

# Chapter 200 EXTENSIONS OF TIME TO OPPOSE

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## 201 In General

**Trademark Act § 13(a), 15 U.S.C. § 1063(a)** Any person who believes that he would be damaged by the registration of a mark upon the principal register, including the registration of any mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125 (c) of this title, may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 1062 of this title of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Director for good cause when requested prior to the expiration of an extension. The Director shall notify the applicant of each extension of the time for filing opposition. An opposition may be amended under such conditions as may be prescribed by the Director.

### 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 paragraphs (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. § 2.102 **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) The time for filing an opposition shall not be extended beyond 180 days from the date of publication. Any request to extend the time for filing an opposition must be filed before thirty days have expired from the date of publication or before the expiration of a previously granted extension of time, as appropriate. Requests to extend the time for filing an opposition must be filed as follows:

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

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

(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.

Any person, whether natural or juristic, who believes that he, she, or it would be damaged by the registration of a mark on the Principal Register may, upon payment of the prescribed fee, file an opposition in the Office, stating the grounds therefor, within 30 days after the publication of the mark in the Official Gazette for purposes of opposition. [Note 1.] See [TBMP § 303.02](#) ("Meaning of the term 'person'").

For further information concerning the filing of an opposition, see [TBMP Chapter 300](#).

Similarly, 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 to extend the time for filing an opposition. [Note 2.] Requests for extensions of time to oppose are filed with and determined by the Board. [Note 3.] Requests for extension of time to oppose an application based on Trademark Act §§ 1 or 44 of the Act must be filed through ESTTA unless ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present. [Note 4.] However, requests for extensions of time to oppose a Trademark Act § 66(a) application must always be filed electronically in ESTTA, and may not under any circumstances be filed in paper form. [Note 5.]

The time for filing a request for an extension of time to oppose is governed by Trademark Act § 13(a), [15 U.S.C. § 1063\(a\)](#), and [37 C.F.R. § 2.102\(c\)](#). Other requirements for a request for an extension of time to oppose are set forth in [37 C.F.R. § 2.102\(a\)](#), [37 C.F.R. § 2.102\(b\)](#), and [37 C.F.R. § 2.102\(d\)](#). Moreover, an extension of time to oppose must also meet the general requirements for submissions to the Board specified in [37 C.F.R. § 2.126](#). See [TBMP § 106.03](#). Each of these requirements is discussed in the sections that follow.

The Board lacks jurisdiction to decide an untimely filed opposition. [Note 6.]

#### NOTES:

1. Trademark Act § 13(a), [15 U.S.C. § 1063\(a\)](#); [37 C.F.R. § 2.101](#). See also [37 C.F.R. § 2.80](#) (mark entitled to registration will be published in the Official Gazette for opposition).
2. Trademark Act § 13(a), [15 U.S.C. § 1063\(a\)](#); [37 C.F.R. § 2.102](#).
3. See [37 C.F.R. § 2.102\(a\)](#); *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1075 n.2 (TTAB 1993) (37 C.F.R. § 2.102 delegates the authority to the Board to grant ex parte extensions of time to oppose). See [TMEP § 1503.04](#).
4. [37 C.F.R. § 2.102\(a\)\(1\)](#). See also [37 C.F.R. § 2.126\(a\)](#) (“Submissions must be made to the Trademark Trial and Appeal Board via ESTTA.”).
5. [37 C.F.R. § 2.102\(a\)\(1\)](#). See *In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019, 2020-21 (TTAB 2005) (requests for extension of time to oppose a Trademark Act § 66(a) (Madrid Protocol) application must be filed via ESTTA; paper requests for extensions will be denied).
6. *Renaissance Rialto Inc. v. Ky Boyd*, 107 USPQ2d 1083, 1084 (TTAB 2013) (whether an opposition was timely filed is “an issue of jurisdictional significance,” untimely filed opposition dismissed without prejudice to file a cancellation for lack of jurisdiction). See generally *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075 (TTAB 1993).

## 202 Time for Filing Request

### 202.01 In General

**Trademark Act § 13(a)**, [15 U.S.C. § 1063\(a\)](#) Any person who believes that he would be damaged by the registration of a mark upon the principal register, including the registration of any mark which would be

*likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 1062 of this title of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Director for good cause when requested prior to the expiration of an extension. The Director shall notify the applicant of each extension of the time for filing opposition. An opposition may be amended under such conditions as may be prescribed by the Director.*

[37 C.F.R. § 2.102\(c\)](#) *The time for filing an opposition shall not be extended beyond 180 days from the date of publication. Any request to extend the time for filing an opposition must be filed before thirty days have expired from the date of publication or before the expiration of a previously granted extension of time, as appropriate. Requests to extend the time for filing an opposition must be filed as follows:*

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

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

(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.*

A first request for an extension of time to oppose an application for registration of a mark must be filed prior to the expiration of the thirty-day period after publication of the mark in the Official Gazette, pursuant to Trademark Act § 12(a), [15 U.S.C. § 1062\(a\)](#). [Note 1.] Any request for a further extension of time to oppose must be filed by the initial requesting party, or its privy, prior to the expiration of an extension granted to the requesting party or its privy. [Note 2.]

All requests to extend the time for filing an opposition must be filed through ESTTA. [Note 3.] For an application based on Trademark Act §§ 1 or 44, a request to extend the opposition period may be filed in paper form only if ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present. [Note 4.] Requests for extension of time to oppose a Trademark Act § 66(a) application may not under any circumstances be filed in paper form. [Note 5.]

Any paper request must be timely, and must be accompanied by a Petition to the Director with the requisite fees and a showing that ESTTA was unavailable because of technical problems or that extraordinary circumstances are present. [Note 6.] The timeliness of any paper submission will be determined in accordance with [37 C.F.R. § 2.195](#) through [37 C.F.R. § 2.198](#). [Note 7.] See [TBMP § 111.02](#) (certificate of mailing procedure) and [TBMP § 111.01](#) (Priority Mail Express®) for further information about submissions filed in paper form and procedures providing for the timeliness of any paper submissions. Paper filings must also

meet the general requirements for submissions to the Board specified in [37 C.F.R. § 2.126](#). See [TBMP § 106.03](#) and [TBMP § 107](#)

No more than three requests to extend the time for filing an opposition, totaling 180 days from the date of publication, may be filed. [Note 8.] During the initial 30-day period following publication of the mark, a potential opposer may file a request for a thirty-day extension without a showing of cause, see [TBMP § 207.02](#) (Extensions Up to 120 Days from Date of Publication), followed by a request for a sixty-day extension for good cause. [Note 9.] If granted, the potential opposer will have until 120 days from the date of publication within which to oppose. Alternatively, the potential opposer may file a single first request for a ninety-day extension of time for good cause, thereby obtaining, if granted, an extension up to 120 days from the date of publication. [Note 10.] A sixty-day extension is not available as a first extension of time to oppose. [Note 11.] After one or two granted requests totaling 120 days from the date of publication, the potential opposer may request one final extension of time for an additional sixty days, but only with the consent of the applicant or a showing of extraordinary circumstances. [Note 12.]

The final request (for the 120-180 day period after publication) can only be granted for sixty days and not any other period of time. [Note 13.] For example, within the 90-120 day period from publication, the potential opposer cannot request a thirty-day extension of time, even with the consent of the applicant. If an extension of less than sixty days is requested, even if based on consent, the request will be denied unless the reasons stated for the granting of the request are determined to be extraordinary, in which case the request will be granted for sixty days. In other words, although a thirty-day extension of time is not permissible under [37 C.F.R. § 2.102\(c\)\(3\)](#), the presence of extraordinary circumstances would allow the granting of a sixty-day extension of time. No further extensions of time to oppose will be permitted.

The following chart illustrates the initial publication period and extensions of time to oppose which may be granted:

<b>Publication</b> 30 days <a href="#">37 C.F.R. § 2.102(c)</a>	<b>First 30 days</b> – no reason necessary <a href="#">37 C.F.R. § 2.102(c)(1)(i)</a>	<b>Next 60 days</b> – for good cause or consent <a href="#">37 C.F.R. § 2.102(c)(2)</a>	<b>Final 60 days</b> – with consent or under extraordinary circumstances <a href="#">37 C.F.R. § 2.102(c)(3)</a>
	<b>First 90 Days</b> – for good cause or consent <a href="#">37 C.F.R. § 2.102(c)(1)(ii)</a>		

#### NOTES:

1. Trademark Act § 13(a), [15 U.S.C. § 1063\(a\)](#); [37 C.F.R. § 2.102\(c\)](#). See *In re Kabushiki Kaisha Hitachi Seisakusho*, 33 USPQ2d 1477, 1478 (Comm'r Pats. 1994) (citing *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980) (timeliness of extension requests is statutory and cannot be waived)). Cf. *Yahoo! Inc. v. Loufrani*, 70 USPQ2d 1735, 1736 (TTAB 2004) (because requirements of Section 13(a) of the Act for the filing of an opposition are statutory, they cannot be waived by stipulation of the parties, nor can they be waived by the Director on petition).

2. [37 C.F.R. § 2.102\(b\)](#).

3. [37 C.F.R. § 2.102\(a\)\(1\)](#). See also [37 C.F.R. § 2.126\(a\)](#) (“Submissions must be made to the Trademark Trial and Appeal Board via ESTTA.”).

4. [37 C.F.R. § 2.102\(a\)\(1\)](#) and [37 C.F.R. § 2.126\(a\)](#).



5. [37 C.F.R. § 2.102\(a\)\(1\)](#). See *NSM Resources Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1039 n.19 (TTAB 2014) (Use of ESTTA is mandatory for the filing of extensions of time to oppose applications filed under the Madrid Protocol).
6. [37 C.F.R. § 2.120\(a\)\(2\)](#). Cf. *DFC Expo LLC v. Coyle*, 121 USPQ2d 1903 (TTAB 2017) (untimely paper submission of notice of opposition without certificate of mailing, fees, or petition to Director denied).
7. [37 C.F.R. § 2.102\(a\)\(2\)](#) and [37 C.F.R. § 2.102\(d\)](#).
8. [37 C.F.R. § 2.102\(c\)\(1\)\(i\)](#) and [37 C.F.R. § 2.102\(c\)\(2\)](#).
9. [37 C.F.R. § 2.102\(c\)\(1\)\(i\)](#), [37 C.F.R. § 2.102\(c\)\(2\)](#), and [37 C.F.R. § 2.102\(c\)\(3\)](#).
10. [37 C.F.R. § 2.102\(c\)\(1\)\(ii\)](#).
11. [37 C.F.R. § 2.102\(c\)\(1\)\(ii\)](#).
12. [37 C.F.R. § 2.102\(c\)\(3\)](#).
13. [37 C.F.R. § 2.102\(c\)\(3\)](#).

## 202.02 Date of Publication of Mark

The date of publication of a mark is the issue date of the Official Gazette in which the mark appears, pursuant to Trademark Act § 12(a), [15 U.S.C. § 1062\(a\)](#), for purposes of opposition.

## 202.03 Premature Request

Trademark Act § 13(a), [15 U.S.C. § 1063\(a\)](#), provides that an opposition to the registration of a mark upon the Principal Register may be filed “within thirty days after” the publication of the mark in the Official Gazette under Trademark Act § 12(a), [15 U.S.C. § 1062\(a\)](#). Trademark Act § 13(a), [15 U.S.C. § 1063\(a\)](#) also provides for extensions of the time for filing an opposition under certain conditions. ESTTA does not permit a party to file a premature notice of opposition or premature request for an extension of time to oppose. Any paper-filed opposition, and any paper-filed request for an extension of time to oppose, filed before the date of publication of the mark sought to be opposed, is premature, and the Board will reject the opposition even if the mark has been published by the time of the Board’s action. Cf. [TBMP § 306.03](#) (Premature Opposition).

## 202.04 Late Request

A request for an extension of time to oppose must be filed prior to the expiration of the thirty-day period after publication for opposition of the mark which is the subject of the request, in the case of a first request, or prior to the expiration of an extension granted to the requesting party or its privy, in the case of a request for a further extension. [Note 1.] See [TBMP § 206.02](#) for information regarding further extension requests filed by a party in privity with the person who requested and was granted the extension of time. Because these timeliness requirements are statutory, they cannot be waived by stipulation of the parties, nor can the Director upon petition waive them. [Note 2.] The ESTTA filing system does not permit a party to file a late request for extension of time to oppose. [Note 3.] Likewise, later paper submissions will be denied. A first request filed in paper after the expiration of the thirty-day period following publication of the subject mark,

or a request for a further extension filed in paper after the expiration of the previous extension granted to the requesting party or its privy, will be denied by the Board as late, even if the applicant has consented to the granting of the late-filed request.

Moreover, once the time for opposing the registration of a mark has expired, the Office will not withhold issuance of the registration, or a notice of allowance where appropriate, while applicant negotiates for settlement with a party that failed to timely oppose. This is so even if the applicant itself requests that issuance be withheld.

Potential opposers are reminded that parties may not rely on information obtained by telephone with the Board. [37 C.F.R. § 2.191](#) provides in pertinent part: “The action of the Office will be based exclusively on the written record. No attention will be paid to any alleged oral promise, stipulations, or understanding in relation to which there is disagreement or doubt.” [Note 4.] See [TBMP § 104](#) (Business to be Conducted in Writing).

## NOTES:

1. Trademark Act § 13(a), [15 U.S.C. § 1063\(a\)](#); [37 C.F.R. § 2.102\(c\)](#). See, e.g., *Renaissance Rialto Inc. v. Ky Boyd*, 107 USPQ2d 1083, 1084 (TTAB 2013) (whether an opposition was timely filed is “an issue of jurisdictional significance”; untimely filed opposition dismissed without prejudice to file a cancellation for lack of jurisdiction).

