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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 CFR § 2.101 Filing an opposition.**

**(a)** An opposition proceeding is commenced by filing in the Office a timely notice of opposition with the required fee. The notice must include proof of service on the applicant, or its attorney or domestic representative of record, at the correspondence address of record in the Office, as detailed in §§ 2.101(b) and 2.119.

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

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

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

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

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

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

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

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

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

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

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

**37 CFR § 2.102 Extension of time for filing an opposition.**

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

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

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

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

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

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

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

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

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 TBMP § 303.02.

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 upon the Principal Register may file a written request to extend the time for filing an opposition. [Note 2.] Requests for extensions of time to oppose are determined by the Board. [Note 3.]

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 CFR § 2.102(c). Other requirements for a request for extension of time to oppose are set forth in 37 CFR § 2.102(a) and 37 CFR § 2.102(b).

Moreover, an extension of time to oppose must also meet the general requirements for submissions to the Board specified in 37 CFR § 2.126. Each of these requirements is discussed in the sections that follow.

#### **NOTES:**

1. Trademark Act § 13(a), 15 U.S.C. § 1063(a); 37 CFR § 2.101.
2. Trademark Act § 13(a), 15 U.S.C. § 1063(a); 37 CFR § 2.102.
3. See 37 CFR § 2.102(a); *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1075 n.2 (TTAB 1993) (37 CFR § 2.102 delegates the authority to the Board to grant ex parte extensions of time to oppose).

## **202 Time for Filing Request**

### **202.01 In General**

**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) [§ 43(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 [§ 12] 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 CFR § 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 either a thirty-day extension of time, which will be granted upon request, or a ninety-day extension of time, which will be granted only for good cause shown.*

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

*(3) After receiving one or two extensions of time totaling ninety days, a person may file one final request for an extension of time for an additional sixty days. The Board will grant this request only upon written consent or stipulation signed by the applicant or its authorized representative,*

*or a written request by the potential opposer or its authorized representative stating that the applicant or its authorized representative has consented to the request, or a showing of extraordinary circumstances. No further extensions of time to file an opposition will be granted under any circumstances.*

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), for purposes of opposition. Any request for a further extension of time to oppose must be filed prior to the expiration of an extension granted to the requesting party or its privy. [Note 1.]

The timely filing of documents in the Office requires that the documents actually be received in the Office within the set time period unless such documents are filed in accordance with 37 CFR § 2.197 and 37 CFR § 2.198, which provide for filing of papers by certificate of mailing and Express Mail, respectively. See TBMP § 110 and TBMP § 111. Documents filed in accordance with these rules are considered as having been filed on the date of deposit as first class U.S. mail or Express Mail even if the mailed correspondence is not received in the Office until after the due date. [Note 2.] See TBMP § 110.01. The Express Mail filing procedure applies only to the “Express Mail” of the United States Postal Service, not any third-party carrier that offers overnight delivery. [Note 3.] See TBMP § 110.01. For extension requests filed electronically through the Board’s Electronic System for Trademark Trials and Appeals (ESTTA), all time periods are calculated electronically and the filer is immediately informed of the timeliness of the filing. See TBMP § 109 and TBMP § 110.09.

In the event that a particular extension request submitted on paper is timely filed with an appropriate certificate of mailing, pursuant to 37 CFR § 2.197, but is not received in the Office, the correspondence will be considered timely if the party that submitted it supplies an additional copy of the previously mailed extension request and certificate, and includes a statement attesting to the previous timely mailing. The statement must be verified if it is made by a person other than a practitioner, as defined in 37 CFR § 11.1. [Note 4.] TBMP § 110.01. The only evidence accepted by the Office to prove deposit of the missing extension request is an exact copy of the disputed document including a copy of the executed original certificate of mailing. A reconstructed request and certificate of mailing will not suffice. [Note 5.] See generally TBMP § 110.

A potential opposer that has filed an extension request on paper should not wait until it has received notification from the Board of the grant or denial of the request before filing an opposition or a request for a further extension of time to oppose. If a request for an extension of time to oppose is granted, the length of the granted extension may be less than that sought in the extension request. A first extension runs from the expiration of the thirty-day opposition period after publication. In the case of a subsequent extension, it will run from the date of expiration of the previously granted extension. [Note 6.] While the Board attempts to notify a potential opposer of the grant of an extension request filed on paper before a granted extension expires, particularly when the length of the granted extension is less than that requested, the Board is under no obligation to do so, and in some cases cannot. [Note 7.] Note that filing extension requests electronically using ESTTA will usually eliminate this problem, since almost all

ESTTA extension requests are processed automatically and granted within minutes of filing.

