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101 Applicable Authority

101.01 Statute and Rules of Practice

All proceedings before the Trademark Trial and Appeal Board ("TTAB" or "Board") are governed by the Lanham Trademark Act of 1946, as amended, ("Act of 1946" or "Act"), 15 U.S.C. § 1051 et seq.; the rules of practice in trademark cases (commonly known as the Trademark Rules of Practice), which may be found in Parts 2 and 7 of Title 37 of the Code of Federal Regulations ("CFR"); the rules pertaining to assignments in trademark cases, which may be found in Parts 3 and 7 of 37 CFR; and the rules relating to representation of others before the United States Patent and Trademark Office which may be found in Part 10 of 37 CFR. The United States Patent and Trademark Office ("USPTO" or "Office") rules governing procedure in inter partes proceedings before the Board are adapted, in large part, from the Federal Rules of Civil Procedure, with modifications due primarily to the administrative nature of Board proceedings.¹

A copy of Title 37 of the CFR may be obtained at a nominal cost from the U.S. Government Printing Office. Title 37 of the CFR may also be found on the Internet at the Government Printing Office web site at: www.access.gpo.gov/nara/cfr or at the USPTO web site at: www.uspto.gov.

Information regarding proposed and final rule changes to Title 37 is also posted on the Office web site at www.uspto.gov.

101.02 Federal Rules

Inter partes proceedings before the Board are also governed by the Federal Rules of Civil Procedure ("Fed. R. Civ. P."), except as otherwise provided in the Trademark Rules of Practice, and "wherever applicable and appropriate";² and by the Federal Rules of Evidence ("Fed. R. Evid.").³

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

² See 37 CFR § 2.116(a).

³ See 37 CFR §§ 2.116(a), 2.120(a), and 2.122(a); *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1753 n.3 (Fed. Cir. 1998); and *Cerveceria India Inc. v. Cerveceria Centroamericana, S.A.*, 10 USPQ2d 1064 (TTAB 1989), *aff'd*, *Centroamericana, S.A. v. Cerveceria India, Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1311 (Fed. Cir. 1989) (In applying the burden of proof provisions of Fed. R. Evid. 301, the court stated "[t]he Federal Rules of Evidence generally apply to TTAB proceedings.").

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There is no provision in the Trademark Rules of Practice concerning the applicability of the Federal Rules of Evidence to *ex parte* appeals before the Board. However, certain of the principles embodied in the Federal Rules of Evidence are applied by the Board, in practice, in evaluating the probative value of evidence submitted in *ex parte* cases.⁴

101.03 Decisional Law

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

Decisions of the Board, the Director, and the Court of Appeals for the Federal Circuit appear in the *United States Patent Quarterly* ("USPQ"), a periodical publication of The Bureau of National Affairs, Inc., Washington, D.C., and may also be found in Reed Elsevier, Inc.'s "LEXIS" legal database, and in the Intellectual Property Library of West Publishing Company's WESTLAW database.

Decisions that are designated by the Board "citable as precedent" or "for publication in full" are citable as precedent. Decisions which are not so designated, or which are designated for publication only in digest form, are not citable authority.⁵ A nonprecedential or digest decision will, however, be considered in determining issues of claim preclusion, issue preclusion, judicial estoppel, law of the case, or the like, provided that (1) a party to the pending Board proceeding, or its privy, was also a party to the prior proceeding, and (2) a complete copy of the decision is submitted.⁶

⁴ See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859, 1860 (Fed. Cir. 1987) (articles from general and business publications are not hearsay and are probative of descriptive usage); *In re Broadway Chicken, Inc.*, 38 USPQ2d 1559, 1565 (TTAB 1996) (listings from telephone directories and Dun & Bradstreet databases are not inadmissible hearsay); and *In re American Olean Tile Co.*, 1 USPQ2d 1823, 1824 n.2 (TTAB 1986) (affidavit consisting of third-hand report by unidentified person is inadmissible hearsay). See also *In re Foundry Products, Inc.*, 193 USPQ 565 (TTAB 1976). For further information concerning the treatment of evidence in Board *ex parte* proceedings, see TBMP § 1208 and authorities cited therein.

⁵ See *In re Polo International, Inc.*, 51 USPQ2d 1061, 1063 n.3 (TTAB 1999) (non-precedential case disregarded); *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1336 (TTAB 1997) citing *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1275 n.9 (TTAB 1992); and *In re American Olean Tile Co.*, *supra* at 1825 n.3 (published digests do not indicate the facts on which the determinations were based). See also *Marcon, Ltd. v. Merle Norman Cosmetics, Inc.*, 221 USPQ 644, 645 n.4 (TTAB 1984) and *Roberts Proprietaries, Inc. v. Rumby International, Inc.*, 212 USPQ 302, 303 (TTAB 1981).

⁶ See *General Mills Inc. v. Health Valley Foods*, *supra*.

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101.04 Director's Orders and Notices

Occasionally, the Director of the United States Patent and Trademark Office or another USPTO official acting under the Director's authority, publishes in the *Official Gazette* an Order or Notice relating to a particular Office policy, practice, procedure, or other such matter of interest to the public. Some of these Orders and Notices affect practice and procedure before the Trademark Trial and Appeal Board. Such notices are also posted on the Office's web site at www.uspto.gov.

102 Nature of Board Proceedings

102.01 Jurisdiction of Board

The Trademark Trial and Appeal Board is an administrative tribunal of the United States Patent and Trademark Office within the Office of General Counsel. The Board is empowered to determine only the right to register.⁷

The Board is not authorized to determine the right to use, nor may it decide broader questions of infringement or unfair competition.⁸

⁷ See Sections 17, 18, 20, and 24 of the Act of 1946, 15 U.S.C. §§ 1067, 1068, 1070, and 1092.

⁸ See *Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car Inc.*, 62 USPQ2d 1857, 1858 (TTAB 2002), *aff'd*, 300 F.3d 1333, 66 USPQ2d 1811 (Fed. Cir. 2003) (no jurisdiction to decide issues arising under state dilution laws); *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1481 (Fed. Cir. 1990) (cannot adjudicate unfair competition issues); *Carano v. Vina Concha Y Toro S.A.*, 67 USPQ2d 1149 (TTAB 2003) (no jurisdiction to determine copyright infringement; opposer's claim that applicant neither owns nor is entitled to use mark was not separable from opposer's copyright claim); *Ross v. Analytical Technology Inc.*, 51 USPQ2d 1269, 1270 n.2 (TTAB 1999) (no jurisdiction over unfair competition claims); *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1771 n.5 (TTAB 1994) (no jurisdiction over claims of trademark infringement and unfair competition) *aff'd (unpub'd)*, 108 F.3d 1392 (Fed. Cir. 1997); *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460, 1464 (TTAB 1992) (not empowered to render declaratory judgment); *Andersen Corp. v. Therm-O-Shield Int'l, Inc.*, 226 USPQ 431, 432 n.5 (TTAB 1985) (may not entertain any claim based on Section 43(a) of the Act, 15 U.S.C. 1125(a)); *Electronic Water Conditioners, Inc. v. Turbomag Corp.*, 221 USPQ 162, 163-64 (TTAB 1984) (unfair competition and Section 43(a) claims are outside the Board's jurisdiction); *Hershey Foods Corp. v. Cerreta*, 195 USPQ 246, 252 (TTAB 1977) (determination of whether opposer is guilty of unfair business practices is not within the province of the Board); *Yasutomo & Co. v. Commercial Ball Pen Co.*, 184 USPQ 60, 61 (TTAB 1974) (no jurisdiction to address anti-trust issues); and *American-International Travel Service, Inc. v. AITS, Inc.*, 174 USPQ 175, 179 (TTAB 1972) (no jurisdiction to determine whether opposer violated criminal statute).

But see Loglan Institute Inc. v. Logical Language Group Inc., 962 F.2d 1038, 22 USPQ2d 1531, 1534 (Fed. Cir. 1992) (Board may have erred in stating that it lacked jurisdiction over equitable defenses which were based on allegations of trademark infringement and unfair competition); *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641, 647 (Fed. Cir. 1983) (regarding Board's authority to consider an agreement, its construction, or its validity if necessary to decide the issues properly before it, including the issue of estoppel); and *Knickerbocker Toy Co. v. Faultless Starch Co.*, 467 F.2d 501, 175 USPQ 417, 423 (CCPA 1972) (Board is not precluded from passing on the validity of a copyright if it is necessary to do so in the course of the exercise of its statutory

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Similarly, the Board, being an administrative tribunal, has no authority to declare any portion of the Act of 1946, or any other act of Congress, unconstitutional.⁹

102.02 Types of Board Proceedings

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

An opposition is a proceeding in which the plaintiff seeks to prevent the issuance of a registration of a mark on the Principal Register. "Any person who believes that he would be damaged by the registration of a mark" may file an opposition thereto, but the opposition may be filed only as a timely response to the publication of the mark, under Section 12(a) of the Act, 15 U.S.C. § 1062(a), in the *Official Gazette* of the United States Patent and Trademark Office.¹⁰

A cancellation proceeding is a proceeding in which the plaintiff seeks to cancel an existing registration of a trademark. A petition for cancellation may only be filed after the issuance of the registration. A petition for cancellation may be filed by "any person who believes that he is or will be damaged by the registration" of the mark.¹¹

jurisdiction); *M-5 Steel Mfg. Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086 (TTAB 2001) (contractual estoppel considered); *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701, 1702 (TTAB 2000) (noting that by rule change effective August 5, 1999, the 1946 Act was amended to allow parties to bring dilution claims under Section 43(c) in opposition and cancellation proceedings); and *British-American Tobacco Co. v. Philip Morris Inc.*, 55 USPQ2d 1585, 1589 (TTAB 2000) (a claim under Article 8 of the Pan American Convention is within the jurisdiction of the Board since it pertains expressly to the registrability of marks and provides for the cancellation of registrations).

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

⁹ *See Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1710 (TTAB 1999) (no authority to declare provisions of the Act unconstitutional nor to determine whether Section 2(a) is overbroad or vague), *rev'd on other grounds*, 284 F. Supp. 2d 96, 68 USPQ2d 1225 (D.D.C. 2003) and *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991) (no jurisdiction to determine whether Section 7(c) of the Act, the constructive use provision, violates the commerce clause of the constitution). *See also, for example, Capital Speakers Inc. v. Capital Speakers Club of Washington, D.C. Inc.*, 41 USPQ2d 1030, 1034 n.3 (TTAB 1996) (no authority to determine whether private activities rendered to members of private club constitute "commerce").

¹⁰ *See* Section 13 of the Act of 1946, 15 U.S.C. § 1063.

¹¹ *See* Sections 14 and 24 of the Act of 1946, 15 U.S.C. §§ 1064 and 1092.

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An interference is a proceeding in which the Board determines which, if any, of the owners of conflicting applications (or of one or more applications and one or more registrations which are in conflict), is entitled to registration.¹² The proceeding is declared by the Office only upon petition to the Director showing extraordinary circumstances therefor, that is, that the party who filed the petition would be unduly prejudiced without an interference.¹³ Ordinarily, the availability of an opposition or cancellation proceeding is deemed to prevent any undue prejudice from the unavailability of an interference proceeding.¹⁴ An interference that has been declared by the Director is not instituted by the Board until after all of the marks that are to be involved in the proceeding have been published in the *Official Gazette* for opposition.¹⁵

A concurrent use proceeding is a proceeding in which the Board determines whether one or more applicants is entitled to a concurrent registration, that is, a registration with conditions and limitations, fixed by the Board, as to the mode or place of use of the applicant's mark or the goods and/or services on or in connection with which the mark is used (usually, a concurrent registration is restricted as to the territory which it covers).¹⁶ The proceeding may be generated only through the filing of an application for registration as a lawful concurrent user, and is instituted by the Board only after each of the one or more involved applications has been published for opposition in the *Official Gazette*, and all oppositions thereto (if any) have been withdrawn or dismissed.¹⁷

The Board also has jurisdiction over *ex parte* appeals, that is, appeals from an examining attorney's final refusal to register a mark in an application.¹⁸

¹² See Section 18 of the Act, 15 U.S.C. § 1068.

¹³ See Section 16 of the Act of 1946, 15 U.S.C. § 1066; 37 CFR § 2.91; and TBMP § 1002 (Declaration of Interference).

¹⁴ See 37 CFR § 2.91(a).

¹⁵ See TBMP § 1003 (Institution of Interference). *For further information concerning interference proceedings, see TBMP chapter 1000.*

¹⁶ See TBMP § 1101.01 and authorities cited therein.

¹⁷ See TBMP §§ 1102.01 (Means of Generation) and 1105 (Applications and Registrations not Subject to Proceeding), and authorities cited therein. *For further information concerning concurrent use proceedings, see TBMP chapter 1100.*

¹⁸ See Sections 12(b) and 20 of the Trademark Act, 15 U.S.C. §§ 1062(b) and 1070; 37 CFR §§ 2.141 and 2.142; and TBMP chapter 1200 (Ex Parte Appeals). *See also, e.g., In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994) citing *In re BankAmerica Corp.*, 231 USPQ 873 (TTAB 1986).

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102.03 General Description of Board Proceedings

An inter partes proceeding before the Board is similar to a civil action in a Federal district court. There are pleadings (at least in an opposition or cancellation proceeding); a wide range of possible motions; discovery; and briefs, followed by a decision on the case.¹⁹ However, because the Board is an administrative tribunal, its rules and procedures necessarily differ in some respects from those prevailing in the Federal district courts.²⁰ The principal difference is that proceedings before the Board are conducted in writing, and the Board's actions in a particular case are based upon the written record therein. For example, the Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. Indeed, a party to a proceeding before the Board need never come to the offices of the Board at all, unless the Board requests that the parties meet with the Board at its offices for a pre-trial conference pursuant to 37 CFR § 2.120(i)(2), or unless the party wishes to argue its case at oral hearing (an oral hearing is held only if requested by a party to the proceeding).

An ex parte appeal, being appellate in nature, is a much simpler and shorter procedure, involving only the filing of briefs by the applicant and examining attorney, and, if requested by the applicant, an oral hearing.