2. See *In re Kabushiki Kaisha Hitachi Seisakusho*, 33 USPQ2d 1477, 1478 (Comm’r Pats. 1994) (citing *In re Cooper*, 209 USPQ 670, 671 (Comm’r 1980) (timeliness of extension requests is statutory and cannot be waived)). Cf. *Yahoo! Inc. v. Loufrani*, 70 USPQ2d 1735, 1736 (TTAB 2004) (because requirements of Section 13(a) of the Act for the filing of an opposition are statutory, they cannot be waived by stipulation of the parties, nor can they be waived by the Director on petition).

3. Cf. *PPG Industries, Inc. v. Guardian Industries Corp.*, 73 USPQ2d 1926, 1927 (TTAB 2005) (“... when a paper is filed via ESTTA, it must be signed in conformance with Rule 2.193(c)(1)(iii). As a practical matter, ESTTA will allow the filing party to complete the submission process only after the required electronic signature has been entered.”).

4. See *In re Merck & Co.*, 24 USPQ2d 1317, 1318 n.2 (Comm’r 1992).

## 203 Form of Request

### 203.01 General Considerations

#### 203.01(a) Required Electronic Filings; Paper Filings

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

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

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

(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.

### **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.*

A request for an extension of time to oppose must be submitted through ESTTA and must specify the period of extension desired. [Note 1.] Available forms and instructions for electronic filing can be found at <http://estta.uspto.gov>.

If ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, a request to extend time to oppose an application based on Trademark Act §§ 1 or 44, [15 U.S.C. § 1051](#) or [15 U.S.C. § 1126](#), may be filed in paper form. [Note 2.] See [TBMP § 106.03](#) and [TBMP § 107](#) for general information about paper filings. The requirements for formatting electronic and paper submissions to the Board are specified in [37 C.F.R. § 2.126\(a\)](#) and [37 C.F.R. § 2.126\(b\)](#), respectively.

Under no circumstances may a request to extend the opposition period for a Madrid Protocol application, i.e., an application filed under Trademark Act § 66(a), 15 U.S.C. § 1141f(a), be filed in paper form. [Note 3.] The requirement to use 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 filed against applications requesting extension of protection under the Madrid Protocol. A request for an extension of time to oppose a Madrid Protocol application that is not filed through ESTTA will be denied.

No more than three requests to extend the time for filing an opposition, totaling 180 days from the date of publication, may be filed. [Note 4.] During the initial 30-day period following publication of the mark, a potential opposer may file a request for a thirty-day extension without a showing of cause, *see* [TBMP § 207.02](#), followed by a request for a sixty-day extension for good cause, if the first request was granted. [Note 5.] If granted, the potential opposer will have until 120 days from the date of publication within which to oppose. A sixty-day extension of time to oppose is not available as a first extension of time to oppose. [Note 6.] Alternatively, the potential opposer may file a single first request for a ninety-day extension of time for good cause, thereby obtaining, if granted, an extension up to 120 days from the date of publication. [Note 7.] After one or two granted requests totaling 120 days from the date of publication, the potential opposer may request one final extension of time for an additional sixty days, but only with the consent of the applicant or a showing of extraordinary circumstances. [Note 8.]

The final request (for the 120–180 day period after publication) can only be granted for sixty days and not any other period of time. [Note 9.] For example, within the 90-120 day period from publication, the potential opposer cannot request a thirty day extension of time, even with the consent of the applicant. If an extension of less than sixty days is requested, even if based on consent, the request will be denied unless the reasons stated for the granting of the request are determined to be extraordinary, in which case the request will be granted for sixty days instead. In other words, although a thirty day extension of time is not permissible under [37 C.F.R. § 2.102\(c\)\(3\)](#), the presence of extraordinary circumstances would allow the grant of a sixty day extension of time. No further extensions of time to oppose will be permitted.

The following chart illustrates the initial publication period and extensions of time to oppose which may be granted:

Publication	First 30 days – no reason necessary	Next 60 days – for good cause or consent	Final 60 days – with consent or under extraordinary circumstances
30 days <a href="#">37 C.F.R. § 2.102(c)</a>	<a href="#">37 C.F.R. § 2.102(c)(1)(i)</a>	<a href="#">37 C.F.R. § 2.102(c)(2)</a>	
	First 90 Days – for good cause or consent <a href="#">37 C.F.R. § 2.102(c)(1)(ii)</a>		<a href="#">37 C.F.R. § 2.102(c)(3)</a>

#### NOTES:

1. [37 C.F.R. § 2.102\(a\)\(1\)](#); [37 C.F.R. § 2.102\(c\)](#). See also [37 C.F.R. § 2.126\(a\)](#) (“Submissions must be made to the Trademark Trial and Appeal Board via ESTTA.”).
2. [37 C.F.R. § 2.102\(a\)\(1\)](#) and [37 C.F.R. § 2.102\(a\)\(2\)](#).
3. [37 C.F.R. § 2.102\(a\)\(1\)](#). See *NSM Resources Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1039 n.19 (TTAB 2014) (Use of ESTTA is mandatory for the filing of extensions of time to oppose applications filed under the Madrid Protocol).
4. [37 C.F.R. § 2.102\(c\)\(1\)\(i\)](#) and [37 C.F.R. § 2.102\(c\)\(2\)](#).
5. [37 C.F.R. § 2.102\(c\)\(1\)\(i\)](#) and [37 C.F.R. § 2.102\(c\)\(2\)](#).
6. [37 C.F.R. § 2.102\(c\)\(1\)\(ii\)](#).
7. [37 C.F.R. § 2.102\(c\)\(1\)\(ii\)](#).
8. [37 C.F.R. § 2.102\(c\)\(3\)](#).
9. [37 C.F.R. § 2.102\(c\)\(3\)](#).

#### 203.01(b) Note on Electronic Filing With ESTTA

Electronic filing of extensions of time to oppose using ESTTA is required in all instances. In the rare occasion that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, a request to extend the time to oppose an application based on Trademark Act §§ 1 or 44, [15 U.S.C. § 1051](#) or [15 U.S.C. § 1126](#) may be filed in paper form. [Note 1.] A potential opposer is encouraged to plan ahead. “System status” for current and planned outages may be checked on the USPTO website. At times, a system

may be down for a short period. A potential opposer, if unsuccessful at electronic filing on a first attempt, should try again later in the day before resorting to paper filing. Under no circumstances may a request to extend the opposition period for an application based on Trademark Act § 66(a), [15 U.S.C. § 1141f\(a\)](#), be filed on paper. [Note 2.]

To assist the user, ESTTA provides prompts to supply and verify all required information. Most extensions of time to oppose filed via ESTTA are automatically processed, providing a nearly instantaneous Board order (with an email notification providing a link to the filing in TTABVue) granting the requested extension (if appropriate).

ESTTA forms, including a request for extension of time to oppose, and filing instructions can be found at <https://estta.uspto.gov>. Filers with questions about electronic filing may call (571) 272-8500 or (800) 786-9199 (toll free) (8:30 am – 5:00 pm Eastern Time) for assistance, or send an email to [TTABISInfo@uspto.gov](mailto:TTABISInfo@uspto.gov). [Note 3.] For technical questions that arise during filing via ESTTA, the filer may send an email to [ESTTA@uspto.gov](mailto:ESTTA@uspto.gov). Questions of a general nature regarding Board proceedings should be directed to the phone numbers listed above.

See [TBMP § 106.03](#) and [TBMP § 110](#) for general information on ESTTA filing.

#### NOTES:

1. [37 C.F.R. § 2.102\(a\)\(1\)](#) and [37 C.F.R. § 2.102\(a\)\(2\)](#).
2. [37 C.F.R. § 2.102\(a\)\(1\)](#). *See also In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019, 2020-21 (TTAB 2005) (requests for extension of time to oppose a Trademark Act § 66(a) (Madrid Protocol) application must be filed via ESTTA; paper requests for extensions will be denied).
3. When sending an email inquiry, include a description of the problem or question, the ESTTA tracking number (if any), the Board proceeding (or application) number (if any), and a name and telephone number for contact. The Board will respond to email inquiries within two business days. Email should not be used for more urgent inquiries.

## 203.02 Identifying Information

### 203.02(a) In General

ESTTA contains the necessary forms for filing extensions of time to oppose. Selecting the correct form will appropriately identify the filing, and once the required fields for identifying the application and potential opposer are completed, the filing can be electronically transmitted to the Office. Any attachments to ESTTA forms should be separately captioned and identified for clarity. An email notification of the Office's receipt of the transmission will be sent and most extension requests will be automatically processed. Multiple claimants seeking to proceed as co-opposers should use a separate form for each potential opposer. *See* [TBMP § 203.02\(b\)](#).

In the rare instances where the rules permit an extension request against a Trademark Act §§ 1 or 44 application to be filed on paper, it should bear at its top the heading "IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD," followed by information identifying the application to which the request pertains, namely, the name of the applicant, and the application serial number, filing date, mark, and date of publication in the Official Gazette. [Note

1.] The request should also bear an appropriate title describing its nature, such as “Request for Extension of Time to Oppose” or “Request for Further Extension of Time to Oppose.” For ESTTA users, once the correct form is selected, the filing will be appropriately identified.

#### NOTES:

1. *See In re Merck & Co.*, 24 USPQ2d 1317, 1318 (Comm’r 1992) (Board’s refusal to institute opposition as untimely was proper where potential opposer had misidentified applicant and serial number in its extension request). Cf. [37 C.F.R. § 2.194\(b\)\(1\)](#) (“A letter about a trademark application should identify the serial number, the name of the applicant, and the mark.”); *Yahoo! Inc. v. Loufrani*, 70 USPQ2d 1735, 1736 n.4 (TTAB 2004) (opposition dismissed as nullity where notice of opposition misidentified the application sought to be opposed).

### 203.02(b) Requirement for Identification of Potential Opposer

A request for an extension of time to oppose must identify the potential opposer with reasonable certainty. [Note 1.] An extension request filed through ESTTA cannot be electronically transmitted to the Office unless all required fields, including the field for identification of the potential opposer, are completed. If a paper-filed request for extension of time to oppose fails to identify the potential opposer with reasonable certainty, and assuming all other requirements for the paper filing are satisfied, the defect regarding the identity of the potential opposer may be corrected only if the correction can be made prior to the expiration of the time for filing the request, that is, before the expiration of the thirty-day opposition period following publication of the subject mark in the case of a first request, or before the expiration of the previous extension in the case of a request for a further extension. Any requests for extensions of time to oppose in which the potential opposer is not identified with reasonable certainty cannot be remedied after the opposition period, including any extensions, has expired. [Note 2.]

If a paper-filed request for a further extension of time to oppose does not specifically name the potential opposer, but it is clear from the circumstances that the request is being submitted on behalf of the same potential opposer which obtained an earlier extension, the request may be construed by the Board as identifying the potential opposer with reasonable certainty. However, the better, and safer, practice is to specifically name the potential opposer in each request for an extension of time to oppose.

**ESTTA Tip:** When filing electronic requests for extensions of time to oppose on behalf of more than one potential opposer, *file a separate request for each potential opposer*. Do not file a joint request (i.e., on behalf of “ABC, Co. and XYZ Inc.”), as this will make it more difficult to include both potential opposers as parties to an opposition, if one is filed. When filing the opposition, both (separate) potential opposers can be easily added as parties to the same opposition proceeding, and all fees will be calculated correctly. [Note 3.]

#### NOTES:

1. [37 C.F.R. § 2.102\(b\)](#).

2. *See In re Spang Industries, Inc.*, 225 USPQ 888, 888 (Comm’r 1985) (since extension request failed to identify any party except attorney filing request, and since privity does not include attorney/client relationship, subsequent notice of opposition was untimely). Cf. *In re Su Wung Chong*, 20 USPQ2d 1399, 1400 (Comm’r 1991) (inadvertence is not extraordinary circumstance to waive rule requiring that statement indicating consent or showing extraordinary circumstances for extension over 120 days must be submitted at time



extension request is filed, not after the fact); *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093, 1094 (Comm'r 1990) (subsequently obtained consent is not sufficient to allow Board to entertain request for reconsideration, and omission, in itself, is not extraordinary circumstance to waive requirement that consent accompany extension request).

3. *Cf. Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 n.2 (TTAB 2009) (electronically-filed opposition in which opposers were not separately named did not include correct fees; consequently one potential opposer was not considered to be a party); *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994) (Multiple claimants may initiate opposition together and proceed as co-opposers, if opposition is filed within statutory opposition period or during extension of time, and if each of joint opposers submits opposition fee and establishes standing and grounds for opposition.).

### 203.03 Signature

[37 C.F.R. § 2.120\(a\)](#) *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 § 11.1 4(b) of this chapter. Electronic signatures pursuant to 2.193(c) are required for electronically filed extension requests.*

A request for an extension of time to oppose must be signed either by the potential opposer or by its attorney, as specified in [37 C.F.R. § 11.1](#) or other authorized representative, as specified in [37 C.F.R. § 11.14\(b\)](#). [Note 1.] *See also* [TBMP § 114.06](#). The required signature information fields include the signature; the name of the person signing; a description of the capacity in which he or she signs (e.g., as the individual who is the potential opposer, if the potential opposer is an individual; as a corporate officer, specifying the particular office held, if the potential opposer is a corporation; as potential opposer's attorney; etc.); his or her email and business address (to which correspondence relating to the request will be sent); and telephone number. An extension request filed through ESTTA cannot be electronically transmitted to the Office unless all required fields, including the signature field, are completed.

An extension request filed electronically through ESTTA does not require a conventional signature. Instead 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.] *See* [TBMP § 106.02](#).

In the rare instance where an extension request against a Trademark Act §§ 1 or 44 application is filed in paper form, the request should bear, under the written signature, the name, in typed or printed form, of the person signing; a description of the capacity in which he or she signs (e.g., as the individual who is the potential opposer, if the potential opposer is an individual; as a corporate officer, specifying the particular office held, if the potential opposer is a corporation; as potential opposer's attorney; etc.); his or her email and business address (to which correspondence relating to the request will be sent); and telephone number.