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.] 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.] Alternatively, the potential opposer may file a single first request for a ninety-day extension of time for good cause. [Note 10.] 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 11.]

The final request (120-180 days after publication) can only be granted for sixty days and not any other period of time. [Note 12.] For example, after 120 days 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 based on consent, the request will be denied unless the reasons stated for the granting of the request are extraordinary, in which case the request will be granted for sixty days instead of the thirty days requested. This is because a thirty-day extension of time is not permissible under 37 CFR § 2.102(c)(3). However, the citing of extraordinary circumstances would allow the granting of a sixty-day extension of time.

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

<b>Publication</b> 30 days <u>37 CFR § 2.102(c)</u>	<b>First 30 days</b> – no reason necessary <u>37 CFR § 102(c)(1)</u>	<b>Next 60 days</b> – for good cause or consent <u>37 CFR § 102(c)(2)</u>	<b>Final 60 days</b> – with consent or under extraordinary circumstances <u>37 CFR § 102(c)(3)</u>
	<b>First 90 Days</b> – for good cause or consent <u>37 CFR § 102(c)(1)</u>		

**NOTES:**

1. Trademark Act § 13(a), 15 U.S.C. § 1063(a); 37 CFR § 2.102(c). *See In re Cooper*, 209 USPQ 670, 671 (Comm’r 1980) (timeliness of extension requests is statutory and cannot be waived).
2. *See In re Pacesetter Group, Inc.*, 45 USPQ2d 1703, 1704 (Comm’r 1994).
3. *See In re Pacesetter Group, Inc.*, 45 USPQ2d 1703, 1704 (Comm’r 1994) (papers filed using overnight courier not entitled to benefit of Express Mail procedure). Because the certificate of mailing and Express Mail procedures both require use of the United States Postal Service, correspondence mailed from outside of the United States is not eligible to receive the benefit of either provision. Accordingly, papers posted from outside of the United States will be accorded a filing date as of the date of their actual receipt in the USPTO. *See* 37 CFR § 2.195(a). Note,

however, that electronic filing using ESTTA is available to all filers, from wherever transmitted. ESTTA papers are accorded the filing date (Eastern time -- USA) upon which the Office receives the complete transmission. 37 CFR § 2.195(a)(2); <http://estta.uspto.gov> (instructions for filing via ESTTA).

4. *See* 37 CFR § 2.197(b).

5. *In re Sasson Licensing Corp.*, 35 USPQ2d 1510, 1512 (Comm'r 1995) (a declaration attesting to the filing and to the certificate of mailing is not acceptable as evidence of timely filing).

6. *See In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093, 1094 (Comm'r 1990).

7. *See Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310, 1312 (Comm'r 1991) (where misdirection of initial extension prevented Board from addressing calculation error in the request); *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093, 1094 (Comm'r 1990) (potential opposer was not notified of partial grant of extension request until after date had passed). *Cf. In re Holland Amercian Wafer Co.*, 737 F.2d 1015, 222 USPQ 273, 275 (Fed. Cir. 1984) (no statute or regulation imposes obligation on Office to notify parties of defects in sufficient time to allow correction); *In re L.R. Sport Inc.*, 25 USPQ2d 1533, 1534 (Comm'r 1992) (no obligation to notify of defective statement of use); *In re Application Papers Filed November 12, 1965*, 152 USPQ 194, 195 (Comm'r 1966) (no obligation to discover deficiencies within a specified time).

8. 37 CFR § 2.102(c).

9. 37 CFR §§ 2.102(c)(1)-(2).

10. 37 CFR § 2.102(c)(1).

11. 37 CFR § 2.102(c)(3).

12. 37 CFR § 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 for opposition, pursuant to 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 this time for filing an opposition under certain conditions. Thus, any opposition, and any request for an extension of time to oppose, filed before the 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 privy. 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.] Accordingly, a first request filed after the expiration of the thirty-day period following publication of the subject mark, or a request for a further extension filed after the expiration of the previous extension granted to the requesting party or its privy, must 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 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.

### **NOTES:**

1. Trademark Act § 13(a), 15 U.S.C. § 1063(a); 37 CFR § 2.102(c). *See In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980).
2. *See In re Sasson Licensing Corp.*, 35 USPQ2d 1510, 1512 (Comm'r 1995) (waiver of 37 CFR § 1.8 (now 37 CFR § 2.197) would effectively waive Trademark Act § 13, 15 U.S.C. § 1063(a), and, in any event, fact that potential opposer did not retain executed hard copies of documents filed with Office and cannot prove document was timely is not an extraordinary circumstance justifying a waiver of 37 CFR § 1.8); *In re Kabushiki Kaisha Hitachi Seisakusho*, 33 USPQ2d 1477, 1478 (Comm'r 1994); *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980).

