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101 Applicable Authority

101.01 Statute and Rules of Practice

All proceedings before the Trademark Trial and Appeal Board (“Board”) are governed by the Lanham Trademark Act of 1946, as amended, (“Trademark Act”), [15 U.S.C. § 1051](#) et seq.; the rules of practice in trademark cases (commonly known as the Trademark Rules of Practice), which may be found in Parts 2 and 7 of Title 37 of the Code of Federal Regulations (“C.F.R.”); the rules pertaining to assignments in trademark cases, which may be found in Parts 3 and 7 of 37 C.F.R.; and the rules relating to the conduct of practitioners and the representation of others before the United States Patent and Trademark Office (“USPTO”) which may be found in Part 11 of 37 C.F.R. The USPTO rules governing procedure in inter partes proceedings before the Board are adapted, in large part, from the Federal Rules of Civil Procedure, with modifications due primarily to the administrative nature of Board proceedings. [Note 1.]

A copy of Title 37 of the C.F.R. may be obtained at a nominal cost from the U.S. Government Printing Office. An electronic version of Title 37 of the C.F.R. may be found online at the Government Printing Office website through: <https://www.gpo.gov/fdsys/browse/collectiontab.action> or on the USPTO website at: <https://www.uspto.gov/sites/default/files/documents/tmlaw.pdf>.

Information regarding proposed and final rule changes to Title 37 is also posted on the USPTO website at <https://www.uspto.gov/trademark/trademark-updates-and-announcements/recent-and-upcoming-statutory-and-regulatory-changes>.

NOTES:

1. *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988).

101.02 Federal Rules

[37 C.F.R. § 2.122\(a\)](#) **Applicable rules.** *Unless the parties otherwise stipulate, 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. When evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.*

[37 C.F.R. § 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.*

Inter partes proceedings before the Board are also governed by the Federal Rules of Civil Procedure, except as otherwise provided in the Trademark Rules of Practice, and “wherever applicable and appropriate,” [Note 1], and by the Federal Rules of Evidence. [Note 2.]

There is no provision in the Trademark Rules of Practice concerning the applicability of the Federal Rules of Evidence to ex parte appeals before the Board. However, certain of the principles embodied in the Federal Rules of Evidence are applied by the Board, in practice, in evaluating the probative value of evidence submitted in ex parte cases. [Note 3.] See [TBMP § 1208](#).

NOTES:

1. [37 C.F.R. § 2.116\(a\)](#). See *Multisorb Technology Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013) (Consistent with 37 C.F.R. § 2.116(a), the Board also generally follows settled federal practice when deciding cases raising procedural issues that fall within the interstices between the provisions in the Federal Rules, the C.F.R., and the Trademark Board Manual of Procedure). See also *Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1326 (TTAB 2011) (citing 37 C.F.R. § 2.116(a)).

2. [37 C.F.R. § 2.122\(a\)](#). See *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S. 138, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015) (proceedings before the TTAB are largely governed by the Federal Rules of Civil Procedure and Evidence); *Centroamericana, S.A. v. Cervceria India, Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1311 (Fed. Cir. 1989) (In applying the burden of proof provisions of Fed. R. Evid. 301, the court stated “[t]he Federal Rules of Evidence generally apply to TTAB proceedings.”). See, e.g., *Double Coin Holdings Ltd. v. Tru Development*, 2019 USPQ2d 377409, at *3, 4 (TTAB 2019) (Fed. R. Evid. 602, 701 and 1006); *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1117 (TTAB 2009) (applying Fed. R. Evid. 201); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1956 (TTAB 2008) (Fed. R. Evid. 801); *Bass Pro Trademarks LLC v. Sportsman’s Warehouse Inc.*, 89 USPQ2d 1844, 1861 (TTAB 2008) (Fed. R. Evid. 701); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1104-05 (TTAB 2007) (Fed. R. Evid. 803 and 1004); *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1264-65 (TTAB 2003) (Fed. R. Evid. 612); *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1405 (TTAB 1998) (Fed. R. Evid. 902); *HRL Assoc. Inc. v. Weiss Assoc. Inc.*, 12 USPQ2d 1819, 1822 (TTAB 1989) (Fed. R. Evid. 408); *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445, 1448, n.20 (TTAB 1986) (Fed. R. Evid. 401).

3. See, e.g., *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859, 1860 (Fed. Cir. 1987) (articles from general and business publications are not hearsay and are probative of descriptive usage); *In re Broadway Chicken, Inc.*, 38 USPQ2d 1559, 1565 (TTAB 1996) (listings from telephone directories and Dun & Bradstreet databases are not inadmissible hearsay); *In re American Olean Tile Co.*, 1 USPQ2d 1823, 1824 n.2 (TTAB 1986) (affidavit consisting of third-hand report by unidentified person is inadmissible hearsay); *In re Foundry Products, Inc.*, 193 USPQ 565, 567 (TTAB 1976) (third-party registrations not considered when copies were not made of record).

101.03 Decisional Law

Proceedings before the Board are also governed, to a large extent, by precedential decisions in prior cases. These decisions include those of the Board itself, as well as the decisions of the Court of Appeals for the Federal Circuit (“Federal Circuit”) (which determines appeals from decisions of the Board); the Court of Customs and Patent Appeals (predecessor of the Court of Appeals for the Federal Circuit); and the Director of The United States Patent and Trademark Office (formerly the Commissioner of Patents and Trademarks) (“Director”), who determines petitions seeking review of Board actions on procedural matters.

The Board relies primarily on precedent from the Court of Appeals for the Federal Circuit. The Federal Circuit is the Board’s primary reviewing court since by statute, any applicant or party to an inter partes proceeding who is dissatisfied with the Board’s decision may seek review of the decision in the Federal Circuit. Also the Federal Circuit’s cases address registration issues more specifically. [Note 1.]

Decisions of the Board, the Director, and the Court of Appeals for the Federal Circuit appear in the United States Patents Quarterly (“USPQ”), Bloomberg Law database, [Note 2], and may also be found in LexisNexis Corporation’s LEXIS/NEXIS legal database, and in the Intellectual Property Library of ThomsonReuters Corporation’s WESTLAW database. Board decisions are also available on public electronic databases at

the Board home page of the USPTO website at <https://e-foia.uspto.gov/Foia/TTABReadingRoom.jsp> (final decisions), and at TTABVUE <http://ttabvue.uspto.gov/ttabvue/> (docket information and full images of Board files).

Decisions that are designated by the Board “citable as precedent,” “precedent of the Board,” “Precedent of the TTAB,” or “for publication in full” are citable as precedent. Decisions which are not so designated, or which are designated for publication only in digest form, are not binding on the Board, but may be cited for whatever persuasive weight to which they may be entitled. Decisions of other tribunals may be cited to the extent allowed and for the purposes permitted by the tribunal that issued the decision. “Citation to all TTAB decisions should be to the United States Patent Quarterly, if the decision appears therein; otherwise, to a USPTO public electronic database [as listed above]. If a non-precedential decision does not appear in the United States Patents Quarterly or the USPTO’s public electronic databases, the citing party should append a copy of the decision to the motion or brief in which the decision is cited.” [Note 3.]

Any cited decision of the Board or another court, which appears in the USPQ, should include a citation to the USPQ, in addition to citation to an official reporter (if any), such as the Federal Reporter or Federal Supplement. [Note 3.] See [TBMP § 801.03](#) (inter partes briefs); [TBMP § 1203.02\(f\)](#)(ex parte briefs).

NOTES:

1. *Grand Canyon West Ranch LLC v. Hualapai Tribe*, 88 USPQ2d 1501, 1506 n.2 (TTAB 2008). See also 15 U.S.C. § 1071(a); 28 U.S.C. § 1295(a)(4)(B).
2. Bloomberg Law ceased publishing the USPQ in print form in December 2018.
3. *Citation of Opinions to the Trademark Trial and Appeal Board*, O.G. Notice (Jan. 23, 2007). The final decisions of the Board are posted at <https://e-foia.uspto.gov/Foia/TTABReadingRoom> and files of Board proceedings are available at <http://ttabvue.uspto.gov/ttabvue/>. See also *In re Fiat Group Marketing & Corporate Communications S.p.A.*, 109 USPQ2d 1593, 1596 n.6 (TTAB 2014) (non-precedential decisions are not binding on the Board, but may be cited to and considered for whatever persuasive value they may hold); *In re the Procter & Gamble Co.*, 105 USPQ2d 1119, 1121 (TTAB 2012) (no prohibition against citing to non-precedential opinions, but the Board does not encourage this practice); *In re Luxuria s.r.o.*, 100 USPQ2d 1146, 1151 n.7 (TTAB 2011) (parties may cite to non-precedential decisions, but they are not binding on the Board); *Corporacion Habanos SA v. Rodriquez*, 99 USPQ2d 1873, 1875 n.5 (TTAB 2011) (although parties may cite to non-precedential cases, the Board does not encourage the practice).
4. See *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1830 (TTAB 2012) (include citation to the *United States Patent Quarterly* (USPQ) if the case appeared in that reporter); *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1736 n.11 (TTAB 2012) (same); *In re Carlson*, 91 USPQ2d 1198, 1199 (TTAB 2009) (same).

101.04 Director’s Orders and Notices

Occasionally, the Director or another USPTO official acting under the Director’s authority, publishes in the Official Gazette an order or notice relating to a particular Office policy, practice, procedure, or other such matter of interest to the public. Some of these orders and notices affect practice and procedure before the Board. Such notices are also posted on the Office’s website at <https://www.uspto.gov/trademark/trademark-updates-and-announcements/recent-postings>.

101.05 Trademark Trial and Appeal Board Manual of Procedure

The Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) (i.e., this Manual) is a compilation of statutory, regulatory, and decisional authority relevant to Board practice and procedure. It is written as a guide for both the Board and practitioners. In addition to compiling applicable authority, the TBMP includes many practical suggestions on practice before the Board. Nonetheless, the TBMP “does not modify, amend, or serve as a substitute for any statutes, rules or decisional law and is not binding upon the [TTAB].” [Note 1.]

The TBMP is revised annually to incorporate changes in applicable statutes, rules, and case law, and to reflect changes in Board practice. [Note 2.] Practitioners consulting the TBMP should keep the publication date of the current revision in mind, and conduct any research necessary to determine whether there have been any relevant changes in the law since publication.

The TBMP is not – nor is it intended to be – a comprehensive reference on all aspects of the procedural or substantive law applicable to Board proceedings. Parties are urged to conduct appropriate legal research as needed.

NOTES:

1. *Rosenruist-Gestao E Servicos LDA v. Virgin Enterprises Ltd.*, 511 F.3d 437, 85 USPQ2d 1385, 1393 (4th Cir. 2007) (quoting TBMP Introduction). *See also El Encanto, Inc. v. Hatch Chile Co.*, 825 F.3d 1161, 119 USPQ2d 1139, 1143 (10th Cir. 2016) (quoting in part from TBMP Introduction). *Cf. In re Sones*, 590 F.3d 1282, 93 USPQ2d 1118, 1123 (Fed. Cir. 2009) (“the TMEP is instructive, but ‘is not established law,’”) (*citing In re Pennington Seed, Inc.*, 466 F.3d 1053, 80 USPQ2d 1758, 1763 (Fed. Cir. 2006)) (“While the TMEP is not established law, but only provides instructions to examiners, it does represent the PTO’s established policy on varietal names that is entitled to our respect.”).

2. The Board welcomes suggestions for improving the content of the TBMP. Suggestions and comments should be addressed to:

ATTN: TBMP Editor
U.S. Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Suggestions may be submitted electronically to: TBMPComments@uspto.gov.

102 Nature of Board Proceedings

102.01 Jurisdiction of Board

The Trademark Trial and Appeal Board is an administrative tribunal of the United States Patent and Trademark Office. The Board is empowered to determine only the right to register. [Note 1.] The Board’s determination of registrability does not require in every instance a decision on every pleaded claim, and the Board uses its discretion to decide only those claims necessary to enter judgment and dispose of the case. [Note 2.]

The Board is not authorized to determine the right to use, nor may it decide broader questions of infringement or unfair competition. [Note 3.]

The Board, being an administrative tribunal, has no authority to declare any portion of the Act of 1946, or any other act of Congress, unconstitutional. [Note 4.] But this does not mean that parties who want to raise challenges to an act of Congress or other Constitutional claims should not include them in their pleadings. Like other claims, Constitutional claims should be raised before the Board to consider in the first instance to avoid waiving them. [Note 5.] Where a party raises a constitutional claim, the Board may address the claim or issues raised by the claim, including any factual or statutory premises underlying the claim. [Note 6.]

NOTES:

1. Trademark Act § 17, [15 U.S.C. § 1067](#), Trademark Act § 18, [15 U.S.C. § 1068](#), Trademark Act § 20, [15 U.S.C. § 1070](#), Trademark Act § 24, [15 U.S.C. § 1092](#). See *Conolty v. Conolty O'Connor NYC LLC*, 111 USPQ2d 1302, 1309 (TTAB 2014); *Blackhorse v. Pro-Football, Inc.*, 111 USPQ2d 1080, 1082-83 (TTAB 2014).

2. *Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013).

3. *FirstHealth of the Carolinas Inc. v. CareFirst of Md. Inc.*, 479 F.3d 825, 81 USPQ2d 1919, 1921 (Fed. Cir. 2007) (quoting TBMP); *Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car Inc.*, 300 F.3d 1333, 66 USPQ2d 1811, 1819-20 (Fed. Cir. 2003) (no jurisdiction to decide issues arising under state dilution laws), *aff'g* 62 USPQ2d 1857, 1858 (TTAB 2002); *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1481 (Fed. Cir. 1990) (Board cannot adjudicate unfair competition issues); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 (TTAB 2011) (no authority to determine the right to use, or the broader questions of infringement, unfair competition, damages or injunctive relief); *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1216 (TTAB 2006) (“[T]he Board’s jurisdiction is limited to determining whether trademark registrations should issue or whether registrations should be maintained; it does not have authority to determine whether a party has engaged in criminal or civil wrongdoings.”), *aff'd unpub'd*, 240 F. App'x 865 (Fed. Cir. July 11, 2007), *cert. denied*, 552 U.S. 1109 (2008); *Carano v. Vina Concha Y Toro S.A.*, 67 USPQ2d 1149, 1151-52 (TTAB 2003) (no jurisdiction to determine copyright infringement; opposer’s claim that applicant neither owns nor is entitled to use mark was not separable from opposer’s copyright claim); *Ross v. Analytical Technology Inc.*, 51 USPQ2d 1269, 1270 n.2 (TTAB 1999) (no jurisdiction over unfair competition claims); *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1771 n.5 (TTAB 1994) (no jurisdiction over claims of trademark infringement and unfair competition), *aff'd mem.*, 108 F.3d 1392 (Fed. Cir. 1997); *Kelly Services Inc. v. Greene's Temps. Inc.*, 25 USPQ2d 1460, 1464 (TTAB 1992) (not empowered to render declaratory judgment); *Andersen Corp. v. Therm-O-Shield International, Inc.*, 226 USPQ 431, 432 n.5 (TTAB 1985) (may not entertain any claim based on Trademark Act § 43(a)); *Electronic Water Conditioners, Inc. v. Turbomag Corp.*, 221 USPQ 162, 163-64 (TTAB 1984) (unfair competition and Trademark Act § 43(a) claims are outside the Board’s jurisdiction); *Hershey Foods Corp. v. Cerreta*, 195 USPQ 246, 252 (TTAB 1977) (determination of whether opposer is guilty of unfair business practices is not within the province of the Board); *Yasutomo & Co. v. Commercial Ball Pen Co.*, 184 USPQ 60, 61 (TTAB 1974) (no jurisdiction to address anti-trust issues); *American-International Travel Service, Inc. v. AITS, Inc.*, 174 USPQ 175, 179 (TTAB 1972) (no jurisdiction to determine whether opposer violated criminal statute).

But see Loglan Institute Inc. v. Logical Language Group Inc., 962 F.2d 1038, 22 USPQ2d 1531, 1534 (Fed. Cir. 1992) (Board may have erred in stating that it lacked jurisdiction over equitable defenses which were based on allegations of trademark infringement and unfair competition); *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641, 647 (Fed. Cir. 1983) (regarding Board’s authority to consider an agreement, its construction, or its validity if necessary to decide the issues properly before it, including the issue of estoppel); *Knickerbocker Toy Co. v. Faultless Starch Co.*, 467 F.2d 501, 175 USPQ 417, 423

(CCPA 1972) (Board is not precluded from passing on the validity of a copyright if it is necessary to do so in the course of the exercise of its statutory jurisdiction); *Diaz v. Servicios De Franquicia Pardo's S.A.C.*, 83 USPQ2d 1320, 1326 (TTAB 2007) (Board has jurisdiction over assertion of priority under Article 7 of the Pan American Convention because it pertains expressly to the registrability of marks and priority rights based on use); *M-5 Steel Manufacturing Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086, 1094-95 (TTAB 2001) (contractual estoppel considered); *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701, 1702 (TTAB 2000) (noting that by rule change effective August 5, 1999, the 1946 Act was amended to allow parties to bring dilution claims under Trademark Act § 43(c) in opposition and cancellation proceedings); *British-American Tobacco Co. v. Philip Morris Inc.*, 55 USPQ2d 1585, 1589 (TTAB 2000) (a claim under Article 8 of the Pan American Convention is within the jurisdiction of the Board because it pertains expressly to the registrability of marks and provides for the cancellation of registrations).

See also The Scotch Whiskey Association v. United States Distilled Products Co., 13 USPQ2d 1711, 1715 (TTAB 1989), *recon. denied*, 17 USPQ2d 1240, 1243 (TTAB 1990) (Board cannot consider claims of unfair competition standing alone, but can consider such claims in determining the registrability of a mark, that is, in determining a separate, properly pleaded ground for opposition or cancellation), *dismissed*, 18 USPQ2d 1391, 1394 (TTAB 1991) (where petitioner did not plead a separate ground on which to base the petition to cancel, petitioner's claims under Articles 10 and 10 *bis* of the Paris Convention could not be considered), *rev'd on other grounds*, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991).

4. *In re District of Columbia*, 101 USPQ2d 1588, 1602 (TTAB 2012) (no authority to declare provisions of the Trademark Act unconstitutional), *aff'd sub nom. In re City of Houston*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013); *Blackhorse v. Pro-Football Inc.*, 98 USPQ2d 1633, 1638 (TTAB 2011) (same); *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1710 (TTAB 1999) (same), *rev'd on other grounds*, 284 F. Supp. 2d 96, 68 USPQ2d 1225 (D.D.C. 2003); *Hawaiian Host, Inc. v. Rowntree MacKintosh PLC*, 225 USPQ 628, 630 (TTAB 1985) (no authority to declare Trademark Act § 44(e) unconstitutional); *Electric Storage Battery Co. v. Mine Safety Appliances Co.*, 143 USPQ 163, 167 (TTAB 1964) (no authority to find Trademark Act § 23 unconstitutional).

5. *Elgin v. Department of Treasury*, 567 U.S. 1, 22–23 (2012) (noting that an agency could “apply its expertise” to the “many threshold questions that may accompany a constitutional claim,” and that an agency’s “statutory interpretation could alleviate constitutional concerns”); *In re DBC*, 545 F.3d 1373, 1378-80 (Fed. Cir. 2008) (holding that a party forfeited an Appointments Clause challenge that it failed to present to the agency in the first instance).

6. *In re ADCO Industries-Technologies L.P.*, 2020 USPQ2d 53786, at *9-11 (TTAB 2020) (addressing applicant's argument that 15 U.S.C. §§ 1052(a) and (c) are unconstitutional because they violate the First Amendment to the United States Constitution).

102.02 Types of Board Proceedings

The Board has jurisdiction over four types of inter partes proceedings, namely, oppositions, cancellations, interferences, and concurrent use proceedings.

An opposition is a proceeding in which the plaintiff seeks to prevent the issuance of a registration, in whole or in part, of a mark on the Principal Register. “Any person who believes that he would be damaged by the registration of a mark” may file an opposition thereto, but the opposition may be filed only as a timely response to the publication of the mark, in the Official Gazette of the United States Patent and Trademark Office. [Note 1.] *See* [TBMP § 303](#) (Who May Oppose or Petition to Cancel).

A cancellation proceeding is a proceeding in which the plaintiff seeks to cancel an existing registration, in whole or in part, of a trademark on the Principal Register or the Supplemental Register. A petition for cancellation may only be filed after the issuance of the registration. A petition for cancellation may be filed by “any person who believes that he is or will be damaged by the registration” of the mark. [Note 2.] See [TBMP § 303](#) (Who May Oppose or Petition to Cancel).

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 which are in conflict), is entitled to registration. [Note 3.] The proceeding is declared by the Office only upon Petition to the Director showing extraordinary circumstances therefor, that is, that the party who filed the petition would be unduly prejudiced without an interference. [Note 4.] See [TBMP § 1002](#) (Declaration of Interference). Ordinarily, the availability of an opposition or cancellation proceeding is deemed to prevent any undue prejudice from the unavailability of an interference proceeding. [Note 5.] An interference that has been declared by the Director is not instituted by the Board until after all of the marks that are to be involved in the proceeding have been published in the Official Gazette for opposition. See [TBMP § 1003](#). For further information, see [TBMP Chapter 1000](#) (Interferences).

A concurrent use proceeding is a proceeding in which the Board determines whether one or more applicants is entitled to a concurrent registration on the Principal Register, that is, a registration with conditions and limitations, fixed by the Board, as to the mode or place of use of the applicant’s mark or the goods and/or services on or in connection with which the mark is used (usually, a concurrent registration is restricted as to the territory which it covers). See [TBMP § 1101.01](#). The proceeding may be initiated only through the filing of an application for registration as a lawful concurrent user, and is instituted by the Board only after each of the one or more involved applications has been published for opposition in the Official Gazette, and all oppositions thereto (if any) have been withdrawn or dismissed. See [TBMP § 1102.01](#) and [TBMP § 1105](#). For further information, see [TBMP Chapter 1100](#) (Concurrent Use Proceedings).

The Board also has jurisdiction over ex parte appeals, that is, appeals from an examining attorney’s final refusal to register a mark in an application. [Note 6.] See [TBMP Chapter 1200](#) (Ex Parte Appeals).

NOTES:

1. Trademark Act § 13, [15 U.S.C. § 1063](#), Trademark Act § 12(a) [15 U.S.C. § 1062 \(a\)](#), Trademark Act § 18, [15 U.S.C. § 1068](#).
2. Trademark Act § 14, [15 U.S.C. § 1064](#), Trademark Act § 18, [15 U.S.C. § 1068](#), Trademark Act § 24, [15 U.S.C. § 1092](#).
3. Trademark Act § 16, [15 U.S.C. § 1066](#), Trademark Act § 18, [15 U.S.C. § 1068](#).
4. Trademark Act § 16, [15 U.S.C. § 1066](#); [37 C.F.R. § 2.146\(a\)\(4\)](#).
5. Removal of Rules Governing Trademark Interferences 82 Fed. Reg. 48469, 48470 (Oct. 18, 2017).
6. Trademark Act § 12(b), [15 U.S.C. § 1062\(b\)](#), Trademark Act § 20, [15 U.S.C. § 1070](#); [37 C.F.R. § 2.141](#), [37 C.F.R. § 2.142](#).

102.03 General Description of Board Proceedings

An inter partes proceeding before the Board is similar to a civil action in a federal district court. There are pleadings (at least in an opposition or cancellation proceeding); a wide range of possible motions; conferencing; disclosures; discovery; trial; briefs; and, if requested, an oral hearing, followed by a decision on the case. [Note 1.] However, because the Board is an administrative tribunal, its rules and procedures necessarily differ in some respects from those prevailing in the federal district courts. [Note 2.] *See also* [TBMP § 502.01](#) (Available Motions) and [TBMP § 702](#) (Pretrial Disclosures; Manner of Trial; and Introduction of Evidence). The principal difference is that proceedings before the Board are conducted in writing, and the Board's actions in a particular case are based upon the written record therein. For example, the Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. Indeed, a party to a proceeding before the Board need never come to the offices of the Board at all, unless the Board requests that the parties meet with the Board at its offices for a pretrial conference pursuant to [37 C.F.R. § 2.120\(j\)](#), or unless the party wishes to argue its case at oral hearing (an oral hearing is held only if requested by a party to the proceeding). Parties may stipulate to expediting the proceeding in whole or in part utilizing Accelerated Case Resolution (ACR). *See* [TBMP § 528.05\(a\)\(2\)](#), [TBMP § 702.04](#), and [TBMP § 705](#).

An ex parte appeal, being appellate in nature, is a much simpler and shorter procedure, involving only the filing of briefs by the applicant and examining attorney, and, if requested by the applicant, an oral hearing. *See* [TBMP Chapter 1200](#) (Ex Parte Appeals).

“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 [the] administrative trademark judges...” [Note 3.] This Manual refers to these statutory members of the Board collectively as “judges.”

Interlocutory motions, requests, conceded matters, and other matters not actually or potentially dispositive of a proceeding may be acted upon by a single Board judge, or by a single interlocutory attorney (“attorney”) or paralegal to whom such authority has been delegated, and certain conceded and non-dispositive matters may be acted on automatically by ESTTA. [Note 4.] Decisions on the merits of a case, and on complex or contested motions that are potentially dispositive of the case, are rendered by a panel of at least three Board judges. [Note 5.] Stipulations or consented (or uncontested) motions to dispose of the proceeding in a certain manner may be decided per curiam by the Board. [Note 6.] Institution orders, stipulated scheduling motions, issuance of notices of default, and other administrative matters may be acted upon by Board paralegals or may be administered through ESTTA. [Note 7.] Motions disposed of orders entitled “By the Trademark Trial and Appeal Board” have the same legal effect as orders by a panel of three Administrative Trademark Judges of the Board. [Note 8.] The parties must enter their changes of address and representation using ESTTA. For further information regarding ESTTA, see [TBMP § 110](#).

