 CFR §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.

An appeal from an examining attorney's action is taken to the Trademark Trial and Appeal Board (Board), not to a court. An appeal is taken by filing a notice of appeal and paying the appeal fee within six months of the date of issuance of the action from which the appeal is taken. [15 U.S.C. §1070](#); [37 C.F.R. §2.142\(a\)](#); [Trademark Trial and Appeal Board Manual of Procedure](#) (TBMP) [§1202.03](#).

The Trademark Act gives applicants a right to appeal to the Board after a final action by an examining attorney. [15 U.S.C. §1070](#). Under [37 C.F.R. §2.141\(a\)](#), a second refusal on the same grounds or a repeated requirement is considered a final action for purposes of appeal as long as all refusals or requirements are repeated in that action. Appeal from a first refusal or requirement, however, is premature. In addition, an Office action's mere advisory statement regarding a potential refusal is not subject to appeal. *In re Harley*, 119 USPQ2d 1755, 1757 (TTAB 2016) ("An advisory statement made by an examining attorney indicating that a refusal or requirement may issue if specified circumstances arise is not a refusal to register, let alone a *final* refusal to register, and is therefore not subject to appeal.").

The applicant must file the notice of appeal and appeal fee within six months of the date of issuance of the final refusal. [37 C.F.R. §2.142\(a\)](#); [TBMP §1202.02](#). Notices of appeal must be filed through the Electronic System for Trademark Trials and Appeals (ESTTA) at <https://estta.uspto.gov>. [37 C.F.R. §2.126](#). If ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, the notice of appeal may be filed in paper form. [37 C.F.R. §2.126\(b\)](#). A submission in paper form must include a written explanation of such technical problems or extraordinary circumstances. *Id.* If filing on paper, the applicant may use a certificate of mailing or Priority Mail Express® to avoid lateness. See [37 C.F.R. §2.197](#) and [§2.198](#), and [TMEP §305.02](#) and [§305.03](#) regarding certificate of mailing and Priority Mail Express® procedures and [TBMP §106.03](#) and [§107](#) for general information regarding permitted paper submissions with the Board. If the applicant does not timely file a notice of appeal and appeal fee, the application is abandoned. [15 U.S.C. §1062\(b\)](#). If the applicant's failure to file a proper notice of appeal was unintentional, the applicant may file a petition to revive within the deadlines specified in [37 C.F.R. §2.66\(a\)](#) and subject to the requirements listed in [37 C.F.R. §2.66\(b\)\(3\)](#) (see [TMEP §§1714.01\(a\)\(ii\)](#), [\(d\)](#)).

The unintentional delay standard of [37 C.F.R. §2.66](#) does not apply to applications that are abandoned due to an **incomplete** response. See [TMEP §§1714.01\(f\)\(ii\)–\(f\)\(ii\)\(E\)](#) regarding situations where the unintentional delay standard does not apply.

In appropriate circumstances, after an appeal is filed either the applicant or the examining attorney can request a remand, or the Board may remand the application to the examining attorney. See [TBMP §1209](#) regarding remand during an appeal. See also [TMEP §1504.05](#) for further information.

See generally [37 C.F.R. §2.142](#) and [§2.144](#) and [TBMP Chapter 1200](#) for further information about ex parte appeals to the Board, and [15 U.S.C. §1071](#), [37 C.F.R. §2.145](#), and [TBMP Chapter 900](#) regarding appeal to a court from a decision of the Board.

### **1501.01 Appealable Matter**

An applicant who wishes to contest a refusal based on a matter of substance (e.g., a matter arising under §§2-6, or 23 of the Trademark Act, [15 U.S.C. §§1052-1056](#), [1091](#)), should file an appeal to the Board, not a petition to the Director.

If the only issue in dispute is a question regarding the applicant's compliance with a technical provision of the Trademark Act or Trademark Rules of Practice, the applicant may file a petition to the Director rather than an appeal. See [37 C.F.R. §§2.63\(a\), \(b\), 2.146](#). See also [TMEP §1704](#) and [TBMP §1201.05](#) regarding petitionable matter versus appealable matter.

An examining attorney's requirement that is the subject of a petition decided by the Director subsequently may not be the subject of an appeal to the Board. [37 C.F.R. §2.63\(c\)](#).

### **1501.02 Appeal Briefs**

#### **1501.02(a) Applicant's Appeal Brief**

The applicant must file an appeal brief within 60 days of the date of the appeal, or the Board may dismiss the appeal. [37 C.F.R. §2.142\(b\)\(1\)](#); see *In re Live Earth Prods. Inc.*, 49 USPQ2d 1063 (TTAB 1998). If the appeal is dismissed, the applicant may file a motion with the Board to set aside the dismissal and accept a late-filed brief. Applicant may also file a motion to accept a late-filed brief when the time for filing the brief has expired but the Board has not yet issued an order dismissing the appeal. If the Board denies the motion, the applicant may file a TEAS Petition to Director under [37 C.F.R. §2.146](#), requesting that the Director review the Board's action. The Director will reverse the Board's action only if the Board clearly erred or abused its discretion. An applicant should not file a Petition to Director until it has *first* filed a request/motion to accept the late-filed brief with the Board, and the Board has denied the request/motion. [TBMP §1203.02\(a\)](#). The applicant may not file a petition to revive under [37 C.F.R. §2.66](#) when an appeal is dismissed for failure to file a brief. [TMEP §1714.01\(f\)\(ii\)\(E\)](#).

The date of appeal for purposes of calculating the due date of the appeal brief is the date on which the notice of appeal and filing fee is received by the USPTO. If the applicant has also filed a request for reconsideration under [37 C.F.R. §2.63\(b\)\(3\)](#), the Board will acknowledge receipt of the appeal and request, suspend further proceedings (including applicant's time for filing its appeal brief), and remand the application to the examining attorney. See [TBMP §1203.02\(a\)](#) and [§1204](#) for further information. The filing of a request for reconsideration within six months of a final Office action will automatically result in a suspension of the

appeal, and an applicant need not file either its appeal brief or a request for an extension of time to file the brief. See [TBMP §1204](#).

The applicant's brief may not exceed twenty-five double-spaced pages in length, and should meet the requirements of [37 C.F.R. §2.126](#), [37 C.F.R. §2.142\(b\)\(2\)](#); [TBMP §1203.01](#); see *In re Thomas*, 79 USPQ2d 1021 (TTAB 2006) (Board refused to consider applicant's 29-page brief).

### **1501.02(b) Examining Attorney's Appeal Brief**

After the applicant's brief has been filed, the Board will send a notice to the examining attorney. The examining attorney has sixty days from the date of the Board's notice to file a responsive brief with the Board and issue a copy to the applicant. [37 C.F.R. §2.142\(b\)\(1\)](#); see [TBMP §1203.02\(b\)](#).

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

Examining attorneys should use the format shown in Appendix A as a model when preparing an appeal brief. The purpose of this format is to promote consistency and to provide content guidelines. The substance of the appeal brief is a matter of individual discretion.