## **203 Form of Request**

### **203.01 General Considerations**

#### **203.01(a) Paper or Electronic Filings**

##### **37 CFR § 2.102 Extension of time for filing an opposition.**

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

*chapter. Electronic signatures pursuant to § 2.193(c) are required for electronically filed extension requests.*

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

A request for an extension of time to oppose must be made in writing and must specify the period of extension desired. [Note 1.]

A request for extension of time to oppose a Trademark Act § 1 or Trademark Act § 44, 15 U.S.C. § 1051 or 15 U.S.C. § 1126 application may either be filed on paper or through ESTTA. [Note 2.] *See* TBMP § 106.03 and TBMP § 107. However, a request for extension of time to oppose a Trademark Act § 66(a), 15 U.S.C. § 1141f(a) (Madrid Protocol), application must be filed through ESTTA. [Note 3.] *See* TBMP § 106.03. The requirements for paper and electronic submissions to the Board are specified in 37 CFR § 2.126(a) and 37 CFR § 2.126(c), respectively. Available forms and instructions for electronic filing can be found at <http://estta.uspto.gov>.

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.] 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.] Alternatively, the potential opposer may file a single first request for a ninety-day extension of time for good cause. [Note 6.] 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 7.]

The final request (120–180 days after publication) can only be granted for sixty days and not any other period of time. [Note 8.] For example, at 120 days after 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 based on consent, the request will be denied unless the reasons stated for the granting of the request are extraordinary, in which case the request will be granted for sixty days instead of the thirty days requested. This is because a thirty day extension of time is not permissible under 37 CFR § 2.102(c)(3). However, the citation of extraordinary circumstances would allow the grant of a sixty day extension of time.

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

<b>Publication</b> 30 days <u>37 CFR § 2.102(c)</u>	<b>First 30 days</b> – no reason necessary <u>37 CFR § 102(c)(1)</u>	<b>Next 60 days</b> – for good cause or consent <u>37 CFR § 102(c)(2)</u>	<b>Final 60 days</b> – with consent or under extraordinary circumstances <u>37 CFR § 102(c)(3)</u>
	<b>First 90 Days</b> – for good cause or consent <u>37 CFR § 102(c)(1)</u>		

**NOTES:**

1. 37 CFR § 2.102(a).
2. 37 CFR § 2.102(a)(1).
3. 37 CFR § 2.102(a)(2).
4. 37 CFR § 2.102(c)(3).
5. 37 CFR § 2.102(c).
6. 37 CFR § 2.102(c)(1).
7. 37 CFR § 2.102(c)(3).
8. 37 CFR § 2.101(c)(3).

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

Electronic filing of extensions of time to oppose using ESTTA is optional, except in the case of extensions of time to oppose applications under Trademark Act § 66(a), 15 U.S.C. § 1141f(a) (Madrid Protocol). [Note 1.] It should be noted, however, that nearly all extensions of time to

oppose are now filed electronically using ESTTA. Electronic filing is strongly encouraged by the Board. Use of ESTTA for filing extensions of time to oppose provides users with instant proof of timely filing, even when use of a certificate of mailing or the Express Mail procedure is unavailable. *See* TBMP § 202.01. Moreover, because ESTTA prompts the user to supply and verify all required information, use of ESTTA for filing extensions of time to oppose will usually avoid common pitfalls in filing. Most extensions of time to oppose filed via ESTTA are automatically processed, providing a nearly instantaneous order (via e-mail) granting the requested extension (if appropriate).

ESTTA forms, including a request for extension of time to oppose, and filing instructions can be found at <http://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 e-mail to [ESTTA@uspto.gov](mailto:ESTTA@uspto.gov). [Note 2.] The e-mail address is for technical ESTTA questions only. Questions of a general nature regarding Board proceedings should be directed to the phone numbers listed above. **Papers will not be accepted for filing by e-mail.**

*See* TBMP § 106.03 and TBMP § 110.09 for general information on ESTTA filing.

#### **NOTES:**

1. 37 CFR § 2.102(a)(2). *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).

2. When sending an e-mail 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 telephone number for contact. The Board will respond to e-mail inquiries within two business days. E-mail should not be used for more urgent inquiries.