NOTES:

1. *See B&B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S. 138, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988) (USPTO rules governing the procedures are designed to approximate the proceedings in a courtroom trial).

2. *See B&B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S.138, 135 S.Ct. 1293, 113 USPQ2d 2045, 2049 (2015); *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004

(Fed. Cir. 1988); *La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234, 235 (Comm’r 1976) (“The procedures followed by the Board are not like the procedures in a courtroom and the applicability of the Federal Rules of Civil Procedure must be judged in that light...”).

3. Trademark Act § 17(b), [15 U.S.C. § 1067\(b\)](#).

4. [37 C.F.R. § 2.127\(c\)](#).

5. [37 C.F.R. § 2.129\(a\)](#), [37 C.F.R. § 2.142\(e\)\(1\)](#). See *Fifth Generation Inc. v. Titomirov Vodka LLC*, 2019 USPQ2d 418666, at *3 (TTAB 2019) (Board will not decide potentially dispositive motion by telephone; such motions must issue by panel or per curiam).

6. See *Fifth Generation Inc. v. Titomirov Vodka LLC*, 2019 USPQ2d 418666, at *3 (TTAB 2019) (potentially dispositive motions may issue per curiam).

7. [37 C.F.R. § 2.2\(g\)](#).

8. [37 C.F.R. § 2.127\(c\)](#).

103 Location and Address of Board

The Board is located at 600 Dulany Street, Alexandria, Virginia 22313-1451. The mailing address of the Board is:

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451.

104 Business to be Conducted in Writing

[37 C.F.R. § 2.190\(b\)](#) *Electronic trademark documents.* ... Documents that relate to proceedings before the Trademark Trial and Appeal Board must be filed electronically with the Board through ESTTA.

[37 C.F.R. § 2.191](#) *Action of the Office based on the written record.* All business with the Office must be transacted in writing. The action of the Office will be based exclusively on the written record. No consideration will be given to any alleged oral promise, stipulation, or understanding when there is disagreement or doubt.

With the exceptions of discovery conferences with Board participation, see [TBMP § 401.01](#), and telephone conferences, see [TBMP § 413.01](#) and [TBMP § 502.06](#), all business with the Board should be transacted in writing. [37 C.F.R. § 2.191](#) The personal attendance of parties or their attorneys or other authorized representatives at the offices of the Board is unnecessary, except in the case of a pretrial conference as provided in [37 C.F.R. § 2.120\(j\)](#), or upon oral argument at final hearing, if a party so desires, as provided in [37 C.F.R. § 2.129](#). Decisions of the Board will be based exclusively on the written record before it. [Note 1.] Documents filed in proceedings before the Board must be filed through ESTTA. [37 C.F.R. § 2.190\(b\)](#). See [TBMP § 110.01\(a\)](#).

Board proceedings are conducted in English. If a party intends to rely upon any submissions that are in a language other than English, the party should also file a translation of the submissions. If a translation is not filed, the submissions may not be considered. [Note 2.]

NOTES:

1. *Cf. In re Sovran Fin. Corp.*, 25 USPQ2d 1537, 1538 (Comm’r 1992) (regarding actions taken by examining attorneys); *In re Merck & Co.*, 24 USPQ2d 1317, 1318 n.2 (Comm’r 1992) (regarding oral representation by Board employee); *In re Investigacion Y Desarrollo de Cosméticos S.A.*, 19 USPQ2d 1717, 1719 (Comm’r 1991).

2. *See, e.g., Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477 (TTAB 2017) (while translations must be signed by person making translation, they need not be certified to be considered; certification is a suggested better practice); *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1734 n.8 (TTAB 2012) (noting that printed publications submitted in a foreign language without translations are of limited probative value); *Johnson & Johnson v. Obschestvo s ogranitchennoy; otvetstvennostiu “WDS”*, 95 USPQ2d 1567, 1570 n.3 (TTAB 2010) (noting that if a party intends to rely at trial on business records in a foreign language, it must provide a translation); *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1405 (TTAB 1998) (noting that a proffered excerpt from a newspaper or periodical is lacking in foundation and, thus, is not admissible as evidence to the extent that it is unintelligible because it is in a language other than English). *See also Lacteos de Honduras S.A. v. Industrias Sula, S. De R.L. de C.V.*, 2020 USPQ2d 10087, at *6 (TTAB 2020) (for purpose of determining plausibility of allegations in counterclaim, in connection with motion to dismiss, Board did not consider attached exhibits to complaint because they were in Spanish with no English translation provided); *Empresa Cubana Del Tabaco v. General Cigar Co.*, 2019 USPQ2d 227680, at *1 n.1 (TTAB 2019) (Board noted that petitioner provided testimony declarations with translations from Spanish to English).

105 Contact With Board Personnel**37 C.F.R. § 11.305 *Impartiality and decorum of the tribunal.***

(a) *A practitioner shall not:*

* * * *

(b) *Communicate ex parte with such a person during the proceeding unless authorized to do so by law, rule or court order.*

* * * *

Parties or their attorneys or other authorized representatives may telephone the Board to inquire about the status of a case or to ask for procedural information, but not to discuss the merits of a case or any particular issue. [Note 1.] The telephone number of the Board is (571) 272-8500, or (800) 786-9199 (toll free). If an inquiry involves a particular case, the person making the inquiry should be prepared to give the number of the proceeding or application in question. Inquiries to the Board should not be made by email.

NOTES:

1. [37 C.F.R. § 11.305\(b\)](#). *See Melwani v. Allegiance Corp.*, 97 USPQ2d 1537, 1542 n.15 (TTAB 2010) (to inquire as to status of Board proceeding, party may call Board during business hours).

106 Identification, Signature, and Form of Submissions

106.01 Identification of Submissions

A submission filed in a proceeding before the Board should bear at its top the heading “IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD,” followed by the name and number of the inter partes proceeding (or, in the case of an ex parte appeal, or an extension of time to oppose, the application) to which it relates. [Note 1.] The document should also include a title describing its nature, e.g., “Notice of Opposition,” “Answer,” “Motion to Compel,” “Brief in Opposition to Respondent’s Motion for Summary Judgment,” or “Notice of Reliance.”

Documents filed in an application which is the subject of an inter partes proceeding before the Board should be filed with the Board, not the Trademark Operation, and should bear at the top of the first page both the application serial number, and the inter partes proceeding number and title. Similarly, requests under Trademark Act § 7, [15 U.S.C. § 1057](#), to amend, correct, or surrender a registration which is the subject of a Board inter partes proceeding, and any new power of attorney, designation of domestic representative, or change of address submitted in connection with such a registration, should be filed with the Board, not with the Trademark Operation, and should bear at the top of its first page both the registration number, and the inter partes proceeding number and title. [Note 2.]

NOTES:

1. [37 C.F.R. § 2.194](#).
2. [37 C.F.R. § 2.194](#).

106.02 Signature of Submissions

[37 C.F.R. § 2.119\(e\)](#) *Every submission 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 submission will not be refused consideration if a signed copy is submitted to the Office within the time limit set in the notification of this defect by the Office.*

[37 C.F.R. § 11.14\(e\)](#) **Appearance.** *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. Except as specified in § 2.11(a) of this chapter, an individual may appear in a trademark or other non-patent matter in his or her own behalf or on behalf of:*

- (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.*

[37 C.F.R. § 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.*

37 C.F.R. § 2.193 Trademark correspondence and signature requirements.

(a) **Signature required.** *Each piece of correspondence that requires a person's 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 or through TEAS or ESTTA.*

(b) **Copy of original signature.** *If a 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 the signer 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 first and last name, and the title or position, 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 immediately below or adjacent to the signature.

(e) **Proper person to sign.** Documents filed in connection with a trademark application or registration must be signed as specified in paragraphs (e)(1) through (9) of this section.

(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:

(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

* * * *

(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.

* * * *

(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) may also be subject to disciplinary action. See § 11.18(d) and § 11.804 of this chapter.

* * * *

(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.

Every document filed in an inter partes or ex parte proceeding before the Board, 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, as appropriate, and the signatory must be identified. [Note 1.]

Documents filed through ESTTA, the Board’s electronic filing system, do not require a conventional signature. Electronic signatures pursuant to [37 C.F.R. § 2.193\(c\)](#) are required for electronic filings. The

party or its representative enters a “symbol” that has been adopted as a signature. The Board will accept any combination of letters, numbers, space and/or punctuation marks as a valid signature if it is placed between two forward slash (“/”) symbols. [Note 2.] The electronic signature entered on the ESTTA form is sufficient as the required signature for the entire submission, including in the absence of a signature on any attachment to the filing form. [Note 3.] The electronic filing cover sheet in ESTTA must be signed by the party filing it, the party’s attorney or other authorized representative, as appropriate. For further information regarding the filing of submissions using ESTTA, see [TBMP § 110](#).

A party may act in its own behalf in a proceeding before the Board, if the party is domiciled in the United States, or an attorney may represent the party. [Note 4.] See [TBMP § 114](#) (Representation of a Party).

When an individual who is a party to a Board proceeding elects to act in his or her own behalf, the individual must sign any documents that he or she files with the Board. If a party which is a partnership elects to act in its own behalf, a partner should sign documents filed by the partnership. If a party which is a corporation or association elects to act in its own behalf, an officer thereof who is authorized to sign for the corporation or association should sign for that corporation or association. If joint applicants elect to act on their own behalf, all joint applicants must sign any documents filed with the Board. [Note 5.]

If a document is filed on behalf of a party by the party’s attorney or other authorized representative, it must bear the signature of, and be personally signed or inserted by, that attorney or other representative, unless it is a document required to be signed personally by the party. An attorney or other authorized representative who signs a document, and then files it with the Board on behalf of a party, should remember that his or her signature to the document constitutes a certification of the elements specified in [37 C.F.R. § 11.18\(b\)](#), and that a knowing violation of the provisions of that rule by an attorney or other authorized representative will leave him or her open to disciplinary action. [Note 6.] See [TBMP § 114.04](#) (regarding meaning of the designation “other authorized representative”) and [TBMP § 527.02](#) (regarding motions for Fed. R. Civ. P. 11 sanctions). A person transmitting paper documents, when permitted, for filing with the Board may sign a cover letter or transmittal letter, and the Office does not require the party, attorney, or authorized representative to sign a cover or transmittal letter. [Note 7.]

It is not appropriate for one person to sign a document for another person, as, for example, “John Smith, for John Doe” or “John Doe, by John Smith.” [Note 8.]

A document filed in a proceeding before the Board should include the first and last name, in typed or printed form, of the person who signed [Note 9]; a description of the capacity in which he or she signed (e.g., as the individual who is a party, if the filing party is an individual; as a corporate officer, if the filing party is a corporation; or as the filing party’s attorney); and his or her business address and telephone number. The inclusion of the signing person’s address and phone number on the submission itself is vital for any paper or physical submissions permitted under the rules because mail physically sent to the Office is opened in the Mail Room, and ordinarily the envelopes are discarded there before the mail is sent on to its ultimate destination within the Office. Thus, the Board rarely sees the return addresses on the mailing envelopes of papers filed in Board proceedings.

In accordance with [37 C.F.R. § 2.193\(b\)](#), a legible copy of the signed document is to be filed with the Board because filings are required to be submitted using ESTTA. The original should be retained as evidence of authenticity. If a question as to the authenticity of a filed copy arises, the Office may require submission of the original. [Note 10.]

Notwithstanding the requirement that a document filed before the Board be signed, an unsigned document filed in paper form, when permitted, will not be refused consideration if a signed copy is submitted to the

Board within the time limit set in the notification of this defect by the Board. [Note 11.] Similarly, an improperly signed document, whether filed in ESTTA or on paper, when permitted, will not be refused consideration if a properly signed copy is submitted to the Board within the time set in the notification of this defect by the Board. [Note 12.]

NOTES:

1. [37 C.F.R. § 2.193\(d\)](#); [37 C.F.R. § 2.193\(b\)](#); [37 C.F.R. § 2.119\(e\)](#); and [37 C.F.R. § 11.18 \(a\)](#).
2. [37 C.F.R. § 2.193 \(c\)\(1\)](#); [37 C.F.R. § 2.102\(a\)](#); [37 C.F.R. § 2.111\(b\)](#); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1039 n.12 (TTAB 2012) (applicant's use of symbols qualified as a signature); *DaimlerChrysler Corp. v. Maydak*, 86 USPQ2d 1945, 1946 (TTAB 2008) (applicant's use of a symbol between the forward slash marks, followed by his name, qualified as a signature); *PPG Industries Inc. v. Guardian Industries Corp.*, 73 USPQ2d 1926, 1927 (TTAB 2005).
3. [37 C.F.R. § 2.193\(c\)\(1\)](#); *DaimlerChrysler Corp. v. Maydak*, 86 USPQ2d 1945, 1946 (TTAB 2008); *PPG Industries Inc. v. Guardian Industries Corp.*, 73 USPQ2d 1926, 1928 (TTAB 2005) (electronically signed ESTTA form made notice of opposition acceptable although attached pleading was not separately signed).
4. [37 C.F.R. § 11.14\(a\)](#); [37 C.F.R. § 11.14\(e\)](#).
5. [37 C.F.R. § 11.14\(e\)](#). See [37 C.F.R. § 2.193\(e\)\(2\)\(ii\)](#).
6. [37 C.F.R. § 2.193\(f\)](#); [37 C.F.R. § 11.18\(c\)](#). Cf. Fed. R. Civ. P. 11. See also *Clorox Co. v. Chemical Bank*, 40 USPQ2d 1098, 1100 n.9 (TTAB 1996) (accuracy in factual representations is expected). Pro se parties are also bound by [37 C.F.R. § 11.18](#).
7. [37 C.F.R. § 2.193\(e\)\(10\)](#).
8. [37 C.F.R. § 2.119\(e\)](#) and [37 C.F.R. § 11.18 \(a\)](#); *Boyd's Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017, 2018 (TTAB 2003) (response to motion signed by person on behalf of practitioner is inappropriate). Cf. *Cerveceria India Inc. v. Cerveceria Centroamericana, S.A.*, 10 USPQ2d 1064, 1067 (TTAB 1989) (Section 8 declaration signed by someone other than named person, while perhaps unacceptable, does not constitute fraud), *aff'd Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989).
9. See, e.g., [37 C.F.R. § 2.193\(d\)](#).
10. [37 C.F.R. § 2.193\(b\)](#).
11. [37 C.F.R. § 2.119\(e\)](#).
12. Cf. [37 C.F.R. § 2.119\(e\)](#); *Birlinn Ltd. v. Stewart*, 111 USPQ2d 1905, 1908 (TTAB 2014) (Board applies opportunity to cure provision in 2.119(e) to improperly signed papers, which defines the time period for cure as "within the time limit set in the notification of this defect by the Office").

106.03 Form of Submissions

[37 C.F.R. § 2.126](#) *Form of submissions to the Trademark Trial and Appeal Board.*

(a) *Submissions must be made to the Trademark Trial and Appeal Board via ESTTA.*

(1) *Text in an electronic submission must be filed in at least 11-point type and double-spaced.*

(2) *Exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission and must be clear and legible.*

(b) *In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, submissions may be filed in paper form. All submissions in paper form, except the extensions of time to file a notice of opposition, the notice of opposition, the petition to cancel, or answers thereto (see §§ 2.101(b)(2), 2.102(a)(2), 2.106(b)(1), 2.111(c)(2), and 2.114(b)(1)), must include a written explanation of such technical problems or extraordinary circumstances. Paper submissions that do not meet the showing required under this paragraph (b) will not be considered. 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.*

(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(f) must be submitted using the “Confidential” selection available in ESTTA or, where appropriate, under a separate paper 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 for public viewing with the confidential portions redacted must be submitted concurrently.*

The rules now require that all submissions must be made to the Board via the Internet through ESTTA, subject to certain limited exceptions permitting submissions to be made on paper. Any permitted paper submission must be accompanied by a written explanation showing that ESTTA was unavailable due to technical problems, or that extraordinary circumstances are present, and, where required, a Petition to the Director with the requisite petition fee. [Note 1.] However, because ESTTA currently does not accept multimedia files, the Board will continue its current practice of accepting the submission of physical DVDs or CDs as exhibits in inter partes proceedings for the limited purpose of allowing parties to submit multimedia evidence, such as commercials. [Note 2.]

The requirements for electronic submissions over the Internet can be found in [37 C.F.R. § 2.126\(a\)](#). Submissions over the Internet are made through ESTTA which is available on the USPTO website. [Note 3.] Using ESTTA, a person can complete and submit forms, with attachments and/or exhibits, to the Board over the Internet, making an official filing online. ESTTA gives step-by-step instructions for properly completing a form. Available forms and instructions can be found at: <https://estta.uspto.gov>. For more information regarding ESTTA, see [TBMP § 110](#).

The Board requires use of ESTTA for the filing of all submissions in Board proceedings. ESTTA permits round-the-clock filing with real-time receipt confirmation, while reducing delay and the possibility of mishandling of submissions within the USPTO. Many ESTTA filings are processed automatically, with an

appropriate Board order issuing within minutes of filing. ESTTA users are strongly urged to plan ahead. Because unexpected problems can occur, users should keep filing deadlines in mind and allow plenty of time to resolve any issue which may arise. The Board will provide general assistance to ESTTA filers but cannot guarantee that any problem will be resolved prior to a deadline. If ESTTA filing is not possible prior to a deadline for any reason, parties should timely submit their filings on paper using another accepted filing method (e.g., certificate of mailing and Priority Mail Express® procedures). See [TBMP § 111.02](#), *et seq.* (Certificates of Mailing), and [TBMP § 111.01](#), *et seq.* (Priority Mail Express®). Any paper filing must be accompanied by a written explanation showing that ESTTA was unavailable due to technical problems, or that extraordinary circumstances are present, and, where required, a Petition to the Director with the requisite petition fee. Petitions to file on paper are subject to [37 C.F.R. § 2.146](#), including the requirement for verified facts.

The requirement for use of ESTTA under all circumstances for the filing of either extensions of time to oppose or notices of opposition against Madrid Protocol applications, i.e., applications under [Trademark Act § 66\(a\)](#), [15 U.S.C. § 1141f\(a\)](#), further enables the USPTO to fulfill its obligation to timely notify the International Bureau of the World Intellectual Property Organization (“WIPO”) of oppositions against requests for extension of protection under the Madrid Protocol. A request for an extension of time to oppose a Madrid Protocol application which is not filed through ESTTA will be denied. Similarly, a notice of opposition not filed through ESTTA against such an application will not be instituted. [Note 4.]

Filers may call the Board with questions about filing at (571) 272-8500 or (800) 786-9199 (toll free). Alternatively, filers may send non-urgent email inquiries to ESTTA@uspto.gov, and include a description of the problem, the ESTTA tracking number and Board proceeding number (if any), and a telephone number for contact. The Board will respond to email inquiries within two business days. The email address is for technical ESTTA questions only. **Documents will not be accepted for filing by email.**

The requirements for paper submissions, when permitted, are set out in [37 C.F.R. § 2.126\(b\)](#). A paper submission must be 8 to 8.5 inches wide and 11 to 11.69 inches long, and printed in at least 11-point type and double-spaced, with the text on one side only of each sheet. If a paper submission contains dividers, the dividers may not contain tabs or any devices that extend beyond the edges of the paper, and must be on the same size and weight paper as the submission.

In addition, a paper submission must not be stapled or bound. This is important because all paper submissions are scanned electronically into the Board’s electronic information system and removing staples or binding prior to scanning is difficult and time-consuming, especially where papers have been bound by machine. Moreover, disassembling stapled or bound papers can damage pages, resulting in jammed scanning equipment and increasing the possibility that pages will become lost or disordered during scanning. [Note 5.] These are additional reasons why the Board requires all submissions to be made using ESTTA.

Any paper document filed with the Board must be either the original or a legible copy thereof, on good quality paper. [Note 6.] Extra copies of a document should not be submitted. [Note 7.]

Exhibits pertaining to an electronic submission must be filed electronically through ESTTA as an attachment to the submission and conform to the requirements for electronic submissions, except when a party needs to submit a multimedia exhibit on CD or DVD. [Note 8.] When making a submission of an exhibit on CD or DVD, parties are advised to include in the accompanying ESTTA filing a “placeholder” exhibit page to indicate the CD or DVD exhibit, and to mail the CD or DVD to the Board. See [TBMP § 110.02\(c\)](#) regarding size limitations. Exhibits to a submission are also subject to the requirements of [37 C.F.R. § 2.126](#). A best practice for electronic exhibits in PDF form is to use a separator page for each exhibit and to assign a

bookmark to that page with an alpha-numeric designation (such as A, B, C or 1, 2, 3) for easy navigation and location of the exhibit.

Exhibits pertaining to a paper submission, where permitted, must be filed on paper and must comply with the requirements for a paper submission. [Note 9.]

As with any paper submission, paper exhibits may not contain tabs, dividers or any such devices that extend beyond the edges of the paper, and moreover, may not be stapled or bound. However, it is acceptable to use binder clips or rubber bands, or similar devices that would allow for easy separation of the papers for scanning.

Exhibits that are large, bulky, valuable, or breakable may be photographed or otherwise reproduced so that an appropriate digitized or paper image of the exhibits can be filed with the Board in lieu of the originals. Exhibits consisting of videotapes or audiotapes of commercials, demonstrations, etc., may not be filed electronically.

The requirements for confidential submissions are specified in [37 C.F.R. § 2.126\(c\)](#). To be handled as confidential, and kept out of the public record, submissions to the Board that are confidential must be filed 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 also be submitted for the public record. [Note 10.] Confidential materials must be filed through ESTTA using the “CONFIDENTIAL” option. See [TBMP § 120.02](#) and [TBMP § 412.04](#) for information on filing confidential materials.

The Board, in its discretion, may refuse to enter and consider submissions which are not in compliance with [37 C.F.R. § 2.126](#).

Format of submissions. Apart from the identification, signature, and form requirements referred to above, there is no particular format that submissions to the Board must follow. Nor does the Office have printed forms for any documents filed in Board proceedings. Where possible, parties are encouraged to include a citation to the TTABVUE docket entry and TTABVUE page number, e.g., 1 TTABVUE 2. [Note 11.] For material or testimony that has been designated confidential and which does not appear on TTABVUE, the TTABVUE docket entry number where such material or testimony is located should be included in any citation. [Note 12.]

Although there is no particular format that a submission must follow, in large record cases, the Board may direct the parties on the form of submission for exhibits and may direct the parties to prepare and file an appendix in a specific format. [Note 13.]

NOTES:

1. [37 C.F.R. § 2.126\(b\)](#); see also [37 C.F.R. § 2.101\(b\)\(2\)](#), [37 C.F.R. § 2.102\(a\)\(2\)](#), [37 C.F.R. § 2.106\(b\)\(1\)](#), [37 C.F.R. § 2.111\(c\)\(2\)](#), and [37 C.F.R. § 2.114\(b\)\(1\)](#).

2. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69966 (October 7, 2016). See also *Wirecard AG v. Striatum Ventures B.V.*, 2020 USPQ2d 10086, at *3 n.4 (TTAB 2020) (a party that wishes to submit audio or video files must record the files on an appropriate medium such as CD-ROM or DVD and physically file it with the Board); *The Pierce-Arrow Society v. Spintek Filtration, Inc.*, 2019 USPQ2d 471774, at *1 n.8 (TTAB 2019) (Board

considered video documentary submitted on CD-ROM); *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1654-55 (TTAB 2014) (parties may not, by agreement, override Trademark Rule 2.126 provisions for form of submissions; however, video and audio recordings of evidence such as commercials may be submitted on CD-ROM), *appeal dismissed per stipulation*, No. 14-CV-4463 (D. Minn. Jan. 15, 2016).

3. [37 C.F.R. § 2.2\(g\)](#); [37 C.F.R. § 2.126\(a\)](#).

4. *In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019, 2021 (TTAB 2005).

5. See also RULES OF PRACTICE FOR TRADEMARK-RELATED FILINGS UNDER THE MADRID PROTOCOL IMPLEMENTATION ACT; 68 Fed. Reg. 55748, 55760 (September 26, 2003).

6. See, e.g., [37 C.F.R. § 2.126\(a\)\(2\)](#) (must be clear and legible). See also *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc. dba Watermark Cruises*, 107 USPQ2d 1750, 1758 n.16 (TTAB 2013) (“the onus is on the party making the submissions to ensure that, at a minimum, all materials are clearly readable by the adverse party and the Board”), *aff’d*, 565 F. App’x 900 (Fed. Cir. 2014) (mem.); *In re Virtual Independent Paralegals, LLC*, 2019 USPQ2d 111512, at *7 n.23 (TTAB 2019) (“the Board will consider evidence, or a portion of the evidence, only if it is clear and legible.”).

7. *DeLorme Publishing Co. v. Eartha’s Inc.*, 60 USPQ2d 1222, 1222 n.1 (TTAB 2000) (papers should be filed in single copies only unless otherwise required by rule); *ITC Entertainment Group Ltd. v. Nintendo of Am. Inc.*, 45 USPQ2d 2021, 2022-23 (TTAB 1998) (unnecessary copies and attachments to motions resulted in undue delay and a waste of Board resources); *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1708 n.1 (TTAB 1994).

8. [37 C.F.R. § 2.126\(a\)](#). See also MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69966 (October 7, 2016).

9. [37 C.F.R. § 2.126\(b\)](#).

10. [37 C.F.R. § 2.126\(c\)](#).

11. *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

12. *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

13. *AT&T Mobility LLC v. Thomann*, 2020 USPQ2d 53785, at *12 (TTAB 2020) (parties directed to file an appendix of all testimony and documentary evidence, identifying page number and relevance, and to bookmark all exhibits submitted in PDF form by alpha-numeric designation).

107 How and Where to File Permitted Paper Filings and Fees

[37 C.F.R. § 2.195](#) **Filing date of trademark correspondence.** The filing date of trademark correspondence is determined as follows:

(a) **Electronic Submissions.** The filing date of an electronic submission is the date the Office receives the submission, based on Eastern Time, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia.