If all other requirements for a paper-filed request are met, an unsigned paper-filed request will not be refused consideration if a signed copy is submitted to the Office within the time limit set in the written notification of this defect by the Board. [Note 3.] [TBMP § 106.02](#).

A potential opposer that has submitted an unsigned paper request should not wait until it has submitted a signed copy of the request (in response to the Board's written notification of the defect), and the Board has



acted on the request, before filing an opposition or a request for a further extension of time to oppose. If the extension request is ultimately granted, the length of the granted extension may be less than that sought in the extension request, and it will run from the expiration of the thirty-day opposition period after publication, in the case of a first request, or from the date of expiration of the previously granted extension, in the case of a subsequent request. If no opposition or request for further extension of time to oppose is filed prior to the expiration of any extension ultimately granted to the potential opposer, the time for opposing will be deemed to have expired, and the application that was the subject of the request will be sent for issuance of a registration or a notice of allowance, as appropriate. See [TBMP § 202.01](#) (Time for Filing Request).

#### NOTES:

1. [37 C.F.R. § 2.102\(a\)](#); *La Maur, Inc. v. Andis Clipper Co.*, 181 USPQ 783, 784 (Comm'r 1974) (extension requests signed and filed on behalf of potential opposer by its attorney acceptable).
2. [37 C.F.R. § 2.193\(c\)](#). See [TMEP § 611.01\(b\)](#) (Requirements for Signature) and [TMEP § 611.01\(c\)](#) (Signature of Documents Filed Electronically).
3. [37 C.F.R. § 2.119\(e\)](#). See also *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”).

### 203.04 Service Not Required

Except for the notice of opposition and petition to cancel, every paper filed in the USPTO in inter partes cases must be served upon the other parties to the proceeding, and proof of such service must be made before the Board will consider the paper. [Note 1.] Because a request for an extension of time to oppose is filed prior to the commencement of the opposition, it is ex parte, rather than inter partes, in nature. Accordingly, the request need not be served (or include proof of service) upon the applicant. [Note 2.] Once the Board has acted upon a request for an extension of time to oppose, the Board will send the applicant a copy of the Board's action thereon. [Note 3.]

#### NOTES:

1. [37 C.F.R. § 2.119\(a\)](#).
2. *La Maur, Inc. v. Andis Clipper Co.*, 181 USPQ 783, 784 (Comm'r 1974) (request for extension of time is an ex parte matter; requests need not be served on applicant).
3. Trademark Act § 13, [15 U.S.C. § 1063](#).

### 203.05 Duplicate Requests

It sometimes happens that duplicate requests for an extension of time to oppose are filed on behalf of the same party by two attorneys from the same firm, or from differing firms, or by an attorney from a firm and in-house counsel. Attorneys should make every effort to avoid the filing of such duplicate requests, which waste the time and resources of the Board and the attorneys, and to promptly notify the Board upon discovery of any such duplicate requests.

Most requests for extension of time filed via ESTTA are automatically processed. Because they are not examined by Board staff, duplicate requests may be granted. Whether filed through ESTTA or on paper, counsel should avoid duplicate filings by checking the application status in TTABVue prior to filing an extension request.

## 204 Fees

There is a tiered fee structure for filing extensions of time to oppose that is calculated per application rather than per class. There is no fee for filing a first thirty-day request for an extension of time to oppose. There is a per application fee for filing either a second sixty-day request or a first ninety-day request for extension of time to oppose (combining the no-fee 30 day extension of time to oppose and the fee required for a subsequent 60-day extension of time to oppose). [Note 1.] There 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 are higher for paper submissions. [Note 3.] Petition fees are applicable to all requests for extensions of time to oppose filed in paper form, in addition to the per application filing fees. [Note 4.]

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.

### NOTES:

1. [37 C.F.R. § 2.6\(a\)\(22\)\(i\)](#) and [37 C.F.R. § 2.6\(a\)\(22\)\(ii\)](#).
2. [37 C.F.R. § 2.6\(a\)\(23\)\(i\)](#) and [37 C.F.R. § 2.6\(a\)\(23\)\(ii\)](#).
3. [37 C.F.R. § 2.6\(a\)\(22\)\(i\)](#) and [37 C.F.R. § 2.6\(a\)\(23\)\(i\)](#).
4. [37 C.F.R. § 2.102\(a\)\(2\)](#); [37 C.F.R. § 2.6\(a\)\(15\)\(i\)](#) and [37 C.F.R. § 2.6\(a\)\(15\)\(ii\)](#).

## 205 Mark on Supplemental Register Not Subject to Opposition

Although the mark in an application for registration on the Principal Register is published for, and subject to, opposition, the mark in an application for registration on the Supplemental Register is not. [Note 1.] If it appears after examination of an application to register a mark on the Supplemental Register, that applicant is entitled to the registration, a certificate of registration is issued without publication for opposition. [Note 2.] Upon issuance of the registration, the mark appears in the Official Gazette, not for opposition, but rather to give notice of the issuance of a registration. [Note 3.]

Because applications for registration on the Supplemental Register are not subject to opposition, but only to cancellation, requests for extensions of time to oppose are not permitted. ESTTA does not permit the filing of a request for an extension of time to oppose against an application for registration on the Supplemental Register, and if such a request were to be filed in paper form, the Board must deny it. The remedy of the would-be opposer lies in the filing of a petition to cancel the registration of the mark, once the registration has issued. [Note 4.]

**NOTES:**

1. Trademark Act § 24, [15 U.S.C. § 1092](#); [37 C.F.R. § 2.82](#).
2. Trademark Act § 23(b) and Trademark Act § 24; [15 U.S.C. § 1091\(b\)](#) and [15 U.S.C. § 1092](#); [37 C.F.R. § 2.82](#).
3. Trademark Act § 24, [15 U.S.C. § 1092](#); [37 C.F.R. § 2.82](#); [TMEP § 1502](#).
4. See Trademark Act § 24, [15 U.S.C. § 1092](#).

**206 Who May File an Extension of Time to Oppose**[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. ...*

(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.*

**206.01 General Rule**

Any person, whether natural or juristic who believes that he, she, or it would be damaged by the registration of a mark upon the Principal Register may, upon payment of the prescribed fee, file an opposition in the Office, stating the grounds therefor, within 30 days after the publication of the mark in the Official Gazette for purposes of opposition. [Note 1.] See also [TBMP § 303.02](#).

Similarly, any person, whether natural or juristic, who believes that he, she, or it would be damaged by the registration of a mark upon the Principal Register may file a request to extend the time for filing an opposition. [Note 2.] See [TBMP § 203](#). A request for an extension of time to oppose must identify the potential opposer with reasonable certainty. [Note 3.] See [TBMP § 203.02\(b\)](#).

The potential opposer's belief in its prospective damage arising from registration (i.e., its standing, now referred to as an entitlement to bring a statutory cause of action, see [TBMP § 309.03\(b\)](#)) need not be explicitly stated in an extension request, and is rarely an issue. Nonetheless, a request for extension of time to oppose may not be filed for improper purposes, such as harassment or delay. Although the Board may question a potential opposer's entitlement to bring a statutory cause of action in appropriate cases, either upon motion or sua sponte, the question will rarely be before the Board because, most of the time, an order automatically granting the requested extension is issued by ESTTA. Moreover, because extensions are limited in time, and potential opposers are not required to state potential grounds for an opposition, it will almost always be more appropriate to defer the issue of entitlement to bring a statutory cause of action until an opposition (if any) is filed, setting out the grounds for the opposition and the opposer's belief in damage. See, e.g., [TBMP § 503](#) (Motion to Dismiss for Failure to State a Claim).

An extension of time to oppose is a personal privilege which inures only to the benefit of the party to which it was granted and those in privity with that party. [Note 4.] For this reason, a request for a further extension of time to oppose, or an opposition filed during an extension of time, ordinarily must be filed in the name of the party to which the previous extension was granted. [Note 5.] [TBMP § 206.02](#) (Request by Privy). A request for a further extension, or an opposition, filed in a different name will be accepted if a person in privity with the person granted the previous extension files it, or if the person that requested the extension was misidentified through mistake. [Note 6.]

## NOTES:

1. Trademark Act § 13(a), [15 U.S.C. § 1063\(a\)](#); [37 C.F.R. § 2.101](#).
2. Trademark Act § 13(a), [15 U.S.C. § 1063\(a\)](#); [37 C.F.R. § 2.102](#).
3. [37 C.F.R. § 2.102\(b\)](#).
4. See [37 C.F.R. § 2.102\(b\)](#); *Renaissance Rialto Inc. v. Ky Boyd*, 107 USPQ2d 1083, 1087 (TTAB 2013) (acquisition of another's right to oppose, independent of a transfer of rights to a trademark and its associated goodwill, is an insufficient basis upon which to claim the benefit of the transferor's personal privilege in an extension of time to oppose an application; opposition dismissed for lack of jurisdiction); *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994) (“[A]n extension of time to oppose inures to the benefit of the potential opposer and its privies, so that a party in privity with a potential opposer may step into the potential opposer's shoes and file a notice of opposition or may join with the potential opposer as a joint opposer.”); “Typically, the right to go forward with an opposition may be transferred when the opposer, or its pleaded mark and the goodwill associated therewith, has been acquired by another party.”); *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1077 (TTAB 1993) (“An extension of time to oppose is a personal privilege, inuring only to the benefit of the party to which it was granted or a party shown to be in privity therewith. A party cannot claim the benefit of an extension granted to another (unrelated) party.”); *In re Cooper*, 209 USPQ 670, 671 (Comm’r 1980) (unrelated entities).
5. *Renaissance Rialto Inc. v. Boyd*, 107 USPQ2d 1083, 1087 (TTAB 2013) (acquisition of another’s right to oppose, independent of a transfer of rights to a trademark and its associated goodwill, is an insufficient basis upon which to claim the benefit of the transferor’s personal privilege in an extension of time to oppose); *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1077 (TTAB 1993) (“A party cannot claim the benefit of an extension granted to another (unrelated) party.”).
6. See *Custom Computer Services, Inc. v. Paychex Properties, Inc.*, 337 F.3d 1334, 67 USPQ2d 1638, 1640 (Fed. Cir. 2003) (privity and misidentification by mistake “are two disjunctive conditions under which an opposer may claim the benefit of an extension granted to another named entity”); *Warren Distribution, Inc. v. Royal Purple, LLC*, 115 USPQ2d 1667, 1669-70 (TTAB 2015) (company that filed notice of opposition not in privity with individual who filed extension request in her own name; and such individual was not “misidentified” as entity seeking extension “by mistake.”).

## 206.02 Request for Further Extension Filed by Privy

A request for a further extension, or an opposition, filed by a different party will not be rejected on that ground if it is shown to the satisfaction of the Board that the different party is in privity with the party granted the previous extension. [Note 1.] The “showing” should be in the form of a recitation of the facts upon which the claim of privity is based. The showing must be submitted with the request or opposition. ESTTA will

prompt the filer to provide an explanation. In the rare instance that the rules permit the filing to be made in paper form, the Board will issue an order requesting an explanation of the discrepancy. If the request for a further extension, or the opposition, is filed both in the name of the party granted the previous extension and in the name of one or more different parties, an explanation will be requested as to each different party, and the request will not be granted, or the opposition accepted, as to any different party which fails to make a satisfactory showing of privity.

In the field of trademarks, the concept of privity generally includes, *inter alia*, the relationship of successive ownership of a mark (e.g., assignor, assignee) and the relationship of “related companies” within the meaning of Trademark Act § 5 and Trademark Act § 45, [15 U.S.C. § 1055](#) and [15 U.S.C. § 1127](#). [Note 2.] It does not, however, include the attorney/client relationship. [Note 3.]

If, at the time when a first request for an extension of time to oppose is being prepared, it is not clear which of two or more entities will ultimately be the opposer(s), the better practice is to name each of them, in that and any subsequent extension request, as a potential opposer, thereby avoiding any need for a showing of privity when an opposition or subsequent extension request is later filed by one or more of them.

**ESTTA Tip:** When filing electronic requests for extensions of time to oppose on behalf of more than one potential opposer, *file a separate request for each potential opposer*. Do not file a joint request (*i.e.*, on behalf of “ABC, Co. and XYZ Inc.”), as this will make it more difficult to include both potential opposers as parties to an opposition, if one is filed. When filing the opposition, both (separate) potential opposers can be easily added as parties to the same opposition proceeding, and all fees will be calculated correctly. [Note 4.]

## NOTES:

1. [37 C.F.R. § 2.102\(b\)](#); *In re Spang Industries, Inc.*, 225 USPQ 888, 888 (Comm’r 1985) (“parties in privity must have the same right or interest”); *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994) (licensee, as party in privity with opposer, could have joined opposer in filing opposition during extension of time to oppose); *In re Cooper*, 209 USPQ 670, 671 (Comm’r 1980) (two unrelated entities that merely share same objection to registration are not in privity).