## **203.02 Identifying Information**

### **203.02(a) In General**

An extension request filed on paper 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. Any attachments to ESTTA forms should be separately captioned and identified for clarity.

## 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 CFR §§ 2.194(b)(1)-(2) (“A letter about a trademark application should identify the serial number, the name of the applicant, and the mark.” “A letter about a registered trademark should identify the registration number, the name of the registrant, and the mark.”).

### **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.] If a request for extension of time to oppose fails to identify the potential opposer with reasonable certainty, 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, 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. [Note 2.]

If a 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.

**Tip for ESTTA filers:** 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 CFR § 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 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; one potential opposer was accordingly not considered to be a party).

### **203.03 Signature**

**37 CFR § 2.102(a)** *Any person who believes that he, she or it would be damaged by the registration of a mark on the Principal Register may file in the Office a written request, addressed to the Trademark Trial and Appeal Board, to extend the time for filing an opposition. The written request need not be verified, but must be signed by the potential opposer or by the potential opposer's attorney, as specified in § 11.1 of this chapter, or authorized representative, as specified in § 11.14(b) of this chapter. Electronic signatures pursuant to § 2.193(c) are required for electronically filed extension requests.*

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 CFR § 11.1 or other authorized representative, as specified in 37 CFR § 11.14(b). [Note 1.] A paper 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 business address (to which correspondence relating to the request will be sent); and telephone number. This information is required on the electronic form as well.

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.*

While a request for an extension of time to oppose must be signed, an 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 3.] TBMP § 106.02. An extension request filed through ESTTA cannot be electronically transmitted to the Office unless all required fields, including the signature field, are completed.

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 (after submission of a signed copy of the request) 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 CFR § 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 CFR § 2.193(c). See TMEP § 611.01(b) (Requirements for Signature), TMEP § 611.01(c) (Signature of Documents Filed Electronically).
3. 37 CFR § 2.119(e).

### **203.04 Service**

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.] The timely filing of a notice of opposition in the Office with proof of service and the required fee commences an opposition proceeding. [Note 2.] 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 3.] 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 extension request together with the Board's action thereon. [Note 4.]

#### **NOTES:**

1. 37 CFR § 2.119(a).
2. 37 CFR § 2.101(a).
3. *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).
4. 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.

When duplicate paper requests have been filed and the first request has been granted, the second request is given no consideration, and the attorneys are notified in writing of the duplicate filings

and are requested to take appropriate action to avoid filing duplicate requests in the future. [Note 1.] If requests filed by different attorneys on behalf of the same party are duplicates but for the fact that the second request seeks a longer extension than the first, the second request will be granted, if otherwise appropriate, but the attorneys will be requested in writing to avoid the filing of further duplicate requests.

#### **NOTES:**

1. 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. However filed, counsel should avoid duplicate filings by checking the application status in TTABVUE prior to filing an extension request (or any other paper).

### **204 Fee**

There is no fee for filing a request for an extension of time to oppose. [Note 1.]

#### **NOTES:**

1. *See* 37 CFR § 2.6.

### **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 registration's issuance. [Note 3.]

Accordingly, the Board must deny any request for an extension of time to oppose the mark in an application for registration on the Supplemental Register. 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 CFR § 2.82.

2. Trademark Act § 23(b) and Trademark Act § 24; 15 U.S.C. § 1091(b) and 15 U.S.C. § 1092; 37 CFR § 2.82.

3. Trademark Act § 24, 15 U.S.C. § 1092; 37 CFR § 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 CFR § 2.102 Extension of time for filing an opposition.**

*(a) Any person who believes that he, she or it would be damaged by the registration of a mark on the Principal Register may file in the Office a written request, addressed to the Trademark Trial and Appeal Board, to extend the time for filing an opposition. ...*

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

### **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 written 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) 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. The Board may question a potential opposer's standing in appropriate cases, either upon motion or sua sponte. But 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 standing 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 CFR § 2.101.
2. Trademark Act § 13(a), 15 U.S.C. § 1063(a); 37 CFR § 2.102.
3. 37 CFR § 2.102(b).
4. *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.").
5. See 37 CFR § 2.102(b); *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994); *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980).
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").

### **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, and must be submitted either with the request or opposition, or during the time allowed by the Board in its action 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.

**Tip for ESTTA filers:** 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 CFR § 2.102(b); *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 Renaissance Rialto Inc. v. Boyd*, 107 USPQ2d 1083, 1086-87 (TTAB 2013) (notice of opposition untimely where opposer not a successor to any proprietary interest in the mark where transferor had no rights to transfer); *International Nutrition Co. v. Horphag Research Ltd.*, 220 F.3d 1325, 55 USPQ2d 1492, 1495 (Fed. Cir. 2000) (discussion of various ‘privity’ relationships); *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). *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 CFR § 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, and must be submitted either with the request or opposition, or during the time allowed by the Board in its letter requesting an explanation of the discrepancy.