(b) **Paper Correspondence.** The filing date of a submission submitted on paper is the date the Office receives the submission, except as follows:

(1) **Priority Mail Express®.** The filing date of the submission is the date of deposit with the USPS, if filed pursuant to the requirements of § 2.198.

* * * *

(3) **Office closed.** The Office is not open to receive paper correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia.

(c) **Email and facsimile submissions.** Email and facsimile submissions are not permitted and, if submitted, will not be accorded a date of receipt.

(d) **Interruptions in USPS.** *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 Priority Mail Express® Post Office to Addressee service who was unable to deposit the correspondence with the USPS due to the interruption or emergency may petition the Director to consider such correspondence as filed on a particular date in the Office. The petition must:*

(1) *Be filed promptly after the ending of the designated interruption or emergency;*

(2) *Include the original correspondence or a copy of the original correspondence; and*

(3) *Include a statement that the correspondence would have been deposited with the USPS on the requested filing date but for the designated interruption or emergency in Priority Mail Express® 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 Priority Mail Express® on the requested filing date.*

The Board requires electronic filing using ESTTA for all submissions in Board proceedings. However, for those submissions that are permitted to be filed on paper due to the unavailability of ESTTA as a result of technical problems, or when extraordinary circumstances are present, the specific requirements for delivery of such submissions to the Office are set out below.

Documents relating to proceedings before the Board may be filed during regular office hours by hand delivery or by courier service to:

Trademark Assistance Center
James Madison Building - East Wing
Concourse Level, Room C55
600 Dulany Street
Alexandria, VA 22314

Such papers may also be filed by depositing them in the mail addressed to:

United States Patent and Trademark Office:
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Documents to be filed with the Board, including a notice of ex parte appeal, may not be filed by facsimile transmission (“fax”). [Note 1.] If documents are filed with the Board by fax transmission, they will not receive a filing date. [Note 2.]

The Board does not accept any filings by email. [Note 3.] For information on filing submissions using ESTTA, the Board’s electronic filing system, see [TBMP § 110](#).

For information on how to pay fees, see [TBMP § 118](#).

NOTES:

1. [37 C.F.R. § 2.195\(c\)](#). See, e.g., *Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280, 1283 (TTAB 2008) (facsimile filing of notice of opposition not accepted).

2. [37 C.F.R. § 2.195\(c\)](#). See, e.g., *Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280, 1283 (TTAB 2008) (facsimile filing of notice of opposition not accorded filing date).

3. [37 C.F.R. § 2.195\(c\)](#).

108 Filing Receipts

When a document intended for the Board is filed in the Office, it is possible to obtain a receipt evidencing the date of such filing.

Documents uploaded to ESTTA, the Board's electronic filing system, are deemed filed upon successful completion of transmission to the Board, including the receipt of any required fee. When documents are successfully filed online using ESTTA, the filer will receive an on-screen acknowledgement of the filing, including an ESTTA tracking number. The filer will also receive an email filing receipt including the ESTTA tracking number and filing information which includes the number of pages transmitted. [Note 1.] If the filer does not receive an on-screen acknowledgement and an email filing receipt, it should not assume that the paper has been successfully filed. Upon filing, the cover sheet for correspondence transmitted electronically through ESTTA is automatically affixed with the date the Office receives the complete transmission. Eastern Time controls the filing date. [Note 2.] See [TBMP § 110](#). Most ESTTA submissions are automatically entered into the TTAB proceeding docket and appear in TTABVUE shortly after transmission, although some require manual processing, which can take up to a week. If your ESTTA submission does not appear in TTABVUE within a week of transmission, please contact the TTAB at 571-272-8500, Mon-Fri. 8:30 am to 5:00 pm, ET for assistance.

In the case of a document permitted to be submitted on paper, if sent by mail, a receipt may be obtained by submitting with the document a stamped, self-addressed postcard with sufficient information to identify clearly the document, the party on whose behalf the paper is being filed, and the proceeding or application in connection with which the document is being filed. When the Office receives the document and the postcard, it will date-stamp both of them and mail the postcard back.

If a document permitted to be submitted on paper is delivered by hand to the Trademark Assistance Center, see [TBMP § 107](#), the receipt may take the form of a postcard bearing appropriate identifying information, or a duplicate copy of the document, or a duplicate copy of the transmittal letter with appropriate identifying information. The receipt and the document will be date-stamped and the receipt will be handed back to the person who delivered the paper.

NOTES:

1. *Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1351 (TTAB 2014), *appeal dismissed per stipulation*, No. 2014-1461 (Fed. Cir. Oct. 10, 2014).

2. [37 C.F.R. § 2.195\(a\)](#). See MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 19296, 19296 (to be codified at 37 C.F.R. pt. 2 (proposed April 4, 2016)). See <https://estta.uspto.gov> for instructions for filing using ESTTA.

109 Filing Date

[37 C.F.R. § 2.195](#). **Filing date of trademark correspondence.** *The filing date of trademark correspondence is determined as follows:*

(a) **Electronic submissions.** *The filing date of an electronic submission is the date the Office receives the submission, based on Eastern Time, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia.*

(b) **Paper correspondence.** *The filing date of a submission submitted on paper is the date the Office receives the submission, except as follows:*

(1) **Priority Mail Express®.** *The filing date of the submission is the date of deposit with the USPS, if filed pursuant to the requirements of § 2.198.*

* * * *

(3) **Office closed.** *The Office is not open to receive paper correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia.*

(c) **Email and facsimile submissions.** *Email and facsimile submissions are not permitted and, if submitted, will not be accorded a date of receipt.*

(d) **Interruptions in USPS.** *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 Priority Mail Express® Post Office to Addressee service who was unable to deposit the correspondence with the USPS due to the interruption or emergency may petition the Director to consider such correspondence as filed on a particular date in the Office. The petition must:*

(1) *Be filed promptly after the ending of the designated interruption or emergency;*

(2) *Include the original correspondence or a copy of the original correspondence; and*

(3) *Include a statement that the correspondence would have been deposited with the USPS on the requested filing date but for the designated interruption or emergency in Priority Mail Express® 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 Priority Mail Express® on the requested filing date.*

The cover sheet for correspondence transmitted electronically through ESTTA is automatically affixed with the date the Office receives the complete transmission, including any required fee. [Note 1.] Eastern Time controls the filing date. [Note 2.] Once a request is transmitted electronically, the system immediately provides the sender with an email acknowledgement of receipt. For more information regarding ESTTA, see [TBMP § 110](#).

Mailed or hand-delivered correspondence, when permitted, is stamped with the date of receipt in the Office (i.e., the “filing” date) unless the correspondence is filed by the Priority Mail Express® procedure provided in [37 C.F.R. § 2.198](#). [Note 3.]

When correspondence intended for the Board is filed by the “Priority Mail Express® Post Office to Addressee” service of the United States Postal Service, the document's filing date is the date of deposit with the USPS, as shown by the "date accepted" on the Priority Mail Express® label or other official USPS notation. If the

date of deposit with the Postal Service cannot be determined, the correspondence will be stamped with the date of its actual receipt in the USPTO. [Note 4.]

The Board does not accept correspondence by facsimile. Any such filings, including a notice of ex parte appeal, will not be accorded a filing date. [Note 5.]

When correspondence intended for the Board is filed by first-class mail with a certificate of mailing, in accordance with the procedure described in [37 C.F.R. § 2.197\(a\)](#), it is stamped with the date of receipt of the correspondence in the Office. The mailing date specified in the certificate of mailing is used for purposes of determining the timeliness of the correspondence. The date of receipt is used for all other purposes. [Note 6.]

NOTES:

1. [37 C.F.R. § 2.195](#); *Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280, 1282 (TTAB 2008) (receipt date of ESTTA submission is automatically affixed to paper). See <https://estta.uspto.gov> for instructions for filing using ESTTA.
2. [37 C.F.R. § 2.195](#). See MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 19296, 19296 (to be codified at 37 C.F.R. pt. 2 (proposed April 4, 2016)).
3. [37 C.F.R. § 2.195\(b\)](#).
4. [37 C.F.R. § 2.195\(b\)\(1\)](#), [37 C.F.R. § 2.198\(a\)](#) and [37 C.F.R. § 2.198\(b\)](#). See [37 C.F.R. § 2.198\(c\)](#) and [37 C.F.R. § 2.198\(d\)](#), regarding procedures for petitioning the Director to correct a filing date discrepancy and for procedures for petitioning the Director if the “date accepted” by the Postal Service was incorrently entered or omitted.
5. [37 C.F.R. § 2.195\(c\)](#). See also *Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280, 1283 (TTAB 2008) (fax transmission of notice of opposition not acceptable under any circumstances and not accorded a filing date).
6. [37 C.F.R. § 2.195\(b\)\(2\)](#) and [37 C.F.R. § 2.197\(a\)](#). For information concerning the date stamped by the USPTO on correspondence by “Priority Mail Express® Post Office to Addressee” when interruptions or emergencies occur in the United States Postal Service, see 35 U.S.C. § 21 and [37 C.F.R. § 2.195\(d\)](#).

110 Electronic Filing Using ESTTA

110.01 In General

[37 C.F.R. § 2.2](#)

* * * *

(g) *The acronym ESTTA means the Electronic System for Trademark Trials and Appeals and, as used in this part, includes all related electronic systems required to complete an electronic submission through ESTTA.*

* * * *

(r) *Eastern Time means Eastern Standard Time or Eastern Daylight Time, as appropriate.*

(s) *The term electronic submission as used in this part refers to any submission made through an electronic filing system available on the Office's website, but not through email or facsimile transmission.*

37 C.F.R. § 2.126 Form of submissions to the Trademark Trial and Appeal Board.

(a) *Submissions must be made to the Trademark Trial and Appeal Board via ESTTA.*

(1) *Text in an electronic submission must be filed in at least 11-point type and double-spaced.*

(2) *Exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission and must be clear and legible.*

(b) *In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, submissions may be filed in paper form. All submissions in paper form, except the extensions of time to file a notice of opposition, the notice of opposition, the petition to cancel, or answers thereto (see §§ 2.101(b)(2), 2.102(a)(2), 2.106(b)(1), 2.111(c)(2), and 2.114(b)(1)), must include a written explanation of such technical problems or extraordinary circumstances. Paper submissions that do not meet the showing required under this paragraph (b) will not be considered. 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.*

(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(f) must be submitted using the “Confidential” selection available in ESTTA or, where appropriate, under a separate paper 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 for public viewing with the confidential portions redacted must be submitted concurrently.*

37 C.F.R. § 2.101(b)(1) *An opposition to an application must be filed by the due date set forth in paragraph (c) of this section through ESTTA.*

37 C.F.R. § 2.102(a)(1) *A request to extend the time for filing an opposition to an application must be filed through ESTTA by the opposition due date set forth in § 2.101(c).*

37 C.F.R. § 2.101(b)(3) *An opposition to an application based on Section 66(a) of the Act must be filed through ESTTA and may not under any circumstances be filed in paper form.*

37 C.F.R. § 2.102(a)(1) *A request to extend the opposition period for an application based on Section 66(a) of the Act must be filed through ESTTA and may not under any circumstances be filed in paper form.*

37 C.F.R. § 2.111(c)(1) *A petition to cancel a registration must be filed through ESTTA.*

37 C.F.R. § 2.190(b) **Electronic trademark documents.** ... Documents that relate to proceedings before the Trademark Trial and Appeal Board must be filed electronically with the Board through ESTTA.

37 C.F.R. § 2.195(a) **Electronic submissions.** The filing date of an electronic submission is the date the Office receives the submission, based on Eastern Time, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia.

ESTTA – the Electronic System for Trademark Trials and Appeals – is the Board’s electronic filing system. ESTTA is a web-based application available on the Internet. No special software (apart from a web browser) need be installed on the user’s computer in order to use ESTTA. Likewise, users need not open an account or obtain a password, and there is no additional fee for use of ESTTA.

The Board requires use of ESTTA for the filing of all submissions in Board proceedings and for filing of extensions of time to oppose. ESTTA permits round-the-clock filing with real-time receipt confirmation, while reducing delay and the possibility of mishandling of submissions in route to or within the USPTO. Many ESTTA filings are processed automatically, with an appropriate Board order issuing within minutes of filing. Use of ESTTA helps filers avoid common (and sometimes fatal) pitfalls in filing, and allows the Board to efficiently and expeditiously process and act upon filings.

Upon completion of a successful filing, a filer using ESTTA will receive both an on-screen and email acknowledgement of receipt from ESTTA with the ESTTA tracking number and the filing information including the official filing date. The filing date is the date on which the complete ESTTA filing (including any required fee) is received in the USPTO. Although an ESTTA filing can be made from anywhere in the world, Eastern Time controls the filing date, not the local date from where the filing was made. [Note 1.] ESTTA filers should not send hard copies of electronically-filed documents to the Board.

The ESTTA user manual, ESTTA forms, and instructions for their use can be found at <https://estta.uspto.gov/>. Contextually appropriate help is available throughout ESTTA by clicking on highlighted, hyper-linked terms. These terms usually appear in blue, but may differ depending on your browser settings. Filers should also check “What’s New in ESTTA” for important user guidelines.

It is the responsibility of the party making submissions to the Board using ESTTA to ensure that the submissions have been entered into the trial record. [Note 2.] Parties are urged to check not only the ESTTA filing receipts but also TTABVUE, the Board’s electronic docket information and file database, to ensure that all documents have been properly transmitted and entered. [Note 3.]

This section is not intended to provide a comprehensive reference for use of ESTTA, but merely to emphasize ESTTA’s benefits and availability, and to provide some basic facts about its use.

NOTES:

1. 37 C.F.R. § 2.2; 37 C.F.R. § 2.195(a). See MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 19296, 19296 (to be codified at 37 C.F.R. pt. 2 (proposed April 4, 2016)); <https://estta.uspto.gov> (instructions for filing using ESTTA).

2. *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1506 n.195 (TTAB 2017); *Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1351 (TTAB 2014), appeal dismissed per stipulation, No. 2014-1461 (Fed. Cir. Oct. 10, 2014).

3. *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1506 n.195 (TTAB 2017); *Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1351 (TTAB 2014), appeal dismissed per stipulation, No. 2014-1461 (Fed. Cir. Oct. 10, 2014).

110.01(a) ESTTA is Mandatory for All Filings

Use of ESTTA is required for the filing of all submissions in Board proceedings. [Note 1.]

Use of ESTTA previously had been mandatory only for the filing of either (1) extensions of time to oppose Madrid Protocol applications, i.e., applications under Trademark Act § 66(a), [15 U.S.C. § 1141f\(a\)](#), or (2) notices of opposition against Madrid Protocol applications. [Note 2.] The requirement for use of ESTTA for such filings enables the USPTO to fulfill its obligation to timely notify the International Bureau of the World Intellectual Property Organization of oppositions against requests for extension of protection under the Madrid Protocol. A request for an extension of time to oppose a Madrid Protocol application which is not filed through ESTTA will be denied in all circumstances. [Note 3.] Similarly, a notice of opposition not filed through ESTTA against such an application will not be instituted under any circumstances. [Note 4.] For a further discussion of filing notices of opposition against Madrid Protocol applications using ESTTA, see [TBMP § 306.01](#).

In the rare circumstances the rules permit submissions in paper form, the paper submission must be accompanied by a written explanation showing that ESTTA was unavailable due to technical problems, or that extraordinary circumstances are present, and, where required, a Petition to the Director with the requisite petition fee. [Note 5.] Petitions to file on paper are generally subject to [37 C.F.R. § 2.146](#), including the requirement for verified facts. [Note 6.] However, a Petition to the Director to accept paper submission of a petition to cancel a registration on the fifth year anniversary of the date of registration is subject to the requirements of [37 C.F.R. § 2.147\(b\)](#), including the requirement for a declaration under [37 C.F.R. § 2.20](#) or 28 U.S.C. § 1746. [Note 7.]

NOTES:

1. See [37 C.F.R. § 2.126\(a\)](#) (submissions must be made through ESTTA); [37 C.F.R. § 2.101\(b\)](#) (notices of opposition must be filed through ESTTA); [37 C.F.R. § 2.102\(a\)\(1\)](#) (extensions of time to oppose must be filed in ESTTA); [37 C.F.R. § 2.102\(a\)\(2\)](#) (extensions of time to oppose Trademark Act § 66(a) applications must be filed through ESTTA); [37 C.F.R. § 2.101\(b\)\(2\)](#) (notice of opposition against § 66(a) application must be filed through ESTTA); [37 C.F.R. § 2.111\(c\)\(1\)](#) (petition to cancel must be filed through ESTTA). [37 C.F.R. § 2.190\(b\)](#) (electronic trademark documents).

2. See [37 C.F.R. § 2.126](#) (Form of Submissions to the Trademark Trial and Appeal Board); [37 C.F.R. § 2.102\(a\)\(2\)](#) (extensions of time to oppose Trademark Act § 66(a), [15 U.S.C. § 1141f\(a\)](#) applications must be filed through ESTTA); [37 C.F.R. § 2.101\(b\)\(2\)](#) (notice of opposition against § 66(a) application must be filed through ESTTA). See, e.g., *CSC Holdings LLC v. SAS Optimhome*, 99 USPQ2d 1959, 1960 (TTAB 2011) (opposition to § 66(a) application must be filed via ESTTA); *Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1561 (TTAB 2011) (same); *O.C. Seacrets Inc. v. Hotelplan Italia S.p.A.*, 95 USPQ2d 1327, 1328 n.2 (TTAB 2010) (same).

3. *In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019, 2020-21 (TTAB 2005).

4. See *In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019, 2020-21 (TTAB 2005).

5. [37 C.F.R. § 2.101\(b\)\(2\)](#); [37 C.F.R. § 2.102\(a\)\(2\)](#); [37 C.F.R. § 2.111\(c\)\(2\)\(i\)](#); [37 C.F.R. § 2.126\(b\)](#).
6. [37 C.F.R. § 2.101\(b\)\(2\)](#); [37 C.F.R. § 2.102\(a\)\(1\)](#); [37 C.F.R. § 2.111\(c\)\(2\)\(i\)](#).
7. [37 C.F.R. § 2.111\(c\)\(2\)\(ii\)](#).

110.01(b) Plan Ahead

ESTTA users are strongly urged to plan ahead. Because unexpected problems can occur, users should keep filing deadlines in mind and allow plenty of time to resolve any issue which may arise. [Note 1.] The Board will provide general assistance to ESTTA filers, see [TBMP § 110.04](#) (Questions about ESTTA Filing), but cannot guarantee that any problem will be resolved prior to a deadline. As discussed above, ESTTA filing is mandatory. *If ESTTA filing is not possible prior to a deadline for any reason, parties should timely submit their filings on paper, using another filing option as appropriate (e.g., certificate of mailing or Priority Mail Express® procedures)*. See [TBMP § 111.02](#) (Certificate of Mailing), and [TBMP § 111.01](#) (Priority Mail Express® procedure). Any paper filing must be accompanied by a written explanation showing that ESTTA is unavailable due to technical problems, or that extraordinary circumstances are present, and, where required, a Petition to the Director with the requisite petition fee. Petitions to file on paper are generally subject to [37 C.F.R. § 2.146](#), including the requirement for verified facts. [Note 2.] However, a Petition to the Director to accept paper submission of a petition to cancel a registration on the fifth year anniversary of the date of registration is subject to the requirements of [37 C.F.R. § 2.147\(b\)](#), including the requirement for a declaration under [37 C.F.R. § 2.20](#) or 28 U.S.C. § 1746. [Note 3.]

Please Note: An extension of time to oppose, or a notice of opposition involving an application under Trademark Act § 66(a) **must** be filed through ESTTA, and may not under any circumstances be filed in paper form. [Note 4.] Users should not anticipate that the Board will extend a deadline because it was not possible to file a submission by ESTTA on the due date.

NOTES:

1. *Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280, 1282-83 (TTAB 2008) (ESTTA filer encountered unexpected problem in ESTTA filing; filer transmitted notice of opposition by fax. Held: ESTTA filing not received and fax filing is unacceptable; opposition dismissed as a nullity.).

2. [37 C.F.R. § 2.101\(b\)\(2\)](#); [37 C.F.R. § 2.102\(a\)\(1\)](#); [37 C.F.R. § 2.111\(c\)\(2\)\(i\)](#).

3.

[37 C.F.R. § 2.111\(c\)\(2\)\(ii\)](#).

4. See [37 C.F.R. § 2.102\(a\)\(1\)](#) (extension of time to oppose) and [37 C.F.R. § 2.101\(b\)\(3\)](#) (notice of opposition). *CSC Holdings LLC v. SAS Optimhome*, 99 USPQ2d 1959, 1960 (TTAB 2011) (any opposition to a Trademark Act § 66(a), 15 U.S.C. § 1141f(a), application must be filed through ESTTA); *Hunt Control System, Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1561 (TTAB 2011) (same); *O.C. Seacrets Inc. v. Hotelplan Italia S.p.A.*, 95 USPQ2d 1327, 1328 n.2 (TTAB 2010) (same).

110.02 Attachments to ESTTA Filings

110.02(a) In General

Many ESTTA forms permit or require the filer to attach an electronic file to be transmitted to the Board as part of the filing. For instance, an ESTTA user filing a notice of opposition or petition for cancellation must attach to its filing a pleading (*i.e.*, a short and plain statement showing that the filer is entitled to relief). Likewise, a party filing a motion for summary judgment must attach a motion, as well as any affidavits or other evidence in support of it. When such a file can or must be attached, ESTTA will prompt the user to identify the file on the user's computer and attach it to the ESTTA submission. Once a file has been selected and attached, the file may be opened in a separate window so that the user may determine whether all of the relevant pages of the selected file or files have been designated for filing.

110.02(b) Form of ESTTA Attachments

Attachments to ESTTA filings may be in PDF, TIFF or TXT format. [Note 1.] PDF is preferred, and should be used, if possible. Files should be formatted in letter size (8.5" x 11"), and should be rendered at 300 dpi resolution. ESTTA will accept either color or black and white PDF documents for uploading. It is recommended that all documents submitted electronically via ESTTA be "machine readable" to allow the Board and others to search the document using key words, and also mark and copy text from it. Most word processors feature drop-down options to "create .pdf," "save to .pdf," or "print to .pdf."

The filer is responsible for ensuring that all Board submissions – including attachments to ESTTA filings – are legible. Filers should be aware that the quality of ESTTA submissions is often better than those submitted in paper. [Note 2.] Problems with image quality sometimes arise when poor quality documents are scanned or when the quality of legible documents is degraded in the scanning process; these problems typically arise in documents (or parts of documents) featuring graphical material, as opposed to text. Quality can sometimes be significantly degraded when contrast settings used in scanning are not appropriate for graphical material, or when color materials are scanned or copied in black and white prior to submission. If legibility of material in color or grayscale is important, filers are urged to scan the papers in color and to adjust the scanner's contrast settings to achieve acceptable results prior to ESTTA filing. Users are urged to check the quality of their submission in TTABVUE after filing. TTABVUE contains the same images that the Board will use in considering the submission; if the TTABVUE image is not of acceptable quality, the user should not assume that the Board will be able to view and consider it appropriately. [Note 3.] Original paper documents, when such submissions are permitted, are retained for a period of time, usually less than one year, because, the Board works from the scanned images, rather than the originals.

In addition, electronically submitted pleadings, motions, briefs, and the like must be formatted for at least 11-point type and be double-spaced. [Note 4.] Exhibits to pleadings, motions, and briefs need not be reformatted to meet these requirements, but must be legible.

NOTES:

1. PDF stands for Portable Document Format, a platform-independent, open standard for document exchange. TIFF stands for Tagged Image File Format. TXT is used here to denote a plain-text file format (with .txt extension), with little or no formatting or graphics capability. TIFF and TXT files will be converted to PDF format when they are received by ESTTA. Most word processing programs can directly convert files into one of these formats. Alternatively, papers can usually be scanned in PDF or TIFF format.

2. *In re Loggerhead Tools, LLC*, 119 USPQ2d 1429, 1433 n.5 (TTAB 2016) (filers are responsible for ensuring that all submissions are legible). All paper submissions, when permitted, are scanned by the Board upon receipt. **Please Note:** whether filed in paper form or filed electronically, the quality of papers scanned into TTABVUE appears the same way as when they are submitted. *See, e.g., In re Sela Products, LLC*, 107 USPQ2d 1580, 1585 n.5 (TTAB 2013).

3. *In re Virtual Independent Paralegals, LLC*, 2019 USPQ2d 111512, at *7 n.23 (TTAB 2019) (“If evidence is not legible, we cannot consider it”; “the Board will only consider evidence or a portion of the evidence if it is clear and legible.”); *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1506 n.195 (TTAB 2017) (party has responsibility of ensuring submission entered into record); *Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1350-51 (TTAB 2014) (duty of party making submissions to ensure they were entered into the trial record), *appeal dismissed per stipulation*, No. 2014-1461 (Fed. Cir. Oct. 10, 2014); *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014) (“the Board primarily uses TTABVUE in reviewing evidence”); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc. dba Watermark Cruises*, 107 USPQ2d 1750, 1758 n.16 (TTAB 2013) (“the onus is on the party making the submissions to ensure that, at a minimum, all materials are clearly readable by the adverse party and the Board”), *aff’d*, 565 F. App’x 900 (Fed. Cir. 2014) (mem.).

4. [37 C.F.R. § 2.126\(a\)](#).

110.02(c) Size Limitations

ESTTA is suited for large filings such as trial testimony and notices of reliance. There is no specific limit to the amount of evidence one may submit in support of a Board proceeding. However, filers should use reason and avoid the submission of irrelevant or merely cumulative evidence. The unnecessary submission of large records is a significant burden upon the Board. [Note 1.] See [TBMP § 702.05](#) for more information about submission of large records in general.