The Board includes both interlocutory attorneys and administrative trademark judges (known also as Board members). Interlocutory motions, requests, and other matters not actually or potentially dispositive of a proceeding may be acted upon by a single Board judge or by a single interlocutory attorney to whom such authority has been delegated.²¹ Decisions on the case, and on complex or contested motions that are potentially dispositive of the case, are rendered by a panel of at least three Board judges.²² Stipulations or consented (or uncontested) motions to dispose of the proceeding in a certain manner may be decided per curiam by the Board.

¹⁹ See *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988) (USPTO rules governing the procedures are designed to approximate the proceedings in a courtroom trial).

²⁰ See *Yamaha International Corp. v. Hoshino Gakki Co.*, *supra* at 1004. See also *La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234, 235 (Comm'r 1976). Cf. TBMP §§ 502.01 (Available Motions) and 702 (Manner of Trial and Introduction of Evidence).

²¹ See 37 CFR § 2.127(c).

²² See, e.g., 37 CFR §§ 2.129(a) and 2.142(e)(1).

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103 Location and Address of Board

The Board is located at 2900 Crystal Drive, Ninth Floor, Arlington, Virginia 22202-3514. The mailing address of the Board is Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514.²³

104 Business to be Conducted in Writing

37 CFR § 2.191 All business with the Office should be transacted in writing. The personal appearance of applicants or their representatives at the Office is unnecessary. The action of the Office will be based exclusively on the written record. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

All business with the Board should be transacted in writing. The personal attendance of parties or their attorneys or other authorized representatives at the offices of the Board is unnecessary, except in the case of a pre-trial conference as provided in 37 CFR § 2.120(i)(2), or upon oral argument at final hearing, if a party so desires, as provided in 37 CFR § 2.129. Decisions of the Board will be based exclusively on the written record before it.²⁴

105 Contact With Board Personnel

37 CFR § 10.93(b) In an adversary proceeding, including any inter partes proceeding before the Office, a practitioner shall not communicate, or cause another to communicate, as to the merits of the cause with a judge, official, or Office employee before whom the proceeding is pending, except:

- (1) In the course of official proceedings in the cause.*
- (2) In writing if the practitioner promptly delivers a copy of the writing to opposing counsel or to the adverse party if the adverse party is not represented by a practitioner.*
- (3) Orally upon adequate notice to opposing counsel or to the adverse party if the adverse party is not represented by a practitioner.*
- (4) As otherwise authorized by law.*

²³ Mail box designations (BOX TTAB) and fee notations (FEE – NO FEE) are no longer required.

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

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Parties or their attorneys or other authorized representatives may telephone the Board, or come to the offices of the Board, to inquire about the status of a case or to ask for procedural information, but not to discuss the merits of a case or of any particular issue. The telephone number of the Board is (703) 308-9300. If an inquiry involves a particular case, the person making the inquiry should be prepared to give the number of the proceeding or application in question.

106 Identification, Signature, and Form of Submissions

106.01 Identification of Submissions

A document filed in a proceeding before the Board should bear at its top the heading "IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD," followed by the name and number of the inter partes proceeding (or, in the case of an ex parte appeal, the application) to which it relates.²⁵ The document should also include a title describing its nature, *e.g.*, "Notice of Opposition," "Answer," "Motion to Compel," "Brief in Opposition to Respondent's Motion for Summary Judgment," "Notice of Reliance."

Documents filed in an application which is the subject of an inter partes proceeding before the Board should be filed with the Board, and should bear at the top of its first page both the application serial number, and the inter partes proceeding number and title. Similarly, requests under Section 7 of the Act, 15 U.S.C. § 1057, to amend, correct, or surrender a registration which is the subject of a Board inter partes proceeding, and any new power of attorney, designation of domestic representative, or change of address submitted in connection with such a registration, should be filed with the Board, and should bear at the top of its first page both the registration number, and the inter partes proceeding number and title.²⁶

106.02 Signature of Submissions

37 CFR § 2.119(e) Every paper filed in an inter partes proceeding, and every request for an extension of time to file an opposition, must be signed by the party filing it, or by the party's attorney or other authorized representative, but an unsigned paper will not be refused consideration if a signed copy is submitted to the Patent and Trademark Office within the time limit set in the notification of this defect by the Office.

37 CFR § 10.14(e) No individual other than those specified in paragraphs (a), (b), and (c) of this section will be permitted to practice before the Office in trademark cases. Any individual may

²⁵ Cf. 37 CFR § 2.194.

²⁶ Cf. 37 CFR § 2.194.

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appear in a trademark or other non-patent case in his or her own behalf. Any individual may appear in a trademark case for (1) a firm of which he or she is a member or (2) a corporation or association of which he or she is an officer and which he or she is authorized to represent, if such firm, corporation, or association is a party to a trademark proceeding pending before the Office.

37 CFR § 10.18(a) *For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature, personally signed by such practitioner, in compliance with § 1.4(d)(1) of this chapter.*

(b) *By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that-*

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that-

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;

(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) *Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any*

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patent, trademark registration, or certificate resulting therefrom. Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Director, or the Director's designee, which may include, but are not limited to, any combination of-

- (1) Holding certain facts to have been established;*
- (2) Returning papers;*
- (3) Precluding a party from filing a paper, or presenting or contesting an issue;*
- (4) Imposing a monetary sanction;*
- (5) Requiring a terminal disclaimer for the period of the delay; or*
- (6) Terminating the proceedings in the Patent and Trademark Office.*

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action. See § 10.23(c)(15).

37 CFR § 2.193(c)

- (1) Each piece of correspondence that requires a person's signature, must:*
 - (i) Be an original, that is, have an original signature personally signed in permanent ink by that person; or*
 - (ii) Be a copy, such as a photocopy or facsimile transmission (§ 2.195(c)), of an original. In the event that a copy of the original is filed, the original should be retained as evidence of authenticity. If a question of authenticity arises, the Office may require submission of the original; or*
 - (iii) Where an electronically transmitted trademark filing is permitted or required, the person who signs the filing must either:*
 - (A) Place a symbol comprised of numbers and/or letters between two forward slash marks in the signature block on the electronic submission;*
 - or*
 - (B) Sign the verified statement using some other form of electronic signature specified by the Director.*

(2) The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any document by a party, whether a practitioner or non-practitioner, constitutes a certification under § 10.18(b) of this chapter. Violations of §10.18(b)(2) of this chapter by a party, whether a practitioner or non-practitioner, may result in the imposition of sanctions under § 10.18(c) of this chapter. Any practitioner violating § 10.18(b) may also be subject to disciplinary action. See §§ 10.18(d) and 10.23(c)(15).

37 CFR § 2.193(d) *When a document that is required by statute to be certified must be filed, a copy, including a photocopy or facsimile transmission, of the certification is not acceptable.*

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Every document filed in an inter partes or ex parte proceeding before the Board, and every request for an extension of time to file an opposition, must be signed by the party filing it, or by the party's attorney or other authorized representative, as appropriate.²⁷

Documents filed through the electronic filing systems available at the Board do not require a conventional signature. Electronic signatures pursuant to 37 CFR § 2.193(c)(1)(iii) are required for electronic filings.²⁸ 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.²⁹

A party may act in its own behalf in a proceeding before the Board, or an attorney or other authorized representative may represent the party.³⁰ When an individual who is a party to a Board proceeding elects to act in his or her own behalf, the individual must sign any documents that he or she files with the Board. If a party which is a partnership elects to act in its own behalf, a partner should sign documents filed by the partnership. If a party which is a corporation or association elects to act in its own behalf, documents filed by the corporation or an officer thereof who is authorized to sign for the corporation or association should sign for that corporation or association.³¹

If a document is filed on behalf of a party by the party's attorney or other authorized representative, it must bear the signature of, and be signed by, that attorney or other representative, unless it is a document required to be signed by the party. An attorney or other authorized representative who signs a document, and then files it with the Board on behalf of a party, should remember that his or her signature to the document constitutes a certification of the elements specified in 37 CFR § 10.18(b), and that a knowing violation of the provisions of that rule by an attorney or other authorized representative will leave him or her open to disciplinary action.³²

²⁷ See 37 CFR §§ 2.193(c); 2.119(e); and 10.18(a).

²⁸ See 37 CFR §§ 2.102(a) and 2.111(b).

²⁹ See 37 CFR § 2.193(c)(1)(ii). See also TMEP § 804.05.

³⁰ See 37 CFR § 10.14 and TBMP § 114 (Representation of a Party). Cf. 37 CFR § 2.11.

³¹ See 37 CFR § 10.14(e).

³² See 37 CFR § 10.18. Cf. Fed. R. Civ. P. 11 and TBMP § 527.02 (regarding motions for Rule 11 sanctions). See also, for example, *The Clorox Co. v. Chemical Bank*, 40 USPQ2d 1098, 1100 n.9 (TTAB 1996) (accuracy in factual representations is expected). For information concerning the meaning of the designation “other authorized representative,” see TBMP § 114.04.

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It is not appropriate for one person to sign a document for another person, as, for example, "John Smith, for John Doe" or "John Doe, by John Smith."³³

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

In accordance with 37 CFR § 2.193(c) either the original of the signed document, or a legible copy thereof, may be filed with the Board. If a paper copy is filed, the original should be retained as evidence of authenticity. If a question as to the authenticity of a filed copy arises, the Office may require submission of the original.³⁴

Notwithstanding the requirement that a document filed before the Board be signed, an unsigned document will not be refused consideration if a signed copy is submitted to the Board within the time limit set in the notification of this defect by the Board.³⁵

106.03 Form of Submissions

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 the text on one side only of each sheet;

³³ See 37 CFR §§ 2.119(e) and 10.18(a). See also *Boyd's Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017 (TTAB 2003) (response to motion to suspend signed by person on behalf of practitioner is inappropriate); *Cerveceria India Inc. v. Cerveceria Centroamericana, S.A.*, 10 USPQ2d 1064, 1067 (TTAB 1989) (Section 8 declaration signed by someone other than named person, while perhaps unacceptable, does not constitute fraud), *aff'd Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989) and *In re Cowan*, 18 USPQ2d 1407, 1409 (Comm'r 1990) (Section 8 declaration in name of sole proprietor, but signed for him by his attorney, not acceptable).

³⁴ See 37 CFR § 2.193(c)(1)(ii). For information concerning fax copies, see TBMP § 107.

³⁵ See 37 CFR § 2.119(e).

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- (2) A paper submission must be 8 to 8.5 inches (20.3 to 21.5 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 or CD-ROM concurrently with the paper submission, and comply with the requirements for a paper or CD-ROM submission.*

(b) Submissions may be made to the Trademark Trial and Appeal Board on CD-ROM where the rules in this part or Board practice permit. A CD-ROM submission must identify the parties and case number and contain a list that clearly identifies the documents and exhibits contained thereon. This information must appear in the data contained in the CD-ROM itself, on a label affixed to the CD-ROM, and on the packaging for the CD-ROM. Text in a CD-ROM submission must be in at least 11-point type and double-spaced. A brief filed on CD-ROM must be accompanied by a single paper copy of the brief. A CD-ROM submission must be accompanied by a transmittal letter on paper that identifies the parties, the case number and the contents of the CD-ROM.

(c) Submissions may be made to the Trademark Trial and Appeal Board electronically via the Internet where the rules in this 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.

(d) 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.

Submissions may be made to the Board on paper, CD-ROM, or electronically over the Internet, as permitted by the rules or Board practice. For example, the rules provide that an opposition against a Section 1 or 44 application, or a request for extension of time to oppose a Section 1 or 44 application, may either be filed on paper or through ESTTA, but that an opposition against a 66(a) application, or a request for extension of time to oppose a 66(a) application, may only be

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filed through ESTTA.³⁶ The rules do not permit the filing of any extension of time to oppose or any notice of opposition on CD-ROM. Similarly, Board practice does not permit the filing of any petition for cancellation on CD-ROM. A petition for cancellation must be filed either on paper or through ESTTA.

Trademark Rule 2.126 also specifies the requirements for each form of submission to the Board, including a confidential submission. The requirements for paper submissions are set out in part (a) of 37 CFR § 2.126. A paper submission must be 8 to 8.5 inches wide and 11 to 11.69 inches long, and printed in at least 11-point type and double-spaced, with the text on one side only of each sheet. If a paper submission contains dividers, the dividers may not contain tabs or any devices that extend beyond the edges of the paper, and must be on the same size and weight paper as the submission.

In addition, a paper submission must not be stapled or bound. This is important because all paper submissions are scanned electronically into the Board's electronic information system and removing staples or binding prior to scanning is difficult and time-consuming, especially where papers have been bound by machine. Moreover, disassembling stapled or bound papers can damage pages, resulting in misdeeds to the scanning equipment and increasing the likelihood that pages will become disordered during scanning.³⁷

A paper filed with the Board may be either the original or a legible copy thereof, on good quality paper.³⁸ Extra copies of a paper should not be submitted.³⁹

CD-ROM submissions are governed by part (b) of 37 CFR § 2.126, and the requirements for electronic submissions over the Internet can be found in part (c) of 37 CFR § 2.126. Submissions over the Internet are made through the Board's electronic filing system, ESTTA (Electronic System for Trademark Trials and Appeals) which is available on the USPTO web site.⁴⁰ Using ESTTA, a person can complete and submit forms, with attachments and/or exhibits, to the Board over the Internet, making an official filing online. ESTTA gives step-by-step

³⁶ See 37 CFR § 2.101(b) regarding the filing of oppositions, and § 2.102(a) regarding the filing of extensions of time to oppose.

³⁷ See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act; Final Rule, published in the *Federal Register* on September 26, 2003 at 68 FR 55748 at 55760.

³⁸ See 37 CFR § 2.193(c) and, with respect to fax copies, TBMP § 107.