#### NOTES:

1. See 37 CFR § 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); *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); *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); *Pyco, 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 providing for right to apply; since distributor had no right to apply, subsequent assignment to proper applicant 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 CFR § 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 either a thirty-day extension of time, which will be granted upon request, or a ninety-day extension of time, which will be granted only for good cause shown.*

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

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

### **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. 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 2.] Alternatively, the potential opposer may file a single first request for a ninety-day extension of time for good cause. [Note 3.] 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 4.]

The final request (120-180 days after publication) can only be granted for sixty days and not any other period of time. [Note 5.] For example, 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 based on consent, the request will be denied unless the reasons stated for the granting of the request are extraordinary, in which case the request will be granted for sixty days instead of the thirty days requested. This is because a thirty day extension of time is not permissible under 37 CFR § 2.102(c)(3). However, the citation 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 37 CFR § 2.102(c)	<b>First 30 days</b> – no reason necessary 37 CFR § 102(c)(1)	<b>Next 60 days</b> – for good cause or consent 37 CFR § 102(c)(2)	<b>Final 60 days</b> – with consent or under extraordinary circumstances 37 CFR § 102(c)(3)
	<b>First 90 Days</b> – for good cause or consent 37 CFR § 102(c)(1)		

**NOTES:**

1. 37 CFR § 2.102(c)(3).
2. 37 CFR § 2.102(c).
3. 37 CFR § 2.102(c)(1).
4. 37 CFR § 2.102(c)(3).
5. 37 CFR § 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.]

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 CFR § 2.102(c).
2. 37 CFR § 2.102(c).
3. 37 CFR § 2.102(c)(1).
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 (120-180 days after publication) can only be granted for sixty days and not any other period of time. [Note 2.] For example, 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 based on consent, the request will be denied unless the reasons stated for the granting of the request are extraordinary, in which case the request will be granted for sixty days instead of the thirty days requested. This is because a thirty day extension of time is not permissible under 37 CFR § 2.102(c)(3). However, the citation 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 authorized representative, or (2) 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 (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.]

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 request that the parties are discussing settlement; the request must expressly state that applicant has consented to the extension. [Note 6.] In addition, the statement of consent should appear in the body of the request, not merely in the title (e.g. “Consented Request to Extend”) of the 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.]

#### **NOTES:**

1. 37 CFR § 2.102(c)(3).
2. 37 CFR § 2.102(c)(3).
3. 37 CFR § 2.102(c)(3).
4. 37 CFR § 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) (applicant’s silence in response to potential opposer’s inquiries about extension requests does not amount to consent).
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**

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.]

While a request for an extension of time to oppose must be signed, an 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. Extension requests filed through ESTTA cannot be electronically transmitted to the Office unless all required fields, including the signature field, are completed. 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.

#### **NOTES:**

1. *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 CFR § 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 decision on 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**

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 CFR § 2.102(c). If a first request for an extension of time to oppose asks for a time 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, the extension, if granted, will be set to expire in ninety days. [Note 7.] See TBMP § 207.02. If good cause for a first extension beyond thirty days has not been shown, the time will be set to expire on the thirtieth day. [Note 8.] See TBMP § 207.02 (Extensions Up to 120 Days From Date of Publication).

If a further request for extension of time to oppose (that is, beyond a first thirty-day request) 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), and shows good cause, the extension, if granted, will be set to expire in sixty days.

After receiving a first thirty-day and a sixty-day extension of time, or a first ninety-day extension of time, if a potential opposer requests an extension of time for any other period other than a sixty-day request, the request will be denied unless the party has cited extraordinary circumstances. [Note 9.] See TBMP § 207.03.

**Note for ESTTA filers:** ESTTA automatically calculates extension dates, preventing many pitfalls associated with calculation of extension dates. Further, ESTTA only allows requests to be made in permissible intervals, avoiding mistakes and unexpected results.

## NOTES:

1. See 37 CFR § 2.195 (Receipt of trademark correspondence); 37 CFR § 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 CFR § 2.102(c)(1).

4. See 37 CFR § 2.102(c)(2).
5. See 37 CFR § 2.102(c)(1).
6. See 37 CFR § 2.102(c)(3).
7. See 37 CFR § 2.102(c); *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 CFR § 2.102(c).
9. See 37 CFR § 2.102(c)(3).