Filers should, however, be aware of certain system limitations. Filers may attach one or more files to any ESTTA form that permits or requires an attachment. The size limit for each file attached is 6 MB, and the aggregate of all attached files for a single ESTTA transmission may not exceed 53 MB. However, because very large files degrade the performance of the Board’s electronic file system, *filers should limit each ESTTA submission to no more than an aggregate (all attached files combined) so as not to exceed the limitations*. If a single submission, e.g., a single testimonial transcript or notice of reliance, will exceed the limitations, it should be broken into two or more submissions, in logical segments, filed consecutively.

NOTES:

1. *Corporacion Habanos SA v. Guantanamera Cigars Co.*, 102 USPQ2d 1085, 1091 (TTAB 2012) (excessive record on a single issue); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 (TTAB 2011) (excessively large record); *UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1873 (TTAB 2011) (parties’ submitted much more evidence than was necessary to support respective positions).

110.03 Service of ESTTA Filings

Except for the notice of opposition, the petition to cancel, or notice of a concurrent use proceeding, every submission filed in a Board inter partes proceeding must be served upon the other parties to the proceeding, and proof of service must be provided before the paper will be considered. [Note 1.] For all other submissions

filed in ESTTA, the filer must include a certificate of service as an attachment (or as part of an attachment) to the ESTTA filing as proof of service. Many of the ESTTA forms, e.g., “consent motion forms,” assist the filer by including a certificate of service as part of the ESTTA submission.

In addition to the requirement for a certificate of service, all submissions must actually be served upon the other parties to the proceeding by email, unless otherwise stipulated. [Note 2.] See [TBMP § 113](#) (Service of Papers).

The Board effects service of the notice of opposition or petition to cancel or notice of concurrent use proceeding by providing, in the notice of institution, a web link or web address to access the electronic proceeding record. [Note 3.] For other filings, ESTTA does not automatically serve papers upon opposing parties. [Note 4.]

For a further discussion regarding the filing of a notice of opposition or a petition for cancellation using ESTTA, and notification, see [TBMP § 306.01](#) (notice of opposition); and [TBMP § 307.01-TBMP § 307.02](#) (petition for cancellation).

NOTES:

1. [37 C.F.R. § 2.119\(a\)](#); [37 C.F.R. § 2.105\(a\)](#); [37 C.F.R. § 2.113\(a\)](#).
2. See, e.g., *Springfield Inc. v. XD*, 86 USPQ2d 1063, 1064 (TTAB 2008) (“The proof of service requirement assumes actual service on applicant, or its attorney or domestic representative of record, if any.”). See also [37 C.F.R. § 2.119\(b\)](#).
3. [37 C.F.R. § 2.99\(d\)\(1\)](#); [37 C.F.R. § 2.105\(a\)](#); [37 C.F.R. § 2.113\(a\)](#).
4. See, e.g., *Coffee Studio LLC v. Reign LLC*, 129 USPQ2d 1480, 1482 (TTAB 2019) (filing notice sent to each party by ESTTA does not constitute service); *Equine Touch Foundation Inc. v. Equinology Inc.*, 91 USPQ2d 1943, 1944 n.5 (TTAB 2009) (“Actual forwarding of the service copy, however, is the responsibility of the filer, as ESTTA does not effect service for the filer.”); *Schott AG v. Scott*, 88 USPQ2d 1862, 1863 n.3 (TTAB 2008) (same).

110.04 Questions About ESTTA Filing

Filers may call the Board with questions about filing at (571) 272-8500 or (800) 786-9199 (toll free) from 8:30 a.m. until 5:00 p.m. (Eastern Time). Alternatively, filers may send non-urgent email inquiries to ESTTA@uspto.gov, and include a description of the problem, the ESTTA tracking number and Board proceeding number (if any), and a telephone number for contact. The Board will respond to email inquiries within two business days. The email address is for technical ESTTA questions only. **Submissions will not be accepted for filing by email.** See [TBMP § 107](#) (“The Board does not accept any filings by email.”).

ESTTA users are encouraged to contact the Board when ESTTA is not working as expected. Whether or not one is able to overcome a problem, others are likely to have similar difficulties. Absent notification by users, the Board may be unaware of the problem, delaying any necessary repair.

111 Priority Mail Express® and Certificate of Mailing Procedures

The procedures described below apply to submissions in paper form.

The Priority Mail Express® procedure discussed below at [TBMP § 111.01](#) applies only to paper submissions that meet an exception to the requirement that submissions be filed electronically using ESTTA. For information regarding the electronic filing of submissions through ESTTA, see [TBMP § 110](#).

The certificate of mailing procedure discussed below at [TBMP § 111.02](#) applies only to paper submissions that meet an exception to the requirement that submissions be filed electronically through ESTTA. For information regarding the electronic filing of submissions via the Internet using ESTTA, see [TBMP § 110](#).

111.01 Priority Mail Express® - In General

[37 C.F.R. § 2.198](#) *Filing of correspondence by Priority Mail Express®.*

(a) *The filing date of correspondence submitted under this section is the date of deposit with the USPS, as shown by the "date accepted" on the Priority Mail Express® label or other official USPS notation.*

(b) *If the USPS deposit date cannot be determined, the filing date is the date the Office receives the submission.*

(c) *If there is a discrepancy between the filing date accorded by the Office to the correspondence and the "date accepted," the party who submitted the correspondence may file a petition to the Director under § 2.146(a)(2) to accord the correspondence a filing date as of the "date accepted." The petition must:*

(1) *Be filed within two months after the date of deposit;*

(2) *Include a true copy of the Priority Mail Express® mailing label showing the "date accepted," and any other official notation by the USPS relied upon to show the date of deposit; and*

(3) *Include a verified statement attesting to the facts of the original mailing.*

(d) *If the party who submitted the correspondence can show that the "date accepted" was incorrectly entered or omitted by the USPS, the party may file a petition to the Director under § 2.146(a)(2) to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS. The petition must:*

(1) *Be filed within two months after the date of deposit;*

(2) *Include proof that the correspondence was deposited in the Priority Mail Express® Post Office to Addressee service prior to the last scheduled pickup on the requested filing date. Such proof must be corroborated by evidence from the USPS or evidence that came into being within one business day after the date of deposit; and*

(3) *Include a verified statement attesting to the facts of the original mailing.*

(e) *If correspondence is properly addressed to the Office pursuant to § 2.190 and deposited with sufficient postage in the Priority Mail Express® Post Office to Addressee service of the USPS, but not received by the Office, the party who submitted the correspondence may file a petition to the Director under § 2.146(a)(2) to consider such correspondence filed in the Office on the USPS deposit date. The petition must:*

(1) *Be filed within two months after the date of deposit;*

(2) *Include a copy of the previously mailed correspondence showing the number of the Priority Mail Express® mailing label thereon; and*

(3) *Include a verified statement attesting to the facts of the original mailing.*

The Priority Mail Express® Post Office to Addressee service is not applicable to the filing of an extension of time to oppose a Trademark Act § 66(a) application, [15 U.S.C. §1141f\(a\)](#), or a notice of opposition involving an application under Trademark Act § 66(a). [Note 1.]

Any paper or fee that meets an exception of the requirement to file through ESTTA, can be filed utilizing the Priority Mail Express® Post Office to Addressee service of the United States Postal Service, and be considered as having been filed in the Office on the date of deposit with the USPS. [Note 2.]

In effect, the Priority Mail Express® procedure permits all types of permitted correspondence intended for the Board to be sent by the Priority Mail Express® Post Office to Addressee service even on the due date for the correspondence and still be considered timely, notwithstanding the fact that the mailed correspondence may not be received by the Board until after the due date. This filing procedure applies only to the Priority Mail Express® Post Office to Addressee service of the United States Postal Service, not any third-party carrier that offers overnight delivery. [Note 3.]

Please Note: Priority Mail Express® now substitutes for “Express Mail.”

NOTES:

1. [37 C.F.R. § 2.102\(a\)\(1\)](#) (extension of time to oppose) and [37 C.F.R. § 2.101\(b\)\(3\)](#) (notice of opposition).
2. See [37 C.F.R. § 2.198\(a\)](#). See also [TMEP § 305.03](#) for Priority Mail Express® procedures for the Trademark Operation.
3. See, e.g., *In re Pacesetter Group, Inc.*, 45 USPQ2d 1703, 1704 (Comm’r 1994) (correspondence sent by Federal Express not entitled to benefit of Express Mail procedure).

111.01(a) Requirements for Priority Mail Express®

Prior to the original mailing, the Priority Mail Express® mailing label number should be placed on correspondence filed thereunder. The number of the mailing label should be placed on each separate submission and each fee transmitted, either directly on the document or on a separate paper firmly and securely attached to the document.

A party meeting an exception of the requirement to file submissions in Board proceedings through ESTTA who elects to send mail to the Board by the Priority Mail Express® service of the U.S. Postal Service should be careful to use the "Priority Mail Express® Post Office to Addressee" service, rather than the Priority Mail Express® “Hold for Pickup” service which delivers the mail Post Office to Post Office.

111.01(b) Questionable Date of Mailing

If the “date accepted” appearing on the Priority Mail Express® label is illegible, the filing date will be the actual receipt date by the USPTO. [37 C.F.R. § 2.198\(b\)](#). If there is a discrepancy between the filing date assigned by the Office and the date of deposit, the person who filed the correspondence may petition the Director to accord the “date accepted” date by providing the evidence set forth in [37 C.F.R. § 2.198\(c\)](#), [37 C.F.R. § 2.198\(d\)](#), and [37 C.F.R. § 2.198\(e\)](#). [Note 1.]

NOTES:

1. See [TMEP § 305.03](#) for further information on petitions to change the filing date.

111.02 Certificate of Mailing – In General**[37 C.F.R. § 2.197](#) Certificate of mailing.**

(a) *The filing date of correspondence submitted under this section is the date of deposit with the USPS if the correspondence:*

- (1) *Is addressed as set out in § 2.190 and deposited with the USPS with sufficient postage as first-class mail; and*
- (2) *Includes a certificate of mailing for each piece of correspondence that:*
 - (i) *Attests to the mailing and the address used;*
 - (ii) *Includes the name of the document and the application serial number or USPTO reference number, if assigned, or registration number to which the document pertains;*
 - (iii) *Is signed separately from any signature for the correspondence by a person who has a reasonable basis to expect that the correspondence would be mailed on the date indicated; and*
 - (iv) *Sets forth the date of deposit with the USPS.*

(b) *If correspondence is mailed in accordance with paragraph (a) of this section, but not received by the Office, the party who mailed such correspondence may file a petition to the Director under § 2.146(a)(2) to consider such correspondence filed in the Office on the date of deposit with the USPS. The petition must:*

- (1) *Be filed within two months after the date of mailing;*
- (2) *Include a copy of the previously mailed correspondence and certificate; and*
- (3) *Include a verified statement attesting to the facts of the original mailing.*

(c) *If the certificate of mailing does not meet the requirements of paragraph (a)(2) of this section, the filing date is the date the Office receives the submission.*

A party meeting an exception of the requirement to file submissions in Board proceedings through ESTTA who elects to file correspondence by mail may utilize the certificate of mailing procedure.

Permitted correspondence required to be filed within a set period of time will be considered as being timely filed, even though the correspondence is not received by the Office until after the expiration of the set period, if, prior to the expiration of the set period, (1) the correspondence is mailed to the Office by first-class mail, with the proper address, and (2) includes a certificate of mailing which meets the requirements specified in [37 C.F.R. § 2.197\(a\)](#). [Note 1.]

In effect, the certificate of mailing procedure permits correspondence to be sent to the Office by first-class mail, even on the due date for the correspondence and still be considered timely, notwithstanding the fact that the mailed correspondence will not be received in the Office until after the due date. [Note 2.]

However, the Board, in its discretion, may require additional evidence to determine if correspondence which bears a certificate of mailing or a certificate of transmission was timely filed, i.e., was mailed or transmitted on the date stated in the certificate. [Note 3.]

The certificate of mailing procedure applies to the filing of many types of correspondence in Board proceedings. However, the certificate of mailing procedure is not available for extensions of time to oppose Trademark Act § 66(a) applications or for the filing of oppositions involving Trademark § 66(a) applications. See [TBMP § 111.02\(f\)](#)

The certificate of facsimile transmission procedure is no longer available for any submissions. [Note 4.] See [TBMP § 107](#) (How and Where to File Papers and Fees).

NOTES:

1. [37 C.F.R. § 2.197\(a\)](#); *In re LS Bedding*, 16 USPQ2d 1451, 1452-53 (Comm'r 1990) (certificate of mailing procedure is used to determine timeliness, while the actual receipt date is used for all other purposes, such as an application filing date). See *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1734 n.2 (TTAB 2001) (no certificate of mailing).
2. See *Luemme Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758, 1759 n.1 (TTAB 1999) (motion to extend filed by a certificate of mailing dated next business day was timely where the period closed on the preceding day, a Sunday).
3. *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1295 (TTAB 1997) (where prima facie proof of certificate of mailing is rebutted by other evidence, person signing certificate must submit an affidavit specifying the date of actual deposit). Cf. *In re Klein*, 6 USPQ2d 1547, 1551-52 (Comm'r 1987), *aff'd sub nom. Klein v. Peterson*, 696 F. Supp. 695, 8 USPQ2d 1434 (D.D.C. 1988), *aff'd* 866 F.2d 412, 9 USPQ2d 1558 (Fed. Cir. 1989).
4. See CHANGES TO THE TRADEMARK RULES OF PRACTICE TO MANDATE ELECTRONIC FILING, 84 Fed. Reg. 37081, 37085 (July 31, 2019). (“[F]acsimile transmissions, ... are not permitted under this rule for any applications or submissions.”).

111.02(a) Requirements for Certificate

[37 C.F.R. §2.190](#) *Addresses for trademark correspondence with the United States Patent and Trademark Office.*

(a) **Paper trademark documents.** *In general, trademark documents to be delivered by the USPS must be addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451. Trademark-related documents to be delivered by hand, private courier, or other delivery service may be delivered 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.** *Trademark documents filed electronically must be submitted through TEAS. Documents that relate to proceedings before the Trademark Trial and Appeal Board must be filed electronically with the Board through ESTTA.*

(c) **Trademark assignment documents.** *Requests to record documents in the Assignment Recordation Branch may be filed electronically through ETAS. Paper documents and cover sheets to be recorded in the Assignment Recordation Branch should be addressed as designated in § 3.27 of this chapter.*

(d) **Requests for certified copies of trademark documents.** *Paper requests for certified copies of trademark documents must 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 of this chapter, and petitions to the Director to review an action of the Office's Madrid Processing Unit must be addressed to: Madrid Processing Unit, 600 Dulany Street, Alexandria, VA 22314-5796.*

The requirements for filing trademark-related documents on paper (except for paper trademark-related documents sent to the Assignment Recordation Branch for recordation and requests for certified copies of trademark application and registration documents) by the certificate of mailing procedure are as follows:

(1) Prior to the expiration of the set period, the correspondence must be deposited with the U.S. Postal Service, with sufficient postage as first-class mail, addressed to:

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

and;

(2) Each piece of correspondence must include a certificate which states the date of deposit with the USPS, attests to the mailing and the address used, includes the name of the document and the application serial number, reference number, or registration to which it pertains, and is signed (separate and apart from any signature for the piece of correspondence itself) by a person who has a reasonable basis to expect that the correspondence will be mailed on or before the date indicated. [Note 1.]

Paper trademark-related documents sent to the Assignment Recordation Branch for recordation should be addressed to: Mail Stop Assignment Recordation Branch Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450. If a certificate of mailing is used on such correspondence, it should specify that address. [Note 2.]

Requests for certified copies of trademark documents pertaining to applications and registrations are handled by the USPTO Patent and Trademark Office Certified Copy Center. Requests are submitted online at <https://certifiedcopycenter.uspto.gov/>. See [TBMP § 121](#) for further information on obtaining file copies.

The Assignment Recordation Branch of the Public Records Division also has an electronic trademark assignment recording form on the Office website. The system is called ETAS (Electronic Trademark Assignment System) and allows customers to create and submit a Trademark Assignment Recordation Coversheet by completing online web forms and attaching the supporting legal documentation. The form and additional information can be accessed at www.uspto.gov/trademarks/process/assign.jsp. [Note 4.]

The certificate of mailing procedure may not be used for mail sent to the United States Patent and Trademark Office from a foreign country, because U.S. Postal Service first-class mail services are not available in foreign countries.

A certificate of mailing should be clearly labeled as such and should include a reference to the proceeding number to which it pertains, the date of mailing, and the signature of the person attesting that the document is being mailed on a certain date. When possible, the certificate should appear on the paper being mailed, rather than on a separate sheet of paper.

NOTES:

1. [37 C.F.R. § 2.197\(a\)](#) and [37 C.F.R. § 2.195\(b\)\(3\)](#).
2. [37 C.F.R. § 2.190\(c\)](#); [37 C.F.R. § 3.27](#).
3. [37 C.F.R. § 2.190\(c\)](#).

111.02(b) Suggested Format

Shown below is a suggested format for a certificate of mailing, under [37 C.F.R. § 2.197](#), for trademark-related mail (except for trademark-related documents sent to the Assignment Recordation Branch for recordation and requests for certified copies of trademark application and registration documents):

Certificate of Mailing

I hereby certify that this correspondence

is being deposited with the United States

Postal Service with sufficient postage as

First-class mail in an envelope addressed to:

ATTN: Trademark Trial and Appeal Board

Commissioner for Trademarks

P.O. Box 1451

Alexandria, VA 22313-1451

on _____

Date Signature

Typed or printed name of

person signing certificate

111.02(c) Location of Certificate

If the simple certificate of mailing format shown in [TBMP § 111.02\(b\)](#) is used, it may appear on the first page of the correspondence, if feasible. Otherwise, it should appear in its entirety on the last page of the correspondence to which it pertains. If the certificate is typed, and there is not enough room on the last page to type the certificate in its entirety, it should at least be started on the last page, so that only part of it

continues over to another page. The simple certificate of mailing format should never be used by itself on a separate page at the end of the correspondence. If it is, and the page becomes detached from the rest of the submission, there will be no way of determining the identity of the correspondence to which it relates, and the benefit of the certificate will be lost.

In some cases, there may not be room for a certificate of mailing on a piece of correspondence. In such a case, the certificate may be typed on a separate sheet of paper securely attached to the correspondence.

A certificate placed on a separate sheet of paper must include additional information, namely, a description of the nature of the correspondence to which it pertains, as well as the identity of the application, registration, or Office proceeding in connection with which the correspondence is being filed. If there is any doubt concerning the identity of the correspondence to which a certificate of mailing on a separate sheet pertains, the certificate will not be accepted.

111.02(d) Loss of Certificate of Mailing

If a certificate of mailing is typed on a separate sheet of paper attached to a piece of correspondence, and the certificate becomes detached, after the correspondence is filed in the Office, and does not contain identifying information sufficient to enable the Office to associate the certificate with the appropriate piece of correspondence, the Office will accept, as evidence that the certificate was filed with the specified correspondence, a postcard receipt (*see* [TBMP § 108](#)) which identifies the separate certificate of mailing sheet and the correspondence to which it was attached; accompanied by a copy of the certificate of mailing sheet as originally mailed.

111.02(e) No Receipt of Correspondence Bearing Certificate

In the event that correspondence intended for the USPTO is timely filed with an appropriate certificate of mailing, pursuant to [37 C.F.R. § 2.197](#), but is not received in the Office, and there is a resulting Office action, in a proceeding or an application, which is adverse to the submitting party, the correspondence will be considered timely if the party which submitted it (1) informs the Office of the previous mailing of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence, (2) supplies an additional copy of the previously mailed correspondence and certificate, and (3) includes a statement attesting, on a personal knowledge basis or to the satisfaction of the Director, to the previous timely mailing. The statement must be verified if it is made by a person other than a practitioner, as that term is defined in [37 C.F.R. § 11.1](#). *See also* [TBMP § 107](#) (How and Where to File Papers and Fees). [Note 1.] Documents may not be filed with the Board by facsimile transmission, and any document so filed will not be accepted. [Note 2.]

For lost or misplaced correspondence intended for the Board, the evidence required by [37 C.F.R. § 2.197\(b\)](#) should be submitted to the Board for consideration. If the requirements of [37 C.F.R. § 2.197\(b\)](#) cannot be met, the only alternative is a Petition to the Director.

NOTES:

1. [37 C.F.R. § 2.197\(b\)](#).
2. [37 C.F.R. § 2.190](#) and [37 C.F.R. § 2.195\(c\)](#).

111.02(f) Excluded Filings

The certificate of mailing procedure is **not** applicable to the filing of an extension of time to oppose a Trademark Act § 66(a) application, [15 U.S.C § 1141f\(a\)](#) or a notice of opposition involving an application under Trademark Act § 66(a). [Note 1.] The certificate of mailing procedure is applicable to all other types of paper filings in Board proceedings, only to the limited extent paper filings are permitted (see [TBMP §106.03](#)), including a notice of opposition; a petition to cancel; a request for an extension of time to oppose a Trademark Act § 1 or § 44 application, [15 U.S.C § 1051\(a\)](#) and [15 U.S.C § 1126](#); a notice of appeal to the Board from a final refusal of registration; a notice of appeal to the Court of Appeals for the Federal Circuit from a decision of the Board; and a notice of election (in an inter partes proceeding) to proceed by civil action under Trademark Act § 21(a)(1), [15 U.S.C. § 1071\(a\)\(1\)](#), in response to another party's appeal to the Court of Appeals for the Federal Circuit. Any paper filing must be accompanied by a written statement showing that ESTTA was unavailable due to technical problems, or that extraordinary circumstances are present, and, where required, a Petition to the Director with the requisite petition fee. Petitions to file on paper are generally subject to [37 C.F.R. § 2.146](#) including the requirement for verified facts. [Note 2.] However, a Petition to the Director to accept paper submission of a petition to cancel a registration on the fifth year anniversary of the date of registration is subject to the requirements of [37 C.F.R. § 2.20](#) or 28 U.S.C. § 1746. [Note 3.]

A certificate of mailing is not necessary or appropriate for documents filed using ESTTA. When an ESTTA filing is received by the Board, the filer will be provided with a notice that the document has been successfully filed. *See generally* [TBMP § 110.09](#).

NOTES:

1. [37 C.F.R. § 2.102\(a\)\(1\)](#) (“A request to extend the opposition period for an application based on Section 66(a) of the Act must be filed through ESTTA and may not under any circumstances be filed in paper form.”); [37 C.F.R. § 2.101\(b\)\(3\)](#) (“An opposition to an application based on Section 66(a) of the Act must be filed through ESTTA and may not under any circumstances be filed in paper form.”).
2. [37 C.F.R. § 2.101\(b\)\(2\)](#); [37 C.F.R. § 2.111\(c\)\(2\)\(i\)](#).
3. [37 C.F.R. § 2.111\(c\)\(2\)\(ii\)](#).

111.02(g) A Certificate of Mailing is Not ...

As is evident from the requirements for a certificate of mailing, specified in [37 C.F.R. § 2.197\(a\)](#), the certificate of mailing procedure is not the same as mailing by certified mail. Correspondence sent to the Board by certified mail, and not in compliance with the [37 C.F.R. § 2.197\(a\)](#) requirements for a certificate of mailing, will be stamped with the date of receipt of the correspondence in the Office, and that date will be used for all purposes, including the timeliness of the filing of the correspondence. [Note 1.]

Further, a certificate of mailing is not the equivalent of a certificate of service. A certificate of mailing indicates when correspondence was sent to the Office pursuant to the provisions of [37 C.F.R. § 2.197\(a\)](#). The mailing date recited in a certificate of mailing is used for purposes of determining the timeliness of the filing of the correspondence bearing the certificate. A certificate of service, on the other hand, indicates the date when a copy of the correspondence was served upon another party. A certificate of service cannot be used to prove the timeliness of the filing of the correspondence. *See* [TBMP § 113](#) for information concerning a certificate of service.

NOTES:

1. See [37 C.F.R. § 2.195](#) and [37 C.F.R. § 2.197](#).

112 Times for Taking Action

37 C.F.R. § 2.196 *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 regulation by or 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.

For example, if, as set by the Board, an answer to a complaint falls due on a Saturday, Sunday, or federal holiday within the District of Columbia, an answer filed on the next business day will be considered timely. If, as set by the Board, the close of discovery falls on a Saturday, Sunday, or federal holiday within the District of Columbia, and such date is the due date for written responses to discovery requests (i.e., interrogatories, requests for production of documents, and requests for admission), such responses may be served, and discovery depositions may be taken, on the next business day. Similarly, if, as set by the Board, the close of a testimony period falls on a Saturday, Sunday, or federal holiday within the District of Columbia, testimony depositions may be taken, testimony declarations and affidavits may be filed, and other evidence may be offered, on the next business day. [Note 1.]

If, because of some unscheduled event, such as adverse weather conditions, the Office is officially closed by Executive Order of the President or by the Office of Personnel Management for an entire day, that day will be regarded by the Office as a federal holiday within the District of Columbia. Any action due to be taken, or fee due to be paid, on that day, will be considered timely if the action is taken, or the fee paid, on the next succeeding business day on which the Office is open. If, because of an unscheduled event, the Office is closed for part of a business day, but is open for business for some part of the day between 8:30 a.m. and 5:00 p.m. Eastern Time, any action due to be taken, or fee due to be paid, on that day remains due on that day. [Note 2.] Notification of any change in this policy, given the particular circumstances of an unscheduled event, will be posted on the Office website at www.uspto.gov. [Note 3.] Except for maintenance and emergencies, ESTTA remains available for electronic filing of papers at all times despite official closure of the Office.

Please Note: [37 C.F.R. § 2.196](#) is not applicable when the opening of an assigned period (e.g., discovery, testimony) falls on a Saturday, Sunday or Federal holiday. [37 C.F.R. § 2.196](#) does not apply to a motion that must be filed before the day of the deadline for pretrial disclosures for the first testimony period. [Note 4.]