³⁹ See *DeLorme Publishing Co. v. Eartha's Inc.*, 60 USPQ2d 1222, 1222 n.1 (TTAB 2000) (papers should be filed in single copies only unless otherwise required by rule); *ITC Entertainment Group Ltd. v. Nintendo of America Inc.*, 45 USPQ2d 2021, 2022-23 (TTAB 1998) (unnecessary copies and attachments to motions resulted in undue delay and a waste of Board resources); and *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1708 n.1 (TTAB 1994).

⁴⁰ See 37 CFR § 2.2(g).

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instructions for properly completing a form.⁴¹ Available forms and instructions can be found at: <http://estta.uspto.gov>. The Board's electronic filing system is also available to the public in the Trademark Library Search Room.

Exhibits to a submission are also subject to the requirements of 37 CFR § 2.126. Exhibits pertaining to a paper submission must be filed on paper or CD-ROM and must comply with the requirements for a paper or CD-ROM submission.⁴² Exhibits pertaining to an electronic submission must be filed electronically as an attachment to the submission and conform to the requirements for electronic submissions.⁴³

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

Exhibits that are large, bulky, valuable, or breakable may be photographed or otherwise reproduced so that an appropriate paper or digitized image of the exhibits can be filed with the Board in lieu of the originals. Exhibits consisting of videotapes or audiotapes of commercials, demonstrations, etc., may be transferred to an appropriate electronic format for submission to the Board.

The requirements for confidential submissions are specified in part (d) of 37 CFR § 2.126. To be handled as confidential, and kept out of the public record, submissions to the Board that are confidential must be filed under a separate cover. Both the submission and its cover must be marked confidential and must identify the case number and the parties. A copy of the submission with the confidential portions redacted must also be submitted.⁴⁴ Confidential materials filed in the absence of a protective order are not regarded as confidential and will not be kept confidential by the Board.⁴⁵

The Board, in its discretion, may refuse to enter and consider submissions filed in violation of 37 CFR 2.126.

⁴¹ See 37 CFR § 2.126(c).

⁴² See 37 CFR § 2.126(a)(6).

⁴³ See 37 CFR § 2.126(c).

⁴⁴ See 37 CFR § 2.126(d). See also TBMP § 120.02 (Confidential Materials).

⁴⁵ See TBMP § 120.02.

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Format of submissions. Apart from the identification, signature, and form requirements referred to above, there is no particular *format* that submissions to the Board must follow. Nor does the Office have printed forms for any documents filed in Board proceedings.⁴⁶ As an aid to litigants, however, suggested formats for certain types of documents filed in Board proceedings can be found in the Appendix of Forms to this manual as well as in the section where the particular type of document is discussed. These include a notice of appeal to the Board, designation of domestic representative, certificate of mailing or certificate of transmission under 37 CFR § 2.197, and a certificate of service.

107 How and Where to File Papers and Fees

37 CFR § 2.195 Receipt of trademark correspondence.

(a) Date of receipt and Express Mail date of deposit.

Trademark correspondence received in the Office is given a filing date as of the date of receipt except as follows:

- (1) The Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for correspondence transmitted electronically under paragraph (a)(2) of this section or transmitted by facsimile under paragraph (a)(3) of this section, no correspondence is received in the Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.*
- (2) Trademark-related correspondence transmitted electronically will be given a filing date as of the date on which the Office receives the transmission.*
- (3) Correspondence transmitted by facsimile will be given a filing date as of the date on which the complete transmission is received in the Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the filing date will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.*
- (4) Correspondence filed in accordance with § 2.198 will be given a filing date as of the date of deposit as “Express Mail” with the United States Postal Service.*

(b) Correspondence delivered by hand.

In addition to being mailed, correspondence may be delivered by hand during hours the Office is open to receive correspondence.

(c) Facsimile transmission.

Except in the cases enumerated in paragraph (d) of this section, correspondence, including authorizations to charge a deposit account, may be transmitted by facsimile. The receipt date accorded to the correspondence will be the date on which the complete transmission is received

⁴⁶ See 37 CFR § 2.126.

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in the Office, unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. See § 2.196. To facilitate proper processing, each transmission session should be limited to correspondence to be filed in a single application, registration or proceeding before the Office. The application serial number, registration number, or proceeding number should be entered as a part of the sender's identification on a facsimile cover sheet.

(d) *Facsimile transmissions are not permitted and if submitted, will not be accorded a date of receipt, in the following situations:*

- (1) Applications for registration of marks;*
- (2) Drawings submitted under § 2.51, § 2.52, § 2.72 or § 2.173;*
- (3) Correspondence to be filed with the Trademark Trial and Appeal Board, except notices of ex parte appeal; and*
- (4) Requests for cancellation or amendment of a registration under Section 7(e) of the Trademark Act; and certificates of registration surrendered for cancellation or amendment under Section 7(e) of the Trademark Act.*

(e) Interruptions in U.S. Postal Service.

If interruptions or emergencies in the United States Postal Service which have been so designated by the Director occur, the Office will consider as filed on a particular date in the Office any correspondence which is:

- (1) Promptly filed after the ending of the designated interruption or emergency; and*
- (2) Accompanied by a statement indicating that such correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service.*

An increasing number of documents can be filed with the Office through its web site at www.uspto.gov. For those documents that are being delivered to the Office, the specific requirements are set out below.

Documents relating to proceedings before the Board, and ***not accompanied by a fee***, may be filed during regular office hours by hand delivery or by courier service to the Board at 2900 Crystal Drive, South Tower Building, Ninth Floor, Arlington, Virginia 22202-3514; or at the Intake Processing Unit at 2900 Crystal Drive, South Tower Building, Arlington, Virginia 22202-3514; or at the Customers' Window at 2011 S. Clark Place, Crystal Plaza Building 2, First Floor, Arlington, Virginia 22202; or (by courier delivery only) to the Patent and Trademark Office Mail Room (Correspondence and Mail Division) at 2011 S. Clark Place, Crystal Plaza Building 2, First Floor, Arlington, Virginia 22202 (*delivery of documents intended for the Board to one of the Crystal Plaza Building 2 locations is NOT recommended, because documents delivered to these locations, rather than to one of the South Tower Building locations, may take considerably longer to reach the Board*). Such papers may also be filed by depositing them in the mail addressed to the Board's mailing address (Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514).

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Documents relating to proceedings before the Board, and *accompanied by fees* may be filed by mailing them to the Board's mailing address, i.e., Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514. Papers with fees may also be filed during regular business hours by hand delivery to the Finance Window at 2900 Crystal Drive, South Tower Building, Arlington, Virginia 22202-3514 (where the fee will be "received" or "posted" immediately and the paper then forwarded to the Intake Processing Unit on the same floor); or to the Customers' Window on the first floor at 2011 S. Clark Place, Crystal Plaza Building 2, Arlington, Virginia 22202; (*delivery of papers intended for the Board to the Crystal Plaza Building is NOT recommended, because papers delivered to this location, rather than to one of the South Tower Building locations, may take considerably longer to reach the Board*).

Fee papers filed in person must be filed at one of the locations identified above because the Board does not have the mechanism to process financial transactions.

With the exception of the notice of ex parte appeal to the Board, or in the absence of a specific request by the Board, documents to be filed with the Board may not be filed by facsimile transmission ("fax").⁴⁷ If documents other than the notice of appeal in an ex parte appeal are filed with the Board by fax transmission, they will not receive a filing date.

However, the Board will accept, and give filing dates to, documents that had been faxed to, for example, local counsel, when the fax copies are, in turn, hand delivered to the Board, or are sent to the Board by mail or courier service. In addition, the Board may request that a party send by fax transmission a copy of a document that has already been filed in the Office by one of the acceptable methods described above, such as by mail, but which document has not yet been received by the Board and/or entered in the proceeding file for which it is intended. The Board may make such a request when, for example, (1) a Board attorney needs a copy of the document in order to make an immediate ruling, by telephone conference, on a motion, or (2) the Board needs to see a copy of a document that was assuredly filed in the Office, but which the Board does not have or cannot locate. When the Board requests that a copy of a document be sent to the Board by fax transmission, the name of the Board employee making the request must appear on the cover sheet of the transmission, so that the Board staff member receiving the transmission will know that the transmission is authorized, and can immediately give the paper to the employee who requested it. If the name of the requesting Board employee does not appear on the cover sheet, the staff member receiving the transmission will presume that the transmission is unauthorized, and the paper will be disregarded.

When a fax transmission is authorized, the requirements of 37 CFR § 2.195(c) should be met. In addition, it is recommended that the fax cover sheet specify the number of pages being transmitted, and the name, address, fax number, and telephone number of the transmitting party, as well as the proceeding number to which the document pertains.

⁴⁷ See 37 CFR § 2.195(c)(3).

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A document transmitted by fax must be legible. The document that is used as the original for the fax transmission should be retained by the sender as evidence of the content of the transmission.⁴⁸

Correspondence filed by fax transmission should be transmitted to the fax number of the USPTO location for which it is intended. Transmission of correspondence to the fax number of the wrong USPTO location will cause delay in matching the correspondence with the file to which it pertains. The Board itself has several different fax numbers. The Board fax number to be used for a notice of ex parte appeal to the Board is (703) 308-9333. In those cases where the Board requests that a party send a copy of some other paper by fax transmission, the party will be provided with the appropriate fax number.

The Board's fax machines are attended between the business hours of 8:30 a.m. and 5:00 p.m., Eastern Standard Time, Monday through Friday, excluding holidays. Normally, the machines may be accessed 24 hours a day. However, there may be times when reception is not possible because of equipment failure or maintenance requirements. Accordingly, persons transmitting correspondence to the Board by fax should be cautious about relying on the availability of this service near time deadlines, such as the end of the six-month period for filing a notice of appeal in an ex parte appeal to the Board.⁴⁹

For information on how to pay fees, see TBMP § 118.

108 Filing Receipts

When a document (with or without a fee) intended for the Board is filed in the Office, it is possible to obtain a receipt evidencing the date of such filing. In the case of a document sent by mail, a receipt may be obtained by submitting with the document a stamped, self-addressed postcard with sufficient information to identify clearly the document, the party in whose behalf the paper is being filed, and the proceeding or application in connection with which the document is being filed. When the Office receives the document and the postcard, it will date-stamp both of them and mail the postcard back.

Correspondence transmitted electronically through ESTTA is stamped with the date and time the Office receives the transmission or, if a fee is required, the date and time the payment process is completed.⁵⁰ Eastern time controls the filing date. Once a request is transmitted electronically, the system immediately provides the sender with an e-mail acknowledgement of receipt.

⁴⁸ See 37 CFR § 2.193(c).

⁴⁹ Cf. TMEP § 306.02.

⁵⁰ See 37 CFR § 2.195(a) and instructions for filing via ESTTA on the USPTO web site.

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If a document intended for the Board is delivered by hand or by courier service to the offices of the Board, or to the Intake Processing Unit at 2900 Crystal Drive, South Tower Building, Third Floor, Arlington, Virginia 22202-3514, or to the Finance Window on the same floor of that building, the receipt may take the form of a postcard bearing appropriate identifying information, or a duplicate copy of the document, or a duplicate copy of the transmittal letter with appropriate identifying information. The receipt and the document will be date-stamped and the receipt will be handed back to the person who delivered the paper. If a paper is delivered by hand or by courier service to the Customers' Window at 2011 S. Clark Place, Crystal Plaza Building 2, Room 1B03, Arlington, Virginia 22202, the receipt may be in the form of a postcard, or, alternatively, a handwritten receipt will be furnished. If a document is delivered by courier service to the U.S. Patent and Trademark Office Mail Room (Correspondence and Mail Division) at 2011 S. Clark Place, Crystal Plaza Building 2, Room 1A-01, Arlington, Virginia 22202, the postcard receipt must be used.

When a document is submitted to the Board by fax transmission, the Board will not formally acknowledge receipt of the document. However, the Board fax machine usually will confirm to the sending unit that the transmission is complete. Parties are reminded that, with the exception of the notice of ex parte appeal to the Board, or unless otherwise specifically authorized by the Board, documents intended for the Board may not be filed by fax transmission.⁵¹

109 Filing Date

37 CFR § 2.195 Receipt of trademark correspondence.

(a) Date of receipt and Express Mail date of deposit. Trademark correspondence received in the Office is given a filing date as of the date of receipt except as follows:

- (1) The Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for correspondence transmitted electronically under paragraph (a)(2) of this section or transmitted by facsimile under paragraph (a)(3) of this section, no correspondence is received in the Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.*
- (2) Trademark-related correspondence transmitted electronically will be given a filing date as of the date on which the Office receives the transmission.*
- (3) Correspondence transmitted by facsimile will be given a filing date as of the date on which the complete transmission is received in the Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the filing date will be the next succeeding day that is not a Saturday, Sunday, or Federal holiday within the District of Columbia.*
- (4) Correspondence filed in accordance with § 2.198 will be given a filing date as of the date of deposit as "Express Mail" with the United States Postal Service.*

⁵¹ See 37 CFR § 2.195(c)(3). See also TBMP § 107 (How and Where to File Papers and Fees).

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(b) Correspondence delivered by hand. *In addition to being mailed, correspondence may be delivered by hand during hours the Office is open to receive correspondence.*

(c) Facsimile transmission. *Except in the cases enumerated in paragraph (d) of this section, correspondence, including authorizations to charge a deposit account, may be transmitted by facsimile. The receipt date accorded to the correspondence will be the date on which the complete transmission is received in the Office, unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. See §2.196. To facilitate proper processing, each transmission session should be limited to correspondence to be filed in a single application, registration or proceeding before the Office. The application serial number, registration number, proceeding number should be entered as a part of the sender's identification on a facsimile cover sheet.*

(d) Facsimile transmissions are not permitted and if submitted, will not be accorded a date of receipt, in the following situations:

- (1) Applications for registration of marks;*
- (2) Drawings submitted under § 2.51, § 2.52, § 2.72 or § 2.173;*
- (3) Correspondence to be filed with the Trademark Trial and Appeal Board, except notices of ex parte appeal; and*
- (4) Requests for cancellation or amendment of a registration under section 7(e) of the Trademark Act, and certificates of registration surrendered for cancellation or amendment under section 7(e) of the Trademark Act.*

(e) Interruptions in U.S. Postal Service. *If interruptions or emergencies in the United States Postal Service which have been so designated by the Director occur, the Office will consider as filed on a particular date in the Office any correspondence which is:*

- (1) Promptly filed after the ending of the designated interruption or emergency; and*
- (2) Accompanied by a statement indicating that such correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service.*

Correspondence transmitted electronically through ESTTA is stamped with the date and time the Office receives the transmission or, if a fee is required, the date and time the payment process is completed.⁵² Eastern time controls the filing date. Once a request is transmitted electronically, the system immediately provides the sender with an e-mail acknowledgement of receipt.