## **210 Objections 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 will provide notice to the applicant of the extension request, which may be viewed at <http://ttabvue.uspto.gov>.

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

However, nearly all requests for extension of time to oppose are now filed electronically, and most of those will be automatically processed within minutes, so 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).

Further, an applicant who receives notification from the Board that a request for extension of time to oppose has been granted may submit objections to the granting of any further extensions of time to the potential opposer. In such a case, the objections will be considered by the Board in determining any subsequent request filed by the potential opposer, for an extension of time to oppose. If the Board does not receive objections until after it has granted a subsequent extension request, they will be treated as a request for reconsideration of the Board's action.

Any document 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 document 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 document together with the Board's action on the extension request, or, if the document is treated by the Board as a request for reconsideration, with the Board's action on the request for reconsideration.

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

### **211.01 Request for Reconsideration**

If an applicant or potential opposer is dissatisfied with an action 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 receives the Board's action.

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 action granting or denying the request. One copy of the action is entered in the record of the subject application, one copy is sent to the applicant, and one copy is 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 together with that party's copy of the Board's action 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.

#### **NOTES:**

1. Cf. 37 CFR § 2.89(g).

### **211.02 Relief after Institution of Opposition**

If an applicant is dissatisfied with an action 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 action 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 action 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 CFR § 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 affidavits or declarations in accordance with 37 CFR § 2.20, and these affidavits or declarations, 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 within 15 days from the mailing date of the grant or denial of the request. [Note 3.] A petition from the denial of a request must be served on the attorney or other authorized representative of the applicant, if any, or on the applicant. [Note 4.] A petition from the grant of a request must be served on the attorney or other authorized representative of the opposer, if any, or on the opposer. [Note 5.] Proof of service of the petition must be made as provided in 37 CFR § 2.119. [Note 6.] See TBMP §§ 113.03 (Elements of Certificate), and 113.04 (Manner of Service). The potential opposer or the applicant, as the case may be, may file a response within 15 days from the date of service of the petition. [Note 7.] A copy of the response must be served upon the petitioner, with proof of service as provided by 37 CFR § 2.119(a). No further document relating to the petition may be filed. [Note 8.]

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 9.] 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 action will be sent to both parties.

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

**NOTES:**

1. 37 CFR § 2.146 (Petitions to the Director). See TMEP § 1704 (Petitionable Subject Matter).
2. 37 CFR § 2.146(c).
3. 37 CFR § 2.146(e)(1).
4. 37 CFR § 2.146(e)(1).
5. 37 CFR § 2.146(e)(1).
6. 37 CFR § 2.146(e)(1).
7. 37 CFR § 2.146(e)(1).
8. 37 CFR § 2.146(e)(1).
9. See 37 CFR § 2.146(g); *In re Docrite Inc.*, 40 USPQ2d 1636, 1637 n.1 (Comm'r 1996) (citing 37 CFR § 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 extension of time to oppose, 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 paper (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, and the application is not 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 paper. [Note 2.] Unless an inter partes proceeding (i.e., an opposition or concurrent use proceeding) is pending, all post-publication amendments must be filed with the Trademark Examining Operation. [Note 3.]

However, the Board does determine the propriety of a request filed by an attorney or other authorized representative 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 in 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.

Any amendment 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 or by faxing it to the USPTO at (571) 270-9007. Any inquiry about the status of the amendment should be directed by e-mail to [TMPostPubQuery@uspto.gov](mailto:TMPostPubQuery@uspto.gov).

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 papers with the Board will only delay consideration of the amendment. 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 CFR §§ 2.102(c)(1) or (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 CFR § 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 CFR § 2.84 (examining attorney may exercise jurisdiction over application prior to publication, and with the permission of the Director, after publication) with 37 CFR § 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 CFR § 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

printing 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, provided that the amendment does not necessitate issuance of a refusal or requirement by the examining attorney. If a refusal or requirement by the examining attorney would be needed, 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 1.]

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 2.]

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. *E.g.*, 37 CFR § 2.84(b); TMEP § 1504 (Jurisdiction over Application); TMEP § 1505 et seq. (Amendments filed by Applicants After Publication).
2. *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 paper 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 document relating to an application. Such amendments should be filed with the Trademark Examining Operation electronically through TEAS or by faxing it to the USPTO at (571) 270-9007.

### **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 should be filed either electronically through TEAS or by faxing the amendment to (571) 270-9007. Filing such amendments with the Board serves only to delay consideration of the paper. If an amendment is received by the Board, the amendment will be forwarded to the Trademark Examining Operation.