2. *See International Nutrition Co. v. Horphag Research Ltd.*, 220 F.3d 1325, 55 USPQ2d 1492, 1495 (Fed. Cir. 2000) (discussion of various ‘privity’ relationships); *Warren Distribution, Inc. v. Royal Purple, LLC*, 115 USPQ2d 1667, 1670-71 (TTAB 2015) (notice of opposition untimely where opposer was not in privity with employee who filed extension request in individual name); *Renaissance Rialto Inc. v. Boyd*, 107 USPQ2d 1083, 1086-87 (TTAB 2013) (notice of opposition untimely where opposer, as purported assignee, could not succeed to any proprietary interest in the mark because transferor had no rights to transfer; case dismissed for lack of jurisdiction); *Rolex Watch U.S.A., Inc. v. Madison Watch Co., Inc.*, 211 USPQ 352, 358 (TTAB 1981) (regarding right of owner, or one in privity with owner, to maintain opposition or cancellation based on Trademark Act § 2(d)); *In re Cooper*, 209 USPQ 670, 671 (Comm’r 1980) (two unrelated entities that merely share same objection to registration are not in privity despite having both been named as defendants in civil actions brought by owner of mark). *Cf. John W. Carson Found. v. Toilets.com Inc.*, 94 USPQ2d 1942, 1946-47 (TTAB 2010) (res judicata; privity with parties to previous action); *Argo & Co. v. Carpetsheen Manufacturing, Inc.*, 187 USPQ 366, 367 (TTAB 1975) (motion to suspend granted in view of privity of applicant with parties in civil action); *F. Jacobson & Sons, Inc. v. Excelled Sheepskin & Leather Coat Co.*, 140 USPQ 281, 282 (Comm’r 1963) (parent in privity). *But see Tokaido v. Honda Associates Inc.*, 179 USPQ 861, 862 (TTAB 1973) (respondent’s motion to suspend for civil action between respondent and third party denied where petitioner as nonexclusive licensee of third party was not in privity with third party).

3. *In re Spang Industries, Inc.*, 225 USPQ 888, 888 (Comm’r 1985) (“An attorney/client relationship does not invest the attorney with the same right or interest as his client ....”).

4. *Cf. Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 n.2 (TTAB 2009) (electronically-filed opposition in which opposers were not separately named did not include correct fees; one potential opposer was accordingly not considered to be a party).

### 206.03 Misidentification of Potential Opposer

A request for a further extension, or an opposition, filed in a different name will not be rejected on that ground if it is shown to the satisfaction of the Board that the party in whose name the extension was requested was misidentified through mistake. [Note 1.] The phrase “misidentified through mistake,” as used in [37 C.F.R. § 2.102\(b\)](#), means a mistake in the form of the potential opposer’s name or its entity type, not the naming of a different existing legal entity that is not in privity with the party that should have been named. [Note 2.]

The “showing” submitted in support of a claim of misidentification through mistake should be in the form of a recitation of the facts upon which the claim of misidentification through mistake is based. The showing must be submitted with the request or opposition. ESTTA will prompt the filer to provide an explanation. In the rare instance that the rules permit the filing to be made in paper form, the Board will issue an order requesting an explanation of the discrepancy.

#### NOTES:

1. See [37 C.F.R. § 2.102\(b\)](#); *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1077 (TTAB 1993).

2. *Custom Computer Services, Inc. v. Paychex Properties, Inc.*, 337 F.3d 1334, 67 USPQ2d 1638, 1640 (Fed. Cir. 2003) (entity named in extensions was not a “different existing legal entity” from entity that filed opposition); *Warren Distribution, Inc. v. Royal Purple, LLC*, 115 USPQ2d 1667, 1670-71 (TTAB 2015) (no misidentification through mistake between employee who filed extension request as individual and employer who filed notice of opposition); *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1077 (TTAB 1993) (word processing error resulting in identification of different legal entity was not a “mistake” within the meaning of the rule); [TMEP § 803.06](#) (Applicant May Not be Changed).

*Cf. Arbrook, Inc. v. La Citrique Belge, Naamloze Vennootschap*, 184 USPQ 505, 506 (TTAB 1974) (motion to substitute granted where opposition was mistakenly filed in name of original owner and original owner assigned mark to opposer nunc pro tunc); *Davidson v. Instantype, Inc.*, 165 USPQ 269, 271 (TTAB 1970) (leave to amend to substitute proper party granted where opposition was filed in name of the individual rather than in the name of the corporation); *Pycor, Inc. v. Pico Corp.*, 165 USPQ 221, 222 (TTAB 1969) (where succession occurred prior to filing of opposition, erroneous identification of opposer as a partner in a firm which no longer existed was not fatal); *Raker Paint Factory v. United Lacquer Manufacturing Corp.*, 141 USPQ 407, 409 (TTAB 1964) (sole owner substituted for partnership where original plaintiff identified as partnership composed of that individual, since originally named plaintiff was not actually in existence when opposition was filed and even if it were, as a partner, he is a successor to the partnership).

*Cf. also In re Tong Yang Cement Corp.*, 19 USPQ2d 1689, 1690 (TTAB 1991) (correction not permitted where joint venture owned the mark but the application was filed by a corporation which was one member of the joint venture); *In re Atlanta Blue Print Co.*, 19 USPQ2d 1078, 1079 (Comm’r 1990) (permitted to amend name of registrant in Trademark Act §§ 8 and 15, 15 U.S.C. §§ 1058 and 1065, declaration where



trade name was inadvertently substituted for corporate name); *In re Techsonic Industries, Inc.*, 216 USPQ 619, 620 (TTAB 1982) (allowed to correct application where applicant was identified by only a portion of its earlier used name and earlier name had already been supplanted by new name at time application was filed, but at all times was one single entity); *Argo & Co. v. Springer*, 198 USPQ 626, 634 (TTAB 1978) (Board granted applicant's motion to change its name from corporation which was defectively incorporated to individuals who were true owners of mark at time of filing); *In re Eucryl, Ltd.*, 193 USPQ 377, 378 (TTAB 1976) (exclusive U.S. distributor is owner only if it has agreement with manufacturer providing for right to apply; since distributor had no right to apply, despite its being a sister company and thus related to manufacturer, subsequent assignment to manufacturer did not cure defect); *Argo & Co. v. Springer*, 189 USPQ 581, 582 (TTAB 1976) (defendant can be substituted when originally named party was not in existence at time of filing complaint); *U.S. Pioneer Electronics Corp. v. Evans Marketing, Inc.*, 183 USPQ 613, 614 (Comm'r 1974) (deletion of "company" permissible).

## 207 Requirements for Showing of Cause; Extraordinary Circumstances

37 C.F.R. § 2.102(c) *The time for filing an opposition shall not be extended beyond 180 days from the date of publication. Any request to extend the time for filing an opposition must be filed before thirty days have expired from the date of publication or before the expiration of a previously granted extension of time, as appropriate. Requests to extend the time for filing an opposition must be filed as follows:*

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

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

### 207.01 In General

The time for filing an opposition will not be extended beyond 180 days from the date of publication. [Note 1.] No more than three requests to extend the time to oppose may be filed. [Note 2.] During the initial 30-day period following publication of the mark, a potential opposer may file a first request for a thirty-day extension without a showing of cause, *see* [TBMP § 207.02](#), followed by a request for a sixty-day extension for good cause. [Note 3.] If granted, the potential opposer will have until 120 days from the date of publication within which to oppose. Alternatively, the potential opposer may file a single first request for a ninety-day extension of time for good cause thereby obtaining, if granted, an extension up to 120 days from the date of publication. [Note 4.] A sixty-day extension if not available as a first extension of time to oppose. [Note 5.] After one or two granted requests totaling 120 days from the date of publication, *see* [TBMP § 207.02](#), the potential opposer may request one final extension of time for an additional sixty days, but only with the consent of applicant or a showing of extraordinary circumstances. [Note 6.]

The final request (for the 120-180 day period after publication) can only be granted for sixty days and not any other period of time. [Note 7.] For example, within the 90-120 day period from publication, the potential opposer cannot request a thirty day extension of time, even with the consent of the applicant. If an extension of less than sixty days is requested, even if based on consent, the request will be denied unless the reasons stated for the granting of the request are determined to be extraordinary, in which case the request will be granted for sixty days. In other words, although a thirty day extension of time is not permissible under [37 C.F.R. § 2.102\(c\)\(3\)](#), the presence of extraordinary circumstances would allow the granting of a sixty-day extension of time. No further extensions of time to oppose will be permitted.

The following chart illustrates the initial publication period and extensions of time to oppose which may be granted:

<b>Publication</b> 30 days <a href="#">37 C.F.R. § 2.102(c)</a>	<b>First 30 days</b> – no reason necessary <a href="#">37 C.F.R. § 2.102(c)(1)(i)</a> <b>First 90 Days</b> – for good cause or consent <a href="#">37 C.F.R. § 2.102(c)(1)(ii)</a>	<b>Next 60 days</b> – for good cause or consent <a href="#">37 C.F.R. § 2.102(c)(2)</a>	<b>Final 60 days</b> – with consent or under extraordinary circumstances <a href="#">37 C.F.R. § 2.102(c)(3)</a>
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#### NOTES:

1. [37 C.F.R. § 2.102\(c\)\(3\)](#).
2. [37 C.F.R. § 2.102\(c\)\(1\)\(i\)](#) - [37 C.F.R. § 2.102\(c\)\(2\)](#).
3. [37 C.F.R. § 2.102\(c\)\(1\)\(i\)](#) and [37 C.F.R. § 2.102\(c\)\(2\)](#).
4. [37 C.F.R. § 2.102\(c\)\(1\)\(ii\)](#).
5. [37 C.F.R. § 2.102\(c\)\(1\)\(ii\)](#).
6. [37 C.F.R. § 2.102\(c\)\(3\)](#).
7. [37 C.F.R. § 2.102\(c\)\(3\)](#).

### 207.02 Extensions Up to 120 Days From the Date of Publication

A first extension of time to oppose for not more than thirty days will be granted upon written request, if the request is otherwise appropriate (e.g., is timely filed by a party who believes it would be damaged by registration, and identifies the potential opposer with reasonable certainty). See [TBMP § 202](#) (Time for Filing Request), [TBMP § 206](#) (Who May File an Extension of Time to Oppose). No showing of cause is required for the first thirty-day extension. [Note 1.]

Following the first thirty-day extension of time to oppose, the Board may grant a further extension of time for sixty days, provided good cause is shown for the further extension and the request is otherwise appropriate (e.g., is timely filed before the first thirty-day extension expires, and includes a showing of privity, if necessary). [Note 2.] See [TBMP § 202](#) (Time for Filing Request), [TBMP § 206](#) (Who May File an Extension of Time to Oppose).

Alternatively, a potential opposer may request a ninety-day extension of time in the first request, provided good cause for the extension is shown. [Note 3.] If an otherwise proper first extension request seeks an extension of ninety days, but does not include a showing of good cause for the time in excess of thirty days, the potential opposer will be granted an extension of only thirty days. [Note 4.]

See [TBMP § 209.02](#) for information on calculating extension expiration dates.

A showing of good cause for an extension of time to oppose over thirty days must set forth the reasons why additional time is needed for filing an opposition. Circumstances that may constitute good cause include the potential opposer's need to investigate the claim, the potential opposer's need to confer with or obtain counsel, applicant's consent to the extension, settlement negotiations between the parties, the filing of a letter of protest by the potential opposer, an amendment of the subject application, the filing of a petition to the Director from the grant or denial of a previous extension, and civil litigation between the parties. The merits of the potential opposition are not relevant to the issue of whether good cause exists for the requested extension. See [TBMP § 215](#) (Effect of Letter of Protest), [TBMP § 212](#) (Amendment of Application During or After Extension), [TBMP § 211.03](#) (Petition to the Director).

#### NOTES:

1. See Trademark Act § 13(a), [15 U.S.C. § 1063\(a\)](#); [37 C.F.R. § 2.102\(c\)\(1\)\(i\)](#).
2. [37 C.F.R. § 2.102\(c\)\(2\)](#).
3. [37 C.F.R. § 2.102\(c\)\(1\)\(ii\)](#).
4. See *Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310, 1312 (Comm'r 1991) (under previous rule, potential opposer only entitled to extension of 30 days where initial request exceeded thirty days by two days and potential opposer did not assert good cause for additional days).

### 207.03 Extensions Beyond 120 Days From the Date of Publication

The time for filing an opposition will not be extended beyond 180 days from the date of publication. After one or two granted requests totaling 120 days from the date of publication, see [TBMP § 207.02](#), and prior to the expiration of the previous request, the potential opposer may request one final extension of time for an additional sixty days. [Note 1.]

The final request (for the 120-180 day period after publication) can only be granted for sixty days and not any other period of time. [Note 2.] For example, within the 90-120 day period from publication, the potential opposer cannot request a thirty day extension of time, even with the consent of the applicant. If an extension of less than sixty days is requested, even if based on consent, the request will be denied unless the reasons stated for the granting of the request are determined to be extraordinary, in which case the request will be granted for sixty days. In other words, although a thirty day extension of time is not permissible under [37 C.F.R. § 2.102\(c\)\(3\)](#), the presence of extraordinary circumstances would allow the granting of a sixty day extension of time. No further extensions of time to file an opposition will be granted under any circumstances. [Note 3.]

The Board will grant this request if the potential opposer submits one of the following: (1) a written consent or stipulation signed by the applicant or its attorney, or (2) a request by the potential opposer or its attorney

stating that the applicant has consented to the request, or (3) a showing of extraordinary circumstances. [Note 4.]

Extraordinary circumstances are those which are beyond what is usual or ordinary, for example fire, extreme weather, or death. Settlement negotiations between the parties, the filing of a letter of protest by the potential opposer, the pendency of a post-publication amendment, or civil litigation between the parties do not constitute extraordinary circumstances. [Note 5.]

Applicant's consent to an extension of time to oppose must be express, though it may be provided orally, and the extension request must state that such consent has been provided. It is not sufficient to indicate in the extension request that the parties are discussing settlement; the request must expressly state that applicant has consented to the extension. [Note 6.] In the rare circumstances where the rules permit the request to be filed in paper form, the statement of applicant's consent should appear in the body of the request, not merely in the title (e.g. "Consented Request to Extend") of the filing.

ESTTA provides prompts for either of these elements (extraordinary circumstances or applicant's consent) and a request will not be electronically transmitted to the Office until one of these fields is selected and completed. As a result, extension requests successfully filed using ESTTA will rarely, if ever, be deficient for failure to supply the statement of extraordinary circumstances, or the statement that applicant has consented.

In the case of a permitted paper filing, if one of these elements (i.e., the showing of extraordinary circumstances, or applicant's written consent, or the statement that applicant has consented) is omitted from an extension request based in whole or in part upon the omitted element, the Board can allow the defect to be corrected only if the correction is made prior to the expiration of the time for filing the request, that is, prior to the expiration of the previous extension. [Note 7.]