The brief may not exceed twenty-five double-spaced pages in length. [37 C.F.R. §2.142\(b\)\(2\)](#); [TBMP §1203.01](#); see *In re Thomas*, 79 USPQ2d 1021 (TTAB 2006) (Board refused to consider applicant's 29-page brief). When referring to the record, the examining attorney should cite to the electronic record for the application, currently the Trademark Status and Document Retrieval database (TSDR). The citation format should be by date, name of the paper under which the evidence was submitted, and the page number in the electronic record, for example, November 4, 2013 Office Action, TSDR p. 2. Where appropriate, reference to the TTABVue entry and page number should also be used, for example, 1 TTABVue 2. See [TBMP §1203.01](#).

The record in the application should be complete prior to appeal. [37 C.F.R. §2.142\(d\)](#); [TMEP §710.01\(c\)](#); see *In re ADCO Indus.-Techs., L.P.*, 2020 USPQ2d 53786, at \*2 (TTAB 2020). Examining attorneys should not resubmit with the brief any evidence that is already in the application record. *In re Virtual Indep. Paralegals, LLC*, 2019 USPQ2d 111512, at \*1 (TTAB 2019) ("multiple submissions of the same evidence can cause confusion in reviewing the record and unnecessary delay in issuing a final decision"). Any exhibits attached to a brief that were not made of record during examination are untimely, and generally will not be considered. See *In re tapio GmbH*, 2020 USPQ2d 11387, at \*3-4 (TTAB 2020); *In re Medline Indus., Inc.*, 2020 USPQ2d 10237, at \*2 (TTAB 2020) (citing *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018), *aff'd per curiam*, 777 F. App'x 516, 2019 BL 343921 (Fed. Cir. 2019)). However, if the applicant does submit such evidence, the examining attorney should specifically object to such evidence if he or she does not want it to be considered. If the examining attorney does not object to untimely evidence, and discusses it in his or her brief or elsewhere in the record, the Board may treat it as of record. [TBMP §1207.03](#); [TMEP §710.01\(c\)](#); see *In re City of Hous.*, 101 USPQ2d 1534, 1536 (TTAB 2012) (citing *In re Broyhill Furniture Indus., Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001)), *aff'd*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013).

If, during the preparation of the appeal brief, the examining attorney determines that jurisdiction should be restored for further examination (e.g., to make a new refusal, to correct informalities, to suspend, or good cause exists to introduce additional evidence), the examining attorney should submit a request for remand instead of an appeal brief. See [TMEP §1504.05](#). If the Board grants the examining attorney's request, the

Board will stay further proceedings in connection with the appeal. If the Board denies the request, it will reset the time for submission of the examining attorney's appeal brief.

### **1501.02(c) Reply Briefs in Ex Parte Appeals**

The applicant may file a brief in reply to the examining attorney's appeal brief. Reply briefs must be filed within twenty days of the date of issuance of the examining attorney's brief. [37 C.F.R. §2.142\(b\)\(1\)](#). The examining attorney may not file a written response to the reply brief. However, in the oral argument (if the applicant requests an oral argument), the examining attorney should respond to any significant issues raised in the applicant's reply brief.

### **1501.03 Withdrawal of Refusal or Requirement After Appeal**

If, after considering the applicant's brief or reply brief, the examining attorney believes that the requirement or refusal should be withdrawn, the examining attorney must withdraw the requirement or refusal and approve the application for publication or registration, if it is otherwise in condition for such action. The examining attorney must also promptly attempt to notify the applicant by telephone or email that the requirement or refusal is withdrawn, and must enter an appropriate Note to the File in the record. This approval for publication or allowance for registration may be done at any time before the Board's decision on appeal. It is not necessary to notify the Board that the refusal or requirement has been withdrawn.

If there are multiple grounds for refusal and/or requirements, and the examining attorney decides that only certain refusals and/or requirements should be withdrawn, the appeal should go forward on the remaining ground(s) only. The following language should be included in the examining attorney's brief, informing the applicant of the withdrawal of the refusal(s) and/or requirement(s):

The examining attorney acknowledges receipt of the applicant's appeal brief. The examining attorney has withdrawn [specify the refusal(s) and/or requirement(s)].

### **1501.04 Fee for Appeal**

When filing an ex parte appeal to the Board from the refusal of the examining attorney to register a mark, the applicant must pay a fee for each class in the application for which the appeal is taken. [37 C.F.R. §2.141\(b\)](#).

The fee for at least one class must be paid before expiration of the six-month statutory filing period, or the application is abandoned. If the fee filed with the appeal is sufficient for at least one class but insufficient for all the classes in a multiple-class application, and the applicant has not specified the class(es) to which the fee applies, the Board will notify the applicant of the defect, and will set a time limit in which the applicant may either pay the additional fee(s), or limit the appeal to the number of classes for which the fee(s) have been paid. If the applicant does not submit the required fee(s) or specify the class(es) to which the fee applies within the time set in the notice, the fee submitted will be applied to the classes in ascending order, beginning with the lowest-numbered class and including the number of classes in the application for which sufficient fees have been submitted. See [37 C.F.R. §2.141\(b\)](#); [TBMP §1202.04](#).

## 1501.05 Amendment During Appeal

If the applicant files an amendment after filing a timely notice of appeal, the examining attorney may not act on it without authorization from the Board, because jurisdiction over the application is with the Board after a notice of appeal is filed. In appropriate cases, the Board may remand the case to the examining attorney to consider the matter presented in the document, with appropriate instructions to the examining attorney regarding consideration of the document and disposition of the case after such consideration. [TBMP §1205](#).

If an application is remanded to the examining attorney to consider an amendment, and the examining attorney determines that the amendment places the application in condition for publication or issue, the examining attorney should notify the applicant by telephone or email that the amendment has been entered, and that the amendment renders the appeal moot. It is not necessary to notify the Board.

## 1501.06 Amendment After Decision on Appeal

An examining attorney may not take action in an application after the Board has rendered a decision on appeal, because the examining attorney does not have jurisdiction over the application. *See In re U.S. Catheter & Instrument Corp.*, 158 USPQ 54, 55 n.3 (TTAB 1968). After a decision on appeal, the applicant may file a TEAS Petition to Director under [37 C.F.R. §2.142\(g\)](#) to reopen prosecution of the application. If the petition is granted, jurisdiction will be restored to the examining attorney to take the specified action.

A petition to reopen prosecution of the application could be granted if the appeal involved the applicant's compliance with a requirement rather than a refusal based on the nature of the mark. *See In re Hickory Mfg. Co.*, 183 USPQ 789 (Comm'r Pats. 1974). However, the Director will deny a petition to reopen prosecution if granting the petition would require further examination (e.g., to consider a claim of acquired distinctiveness under [15 U.S.C. §1052\(f\)](#) or an amendment to the Supplemental Register). *See In re Petite Suites Inc.*, 21 USPQ2d 1708 (Comm'r Pats. 1991); *In re Vycom Elecs. Ltd.*, 21 USPQ2d 1799 (Comm'r Pats. 1986); *In re Mack Trucks, Inc.*, 189 USPQ 642 (Comm'r Pats. 1976); *see also* [TBMP §1218](#) (and cases cited therein).