## **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 CFR § 2.102(c)(1) or 37 CFR § 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 CFR § 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.

In situations where the potential opposer files the notice of opposition electronically using ESTTA, the potential opposer should file the notice of opposition first and wait to receive an opposition number. (Most ESTTA-filed oppositions are instituted automatically within minutes of successful filing.) After the opposition number has been received and a proceeding number assigned, the potential opposer should then file a separate motion to suspend the opposition, citing the pendency of an amendment as grounds for seeking a suspension of proceedings.

## **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; and 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. If the amendment is not approved, the parties will be so advised, and proceedings will be resumed with appropriate dates set.

## **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 CFR § 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 request 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 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, a Board administrative staff member will prepare an order advising potential opposer and applicant thereof, and take further appropriate action. Examples are described below.

If the restoration of jurisdiction occurs during the running of an extension of time to oppose, the order will inform the potential opposer and applicant that jurisdiction over the application has been restored to the examining attorney; 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); 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 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, along with the notice of opposition, 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.

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.

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

#### **NOTES:**

1. See 37 CFR § 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 CFR § 2.130 (new matter suggested by the trademark examining attorney); TMEP § 1504.02.

3. See TMEP § 1504.05.

4. See TMEP § 1904.02(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 go to issue, 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. See specifically 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), Trademark Act § 69(a), 15 U.S.C. § 1141h(c); *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 knowledge of facts bearing upon the registrability of a mark in a pending application may bring such information 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 is, a letter that recites the facts and is accompanied by supporting evidence. [Note 1.] The Deputy Commissioner will determine whether the letter of protest should be “granted,” that is, whether the information or evidence should be given to the examining attorney for consideration. [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 ordinarily must be filed within thirty days after publication in order to be considered timely, and will usually be denied as untimely if filed more than thirty days after publication. [Note 3.] If the application is the subject of an opposition, the request for restoration of jurisdiction must be directed to the Board. [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 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 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 granted 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 submitted with the letter of protest. [Note 7.] Sometimes, a letter of protest is filed *before* the mark has been published for opposition but the Deputy Commissioner does not grant the letter of protest until after the mark has been published. In such case, if the mark has not been opposed, it is discretionary with the examining attorney whether to request that the Deputy Commissioner restore jurisdiction for further consideration of the registrability of the mark. [Note 8.] If the mark has been opposed, jurisdiction rests with the Board, and therefore the examining attorney must request that the Board remand the application for the purpose of making a refusal or requirement based on the relevant evidence submitted with the letter of protest. [Note 9.] On the other hand, if a letter of protest is filed *after* the mark has been published, and the Deputy Commissioner grants the letter of protest, then regardless of whether an extension of time request to oppose the application is pending, the Deputy Commissioner will restore jurisdiction to the examining attorney for the purpose of making a refusal or requirement based on the relevant evidence submitted with the letter of protest. [Note 10.] If the mark is the subject of an opposition when the Deputy Commissioner grants a letter of protest, jurisdiction rests with the Board, and therefore the examining attorney must request that the Board remand the application for the purpose of making a refusal or requirement based on the relevant evidence submitted with the letter of protest. [Note 11.]

If the Deputy Commissioner grants a letter of protest filed with respect to 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 grant in any order on any further request to extend, or when instituting an opposition.

Examples are described below:

### **Grant of Letter of Protest During Extension of Time:**

Sometimes, when the Board considers an extension of time to oppose, the letter of protest has been granted, but jurisdiction over the application may or may not have been restored to the examining attorney, as discussed above. If jurisdiction has *not* been restored, then the question of registrability is not before the examining attorney and the opposition period, and any request for extension of time to oppose or notice of opposition which may be filed, will be processed as usual. 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 approving the extension request and notifying the potential opposer and applicant that the letter of protest has been granted, and jurisdiction over the application restored to the examining attorney who has issued an Office Action; 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 a letter of protest has been granted, jurisdiction has been restored, and an office action has issued, if the Board fails to do so, the potential opposer is not excused from the noted responsibilities.

### **Grant of Letter of Protest During Opposition:**

If a party files a timely opposition while a letter of protest is pending, but not yet determined by the Deputy Commissioner, the Board will institute the opposition as it normally would. If the letter of protest (filed before or after publication of the subject mark) subsequently is granted, the examining attorney may seek remand of the application from the Board. [Note 12.] 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 CFR § 2.130.