See [TBMP § 209.02](#) for information on calculating extension expiration dates.

#### NOTES:

1. [37 C.F.R. § 2.102\(c\)\(3\)](#).
2. [37 C.F.R. § 2.102\(c\)\(3\)](#).
3. [37 C.F.R. § 2.102\(c\)\(3\)](#).
4. [37 C.F.R. § 2.102\(c\)\(3\)](#).
5. *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093, 1094 (Comm'r 1990) (mere existence of settlement discussions does not constitute extraordinary circumstances).
6. *See In re Su Wung Chong*, 20 USPQ2d 1399, 1400 (Comm'r 1991) (inadvertent omission of showing of extraordinary circumstances, or consent, at the time extension request was filed does not constitute reason to accept extension; whether applicant's silence in response to potential opposer's inquiries about extension requests amounted to consent was "not the question on petition").
7. *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093, 1094 (Comm'r 1990) (extraordinary circumstances not shown for extension; subsequently obtained consent insufficient). *Cf. In re Spang*

*Industries, Inc.* 225 USPQ 888, 888 (Comm’r 1985) (potential opposer not identified with reasonable certainty; defect not curable after time for filing extension expired).

## 208 Essential Element Omitted

Extension requests filed through ESTTA cannot be electronically transmitted to the Office unless all required fields, including the signature field, are completed, and therefore, ESTTA will not process a request that is missing an essential element (e.g., allegation of consent, extraordinary circumstance). As a result, extension requests successfully filed using ESTTA will rarely, if ever, be deficient for failure to supply an essential element of the request.

Where filing in paper form is undertaken and permitted, if any element (e.g., identification of potential opposer, showing of good cause, showing of extraordinary circumstances, applicant’s written consent, statement that applicant has consented) essential to a particular request for extension of time to oppose is omitted from the request, the Board can allow the defect to be corrected only if the correction is made prior to the expiration of the time for filing the request, that is, prior to the expiration of the thirty-day opposition period following publication of the subject mark, in the case of a first request, or prior to the expiration of the previous extension, in the case of a request for a further extension. [Note 1.]

In the circumstance where a permitted paper filing of an extension of time to oppose is missing the required signature, the unsigned paper request will not be refused consideration if a signed copy is submitted to the Office within the time limit set in the written notification of this defect by the Board. [Note 2.] See [TBMP § 106.02](#). See also [TBMP § 114](#); [TBMP § 203.03](#).

### NOTES:

1. *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093, 1094 (Comm’r 1990) (extraordinary circumstances not shown for extension; subsequently obtained consent insufficient); *In re Spang Industries, Inc.*, 225 USPQ 888 (Comm’r 1985) (potential opposer not identified with reasonable certainty; defect not curable after time for filing extension expired).

2. See [37 C.F.R. § 2.119\(e\)](#).

## 209 Action by Board on Request

### 209.01 Suspension Policy

The Board will not suspend the running of an extension of time to oppose for any reason. A potential opposer must either continue to file timely requests for extensions of time, if it wishes to preserve its right to oppose, or file the notice of opposition. Once the notice of opposition is filed, however, the Board will suspend the opposition under appropriate circumstances. See, e.g., [TBMP § 211.03](#) (no suspension pending decision on petition to the Director), [TBMP § 212.05](#) (no suspension pending consideration of amendment), [TBMP § 215](#) (no suspension pending determination regarding letter of protest), [TBMP § 216](#) (no suspension pending cancellation of an inadvertently issued registration). For information on the suspension of an opposition proceeding *after* commencement, see [TBMP § 510](#).

## 209.02 Determination of Extension Expiration Date

ESTTA automatically calculates extension dates, in the permissible intervals, with the appropriate fee, where applicable.

The extension expiration date stated in an action granting an extension is the date upon which the extension actually expires, even if that date is a Saturday, Sunday, or a federal holiday within the District of Columbia. If the expiration date falls on a Saturday, Sunday, or a federal holiday within the District of Columbia, an opposition, or a request for a further extension, filed by the potential opposer on the next succeeding day which is not a Saturday, Sunday, or a federal holiday will be considered timely. [Note 1.] See [TBMP § 112](#). However, the beginning date for calculating any subsequent extension is the actual expiration date of the previous extension, regardless of whether the expiration date fell on a weekend or federal holiday. [Note 2.]

A potential opposer may file a first request for a thirty-day extension without a showing of cause, [Note 3] followed by a request for a sixty-day extension for good cause that is filed prior to the expiration of the first thirty-day period. [Note 4.] See [TBMP § 207.02](#). Alternatively, the potential opposer may file a single request for a ninety-day extension of time for good cause. [Note 5.] After one or two granted requests totaling 120 days from the date of publication, see [TBMP § 207.02](#), and prior to the expiration of the previous extension, the potential opposer may file one final extension request for an additional sixty days with the consent of applicant or a showing of extraordinary circumstances. [Note 6.]

Extensions of time to oppose will only be granted in the increments set out in [37 C.F.R. § 2.102\(c\)](#).

ESTTA automatically calculates the appropriate extension periods, and filers will be prompted to select a time period which complies with [37 C.F.R. § 2.102\(c\)](#).

For permitted paper filings, incorrectly requested time periods are addressed as follows:

If a paper filing of a potential opposer seeks a *first* request for an extension of time to oppose which is longer than thirty days (or seeks an extension of “thirty days,” but specifies an extension expiration date which is later than the expiration date of the requested “thirty days”), and good cause is shown and the required fee submitted, the extension, if granted, will be set to expire in ninety days. [Note 7.] See [TBMP § 207.02](#).

If a permitted paper filing of a potential opposer seeks a *further* request for extension of time to oppose (that is, beyond a first thirty-day request) and asks for a time which is longer or shorter than sixty days (or asks for certain number of days, but specifies an extension expiration date which is longer or shorter than the expiration date of the requested number of days), shows good cause and submits the required fee, the additional extension, if granted, will be set to expire in sixty days. [Note 8.]

If a permitted paper filing of a potential opposer requests an extension of time for any other period other than a sixty-day request after receiving a first thirty-day and an additional sixty-day extension of time, or a first ninety-day extension of time, the request will be denied unless the party has shown extraordinary circumstances and submitted the required fee. [Note 9.] See [TBMP § 207.03](#).

See [TBMP § 204](#) for information on the required fees for certain extensions of time to oppose.



**NOTES:**

1. See [37 C.F.R. § 2.195](#) (Receipt of trademark correspondence); [37 C.F.R. § 2.196](#) (Times for taking action: Expiration on Saturday, Sunday or federal holiday); *Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310, 1312 (Comm'r 1991) (30-day extension expired on Saturday; rule allowing filing of opposition or subsequent extension on following Monday does not extend opposition period; subsequent extension period ran from Saturday, not the next Monday).
2. *Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310, 1312 (Comm'r 1991).
3. See [37 C.F.R. § 2.102\(c\)\(1\)\(i\)](#).
4. See [37 C.F.R. § 2.102\(c\)\(2\)](#).
5. See [37 C.F.R. § 2.102\(c\)\(1\)\(ii\)](#).
6. See [37 C.F.R. § 2.102\(c\)\(3\)](#).
7. See [37 C.F.R. § 2.102\(c\)\(1\)\(i\)](#) and [37 C.F.R. § 2.102\(c\)\(2\)](#) (“A sixty-day extension is not available as a first extension of time to oppose.”). Cf. *Kimberly-Clark Corp. v. Paper Converting Industries, Inc.*, 21 USPQ2d 1875, 1877 (Comm'r 1991) (under former rules, initial request extending beyond thirty days with required showing of good cause granted).
8. See [37 C.F.R. § 2.102\(c\)\(2\)](#).
9. See [37 C.F.R. § 2.102\(c\)\(3\)](#).

**210 Objection to Request**

Since a request for an extension of time to oppose is ex parte in nature, there is no requirement that a copy has to be served upon the applicant. See [TBMP § 203.04](#). For the same reason, an applicant is not notified of the filing of an extension request before the Board has acted on it. The Board's action on the extension request constitutes notice to the applicant of the extension request, a copy of which may be viewed at <http://ttabvue.uspto.gov>.

An applicant may learn of the filing of an extension request, and file an objection thereto, before applicant receives notice from the Board of the request. This may happen, for example, when a potential opposer serves a courtesy copy of the request upon applicant. If the Board receives an objection before it acts upon the request, the Board will consider the objection. If the objection is received after action on the request, and the request has been granted, the objection will be treated as a request for reconsideration.

However, ESTTA automatically processes requests for extension of time to oppose within minutes of filing. Consequently, it is rare for an applicant to learn of an extension request in time to file an objection prior to Board action on it. Accordingly, an applicant that receives notification from the Board that an extension request has been filed and granted may submit objections in the form of a request for reconsideration. See [TBMP § 211.01](#) (Request for Reconsideration).

An applicant who receives notification from the Board that a request for extension of time to oppose has been granted may submit an objection to the granting of any further extensions of time to the potential

opposer. In such a case, the objection will be considered by the Board in determining any subsequent request for an extension of time to oppose filed by the potential opposer. If the Board does not receive an objection until after the Board has granted a subsequent extension request, the objection will be treated as a request for reconsideration of the Board's action.

Any submission objecting to a request for an extension of time to oppose, or to the granting of any further extensions of time to oppose, should state clearly the reasons for objection. There is no requirement that the submission be served upon the potential opposer. If there is no indication that service has been made, the Board will send potential opposer a copy of the submission together with the Board's action on the extension request, or, if the submission is treated by the Board as a request for reconsideration, with the Board's action on the request for reconsideration.

An ESTTA form for electronically filing an objection is now available. Consequently, the filing must be made through ESTTA.

## **211 Relief From Action of Board**

### **211.01 Request for Reconsideration**

If an applicant or potential opposer is dissatisfied with an order of the Board on a request for an extension of time to oppose, it may file a request for reconsideration of the action, stating the reasons. The request should be filed promptly after the filing party learns of or receives the Board's order, whichever is first.

A request for reconsideration of a Board action relating to a request for an extension of time to oppose is examined by one of the Board's administrative staff members, who will prepare an order granting or denying the request. A copy of the order is entered in the record of the subject application, sent to the applicant, and sent to the potential opposer.

There is no requirement that a request for reconsideration be served upon the non-filing party. If there is no indication that service has been made, the Board will send the non-filing party a copy of the request, usually in the nature of a link to the TTABVUE database, together with that party's copy of the Board's order granting or denying the request.

The filing of a request for reconsideration of the denial, or the granting, of a request for an extension of time to oppose does not relieve the potential opposer of the responsibility of filing an opposition, or a request for a further extension of time to oppose, before the expiration of the relevant extension. [Note 1.] The Board will not suspend the time for filing an opposition or a subsequent extension of time pending consideration of a request for reconsideration. See [TBMP § 209.01](#).

An ESTTA form for electronically filing a request for reconsideration is now available. Consequently, the filing must be made through ESTTA.

#### **NOTES:**

1. Cf. [37 C.F.R. § 2.89\(g\)](#) ("Failure to notify the applicant of the grant or denial of the request prior to the expiration of the existing period or requested extension does not relieve the applicant of the responsibility of timely filing a statement of use under § 2.88.").

## 211.02 Relief after Institution of Opposition

If an applicant is dissatisfied with an order of the Board on a request for an extension of time to oppose and the opposition has been filed and instituted, the applicant may raise the issue by means of a motion to dismiss the opposition for lack of jurisdiction. [Note 1.]

### NOTES:

1. *Central Manufacturing Inc. v. Third Millennium Tech. Inc.*, 61 USPQ2d 1210, 1215 (TTAB 2001) (motion to dismiss granted where it was found that opposer's allegations of consent and good cause for extension request were untrue); *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1075 n.2 (TTAB 1993) (applicant may question propriety of extensions of time in a motion to dismiss).

## 211.03 Petition to the Director

If an applicant or potential opposer is dissatisfied with an order of the Board on a request for an extension of time to oppose, it may file a petition to the Director for review of the order in question. [Note 1.]

The petition to the Director must include a statement of the facts relevant to the petition, the points to be reviewed, the action or relief requested, and the requisite fee, as specified in [37 C.F.R. § 2.6](#). Any brief in support of the petition must be embodied in or accompany the petition. If facts are to be proved, the proof must be in the form of verified statements which, with any exhibits thereto, must accompany the petition. [Note 2.]

A petition from the grant or denial of a request for an extension of time to oppose must be: filed not later than 15 days after the issue date of the grant or denial of the request; served on the attorney, if any, or on the applicant; and served on the attorney, if any, or on the opposer. Proof of service of the petition must be made as provided in [37 C.F.R. § 2.119](#). [Note 3.] See [TBMP § 113.03](#) (Elements of Certificate), and [TBMP § 113.04](#) (Manner of Service). The potential opposer or the applicant, as the case may be, may file a response not later than 15 days after the date of service of the petition. A copy of the response must be served upon the petitioner, with proof of service as provided by [37 C.F.R. § 2.119](#). No further document relating to the petition may be filed. [Note 4.]

The filing of a petition by the potential opposer from the denial, or by the applicant from the granting, of a request for an extension of time to oppose, does not relieve the potential opposer of the responsibility of filing an opposition, or a request for a further extension of time to oppose, prior to the expiration of the extension which is the subject of the petition. [Note 5.] The filing of a petition will constitute good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark, but will not constitute extraordinary circumstances justifying an extension of time beyond 120 days from publication. The Board will not suspend the time for filing an opposition or subsequent extension pending consideration of a petition to the Director. See [TBMP § 209.01](#).

If the petition is resolved unfavorably to opposer during the running of an extension of time, any opposition or request for further extension of time to oppose filed during or after the extension period in question will be rejected as untimely.