## 1501.07 Examining Attorney's Request for Reconsideration

In *In re Ferrero S.p.A.*, 22 USPQ2d 1800 (TTAB 1992), *recon. denied*, 24 USPQ2d 1061 (TTAB 1992), an augmented panel of the Board expressly overruled prior precedent and held that an examining attorney may request reconsideration of a Board decision reversing the examining attorney in an ex parte appeal.

The examining attorney's request must be filed within one month from the date of the Board's decision. [37 C.F.R. §2.144](#). No new evidence can be introduced with the request. The request should point out any errors of fact or law in the Board's decision.

To request reconsideration, the examining attorney must prepare a request and a supporting brief and submit the request to the managing attorney for concurrence in the decision to seek reconsideration. If the managing attorney concurs, the managing attorney will submit the request for reconsideration and brief to the Office of the Deputy Commissioner for Trademark Examination Policy for approval.

If that Office approves the request, the examining attorney will file the request with the Board and send a copy to the applicant. The Board will set an appropriate time for the applicant to respond to the request. The examining attorney may not file a reply brief in response to the applicant's brief.



## 1502 Publication in *Trademark Official Gazette*

After examination of an application is completed and the examining attorney determines that the mark is entitled to registration on the Principal Register, the mark is published in the USPTO's *Trademark Official Gazette* for opposition. [15 U.S.C. §1062](#); [37 C.F.R. §2.80](#). Any notice of opposition must be filed within thirty days after the date of publication, or within an extension of time granted by the Board for filing an opposition. [15 U.S.C. §1063\(a\)](#); [37 C.F.R. §2.101\(c\)](#); [TMEP §1503.03](#). See [TMEP §1503.01](#) for further information about filing a notice of opposition.

Marks that are found to be registrable on the Supplemental Register are registered when published in the *Trademark Official Gazette*. Marks registered on the Supplemental Register cannot be opposed, but are subject to cancellation under [15 U.S.C. §1064](#). [15 U.S.C. §1094](#).

In addition, marks registered on the Principal Register under the intent-to-use provisions of §1(d) of the Act are printed in the *Trademark Official Gazette* on the date of issuance of the registration. These marks were previously published for opposition, and are not subject to opposition again. See [TMEP §1105](#) regarding the publication of intent-to-use applications for opposition.

### 1502.01 Notification of Clerical Errors in Trademark Official Gazette

To request correction of a clerical error made by the USPTO, or a typographical error made by the applicant, that appears in the USPTO electronic record after the mark has been approved for publication or in the *Trademark Official Gazette*, the applicant or applicant's attorney must file a written request, signed by a proper party. [37 C.F.R. §2.193\(e\)\(2\)](#). The request must be made using the TEAS Post-Publication Amendment form at <https://teas.uspto.gov>. There is no fee for such a request. If the request is regarding a clerical error in the *Trademark Official Gazette*, it should be filed within one week after the date of publication.

Only clerical errors by the USPTO (e.g., a typographical error or omission, drawing printed upside down, or incorrectly stated data) can be corrected. The USPTO will review the applicant's request to verify the clerical error and determine whether the error can be corrected without jurisdiction being restored to the examining attorney or republication being required.

See [TMEP §§1505 et seq.](#) for information concerning post-publication amendments and when republication is required.

## 1503 Opposition

### 1503.01 Filing a Notice of Opposition

Any person who believes that he or she would be damaged by the registration of a mark on the Principal Register may oppose registration by filing a notice of opposition with the Board, and paying the required fee, within thirty days after the date of publication, or within an extension period granted by the Board for filing an opposition. See [15 U.S.C. §1063](#); [37 C.F.R. §§2.101-2.107](#); [TBMP §303](#).

The notice of opposition must include a concise statement of the reasons for the opposer's belief that the opposer would be damaged by the registration of the opposed mark, and must state the grounds for opposition. [37 C.F.R. §2.104\(a\)](#); [TBMP §309.03\(a\)\(2\)](#).

A notice of opposition to an application based on §1 or §44 of the Trademark Act must be filed through the Electronic System for Trademark Trials and Appeals (ESTTA) at <https://estta.uspto.gov/>. [37 C.F.R. §2.101\(b\)\(1\)](#). If ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, an opposition to an application based on §1 or §44 may be filed in paper form. [37 C.F.R. §2.101\(b\)\(2\)](#). The paper opposition must be filed by the due date set forth in [37 C.F.R. §2.101\(c\)](#) and must be accompanied by a paper petition to the Director under [37 C.F.R. §2.146](#), with the required fees and a showing that ESTTA was unavailable because of technical problems or that extraordinary circumstances are present. [37 C.F.R. §2.101\(b\)\(2\)](#); see *DFC Expo LLC*, 121 USPQ2d 1903, 1906 (TTAB2017) ; [TBMP §309.02](#). See [37 C.F.R. §2.197](#) and [§2.198](#), and [TMEP §305.02](#) and [§305.03](#) regarding certificate of mailing and Priority Mail Express® procedures and [TBMP §106.03](#) and [§107](#) for general information regarding permitted paper submissions with the Board.

A notice of opposition to an application based on §66(a) of the Act *must* be filed through ESTTA and may not be filed in paper form under any circumstances. [37 C.F.R. §2.101\(b\)\(3\)](#); [TBMP §309.01](#); see *In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019 (TTAB 2005).

A notice of opposition does not have to be verified, and it may be signed by either the opposer or the opposer's attorney. [37 C.F.R. §2.101\(b\)](#); [TBMP §309.02\(b\)](#).

### 1503.02 Joining Persons in an Opposition

Two or more persons may join in an opposition. [TBMP §303.06](#). Related companies are separate persons for the purpose of filing an opposition.

### 1503.03 Time for Opposing

An opposition must be filed within thirty days after the date of publication in the *Trademark Official Gazette* , or within an extension period granted by the Board. [15 U.S.C. §1063\(a\)](#); [37 C.F.R. §2.101\(c\)](#); [TBMP §§306-306.04](#). The time within which to file an opposition is set by statute and may not be extended or waived. *In re Kabushiki Kaisha Hitachi Seisakusho*, 33 USPQ2d 1477 (Comm'r Pats. 1994); *In re Cooper*, 209 USPQ 670 (Comm'r Pats. 1980); [TBMP §306.04](#).

When a registration is issued, inadvertently, from an application that was the subject of a timely filed notice of opposition, the Board is without authority to cancel the registration and restore it to application status.

In this situation, the Board will refer the registration file to the Office of the Deputy Commissioner for Trademark Examination Policy for appropriate action. See [TBMP §216](#). See also [TMEP §1609.10\(a\)](#) regarding correction of USPTO errors.

### 1503.04 Extension of Time to Oppose

Requests for extensions of time to oppose are handled by the Board. See [TBMP Chapter 200](#).

A request for an extension of time must be filed within thirty days after the date of publication in the *Trademark Official Gazette* , or within an extension period granted by the Board. [15 U.S.C. §1063\(a\)](#); [37 C.F.R. §2.102\(c\)](#); [TBMP §202.01](#). The time within which to file a request for extension of time to oppose is set by statute and may not be extended or waived. *In re Kabushiki Kaisha Hitachi Seisakusho*, 33 USPQ2d 1477 (Comm'r Pats. 1994 ) ; *In re Cooper*, 209 USPQ 670 (Comm'r Pats. 1980).