Mailed or hand-delivered correspondence is stamped with the date of receipt in the Office (i.e., the "filing" date) unless the correspondence is filed by the "Express Mail" procedure provided in 37 CFR § 2.198.⁵³ The "date of receipt" of correspondence mailed to the Office is the date

⁵² See 37 CFR § 2.195(a) and instructions for filing via ESTTA on the USPTO web site.

⁵³ See 37 CFR § 2.195(a).

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stamped by the Post Office on the mailbags in which the correspondence is delivered to the Office.⁵⁴

When correspondence intended for the Board is filed by the "Express Mail Post Office to Addressee" service of the United States Postal Service the document will be stamped with the "date in" as the date of receipt (unless the "date in" is a Saturday, Sunday, or Federal holiday within the District of Columbia). If the deposit date cannot be determined, the correspondence will be stamped with the date of actual receipt.⁵⁵

If correspondence which is permitted to be filed by fax transmission to the Board is filed by that method with a certificate of transmission in accordance with 37 CFR § 2.197(a), the transmission date specified in the certificate of transmission is used for purposes of determining the timeliness of the correspondence.⁵⁶ The date of receipt of the transmission, as described in 37 CFR § 2.195(a)(3), is used for all other purposes.⁵⁷

When correspondence intended for the Board is filed by first-class mail with a certificate of mailing, in accordance with the procedure described in 37 CFR § 2.197(a), it is stamped with the date of receipt of the correspondence in the Office, i.e., the date on the mail bags in which the correspondence is delivered to the Office. The mailing date specified in the certificate of mailing is used for purposes of determining the timeliness of the correspondence. The date of receipt is used for all other purposes.⁵⁸

⁵⁴ See 37 CFR § 2.195(b); *In re Amethyst Investment Group*, 37 USPQ2d 1735 (Comm'r 1995); and *In re Klein*, 6 USPQ2d 1528, 1536 (Dep't Comm. 1986), *aff'd sub nom. Klein v. Peterson*, 696 F. Supp. 695, 8 USPQ2d 1434 (D.D.C. 1988), *aff'd*, 866 F.2d 912, 9 USPQ2d 1558 (Fed. Cir. 1989).

⁵⁵ See 37 CFR §§ 2.195 and 2.198. See 37 CFR § 2.198 regarding procedures for petitioning the Director for any filing date discrepancy.

⁵⁶ See 37 CFR § 2.197(a). For further information concerning correspondence that may be filed by fax transmission to the Board, see TBMP § 107.

⁵⁷ See 37 CFR § 2.197(a). For further information concerning correspondence that may be filed by fax transmission to the Board, see TBMP § 107.

⁵⁸ See 37 CFR §§ 1.6(a) and 1.8(a). For information concerning the date stamped by the USPTO on correspondence when interruptions or emergencies occur in the United States Postal Service, see 37 CFR § 1.6(e).

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110 Certificate of Mailing or Transmission Procedure

110.01 In General

37 CFR § 2.197 Certificate of mailing or transmission.

(a) Except in the cases enumerated in paragraph (a)(2) of this section, correspondence required to be filed in the Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

(1) Correspondence will be considered as being timely filed if:

(i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:

(A) Addressed as set out in § 2.190 and deposited with the U.S. Postal Service with sufficient postage as first class mail; or

(B) Transmitted by facsimile to the Office in accordance with § 2.195(c); and

(ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

(2) The procedure described in paragraph (a)(1) of this section does not apply to the filing of a trademark application.

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Office, and an application is abandoned, a registration is cancelled or expired, or a proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence within two months after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

(c) The Office may require additional evidence to determine whether the correspondence was timely filed.

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Except in certain instances, specified in 37 CFR § 2.197(a), as amplified by 37 CFR § 2.195(c), correspondence required to be filed within a set period of time will be considered as being timely filed, even though the correspondence is not received by the Office until after the expiration of the set period, if, prior to the expiration of the set period, (1) the correspondence is mailed to the Office by first-class mail, with the proper address, or (for correspondence which is permitted to be filed by fax) is transmitted to the Office by fax, in accordance with 37 CFR § 2.195(c), and (2) includes a certificate of mailing or transmission which meets the requirements specified in 37 CFR § 2.197(a).⁵⁹

In effect, the certificate of mailing or transmission procedure permits certain types of correspondence, as specified in 37 CFR §§ 2.197(a) and 2.195(c), to be sent to the Office by first-class mail, or by fax transmission, even on the due date for the correspondence and still be considered timely, notwithstanding the fact that the mailed correspondence will not be received in the Office until after the due date, or that the fax transmission may not, because of equipment failure or maintenance requirements, be completed until the next day.⁶⁰

However, the Office, in its discretion, may require additional evidence to determine if correspondence which bears a certificate of mailing or a certificate of transmission was timely filed, i.e., was mailed or transmitted on the date stated in the certificate.⁶¹

The certificate of mailing procedure applies to the filing of all types of correspondence in Board proceedings.

The certificate of transmission procedure is available in Board proceedings only for the filing of a notice of ex parte appeal to the Board.⁶²

⁵⁹ See 37 CFR § 2.197(a) and *In re LS Bedding*, 16 USPQ2d 1451, 1452-53 (Comm'r 1990) (certificate of mailing procedure is used to determine timeliness, while the actual receipt date is used for all other purposes, such as an application filing date). See also *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1734 n.2 (TTAB 2001) (no certificate of mailing).

⁶⁰ See *Luemme Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758, 1759 n.1 (TTAB 1999) (motion to extend filed by a certificate of mailing dated next business day was timely).

⁶¹ See 37 CFR § 2.197(c); *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293 (TTAB 1997) (where prima facie proof of certificate of mailing is rebutted by other evidence, person signing certificate must submit an affidavit specifying the date of actual deposit); and *In re Klein*, 6 USPQ2d 1547, 1551-52 (Comm'r 1987), *aff'd sub nom. Klein v. Peterson*, 696 F. Supp. 695, 8 USPQ2d 1434 (D.D.C. 1988), *aff'd* 866 F.2d 412, 9 USPQ2d 1558 (Fed. Cir. 1989).

⁶² See 37 CFR §§ 2.195(c) and 2.197(a), and TBMP § 107 (How and Where to File Papers and Fees).

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110.02 Requirements for Certificate

37 CFR § 2.190 Addresses for trademark correspondence with the United States Patent and Trademark Office.

(a) Trademark correspondence -- in general

All trademark-related documents filed on paper, except documents sent to the Assignment Services Division for recordation and requests for copies of trademark documents, should be addressed to:

*Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514*

(b) Electronic trademark documents. *An applicant may transmit a trademark document through TEAS, at <http://www.uspto.gov>.*

(c) Trademark Assignments. *Requests to record documents in the Assignment Services Division may be filed through the Office's web site, at <http://www.uspto.gov>. Paper documents and cover sheets to be recorded in the Assignment Services Division should be addressed to:*

*Mail Stop Assignment Recordation Services
Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450*

See § 3.27 of this chapter.

(d) Requests for copies of trademark documents. *Copies of trademark documents can be ordered through the Office's web site at www.uspto.gov. Paper requests for certified or uncertified copies of trademark documents should be addressed to:*

*Mail Stop Document Services
Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450*

The requirements for filing trademark-related documents (except for trademark-related documents sent to the Assignment Services Division for recordation and requests for certified

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copies of trademark application and registration documents) by the certificate of mailing or transmission procedure are as follows:⁶³

1. *Prior to the expiration of the set period*, the correspondence must be either (i) deposited with the U.S. Postal Service, with sufficient postage as first-class mail, addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514, or (ii) (for correspondence which is permitted to be filed by fax) transmitted to the Office by fax, in the manner described in 37 CFR § 2.195(c); and
2. Each piece of correspondence must include a certificate which states the date of deposit or transmission, and is signed (separate and apart from any signature for the piece of correspondence itself) by a person who has a reasonable basis to expect that the correspondence will be mailed or transmitted on or before the date indicated.

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

Requests for copies (certified or uncertified) of trademark documents pertaining to applications and registrations are handled by the Certification Division, Office of Public Records. The address for all such requests mailed to the Office is: Mail Stop Document Services, Director of the United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450.⁶⁴

The Assignment Services Division of the Office of Public Records also has an electronic trademark assignment recording form on the Office web site. The system is called ETAS (Electronic Trademark Assignment System) and allows customers to create and submit a Trademark Assignment Recordation Coversheet by completing on-line web forms and attaching the supporting legal documentation. The form and additional information can be accessed by going to www.uspto.gov, going to "Trademarks" and then "File Assignment Documents On-line."

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

A certificate of mailing or a certificate of transmission should be clearly labeled as such and should include a reference to the proceeding number to which it pertains, the date of

⁶³ See 37 CFR § 2.197(a).

⁶⁴ See 37 CFR § 2.190(d).

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transmission, and the signature of the person attesting that the document is being transmitted on a certain date. When possible, the certificate should appear on the paper being transmitted, rather than on a separate sheet of paper.

110.03 Suggested Format

Shown below is a suggested format for a certificate of mailing, under 37 CFR § 2.197, for trademark-related mail (except for trademark-related documents sent to the Assignment Services Division for recordation and requests for certified copies of trademark application and registration documents)

Certificate of Mailing

I hereby certify that this correspondence
is being deposited with the United States
Postal Service with sufficient postage as
First-class mail in an envelope addressed to:

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

on _____
Date Signature

Typed or printed name of
person signing certificate

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Shown below is a suggested format for a certificate of transmission under 37 CFR § 2.197:

Certificate of Transmission

I hereby certify that this correspondence
is being facsimile transmitted to the
United States Patent and Trademark
Office

on _____
Date Signature

Typed or printed name of
person signing certificate

110.04 Location of Certificate

If one of the simple certificate of mailing or certificate of transmission formats shown in TBMP § 110.03 is used, it may be applied by rubber stamp to the first page of the correspondence, if feasible. Otherwise, it should be stamped or typed in its entirety on the last page of the correspondence to which it pertains. If the certificate is typed, and there is not enough room on the last page to type the certificate in its entirety, it should at least be started on the last page, so that only part of it continues over to another page. The simple certificate of mailing or certificate of transmission format should never be used by itself on a separate page at the end of the correspondence. If it is, and the page becomes detached from the rest of the submission, there will be no way of determining the identity of the correspondence to which it relates, and the benefit of the certificate will be lost.

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

However, the simple certificate formats shown in TBMP § 110.03 are not appropriate for use on a separate sheet of paper. Rather, a certificate placed on a separate sheet of paper must include additional information, namely, a description of the nature of the correspondence to which it pertains, as well as the identity of the application, registration, or Office proceeding in connection with which the correspondence is being filed. If there is any doubt concerning the identity of the correspondence to which a certificate of mailing or certificate of transmission on a separate sheet pertains, the certificate will not be accepted.

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110.05 Loss of Certificate of Mailing

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

110.06 No receipt of Correspondence Bearing Certificate

In the event that correspondence intended for the USPTO is timely filed with an appropriate certificate of mailing or certificate of transmission, pursuant to 37 CFR § 2.197, but is not received in the Office, and there is a resulting Office action, in a proceeding or an application, which is adverse to the submitting party, the correspondence will be considered timely if the party which submitted it (1) informs the Office of the previous mailing or facsimile transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence, (2) supplies an additional copy of the previously mailed or transmitted correspondence and certificate, and (3) includes a statement attesting, on a personal knowledge basis or to the satisfaction of the Director, to the previous timely mailing or transmission. The statement must be verified if it is made by a person other than a practitioner, as defined in 37 CFR § 10.1(r). If the correspondence was appropriate for filing by fax transmission, a copy of the sending fax machine's report confirming transmission may be used to support the statement.⁶⁵ If the document is not one authorized to be filed by facsimile transmission, the document will not be accepted.

For lost or misplaced correspondence intended for the Board, the evidence required by 37 CFR § 2.197(b) should be submitted to the Board for consideration. If the requirements of 37 CFR § 2.197(b) cannot be met, the only alternative is a petition to the Director.

110.07 Excluded Filings

The certificate of mailing procedure is not applicable to the filing of a trademark application. The certificate of mailing procedure is applicable to all types of filings in Board proceedings, including a notice of opposition; a petition to cancel; a request for an extension of time to oppose; a notice of appeal to the Board from a final refusal of registration; a notice of appeal to the Court of Appeals for the Federal Circuit from a decision of the Board; and a notice of election (in an inter partes proceeding) to proceed by civil action under Section 21(a)(1) of the

⁶⁵ *See* 37 CFR § 2.197(b).

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Act of 1946, 15 U.S.C. § 1071(a)(1), in response to another party's appeal to the Court of Appeals for the Federal Circuit.