The provisions of [37 C.F.R. § 2.196](#) do not change the date on which the relevant action must be taken. Instead, the provisions allow an action to be considered timely filed if taken on the next succeeding business day notwithstanding the earlier expiration of the due date on the weekend on or a federal holiday. Thus, when the date for any subsequent action runs from a prior due date or close of a period (e.g., filing a brief after the close of the last testimony period), the due date for the subsequent action is calculated from the actual due date of the prior action or close of the period, not the adjusted date under [37 C.F.R. § 2.196](#).

NOTES:

1. *See, e.g., Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1653 n.8 (TTAB 2007) (Board generally does not distinguish business days and calendar days unless last day of period is not a business day); *Strang Corp. v. Stouffer Corp.*, 16 USPQ2d 1309, 1310 (TTAB 1990) (when the five-year anniversary date of a registration falls on a weekend or holiday, petition filed on next business day is considered to have been filed within five years from the issue date). *Cf. National Football League v. DNH Mgmt. LLC*, 85 USPQ2d 1852, 1854 n.6 (TTAB 2008) (where discovery period closed on Saturday, service of written discovery requests the following Monday was not untimely). **Please Note:** Discovery requests now must be served early enough in the discovery period so that responses are due no later than the close of discovery. Similarly, discovery depositions must be properly noticed and taken during the discovery period. [37 C.F.R. § 2.120\(a\)\(3\)](#).

2. *See, e.g., "Filing of Papers During Unscheduled Closings of the Patent and Trademark Office"*, 1076 TMOG 6 (March 10, 1987), www.uspto.gov/web/offices/com/sol/og/con/files/cons032.htm.

3. *See, e.g., Notice of Shutdown of Certain Electronic Systems of the United States Patent and Trademark Office From Tuesday, December 22, 2015 through Thursday, December 24, 2015*, <http://www.uspto.gov/trademark/trademark-updates-and-announcements/shutdown-certain-electronic-systems-united-states>; and *Notice of USPTO Closure and Designation of September 11, 2001 under 35 U.S.C. § 21(b) for Purpose of Determining Timeliness of Actions or Fees*. www.uspto.gov/emergencyalerts/emergencyclosure01.htm.

4. *Asustek Computer Inc. v. Chengdu Westhouse Interactive Entertainment Co., Ltd.*, 128 USPQ2d 1470, 1471 (TTAB 2018) (motion to compel filed Monday, the deadline for first pretrial disclosures, untimely).

113 Service of Papers**[37 C.F.R. § 2.119](#) Service and signing of papers.**

(a) *Except for the notice of opposition or the petition to cancel, every submission filed in the Office in inter partes cases, including notices of appeal to the courts, must be served upon the other party or parties. Proof of such service must be made before the submission 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 submissions filed with the Board and any other papers served on a party not required to be filed with the Board, 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 must be made by email, unless otherwise stipulated, or if the serving party can show by written explanation accompanying the submission or paper, or in a subsequent amended certificate of service, that service by email was attempted but could not be made due to technical problems or extraordinary circumstances, then service may be made in any of the following ways:*

(1) *By delivering a copy of the submission 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 some person of suitable age and discretion who resides there;*

(4) *Transmission by the Priority Mail Express® 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; or*
- (6) *Other forms of electronic transmission.*

(c) *When service is made by first-class mail, Priority Mail Express®, or overnight courier, the date of mailing or of delivery to the overnight courier will be considered the date of service.*

(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, none of the parties to the proceeding is eligible to use the service option under paragraph (b)(4) of this section. The party not domiciled in the United States may designate by submission filed in the 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 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 chapter. 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) of this chapter, or qualified under § 11.14(b) of this chapter and authorized under § 2.17(f).*

(e) *Every submission 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 submission will not be refused consideration if a signed copy is submitted to the Office within the time limit set in the notification of this defect by the Office.*

* * * *

Parties are required to use email as the method of service for submissions filed with the Board and any other papers not required to be filed with the Board, unless the parties stipulate to an alternative service method, or unless technical problems or extraordinary circumstances prevent email service. [Note 1.] When email service is not practical, for example, due to the size of the attachment, the Board encourages parties to agree on an effective alternative method of service, such as file hosting services. [Note 2.]

NOTES:

1. [37 C.F.R. § 2.119\(b\)](#).
2. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69959 (October 7, 2016).

113.01 Requirement for Service of Submissions

Except for the notice of opposition or the petition to cancel, every submission filed in an inter partes proceeding before the Board, including a notice of appeal from a decision of the Board, must be served by the filing party upon every other party to the proceeding. [Note 1.]

The requirement for service applies not only to submissions filed in an inter partes proceeding before the Board, but also to documents filed in an application or registration which is the subject of such a proceeding, if the documents could have an effect on the inter partes proceeding. For example, a request to amend or correct an application or registration which is the subject of an inter partes proceeding; an abandonment of the application; or a voluntary surrender of the registration, must all be served by the defendant upon every other party to the proceeding.

NOTES:

1. [37 C.F.R. § 2.119\(a\)](#).

113.02 Requirement for Proof of Service

When a party to an inter partes proceeding before the Board files a submission required by [37 C.F.R. § 2.119\(a\)](#) to be served upon every other party to the proceeding, proof that the required service has been made ordinarily must be submitted before the filing will be considered by the Board. Occasionally, in order to expedite matters, and when the interests of the other party or parties would be served thereby, the Board itself will serve, along with an action of the Board relating thereto, a copy of a submission that does not include the required proof of service. For example, if an applicant in an opposition files an abandonment of its involved application without the written consent of the opposer, and the abandonment does not include proof of service upon the opposer, the Board does not send out an action stating that the abandonment will not be considered until proof of service has been submitted. Rather, the Board provides an electronic link to the TTABVUE database for the filed abandonment, along with a copy of an action by the Board entering judgment in opposer's favor pursuant to [37 C.F.R. § 2.135](#) (which provides, in part, that after the commencement of an opposition, if the applicant files a written abandonment of its application or mark without the written consent of every adverse party to the proceeding, judgment shall be entered against the applicant). [Note 1.]

The notice of filing provided by ESTTA to each party when a submission is made does not substitute for service by the filing party. [Note 2.]

NOTES:

1. See, e.g., *Central Manufacturing Inc. v. Third Millennium Tech. Inc.*, 61 USPQ2d 1210, 1212 n.3 (TTAB 2001) (unserved copy of objection to further extensions of time to oppose filed prior to institution of proceeding forwarded to opposer).
2. See *Coffee Studio LLC v. Reign LLC*, 129 USPQ2d 1480, 1482 (TTAB 2019) (filing notice sent to each party by ESTTA does not constitute service).

113.03 Elements of Certificate of Service

The Board will accept, as prima facie proof that a party filing a document in a Board inter partes proceeding has served a copy of the document upon every other party to the proceeding, a statement signed by the filing party, or by its attorney or other authorized representative, clearly stating the date and manner in which service was made. The statement should also specify the name of each party or person upon whom service was made, and the address. The statement must appear on, or be securely attached to, the document being filed. If the statement is on a separate sheet attached to the filing, it should clearly identify the submission and proceeding to which it relates. [Note 1.]

NOTES:

1. See [37 C.F.R. § 2.119\(a\)](#).

Suggested Format

Shown below is a suggested format for a certificate of service:

I hereby certify that a true and complete copy of the foregoing (insert title of submission) has been served on (insert name of opposing counsel or party) by forwarding said copy on (insert date of mailing), via email (or insert other appropriate method of delivery) to: (set out name, address, and email address of opposing counsel or party).

Signature

113.04 Manner of Service

Service of submissions filed with the Board and any paper served on a party not required to be filed with the Board, must be made by email, unless otherwise stipulated, or if the serving party can show by written explanation accompanying the submission or paper, or subsequent amended certificate of service, that service by email was attempted but could not be made due to technical problems or extraordinary circumstances. [Note 1.] The best practice is to reduce such a stipulation to writing, although the agreement should not be filed with the Board unless necessary to resolve a motion.

In the event service by email cannot be made, service of submissions filed in inter partes cases may be made in any of the ways specified in [37 C.F.R. § 2.119\(b\)](#). They are: (1) by hand delivering a copy of the submission to the person being served; (2) by leaving a copy of the submission at the usual place of business of the person being served, with someone in the person's employment; (3) when the person being served has no usual place of business, by leaving a copy of the submission at the person's address, with some person of suitable age and discretion who resides there; (4) transmission by the "Priority Mail Express® 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; and (6) other forms of electronic transmission. [Note 2.]

When service is made by mail, pursuant to [37 C.F.R. § 2.119\(b\)\(4\)](#), the Board considers the mailing date of the submission to be the date when the paper is deposited with the United States Postal Service, i.e., the date when custody of the paper passes to the Postal Service. As provided in [37 C.F.R. § 2.119\(a\)](#), the Board ordinarily accepts, as prima facie proof of the date of mailing, the statement signed by the filing party, or by its attorney or other authorized representative, as to the date and manner of service. However, where the prima facie proof of the certificate of service is rebutted by other evidence, and the paper would be timely served if mailed on the date specified in the certificate of service, but untimely served if not mailed until the date indicated by the rebutting evidence, the Board may request that the person who signed the certificate of service submit an affidavit specifying the date when the paper was actually deposited with the United States Postal Service.

Service may be made by other forms of electronic transmission, such as fax. [Note 3.]

Incorrect manner of service issues by a party domiciled outside the United States is less likely to arise in view of the requirement that foreign domiciled parties to Board proceedings be represented by an attorney who is an active member in good standing of the bar of the highest court of a state in the United States (including the District of Columbia or any Commonwealth or territory of the United States). [Note 4.] Unless a party is domiciled in the United States or its territories, a party cannot represent itself on its own behalf. See [TBMP §114](#). A foreign-domiciled party that has appointed a reciprocally-recognized foreign attorney

or agent, but has not yet appointed U.S. counsel to represent it before the Board, cannot serve an adverse party by the manners of service specified in [37 C.F.R. § 2.119\(b\)\(1\)](#) - [37 C.F.R. § 2.119\(b\)\(3\)](#). Moreover, a foreign party may not substitute its national postal service, or omit reference to the nation of the postal service employed, as a means of using [37 C.F.R. § 2.119\(b\)\(4\)](#) manner of service; [37 C.F.R. § 2.119\(b\)\(4\)](#) requires transmission by the USPS. [Note 5.]

As a practical matter, parties and U.S. counsel that are located outside the United States and are unable to serve submissions by email must meet the service requirement through [37 C.F.R. § 2.119\(b\)\(5\)](#) - [37 C.F.R. § 2.119\(b\)\(6\)](#).

NOTES:

1. [37 C.F.R. § 2.119\(b\)](#).
2. [37 C.F.R. § 2.119\(b\)](#).
3. [37 C.F.R. § 2.119\(b\)\(6\)](#).
4. [37 C.F.R. § 2.11](#), [37 C.F.R. § 2.17\(b\)](#), [37 C.F.R. § 2.17\(c\)](#), [37 C.F.R. § 11.1](#), [37 C.F.R. § 11.14\(c\)\(1\)](#), and [37 C.F.R. § 11.14\(c\)\(2\)](#). See REQUIREMENT OF U.S. LICENSED ATTORNEY FOR FOREIGN TRADEMARK APPLICANTS AND REGISTRANTS, 84 Fed. Reg. 31498, 31501 (July 2, 2019); *Cloudworks Consulting Services Inc. v. Ongoing Operations, LLC*, 2020 USPQ2d 71348, at *1 (TTAB 2020) (“A reciprocally recognized attorney or agent may only appear as an additionally appointed practitioner. A qualified attorney licensed to practice law in the United States, or in any Commonwealth or territory of the United States, must still be appointed as the party’s representative who will file documents with the Board and with whom the Board will correspond.”).
5. [37 C.F.R. § 2.119\(d\)](#) (“If a party to an inter partes proceeding is not domiciled in the United States and is not represented by an attorney . . . located in the United States, none of the parties to the proceeding is eligible to use the service option under paragraph (b)(4) of this section.”).
6. See *Cloudworks Consulting Services Inc. v. Ongoing Operations, LLC*, 2020 USPQ2d 71348, at *1 (TTAB 2020) (Board suspended proceedings pending appointment of United States counsel).

113.05 No Additional Time for Taking Action After Service by Mail

Whenever a party to an inter partes proceeding before the Board is required to take some action within a prescribed period of time after the service of a submission upon that party by another party to the proceeding, and the submission is served by first-class mail, Priority Mail Express®, or overnight courier, the date of mailing or of delivery to the overnight courier will be considered the date of service. The time for taking action is no longer enlarged by 5 days. [Note 1.] Rather, all fifteen-day response dates to submissions served by an adverse party are now amended to twenty days. [Note 2.] In addition, Fed. R. Civ. P. 6(d) is not applicable to Board proceedings. As an alternative to email service, parties may stipulate to accept service by other means but also agree to serve a courtesy copy by email. **Please Note:** a courtesy copy does not substitute for proper service under the applicable Trademark Rules. [Note 3.]

For example, if one party to a proceeding serves, upon another party to the proceeding, a motion to compel discovery by email or other means stipulated to by the parties, the served party’s time for filing a response to the motion will be 20 days from the date of service of the motion “The extra five days provided for in

former § 2.119(c) are already built into the response time period.” [Note 4.] There is no extra response period built into the 30 day response period for responding to discovery or for responding to a motion for summary judgment. [Note 5.]

NOTES:

1. [37 C.F.R. § 2.119\(c\)](#). See also MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69960 (October 7, 2016) (“All fifteen-day response dates initiated by a service date are amended to twenty days.”).
2. See MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69960 (October 7, 2016) (“All fifteen-day response dates initiated by a service date are amended to twenty days.”).
3. *Jacques Moret Inc. v. Speedo Holdings B.V.*, 102 USPQ2d 1212, 1217 n.7 (TTAB 2012).
4. See MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69960 (October 7, 2016).
5. See MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69950-51 (October 7, 2016).

113.06 A Certificate of Service is Not...

A certificate of service is not the equivalent of a certificate of mailing or transmission for any purpose. [TBMP § 111.02\(g\)](#).

114 Representation of a Party

[37 C.F.R. § 2.11](#) *Requirement for representation.*

- (a) *An applicant, registrant, or party to a proceeding whose domicile is not located within the United States or its territories must be represented by an attorney, as defined in § 11.1 of this chapter, who is qualified to practice under § 11.14 of this chapter. The Office cannot aid in the selection of an attorney.*
- (b) *The Office may require an applicant, registrant, or party to a proceeding to furnish such information or declarations as may be reasonably necessary to the proper determination of whether the applicant, registrant, or party is subject to the requirement in paragraph (a) of this section.*
- (c) *An applicant, registrant, or party to a proceeding may be required to state whether assistance within the scope of § 11.5(b)(2) of this chapter was received in a trademark matter before the Office and, if so, to disclose the name(s) of the person(s) providing such assistance and whether any compensation was given or charged.*
- (d) *Failure to respond to requirements issued pursuant to paragraphs (a) through (c) of this section is governed by § 2.65.*
- (e) *Providing false, fictitious, or fraudulent information in connection with the requirements of paragraphs (a) through (c) of this section shall be deemed submitting a paper for an improper purpose, in violation of § 11.18(b) of this chapter, and subject to the sanctions and actions provided in § 11.18(c).*
- (f) *Notwithstanding § 2.63(b)(2)(ii), if an Office action maintains only requirements under paragraphs (a), (b), and/or (c) of this section, or only requirements under paragraphs (a), (b), and/or (c) of this section*

and the requirement for a processing fee under § 2.22(c), the requirements may be reviewed only by filing a petition to the Director under § 2.146.

37 C.F.R. § 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 by being identified as the representative in a document submitted to the Office 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) **Authorization to represent.** When a practitioner qualified under § 11.14 of this chapter signs a document or appears pursuant to paragraph (b) of this section, his or her signature or appearance 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.

(3) **Bar information required.** A practitioner qualified under § 11.14(a) of this chapter will be required to provide the name of a State, as defined in § 11.1 of this chapter, in which he or she is an active member in good standing, the date of admission to the bar of the named State, and the bar license number, if one is issued by the named State. The practitioner may be required to provide evidence that he or she is an active member in good standing of the bar of the specified State.

(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.** The owner of an application or registration may appoint a practitioner(s) qualified to practice under § 11.14 of this chapter to represent the owner for all existing applications or registrations that have the identical owner name.

(e) **Foreign attorneys and agents.** Recognition to practice before the Office in trademark matters is governed by § 11.14(c) 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 recognition.**

(1) The Office considers recognition as to a pending application to end when the mark registers, when ownership changes, or when the application is abandoned.

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

37 C.F.R. § 11.1 Definitions.

* * * *

Unless otherwise clear from the context, the following definitions apply to this part:

* * * *

Attorney or lawyer means an individual who is an active member in good standing of the bar of the highest court of any State. A non-lawyer means a person who is not an attorney or lawyer.

* * * *

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.

* * * *

United States means the United States of America, and the territories and possessions the United States of America.

37 C.F.R. § 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.**

(1) *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 a registered and active member in good standing before the trademark office of the country in which he or she resides and practices and possesses 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 trademark office of such country and the USPTO have reached an official understanding to allow substantially reciprocal privileges to those permitted to practice in trademark matters before the Office. Recognition under this paragraph (c) shall continue only during the period that the conditions specified in this (c) paragraph obtain.*

(2) *In any trademark matter where a foreign attorney or agent authorized under paragraph (c)(1) of this section is representing an applicant, registrant, or party to a proceeding, an attorney, as defined in § 11.1 and qualified to practice under paragraph (a) of this section, must also be appointed pursuant to § 2.17(b) and (c) of this chapter as the representative who will file documents with the Office and with whom the Office will correspond.*

(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) **Appearance.** *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. Except as specified in § 2.11(a) of this chapter, any individual may appear in a trademark or other non-patent matter in his or her own behalf or on behalf of:*

(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;*

(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.*

114.01 Party May Represent Itself

A party, if domiciled in the United States or its territories, may represent itself in an ex parte or inter partes proceeding before the Board, or the party may be represented by an attorney who is licensed to practice law in the United States. [Note 1.]

If a partnership which is a party to a Board proceeding elects to represent itself, the partnership may act through an individual who is a partner. If a party electing to represent itself is a corporation or an association, the party may act through any individual who is (1) an officer of the party and who is (2) in fact authorized to represent it. [Note 2.] Joint owners who elect to represent themselves must act together. [Note 3.]

However, because the governing practices and procedures in proceedings before the Board are quite technical and highly specialized, it is strongly recommended that an attorney knowledgeable about trademark law represent a party. [Note 4.]

Please Note: Effective August 3, 2019, under [37 C.F.R. § 2.11](#), a foreign-domiciled party to a Board proceeding must be represented by an attorney who is an active member in good standing of the bar of the

highest court of a state in the United States (including the District of Columbia or any Commonwealth or territory of the United States). [Note 5.] Domicile for purposes of [37 C.F.R. § 2.11](#) means “permanent legal place of residence” of a natural person or the “principal place of business” of a juristic entity. [Note 6.] A foreign attorney may only appear on a foreign domiciled party’s behalf if the attorney has been reciprocally recognized by the USPTO’s Office of Enrollment and Discipline. [Note 7.] However, even if a foreign applicant has appointed a reciprocally recognized foreign attorney, a qualified attorney who is licensed to practice law in the United States still must be appointed for filing papers and corresponding with the Office. [Note 8.] Generally, if a foreign-domiciled party appears and is not represented by U.S. counsel, the Board will suspend the proceedings and inform the party of the time frame within which it must appoint U.S. counsel to represent it before the Board. [Note 9.]

NOTES:

1. See [37 C.F.R. § 2.11](#); [37 C.F.R. § 11.14\(e\)](#).
2. See [37 C.F.R. § 11.14\(e\)](#).
3. [TMEP § 803.03\(d\)](#). Cf. [37 C.F.R. § 2.193\(e\)\(2\)\(ii\)](#) (“in the case of joint owners who are not represented by a qualified paritioner, all must sign.”).
4. *Hole In 1 Drinks, Inc. v. Lajtay*, 2020 USPQ2d 10020, at *1 (TTAB 2020) (quoting TBMP Section 114.01, and noting that compliance with the Trademark Rules of Practice, and where applicable, the Federal Rules of Civil Procedure and the Federal Rules of Evidence, is required of all parties even those who assume the responsibility and risk of representing themselves).
5. [37 C.F.R. § 2.11](#). See REQUIREMENT OF U.S. LICENSED ATTORNEY FOR FOREIGN TRADEMARK APPLICANTS AND REGISTRANTS, 84 Fed. Reg. 31498, 31498-31501 (July 2, 2019).
6. [37 C.F.R. § 2.2\(o\)](#). See also Trademark Examination Guide 4-19 (Revised) (“Under this rule, a person’s ‘permanent legal place of residence’ is the place the person resides and intends to be the person’s principal home. The ‘principal place of business’ is the location of a juristic entity’s headquarters where the entity’s senior executives or officers ordinarily direct and control the entity’s activities and is usually the center from where other locations are controlled. [37 C.F.R. § 2.2\(p\)](#).”), available at www.uspto.gov.
7. [37 C.F.R. § 11.14\(c\)\(1\)](#)
8. [37 C.F.R. § 11.14\(c\)\(2\)](#); [37 C.F.R. § 2.17\(b\)](#) and [37 C.F.R. § 2.17\(c\)](#). See REQUIREMENT OF U.S. LICENSED ATTORNEY FOR FOREIGN TRADEMARK APPLICANTS AND REGISTRANTS, 84 Fed. Reg. 31498, 31501 (July 2, 2019); *Cloudworks Consulting Services Inc. v. Ongoing Operations, LLC*, 2020 USPQ2d 71348, at *1 (TTAB 2020) (“A reciprocally recognized attorney or agent may only appear as an additionally appointed practitioner. A qualified attorney licensed to practice law in the United States, or in any Commonwealth or territory of the United States, must still be appointed as the party’s representative who will file documents with the Board and with whom the Board will correspond.”).
9. See *Cloudworks Consulting Services Inc. v. Ongoing Operations, LLC*, 2020 USPQ2d 71348, at *1 (TTAB 2020) (Board suspended proceedings pending appointment of United States counsel). See also Trademark Examination Guide 4-19 (Revised) at 8 (September 2019), available at www.uspto.gov.

114.02 Selection of Attorney

The Board cannot aid a party in the selection of an attorney, nor does the Office maintain a register or list of trademark attorneys. [Note 1.]

NOTES:

1. [37 C.F.R. § 2.11\(a\)](#).

114.03 Representation by Attorney

The term “attorney” (or “lawyer”) is defined in [37 C.F.R. § 11.1](#) as “an individual who is an active member in good standing of the bar of the highest court of any State.” An attorney is eligible to represent others before the Office in trademark matters, including proceedings before the Board, and in other non-patent matters. [Note 1.] Such an attorney is not required to apply to the Office for registration or recognition to practice before the Office in trademark and other non-patent matters. An attorney appearing in a Board proceeding will be required to provide his or her bar membership information to show that he or she is an active member in good standing. [Note 2.]

Please Note: Practice before the Board constitutes practice before the Office, subjecting any such attorney to the USPTO RULES OF PROFESSIONAL CONDUCT. [Note 3.] Attorneys practicing before the Board are encouraged to familiarize themselves with the provisions of Part 11 of 37 C.F.R.

An attorney, as defined in [37 C.F.R. § 11.1](#), will be accepted as a representative of a party in a proceeding before the Board if the attorney (1) signs a document that is filed with the Office on behalf of the party and satisfactorily identifies himself or herself as an attorney or lawyer, or is identified as the representative in a document submitted to the Office on behalf of a party to a proceeding, [Note 4] (2) appears in person, or (3) files a written power of attorney signed by the party the attorney represents. [Note 5.]

When representation has been established by the filing of a document a new notice of appearance is sufficient to change the attorney of record. However, if representation has been established by the filing of a power of attorney, and thereafter another attorney or other authorized representative appears on behalf of the party, a new power of attorney is required to change the attorney of record. See [TBMP § 116](#) (Termination of Representation), [TBMP § 513](#) (Motion to Withdraw as Representative).

When an attorney, as defined in [37 C.F.R. § 11.1](#), acting in a representative capacity signs a document or appears in person in a proceeding before the Board, his or her personal signature or appearance constitutes a representation to the Office that, under the provisions of [37 C.F.R. § 11.14](#) (which specifies the types of individuals who may practice before the Office in trademark and other non-patent matters) and the laws of the jurisdiction where the attorney is licensed to practice that he or she is authorized to represent the particular party in whose behalf he or she acts. If there is some question as to whether an individual who makes such an appearance is authorized to act in a representative capacity, further proof of his or her authority may be required. [Note 6.]

If a formal power of attorney is filed in a proceeding before the Board, it should state the name and address of the individual or individuals to whom the power is granted, identify the party granting the power, indicate the power being granted (e.g., “to represent Opposer in this proceeding, with full power of substitution and revocation, and to transact all business in the United States Patent and Trademark Office in connection therewith”), and be signed by the party granting the power. The Office requires that a power of attorney

specify the names of one or more individuals to whom the power is granted. A power that specifies both the names of one or more individuals and the name of a firm will be regarded as a power to the individual(s). [Note 7.] A power that specifies only the name of a firm will be regarded not as a power to the firm but rather simply as a designation of an address to which correspondence is to be sent. [Note 8.] See [TBMP § 117](#) (Correspondence – With Whom Held).

Please Note: Effective August 3, 2019, the Office amended [37 C.F.R. §2.11\(a\)](#) to require foreign-domiciled applicants, registrants, or parties to a trademark proceeding to be represented by an attorney who is licensed to practice law in the United States. The term “domicile” means the “permanent legal place of residence” of a natural person or the “principal place of business” of a juristic entity. [37 C.F.R. §2.2\(o\)](#).