A request for extension of time to oppose an application based on §1 or §44 of the Trademark Act must be filed through ESTTA, at <https://estta.uspto.gov/>. [37 C.F.R. §2.102\(a\)\(1\)](#). If ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, a request to extend the opposition period for an application based on §1 or §44 may be filed in paper form. [37 C.F.R. §2.102\(a\)\(1\)](#); [TBMP §203.01\(a\)](#) The paper extension request must be filed by the due date set forth in [37 C.F.R. §2.101\(c\)](#) and must be accompanied by a paper Petition to Director under [37 C.F.R. §2.146](#), with the required fees and a showing that ESTTA was unavailable because of technical problems or that extraordinary circumstances are present. [37 C.F.R. §2.102\(a\)\(2\)](#). See [TBMP §106.03](#) and [§107](#) for general information regarding permitted paper submissions with the Board.

A request for extension of time to oppose a §66(a) application *must* be filed through ESTTA and may not be filed in paper form under any circumstances. [37 C.F.R. §2.102\(a\)\(1\)](#); [TBMP §203.01\(a\)](#); *see In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019 (TTAB 2005).

For additional information regarding filing a request for an extension of time to oppose, *see* [TBMP Chapters 200](#) and [300](#).

When a registration is issued, inadvertently, from an application that was the subject of an unexpired extension of time to oppose on the date of registration, the Board is without authority to cancel the registration and restore it to application status. *See* [TBMP §216](#). In this situation, a request to have the registration cancelled as inadvertently issued should be directed to the Office of the Deputy Commissioner for Trademark Examination Policy. *See* [TMEP §1609.10\(a\)](#) regarding correction of USPTO errors.

### 1503.05 Opposition to §66(a) Applications

Section 68(a)(2) of the Trademark Act, [15 U.S.C. §1141h\(a\)\(2\)](#), provides that a request for extension of protection is subject to opposition under §13 of the Trademark Act, [15 U.S.C. §1063](#). The USPTO must notify the International Bureau of the World Intellectual Property Organization (IB) within 18 months of the date the IB sends the request for extension of protection to the USPTO of: (1) a notification of refusal based on the filing of an opposition; or (2) a notification of the possibility that an opposition may be filed after expiration of the 18-month period. [15 U.S.C. §1141h\(c\)\(1\)\(B\)-\(C\)](#); *see* [TMEP §§1904.03, 1904.04](#).

An opposition to a §66(a) application, or a request for extension of time to oppose a §66(a) application, must be filed through ESTTA and may not be filed in paper form under any circumstances. [37 C.F.R. §§2.101\(b\)\(3\), 2.102\(a\)\(1\)](#); [TBMP §309.01](#); *see In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019 (TTAB 2005).

Once filed, an opposition to a §66(a) application may not be amended to add to the grounds for opposition, to add to the goods/services opposed, or to add a joint opposer. [37 C.F.R. §§2.104\(c\), 2.107\(b\)](#). The opposition is limited to the goods, services, grounds, and named opposers set forth in the ESTTA-generated opposition form cover sheet. [37 C.F.R. §§2.104\(c\), 2.107\(b\)](#) (“The grounds for opposition, the goods or services opposed, and the named opposers are limited to those identified in the ESTTA cover sheet regardless of what is contained in any attached statement.”) *CSC Holdings LLC v. SAS Optimhome*, 99 USPQ2d 1959, 1962 (TTAB 2011); *Hunt Control Sys., Inc. v. Koninklijke Philips Elec. N.V.*, 98 USPQ2d 1558, 1561-62 (TTAB 2011); *see* [TBMP §315](#).

## 1504 Jurisdiction over Application

### 1504.01 Jurisdiction of Examining Attorney

As a general rule, until publication of the mark in the *Trademark Official Gazette*, the examining attorney has jurisdiction over the application and can issue a refusal or a requirement without the approval of the Director. See [TMEP §1504.03](#) regarding action by the examining attorney after publication.

In addition, for applications under §1(b) of the Act, [15 U.S.C. §1051\(b\)](#), the examining attorney has jurisdiction after issuance of the notice of allowance under §13(b) of the Trademark Act, [15 U.S.C. §1063\(b\)](#), [37 C.F.R. §2.84\(a\)](#). See [TMEP §1107](#) regarding amendment of a §1(b) application during the period between issuance of a notice of allowance and filing of a statement of use.

There is a time period during which an examining attorney cannot issue an action in an application because the USPTO is unable to withdraw the mark from its scheduled publication in the *Trademark Official Gazette*.

The USPTO is generally unable to withdraw a mark within the twenty-day period before the scheduled publication date. See [TMEP §§1505-1505.02\(g\)](#) regarding the processing of amendments filed during this period.

### 1504.02 Jurisdiction of Trademark Trial and Appeal Board

The Board has jurisdiction over an application upon the filing of the notice of appeal. The Board may, in response to an examining attorney's request, on its own initiative, or upon request from the applicant, suspend the appeal and remand the application to the examining attorney. If an examining attorney wants to issue a new refusal or requirement during an appeal, the examining attorney must file a request for remand with the Board. [37 C.F.R. §2.142\(f\)\(6\)](#). See TBMP §§[1209.01](#), [1209.02](#); [TMEP §1504.05](#). See [TMEP §715.04\(a\) and \(b\)](#) regarding the examining attorney's action when an application is remanded after the filing of an appeal.

The Board also has jurisdiction over any application in which a notice of opposition has been filed or a concurrent use proceeding has commenced. [37 C.F.R. §2.133](#). The Board will approve or disapprove any amendments proposed during an inter partes proceeding. See [37 C.F.R. §2.133](#); [TBMP §§514-514.04](#); [TMEP §1505.01\(f\)](#).

In an application under §1 or §44 of the Act, if an examining attorney wants to issue a new refusal or requirement during an inter partes proceeding, the examining attorney must request that the Board suspend the proceedings and remand the application for further examination. [37 C.F.R. §2.130](#); [TBMP §515](#). In a §66(a) application, the examining attorney may not request a remand during an opposition. [TBMP §515](#); [TMEP §1504.05](#).

A request for an extension of time to file an opposition does not vest jurisdiction in the Board. In this situation, any request by the examining attorney for jurisdiction should be addressed to the Director. See [TMEP §§1504.03](#), [1504.04\(a\)](#).

The Board has no jurisdiction over a pending application that has been suspended pending disposition of the applicant's petition to cancel a registration cited under §2(d) of the Trademark Act (see [TMEP §716.02\(a\)](#)), or disposition of the applicant's opposition to an earlier-filed application cited as a potential bar to registration under §2(d) (see [TMEP §§716.02\(c\)](#), [1208.02\(c\)](#)). See [TBMP §605.03\(c\)](#). In either situation, if the applicant

wants to amend its pending application, or submit a consent agreement, the applicant must file the amendment or the consent agreement with the examining attorney, not with the Board. *Id.*

Once the Board has jurisdiction, if it is necessary to require an unrepresented foreign-domiciled party to appoint a qualified U.S. attorney, generally the Board will suspend the proceedings and inform the party of the time frame within which it must appoint a qualified U.S. attorney. [TBMP §114.01](#).