At present, the certificate of transmission procedure is not applicable to any correspondence intended for the Board, except for the notice of appeal in an ex parte appeal to the Board.⁶⁶

110.08 A Certificate of Mailing or Transmission is Not ...

As is evident from the requirements for a certificate of mailing, specified in 37 CFR § 2.197(a), the certificate of mailing procedure is not the same as mailing by certified mail. Correspondence sent to the Board by certified mail, and not in compliance with the 37 CFR § 2.197(a) requirements for a certificate of mailing, will be stamped with the date of receipt of the correspondence in the Office, and that date will be used for all purposes, including the timeliness of the filing of the correspondence.⁶⁷

Further, a certificate of mailing or certificate of transmission is not the equivalent of a certificate of service. A certificate of mailing or certificate of transmission indicates when correspondence was sent *to the Office* pursuant to the provisions of 37 CFR § 2.197(a). The mailing date recited in a certificate of mailing, or the transmission date recited in a certificate of transmission, is used for purposes of determining the timeliness of the filing of the correspondence bearing the certificate. A certificate of service, on the other hand, indicates the date when a copy of the correspondence was served (by hand delivery, first-class mail, "Express Mail," or overnight courier) *upon another party*. A certificate of service cannot be used to prove the timeliness of the filing of the correspondence.⁶⁸

111 "Express Mail" Procedure

111.01 In General

37 CFR § 2.198 Filing of correspondence by "Express Mail."

(a)(1) Except for documents listed in paragraphs (a)(1)(i) and (ii) of this section, any correspondence received by the Office that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed with the Office on the date of deposit with the USPS. The Express Mail procedure does not apply to:

- (i) Applications for registration of marks;*
- (ii) Amendments to allege use under section 1(c) of the Act;*

⁶⁶ See 37 CFR § 2.195(d). See also TBMP § 107 (How and Where to File Papers and Fees).

⁶⁷ See 37 CFR §§ 2.195 and 2.197.

⁶⁸ See TBMP § 113 for information concerning a certificate of service.

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- (iii) *Statements of use under section 1(d) of the Act;*
- (iv) *Requests for extension of time to file a statement of use under section 1(d) of the Act;*
- (v) *Affidavits of continued use under section 8 of the Act;*
- (vi) *Renewal requests under section 9 of the Act; and*
- (vii) *Requests to change or correct addresses.*

(2) The date of deposit with the USPS is shown by the "date-in" on the "Express Mail" label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the date of receipt in the Office as the filing date.

(b) *Correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the "Express Mail" mailing label with the "date-in" clearly marked. Persons dealing indirectly with the employees of the USPS (such as by deposit in an "Express Mail" drop box) do so at the risk of not receiving a copy of the "Express Mail" mailing label with the desired "date-in" clearly marked. The paper(s) or fee(s) that constitute the correspondence should also include the "Express Mail" mailing label number thereon. See paragraphs (c), (d) and (e) of this section.*

(c) *Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Director to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other official USPS notation, provided that:*

- (1) The petition is filed within two months after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;*
- (2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing; and*
- (3) The petition includes a true copy of the "Express Mail" mailing label showing the "date-in," and of any other official notation by the USPS relied upon to show the date of deposit.*

(d) *Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Director to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:*

- (1) The petition is filed within two months after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;*

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(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing; and

(3) The petition includes a showing that establishes, to the satisfaction of the Director, that the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup on the requested filing date. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or evidence that came into being within one business day of the deposit after the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

(e) If correspondence is properly addressed to the Office pursuant to § 2.1990 and deposited with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS, but not received by the Office, the party who mailed the correspondence may petition the Director to consider such correspondence filed in the Office on the USPS deposit date, provided that:

(1) The petition is filed within two months after the person becomes aware that the Office has no evidence of receipt of the correspondence;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) prior to the original mailing;

(3) The petition includes a copy of the originally deposited paper(s) or fee(s) showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, a copy of the "Express Mail" mailing label showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section that the correspondence was deposited in the "Express Mail Post Office to addressee" service prior to the last scheduled pickup on the requested filing date; and

(4) The petition includes a statement that establishes, to the satisfaction of the Director, the original deposit of the correspondence and that the copies of the correspondence, the copy of the "Express Mail" mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence, original "Express Mail" mailing label, returned postcard receipt, and official notation entered by the USPS.

(f) The Office may require additional evidence to determine whether the correspondence was deposited as "Express Mail" with the USPS on the date in question.

Certain papers or fees to be filed in the Office, including any paper or fee intended for the Board, can be filed utilizing the "Express Mail Post Office to Addressee" service (not the "Express Mail

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Post Office to Post Office" service) of the United States Postal Service, and be considered as having been filed in the Office on the date of deposit with the USPS.⁶⁹

In effect, the "Express Mail" procedure permits all types of correspondence intended for the Board to be sent by the "Express Mail Post Office to Addressee" service even on the due date for the correspondence and still be considered timely, notwithstanding the fact that the mailed correspondence may not be received by the Board until after the due date. This filing procedure applies only to the "Express Mail" of the United States Postal Service, not any third-party carrier that offers overnight delivery.⁷⁰

111.02 Requirements for "Express Mail"

Trademark Rule 12.198(b) provides that prior to the original mailing, the "Express Mail" mailing label number should be placed on correspondence filed under Rule 2.198. The number of the mailing label should be placed on each separate submission and each fee transmitted, either directly on the document or on a separate paper firmly and securely attached to the document.

A party that wishes to send mail to the Board by the "Express Mail" service of the U.S. Postal Service should be careful to use the "Express Mail Post Office to Addressee" service, rather than the "Express Mail Post Office to Post Office" service.

111.03 Questionable Date of Mailing

If the "date-in" appearing on the "Express Mail" label is illegible, the filing date will be the actual receipt date by the Office. If there is a discrepancy between the filing date assigned by the Office and the date of deposit, the person who filed the correspondence may petition the Director to accord the "date-in" date by providing the evidence set forth in 37 CFR §§ 2.198(c), (d) and (e).⁷¹

112 Times for Taking Action

37 CFR § 2.196 Expiration on Saturday, Sunday or Federal holiday

Whenever periods of time are specified in this part in days, calendar days are intended. When the day, or the last day fixed by statute or regulation by or under this part for taking any action or paying any fee in the Office falls on a Saturday, Sunday or Federal holiday within the District

⁶⁹ See 37 CFR § 2.198(a)(1) and TMEP § 305.03 for "Express Mail" procedures for the Trademark Examining Operation.

⁷⁰ See *In re Pacesetter Group, Inc.*, 45 USPQ2d 1703, 1704 (Comm'r 1994).

⁷¹ For further information on petition procedures, see Section 305.03(h) of the TMEP.

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of Columbia, the action may be taken, or the fee paid, on the next succeeding day that is not a Saturday, Sunday or a Federal holiday.

For example, if, as set by the Board, an answer to a complaint falls due on a Saturday, Sunday, or Federal holiday within the District of Columbia, an answer filed on the next business day will be considered timely. If, as set by the Board, the close of discovery falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, written requests for discovery (i.e., interrogatories, requests for production of documents, and requests for admission) may be served, and discovery depositions may be taken, on the next business day. Similarly, if, as set by the Board, the close of a testimony period falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, testimony depositions may be taken, and other evidence may be offered, on the next business day.⁷²

If, because of some unscheduled event, such as adverse weather conditions, the Office is officially closed by Executive Order of the President or by the Office of Personnel Management for an *entire* day, that day will be regarded by the Office as a federal holiday within the District of Columbia. Any action due to be taken, or fee due to be paid, on that day, will be considered timely if the action is taken, or the fee paid, on the next succeeding business day on which the Office is open. If, because of an unscheduled event, the Office is closed for *part* of a business day, but is open for business for some part of the day between 8:30 a.m. and 5:00 p.m., any action due to be taken, or fee due to be paid, on that day remains due on that day.⁷³ Notification of any change in this policy, given the particular circumstances of an unscheduled event, will be posted on the Office web site at www.uspto.gov.⁷⁴

113 Service of Papers

37 CFR § 2.119 Service and signing of papers.

(a) Every paper filed in the Patent and Trademark Office in inter partes cases, including notice of appeal, must be served upon the other parties except the notice of interference (§ 2.93), the notification of opposition (§ 2.105), the petition for cancellation (§ 2.113), and the notice of a concurrent use proceeding (§ 2.99), which are mailed by the Patent and Trademark Office. Proof of such service must be made before the paper will be considered by the Office. A statement signed by the attorney or other authorized representative, attached to or appearing on

⁷² See, for example, *Strang Corp. v. Stouffer Corp.*, 16 USPQ2d 1309, 1310 (TTAB 1990) (when the five-year anniversary date of a registration falls on a weekend or holiday, petition filed on next business day is considered to have been filed within five years from the issue date).

⁷³ See "Filing of Papers During Unscheduled Closings of the Patent and Trademark Office," 1076 TMOG 6 (March 10, 1987).

⁷⁴ See, for example, "Notifications Related to Security Issues and Emergencies - Emergency Closure – September 11, 2001" posted on the USPTO web site.

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the original paper when filed, clearly stating the date and manner in which service was made will be accepted as prima facie proof of service.

(b) Service of papers must be on the attorney or other authorized representative of the party if there be such or on the party if there is no attorney or other authorized representative, and may be made in any of the following ways:

- (1) By delivering a copy of the paper to the person served;*
- (2) By leaving a copy at the usual place of business of the person served, with someone in the person's employment;*
- (3) When the person served has no usual place of business, by leaving a copy at the person's residence, with a member of the person's family over 14 years of age and of discretion;*
- (4) Transmission by the "Express Mail Post Office to Addressee" service of the United States Postal Service or by first-class mail, which may also be certified or registered;*
- (5) Transmission by overnight courier.*

Whenever it shall be satisfactorily shown to the Director that none of the above modes of obtaining service or serving the paper is practicable, service may be by notice published in the Official Gazette.

(c) When service is made by first-class mail, "Express Mail," or overnight courier, the date of mailing or of delivery to the overnight courier will be considered the date of service. Whenever a party is required to take some action within a prescribed period after the service of a paper upon the party by another party and the paper is served by first-class mail, "Express Mail," or overnight courier, 5 days shall be added to the prescribed period.

* * * *

113.01 Requirement for Service of Papers

Every document filed in an inter partes proceeding before the Board, including a notice of appeal from a decision of the Board, must be served by the filing party upon every other party to the proceeding. The only exceptions to this rule are the notice of opposition and petition for cancellation, which are sent by the Board to the defendant or defendants.⁷⁵

The requirement for service applies not only to documents filed in an inter partes proceeding before the Board, but also to documents filed in an application or registration which is the subject of such a proceeding, if the documents could have an effect on the inter partes proceeding. For example, a request to amend or correct an application or registration which is the subject of an inter partes proceeding; an abandonment of the application; or a voluntary

⁷⁵ See 37 CFR § 2.119(a).

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surrender of the registration, must all be served by the defendant upon every other party to the proceeding.

113.02 Requirement for Proof of Service

When a party to an inter partes proceeding before the Board files a document required by 37 CFR § 2.119(a), to be served upon every other party to the proceeding, proof that the required service has been made ordinarily must be submitted before the filing will be considered by the Board. Occasionally, in order to expedite matters, and when the interests of the other party or parties would be served thereby, the Board itself will serve, along with an action of the Board relating thereto, a copy of a document that does not include the required proof of service. For example, if an applicant in an opposition files an abandonment of its involved application without the written consent thereto of the opposer, and the abandonment does not include proof of service upon the opposer, the Board does not send out an action stating that the abandonment will not be considered until proof of service has been submitted. Rather, the Board itself mails a copy of the abandonment to the opposer, along with a copy of an action by the Board entering judgment in popover's favor pursuant to 37 CFR § 2.135 (which provides, in part, that after the commencement of an opposition, if the applicant files a written abandonment of its application or mark without the written consent of every adverse party to the proceeding, judgment shall be entered against the applicant).⁷⁶

113.03 Elements of Certificate of Service

The Board will accept, as prima facie proof that a party filing a document in a Board inter partes proceeding has served a copy of the document upon every other party to the proceeding, a statement signed by the filing party, or by its attorney or other authorized representative, clearly stating the date and manner in which service was made. The statement should also specify the name of each party or person upon whom service was made, and the address. The statement must appear on, or be securely attached to, the document being filed. If the statement is on a separate sheet attached to the filing, it should clearly identify the submission and proceeding to which it relates.⁷⁷

Suggested Format

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

⁷⁶ See also, for example, *Central Manufacturing Inc. v. Third Millennium Technology Inc.*, 61 USPQ2d 1210, 1212 n.3 (TTAB 2001) (unserved copy of objection to further extensions of time to oppose filed prior to institution of proceeding forwarded to opposer).

⁷⁷ See 37 CFR § 2.119(a).

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

113.04 Manner of Service

When a party to an inter partes proceeding before the Board files a document required by 37 CFR § 2.119(a), to be served upon every other party to the proceeding, service may be made in any of the ways specified in 37 CFR § 2.119(b). They are: (1) by hand delivering a copy of the submission to the person being served; (2) by leaving a copy of the submission at the usual place of business of the person being served, with someone in the person's employment; (3) when the person being served has no usual place of business, by leaving a copy of the submission at the person's address, with a member of the person's family over 14 years of age and of discretion; (4) transmission by the "Express Mail Post Office to Addressee" service of the United States Postal Service or by first-class mail, which may also be certified or registered; and (5) transmission by overnight courier. In addition, whenever it is satisfactorily shown to the Director that none of the specified modes of service is practicable, service may be made by notice published in the *Official Gazette* of the USPTO.

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

A party filing a document in a Board inter partes proceeding may always, as a courtesy, send a copy to an adverse party by telephonic facsimile transmission ("fax"). However, transmission of the document by fax does not constitute "service" thereof under the provisions of 37 CFR § 2.119.

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Notwithstanding the fax transmission, the paper must still be served upon the adverse party by one of the methods specified in 37 CFR § 2.119(b), and the date of service of the paper upon the adverse party is the date when service is made by one of those specified methods.

113.05 Additional Time for Taking Action After Service by Mail

Whenever a party to an inter partes proceeding before the Board is required to take some action within a prescribed period of time after the service of a paper upon that party by another party to the proceeding, and the paper is served by first-class mail, "Express Mail," or overnight courier, the time for taking action is enlarged by 5 days.⁷⁸

For example, if one party to a proceeding serves, upon another party to the proceeding, a motion to compel discovery, and service of the motion is made by first-class mail, "Express Mail," or overnight courier, the served party's time for filing a response to the motion will be 20 days from the date of service of the motion, that is, from the date of mailing or of delivery to the overnight courier. Because the service was made by first-class mail, "Express Mail," or overnight courier, 5 days are added to the 15-day period prescribed in 37 CFR § 2.127(a) for filing a response to a motion.