If a party files a timely opposition after a letter of protest has been granted 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 CFR § 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 CFR § 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. See *In re Urbano*, 51 USPQ2d 1776, 1778-79 n.5 (TTAB 1999) (letter of protest provided additional information to the examining attorney to support a refusal); *In re BPJ*

*Enterprises Ltd.*, 7 USPQ2d 1375, 1379 (Comm'r 1988) (if examining attorney did not consider issue raised in letter of protest and letter is supported by evidence that would support a refusal, it should be granted; letter reviewed under former standard asking whether letter presented “prima facie” evidence for refusal); *In re Pohn*, 3 USPQ2d 1700, 1703 (Comm'r 1987) (guidelines for timeliness of letter of protest).

2. See TMEP § 1715. For information concerning the standard applied by the Deputy Commissioner in determining whether a letter of protest should be granted, see TMEP § 1715.02 (Letter of Protest Filed Before Publication), and TMEP § 1715.03 (Letter of Protest Filed on the Date of Publication or After Publication).

3. TMEP § 1715.03(b) (“Letters of protest filed more than 30 days after publication are generally denied as untimely.”). See *In re G. Heileman Brewing Co.*, 34 USPQ2d 1476, 1478 (Comm'r 1994) (letter of protest, filed more than a year after publication and accompanied by evidence of descriptiveness which was available 2 months prior to publication, was untimely); *In re BPJ Enterprises Ltd.*, 7 USPQ2d 1375, 1379 (Comm'r 1988); *In re Pohn*, 3 USPQ2d 1700, 1703 (Comm'r 1987).

4. TMEP § 1715.03(c) (“However, if an opposition has been instituted, the Board has jurisdiction over the application. TMEP § 1504.02. Therefore, upon request, the Board will generally restore jurisdiction and remand the application to the examining attorney”). See 37 CFR § 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.

8. TMEP § 1715.02(b).

9. TMEP § 1715.03(c).

10. See TMEP § 1715.03(c).

11. See TMEP § 1715.03(c).

12. See 37 CFR § 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. Such a registration is called an “inadvertently issued” registration.

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 inadvertently overlooked by the Board. [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 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 be returned, and any submitted opposition fee will be refunded. The potential opposer's substantive remedy will, under the statute, 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 a timely opposition, 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. *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 (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 thereafter agrees 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).

### **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, or to withdraw the abandonment and litigate the proceeding, failing which judgment shall be entered against applicant. [Note 5.]

An applicant may expressly abandon its application by filing in the Office a written statement of abandonment or withdrawal of the application, signed by the applicant or by the applicant's attorney or someone with legal authority to bind the applicant. [Note 6.] It is recommended that an express abandonment (filed prior to commencement of an opposition) be filed using TEAS in order to minimize the possibility that a paper-filed abandonment may not be associated with the file and acted upon prior to the institution of any opposition. 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, a Board administrative staff member will prepare an order notifying potential opposer that the application is no longer subject to the filing of a notice of opposition.

#### **NOTES:**

1. If an international registration is cancelled by the International Bureau 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 CFR § 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 CFR § 7.31. Although the transformed application retains the filing and priority date of the abandoned Trademark Act § 66(a) application, 37 CFR § 7.31(b), it is reexamined under 37 CFR Part 2, and will be published for opposition, even if it had been published prior to transformation. 37 CFR § 7.31(c). *See* TMEP § 1904.09, et seq., for information on transformation.

2. *See 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 CFR § 2.68.

4. *See* 37 CFR § 2.135.

5. *See In re First National Bank of Boston*, 199 USPQ 296, 301 (TTAB 1978). Cf. TBMP § 602.01 (abandonment of application during inter partes proceeding).

6. 37 CFR § 2.68.

## **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 [Note 5] as any other timely filed amendment to allege use that is not associated with the application file until after publication. 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 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. [Note 7.] 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 8.] If the application is abandoned while it is before the examining attorney, the examining attorney should likewise notify the Board.

**NOTES:**

1. 37 CFR § 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), Trademark Act § 13(b)(2), 15 U.S.C. § 1051(d)(1), 15 U.S.C. § 1063(b)(2); 37 CFR § 2.81(b).
3. Trademark Act § 13(b)(2), 15 U.S.C. § 1063(b)(2); 37 CFR § 2.81(b).
4. 37 CFR § 2.76(a); 37 CFR § 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 Located After Publication).
6. See TMEP § 1104.04.
7. See TMEP § 1104.04.
8. TMEP § 1104.04.

**220 Inadvertent Issuance of a Notice of Allowance**

Sometimes 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. Additionally, 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. In that case, 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).