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

If it is found necessary (e.g., through internal quality review), for an examining attorney to refuse registration or to make a requirement after a mark has been published for opposition, jurisdiction over the application must be restored to the examining attorney.

With the exception of applications that are the subject of inter partes proceedings before the Board (*see* [TMEP §1504.05](#)), the examining attorney can telephone an applicant and issue an examiner's amendment without restoration of jurisdiction. However, to issue any other kind of Office action, even if merely asking for additional information, the examining attorney must have previously requested and been granted jurisdiction, because the request for additional information is a "requirement."

If it is necessary to issue an Office action after publication, the examining attorney must check the status of the application to determine whether the Board has received a notice of opposition. If a request for an extension of time to file an opposition has been filed, the examining attorney should prepare a request to restore jurisdiction, directed to the Director. *See* [TMEP §1504.04\(a\)](#). If a notice of opposition has been filed, jurisdiction is with the Board, and the examining attorney should file a request for remand, directed to the Board. *See* [TMEP §1504.05](#).

When it is necessary to issue an Office action after publication in a §1(a) application, but it is too late to withdraw the application from issuance of a registration, the examining attorney should bring the matter to the attention of the Office of the Deputy Commissioner for Trademark Examination Policy. After registration, the Deputy Commissioner may restore the application to pendency and refer it to the examining attorney for appropriate action.

*See* [TMEP §§1505-1505.02\(g\)](#) regarding amendments proposed by applicants after publication.

### **1504.04 Restoration of Jurisdiction to Examining Attorney by Director**

If it is necessary to refuse registration or to make a requirement after publication and prior to the filing of a notice of opposition or issuance of a notice of allowance, the examining attorney must request that the Director restore jurisdiction so that the examining attorney may take the specified action on the application. *See* [TMEP §1106.02](#) regarding action by the examining attorney after issuance of a notice of allowance.

Normally, the Director will restore jurisdiction to the examining attorney only if there has been a clear error (*see* [TMEP §706.01](#)). After publication of a mark, a restoration of jurisdiction to the examining attorney is possible only in the case of an application for registration on the Principal Register. A mark found registrable on the Supplemental Register is not published for opposition but is published only when it has registered.

The examining attorney does not have to request jurisdiction to act in a §1(b) application *after* issuance of the notice of allowance. If, after the notice of allowance issues, the examining attorney determines that he or she must issue a new refusal or requirement, the examining attorney must request cancellation of the

notice of allowance. However, the examining attorney should not make a refusal or requirement that could or should have been made during initial examination of the application unless the initial failure to make the refusal or requirement was a clear error, and must consult with the managing attorney or senior attorney before taking the action. See [TMEP §706.01](#) regarding “clear error” and [TMEP §1106.02](#) and [§1106.03](#) regarding action by the examining attorney after issuance of the notice of allowance and cancellation of the notice of allowance.

The provisions with respect to requesting jurisdiction over published §66(a) applications are similar to those for applications under §1(a) and/or §44 of the Trademark Act. [37 C.F.R. §2.84](#). However, when deciding whether to grant requests for jurisdiction of §66(a) applications, the Director must consider the time limits for notifying the IB of a refusal of a §66(a) application, set forth in Article 5(2) of the Madrid Protocol and §68(c) of the Trademark Act, [15 U.S.C. §1141h\(c\)](#). See [TMEP §1904.03\(a\)](#) for further information.

### **1504.04(a) Request for Jurisdiction**

The examining attorney’s request for jurisdiction should be in the form of a memorandum to the Director, accompanied by the Office action that the examining attorney proposes to send to the applicant. The request should be signed by the examining attorney and the managing attorney.

In the Office action, the examining attorney should apologize for the untimeliness of the action because, at this point, except for possible opposition issues, the applicant is expecting issuance of a registration or notice of allowance. The action should provide a detailed explanation of the basis for the refusal or requirement, citing appropriate case law even when addressing basic and well-established propositions.

### **1504.05 Remand to Examining Attorney by Trademark Trial and Appeal Board**

The Board, on its own initiative or in response to a request, may remand an application to the examining attorney for consideration of specific facts or issues. [TBMP §1209](#). Upon receipt of a remand from the Board, the examining attorney may not make a requirement or refuse registration on a ground not specified in the Board’s remand letter or submit evidence relating to a requirement or ground not specified in the Board’s remand letter. *In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1136 (TTAB 2015) ; [TBMP §1209.01](#).

When the Board initiates a remand, the examining attorney must take action upon the remanded issue within the time set by the Board in the remand order. [37 C.F.R. §2.142\(f\)\(1\)](#); [TBMP §1209.01](#).

A request for remand made by the examining attorney should succinctly explain the specific reasons why remand is requested. That is, the request should be a brief statement of the reason for the request and an explanation of the action the examining attorney intends to take. On remand, the examining attorney may address only those issues for which the application was remanded. If the examining attorney identifies additional issues other than those for which the application was remanded, the examining attorney must request an expanded remand to consider the additional issues. [TBMP §1209.02](#).

The following are examples of circumstances when the Board may remand an application to the examining attorney during an ex parte appeal:

- (1) When evidence that the applicant or the examining attorney wants to include in the record was not previously available (e.g., a recent article, newly issued registration, or recent decision).

- (2) When a new attorney for the applicant, or a new examining attorney, wants to supplement the record made by his or her predecessor.
- (3) When the applicant and the examining attorney agree to a remand.
- (4) When the examining attorney requests a remand to issue a new requirement or new ground for refusal of registration, or to reinstate a previously withdrawn requirement or refusal. [37 C.F.R. §2.142\(f\)\(6\)](#). Prior to submission of such a request for remand, however, the examining attorney must bring the matter to the attention of the managing and senior attorneys, who must then bring it to the attention of the Office of the Deputy Commissioner for Trademark Examination Policy. See [TBMP §1209.02](#) regarding an examining attorney's request for remand.

See also [TBMP §1207.02](#).

A request for remand by the examining attorney to submit additional evidence must include a showing of good cause (which may take the form of a satisfactory explanation as to why the evidence was not filed prior to appeal), and be accompanied by the additional evidence sought to be introduced. See [TBMP §1207.02](#). Absent a remand, no evidence should be submitted to the Board following a notice of appeal, except with or in response to an applicant's timely filed request for reconsideration. [37 C.F.R. §2.142\(d\)](#); [TBMP §1207.01](#). See [TBMP §1207.04](#) and [TMEP §715.03](#) regarding the submission of evidence with or in response to a request for reconsideration.

If the examining attorney finds it necessary to refuse registration or to make a requirement during an inter partes proceeding involving an application under §1 or §44 of the Trademark Act, the examining attorney must request the Board to remand the application. [37 C.F.R. §2.130](#). However, the examining attorney must bring the matter to the attention of the managing and senior attorneys, who must then bring it to the attention of the Office of the Deputy Commissioner for Trademark Examination Policy prior to submission of such a request for remand. In a §66(a) application, the examining attorney may not request a remand during an inter partes proceeding.

See [TBMP §1209](#) regarding remand during an appeal and [§515](#) regarding remand during an inter partes proceeding.