Trademark Rule 2.119(c), 37 CFR § 2.119(c), applies *only* when a party has to take some action within a prescribed period after the service of a paper upon it *by another party*, and service of the paper was made in one of three specified ways. It does *not* apply to an action that must be taken by a party within a time set in a communication *from the Board*. Thus, for example, when a Board action notifying a defendant of the filing of an opposition or petition to cancel allows the defendant 40 days from the date of the notification in which to file an answer to the complaint, the answer is due on or before the 40th day, not on the 45th day.

113.06 A Certificate of Service is Not...

A certificate of service is not the equivalent of a certificate of mailing or transmission *for any purpose*.⁷⁹

⁷⁸ See 37 CFR § 2.119(c).

⁷⁹ Cf. TBMP § 110.08 (A Certificate of Mailing or Transmission is Not...).

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114 Representation of a Party

37 CFR § 10.14 Individuals who may practice before the Office in trademark and other non-patent cases.

(a) Attorneys. Any individual who is an attorney may represent others before the Office in trademark and other non-patent cases. An attorney is not required to apply for registration or recognition to practice before the Office in trademark and other non-patent cases.

(b) Non-lawyers. Individuals who are not attorneys are not recognized to practice before the Office in trademark and other non-patent cases, except that individuals not attorneys who were recognized to practice before the Office in trademark cases under this chapter prior to Jan. 1, 1957, will be recognized as agents to continue practice before the Office in trademark cases.

(c) Foreigners. Any foreign attorney or agent not a resident of the United States who shall prove to the satisfaction of the Director that he or she is registered or in good standing before the patent or trademark office of the country in which he or she resides and practices, may be recognized for the limited purpose of representing parties located in such country before the Office in the presentation and prosecution of trademark cases, provided: the patent or trademark office of such country allows substantially reciprocal privileges to those permitted to practice in trademark cases before the United States Patent and Trademark Office. Recognition under this paragraph shall continue only during the period that the conditions specified in this paragraph obtain.

(d) Recognition of any individual under this section shall not be construed as sanctioning or authorizing the performance of any act regarded in the jurisdiction where performed as the unauthorized practice of law.

(e) No individual other than those specified in paragraphs (a), (b), and (c) of this section will be permitted to practice before the Office in trademark cases. Any individual may appear in a trademark or other non-patent case in his or her own behalf. Any individual may appear in a trademark case for (1) a firm of which he or she is a member or (2) a corporation or association of which he or she is an officer and which he or she is authorized to represent, if such firm, corporation, or association is a party to a trademark proceeding pending before the Office.

114.01 Party May Represent Itself

A party may represent itself in an ex parte or inter partes proceeding before the Board, or the party may be represented by an attorney or other authorized representative.⁸⁰

⁸⁰ See 37 CFR § 10.14(e).

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If a partnership which is a party to a Board proceeding elects to represent itself, the partnership may act through an individual who is a partner. If a party electing to represent itself is a corporation or an association, the party may act through any individual who is an officer of the party and who is authorized to represent it.⁸¹

However, because the governing practices and procedures in proceedings before the Board are quite technical and highly specialized, it is strongly recommended that an attorney familiar with trademark law represent a party.

114.02 Selection of Attorney

The Board cannot aid a party in the selection of an attorney, nor does the Office maintain a register or list of trademark attorneys.⁸²

114.03 Representation by Attorney

Any attorney, as that term is defined in 37 CFR § 10.1(c) [i.e., "an individual who is a member in good standing of the bar of any United States court or the highest court of any state"], is eligible to represent others before the Office in trademark cases, including proceedings before the Board, and in other non-patent cases. Such an attorney is not required to apply to the Office for registration or recognition to practice before the Office in trademark and other non-patent cases.⁸³

An attorney, as defined in 37 CFR § 10.1(c), will be accepted as a representative of a party in a proceeding before the Board if the attorney (1) signs a document that is filed with the Office on behalf of the party and satisfactorily identifies himself or herself as an attorney,⁸⁴ (2) appears in person, or (3) files a written power of attorney signed by the party the attorney represents.⁸⁵

When representation has been established by the filing of a paper, a new notice of appearance is sufficient to change the attorney of record. However, if representation has been established by the filing of a power of attorney, and thereafter another attorney or other authorized

⁸¹ See 37 CFR § 10.14(e).

⁸² See 37 CFR § 2.11.

⁸³ See 37 CFR §§ 10.1(c) and 10.14(a), and *Weiffenbach v. Klempay*, 29 USPQ2d 2027, 2031 (Dep't Comm. 1993).

⁸⁴ See *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1613 n.1 (TTAB 1991) (appearance made by filing motion on behalf of respondent).

⁸⁵ See 37 CFR § 2.17(c).

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representative appears on behalf of the party, a new power of attorney is required to change the attorney of record.⁸⁶

When an attorney, as defined in 37 CFR § 10.1(c), acting in a representative capacity signs a paper or appears in person in a proceeding before the Board, his or her personal signature or appearance constitutes, *inter alia*, a representation to the Office that, under the provisions of 37 CFR § 10.14 (which specifies the types of individuals who may practice before the Office in trademark and other non-patent cases) and the laws of the jurisdiction where the attorney is licensed to practice that he or she is authorized to represent the particular party in whose behalf he or she acts. If there is some question as to whether an individual who makes such an appearance is authorized to act in a representative capacity, further proof of his or her authority may be required.⁸⁷

If a formal power of attorney is filed in a proceeding before the Board, it should state the name and address of the individual or individuals to whom the power is granted, identify the party granting the power, indicate the power being granted (e.g., "to represent Opposer in this proceeding, with full power of substitution and revocation, and to transact all business in the United States Patent and Trademark Office in connection therewith"), and be signed by the party granting the power. The Office requires that a power of attorney specify the names of one or more individuals. A power that specifies both the names of one or more individuals and the name of a firm will be regarded as a power to the individual(s).⁸⁸ A power that specifies only the name of a firm will be regarded not as a power to the firm but rather simply as a designation of an address to which correspondence is to be sent.⁸⁹

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

The only non-lawyers permitted to represent others in trademark cases before the Office, including proceedings before the Board, are those who were recognized to practice before the Office in trademark cases under Chapter 1 of 37 CFR prior to January 1, 1957.⁹⁰ Before such a representative may take any action of any kind in a proceeding before the Board, however, the

⁸⁶ For information concerning termination of representation, see TBMP §§ 116 and 513.

⁸⁷ See 37 CFR § 2.17(a).

⁸⁸ See, e.g., *HKG Industries Inc. v. Perma-Pipe Inc.*, 49 USPQ2d 1156, 1158 (TTAB 1998) (other named attorneys appointed by petitioner were authorized to represent petitioner and assume responsibility for the case).

⁸⁹ See TMEP § 602.01 and TBMP § 117 (Correspondence – With Whom Held).

⁹⁰ See 37 CFR § 10.14(b); *Weiffenbach v. Klempay*, 29 USPQ2d 2027, 2031 (Dep't Comm. 1993) (patent agent, admitted to practice before the Office in patent cases after January 1, 1957, was excluded from practice before the Office); and *Weiffenbach v. Frank*, 18 USPQ2d 1397, 1400 (Comm'r 1991) (patent agent engaged in unauthorized representation).

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representative must file in the proceeding a written authorization from the party that he or she represents, or from another person entitled to prosecute the case (e.g., the party's appointed attorney of record).⁹¹

114.05 Representation by Foreign Attorney or Agent

***37 CFR § 10.14(c) Foreigners.** Any foreign attorney or agent not a resident of the United States who shall prove to the satisfaction of the Director that he or she is registered or in good standing before the patent or trademark office of the country in which he or she resides and practices, may be recognized for the limited purpose of representing parties located in such country before the Office in the presentation and prosecution of trademark cases, provided: the patent or trademark office of such country allows substantially reciprocal privileges to those permitted to practice in trademark cases before the United States Patent and Trademark Office. Recognition under this paragraph shall continue only during the period that the conditions specified in this paragraph obtain.*

Under certain conditions, specified in 37 CFR § 10.14(c), a foreign attorney or agent who is not a resident of the United States may be recognized for the limited purpose of representing, in trademark cases before the Office, parties located in the country in which the attorney or agent resides or practices. For information on how to meet the specified conditions, contact the USPTO's Office of Enrollment and Discipline. When a foreign attorney is recognized to practice before the Office, the parties are reminded that the certificate of mailing procedure is not available for use on mail that originates in a foreign country.

Currently, Canada provides substantial reciprocal privileges to attorneys in the United States to practice before its trademark office. Therefore, the USPTO's Office of Enrollment and Discipline recognizes Canada as qualifying for the limited exception provided in § 10.14(c) permitting the Canadian attorney to represent a Canadian party before the Office. The Office of Enrollment and Discipline maintains a list of attorneys who are registered or in good standing with the Canadian Intellectual Property Office.

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

⁹¹ See 37 CFR § 2.17(b).

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114.06 Individual Not Entitled to Represent Others

An individual who is not entitled, under 37 CFR § 10.14(a), (b), or (c), to practice before the Office in trademark cases, will not be permitted to represent a party in a proceeding before the Board.⁹²

If it comes to the attention of the Board that an individual who is not entitled, under 37 CFR § 10.14(a), (b), or (c), to practice before the Office in trademark cases, is attempting to represent a party in a Board proceeding, the Board will notify the individual that he or she is not entitled to do so. If the individual signs and files a paper on behalf of a party to a Board proceeding, the paper will not be considered unless a new copy thereof, signed by the party or by an authorized representative who is entitled to practice before the Office in trademark cases, is filed.

Moreover, no Board correspondence intended for the party will be sent to that individual. Rather, the Board will send such correspondence to the party itself, or to the party's attorney or other authorized representative entitled to practice before the Office in trademark cases.⁹³

114.07 Designation of Domestic Representative

37 CFR § 2.24 Designation of representative by foreign applicant.

If an applicant is not domiciled in the United States, the applicant may designate by a document filed in the United States Patent and Trademark Office the name and address of some person resident in the United States on whom may be served notices or process in proceedings affecting the mark. If the applicant does not file a document designating the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, or if the last person designated cannot be found at the address given in the designation, then notices or process in proceedings affecting the mark may be served on the Director. The mere designation of a domestic representative does not authorize the person designated to prosecute the application unless qualified under paragraph (a), (b) or (c) of § 10.14 of this subchapter and authorized under § 2.17(b).

37 CFR § 2.119(d) *If a party to an inter partes proceeding is not domiciled in the United States and is not represented by an attorney or other authorized representative located in the United States, the party may designate by document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in the proceeding. If the party has appointed a domestic representative, official communications of the United States Patent and Trademark Office will be addressed to the domestic representative unless the proceeding is being prosecuted by an attorney at law or*

⁹² For information concerning who is entitled to practice before the USPTO in trademark cases, see TBMP §§ 114.03-114.05. Cf. TMEP § 602.

⁹³ See 37 CFR § 2.18(d) and TBMP § 117 (Correspondence – With Whom Held).

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other qualified person duly authorized under § 10.14(c) of this subchapter. If the party has not appointed a domestic representative and the proceeding is not being prosecuted by an attorney at law or other qualified person, the Office will send correspondence directly to the party, unless the party designates in writing another address to which correspondence is to be sent. The mere designation of a domestic representative does not authorize the person designated to prosecute the proceeding unless qualified under § 10.14(a), or qualified under § 10.14(b) and authorized under § 2.17(b).

Shown below is a suggested format for the designation of a domestic representative (the suggested format should appear below information identifying the proceeding in connection with which it is filed):

Designation of Domestic Representative

(Name of Domestic Representative), whose postal address is _____

_____ is hereby designated (Name of Designating Party)'s representative upon whom notice or process in this proceeding may be served.

(Signature of Designating Party)

(Identification of Person Signing)

(Date of Signature)

Once a party has appointed a domestic representative, all correspondence in the case will be sent to the domestic representative, unless the party is represented by an attorney or other authorized representative located in the United States, or by a foreign attorney or agent duly qualified under 37 CFR § 10.14(c).⁹⁴

If the party has not appointed a domestic representative and the proceeding is not being prosecuted by an attorney at law or other qualified person, the Office will send correspondence directly to the party, unless the party designates in writing another address to which correspondence is to be sent.⁹⁵

⁹⁴ See TBMP § 117.06 (Correspondence with Foreign Party).

⁹⁵ See 37 CFR § 2.119(d).

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114.08 Adverse Parties Represented by Same Practitioner

37 CFR § 10.66 Refusing to accept or continue employment if the interests of another client may impair the independent professional judgment of the practitioner.

(a) A practitioner shall decline proffered employment if the exercise of the practitioner's independent professional judgment in behalf of a client will be or is likely to be adversely affected by the acceptance of the proffered employment, or if it would be likely to involve the practitioner in representing differing interests, except to the extent permitted under paragraph (c) of this section.

(b) A practitioner shall not continue multiple employment if the exercise of the practitioner's independent professional judgment in behalf of a client will be or is likely to be adversely affected by the practitioner's representation of another client, or if it would be likely to involve the practitioner in representing differing interests, except to the extent permitted under paragraph (c) of this section.

(c) In the situations covered by paragraphs (a) and (b) of this section a practitioner may represent multiple clients if it is obvious that the practitioner can adequately represent the interest of each and if each consents to the representation after full disclosure of the possible effect of such representation on the exercise of the practitioner's independent professional judgment on behalf of each.

(d) If a practitioner is required to decline employment or to withdraw from employment under a Disciplinary Rule, no partner, or associate, or any other practitioner affiliated with the practitioner or the practitioner's firm, may accept or continue such employment unless otherwise ordered by the Director or Commissioner.