For representation by a foreign attorney, or agent, including a Canadian trademark attorney or agent, see [TBMP §114.05](#).

NOTES:

1. See [37 C.F.R. § 11.1](#), [37 C.F.R. § 11.14\(a\)](#); *Weiffenbach v. Klempay*, 29 USPQ2d 2027, 2030 (Dep’t of Comm. 1993) (only individuals who are not attorneys and were recognized to practice before the Office in trademark cases prior to January 1, 1957, and attorneys may represent clients before the Office in trademark cases).
2. [37 C.F.R. § 2.17\(b\)\(3\)](#).
3. See [37 C.F.R. § 11.5\(b\)](#) and [37 C.F.R. § 11.19\(a\)](#).
4. [37 C.F.R. § 2.17\(b\)\(1\)\(ii\)](#) and [37 C.F.R. § 2.17\(b\)\(1\)\(iii\)](#). See *Jacques Moret Inc. v. Speedo Holdings B.V.*, 102 USPQ2d 1212, 1216 (TTAB 2012) (law firm that filed motion to dismiss recognized as counsel of record for respondent); *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1613 n.1 (TTAB 1991) (appearance made by filing motion on behalf of respondent).
5. [37 C.F.R. § 2.17\(b\)\(1\)\(i\)](#) and [37 C.F.R. § 2.17\(c\)](#).
6. [37 C.F.R. § 2.17\(b\)\(2\)](#).
7. *HKG Industries Inc. v. Perma-Pipe Inc.*, 49 USPQ2d 1156, 1158 (TTAB 1998) (other named attorneys appointed by petitioner were authorized to represent petitioner and assume responsibility for the case).
8. [TMEP § 605.01](#) (Requirements for Power of Attorney).

114.04 Representation by Non-lawyer (i.e., "Other Authorized Representative")

The only non-lawyers permitted to represent others in trademark cases before the Office, including proceedings before the Board, are those who were recognized to practice before the Office in trademark cases prior to January 1, 1957. [Note 1.] Before such a representative may take any action of any kind in a proceeding before the Board, however, the representative must file in the proceeding a written authorization from the party that he or she represents, or from another person entitled to prosecute the case (e.g., the party’s appointed attorney of record). [Note 2.]

NOTES:

1. [37 C.F.R. § 11.14 \(b\)](#); *Weiffenbach v. Klempay*, 29 USPQ2d 2027, 2031 (Dep't of Comm. 1993) (patent agent, admitted to practice before the Office in patent cases after January 1, 1957, was excluded from trademark practice before the Office); *Weiffenbach v. Frank*, 18 USPQ2d 1397, 1400 (consent order) (Comm'r 1991) (patent agent who engaged in unauthorized representation in trademark matters reprimanded and barred from such practice). *But see* [37 C.F.R. § 11.18\(c\)](#) and [37 C.F.R. § 11.14\(e\)](#).
2. [37 C.F.R. § 2.17\(f\)](#).

114.05 Representation by Foreign Attorney or Agent**(c) Foreigners**

(1) *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 a registered and active member in good standing before the trademark office of the country in which he or she resides and practices and possesses 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 trademark office of such country and the USPTO have reached an official understanding to allow substantially reciprocal privileges to those permitted to practice in trademark matters before the Office. Recognition under this paragraph (c) shall continue only during the period that the conditions specified in this paragraph (c) obtain.*

(2) *In any trademark matter where a foreign attorney or agent authorized under paragraph (c)(1) of this section is representing an applicant, registrant, or party to a proceeding, an attorney, as defined in § 11.1 and qualified to practice under paragraph (a) of this section, must also be appointed pursuant to § 2.17(b) and (c) of this chapter as the representative who will file documents with the Office and with whom the Office will correspond.*

[37 C.F.R. § 11.14\(f\) 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.*

Under certain conditions, specified in [37 C.F.R. § 11.14\(c\)](#), a foreign attorney or agent who is not a resident of the United States may be recognized for the limited purpose of representing, in trademark cases before the Office, parties located in the country in which the attorney or agent resides or practices. An individual seeking recognition to practice under [37 C.F.R. § 11.14\(c\)](#) must apply in writing to the Director of the Office of Enrollment and Discipline, and pay the appropriate fee. [Note 1.]

Currently, the USPTO's Office of Enrollment and Discipline recognizes only Canada as qualifying for the limited exception provided in [37 C.F.R. § 11.14\(c\)](#), permitting the Canadian trademark attorneys and agents to represent a Canadian party before the Office. The Office of Enrollment and Discipline maintains a list of attorneys who are registered or in good standing with the Canadian Intellectual Property Office. [Note 2.]

Please Note: After August 3, 2019, only Canadian trademark attorneys and agents continue to be authorized to represent Canadian parties in trademark matters before the USPTO as additionally appointed practitioners, so long as they remain registered and in good standing in Canada and are formally reciprocally recognized by the USPTO's Office of Enrollment and Discipline. [Note 3.] Canadian patent agents are no longer authorized to practice before the USPTO in trademark matters. [Note 4.] For inter partes matters and ex

parte appeals pending before August 3, 2019, currently reciprocally recognized Canadian patent attorneys and agents may complete their representation on behalf of a party but may not handle new trademark matters. [Note 5.] A reciprocally recognized Canadian trademark attorney or agent may only appear as an additionally appointed practitioner, [Note 6], and a party is required to appoint a qualified U.S. licensed attorney as the representative who will file documents with the Board and with whom the Board will correspond. [Note 7.] As an additionally appointed practitioner, the Canadian trademark attorney or agent remains authorized to prepare and sign Board filings and to communicate with Board personnel by telephone or email. [Note 8.]

The certificate of mailing procedure is not available for use on mail that originates in Canada, as it is not deposited in the United States mail as required by the certification.

NOTES:

1. [37 C.F.R. § 11.14\(f\)](#).
2. See [TMEP § 602.03](#) (Foreign Attorneys and Agents); REQUIREMENT OF U.S. LICENSED ATTORNEY FOR FOREIGN TRADEMARK APPLICANTS AND REGISTRANTS, 84 Fed. Reg. 31498, 31501 (July 2, 2019) (“Currently, only Canadian attorneys and agents [who are registered, active, and in good standing] are reciprocally recognized under § 11.14(c).”); *Cloudworks Consulting Services Inc. v. Ongoing Operations, LLC*, 2020 USPQ2d 71348, at *1 n.4 (TTAB 2020) (“Currently, only Canadian attorneys and agents are reciprocally recognized under this rule and, in accordance therewith, any representation must be limited to parties located in Canada.”).
3. [37 C.F.R. § 11.14\(c\)\(1\)](#). See REQUIREMENT OF U.S. LICENSED ATTORNEY FOR FOREIGN TRADEMARK APPLICANTS AND REGISTRANTS, 84 Fed. Reg. 31498, 31501 (July 2, 2019). (“Recognized Canadian trademark attorneys and agents continue to be authorized to represent Canadian parties in U.S. trademark matters.”).
4. [37 C.F.R. § 11.14\(c\)\(1\)](#). See REQUIREMENT OF U.S. LICENSED ATTORNEY FOR FOREIGN TRADEMARK APPLICANTS AND REGISTRANTS, 84 Fed. Reg. 31498, 31501 (July 2, 2019) (amended rule 37 C.F.R. § 11.14(c)(1) “removes from the regulations ... the authorization for reciprocally recognized Canadian patent agents to practice before the USPTO in trademark matters.”).
5. REQUIREMENT OF U.S. LICENSED ATTORNEY FOR FOREIGN TRADEMARK APPLICANTS AND REGISTRANTS, 84 Fed. Reg. 31498, 31501 (July 2, 2019) (Canadian patent agents are authorized to practice in trademark matters pending before the Office prior to August 3, 2019, the effective date of 37 C.F.R. § 11.14(c)(1), as amended, where they are listed as the representative). See also Requirement of U.S.-Licensed Attorney for Foreign-Domiciled Trademark Applicants and Registrants, Trademark Examination Guide 4-19 (Revised) at 10 (September 2019) (“Currently reciprocally recognized Canadian patent attorneys and agents, may complete matters which were pending before August 3, 2019, where they are listed as representative, but may not handle new trademark matters.”), available at www.uspto.gov.
6. 37 C.F.R. § 2.11(a); [37 C.F.R. § 11.14\(c\)\(1\)](#); [37 C.F.R. § 11.14\(c\)\(2\)](#). See *Cloudworks Consulting Services Inc. v. Ongoing Operations, LLC*, 2020 USPQ2d 71348, at *1 (TTAB 2020).
7. [37 C.F.R. § 11.14\(c\)\(2\)](#). See REQUIREMENT OF U.S. LICENSED ATTORNEY FOR FOREIGN TRADEMARK APPLICANTS AND REGISTRANTS, 84 Fed. Reg. 31498, 31501 (July 2, 2019); *Cloudworks Consulting Services Inc. v. Ongoing Operations, LLC*, 2020 USPQ2d 71348, at *1 n.4 (TTAB 2020).

8. See *Cloudworks Consulting Services Inc. v. Ongoing Operations, LLC*, 2020 USPQ2d 71348, at *1 n.5 (TTAB 2020).

114.06 Individual Not Recognized to Represent Others

An individual who is not recognized, under [37 C.F.R. § 11.14\(a\)](#), [37 C.F.R. § 11.14\(b\)](#), [37 C.F.R. § 11.14\(c\)](#), or [37 C.F.R. § 11.14\(e\)](#) to practice before the Office in trademark cases, will not be permitted to represent a party in a proceeding before the Board. See [TBMP § 114.03-TBMP § 114.05](#) regarding recognition of who may practice before the USPTO in trademark matters.

If it comes to the attention of the Board that an individual who is not recognized, under [37 C.F.R. § 11.14\(a\)](#), [37 C.F.R. § 11.14\(b\)](#), [37 C.F.R. § 11.14\(c\)](#) or [37 C.F.R. § 11.14\(e\)](#), to practice before the Office in trademark cases, is attempting to represent a client in a Board proceeding, the Board will notify the individual that he or she is not entitled to do so. If the individual signs and files a submission on behalf of a client to a Board proceeding, the submission will not be considered unless a new copy thereof, signed by the party or by an authorized representative who is entitled to practice before the Office in trademark cases, is filed. If an individual not authorized to practice before the Office signs an extension of time to oppose and/or a notice of opposition or a petition for cancellation and it comes to the Board's attention, the Board will notify the individual that he or she is not entitled to do so and allow the party time in which to cure the defect. [Note 1.]

However, no Board correspondence intended for the party will be sent to that individual. Rather, the Board will send such correspondence to the party itself, or to the party's attorney or to the party's domestic representative if appropriate. [Note 2.] See [TBMP § 117](#) (Correspondence – With Whom Held).

NOTES:

1. *Birlinn Ltd. v. Stewart*, 111 USPQ2d 1905, 1908 (TTAB 2014) (Board applies opportunity to cure provision in 2.119(e) to improperly signed papers, which defines the time period for cure as “within the time limit set in the notification of this defect by the Office”); 37 C.F.R. § 2.119(e).
2. [37 C.F.R. § 2.18\(a\)](#).

114.07 Designation of Domestic Representative

[37 C.F.R. § 2.24](#) *Designation and revocation of domestic representative by foreign applicant.*

(a) *An applicant or registrant that is not domiciled in the United States 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).*

(b) *The designation, or a request to change or revoke a designation, must set forth the name, email address, and postal address of the domestic representative and be signed pursuant to § 2.193(e)(8).*

(c) *The mere designation of a domestic representative does not authorize the person designated to represent the applicant or registrant.*

[37 C.F.R. § 2.119\(d\)](#) *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, none of the parties to the proceeding is eligible to use the service option under paragraph (b)(4) of this section. The party not domiciled in the United States may designate by submission filed in the Office the name and address*

of a person resident 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 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 chapter. 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).

Generally, foreign-domiciled applicants and parties to a Board proceeding will not need to designate a domestic representative because such applicant and parties are required to be represented by an attorney who is licensed to practice law in the United States. Where records need to be updated during the pendency of a Board proceeding, shown below is a suggested format for the designation of a domestic representative:

Designation of Domestic Representative

(Name of Domestic Representative), whose postal

address is _____

and whose email address is _____,

is hereby designated (Name of Designating Party's)

representative upon whom notice or process in this

proceeding may be served.

(Signature of Designating Party)

(Identification of Person Signing)

(Date of Signature)

The designation of a domestic representative is not the equivalent of a power of attorney. [Note 1.] In other words, a domestic representative cannot represent a party in Board proceedings. The appointment of a domestic representative serves a different purpose; that is to provide a contact and address for service of process. [Note 2.]

Effective August 3, 2019, all foreign-domiciled applicants, registrants, or parties to a Board proceeding must be represented by an attorney licensed to practice law in the United States. [Note 3.] Even if a party

has appointed a domestic representative, once a U.S. licensed attorney is appointed, the Board will send correspondence only to the appointed attorney.

If the foreign-domiciled party has not appointed a domestic representative and a U.S. licensed attorney has not yet been appointed to represent the party in the proceeding, the Board will send correspondence directly to the party at the address of record for the party, unless the party requests in writing to change its address. [Note 4.]

NOTES:

1. See [TMEP § 610](#); *Jacques Moret Inc. v. Speedo Holdings B.V.*, 102 USPQ2d 1212, 1214 n.4 (TTAB 2012) (discussing difference between an attorney designated solely as domestic representative and an attorney appointed as counsel of record).
2. See [TMEP § 610](#).
3. [37 C.F.R. § 2.11](#).
4. [37 C.F.R. § 2.119\(d\)](#); [37 C.F.R. § 2.18\(a\)\(1\)](#).

114.08 Adverse Parties Represented by Same Practitioner

[37 C.F.R. § 11.107](#) *Conflict of interest; Current clients.*

(a) *Except as provided in paragraph (b) of this section, a practitioner shall not represent a client if the representation involves a concurrent conflict of interest. A concurrent conflict of interest exists if:*

- (1) *The representation of one client will be directly adverse to another client; or*
- (2) *There is a significant risk that the representation of one or more clients will be materially limited by the practitioner's responsibilities to another client, a former client or a third person or by a personal interest of the practitioner.*

(b) *Notwithstanding the existence of a concurrent conflict of interest under paragraph (a) of this section, a practitioner may represent a client if:*

- (1) *The practitioner reasonably believes that the practitioner will be able to provide competent and diligent representation to each affected client;*
- (2) *The representation is not prohibited by law;*
- (3) *The representation does not involve the assertion of a claim by one client against another client represented by the practitioner in the same litigation or other proceeding before a tribunal; and*
- (4) *Each affected client gives informed consent, confirmed in writing.*

As a general rule, a practitioner (i.e., attorney or other authorized representative) may not represent parties with conflicting interests in proceedings before the Office. That is, a practitioner normally may not accept proffered employment, or continue multiple employment, if the exercise of the practitioner's independent professional judgment on behalf of one client is likely to be adversely affected by the practitioner's representation of another client, or if the employment would be likely to involve the practitioner in representing differing interests. [Note 1.]

However, a practitioner may represent multiple clients under the particular circumstances specified in [37 C.F.R. § 11.107\(b\)](#).

If it comes to the attention of the Board that two or more parties whose interests are in conflict appear to be represented by the same practitioner, or by different practitioners within the same firm, each of the parties and their practitioner(s) will be notified by the Board, in writing, of the possible conflict of interest.

It is the responsibility of a practitioner to ensure that there is no violation of the rules cited above. If an impermissible conflict exists, a practitioner should take appropriate action immediately. A practitioner who fails to do so may be subject to disciplinary action.

Please Note: Effective May 3, 2013, the United States Patent and Trademark Office adopted new USPTO RULES OF PROFESSIONAL CONDUCT which are based on the American Bar Association’s MODEL RULES OF PROFESSIONAL CONDUCT. Cases decided prior to May 3, 2013 refer to the USPTO CODE OF PROFESSIONAL CONDUCT that was in effect at that time. These earlier cases continue to be instructive.

NOTES:

1. [37 C.F.R. § 11.107](#); *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 221 USPQ 1077, 1082 (Comm’r 1984) (attorney was disqualified, but law firm was not); *Plus Products v. Con-Stan Industries, Inc.*, 221 USPQ 1071, 1075 (Comm’r 1984) (attorney representing respondent in an opposition disqualified in view of his previous representation of petitioner in USPTO proceedings and in infringement litigation concerning the same trademark issues). *But see Gilman Corp. v. Gilman Brothers Co.*, 20 USPQ2d 1238, 1240 (Comm’r 1991) (petitioner’s former attorney in patent matter not disqualified from representing respondent in trademark cancellation proceeding; no “substantial relationship” between prior and present matters); *Unico American Corp. v. Unico Banking Group*, 223 USPQ 684, 685 (Comm’r 1984) (opposer has no right to seek disqualification of applicant’s counsel based on any possible conflict between applicant and third parties).

115 Conduct of Practitioner

115.01 Applicable Rules

The conduct of an attorney or other authorized representative in proceedings before the Board is governed by Part 11 of 37 C.F.R., Subpart D – **USPTO Rules of Professional Conduct** ([37 C.F.R. § 11.101](#) - [37 C.F.R. § 11.901](#)).

Part 11 of 37 C.F.R., Subpart B – **Recognition to Practice Before the USPTO**, addresses the representation of others before the Office, including who is authorized to practice before the United States Patent and Trademark Office (set out in [37 C.F.R. § 11.4](#) - [37 C.F.R. § 11.18](#)). Part 11 of 37 C.F.R., Subpart C – **Investigations and Disciplinary Proceedings; Jurisdiction, Sanctions, Investigations, and Proceedings**, addresses investigations and disciplinary proceedings ([37 C.F.R. § 11.19](#) - [37 C.F.R. § 11.60](#)).

In addition to the requirements specifically applicable to the conduct of practitioners, all parties in matters before the Board, whether represented by counsel or not, are expected to conduct their business with decorum and courtesy. [Note 1.]

NOTES:

1. [37 C.F.R. § 2.192](#); *MySpace Inc. v. Mitchell*, 91 USPQ2d 1060, 1062 n.4 (TTAB 2009) (referencing 37 C.F.R. § 2.192).

115.02 Disciplinary Proceedings**[37 C.F.R. § 2.193](#) Trademark correspondence and signature requirements.**

* * * *

(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) may also be subject to disciplinary action. See §§ 11.18(d) and 11.804 of this chapter.*

[37 C.F.R. § 11.18](#) Signature and certificate for correspondence filed in the Office.

* * * *

(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 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.*

[37 C.F.R. § 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. Violation of any condition of probation shall be cause for imposition of the disciplinary sanction. Imposition of the disciplinary sanction predicated upon violation of probation shall occur only after an order to show cause why the disciplinary sanction should not be imposed is resolved adversely to the practitioner.*

(b) **Conditions imposed with discipline.** *When imposing discipline, the USPTO Director may condition reinstatement upon the practitioner making restitution, successfully completing a professional responsibility course or examination, or any other condition deemed appropriate under the circumstances.*

(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.*

By presenting a submission to the Office, the signer makes the certifications set forth in [37 C.F.R. § 11.18\(b\)](#), and is subject to sanctions under [37 C.F.R. § 11.18\(c\)](#) for violation of [37 C.F.R. § 11.18\(b\)\(2\)](#), regardless of whether the party is a practitioner or non-practitioner. [Note 1.]

The rules governing disciplinary proceedings are set out in [37 C.F.R. § 11.19-37 C.F.R. § 11.60](#). Such a proceeding is instituted only under the circumstances specified in [37 C.F.R. § 11.19](#).

NOTES:

1. For examples of cases involving disciplined practitioners, see *Bender v. Dudas*, 490 F.3d 1361, 83 USPQ2d 1065, 1072-73 (Fed. Cir. 2007) (decision to exclude patent attorney from practicing before the USPTO was not “arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law” in light of attorney’s failure to disclose to clients his financial relationship with invention promotion company); *Sheinbein v. Dudas*, 465 F.3d 493, 80 USPQ2d 1537, 1539 (Fed. Cir. 2006) (decision to exclude patent attorney from practicing before the USPTO was proper based on attorney’s disbarment in Maryland and the District of Columbia for assisting son to flee the United States to avoid murder investigation); *Klein v. Peterson*, 866 F.2d 412, 9 USPQ2d 1558, 1560 (Fed. Cir. 1989) (patent attorney excluded from practice for certificate of mailing violations); *Moatz v. Colitz*, 68 USPQ2d 1079 (Dir. USPTO 2003) (practitioner suspended for, *inter alia*, aiding others in the unauthorized practice of law, sharing fees with non-practitioners, and handling matter without adequate preparation); *In re Rivera*, 67 USPQ2d 1952, 1954-55 (Dir. USPTO 2003) (reciprocal discipline); *In re Ryznic*, 67 USPQ2d 1115, 1122-23 (Dir. USPTO 2003) (agent suspended for, *inter alia*, prosecuting patent application while employed by USPTO); *In re Cohen*, 66 USPQ2d 1782, 1785 (Dir. USPTO 2003) (practitioner suspended for neglecting client matter and other sanctionable conduct); *Moatz v. Kersey*, 67 USPQ2d 1291, 1294-96 (Dir. USPTO 2002) (practitioner represented private clients while employed by U.S. government and failed to notify USPTO of suspension in other jurisdictions); *Weiffenbach v. Logan*, 27 USPQ2d 1870, 1875 (Comm’r 1993) (patent attorney suspended from practice before USPTO for five years for altering an office action in a patent application and engaging in other unethical conduct); *McCandlish v. Doe*, 22 USPQ2d 1223, 1227 (Comm’r 1992) (patent attorney reprimanded by Commissioner for misrepresenting facts and knowingly allowing documents to remain of record which had been withdrawn).

115.03 Petitions to Disqualify

[37 C.F.R. § 11.19\(c\)](#) *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.*

Petitions to disqualify practitioners representing parties in ex parte or inter partes matters before the Board are not disciplinary proceedings and hence are not governed by [37 C.F.R. § 11.19-37 C.F.R. § 11.60](#). Rather, petitions to disqualify are handled on a case-by-case basis. See [TBMP § 114.08](#) (Adverse Parties Represented by Same Practitioner).

When a petition to disqualify is filed in connection with a proceeding pending before the Board, the Board immediately issues an action suspending proceedings in the case and advising the parties that no additional papers should be filed by the parties until further notice, pending briefing and consideration of the petition.

For further information concerning petitions to disqualify, see [TBMP § 513.02](#).

116 Termination of Representation

116.01 Revocation of Authority

[37 C.F.R. § 2.19](#) *Revocation or withdrawal of power 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.*

Authority to represent a party in a proceeding before the Board may be revoked at any stage of the proceeding, by filing a written revocation with the Board. Thereafter, the Board will not recognize that person as a representative in the case, or give any consideration to any submissions which he or she may file therein, unless a new written authorization of that person, signed by the party, is filed in the proceeding.

116.02 Withdrawal as Representative--In General

[37 C.F.R. § 2.19\(b\)](#) *Withdrawal of attorney. If the requirements of § 11.116 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.*

37 C.F.R. § 11.116 Declining or terminating representation.

(a) *Except as stated in paragraph (c) of this section, a practitioner shall not represent a client, or where representation has commenced, shall withdraw from the representation of a client if:*

- (1) *The representation will result in violation of the USPTO Rules of Professional Conduct or other law;*
- (2) *The practitioner's physical or mental condition materially impairs the practitioner's ability to represent the client; or*
- (3) *The practitioner is discharged.*

(b) *Except as stated in paragraph (c) of this section, a practitioner may withdraw from representing a client if:*

- (1) *Withdrawal can be accomplished without material adverse effect on the interests of the client;*
- (2) *The client persists in a course of action involving the practitioner's services that the practitioner reasonably believes is criminal or fraudulent;*
- (3) *The client has used the practitioner's services to perpetrate a crime or fraud;*
- (4) *A client insists upon taking action that the practitioner considers repugnant or with which the practitioner has a fundamental disagreement;*
- (5) *The client fails substantially to fulfill an obligation to the practitioner regarding the practitioner's services and has been given reasonable warning that the practitioner will withdraw unless the obligation is fulfilled;*
- (6) *The representation will result in an unreasonable financial burden on the practitioner or has been rendered unreasonably difficult by the client; or*
- (7) *Other good cause for withdrawal exists.*

(c) *A practitioner must comply with applicable law requiring notice to or permission of a tribunal when terminating a representation. When ordered to do so by a tribunal, a practitioner shall continue representation notwithstanding good cause for terminating the representation.*

(d) *Upon termination of representation, a practitioner shall take steps to the extent reasonably practicable to protect a client's interests, such as giving reasonable notice to the client, allowing time for employment of other counsel, surrendering papers and property to which the client is entitled and refunding any advance payment of fee or expense that has not been earned or incurred. The practitioner may retain papers relating to the client to the extent permitted by other law.*

Under certain circumstances, a practitioner may withdraw from employment as the attorney or other authorized representative of a party to a proceeding before the Board. A practitioner who wishes to withdraw must file

a written request with the Board for permission to do so. The practitioner may not be able to withdraw until he or she has complied with the conditions specified in [37 C.F.R. § 11.116\(c\)](#)- 37 C.F.R. § 11.116(d).

116.03 When Withdrawal is Mandatory

Withdrawal from employment as the attorney or other representative of a party to a Board proceeding is mandatory under the circumstances specified in [37 C.F.R. § 11.116\(a\)](#).

116.04 When Withdrawal is Permissive

Withdrawal from employment as the attorney or other authorized representative of a party to a Board proceeding is permissive under the circumstances specified in [37 C.F.R. § 11.116\(b\)](#).

116.05 Request to Withdraw

A practitioner who wishes to withdraw from employment as the attorney or other authorized representative of a party to a proceeding before the Board must file a written request with the Board for permission to do so. The request to withdraw must be based upon one of the grounds for mandatory or permissive withdrawal listed in [37 C.F.R. § 11.116\(a\)](#) and [37 C.F.R. § 11.116\(b\)](#). Moreover, the practitioner must comply with the requirements of [37 C.F.R. § 11.116\(c\)](#) and [37 C.F.R. § 11.116\(d\)](#). [Note 1.]