## **1505 Amendments Filed by Applicants After Publication**

Applicants sometimes submit amendments to the application after publication. For processing purposes, an "amendment after publication" includes any amendment filed during the time period in which the USPTO is unable to withdraw a mark from its scheduled publication in the *Trademark Official Gazette*, or from the scheduled issuance of its registration. The USPTO is generally unable to withdraw a mark unless the amendment is received and processed at least twenty days before the scheduled publication date or registration issue date.

The following sections discuss the USPTO's procedures and policies for the disposition of amendments after publication.

### **1505.01 Procedures for Processing Amendments Filed by the Applicant After Publication**

#### **1505.01(a) Requirement for Representation, and Form and Timing of Amendments**

*Requirement for Representation of Non-U.S.-domiciled Applicants.* An applicant's domicile will determine whether the applicant is required to be represented before the USPTO by an attorney who is an active member

in good standing of the bar of the highest court of a U.S. state, Commonwealth, or territory (a qualified U.S. attorney). [37 C.F.R. §§2.11\(a\), 11.1, 11.14\(e\)](#); [TMEP §601](#). An applicant whose domicile is not located within the United States or its territories must be represented by a qualified U.S. attorney. [37 C.F.R. §2.11\(a\)](#); [TMEP §601](#). See [TMEP §601](#) regarding determining domicile and [§602](#) regarding persons authorized to practice before the USPTO in trademark matters.

If the USPTO receives a post-publication amendment filed by an unrepresented foreign domiciliary, an attorney or paralegal in the Office of the Deputy Commissioner for Trademark Examination Policy will follow the procedures in [TMEP §601.01\(a\)](#) and grant the applicant 60 days to appoint a qualified U.S. attorney. If the applicant does not appoint a qualified U.S. attorney within the time allowed, the amendment will not be reviewed.

*Form of amendments.* All amendments filed after publication must be submitted in writing and signed by a proper party. [37 C.F.R. §2.193\(e\)\(2\)](#). Unless a notice of opposition has been filed, the USPTO generally requires that amendments filed after publication but before issuance of a registration or notice of allowance be filed using the TEAS Post-Publication Amendment form at <https://teas.uspto.gov/>.

Requests to correct minor typographical errors entered by the USPTO must also be submitted in writing and signed by a proper party using the same TEAS Post-Publication Amendment form. See [37 C.F.R. §2.193\(e\)\(2\)](#). Inquiries regarding the procedure for submitting a post-publication amendment, or questions regarding the status of a pending post-publication amendment, can be made by calling the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199 or emailing [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov).

Any amendment filed during the pendency of an inter partes opposition proceeding must be filed directly with the Board via ESTTA. See [TBMP §110.01](#); [TMEP §1505.01\(f\)](#).

*Timing of amendments.* The USPTO cannot process any amendment filed during the time periods in which the mark cannot be withdrawn from publication in the *Trademark Official Gazette* or from issuance of a registration. If a request for amendment relates to a mark that cannot be withdrawn from publication, it will be processed in accordance with the procedures set forth in [TMEP §1505.01\(b\)](#) through [§1505.02\(g\)](#). If a request for amendment relates to a mark that cannot be withdrawn from issuance of a registration, or that has already registered, the applicant will be instructed to resubmit its request to the Post Registration Section as a request to amend or correct the registration under §7 of the Trademark Act. [15 U.S.C. §1057](#); [37 C.F.R. §§2.6, 2.173\(a\), 2.174, 2.175](#).

See [TMEP §1107](#) and [§1107.01](#) regarding amendments to a §1(b) application filed between the issuance of a notice of allowance and the submission of a statement of use, and [TMEP §§1609-1609.12](#) regarding amendment of a registration under §7(e) of the Trademark Act.

### **1505.01(b) Processing Amendments to §1(a), §44, and §66(a) Applications in Cases Where No Opposition Has Been Filed and a Registration Certificate Has Not Yet Issued**

Amendments filed after publication will be reviewed by paralegal specialists in the Office of the Deputy Commissioner for Trademark Examination Policy. If necessary, the application will be withdrawn from issue to ensure that the mark does not register before the amendment has been considered. The paralegal specialists will consult with an attorney, if necessary.



**1505.01(b)(i) Acceptable Amendments**

If an amendment is acceptable and does not require republication of the mark, the paralegal specialist will enter the amendment and the mark will continue on to the scheduled issue date. See [TMEP §1505.03\(b\)](#) for examples of amendments that do not require republication.

If the amendment is acceptable and republication is required, the paralegal specialist must telephone or email the applicant and inform the applicant that the amendment is acceptable, but requires republication of the mark. If the applicant wishes to pursue the request, the paralegal specialist must enter a Note to the File in the record that the proposed amendment has been accepted, that republication is required, and that the applicant has agreed to the republication. The paralegal specialist will then enter the amendment and set a new publication date. A new notice of publication will be issued. See [TMEP §1505.03\(a\)](#) for examples of amendments that require republication.

**1505.01(b)(ii) Unacceptable Amendments**

If the paralegal specialist determines that an amendment is unacceptable, the paralegal specialist must provide written notification to the applicant, explaining why the amendment is unacceptable and advising the applicant that: (1) the application will be returned to processing without entry of the requested amendment; and (2) applicant's only recourse is to file a TEAS Petition to Director requesting that jurisdiction be restored to the examining attorney to consider the merits of the amendment. [37 C.F.R. §§2.84, 2.146](#). Any petition to the Director must be filed within six weeks of the publication date to ensure that it is timely processed. Thereafter, any request for amendment must be filed pursuant to §7 of the Trademark Act, [15 U.S.C. §1057](#).

**1505.01(c) Processing Amendments to §1(b) Applications in Cases Where No Opposition Has Been Filed and No Notice of Allowance Has Issued**

Amendments filed after publication and before issuance of a notice of allowance will be reviewed by paralegal specialists in the Office of the Deputy Commissioner for Trademark Examination Policy. If necessary, the application will be withdrawn from issue to ensure that the notice of allowance does not issue before the amendment has been considered.

**1505.01(c)(i) Acceptable Amendments**

If the amendment is acceptable and republication is not required, the paralegal specialist will enter the amendment and schedule the mark for issuance of a notice of allowance. See [TMEP §1505.03\(b\)](#) for examples of amendments that do not require republication.

If the amendment is acceptable and republication is required, a paralegal specialist must telephone or email the applicant and inform the applicant that the amendment is acceptable, but requires republication of the mark. If the applicant wishes to pursue the request, the paralegal specialist must enter a Note to the File in the record indicating that the proposed amendment has been accepted, that republication is required, and that the applicant has agreed to the republication. The paralegal specialist will then enter the amendment and set a new publication date. A new notice of publication will be issued. See [TMEP §1505.03\(a\)](#) for examples of amendments that require republication.

### **1505.01(c)(ii) Unacceptable Amendments**

If the paralegal specialist determines that the amendment is unacceptable, the paralegal specialist must provide written notification to the applicant explaining why the amendment is unacceptable and advising the applicant that: (1) the request to amend the application may be resubmitted with the statement of use; or (2) the applicant may file a TEAS Petition to Director under [37 C.F.R. §2.84](#) and [§2.146](#) requesting that jurisdiction be restored to the examining attorney to consider the merits of the amendment.