As a general rule, a practitioner (i.e., attorney or other authorized representative) may not represent parties with conflicting interests in proceedings before the Office. That is, a practitioner normally may not accept proffered employment, or continue multiple employment, if the exercise of the practitioner's independent professional judgment on behalf of one client is likely to be adversely affected by the practitioner's representation of another client, or if the employment would be likely to involve the practitioner in representing differing interests.⁹⁶

⁹⁶ See 37 CFR §§ 10.66(a) and (b) and *Gilman Corp. v. Gilman Brothers Co.*, 20 USPQ2d 1238, 1240 (Comm'r 1991) (petitioner's former attorney in patent matter not disqualified from representing respondent in trademark cancellation proceeding); *Unico American Corp. v. Unico Banking Group*, 223 USPQ 684, 685 (Comm'r 1984) (opposer has no right to seek disqualification of applicant's counsel based on any possible conflict between applicant and third parties); *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 221 USPQ 1077, 1082 (Comm'r 1984) (attorney was disqualified, but law firm was not); *Plus Products v. Con-Stan Industries, Inc.*, 221 USPQ 1071, 1075 (Comm'r 1984) (attorney representing respondent in an opposition disqualified in view of his previous representation of petitioner in USPTO proceedings and in infringement litigation concerning the same trademark issues); and *Halcon International, Inc. v. Werbow*, 228 USPQ 611, 613 (Comm'r 1980) (attorney representing one

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However, a practitioner may represent multiple clients under the particular circumstances specified in 37 CFR § 10.66(c).

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

It is the responsibility of a practitioner to ensure that there is no violation of the rules cited above. If an impermissible conflict exists, a practitioner should take appropriate action immediately. A practitioner who fails to do so may be subjected to disciplinary action.⁹⁷

115 Conduct of Practitioner

115.01 Applicable Rules

The conduct of an attorney or other authorized representative in proceedings before the Board is governed by Part 10 of 37 CFR. Part 10 contains both Canons (set out in Rules 10.21, 10.30, 10.46, 10.56, 10.61, 10.76, 10.83, 10.100, and 10.110) and Disciplinary Rules (set out in Rules 10.22-10.24, 10.31-10.40, 10.47-10.57, 10.62-10.68, 10.77, 10.78, 10.84, 10.85, 10.87-10.89, 10.92, 10.93, 10.101-10.103, 10.111, and 10.112). Canons are "statements of axiomatic norms, expressing in general terms the standards of professional conduct expected of practitioners in their relationships with the public, with the legal system, and with the legal profession," while Disciplinary Rules are "mandatory in character and state the minimum level of conduct below which no practitioner can fall without being subjected to disciplinary action."⁹⁸

115.02 Disciplinary Proceedings

37 CFR § 2.193 Trademark correspondence and signature requirements.

(c) * * * *

(2) The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any document by a party, whether a practitioner or non-practitioner, constitutes a certification under § 10.18(b) of this chapter. Violations of § 10.18(b)(2) of this chapter by a party, whether a practitioner or non-practitioner, may result in the

party in a patent interference proceeding disqualified in view of his previous representation of the adverse party in connection with a process similar to the process involved in the interference). *See also* Rules 1.7 and 1.9 of the American Bar Association's Model Rules of Professional Conduct.

⁹⁷ *See* 37 CFR § 10.20(b).

⁹⁸ 37 CFR § 10.20.

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imposition of sanctions under § 10.18(c) of this chapter. Any practitioner violating § 10.18(b) may also be subject to disciplinary action. See §§ 10.18(d) and 10.23(c)(15).

37 CFR § 10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.

* * * *

(b) *By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that-*

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that-

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;

(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

37 CFR § 10.130 Reprimand, suspension or exclusion.

(a) *The Commissioner may, after notice and opportunity for a hearing, (1) reprimand or (2) suspend or exclude, either generally or in any particular case, any individual, attorney, or agent shown to be incompetent or disreputable, who is guilty of gross misconduct, or who violates a Disciplinary Rule.*

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(b) Petitions to disqualify a practitioner in ex parte or inter partes cases in the Office are not governed by §§ 10.130 through 10.170 and will be handled on a case-by-case basis under such conditions as the Commissioner deems appropriate.

By rule change effective December 1, 1997, 37 CFR § 2.193(c)(2) was amended to provide that by presenting a paper to the Office, the signer makes the certifications set forth in 37 CFR § 10.18(b), and is subject to sanctions under 37 CFR § 10.18(c) for violation of 37 CFR § 10.18(b)(2), regardless of whether the party is a practitioner or non-practitioner.⁹⁹

The rules governing disciplinary proceedings are set out in 37 CFR §§ 10.130-10.170. Such a proceeding is instituted only under the circumstances specified in 37 CFR §§ 10.131-10.132.

115.03 Petitions to Disqualify

37 CFR § 10.130(b) Petitions to disqualify a practitioner in ex parte or inter partes cases in the Office are not governed by §§ 10.130 through 10.170 and will be handled on a case-by-case basis under such conditions as the Commissioner deems appropriate.

Petitions to disqualify practitioners representing parties in ex parte or inter partes cases before the Board are *not* disciplinary proceedings and hence are not governed by 37 CFR §§ 10.130-10.170. Rather, petitions to disqualify are governed by 37 CFR § 10.130(b).¹⁰⁰

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

For further information concerning petitions to disqualify, see TBMP § 513.02.

⁹⁹ *For examples of cases involving disciplined practitioners, see Klein v. Peterson*, 866 F.2d 412, 9 USPQ2d 1558, 1560 (Fed. Cir. 1989) (patent attorney excluded from practice for certificate of mailing violations); *Weiffenbach v. Logan*, 27 USPQ2d 1870, 1875 (Comm'r 1993) (patent attorney suspended from practice before USPTO for five years for altering an office action in a patent application and engaging in other unethical conduct); and *McCandlish v. Doe*, 22 USPQ2d 1223, 1227 (Comm'r 1992) (patent attorney reprimanded by Commissioner for misrepresenting facts and knowingly allowing documents to remain of record which had been withdrawn).

¹⁰⁰ *For examples of cases involving petitions to disqualify, see the decisions cited in TBMP § 114.08 (Adverse Parties Represented by Same Practitioner).*

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116 Termination of Representation

116.01 Revocation of Authority

37 CFR § 2.19 Revocation of power of attorney; withdrawal.

(a) Authority to represent an applicant, registrant or a party to a proceeding may be revoked at any stage in the proceedings of a case upon notification to the Director; and when it is so revoked, the Office will communicate directly with the applicant, registrant or party to the proceeding, or with the new attorney or domestic representative if one has been appointed. The Office will notify the person affected of the revocation of his or her authorization.

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

116.02 Withdrawal as Representative--In General

37 CFR § 2.19(b) *If the requirements of § 10.40 of this chapter are met, an attorney authorized to represent an applicant, registrant or party in a trademark case may withdraw upon application to and approval by the Director.*

37 CFR § 10.40 Withdrawal from employment.

(a) A practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office (see §§ 1.36 and 2.19 of this subchapter). In any event, a practitioner shall not withdraw from employment until the practitioner has taken reasonable steps to avoid foreseeable prejudice to the rights of the client, including giving due notice to his or her client, allowing time for employment of another practitioner, delivering to the client all papers and property to which the client is entitled, and complying with applicable laws and rules. A practitioner who withdraws from employment shall refund promptly any part of a fee paid in advance that has not been earned.

(b) Mandatory withdrawal. *A practitioner representing a client before the Office shall withdraw from employment if:*

- (1) The practitioner knows or it is obvious that the client is bringing a legal action, commencing a proceeding before the Office, conducting a defense, or asserting a position in litigation or any proceeding pending before the Office, or is otherwise having steps taken for the client, merely for the purpose of harassing or maliciously injuring any person;*
- (2) The practitioner knows or it is obvious that the practitioner's continued employment will result in violation of a Disciplinary Rule;*

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(3) The practitioner's mental or physical condition renders it unreasonably difficult for the practitioner to carry out the employment effectively; or

(4) The practitioner is discharged by the client.

(c) Permissive withdrawal. *If paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matters pending before the Office unless such request or such withdrawal is because:*

(1) The petitioner's client:

(i) Insists upon presenting a claim or defense that is not warranted under existing law and cannot be supported by good faith argument for an extension, modification, or reversal of existing law;

(ii) Personally seeks to pursue an illegal course of conduct;

(iii) Insists that the practitioner pursue a course of conduct that is illegal or that is prohibited under a Disciplinary Rule;

(iv) By other conduct renders it unreasonably difficult for the practitioner to carry out the employment effectively;

(v) Insists, in a matter not pending before a tribunal, that the practitioner engage in conduct that is contrary to the judgment and advice of the practitioner but not prohibited under the Disciplinary Rule; or

(vi) Has failed to pay one or more bills rendered by the practitioner for an unreasonable period of time or has failed to honor an agreement to pay a retainer in advance of the performance of legal services.

(2) The practitioner's continued employment is likely to result in a violation of a Disciplinary Rule;

(3) The practitioner's inability to work with co-counsel indicates that the best interests of the client likely will be served by withdrawal;

(4) The practitioner's mental or physical condition renders it difficult for the practitioner to carry out the employment effectively;

(5) The practitioner's client knowingly and freely assents to termination of the employment; or

(6) The practitioner believes in good faith, in a proceeding pending before the Office, that the Office will find the existence of other good cause for withdrawal.

Under certain circumstances, a practitioner may withdraw from employment as the attorney or other authorized representative of a party to a proceeding before the Board. A practitioner who wishes to withdraw must file a written request with the Board for permission to do so. The practitioner may not withdraw until he or she has complied with the conditions specified in 37 CFR § 10.40(a).

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116.03 When Withdrawal is Mandatory

Withdrawal from employment as the attorney or other representative of a party to a Board proceeding is mandatory under the circumstances specified in 37 CFR § 10.40(b).

116.04 When Withdrawal is Permissive

Withdrawal from employment as the attorney or other authorized representative of a party to a Board proceeding is permissive under the circumstances specified in 37 CFR § 10.40(c).

116.05 Request to Withdraw

A practitioner who wishes to withdraw from employment as the attorney or other authorized representative of a party to a proceeding before the Board must file a written request with the Board for permission to do so. The request to withdraw must be based upon one of the grounds for mandatory or permissive withdrawal listed in 37 CFR §§ 10.40(b) and (c). Moreover, the practitioner must comply with the requirements of 37 CFR § 10.40(a). *See* 37 CFR §§ 2.19(b) and 10.40.¹⁰¹

The propriety of a request for permission to withdraw as counsel in an application that is the subject of a potential opposition is determined by the Board, and not the examining operation.¹⁰²

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

117 Correspondence - With Whom Held

37 CFR § 2.18 Correspondence, with whom held.

(a) *If documents are transmitted by an attorney, or a written power of attorney is filed, the Office will send correspondence to the attorney transmitting the documents, or to the attorney designated in the power of attorney, provided that the attorney is an attorney as defined in §10.1(c) of this chapter.*

(b) *The Office will not undertake double correspondence. If two or more attorneys appear or sign a document, the Office's reply will be sent to the address already established in the record until the applicant, registrant or party, or its duly appointed attorney, requests in writing that correspondence be sent to another address.*

¹⁰¹ *Cf. In re Legendary Inc.*, 26 USPQ2d 1478, 1479 (Comm'r 1992).

¹⁰² *See* TBMP § 212.01 (Jurisdiction to Consider Amendment).

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(c) If an application, registration or proceeding is not being prosecuted by an attorney but a domestic representative has been appointed, the Office will send correspondence to the domestic representative, unless the applicant, registrant or party designates in writing another correspondence address.

(d) If the application, registration or proceeding is not being prosecuted by an attorney and no domestic representative has been appointed, the Office will send correspondence directly to the applicant, registrant or party, unless the applicant, registrant or party designates in writing another correspondence address.

37 CFR § 2.24 Designation of representative by foreign applicant.

If an applicant is not domiciled in the United States, the applicant may designate by a document filed in the United States Patent and Trademark Office the name and address of some person resident in the United States on whom may be served notices or process in proceedings affecting the mark. If the applicant does not file a document designating the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, or if the last person designated cannot be found at the address given in the designation, then notices or process in proceedings affecting the mark may be served on the Director. The mere designation of a domestic representative does not authorize the person designated to prosecute the application unless qualified under paragraph (a), (b) or (c) of §10.14 of this subchapter and authorized under §2.17(b).

37 CFR § 2.119(d) *If a party to an inter partes proceeding is not domiciled in the United States and is not represented by an attorney or other authorized representative located in the United States, the party may designate by document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in the proceeding. If the party has appointed a domestic representative, official communications of the United States Patent and Trademark Office will be addressed to the domestic representative unless the proceeding is being prosecuted by an attorney at law or other qualified person duly authorized under § 10.14(c) of this subchapter. If the party has not appointed a domestic representative and the proceeding is not being prosecuted by an attorney at law or other qualified person, the Office will send correspondence directly to the party, unless the party designates in writing another address to which correspondence is to be sent. The mere designation of a domestic representative does not authorize the person designated to prosecute the proceeding unless qualified under § 10.14(a), or qualified under § 10.14(b) and authorized under § 2.17(b).*

117.01 In General

Whenever the Board takes an action in a proceeding before it, the Board sends a copy of the action to each party or to the party's attorney or other authorized representative. Such correspondence will be sent to the party at the party's address of record in the proceeding, unless

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an appearance is made on behalf of the party by an attorney (as defined in 37 CFR § 10.1(c)), or a written power of attorney is filed, or written authorization of some other person entitled to be recognized is filed, or the party designates in writing another address to which correspondence is to be sent. If one of these events occurs, correspondence will be sent not to the party's address of record, but rather to the attorney who makes the appearance, or to the attorney designated in the power of attorney, or to the other person designated in the written authorization, or to the address designated by the party for correspondence.¹⁰³ If there is no attorney of record, but a domestic representative has been appointed, correspondence will be sent to the domestic representative, unless the party designates in writing another correspondence address. If there is no attorney of record and no domestic representative has been appointed, correspondence will be sent directly to the party. Correspondence will continue to be sent to such address until the party, or the party's attorney or other representative, indicates in writing that correspondence is to be sent to another address.¹⁰⁴

The mailing of correspondence in accordance with standard Office mailing procedures creates a presumption of receipt of correspondence.¹⁰⁵

117.02 When There is More Than One Attorney or Other Authorized Representative

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

The Board ordinarily will not undertake double correspondence, that is, the sending of correspondence to two addresses on behalf of a single party. If more than one attorney or other authorized representative makes an appearance on behalf of a party, the papers filed by the

¹⁰³ See *Societe des Produits Nestle S.A. v. Basso Fedele & Figli*, 24 USPQ2d 1079, 1079 (TTAB 1992) (new power of attorney filed); and *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1613 (TTAB 1991) (appearance made by filing motion in the proceeding).