The propriety of a request for permission to withdraw as counsel in an application that is the subject of a potential opposition is determined by the Board, and not the Trademark Examining Operation. See [TBMP § 212.01](#).

For further information concerning the requirements for a request to withdraw as representative, and the action taken by the Board when such a request is granted, see [TBMP § 513.01](#).

Please Note: Effective May 3, 2013, the United States Patent and Trademark Office adopted new USPTO RULES OF PROFESSIONAL CONDUCT which are based on the American Bar Association's MODEL RULES OF PROFESSIONAL CONDUCT. Cases decided prior to May 3, 2013 refer to the USPTO RULES CODE OF PROFESSIONAL CONDUCT that was in effect at that time. These earlier cases continue to be instructive.

NOTES:

1. See [37 C.F.R. § 2.19\(b\)](#) and [37 C.F.R. § 11.116](#); *In re Slack*, 54 USPQ2d 1504, 1505 (Comm'r 2000) (standards and procedure for withdrawal); *In re Legendary Inc.*, 26 USPQ2d 1478, 1479 (Comm'r 1992) (same). See also *SFW Licensing Corp. v. Di Pardo Packing Ltd.*, 60 USPQ2d 1372, 1374 (TTAB 2001) (request to withdraw may not be used as a subterfuge for an extension of time; request to withdraw and motion to extend filed on last day of testimony period denied).

117 Correspondence - With Whom Held

[37 C.F.R. § 2.18](#) *Correspondence, with whom held.*

(a) *Establishing the correspondent.* The Office will send correspondence as follows:

(1) *If the applicant, registrant, or party to a proceeding is not represented by an attorney qualified to practice before the Office under § 11.14(a) of this chapter, the Office will send correspondence to the applicant, registrant, or party to the proceeding.*

(2) *If an attorney is recognized as a representative pursuant to § 2.17(b)(1), the Office will correspond only with that attorney. A request to change the correspondence address does not revoke a power of attorney. Except for service of a cancellation petition, the Office will not correspond directly with the applicant, registrant, or a party to a proceeding, or with another attorney from a different firm, unless:*

(i) *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);*

(ii) *The attorney has been suspended or excluded from practicing in trademark matters before the USPTO; or*

(iii) *Recognition of the attorney has ended pursuant to § 2.17(g).*

(b) ***Ex parte matters.*** *Only one correspondence address may be designated in an ex parte matter.*

(c) ***Maintaining and changing the correspondence addresses.*** *The applicant, registrant, or party to a proceeding must maintain current and accurate correspondence addresses, as required by § 2.23, for itself and its attorney, if one is designated. If any of these addresses change, a request to change the address, signed in accordance with § 2.193(e)(9), must be promptly filed.*

(d) ***Post registration filings under sections 7, 8, 9, 12(c), 15, and 71 of the Act.*** *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 Act, renewal application under section 9 of the Act, or request for amendment or correction under section 7 of the Act, if a new address is provided, in accordance with paragraph (a) of this section.*

37 C.F.R. § 2.24 *Designation and revocation of domestic of representative by foreign applicant.*

(a) *An applicant or registrant that is not domiciled in the United States 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).*

(b) *The designation, or a request to change or revoke a designation, must set forth the name, email address, and postal address of the domestic representative and be signed pursuant to § 2.193(e)(8).*

(c) *The mere designation of a domestic representative does not authorize the person designated to represent the applicant or registrant.*

37 C.F.R. § 2.119(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, none of the parties to the proceeding is eligible to use the service option under paragraph (b)(4) of this section. The party not domiciled in the United States may designate by submission filed in the Office the name and address of a person resident 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 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 chapter. 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) of this chapter, or qualified under § 11.14(b) of this chapter and authorized under § 2.17(f).*

117.01 In General

Whenever the Board takes an action in a proceeding before it, the Board sends a copy of the action to each party or to the party's attorney. For an unrepresented party, such correspondence will be sent to the party at the party's address of record in the proceeding, which may be updated by the party by designating in writing another address to which correspondence is to be sent. If an appearance is made on behalf of the party by an attorney (as defined in [37 C.F.R. § 11.1](#)), or a written power of attorney is filed, the Board will send correspondence to the attorney who makes the appearance, or to the attorney designated in the power of attorney. [Note 1.] If there is no attorney of record for a foreign-domiciled party, but a domestic representative has been appointed, correspondence will be sent to the domestic representative until an attorney is appointed. [Note 2.]

If the Board has an email address for Board correspondence with a party, notice of all Board actions will be sent by email. [Note 3.] A "hard copy" may not be sent by postal mail. For applications filed prior to February 15, 2020, an email address for Board correspondence will be obtained in the case of an applicant in an ex parte appeal or in an opposition if the applicant had previously supplied an email address in connection with the prosecution of the subject application and had authorized the Office to communicate with applicant by email. For applications filed on or after February 15, 2020, the Board will obtain and use the valid email address required to be provided by all applicants and registrants that are not exempted by treaty or by any appointed attorney for receipt of correspondence from the USPTO. [Note 4.] In all other cases, the Board will obtain an email address for a party when that party files correspondence with the Board using ESTTA, or files a change of correspondence address specifying an email address.

The Board considers the submission of filings using ESTTA as consent to the Board's sending notice of Board actions by email. Unlike the case with paper correspondence, a party may designate more than one email address (separated by commas, up to a limit of 800 characters) for receipt of notice of Board actions. Because notice of Board actions will not always be sent by both electronic and postal mail, it is essential that parties filing electronically with the Board adjust their email "spam" filters to always accept messages from the USPTO domain (uspto.gov). The USPTO webpage entitled "Don't Miss Important E-mails from the USPTO: Add the USPTO to your 'Safe Senders' list" at <https://www.uspto.gov/trademark/trademark-updates-and-announcements/dont-miss-important-e-mails-uspto> includes instructions to ensure that USPTO emails reach the recipient.

If the Board does not have an email address for Board correspondence with a party, a copy of any Board action taken in the case will be sent to that party by postal mail at the party's address of record.

The mailing of correspondence in accordance with standard Office mailing procedures creates a presumption of receipt of correspondence. [Note 5.]

NOTES:

1. See *Societe des Produits Nestle S.A. v. Basso Fedele & Figli*, 24 USPQ2d 1079, 1079-1080 (TTAB 1992) (new power of attorney filed); *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1614 n.1 (TTAB 1991) (appearance made by filing motion in the proceeding).

2. See [37 C.F.R. § 2.18\(b\)](#) (changing the correspondence address). See, e.g., *Equine Touch Foundation Inc. v. Equinology Inc.*, 91 USPQ2d 1943, 1944 n.3 (TTAB 2009) (noting that although counsel filed an answer for respondent, the ESTTA cover sheet generated in filing the answer still listed the correspondence address as respondent rather than counsel and that "[i]f counsel intends to represent respondent throughout

the remainder of this proceeding, counsel should file a change of correspondence address to list himself and his address as the address for correspondence from the Board and future service copies from petitioner.”).

3. CHANGES TO THE TRADEMARK RULES OF PRACTICE TO MANDATE ELECTRONIC FILING, 84 Fed. Reg. 37081, 37082 (July 31, 2019) (“This rule requires applicants and registrants, and parties to a proceeding before the TTAB, to provide and maintain an email address for correspondence.”).

4. CHANGES TO THE TRADEMARK RULES OF PRACTICE TO MANDATE ELECTRONIC FILING, 84 Fed. Reg. 37081, 37082-84 (July 31, 2019); CHANGES TO THE TRADEMARK RULES OF PRACTICE TO MANDATE ELECTRONIC FILING, 84 Fed. Reg. 69330, 69330 (Dec. 18, 2019) (delay of effective date to February 15, 2020).

5. *Jack Lenor Larsen Inc. v. Chas. O. Larson Co.*, 44 USPQ2d 1950, 1953 (TTAB 1997).

117.02 When There is More Than One Attorney or Other Appointed Practitioner

If a party has supplied a list of email addresses for correspondence with the Board, notice of any Board action will be sent as a courtesy to each of the email addresses supplied. The email address for the party, if the party is not represented, or for the party's attorney if the party is represented, is the official correspondence email for purposes of the Board proceeding. See [TBMP § 117.01](#).

With respect to postal mail, the Board ordinarily will not undertake double correspondence, that is, the sending of paper correspondence to two addresses on behalf of a single party. If more than one attorney or other appointed practitioner makes an appearance on behalf of a party, the papers filed by the additional attorney(s) or other practitioner(s) will be accepted, but the Board will send paper correspondence to only one of them, to be determined according to the circumstances in the case. [Note 1.]

If a power of attorney names more than one individual, and does not specify which of them is to have primary responsibility for the case and receive correspondence, the name(s) of the individual attorney(s) in the signature block of the covering transmittal letter will be used by the Board on the proceeding file, on correspondence for the party, and on the final decision of the Board, to identify counsel for the party, unless the party or one of the named attorneys requests otherwise in writing. If there is no transmittal letter, and no other indication as to which of the named attorneys is to have primary responsibility for the case and receive correspondence, the name of the first listed attorney will be used by the Board on the proceeding file, in the Board's electronic databases (e.g., TTABVUE), on correspondence for the party, and on the Board's final decision, unless the party or one of the named attorneys requests otherwise in writing.

If a power of attorney from a party to one attorney (“A”) has been filed, and thereafter another attorney or other authorized representative (“B”) makes an appearance on behalf of the party and files a written request that correspondence be sent to him or her, B ordinarily will be required to submit authorization, from the party or from A, for the requested change in the correspondence address. However, if B's request for change of correspondence address bears proof of service of a copy thereof upon both the party and A, and neither files an objection to the request, the correspondence address will be changed, and future correspondence will be sent to B, rather than to A.

For example, if one attorney (“A”) makes an appearance on behalf of a party, and his or her address is thus established in the proceeding file as the correspondence address, following which a second attorney (“B”) makes an appearance on behalf of the party, and files a written request that correspondence be sent to him or her, the correspondence address in the proceeding file will be changed, and future correspondence will

be sent to B, rather than A. No requirement will be made that B submit authorization, from the party or from A, for the change of correspondence address, nor will B be required to serve a copy of the request upon A. If B does not file a written request that correspondence be sent to him or her, correspondence will continue to be sent to A.

If a power of attorney from a party to one attorney (“A”) has been filed, and thereafter a power of attorney from the party to another attorney (“B”) is filed, the second power of attorney will be construed, even if there is no revocation of the first power, as a written request to change the correspondence address from A to B, unless the party or A directs otherwise. [Note 2.] Likewise, if an attorney makes an appearance on behalf of a party, and thereafter the party files a written power of attorney to another attorney, the Board will send subsequent correspondence to the appointed attorney.

If a power of attorney from a party to one attorney (“A”) has been filed, and thereafter A files an “associate power of attorney” to another attorney (“B”), the correspondence address will remain unchanged, and the Board will continue to send correspondence to A, unless A or the party directs otherwise. [Note 3.]

If a power of attorney from a party to several attorneys (“A,” “B,” and “C”) in the same firm (“XYZ”) has been filed, and thereafter A leaves the firm but does not file a request that all future correspondence be sent to him or her, rather than to B and/or C, the Board will continue to send correspondence to B and/or C. If A, after leaving firm XYZ, does file a request that all future correspondence be sent to him or her, rather than to B and/or C, the correspondence address will be changed as requested. If, however, B and C object, and maintain that it is they, rather than A, who continue to represent the party and are entitled to receive correspondence, proceedings in the case will be suspended until a designation of correspondence address by the party has been submitted.

If oppositions or petitions for cancellation filed by different opposers or petitioners against the same application or registration are consolidated, or if an opposition or petition for cancellation is filed by joint opposers or petitioners, and the different plaintiffs are represented by different attorneys or other authorized representatives, rather than by the same one(s), the plaintiffs must appoint one lead counsel, to whom the Board may send postal correspondence intended for the plaintiffs. [Note 4.] After the lead counsel has been appointed for postal correspondence, the Board will send a copy of any Board order, decision, or other communication to plaintiff’s lead counsel and to the applicant or its attorney. Lead counsel in turn will be responsible for making and distributing postal copies of such Board correspondence to each plaintiff or its attorney. In these cases, the lead counsel is not substituted for the separate counsel of each plaintiff, but rather is responsible for coordinating the conduct of the plaintiffs’ cases. However, by designating more than one email address (separated by commas, up to a limit of 800 characters) for receipt of notice of Board actions, all representatives may receive electronic correspondence from the Board.

In special circumstances, the Board, in its discretion, may send a particular item of postal correspondence to more than one address on behalf of a single party. However, the Board will not send postal correspondence to more than one address on behalf of a single party on a continuing basis.

NOTES:

1. See [37 C.F.R. § 2.18](#).
2. See [TMEP § 604.03](#).
3. See [TMEP § 605.03](#).

4. *Cf. Internet Inc. v. Corp. for National Research Initiatives*, 38 USPQ2d 1435, 1436 n.2 (TTAB 1996) (in three proceedings where defendant in one case was one of two plaintiffs in the two other cases, and where each plaintiff retained separate counsel, Board indicated that it would send correspondence to attorneys for the plaintiff which was a party to all three cases unless otherwise advised).

117.03 Continuation of Correspondence With Representative in Application or Registration When Inter Partes Proceeding Commences

In the case of a party whose application is the subject of a Board proceeding, any appearance or power of attorney (or designation of other appointed practitioner) of record in the application file at the time of the commencement of the Board proceeding is considered to be effective for purposes of the proceeding, and correspondence will be sent initially to that address, [Note 1] including applicant's email address, if electronic communication with the Office has been authorized or if designation of an email address for correspondence is now required by the Office. Thereafter, the correspondence address may be changed in appropriate circumstances.

However, in the case of a party whose registration is the subject of a proceeding before the Board, any representation which may be of record in the registration file at the time of the commencement of the Board proceeding is not considered to be effective for purposes of the Board proceeding. Rather, correspondence is sent to the registrant itself or its domestic representative unless and until an attorney makes an appearance in the Board proceeding in the registrant's behalf, or a written power of attorney is filed in the proceeding by the registrant, or the registrant requests in writing to change its address. [Note 2.]

Changes of attorney addresses or powers of attorney in registration files are accepted by the Office when submitted with post-registration filings, such as those under Trademark Act § 7, Trademark Act § 8, Trademark Act § 9 or Trademark Act § 15, [15 U.S.C. § 1057](#), [15 U.S.C. § 1058](#), [15 U.S.C. § 1059](#) or [15 U.S.C. § 1065](#), as well as in a cancellation or concurrent use proceeding before the Board. The attorney representing the registrant is responsible for insuring that registrant's correspondence addresses are updated. The Office accepts separate written address changes for registrants and domestic representatives, but global changes of address (when one paper is filed listing all involved registrations) will not be effective in changing the address in each file. A single TEAS form for recording a change of address, found at www.uspto.gov/teas/e-TEAS/index.html, can be used to notice a change of address for more than one application or registration. The TEAS form can be used to change the correspondence address only on applications or registrations that are currently active. [Note 3.]

NOTES:

1. [37 C.F.R. § 2.105\(c\)](#). See MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69954 (October 7, 2016). (“For opposition proceedings, the terminology ‘email or correspondence address of record’ in the rule refers to ‘correspondence address’ as it is used throughout the Rules of Practice in Trademark Cases (e.g., §§ 2.18, 2.21, 2.22, 2.23) and the addition of ‘email’ merely highlights that an email correspondence address may be used when authorized.”).

2. [37 C.F.R. § 2.113\(c\)](#), [37 C.F.R. § 2.18](#). See MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69954 (October 7, 2016). (“The Office plans to effect service using the ‘Current Owner Information’ field or, if one has been appointed, the ‘Domestic Representative Information’ field in the USPTO’s TSDR database.”).

3. [TMEP § 609.02\(b\)](#).

117.04 Continuation of Correspondence with Representative of Potential Opposer After Opposition is Filed

When an attorney is appointed in a power of attorney accompanying an opposition, or makes an appearance by filing an opposition on behalf of the opposer, the Board will send correspondence to that attorney, notwithstanding the fact that another attorney or attorneys may have obtained one or more extensions of time to oppose on behalf of the opposer. If, however, a power of attorney filed with an opposition names several attorneys, and there is no transmittal letter and no other indication as to which of them is to have primary responsibility for the case and receive correspondence, but one of the named attorneys obtained an extension of time to oppose, correspondence will be sent to that attorney; if none of the named attorneys obtained an extension of time to oppose, correspondence will be sent to the first named attorney. Thereafter, the correspondence address may be changed in appropriate circumstances.

117.05 Correspondence After Revocation or Withdrawal

If the authority of an attorney or other authorized representative to represent a party in a proceeding before the Board is revoked, or the practitioner is granted permission to withdraw upon request therefor to the Board, and the party is not represented by any other practitioner, correspondence will be sent to the party at its address of record unless another practitioner puts in an appearance, or a written appointment of another practitioner is filed, or the party designates in writing another address to which correspondence is to be sent.

117.06 Correspondence With Foreign Party

If a party to a Board proceeding is not domiciled in the United States and is not represented by an attorney who is licensed to practice law in the United States, correspondence will be sent to the party's domestic representative, if one has been appointed. However, a domestic representative cannot represent a party in Board proceedings. [Note 1.] If the party has not appointed a domestic representative and a U.S. licensed attorney has not yet been appointed in the proceeding, the Office will send correspondence directly to the party at the address of record for the party, which the party may request in writing to change. [Note 2.]

Please Note: Effective August 3, 2019, the Office amended [37 C.F.R. §2.11\(a\)](#) to require foreign-domiciled applicants, registrants, or parties to a trademark proceeding to be represented by an attorney who is licensed to practice law in the United States. If a foreign-domiciled party appears without an attorney, generally, the Board will suspend the proceedings and inform the party of the time frame within which it must appoint a U.S. licensed attorney. [Note 3.]

NOTES:

1. See [TMEP § 610](#).
2. See [37 C.F.R. § 2.119\(d\)](#).
3. See *Cloudworks Consulting Services Inc. v. Ongoing Operations, LLC*, 2020 USPQ2d 71348, at *1 (TTAB 2020) (Board suspended proceedings pending appointment of United States counsel). See also Requirement of U.S.-Licensed Attorney for Foreign-Domiciled Trademark Applicants and Registrants, Trademark Examination Guide 4-19 (Revised) at 8 (September 2019), available at www.uspto.gov.

117.07 Change of Address

If a party to a Board proceeding or its attorney or other authorized representative moves or changes its postal address or email address, a separate notice of the change of address or email address should be filed with the Board using ESTTA, and should reference the proceeding number. [Note 1.] It is the responsibility of a party to a proceeding before the Board to ensure that the Board has the party's current correspondence address, including an email address. If a party fails to notify the Board of a change of address, with the result that the Board is unable to serve correspondence on the party, default judgment may be entered against the party.

A party or its attorney or other authorized representative should not assume that the inclusion of a new address or email address on a document directed to another matter, or on the envelope in which a paper is filed, is sufficient to notify the Board of a change of address. Paper correspondence sent by mail to the Office is opened in the USPTO Mail Room, and ordinarily the envelopes are discarded there before the mail is sent on to its ultimate destination within the Office. Thus, in the rare instances paper filings are permitted under the rules, the Board normally does not see the return addresses on the mailing envelopes of papers filed in Board proceedings. Moreover, while it is the normal practice of the Board to check the address on newly filed submissions and to change its records to reflect any noted change of address, the Board has no obligation to do so. The responsibility for any failure to receive correspondence due to a change of address of which the Board has not been given separate written notice lies with the party or its attorney or other authorized representative.

The best practice is to promptly file a separate change of address with the Board when the correspondence address, including an email address, for any party to a Board proceeding changes. [Note 2.]

NOTES:

1. See [37 C.F.R. § 2.126\(a\)](#).
2. See [37 C.F.R. § 2.18\(c\)](#).

117.08 Individual Not Entitled to Represent Others

An individual who is not entitled, under [37 C.F.R. § 11.14\(a\)](#), [37 C.F.R. § 11.14\(b\)](#), [37 C.F.R. § 11.14\(c\)](#) or [37 C.F.R. § 11.14\(e\)](#), to practice before the Office in trademark cases, will not be permitted to represent a party in a proceeding before the Board, and may not file submissions on behalf of the party. [Note 1.] If it comes to the attention of a Board attorney that such an individual is attempting to represent a party in a Board proceeding, the Board attorney will bring the matter to the attention of the Chief Administrative Trademark Judge, who will coordinate appropriate action with the Office of Enrollment and Discipline. Moreover, no Board correspondence intended for the party will be sent to the individual. Rather, the Board will send such correspondence to the party itself, or to the party's attorney. [Note 2.] However, under certain circumstances, where a submission is signed by an individual not authorized to practice before the Office, the Board may allow time to cure the signature defect. [Note 3.] See also [TBMP § 114.06](#).

NOTES:

1. See [TMEP § 602](#) (Person Authorized to Practice Before USPTO in Trademark Matters).
2. See [37 C.F.R. § 2.18](#).

3. See, e.g., *Birlinn Ltd. v. Stewart*, 111 USPQ2d 1905 (TTAB 2014) (Board applies opportunity to cure provision in 2.119(e) to improperly signed papers, which defines the time period for cure as “within the time limit set in the notification of this defect by the Office”).

118 Payment of Fees

118.01 Lists of Fees and Charges

A list of the fees and charges established by the USPTO for trademark cases may be found in [37 C.F.R. § 2.6](#), and online at the USPTO’s website, www.uspto.gov. A list of fees and charges established by the USPTO for miscellaneous services may be found in 37 C.F.R. § 1.21, as well as on the USPTO website.

A list of fees and charges for processing correspondence relating to international applications and registrations under the Madrid Protocol may be found in [37 C.F.R. § 7.6](#) as well as on the USPTO website. International fees that may be paid to the International Bureau of the World Intellectual Property Organization through the Office in connection with international applications and registrations may be found in [37 C.F.R. § 7.7](#) as well as on the WIPO website, www.wipo.int.

118.02 Fees Payable in Advance

[37 C.F.R. § 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 the purpose for which the fees are paid is clear. The Office may return fees that are not itemized as required by this paragraph.*

118.02(a) Fees for Extensions of Time for Filing an Opposition

[37 C.F.R. § 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 a request with the Trademark Trial and Appeal Board to extend the time for filing an opposition. The 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 request to extend the time for filing an opposition to an application must be filed through ESTTA by the opposition due date set forth in § 2.101(c). In the event that 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 Section 1 or 44 of the Act may be filed in paper form by the opposition due date set forth in § 2.101(c). A request to extend the opposition period for an application based on Section 66(a) of the Act must be filed through ESTTA and may not under any circumstances be filed in paper form.*

(2) *A paper request to extend the opposition period for an application based on Section 1 or 44 of the Act must be filed by the due date set forth in § 2.101(c) and be accompanied by a Petition to the Director under § 2.146, with the fees therefor and the showing required under paragraph (a)(1) of this section. Timeliness of the paper submission will be determined in accordance with §§ 2.195 through 2.198.*

(b) *A 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 must be in the name of the person to whom the extension was granted, except that 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) * * *

(1) *A person may file a first request for:*

(i) *Either a thirty-day extension of time, which will be granted upon request; or*

(ii) *A ninety-day extension of time, which will be granted only for good cause shown. A sixty-day extension is not available as a first extension of time to oppose.*

(2) *If a person was granted an initial 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) * * * *No other time period will be allowed for a final extension of the opposition period.*

* * *

(d) *The filing date of a request to extend the time for filing an opposition is the date of electronic receipt in the Office of the request. In the rare instance that filing by paper is permitted under these rules, the filing date will be determined in accordance with §§ 2.195 through 2.198*

Certain extensions of time to oppose an application for registration require payment of a fee. All required fees for extensions of time to oppose are per application fees, not per class fees, and must be tendered with the extension request.

There is no fee for an initial thirty-day extension request. There is a per application fee for filing a second request of sixty days or for an initial request of ninety-days for an extension of time to oppose. [Note 1.] There also is a per application fee for filing a final sixty-day request for extension of time to oppose after one or two requests totaling 120 days from the date of publication. [Note 2.]

The fees for an extension of time to oppose are higher for paper submissions. Petition fees are applicable to all requests for extensions of time to oppose filed on paper. [Note 3.]

When a request for extension of time to oppose is filed using ESTTA, as required, the correct fee will be calculated and payment must be made before the filing will be transmitted to the USPTO. Note that in order for fees to be properly calculated, each potential opposer must be entered separately. [Note 4.]

NOTES:

1. [37 C.F.R. § 2.6\(a\)\(22\)\(ii\)](#).
2. [37 C.F.R. § 2.6\(a\)\(23\)\(ii\)](#).
3. [37 C.F.R. § 2.102\(a\)\(2\)](#); [37 C.F.R. § 2.6\(a\)\(22\)\(i\)](#); [37 C.F.R. § 2.6\(a\)\(23\)\(i\)](#); [37 C.F.R. § 2.6\(a\)\(15\)](#).
4. *Cf. Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 n.2 (TTAB 2009) (multiple opposers not entered separately in ESTTA, resulting in improper fee being calculated and paid).