If a potential opposer files a timely opposition during the pendency of its petition to the Director, the Board will institute the opposition. At the same time, the Board will normally suspend the opposition pending resolution of the petition. If, along with the notice of opposition, the opposer files a motion to suspend the

opposition, citing the pending petition as the reason for suspension, the Board will institute the opposition, grant the motion to suspend, and state that the opposition is suspended pending resolution of the petition to the Director. A copy of the Board's order will be sent to both parties.

If the decision on the petition is ultimately unfavorable to opposer, the opposition will be dismissed.

#### NOTES:

1. [37 C.F.R. § 2.146](#) (Petitions to the Director). See [TMEP § 1704](#) (Petitionable Subject Matter).
2. [37 C.F.R. § 2.146\(c\)\(1\)](#).
3. [37 C.F.R. § 2.146\(e\)\(1\)](#).
4. [37 C.F.R. § 2.146\(e\)\(1\)](#).
5. See [37 C.F.R. § 2.146\(g\)](#); *In re Docrine Inc.*, 40 USPQ2d 1636, 1637 n.1 (Comm'r 1996) (citing 37 C.F.R. § 2.146(g) and stating that filing petition to review denial of request to extend time to oppose does not stay time to file opposition or further extensions of time to oppose).

## 212 Amendment of Application During or After Extension

### 212.01 Jurisdiction to Consider Amendment

The Board has no jurisdiction over an application unless and until the application becomes involved in a Board inter partes proceeding. [Note 1.] That is, although the Board administers requests for extensions of time to oppose, and has jurisdiction over matters relating to any requested extensions of time to oppose an application, the Board does not have jurisdiction over the subject application until a notice of opposition is filed. In the absence of an inter partes proceeding, the Board has jurisdiction only over matters relating to any requested extensions of time to oppose.

Thus, if, in an application which is the subject of a request for an extension of time to oppose, an amendment or other submission (such as a request for republication, a request for reconsideration of a refusal to approve an amendment) relating to the application is filed by the applicant, unless the application is involved in any Board inter partes proceeding, it is the Trademark Examining Operation (and not the Board) which must determine the propriety of the amendment or other submission. [Note 2.] That is, unless an inter partes proceeding (i.e., an opposition or concurrent use proceeding) is pending, all post-publication amendments concerning an application which is the subject of a request for an extension of time to oppose must be filed with the Trademark Examining Operation. [Note 3.]

However, the Board does determine the propriety of a request filed by an attorney to withdraw as applicant's representative, in an application which is the subject of a request for an extension of time to oppose. The Board has jurisdiction to consider the request to withdraw as representative in such a case, because applicant's representative of record acts on applicant's behalf in matters relating to the requested extensions of time to oppose. See [TBMP § 114](#)-[TBMP § 116](#) for information on representation of parties before the Board. See also [TBMP § 203.03](#).

Any amendment to an application which is the subject of a request for an extension of time to oppose that is proposed by an applicant prior to the commencement of an inter partes proceeding, whether of its own

volition or to accommodate a concern of a potential opposer, must be filed electronically through TEAS. Inquiries regarding the procedure for submitting a post-publication amendment, or questions regarding the status of a pending post-publication amendment, can be made by calling the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199.

Because the Board does not have jurisdiction over an application until the commencement of an inter partes proceeding, parties should take care to direct amendments filed during the opposition period (as extended) to the Trademark Examining Operation as noted above, and not the Board. Filing such submissions with the Board will only delay consideration of the amendment. Moreover, the Board will not suspend the time for filing an opposition or subsequent extension pending consideration of an amendment. *See* [TBMP § 209.01](#). While the pendency of an amendment to an application will normally constitute good cause for an extension of time to oppose under [37 C.F.R. § 2.102\(c\)\(1\)\(ii\)](#) or [37 C.F.R. § 2.102\(c\)\(2\)](#) (extensions up until 120 days from the date of publication), it will not be considered an extraordinary circumstance justifying an extension of time to oppose under [37 C.F.R. § 2.102\(c\)\(3\)](#) (extension 120-180 days from publication). [TBMP § 207.03](#). Parties seeking amendment of a published application as a means to avoid the filing of an opposition are thus advised to do so as early in the opposition period as possible.

#### NOTES:

1. Compare [37 C.F.R. § 2.84](#) (examining attorney may exercise jurisdiction over application prior to publication, and with the permission of the Director, after publication) with [37 C.F.R. § 2.133](#) (application subject to an opposition may not be amended in substance without Board approval). *See generally* [TMEP § 1504](#) (Jurisdiction over Application).
2. *See* [37 C.F.R. § 2.84](#); *In re MCI Communications Corp.*, 21 USPQ2d 1534, 1535 (Comm'r 1991). *Cf. Groening v. Missouri Botanical Garden*, 59 USPQ2d 1601, 1603 (Comm'r 1999) (mark originally published in wrong class may be amended by examining attorney to the correct class and republished in the correct class without either applicant's approval or a restoration of jurisdiction).
3. For information on the procedures for filing and processing post-publication amendments with the Trademark Examining Operation, see [TMEP § 1505](#) (Amendments Filed by Applicants After Publication).

### 212.02 Conditions for Approval of Post-Publication Amendment

During the time between the publication of a mark in the Official Gazette for opposition, and the issuance of a certificate of registration or notice of allowance, an application not involved in an inter partes proceeding before the Board may be amended upon request by the applicant with the Trademark Examining Operation, provided that the amendment meets the requirements of [37 C.F.R. § 2.71](#), [37 C.F.R. § 2.72](#) and [37 C.F.R. § 2.74](#). [Note 1.] Otherwise, an amendment to such an application may be submitted only upon petition to the Director to restore jurisdiction over the application to the examining attorney for consideration of the amendment and further examination. [Note 2.] If a proposed amendment would necessitate issuance of a refusal or requirement by the examining attorney, the amendment cannot be made unless applicant (1) successfully petitions the Director to restore jurisdiction over the application to the examining attorney for consideration of the amendment and further examination, and (2) is able to satisfy any requirement or overcome any refusal asserted in any Office action issued after the restoration of jurisdiction. [Note 3.]

Examples of the types of amendments which may be made under the conditions described above include acceptable amendments to the identification of goods or services, to the drawing, to add a disclaimer, and (in the case of an application under Trademark Act § 1(a), [15 U.S.C. § 1051\(a\)](#), or an application under

Trademark Act § 1(b), [15 U.S.C. § 1051\(b\)](#), in which an acceptable amendment to allege use has been filed), to convert an application for an unrestricted registration to one for concurrent use registration. [Note 4.]

An applicant who files an amendment to its application during an extension of time to oppose need not have potential opposer's consent thereto.

#### NOTES:

1. [37 C.F.R. § 2.84\(b\)](#).
2. [37 C.F.R. § 2.84\(b\)](#).
3. *See, e.g.*, [37 C.F.R. § 2.84\(b\)](#); [TMEP § 1504](#) (Jurisdiction over Application); [TMEP § 1505](#) *et seq.* (Amendments filed by Applicants After Publication).
4. *See In re MCI Communications Corp.*, 21 USPQ2d 1534, 1539 (Comm'r 1991) (disclaimer). *Cf. In re Little Caesar Enterprises, Inc.*, 48 USPQ2d 1222, 1223 (Comm'r 1998) (regarding request to divide certain items out of a class of goods during extension of time to oppose, and petition to waive rule requiring that request to divide be filed before application is approved for publication). *See generally* [TMEP § 1505.01](#) regarding procedures for processing amendments filed after publication.

### 212.03 Form of Amendment

An amendment or other submission relating to an application which is the subject of a request for an extension of time to oppose should be in the normal form for an amendment or other submission relating to an application. Such amendments should be filed with the Trademark Examining Operation electronically through TEAS. Inquiries regarding the procedure for submitting a post-publication amendment, or questions regarding the status of a pending post-publication amendment, can be made by calling the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199.

### 212.04 Action by Board - Upon Receipt of Amendment

Amendments filed in applications which are the subject of an extension of time to oppose are acted on by the Trademark Examining Operation and not by the Board, and must be filed electronically through TEAS, with limited exceptions. [Note 1.] Filing such amendments with the Board serves only to delay their consideration. If an amendment is received by the Board, the amendment will be forwarded to the Trademark Examining Operation.

#### NOTES:

1. *See* [37 C.F.R. § 2.23\(c\)](#), [37 C.F.R. § 2.56\(d\)](#), and [TMEP §301.01](#) (Electronic Filing is Mandatory).

### 212.05 Action by Board - During Consideration of Amendment by TMEO

The filing and pendency of an amendment will be considered good cause for extensions of time to oppose under [37 C.F.R. § 2.102\(c\)\(1\)\(ii\)](#) or [37 C.F.R. § 2.102\(c\)\(2\)](#) (extensions up to 120 days from the date of publication), but it will not constitute extraordinary circumstances justifying an extension of time under [37 C.F.R. § 2.102\(c\)\(3\)](#) (extension 120-180 days from publication). *See* [TBMP § 207.03](#). The Board will not



suspend the time for filing an opposition or subsequent extension pending consideration of an amendment. See [TBMP § 209.01](#).

If a timely opposition is filed while an amendment is still pending before the Trademark Examining Operation, the Board will institute the opposition. Upon the motion of either party, the Board will usually grant a motion to suspend the opposition pending consideration of the amendment by the Trademark Examining Operation. Such a motion to suspend should be promptly filed through ESTTA by either party to an opposition proceeding once that party becomes aware of the filing of the amendment with the Trademark Examining Operation.

### **212.06 Action by Board - After Consideration of Amendment by TMEO**

If an opposition was instituted and suspended prior to the action by the Trademark Examining Operation on a post-publication amendment, and the amendment is subsequently approved, the Board will notify the parties that the amendment was approved, advise the parties that the opposition will go forward on the basis of the application as amended, allow opposer time to indicate whether it wishes to proceed with the opposition on that basis, or to have the opposition dismissed. The Board will also suspend the opposition (or continue suspension) pending opposer's response. If opposer chooses to go forward, proceedings in the opposition will be resumed and appropriate dates will be set or reset. If the amendment is not approved, the parties will be so advised, and proceedings will be resumed with appropriate dates set or reset.

### **212.07 Amendment During Opposition**

If an amendment is filed in an application that is the subject of an opposition, the Board has jurisdiction over the application and will determine the propriety of the amendment. Once an opposition has commenced, the application that is the subject of the opposition may not be amended in substance, except with the consent of the other party or parties and the approval of the Board, or upon motion granted by the Board. [Note 1.] See [TBMP § 514](#) (Motion to Amend Application or Registration).

#### **NOTES:**

1. See [37 C.F.R. § 2.133](#).

### **213 Effect of Restoration of Jurisdiction**

If the examining attorney wishes to issue a new refusal or make a requirement in an application that is the subject of a request for an extension of time to oppose, the examining attorney must make a request to the Director to restore jurisdiction over the application to the examining attorney for that purpose. [Note 1.] If the application is the subject of an opposition, the examining attorney's request for jurisdiction must be directed to the Board. [Note 2.]

It should be noted that with respect to an application filed under Trademark Act § 66(a), [15 U.S.C. § 1141f\(a\)](#), if an opposition has commenced, the examining attorney may not request remand, [Note 3], and that before an opposition commences, a request to restore jurisdiction must be directed to the Director, who will take into consideration the time constraints established by treaty regarding notification of the International Bureau of the World Intellectual Property Organization of any refusal. Thus, because an application filed under Trademark Act § 66(a), [15 U.S.C. § 1141f\(a\)](#), is time-sensitive, the granting of a request to return such application to the examination process is unlikely. [Note 4.]

A request for jurisdiction that is granted by the Director during an unexpired extension of time to oppose does not relieve the potential opposer of the responsibility of filing an opposition, or a request for a further extension of time to oppose, before the expiration of the previous request. After the Board learns that the examining attorney's jurisdiction has been restored during the running of an extension of time to oppose, a Board administrative staff member will prepare an order advising potential opposer and applicant.

As appropriate, the order will approve the extension of time (or, if already approved, note that potential opposer has been granted an extension of time to oppose until a specified date); instruct the examining attorney that if the application is subsequently approved, and the mark is not republished, the application remains subject to any current extensions of time to oppose or oppositions which may have been timely filed; and advise potential opposer that the restoration of jurisdiction does not relieve the potential opposer of the responsibility of filing an opposition, or a further request for extension of time to oppose, prior to the expiration of the previous request.

The restoration of jurisdiction (or the filing of a request for jurisdiction) will constitute good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark, but will not constitute extraordinary circumstances justifying an extension of time beyond 120 days from publication. The Board will not suspend the time for filing an opposition or subsequent extension of time to oppose during restoration of jurisdiction to the examining attorney. *See* [TBMP § 209.01](#).

If, after jurisdiction has been restored, and during the running of an extension of time, the examining attorney approves the application, and the mark is not republished, the Board administrative staff member will issue an order so advising the potential opposer and applicant. The order will also approve the extension of time, if appropriate (or, if already approved, note that potential opposer has been granted an extension of time to oppose until a specified date).

If, after consideration before the examining attorney, the mark is republished, or if registration is ultimately denied, any time remaining in the opposition period, as extended (and any further request for extension) will be moot. No further extension of the original opposition period will be granted. Rather, a potential opposer's time for opposing will recommence on the date of republication.

If a timely opposition is filed while the question of registrability is still before the examining attorney, the Board will institute the opposition. At the same time, the Board will normally suspend proceedings until the registrability of the mark has been finally determined. If, at the time the notice of opposition is filed, the opposer files a motion to suspend the opposition, citing the restoration of jurisdiction as the reason for suspension, the Board will institute the opposition, grant the motion to suspend, and indicate that the opposition is suspended pending final determination of the registrability of the mark. To ensure suspension under such circumstances, the opposer should concurrently, but in a filing separate from the notice of opposition, move to suspend the opposition.