See [TMEP §§1107-1107.01](#) regarding amendments after issuance of the notice of allowance but before the filing of the statement of use.

### **1505.01(d) Processing Amendments Filed Between Issuance of the Notice of Allowance and Filing of Statement of Use**

Generally, the only amendments that will be entered in a §1(b) application between the issuance of a notice of allowance and the submission of a statement of use are those outlined in [TMEP §1107](#). See [37 C.F.R. §2.77\(a\)](#). All other amendments may be entered during this period only with the express permission of the Director, after consideration on petition under [37 C.F.R. §2.146](#). If the Director determines that the amendment requires review by the examining attorney, the petition will be denied and the amendment may be resubmitted with the statement of use in order for the applicant to preserve its right to review. [37 C.F.R. §2.77\(b\)](#). A petition is not required for amendments submitted as part of the statement of use. See [TMEP §§1107-1107.01](#) for further information about amendments filed between the issuance of a notice of allowance and the submission of a statement of use, [§1109.08](#) regarding examination of amendments submitted with a statement of use, and [Chapter 1700](#) regarding petitions to the Director.

### **1505.01(e) Processing Amendments in Cases Where a Request for Extension of Time to Oppose Has Been Filed or Granted**

An amendment of an application that is under an extension of time to file an opposition should be processed in accordance with the procedures set forth in [TMEP §1505.01\(b\)-\(d\)](#). See [TBMP §212.01](#). The Director retains jurisdiction of such an application until an opposition is actually filed.

It is not necessary for the paralegal specialist to notify the Board of the action taken on the amendment.

The Board will not suspend the potential opposer's time to file a notice of opposition in this situation. *Id.*

### **1505.01(f) Processing Amendments in Cases Where an Opposition Has Been Filed**

If the applicant files an amendment after a notice of opposition has been filed, the Board will act on the amendment under [37 C.F.R. §2.133](#). The Board has jurisdiction over any application in which an opposition has been filed. See [TBMP §§514-514.04](#) for further information about amending an application during an opposition.

## **1505.02 Types of Amendments After Publication**

The following subsections discuss the most common types of amendments after publication. Note that there are some restrictions on amendments to §66(a) applications, as discussed below. In addition, only certain amendments are permitted in §1(b) applications between the issuance of the notice of allowance and filing

of the statement of use absent the filing of a petition to the Director under [37 C.F.R. §2.146](#). See [37 C.F.R. §2.77](#); [TMEP §§1107, 1107.01](#).

See [TMEP §1505.01\(a\)](#) regarding the form and timing of filing amendments after publication and [§1609](#) regarding amendment of a registration under §7(e) of the Trademark Act.

### **1505.02(a) Amendments to the Identification**

If an applicant proposes to amend the identification after publication by *restricting* or *deleting* items in the existing identification, and the amendment is otherwise proper, the USPTO will approve the amendment, and the mark will not be republished. Amendments to add to or broaden the scope of an identification are not permitted at any time. See [37 C.F.R. §2.71\(a\)](#); [TMEP §§1402.07-1402.07\(e\)](#).

### **1505.02(b) Amendments to Classification**

In an application under §1 or §44, if the applicant proposes to amend the classification after publication, and the amendment is consistent with the current version of the *Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks*, the USPTO will approve the amendment. Republication is not required.

The international classification in a §66(a) application cannot be changed from the classification assigned by the IB. [37 C.F.R. §2.85\(d\)](#); see [TMEP §1401.03\(d\)](#).

### **1505.02(c) Amendments to Marks**

In an application under §1 or §44, if the applicant proposes to amend the mark after publication, the amendment is not a material alteration of the mark, and the specimen of record or foreign registration (if applicable) supports use of the mark as amended, the USPTO will approve the amendment and will not republish the mark. If the applicant proposes to amend the mark and the amendment represents a material alteration to the mark, the USPTO will not approve the amendment. See [37 C.F.R. §2.72](#); [TMEP §§807.13-807.13\(b\), 807.14-807.14\(f\)](#).

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

### **1505.02(d) Amendments to the Dates of Use**

If, in an application under §1(a), the applicant proposes to amend the dates of use to adopt a date of use that is after the filing date of the application, the USPTO will not approve the amendment. See [37 C.F.R. §2.71\(c\)\(1\)](#). If, in an application under §1(a), the applicant proposes to amend the dates of use to adopt a date of use that is later than the date originally stated, but before the application filing date, the USPTO will approve the amendment and will republish the mark to provide notice to parties who may have commenced use of a similar mark during the intervening period. If the applicant proposes to amend the dates of use to adopt a date that is before the date originally stated, the USPTO will approve the amendment and will not republish the mark. See [TMEP §903.04](#) for further information about amending the dates of use in a pending application, and [§1609.07](#) regarding amendment of the dates of use after registration.

## 1505.02(e) Amendments Adding or Deleting Disclaimers

If an applicant proposes to amend an application to insert a disclaimer after publication and before issuance of the notice of allowance or registration certificate, and the amendment is otherwise proper, the USPTO will approve the amendment and will not republish the mark. If the notice of allowance has issued, an amendment to insert a disclaimer may not be submitted as a post publication amendment. It must be submitted in a TEAS Petition to Director under Trademark Rule 2.146. See [37 C.F.R. §§2.77\(b\)](#), [2.146](#). Likewise, if the USPTO requests the insertion of a disclaimer after publication and the applicant agrees to the disclaimer, the USPTO will enter the disclaimer and will not republish the mark.

If an applicant proposes to amend the application to delete a disclaimer after publication and before issuance of the notice of allowance or registration certificate, and the USPTO determines that the amendment is acceptable, the USPTO will approve the amendment in accordance with the procedures in [TMEP §1505.01\(c\)\(i\)](#), and will republish the mark. If the amendment deleting the disclaimer is unacceptable, the USPTO will follow the procedures in [TMEP §1505.01\(c\)\(ii\)](#).

A request to delete a disclaimer after issuance of the notice of allowance and before the filing of a statement of use is not permitted. Between the issuance of the notice of allowance and the filing of a statement of use, the Office cannot republish the application or issue an Office action regarding the request. Instead, the applicant may submit the amendment with the statement of use.

Republishing is generally required when a disclaimer is deleted after publication (e.g., if printed through a clerical error or originally required by the examining attorney and later determined to be unnecessary).

*Exception:* If the applicant proposes to amend the mark after publication to delete matter that was the subject of a disclaimer (e.g., generic wording), the USPTO determines that the amendment is not a material alteration of the mark, and the applicant also requests that the disclaimer be deleted, republishing is not required.

## 1505.02(f) Amendment of the Basis

In an application that is not the subject of an inter partes proceeding before the Board, if an applicant wants to add or substitute a basis after publication, the applicant must file a TEAS Petition to Director to request that the examining attorney consider the amendment. If the Director grants the petition, and the examining attorney accepts the added or substituted basis, the mark must be republished. [37 C.F.R. §2.35\(b\)\(2\)](#); [TMEP §806.03\(j\)](#). See [TMEP §806.03](#) regarding amending the basis generally and [37 C.F.R. §2.133\(a\)](#) and [TBMP §514](#) regarding amending the basis of an application that is the subject of an inter partes proceeding before the Board.