118.02(b) Fees for Opposition and Cancellation Proceedings

37 C.F.R. § 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.*

(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. 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 paragraph (b)(1) or (2) of this section.*

(1) *An opposition to an application must be filed by the due date set forth in paragraph (c) of this section through ESTTA.*

(2) *In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, an opposition against an application based on Section 1 or 44 of the Act may be filed in paper form. A paper opposition to an application based on Section 1 or 44 of the Act must be filed by the due date set forth in paragraph (c) of this section and be accompanied by a Petition to the Director under § 2.146, with the fees therefor and the showing required under this paragraph. Timeliness of the paper submission will be determined in accordance with §§ 2.195 through 2.198.*

(3) *An opposition to an application based on Section 66(a) of the Act must be filed through ESTTA and may not under any circumstances be filed in paper form.*

(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. 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).*

(d) *An otherwise timely opposition cannot be filed 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. A paper opposition that is not accompanied by the required fee sufficient to pay in full for each named party opposer for each class in the application for which registration is opposed may not be instituted. If time remains in the opposition period as originally set or as extended by the Board, the potential opposer may resubmit the opposition with the required fee.*

(e) *The filing date of an opposition is the date of electronic receipt in the Office of the notice of opposition and required fee. In the rare instances that filing by paper is permitted under these rules, the filing date will be determined in accordance with §§ 2.195 through 2.198.*

* * * *

37 C.F.R. § 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.*

(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. 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) A petition to cancel a registration must be filed through ESTTA.

(2)(i) In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, a petition to cancel may be filed in paper form. A paper petition to cancel a registration must be accompanied by a Petition to the Director under § 2.146, with the fees therefor and the showing required under this paragraph (c). Timeliness of the paper submission, if relevant to a ground asserted in the petition to cancel, will be determined in accordance with §§ 2.195 through 2.198.

(ii) For a petition to cancel a registration on the fifth year anniversary of the date of registration of the mark, a petitioner for cancellation who meets the requirements of § 2.147(b) may submit a petition to the Director to accept a timely filed paper petition to cancel.

(d) The petition for cancellation must be accompanied by the required fee for each party joined as petitioner for each class in the registration(s) for which cancellation is sought (see § 2.6). A petition cannot be filed via ESTTA unless the petition is accompanied by a fee that is sufficient to pay in full for each named petitioner to seek cancellation of the registration(s) in each class specified in the petition. A petition filed in paper form that is not accompanied by a fee sufficient to pay in full for each named petitioner for each class in the registration(s) for which cancellation is sought may not be instituted.

(e) The filing date of a petition for cancellation is the date of electronic receipt in the Office of the petition and required fee. In the rare instances that filing by paper is permitted under these rules, the filing date of a petition for cancellation will be determined in accordance with §§ 2.195 through 2.198.

The filing fee for an opposition or cancellation proceeding must be tendered with the notice of opposition or petition for cancellation. A notice of opposition or petition for cancellation filed without a filing fee will not be accorded a filing date. [Note 1.]

When a notice of opposition or petition for cancellation is filed using ESTTA, the correct fee will be calculated and payment must be made before the filing will be transmitted to the USPTO. Note that in order for fees to be properly calculated, each opposer or petitioner must be entered separately. [Note 2.]

If an otherwise timely notice of opposition or petition for cancellation is submitted on paper with less than the full fee due for each party opposer or party petitioner and for each class opposed or sought to be cancelled, the proceeding may not be instituted. [Note 3.] A paper filing of a notice of opposition or petition to cancel must be accompanied by a Petition to the Director, with required fee, and a showing that ESTTA is unavailable due to technical problems, or extraordinary circumstances are present. [Note 4.] Petitions to file on paper generally are subject to [37 C.F.R. § 2.146](#), including the requirement for verified facts. [Note 5.] However, a Petition to the Director to accept paper submission of a petition to cancel a registration on the fifth year anniversary of the date of registration is subject to the requirements of [37 C.F.R. § 2.147\(b\)](#) including the requirement for a declaration under [37 C.F.R. § 2.20](#) or 28 U.S.C. § 1746. [Note 6.]

NOTES:

1. [37 C.F.R. § 2.101\(d\)](#) and [37 C.F.R. § 2.111\(d\)](#).

2. See *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 n.2 (TTAB 2009) (multiple opposers not entered separately in ESTTA, resulting in improper fee being calculated and paid; opposition considered to be properly filed by first-named opposer only).

3. [37 C.F.R. § 2.101\(d\)](#) and [37 C.F.R. § 2.111\(d\)](#).
4. [37 C.F.R. § 2.101\(b\)\(2\)](#) and [37 C.F.R. § 2.111\(c\)\(2\)](#).
5. [37 C.F.R. § 2.101\(b\)\(2\)](#); [37 C.F.R. § 2.111\(c\)\(2\)\(i\)](#).
6. [37 C.F.R. § 2.111\(c\)\(2\)\(ii\)](#).

118.03 Method of Payment--In General

37 C.F.R. § 2.207 Method 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.*

Filers using ESTTA to file submissions with the Board online will be prompted to pay any necessary fees as a part of the ESTTA filing process. When paying a fee through ESTTA, filers may utilize a credit card, electronic funds transfer, or a USPTO deposit account.

In the rare instances that the rules permit filing by paper, it is also the practice of the Office to accept, as "conditional" payment of a fee, a signed uncertified check. If such a check is returned for insufficient funds, the fee remains unpaid, and the filing date of the fee will be the filing date of any resubmitted adequate payment. [Note 1.] An unsigned check will be returned to its sender, but the Director has the discretion to accept such a check, as "conditional" payment, upon petition showing sufficient cause therefor. [Note 2.]

The Office cannot accept U.S. Treasury checks that have been issued to the applicant or to another party as payment of Office fees. This is true for all refund checks whether issued from the Office or any other government agency. Office rules require that money orders and checks be made payable to the Director of Patents and Trademarks and do not permit the acceptance of U.S. Treasury checks endorsed by the applicant in payment of fees.

NOTES:

1. See *In re Cantatore*, 231 USPQ 742, 744 (Comm'r 1986) (petition to revive was denied because filing fee check was returned for insufficient funds).

2. *See Dubost v. U.S. Patent and Trademark Office*, 777 F.2d 1561, 227 USPQ 977, 980 (Fed. Cir. 1985) (Office has discretion), *on remand*, *In re Dubost*, 231 USPQ 887, 889 (Comm’r 1986) (sufficient cause not shown).

118.04 Method of Payment--Deposit Accounts

For the convenience of attorneys and the general public in paying fees and charges to the Office, deposit accounts may be established in the Office. [Note 1.] The Office has an automated financial system, USPTO Financial Manager, allowing transactions to occur over the Internet through the Office website at www.uspto.gov. Deposit accounts can be maintained through the Internet and funds replenished by check or electronic funds transfer. [Note 2.] A deposit account may be used for payment of any necessary fee when filing online using ESTTA, or when necessary to file paper documents.

The fees for filing an ex parte appeal to the Board, certain extensions of time to oppose an application, an opposition, and a petition for cancellation, may all be charged to a deposit account, provided that the requirements of [37 C.F.R. § 2.208](#) are met. However, the charging of a fee against an account that does not contain sufficient funds to cover it cannot be regarded as payment of the fee. [Note 3.] Thus, the overdrawing of a deposit account may result in the loss of a vital date.

The Office will not accept ex parte appeals if the notice of appeal is not accompanied by at least the minimum fee for one class or specific authorization to charge the deposit account for that fee, as opposed to a general authorization which may have been provided when the application was filed. A general authorization to charge a deposit account will only be effective upon petition to the Director. [Note 4.] Because the general authorization can only be invoked on petition, the Board itself cannot accept the general authorization as a basis for treating the appeal fee as timely submitted.

NOTES:

1. *See* [37 C.F.R. § 2.208](#) (Deposit accounts).
2. [37 C.F.R. § 2.208\(c\)](#).
3. *See* [37 C.F.R. § 2.208\(b\)](#).
4. *In re Sky is the Ltd.*, 42 USPQ2d 1799, 1800 (Comm’r 1996) (“Requiring the Office mailroom and the ITU/Divisional Unit of the Office to check each application file for a general authorization to charge a deposit account would place an undue and unmanageable burden on those sections of the Office.”).

119 Papers and Fees Generally Not Returnable

119.01 Fee Refunds--General Rule

[37 C.F.R. § 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 the 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 C.F.R. 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.*

119.02 Submissions and Fees--Ex Parte Cases

After an application has received a filing date, submissions filed in connection therewith, including ex parte appeal papers, will not be returned. [Note 1.] Use of ESTTA for filing with the Board is required. ESTTA will not accept untimely filings or filings with insufficient fees.

In the rare instance that the rules permit a paper-filed notice of appeal, if a notice of appeal to the Board from an examining attorney's final refusal is late filed, the appeal will not be entertained, the application will be abandoned, the notice of appeal will be retained in the Board's file, and any appeal fee submitted therewith will be refunded. If a notice of appeal is filed prematurely, the appeal will not be entertained, the notice of appeal will be retained in the Board's file, the application will be returned to the examining attorney for further appropriate action, and applicant will be advised that if a timely appeal is subsequently filed in the case, any fee submitted with the premature appeal will be applied thereto. If no timely appeal is filed, applicant may request a refund of any such fee.

If a final refusal to register is withdrawn by the examining attorney, and the application is approved for publication, following which the applicant, not knowing that the application has been approved for publication, files a notice of appeal, the appeal will not be instituted, the notice of appeal will be retained in the Board's file, and any appeal fee submitted therewith will be refunded. In such a case, the notice of appeal, and appeal fee, are considered to have been filed in excess, rather than by change of purpose, since at the time of its filing, the appeal was unnecessary. If, however, the examining attorney withdraws the refusal to register, and approves the application for publication after an appeal to the Board has been filed, the appeal will be dismissed as moot, and the appeal fee will not be refunded (the appeal having been necessary at the time of its filing).

NOTES:

1. See [37 C.F.R. § 2.25](#) (Documents not returnable).

119.03 Submissions and Fees--Inter Partes Cases

In the rare instances that filings by paper are permitted under the rules, after an inter partes proceeding before the Board has been filed, paper submissions and other materials filed in connection therewith, normally will not be returned. Paper submissions filed by mail or hand delivery are scanned. After a short period of retention following filing and scanning, the Board disposes of the paper submissions. Following the conclusion of a proceeding, including any appeal period, any physical materials submitted will be disposed of by the Board in an appropriate manner. See [TBMP § 806](#) (Termination of Proceeding). The Board will retain electronic versions of all submissions pursuant to USPTO document retention policies. Confidential submissions will remain sealed after termination of the proceeding. If, because of a defect in an opposition

or a petition for cancellation filed with the Board, a proceeding is not instituted, any submitted fee will be refunded.

Use of ESTTA for filing with the Board is required. ESTTA will not accept untimely filings, filings with insufficient fees, or filings where any of the conditions identified below exist. However, if ESTTA is unavailable due to technical problems, or due to extraordinary circumstances, an opposition or petition for cancellation may be filed on paper, (except for an opposition against a § 66(a) application) if accompanied by a Petition to the Director under [37 C.F.R. § 2.146](#) and the required fee. [Note 1.] A Petition to the Director to accept paper submission of a petition to cancel a registration on the fifth year anniversary of the date of registration is subject to the requirements of [37 C.F.R. § 2.102\(b\)](#) including the requirement for a declaration under [37 C.F.R. § 2.20](#) or 28 U.S.C. § 1746. [Note 2.]

In the rare circumstances where filing by paper is permitted under the rules, no proceeding will be instituted, and any submitted filing fee will be refunded in the following circumstances:

- (1) If an opposition filed during an extension of time to oppose is in the name of someone other than the person who obtained the extension, and the opposer is unable to show, pursuant to [37 C.F.R. § 2.102\(b\)](#), that it is in privity with the person who obtained the extension, or that the person in whose name the extension was requested was misidentified through mistake.
- (2) If an opposition or a petition for cancellation is filed prematurely (i.e., prior to publication of the subject mark in the Official Gazette for purposes of opposition, or prior to issuance of a registration of the subject mark, respectively, even if the registration has issued by the time of the Board's action).
- (3) If an opposition is filed after the time for opposing has expired; or, is filed unsigned, and a signed copy is not submitted within the time limit set in the notification of this defect by the Board; or is filed without the required fee; or if the opposed application was abandoned before the opposition was filed. *See* [TBMP § 218](#) (Abandonment of Application).

No proceeding will be instituted and the filing fee will not be refunded in the following circumstances:

- (1) If a party files an opposition or petition for cancellation in paper form without the Petition to the Director and the required fee under [37 C.F.R. § 2.146](#), or where applicable, [37 C.F.R. § 2.147](#) the proceeding will not be instituted and the filing fee will not be refunded.
- (2) If a party files an opposition or petition for cancellation in paper form accompanied by the Petition to the Director and the required fee and the required showing in the Petition to the Director is found to be insufficient, the proceeding will not be instituted and the filing fee will not be refunded.

Proceedings will be instituted, and the filing fee charged for a permitted filing in paper form in the following circumstances:

- (1) If a petition to cancel a Principal Register registration that is more than five years old does not allege any ground upon which such a registration can be cancelled (*see* Trademark Act § 14, [15 U.S.C. § 1064](#)), the cancellation will be instituted and the Board will issue an order to show cause why the petition should not be dismissed for failure to state a claim. Note that when filing a petition for cancellation online using ESTTA, time-barred grounds for cancellation are not presented as an option.
- (2) If a petition for cancellation is filed with respect to a registration which, at the time of the filing of the petition, was not a "live" registration (e.g., the time for filing an affidavit of use under Trademark Act § 8, [15 U.S.C. § 1058](#), had expired, and no acceptable affidavit had been filed; the registration had already been cancelled as the result of a previous cancellation proceeding), the proceeding will be instituted, and then dismissed as moot.

(3) If a party files an opposition or a petition for cancellation, and immediately thereafter changes its mind, and requests that the opposition or petition for cancellation not be instituted and that the papers be returned, the request ordinarily will be denied, and the proceeding will be instituted, unless there is a defect in the opposition or petition for cancellation which precludes institution, in which case no proceeding will be instituted, and any submitted fee will be refunded.

When the Board finds that it erroneously instituted a proceeding, the proceeding will be dismissed as a nullity. A refund will be issued in most circumstances involving dismissal as a nullity (e.g., institution of duplicate proceedings). All submissions will be retained by the Board under the assigned proceeding number, pursuant to the applicable retention policy.

NOTES:

1. [37 C.F.R. § 2.101\(b\)\(1\)](#); [37 C.F.R. § 2.101\(b\)\(3\)](#); [37 C.F.R. § 2.101\(b\)\(2\)](#); [37 C.F.R. § 2.101\(d\)](#); [37 C.F.R. § 2.113\(c\)\(1\)](#); [37 C.F.R. § 2.111\(c\)\(2\)](#).
2. [37 C.F.R. § 2.111\(c\)\(2\)\(ii\)](#).

120 Access to Files

[37 C.F.R. § 2.27\(d\)](#) *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.*

[37 C.F.R. § 2.27\(e\)](#) *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 a 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.*

120.01 Non - confidential Files

Except for materials filed under seal pursuant to a protective order or agreement, all pending Board proceeding files and exhibits thereto are available for public inspection and copying. [Note 1.] Most Board records since 2001 are electronic. The electronic records of the Board are accessible via TTABVue on the Board's home page of the USPTO website at <http://ttabvue.uspto.gov/>. The electronic record of applications and registrations, which are the subject matter of pending proceedings before the Board, and extensions of time to oppose are accessible via the Internet at <http://tsdr.uspto.gov/>.

Board records submitted prior to approximately 2001 are kept in paper. An individual who wishes to inspect or copy one of the paper files is directed to the National Archives and Records Administration, www.archives.gov/research.

NOTES:

1. See [37 C.F.R. § 2.27](#).

120.02 Confidential Materials

Materials filed with the Board under seal pursuant to the Board's standard protective order, or a protective agreement signed by the parties, or a protective order entered by the Board or any court and filed in compliance with [TBMP § 412.04](#), will be kept confidential and will 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. [Note 1.] These materials may be inspected only by those individuals who are entitled, under the terms of the protective order, to have access to the protected information. [Note 2.] See [TBMP § 412](#). (Protective Orders), [TBMP § 526](#) (Motion for Protective Order), [TBMP § 703.01\(p\)](#) (Confidential or Trade Secret Material). To be handled as confidential, and kept out of the public record, confidential materials must be so designated at the time of filing. Regardless of submission method, all submissions in Board proceedings which are not properly designated as confidential will be placed in the Board's public records, available on the Internet in TTABVUE.

When using ESTTA, the filer should select "CONFIDENTIAL Opposition, Cancellation or Concurrent Use" under "File Documents in a Board Proceeding." [Note 3.] Filings made using this option will not be made available for public viewing, although an entry will be made on the publicly-available docket sheet in TTABVUE.

If a paper submission contains confidential material, it must be submitted under separate cover. Both the submission and its cover must be marked confidential and must identify the case number and the parties. Paper submissions are scanned into TTABVUE and designated "confidential." After scanning and designating as "confidential," the Board retains the confidential paper submissions for a short period of time before disposing of the confidential paper submissions in an appropriate manner.

The parties are strongly discouraged from submitting materials which contain the personally identifiable information of an individual (e.g., account numbers, social security number, home addresses, and home phone numbers). The parties are also discouraged from submitting unnecessary information (e.g., payroll) that may lead to identity theft or other fraudulent use of such information, even where such information concerns a business but may not be addressed in either the Board's standard protective order or a stipulated protective agreement between the parties. If such information is embedded in the materials being submitted, such privacy information is to be redacted. [Note 4.]

Except for materials filed under seal pursuant to a protective order or agreement, all Board proceeding files and exhibits thereto are available for public inspection and copying. Therefore, only the particular discovery responses, exhibits, deposition transcript pages, or those portions of a brief, pleading or motion that disclose confidential information should be filed under seal pursuant to a protective order. [Note 5.] A good practice would be to clearly mark as "confidential" each page of a submission that contains such matter.

However filed, if a party submits any brief, pleading, motion or other such filing containing confidential information under seal, the party must also submit for the public record a redacted version of said submissions. [Note 6.]

NOTES:

1. See [37 C.F.R. § 2.116\(g\)](#) ("The Trademark Trial and Appeal Board's standard protective order is automatically imposed in all inter partes 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."); [37 C.F.R. § 2.27\(e\)](#). See

also *AT&T Mobility LLC v. Thomann*, 2020 USPQ2d 53785, at *4 (TTAB 2020) (“Confidential filings are accessible only by the Board.”)

2. See [37 C.F.R. § 2.27\(e\)](#); [37 C.F.R. § 2.120\(f\)](#); [37 C.F.R. § 2.125\(f\)](#).

3. See <http://estta.uspto.gov/filing-type.jsp>. This option is only available for filing documents in an existing opposition, cancellation, or concurrent use proceeding. Since a notice of opposition or petition for cancellation provides only notice of a claim and general facts in support of it, there should rarely, if ever, be occasion to file confidential material with a notice or petition. The existence of the proceeding itself will not be treated as confidential.

4. See *United States Polo Association v. David McLane Enterprises, Inc.*, 2019 USPQ2d 108442, at *5, 9-10 (TTAB 2019) (names, addresses, phone numbers, and email addresses of third parties is personally identifying information that may be designated as confidential under the Board’s standard protective order).

5. See [37 C.F.R. § 2.126\(c\)](#); *Duke University v. Haggard Clothing Co.*, 54 USPQ2d 1443, 1445 (TTAB 2000). See also *ProMark Brands, Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1238 n.24 (TTAB 2015) (party allowed time to resubmit deposition transcript separating the confidential testimony from nonconfidential testimony).

6. See [37 C.F.R. § 2.126\(c\)](#).

120.03 Files of Terminated Proceedings

When an inter partes proceeding has been finally determined, i.e., when the proceeding is over (including the resolution of any direct court review), the Office takes certain further steps based on the final decision, including those steps necessary to give effect to the decision. This process is referred to as the “termination” of the proceeding. See [TBMP § 806](#) (Termination of Proceeding).

The official records for all Board proceedings are now kept electronically. The electronic files of all Board proceedings continue to remain available online through TTABVUE after termination.

Pursuant to the National Archives retention schedule, terminated inter partes proceeding file records are transferred to the National Archives after 5 years for permanent retention.

The paper files of cancelled and expired registrations were scheduled to be destroyed three years after the date of cancellation or expiration. The paper files of abandoned applications were scheduled to be destroyed three years after the date of abandonment. In addition, the paper files of terminated opposition proceedings numbered from 30,000 through 53,999, and of terminated cancellation proceedings numbered from 1 through 9399, have been destroyed.

An individual who wishes to inspect or copy a paper file is directed to the National Archives and Records Administration, www.archives.gov/research.

121 Copying of Files

Most records filed in Board proceedings since 2001 are kept electronically. An individual who wishes to inspect or copy one of the paper files is directed to the National Archives and Records Administration, www.archives.gov/research. Paper submissions are scanned into TTABVUE. After scanning, the Board

retains the paper submissions for a short period of time before disposing of the paper submissions in an appropriate manner. See [TBMP § 120.02](#).

The electronic files of the Board are accessible on the Internet via TTABVUE. [Note 1.] The electronic files of applications and registrations which are the subject matter of pending proceedings before the Board are accessible online via TSDR. [Note 2.] Both TTABVUE and TSDR permit users to view, download, and print non-confidential portions of applications, registrations, and Board proceedings.

The U.S. Patent and Trademark Office Certified Copy Center will furnish certified copies of trademark application and registration files, or of one or more papers therefrom, or of papers from the files of Board proceedings, upon written request and payment of the fee prescribed in [37 C.F.R. § 2.6](#). The Office will also furnish, upon written request and payment of the fee prescribed in [37 C.F.R. § 2.6](#), printed copies of trademark registrations, certified copies of registrations with information as to the current status and title of the registration, and abstracts of title to trademark applications and registrations.

All requests for certified copies of trademark documents relating to applications or registrations, including copies of papers from the files of Board proceedings, and abstracts of title, are handled by the USPTO Certified Copy Center. Copies can be ordered online at <http://certifiedcopycenter.uspto.gov/>. Customer service is available by telephone at (571) 272-3150 or (toll free) (800) 972-6382, Monday through Friday between 8:30 a.m. and 5 p.m. ET, and by email at dsd@uspto.gov.

NOTES:

1. <https://ttabvue.uspto.gov/>.
2. <https://tsdr.uspto.gov/>.

122 Certification

122.01 Court Requirements

If a copy of a Board proceeding file, or a portion thereof, is needed for use before a court, the court may require a certified copy (which bears a seal). This may be obtained from the Patent and Trademark Copy Fulfillment Branch, Public Records Division. See [TBMP § 121](#) for information on ordering certified copies.

A paper cannot be certified by the Office as being a true copy of a paper filed in a Board proceeding unless and until it has, in fact, been filed therein. The paper may be filed at the same time that the request for certification is made.

122.02 Certified Copies

Certified copies, bearing a seal, of Office proceeding files, including Board proceeding files, or portions thereof, may be ordered online from the U.S. Patent and Trademark Office Certified Copy Center at <https://certifiedcopycenter.uspto.gov/>. See [TBMP § 121](#) for additional information on ordering certified copies.

123 Status Information for Applications, Registrations and Board Proceedings

Detailed current information about the status and prosecution history of trademark applications and registrations can be obtained online through the TSDR database at <http://tsdr.uspto.gov/>. Information on any recorded documents affecting the title to applications or registrations can be obtained from the Trademark Assignments database at <https://assignment.uspto.gov/trademark/index.html#/trademark/search>.

The Trademark Assistance Center provides general information about the registration process and can also answer status questions. The Center can be reached at (571) 272-9250 or (800) 786-9199 (toll free). [Note 1.]

The status of Board proceedings and of requests for extensions of time to oppose can be obtained online using TTABVUE at <http://ttabvue.uspto.gov>. [Note 2.] General information about Board proceedings (including status information) can be obtained by calling the Trademark Trial and Appeal Board at (571) 272-8500 or (800) 786-9199 (toll free) during business hours.

NOTES:

1. See generally [TMEP § 108](#), *et seq.* (Status Inquiries).
2. *Melwani v. Allegiance Corp.*, 97 USPQ2d 1537, 1542 n.17 (TTAB 2010).

124 Action by Assignee

When a mark which is the subject of a federal application or registration has been assigned, together with the application or registration, in accordance with Trademark Act § 10, [15 U.S.C. § 1060](#), any action with respect to the application or registration which may or must be taken by the applicant or registrant may be taken by the assignee (acting itself, or through its attorney or other authorized representative), provided that the assignment has been recorded or that proof of the assignment has been submitted. [Note 1.] Similarly, when a mark which is not the subject of a federal application or registration, but which is owned and pleaded by a plaintiff in a Board inter partes proceeding, has been assigned, the assignee may act in the proceeding in place of the assignor, provided that proof of the assignment has been submitted in the proceeding. See [TBMP § 512.01](#) (Assignment of Mark).

Please Note: Trademark Act § 10, [15 U.S.C. § 1060](#), and part 3 of 37 C.F.R. are not applicable to Trademark Act § 66(a), [15 U.S.C. § 1141f\(a\)](#) applications and registrations. [Note 2.] Except in limited circumstances, [Note 3] requests to record assignments of § 66(a) applications and registrations must be filed directly with the International Bureau of the World Intellectual Property Organization. [Note 4.] The International Bureau will notify the USPTO of any changes in ownership recorded in the International Register. The USPTO will record only those assignments, or other documents of title, that have been recorded in the International Register. [Note 5.]

NOTES:

1. [37 C.F.R. § 3.71\(d\)](#) (Prosecution by assignee), [37 C.F.R. § 3.73\(b\)](#) (Establishing right of assignee to take action). See Trademark Act § 72, [15 U.S.C. § 1141i](#), [37 C.F.R. § 7.22–37 C.F.R. § 7.24](#) regarding assignment of Trademark Act § 66(a), [15 U.S.C. § 1141f\(a\)](#) applications and registrations.

2. [TMEP § 503.05](#). See [37 C.F.R. § 7.22](#)–[37 C.F.R. § 7.24\(a\)](#) for information on recording changes to applications and registrations under Trademark Act § 66(a).
3. See [TMEP § 1906.01\(a\)\(i\)](#).
4. [37 C.F.R. § 7.22](#). See also [TMEP § 1906](#), *et seq.* (Recording Changes in International Register).
5. See [TMEP § 1906.01\(a\)](#).