If the examining attorney subsequently approves the application, and the mark is republished, and if the change reflected in the republication is one that might have an effect upon an opposition which was timely filed, the Board will issue an order notifying opposer and applicant of the republication, and of the reason therefor; explain that the opposition will be determined on the basis of applicant's correct (or amended) mark, goods or services, disclaimer status, etc.; and allow opposer time to indicate whether it wishes to proceed with the opposition on that basis, or to have the opposition dismissed as a nullity. If opposer chooses to go forward, proceedings in the opposition will be resumed and appropriate dates will be set or reset.

If registration is ultimately denied by the examining attorney, any timely filed opposition will be dismissed as a nullity.

**NOTES:**

1. See [37 C.F.R. § 2.84\(a\)](#); [TMEP § 1504.01](#) (Jurisdiction of Examining Attorney), [TMEP § 1504.02](#) (Jurisdiction of Trademark Trial and Appeal Board); *In re Hershey*, 6 USPQ2d 1470, 1471 n.2 (TTAB 1988) (restoration of jurisdiction to examining attorney by Director is not subject to review by the Board).
2. See [37 C.F.R. § 2.130](#) (New matter suggested by the trademark examining attorney); [TMEP § 1504.02](#).
3. See [TMEP § 1504.05](#).
4. See [TMEP § 1902.02\(1\)](#).

**214 Effect of Republication**

The examining attorney may determine that an application filed under Trademark Act § 1 or Trademark Act § 44, [15 U.S.C. § 1051](#) or [15 U.S.C. § 1126](#), that is the subject of a request for an extension of time to oppose must be republished. This may happen, for example, when the goods or services, although properly identified in the application itself, were published incorrectly; when a disclaimer was mistakenly included in the original publication; or when the application has been amended after publication (but before the filing of an opposition), and the amendment is of such nature as to require republication. [Note 1.] Republication may not be available to applications filed under Trademark Act § 66(a), [15 U.S.C. § 1141f\(a\)](#), due to the time requirements of the Madrid Protocol. [Note 2.]

If a mark is republished by order of the examining attorney, any opposition filed during the original thirty-day opposition period, or within a granted extension thereof, is considered by the Board to be timely. If the change reflected in the republication is one that might have an effect upon the opposition, the Board will issue an order notifying opposer and applicant of the republication, and of the reason therefor; explain that the opposition will be determined on the basis of the application as amended; and allow opposer time to indicate whether it wishes to proceed with the opposition on that basis, or to have its opposition dismissed.

However, once the Board learns that a mark that is the subject of a request for an extension of time to oppose has been or will be republished by order of the examining attorney, no further extension of the original opposition period will be granted. Rather, a potential opposer's time for opposing will recommence with the republication of applicant's mark. Thus, if there is a pending request for an extension of time to oppose, a Board administrative staff member will issue an order notifying potential opposer and applicant of the republication and taking appropriate action with respect to the extension request. Normally, the extension request will be deemed moot. However, if the extension request was filed within thirty days after the date of republication, it may be treated as a request for an extension of the new opposition period.

If there had been an error in the first publication, or the application has been amended thereafter, republication is sometimes necessary in order to give potential opposers fair notice of the registration sought by applicant. Occasionally, however, a mark that has been published correctly, and has not been amended thereafter, is republished not because there is any need for republication, but by inadvertence. When there is no need for republication, and a mark is republished solely by mistake (as, for example, when an application has survived an opposition, and is ready to issue as a registration, but is inadvertently sent to publication rather than to issue), the application may not properly be subjected to another opposition period.

Accordingly, when it comes to the attention of the Board that an application has been republished by mistake, the Board will not entertain any opposition or request for an extension of time to oppose filed in response

to the republication. An opposition filed in response to the inadvertent republication will not be considered (or if instituted, will be dismissed), and the opposition fee will be refunded. The remedy of a would-be opposer or potential opposer in such a case lies in the filing of a petition for cancellation, under Trademark Act § 14, [15 U.S.C. § 1064](#), after applicant's registration has been issued.

#### NOTES:

1. See [TMEP § 1505.03](#) and [TMEP § 1505.03\(a\)](#) listing examples of amendments for which republication is necessary and [TMEP § 1505.03\(b\)](#) listing those for which republication is not necessary.
2. See Trademark Act § 68(c) and Trademark Act § 69(a), [15 U.S.C. § 1141h\(c\)](#) and [15 U.S.C. § 1141i\(a\)](#); *In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019, 2020 (TTAB 2005) (discussing time constraints applicable to Trademark Act § 66(a), 15 U.S.C. § 1141f(a) (Madrid Protocol) applications).

### 215 Effect of Letter of Protest

A third party that has objective evidence bearing upon the registrability of a mark in a pending application may bring such evidence to the attention of the Office by filing, with the Office of the Deputy Commissioner for Trademark Examination Policy ("Deputy Commissioner"), a "letter of protest" that complies with the requirements of [37 C.F.R. § 2.149](#). [Note 1.] The Deputy Commissioner will determine if the letter of protest complies with the requirements of Trademark Rule 2.149 and whether any submitted evidence should be included in the application record for consideration by the examining attorney. [Note 2.]

A letter of protest may be filed either before or after publication of the subject mark for opposition. However, a letter of protest filed after publication must be filed within thirty days after publication in order to be considered timely. [Note 3.] In the case of a published application that is not the subject of an opposition, if the Deputy Commissioner determines that the submission complies with the requirements of Trademark Rule 2.149 and submitted evidence will be included in the application record, jurisdiction over the application will be restored to the examining attorney to take appropriate action. This procedure applies regardless of whether a request for an extension of time to oppose the application is pending. If an opposition has been instituted, the Board has jurisdiction over the application and will restore jurisdiction to the examining attorney upon request. [Note 4.]

The filing of a letter of protest, whether before or after publication of the mark, does not stay the time for filing an opposition or an extension of time to oppose the subject mark. [Note 5.] If a party files a letter of protest before publication but the subject mark still publishes for opposition, then the party must timely file a request for extension of time to oppose, if it wishes to preserve its right to oppose. Similarly, if a party that files a letter of protest after publication wishes to preserve its right to oppose, it too must file a timely request for an extension of time to oppose. [Note 6.] Regardless of when the letter of protest was filed, if the subject mark has been published for opposition, the party may choose to file a notice of opposition instead of a request for extension of time to oppose.

If a potential opposer indicates, in a first or a subsequent request for an extension of time to oppose, that it has filed a letter of protest (not yet determined by the Deputy Commissioner) with respect to the subject mark, such filing will constitute good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark. However, the filing will not constitute extraordinary circumstances justifying an extension of time beyond 120 days from publication. The Board will not suspend the time for

filing an opposition or subsequent extension of time to oppose pending consideration of a letter of protest. See [TBMP § 209.01](#).

If a potential opposer indicates, in a first or a subsequent request for an extension of time to oppose, that a different party has filed a letter of protest (not yet determined by the Deputy Commissioner), with respect to a mark that is the subject of the potential opposer's request for an extension of time to oppose, the filing of the letter of protest will not be considered by the Board to constitute good cause for the granting of an extension to the potential opposer. In other words, a potential opposer may not rely on the filing of a letter of protest by a different party to establish good cause for its own extension of time to oppose.

Typically, a letter of protest is filed and a determination whether submitted evidence should be included in the application record is made before the mark is published. In such case, the examining attorney retains jurisdiction over the application and decides whether to issue a refusal based on the evidence included in the record. [Note 7.] Sometimes, a letter of protest is filed *before* the mark has been published for opposition but the Deputy Commissioner does not review the submission until after the mark has been published. In such case, if the mark has not been opposed, and the examining attorney determines that a refusal or requirement must be made based on the evidence included in the application record, jurisdiction will be restored to the examining attorney to take action on the application. [Note 8.] In any case where an opposition has already been instituted when the Deputy Commissioner makes a determination to include evidence submitted with a letter of protest in the application record, jurisdiction rests with the Board, and therefore a request must be made to the Board to remand the application to the examining attorney to take a specific action. [Note 9.]

If the Deputy Commissioner includes evidence submitted with a letter of protest in the record of an application that is the subject of a first or subsequent request for an extension of time to oppose, the Board may address the consequences of the determination in any order on any further request to extend, or when instituting an opposition.

Examples are described below:

#### **Determination Made on Letter of Protest During Extension of Time:**

Sometimes, when an extension of time to oppose is granted, a determination also has been made to include evidence submitted with a letter of protest in the application record. If jurisdiction has been restored and the examining attorney has issued an Office action asserting a refusal or a requirement, and if a well-taken first or subsequent request for an extension of time to oppose is reviewed during this time, a Board administrative staff member may prepare an order notifying the potential opposer and applicant that jurisdiction over the application was restored to the examining attorney who has issued an Office action as a result of evidence submitted with a letter of protest being included in the record; and that neither the issuance of an action by the examining attorney nor the filing of a response and/or amendment by the applicant relieves the potential opposer of the responsibility of filing an opposition, or a further request for extension of time to oppose, prior to the expiration of the previous request. While the Board attempts to provide such information to the applicant and potential opposer in every instance in which the letter of protest procedure results in jurisdiction being restored to the examining attorney and issuance of an Office action, if the Board fails to do so, the potential opposer is not excused from the noted responsibilities.

#### **Determination Made on Letter of Protest During Opposition:**

If a party files a timely opposition while a letter of protest is pending review by the Deputy Commissioner, the Board will institute the opposition as it normally would. If the Deputy Commissioner subsequently

determines that the letter of protest (filed before or after publication of the subject mark) is compliant and includes evidence in the application record, a request to remand the application to the examining attorney will be made to the Board. [Note 10.] If the Board remands the application back to the examining attorney, the opposition will be suspended for as long as the question of registrability of the subject mark is before the examining attorney.

**Please Note:** A Trademark Act § 66(a) application may not be remanded under [37 C.F.R. § 2.130](#).

If a party files a timely opposition after a determination has been made to include evidence submitted with a letter of protest in the application record and after jurisdiction has been restored to the examining attorney, the Board will normally institute and suspend the opposition until the registrability of the mark has been finally determined by the examining attorney. To ensure suspension under such circumstances, the opposer should concurrently, but in a filing separate from the notice of opposition, move to suspend the opposition, citing the restoration of jurisdiction as the reason for suspension, when filing the notice of opposition.

If an opposed application is abandoned by the applicant for non-response to an Office action issued after jurisdiction has been restored to the examining attorney, or if a refusal made by the examining attorney is upheld on appeal, judgment will not be entered against the applicant under [37 C.F.R. § 2.135](#). Instead, the Board may resume the suspended opposition, giving opposer time to indicate whether it wishes to go forward to obtain a determination on the merits or to have the opposition dismissed as moot. If, however, applicant files a written abandonment without the written consent of every adverse party, judgment will be entered against applicant under [37 C.F.R. § 2.135](#). See [TBMP § 602.01](#).

If the examining attorney subsequently withdraws any refusal or requirement issued in regard to an opposed application in which jurisdiction had been restored to the examining attorney, or if any refusal of registration is reversed on appeal, the Board should be notified for resumption of the suspended opposition. Republication of a mark following restoration of jurisdiction should be very rare, but if the mark is republished, and if the change reflected in the republication is one that might have an effect upon the opposition, the Board will resume the opposition and issue an order notifying opposer and applicant of the republication. The Board will note the reason for republication; explain that the opposition will be determined on the basis of the application as amended; and allow the opposer time to indicate whether it wishes to proceed with the opposition against the amended application, or have the opposition dismissed as moot. If opposer chooses to go forward, appropriate dates will be reset.

#### NOTES:

1. [TMEP § 1715](#).
2. See [TMEP § 1715](#). For information concerning the standard applied by the Deputy Commissioner in determining whether evidence submitted with a letter of protest should be entered into the record, see [TMEP § 1705.03](#) (Letter of Protest Filed Before Publication), and [TMEP § 1705.04](#) (Letter of Protest Filed on the Date of Publication or After Publication).
3. [37 C.F.R. § 2.149\(c\)](#), [TMEP § 1715.02](#) (“Letters of protest filed more than 30 days after publication are untimely.”). Cf. *National Cable Television Association Inc. v. American Cinema Editors Inc.*, 19 USPQ2d 1424 (Fed. Cir. 1991) (letter of protest filed after registration issued deemed “an ineffectual gesture”).
4. [TMEP § 1715.03\(c\)](#) and [TMEP § 1715.04\(b\)](#). See also [37 C.F.R. § 2.130](#); [TMEP § 1504.02](#).



5. [TMEP § 1715.03\(e\)](#); *In re Pohn*, 3 USPQ2d 1700, 1703 (Comm’r 1987).
6. *See In re BPJ Enterprises Ltd.*, 7 USPQ2d 1375, 1377 (Comm’r 1988).
7. *See* [TMEP § 1504.01](#). *Accord Sheetz of Delaware, Inc. v. Doctor’s Associates Inc.*, 108 USPQ2d 1341 (TTAB 2013) (letter of protest submitted during prosecution of the application and later submitted under notice of reliance as evidence by opposer during trial).
8. [TMEP § 1715.03\(b\)](#).
9. [TMEP § 1715.04\(b\)](#).
10. *See* [37 C.F.R. § 2.130](#); [TMEP § 1715.03\(c\)](#). *See also* [TMEP § 1504.02](#).

## 216 Inadvertently Issued Registration

Sometimes a registration is issued, mistakenly, from an application that, at the time of such issuance, is the subject of an unexpired extension of time to oppose, or a timely opposition. These circumstances are examples of where a registration is referred to as “inadvertently issued.”

The Board is without authority, within the context of either an extension of time to oppose, or an opposition proceeding, to cancel an inadvertently issued registration and restore it to application status. Rather, it is the Director who has such authority, and the Director exercises this authority with caution. [Note 1.] A registration will ordinarily be deemed to have been issued inadvertently if a notice of opposition or a request for extension of time to oppose was timely and properly filed but the registration nonetheless issued. [Note 2.] The Director will not find that a registration issued inadvertently if (1) the notice of opposition was defective in some manner, and (2) that defect prevented the Office from identifying the application in question, and from withholding the issuance of a registration. [Note 3.]