In a §66(a) application, the applicant may not change the basis, unless the applicant meets the requirements for transformation under §70(c) of the Act, [15 U.S.C. §1141j\(c\)](#), and [37 C.F.R. §7.31](#). [37 C.F.R. §2.35\(a\)](#). See [TMEP §§1904.09-1904.09\(b\)](#) regarding transformation.

In a multiple-basis application, the applicant may delete a basis at any time prior to registration. [37 C.F.R. §2.35\(b\)\(1\)](#); [TMEP §806.04](#). No petition is required. See [TMEP §806.04\(a\)](#) regarding the deletion of a §1(b) basis after publication or issuance of the notice of allowance.

## 1505.02(g) Amendments to the Applicant's Name, Citizenship, or Entity Type

If an applicant proposes to amend an application after publication to correct an inadvertent error in the manner in which its name, entity type, or citizenship is set forth, and the amendment is otherwise proper, the USPTO will approve the amendment and will not republish the mark. See [TMEP §1201.02\(c\)](#) regarding correcting errors in how the applicant is identified, including examples of correctable and non-correctable errors in identifying the applicant.

## 1505.03 Republication for Opposition

The following sections list examples of post-publication amendments that require republication of the mark and those that do not require republication. If a mark that is the subject of a request for an extension of time to oppose will be republished, the paralegal specialist or the examining attorney who orders the republication must notify the Board that the mark will be republished. See [TBMP §214](#) regarding the effect of republication on marks that are republished during the original thirty-day opposition period or within a granted extension period.

### 1505.03(a) When Republication Is Required

Republication is required after entry of any acceptable post-publication amendment that expands the applicant's rights or would otherwise require notice to third parties. The following list, though not exhaustive, provides examples of amendments that would require republication of the mark:

- Amendment adds or substitutes a basis (*see* [37 C.F.R. §2.35\(b\)\(2\)](#));
- Unnecessary §2(f) claim is deleted;
- Unnecessary disclaimer is deleted;
- A product, service, or class was deleted by USPTO error and is reinserted into the application;
- A product, service, or class was deleted due to partial abandonment (*see* [TMEP §718.02\(a\)](#)) and is reinserted upon granting of petition to revive;
- Identification is amended to an identification that is narrower in scope than the published identification, but results in a material difference in the nature of the goods/services/collective membership organization (e.g., the mark published for “shoes” in Class 25 and the applicant then amends to “orthopedic shoes” in Class 10);
- An incorrect mark was published due to USPTO error;
- The effective filing date (*see* [TMEP §§206-206.04](#)) changes to a later date;
- The priority filing date under §44(d) (*see* [TMEP §1003](#)) is corrected to a later date;
- In a §1(a) application, either the date(s) of first use or the date(s) of first use in commerce is amended to a date(s) that is later than the date(s) stated (but earlier than the filing date of the application);
- In a §1(b) application for which an amendment to allege use has been filed, either the date(s) of first use or the date(s) of first use in commerce is amended to a date(s) that is later than the date(s) stated (but earlier than the filing date of the amendment to allege use);
- Application is amended to the Principal Register from the Supplemental Register;
- Application is amended from a trademark or service mark to certification mark or collective mark or vice versa;
- An application with a §44(e) basis is amended to rely on a different foreign registration after publication.

## 1505.03(b) When Republication Is Not Required

Republication is not required after entry of **acceptable** post-publication amendments in the following situations:

- The mark is amended, and the USPTO determines that the amendment is not a material alteration of the mark;
- A multiple-basis application is amended to delete a §1(b) basis;
- The priority filing date under §44(d) (*see* [TMEP §1003](#)) is corrected to an earlier date;
- Identification is amended to adopt an identification that is narrower in scope than the published identification and there is no material difference in the nature of the goods/services/collective membership organization (e.g., republication is not required if the mark published for “shoes” in Class 25 and the applicant amends to “shoes, namely, running shoes” in Class 25);
- An application that published on the Principal Register is amended to the Supplemental Register;
- The filing date (*see* [TMEP §§206-206.04](#)) is amended to an earlier date (*Note*: The filing date change must be approved by the Office of the Deputy Commissioner for Trademark Examination Policy.);
- The date(s) of first use or date(s) of first use in commerce is amended to adopt a date(s) that is earlier than the date(s) originally stated;
- The goods/services/collective membership organization published in the wrong class;
- A disclaimer is added;
- A §2(f) claim is added;
- The applicant’s name, citizenship, or entity type is amended to correct an inadvertent error;
- In a §1(b) application for which a statement of use has been filed, either the date(s) of first use or the date(s) of first use in commerce is amended to a date(s) that is later than the date(s) stated (but earlier than the statutory deadline for filing the statement of use);
- An amendment to show the dates of use in one or more classes for a multiple-class application that published without the dates showing in those classes, when the dates of use appeared on the allegation of use and are the same as or earlier than those that published for the other classes.
- A statement of concurrent use is added.

## 1506 Concurrent Use Registration Proceeding

A concurrent use registration proceeding is an inter partes proceeding in which the Board determines whether one or more applicants are entitled to concurrent registration. A concurrent registration is one with conditions and limitations, fixed by the Board, as to the mode or place of use of the applicant’s mark or the goods/services/collective membership organization on or in connection with which the mark is used. The Board conducts these proceedings after the mark has been published, and the Board determines whether or not concurrent use registrations should issue. *See* [TBMP Chapter 1100](#).

See [TMEP §§1207.04-1207.04\(g\)](#) regarding the procedure to be followed by examining attorneys in relation to concurrent use.

## 1507 Interference

### 15 U.S.C. §1066 Interference; declaration by Director.

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.



**15 U.S.C. §1068 Action of Director in interference, opposition, and proceedings for concurrent use registration or for cancellation.**

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 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 hereunder 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 2 of this Act. However, no final judgment shall be entered in favor of an applicant under section 1(b) before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 7(c).

An interference is a proceeding in which the Board determines which, if any, of the owners of conflicting applications (or of one or more applications and one or more registrations that are in conflict) is entitled to registration. See [15 U.S.C. §§1066, 1068](#); [TBMP §1001](#).

An interference can be declared only upon petition to the Director. However, the Director will grant such a petition only if the petitioner can show extraordinary circumstances that would result in a party being unduly prejudiced in the absence of an interference. The availability of an opposition or cancellation proceeding ordinarily precludes the possibility of undue prejudice to a party. Thus, a petitioner must show that there is some extraordinary circumstance that would make the remedy of opposition or cancellation inadequate or prejudicial to the party's rights. Interferences are generally limited to situations where a party would otherwise be required to engage in successive or a series of opposition or cancellation proceedings, and where the issues are substantially the same. See *In re Family Inns of Am., Inc.*, 180 USPQ 332 (Comm'r Pats. 1974).

The following matters are not subject to interference: (1) registrations on the Supplemental Register; (2) applications for registration on the Supplemental Register; (3) registrations under the Act of 1920; and (4) registrations of marks that have become incontestable.

See [TMEP §§1208.03-1208.03\(c\)](#) and [TBMP Chapter 1000](#) for more information about interferences.