Accordingly, when it comes to the attention of the Board that a registration has issued inadvertently from an application that is the subject of an unexpired extension of time to oppose, the Board will issue an order approving the extension of time, if appropriate, or, if already approved, noting that potential opposer has been granted an extension of time to oppose until a specified date, and advising potential opposer that if it wishes to preserve its right to oppose should the registration be cancelled as inadvertently issued, potential opposer must continue to file further timely requests for extensions of time to oppose, or it must file the notice of opposition. The Board will then notify the Director. The Director, in turn, may either cancel the registration as inadvertently issued, and restore it to application status, or decline to do so.

The inadvertent issuance of the registration will be considered good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark, but it will not constitute extraordinary circumstances justifying an extension of time beyond 120 days from publication. The Board will not suspend the time for filing an opposition or subsequent extension of time to oppose pending cancellation of an inadvertently-issued registration. *See* [TBMP § 209.01](#).

If a registration that issued inadvertently during an extension of time to oppose is not cancelled by the Director and restored to application status, any opposition that may have been filed by the potential opposer will not be instituted, and any submitted opposition fee will be refunded. The potential opposer’s substantive remedy, under the statute, will be through a petition to cancel the registration.

If a timely opposition is filed while the matter of the registration is pending before the Director, the Board will acknowledge the filing of the notice or opposition and inform the parties that the opposition will be instituted if and when the inadvertently issued registration has been cancelled. A copy of the Board's action will be sent to both parties.

If the Director cancels and restores the registration to application status, the opposition will be instituted and appropriate dates will be set. If the Director declines to cancel the registration, the opposition will not be instituted and the fee will be refunded.

If a registration issues inadvertently during such time as a timely request for an extension of time to oppose or an opposition is pending, the Director normally will cancel the registration as inadvertently issued, and restore it to application status. However, if the opposition has already been finally determined in applicant's favor when the inadvertent issuance is discovered, applicant may either keep the registration, or request that it be cancelled as inadvertently issued, restored to application status, and then reissued.

#### NOTES:

1. *In re Siemens Aktiengesellschaft*, 34 USPQ2d 1862, 1863 (Comm'r Pat. 1995) (inherent authority to cancel an inadvertently issued registration "is to be exercised with caution.") (citing *Mc Lachlan Touch Inc.*, 6 USPQ2d 1395, 1396 (Comm'r 1987)).
2. *Quality S. Manufacturing Inc. v. Tork Lift Central Welding of Kent, Inc.*, 60 USPQ2d 1703, 1704 (Comm'r 2000).
3. *Quality S. Manufacturing Inc. v. Tork Lift Central Welding of Kent, Inc.*, 60 USPQ2d 1703, 1704 (Comm'r 2000) (where notice of opposition misidentified the serial number of opposed application, Director declined to cancel registration, finding that error which caused the registration to issue was made by opposer, not as result of inadvertent act by the Office).

### 217 Relinquishment of Extension

If a potential opposer whose request for an extension of time to oppose is pending, or whose granted extension has not yet expired, files a letter notifying the Board that it will not oppose, the Board will immediately forward the application that was the subject of the request or extension for issuance of a registration certificate or notice of allowance, as appropriate.

If a potential opposer that has requested or obtained an extension of time to oppose has agreed unconditionally in writing not to oppose, applicant may submit a copy of the agreement to the Board, with an appropriate cover letter bearing proof of service upon potential opposer, and the Board will immediately forward the subject application for issuance of a registration certificate or notice of allowance, as appropriate. Cf. [TBMP § 212.06](#) (Action by Board-After Consideration of Amendment by TMEQ).

An ESTTA form for either situation described above involving relinquishment of an extension of time to oppose is available. Consequently, the filing must be made through ESTTA.

### 218 Abandonment of Application

If an applicant files an express abandonment of an application that is the subject of a pending or granted request for extension of time to oppose, or if a Trademark Act § 66(a), [15 U.S.C. § 1141f\(a\)](#), application

that is the subject of a pending or granted request for extension of time to oppose is abandoned by the Office as the result of cancellation of the underlying international registration, [Note 1] the application stands abandoned and any pending request for an extension of time to oppose is moot. An application that has been abandoned is no longer subject to the filing of a new opposition. Any opposition filed on or after the filing date of the abandonment will not be considered, and the filing fee will be refunded. If the opposition was instituted prior to the Board's knowledge of the filing of an express abandonment, the opposition will be dismissed as a nullity and the opposition fee will be refunded. [Note 2.] Cf. [TBMP § 602.01](#) (Withdrawal by Applicant) for information concerning abandonment of an application after the commencement of an opposition.

The abandonment of an application that is not the subject of an inter partes proceeding before the Board (i.e., an opposition, interference, or concurrent use proceeding) is without prejudice to the applicant. It is not necessary that applicant obtain a potential opposer's consent thereto. [Note 3.] Therefore, abandonment of an application during an extension of time to oppose is without prejudice (regardless of whether the potential opposer consents).

In contrast, after the commencement of an opposition, interference, or concurrent use proceeding, if an applicant files an express abandonment of its application (or if a Trademark Act § 66(a), [15 U.S.C. § 1141f\(a\)](#), application is abandoned by the Office as the result of cancellation of the underlying international registration) without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant. [Note 4.] However, if an application is abandoned after the commencement of an opposition, interference, or concurrent use proceeding, but before applicant has been notified thereof by the Board, the applicant will be given an opportunity to obtain the written consent of every adverse party. [Note 5.]

An applicant may expressly abandon its application by filing with the Office a written statement of abandonment or withdrawal of the application, signed by the applicant or by the applicant's attorney. [Note 6.] An express abandonment (filed prior to commencement of an opposition) must be filed using TEAS, with limited exceptions. [Note 7.] Express abandonments filed prior to the commencement of an opposition should not be directed to the Board.

When an applicant files an express abandonment of an application that is the subject of a pending or a granted request for extension of time to oppose, or a Trademark Act § 66(a), [15 U.S.C. § 1141f\(a\)](#), application is abandoned by the Office as the result of cancellation of the underlying international registration, the status of the application in USPTO databases reflects the abandonment. A further extension of time to oppose or a notice of opposition cannot be filed against an abandoned application via ESTTA. That is, ESTTA will not allow the processing of either a further extension of time to oppose or a notice of opposition. A potential opposer also may check the status of an application using USPTO databases, including TSDR, before pursuing a further extension of time to oppose or a notice of opposition.

## NOTES:

1. If an international registration is cancelled by the International Bureau (IB) for any reason, the IB will notify the USPTO and the USPTO will abandon the corresponding Trademark Act § 66(a), [15 U.S.C. § 1141f\(a\)](#), application. See [37 C.F.R. § 7.30](#). If the international registration is cancelled under Article 6(4) of the Madrid Protocol, the applicant may "transform" its abandoned Trademark Act § 66(a) application into one under Trademark Act § 1 or Trademark Act § 44, [15 U.S.C. § 1051](#) or [15 U.S.C. § 1126](#). See [37 C.F.R. § 7.31](#). Although the transformed application retains the filing and priority date of the abandoned Trademark Act § 66(a) application, [37 C.F.R. § 7.31\(b\)](#), it is reexamined under 37 C.F.R. § Part 2, and will be published for opposition, even if it had been published prior to transformation. [37 C.F.R. § 7.31\(c\)](#). See [TMEP § 1904.09](#), *et seq.*, for information on transformation.

2. See *3PMC, LLC v. Huggins*, 115 USPQ2d 1488, 1489 (TTAB 2015) (application abandoned on same day that notice of opposition was filed was not subject to opposition); *Societe des Produits Nestle S.A. v. Basso Fedele & Figli*, 24 USPQ2d 1079, 1081 n.1 (TTAB 1992); *In re First National Bank of Boston*, 199 USPQ 296, 297 (TTAB 1978) (notice of opposition and abandonment both filed on same day; no opposition).

3. See [37 C.F.R. § 2.68](#).

4. See [37 C.F.R. § 2.135](#).

5. See [37 C.F.R. § 2.68](#). Cf. *Rwachsberg Holdings Inc. v. Grüne Erde Beteiligungs GmbH*, 2021 USPQ2d 926, at \*3 n.7 (TTAB 2021) (applicant not allowed to withdraw express abandonment of all classes, including classes not opposed).

6. See [37 C.F.R. § 2.68](#).

7. See [37 C.F.R. § 2.23\(c\)](#), [37 C.F.R. § 2.56\(d\)](#), and [TMEP §301.01](#).

## 219 Amendment to Allege Use; Statement of Use

An amendment to allege use under Trademark Act § 1(c), [15 U.S.C. § 1051\(c\)](#), filed in an intent-to-use application (i.e., an application under Trademark Act 1(b), [15 U.S.C. § 1051\(b\)](#)) after approval for publication, is late-filed. [Note 1.] Thus, an amendment to allege use filed during an extension of time to oppose or during an opposition is late-filed.

A statement of use under Trademark Act § 1(d), [15 U.S.C. § 1051\(d\)](#), is premature if it is filed in an intent-to-use application prior to the issuance of a notice of allowance under Trademark Act § 13(b)(2), [15 U.S.C. § 1063\(b\)\(2\)](#). [Note 2.] A notice of allowance is issued in an intent-to-use application (for which no amendment to allege use has been timely filed and accepted) only after the opposition period (as extended) has expired and all oppositions filed have been dismissed. [Note 3.] Thus, a statement of use filed during an extension of time to oppose or during an opposition is premature.

Any late-filed amendment to allege use or premature statement of use will not be considered, and any fee submitted therewith will be refunded. [Note 4.]

If an intent-to-use application has been published and is under a well-taken request for an extension of time to oppose when a timely filed amendment to allege use (i.e., an amendment to allege use filed prior to approval for publication) is associated with the application, the Board will issue an action approving the extension of time (or, if already approved, noting that potential opposer has been granted an extension of time to oppose until a specified date) and advise the potential opposer that if it wishes to preserve its right to oppose should the amendment to allege use be ultimately withdrawn by the applicant or approved by the examining attorney, the potential opposer must continue to file further timely requests for extensions of time to oppose, or it must file the notice of opposition.

The examining attorney will process the amendment to allege use in the same manner as any other timely filed amendment to allege use that is not associated with the application file until after publication. [Note 5.] In the event that the amendment to allege use is ultimately withdrawn by the applicant, or approved by the examining attorney, the examining attorney should notify the Board (before any scheduled republication of applicant's mark) for further appropriate action with respect to the extension of time to oppose. [Note 6.] If the application is abandoned while it is before the examining attorney, the Board should be notified.

The filing of the amendment to allege use will be considered good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark, but it will not constitute extraordinary circumstances justifying an extension of time beyond 120 days from publication. In such a situation, the Board will not suspend the time for filing an opposition or a subsequent extension of time to oppose pending consideration of the amendment to allege use. See [TBMP § 209.01](#).

If an intent-to-use application has already been published, and is the subject of an opposition, when a timely filed amendment to allege use (i.e., an amendment to allege use filed prior to approval for publication) is associated with the application, the Board normally will suspend the opposition and return the application to the trademark examining attorney for appropriate action with respect to the amendment to allege use. In the event that the amendment to allege use is ultimately withdrawn by the applicant, or approved by the examining attorney, the examining attorney should so notify the Board and the Board will take further appropriate action with respect to the opposition. [Note 7.] If the application is abandoned while it is before the examining attorney, the examining attorney should likewise notify the Board.

## NOTES:

1. [37 C.F.R. § 2.76\(a\)](#); *In re Sovran Financial Corp.*, 25 USPQ2d 1537, 1538 (Comm'r 1992) (amendment to allege use filed during blackout period denied as untimely).
2. Trademark Act § 1(d)(1) and Trademark Act § 13(b)(2), [15 U.S.C. § 1051\(d\)\(1\)](#) and [15 U.S.C. § 1063\(b\)\(2\)](#); [37 C.F.R. § 2.81\(b\)](#).
3. Trademark Act § 13(b)(2), [15 U.S.C. § 1063\(b\)\(2\)](#); [37 C.F.R. § 2.81\(b\)](#).
4. [37 C.F.R. § 2.76\(a\)](#); [37 C.F.R. § 2.88\(a\)](#). See [TMEP § 1104.03\(c\)](#) (Processing Amendment to Allege Use Filed During the Blackout Period).
5. See [TMEP § 1104.04](#) (Processing Timely Amendment to Allege Use Discovered After Publication).
6. See [TMEP § 1104.04](#).
7. See [TMEP § 1104.04](#).

## 220 Inadvertent Issuance of a Notice of Allowance

On a rare occasion, a notice of allowance is issued mistakenly in an intent-to-use application that, at the time of such issuance, is the subject of an unexpired extension of time to oppose or a timely opposition. If a notice of allowance is inadvertently issued in an intent-to-use application which is the subject of an unexpired extension of time to oppose or a timely opposition, and a statement of use is filed, the notice of allowance will be cancelled by the ITU/Divisional Unit as inadvertently issued. The statement of use will be returned, and the fee submitted therewith will be refunded. [Note 1.]

Sometimes a notice of allowance issues after a request for an extension of time to oppose has been submitted but before the request is approved. If, by the time the Board learns of the issuance of the notice of allowance, the extension requested has expired, and no opposition or further extension requests have been filed, the Board will issue an action acknowledging the extension request, and indicating that it was well-taken but that time has since expired and no opposition or further request has been filed. The Board will also indicate that a notice of allowance was inadvertently issued during the requested extension period, but since the

requested time period has run without subsequent action by the potential opposer, the notice of allowance will not be withdrawn.

**NOTES:**

1. See [TMEP § 1106.03](#) (Cancellation of Notice of Allowance).