¹⁰⁴ See 37 CFR § 2.18(b).

¹⁰⁵ See *Jack Lenor Larsen Inc. v. Chas. O. Larson Co.*, 44 USPQ2d 1950, 1953 (TTAB 1997).

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additional attorney(s) or other authorized representative(s) will be accepted, but the Board will send correspondence to only one of them, to be determined according to the circumstances in the case.¹⁰⁶

For example, if one attorney or other authorized representative ("A") makes an appearance on behalf of a party, and his or her address is thus established in the proceeding file as the correspondence address, following which a second attorney or other authorized representative ("B") makes an appearance on behalf of the party, *and files a written request that correspondence be sent to him or her*, the correspondence address in the proceeding file will be changed, and future correspondence will be sent to B, rather than A. No requirement will be made that B submit authorization, from the party or from A, for the change of correspondence address, nor will B be required to serve a copy of the request upon A. If B does not file a written request that correspondence be sent to him or her, correspondence will continue to be sent to A.

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

If a power of attorney from a party to one attorney ("A") has been filed, and thereafter a power of attorney from the party to another attorney ("B") is filed, the second power of attorney will be construed, even if there is no revocation of the first power, as a written request to change the correspondence address from A to B, unless the party or A directs otherwise. *Cf.* TMEP § 603. Likewise, if an attorney makes an appearance on behalf of a party, and thereafter the party files a written power of attorney to another attorney, the Board will send subsequent correspondence to the appointed attorney.

If a power of attorney from a party to one attorney ("A") has been filed, and thereafter A files an "associate power of attorney" to another attorney ("B"), the correspondence address will remain unchanged, and the Board will continue to send correspondence to A, unless A or the party directs otherwise.¹⁰⁷

If a power of attorney from a party to several attorneys ("A," "B," and "C") in the same firm ("XYZ") has been filed, and thereafter A leaves the firm but does not file a request that all future

¹⁰⁶ See 37 CFR § 2.18.

¹⁰⁷ *Cf.* TMEP § 603.

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correspondence be sent to him or her, rather than to B and/or C, the Board will continue to send correspondence to B and/or C. If A, after leaving firm XYZ, does file a request that all future correspondence be sent to him or her, rather than to B and/or C, the correspondence address will be changed as requested. If, however, B and C object, and maintain that it is they, rather than A, who continue to represent the party and are entitled to receive correspondence, proceedings in the case will be suspended until a designation of correspondence address by the party has been submitted.

If oppositions or petitions for cancellation filed by different opposers or petitioners against the same application or registration are consolidated, or if an opposition or petition for cancellation is filed by joint opposers or petitioners, and the different plaintiffs are represented by different attorneys or other authorized representatives, rather than by the same one(s), the Board, in its discretion, may request that the plaintiffs appoint one lead counsel, to whom the Board may send correspondence intended for the plaintiffs.¹⁰⁸ After the lead counsel has been appointed, the Board will send one copy of any forthcoming Board order, decision, or other communication to the applicant or its attorney or other authorized representative, and one copy to plaintiffs' lead counsel. Lead counsel in turn will be responsible for making and distributing copies of such Board correspondence to each plaintiff or its attorney or other authorized representative. In these cases, the lead counsel is not substituted for the separate counsel of each plaintiff, but rather is responsible for coordinating the conduct of the plaintiffs' cases. A Board action requesting the appointment of lead counsel normally includes a detailed explanation of the anticipated duties and responsibilities of lead counsel.

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

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

In the case of a party whose application is the subject of a Board proceeding, any appearance or power of attorney (or designation of other authorized representative) of record in the application file at the time of the commencement of the Board proceeding is considered to be effective for purposes of the proceeding, and correspondence will be sent initially to that address.¹⁰⁹ Thereafter, the correspondence address may be changed in appropriate circumstances.

¹⁰⁸ *Cf. Internet Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435, 1436 n.2 (TTAB 1996) (in three proceedings where defendant in one case was one of two plaintiff's in the two other cases, and where each plaintiff retained separate counsel, Board indicated that it would send correspondence to attorneys for the plaintiff which was a party to all three cases unless otherwise advised).

¹⁰⁹ See 37 CFR § 2.105.

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However, in the case of a party whose registration is the subject of a proceeding before the Board, any representation which may be of record in the registration file at the time of the commencement of the Board proceeding is not considered to be effective for purposes of the Board proceeding. Rather, correspondence is sent to the registrant itself or its domestic representative unless and until an attorney makes an appearance in the Board proceeding in the registrant's behalf, or a written power of attorney is filed in the proceeding by the registrant, or written authorization of some other person entitled to be recognized is filed in the proceeding by the registrant, or the registrant designates in writing another address to which correspondence is to be sent.¹¹⁰

Changes of attorney addresses or powers of attorney in registration files are accepted by the Office when submitted with post-registration filings, such as those under Sections 7, 8, 9 or 15 of the Act, 15 U.S.C. §§ 1057, 1058, 1059 or 1065; as well as in a cancellation or concurrent use proceeding before the Board. The attorney representing the registrant is responsible for insuring that registrant's correspondence address is updated. The Office accepts separate written address changes for registrants and domestic representatives, but global changes of address (when one paper is filed listing all involved registrations) will not be effective in changing the address in each file. A single TEAS¹¹¹ form for recording a change of address, found at www.uspto.gov/teas/index.html, can be used to notice a change of address for more than one application or registration. The TEAS form can be used to change the correspondence address only on applications or registrations that are currently active.¹¹²

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

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

¹¹⁰ See 37 CFR §§ 2.18(d) and 2.113.

¹¹¹ TEAS is the acronym for Trademark Electronic Application System. See 37 CFR § 7.1.

¹¹² See TMEP § 603.02(b).

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117.05 Correspondence After Revocation or Withdrawal

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

117.06 Correspondence With Foreign Party

If a party to a Board proceeding is not domiciled in the United States and is not represented by an attorney or other authorized representative located in the United States, or by a foreign attorney or agent duly qualified under 37 CFR § 10.14(c), correspondence will be sent to the party's domestic representative, if one has been appointed. If the party has not appointed a domestic representative and the proceeding is not being prosecuted by an attorney or other qualified person, the Office will send correspondence directly to the party, unless the party designates in writing another address to which correspondence is to be sent.¹¹³

117.07 Change of Address

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

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

¹¹³ See 37 CFR § 2.119(d).

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117.08 Individual Not Entitled to Represent Others

An individual who is not entitled, under 37 CFR § 10.14(a), (b), or (c), to practice before the Office in trademark cases, will not be permitted to represent a party in a proceeding before the Board, and may not file papers on behalf of the party.¹¹⁴ If it comes to the attention of a Board attorney that such an individual is attempting to represent a party in a Board proceeding, the Board attorney will bring the matter to the attention of the Chief Administrative Trademark Judge, who will coordinate appropriate action with the Office of Enrollment and Discipline. Moreover, no Board correspondence intended for the party will be sent to the individual. Rather, the Board will send such correspondence to the party itself, or to the party's attorney or other authorized representative entitled to practice before the USPTO in trademark cases.¹¹⁵

118 Payment of Fees

118.01 Lists of Fees and Charges

A list of the fees and charges established by the USPTO for trademark cases may be found in 37 CFR § 2.6, and are usually posted on the USPTO web site at www.uspto.gov.

A list of fees and charges established by the USPTO for miscellaneous services may be found in 37 CFR §§ 1.21, as well as on the USPTO web site.

A list of fees and charges for processing correspondence relating to international applications and registrations under the Madrid Protocol may be found in 37 CFR § 7.6 as well as on the USPTO web site. International fees that may be paid to the International Bureau through the Office in connection with international applications and registrations may be found in 37 CFR § 7.7 as well as on the WIPO web site.

118.02 Fees Payable in Advance

37 CFR § 2.206 Trademark Fees payable in advance.

(a) Trademark fees and charges payable to the Office are required to be paid in advance; that is, at the time of requesting any action by the Office for which a fee or charge is payable.

(b) All fees paid to the Office must be itemized in each individual trademark application, or registration file, or trademark proceeding, so the purpose for which the fees are paid is clear. The Office may return fees that are not itemized as required by this paragraph.

¹¹⁴ Cf. TMEP § 602.03.

¹¹⁵ See 37 CFR § 2.18.

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118.03 Method of Payment--In General

37 CFR § 2.207 Method of payment.

(a) All payments of money required in Trademark cases, including fees for the processing of international trademark applications and registrations that are paid through the Office, shall be made in U.S. dollars and in the form of a cashier's or certified check, Treasury note, national bank note, or United States Postal Service money order. If sent in any other form, the Office may delay or cancel the credit until collection is made. Checks and money orders must be made payable to the Director of the United States Patent and Trademark Office. (Checks made payable to the Commissioner of Patents and Trademarks will continue to be accepted.) Payments from foreign countries must be payable and immediately negotiable in the United States for the full amount of the fee required. Money sent to the Office by mail will be at the risk of the sender, and letters containing money should be registered with the United States Postal Service.

(b) Payments of money required for trademark fees may also be made by credit card. Payment of a fee by credit card must specify the amount to be charged to the credit card and such other information as is necessary to process the charge, and is subject to collection of the fee. The Office will not accept a general authorization to charge fees to a credit card. If credit card information is provided on a form or document other than a form provided by the Office for the payment of fees by credit card, the Office will not be liable if the credit card number becomes public knowledge.

It is the practice of the Office to routinely accept, as "conditional" payment of a fee, a signed uncertified check. If such a check is returned for insufficient funds, the fee remains unpaid, and the filing date of the fee will be the filing date of any resubmitted adequate payment.¹¹⁶ An unsigned check will be returned to its sender, but the Director has the discretion to accept such a check, as "conditional" payment, upon petition showing sufficient cause therefor.¹¹⁷

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

¹¹⁶ See *In re Cantatore*, 231 USPQ 742, 744 (Comm'r 1986) (petition to revive was denied because filing fee check was returned for insufficient funds).

¹¹⁷ See *Dubost v. U.S. Patent and Trademark Office*, 777 F.2d 1561, 227 USPQ 977, 980 (Fed. Cir. 1985), *on remand*, *In re Dubost*, 231 USPQ 887, 889 (Comm'r 1986) (sufficient cause not shown).

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Papers accompanied by fees may be filed by delivery to the finance window at 2900 Crystal Drive, South Tower Building, Third Floor, Arlington, VA.¹¹⁸

118.04 Method of Payment--Deposit Accounts

For the convenience of attorneys and the general public in paying fees and charges to the Office, deposit accounts may be established in the Office.¹¹⁹ The Office has an automated financial system, the Revenue Accounting and Management (RAM) system, that allows transactions to occur over the Internet through the Office web site at www.uspto.gov. Deposit accounts can be maintained through the Internet and funds replenished using a credit card.

The fees for filing an ex parte appeal to the Board, an opposition, and a petition for cancellation, may all be charged to a deposit account, provided that the requirements of 37 CFR § 2.208 are met. However, the charging of a fee against an account that does not contain sufficient funds to cover it cannot be regarded as payment of the fee.¹²⁰ Thus, the overdraw of a deposit account may result in the loss of a vital date.¹²¹

The Office will not accept ex parte appeals if the notice of appeal is not accompanied by at least a \$100 fee or specific authorization to charge the deposit account for that fee, as opposed to a general authorization which may have been provided when the application was filed. A general authorization to charge a deposit account will only be effective upon petition to the Director.¹²² Because the general authorization can only be invoked on petition, the Board itself cannot accept the general authorization as a basis for treating the appeal fee as timely submitted.

119 Papers and Fees Generally Not Returnable

119.01 Fee Refunds--General Rule

37 CFR § 2.209 Refunds.

(a) The Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a trademark application, appeal or other trademark filing for which the fee was paid, will not entitle a party

¹¹⁸ For further information concerning how and where to file fees, see TBMP § 107.

¹¹⁹ For information concerning the establishment of a deposit account in the USPTO, see 37 CFR § 2.208.

¹²⁰ See 37 CFR § 2.208(b).

¹²¹ See Notice at 824 TMOG 1200 (February 23, 1966).

¹²² See *In re Sky is the Ltd.*, 42 USPQ2d 1799, 1800 (Comm'r Pats. 1996).

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to a refund of such fee. The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested, and will not notify the payor of such amounts. If a party paying a fee or requesting a refund does not provide the banking information necessary for making refunds by electronic funds transfer (31 U.S.C. 3332 and 31 CFR part 208), or instruct the Office that refunds are to be credited to a deposit account, the Director may require such information, or use the banking information on the payment instrument to make a refund. Any refund of a fee paid by credit card will be by a credit to the credit card account to which the fee was charged.

(b) Any request for refund must be filed within two years from the date the fee was paid, except as otherwise provided in this paragraph. If the Office charges a deposit account by an amount other than an amount specifically indicated in an authorization (§ 2.208(b)), any request for refund based upon such charge must be filed within two years from the date of the deposit account statement indicating such charge, and include a copy of that deposit account statement. The time periods set forth in this paragraph are not extendable.

* * * *

119.02 Papers and Fees--Ex Parte Cases

After an application has received a filing date, papers filed in connection therewith, including ex parte appeal papers, will not be returned.¹²³

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

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

¹²³ See 37 CFR § 2.25.

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will be dismissed as moot, and the appeal fee will not be refunded (the appeal having been necessary at the time of its filing).

119.03 Papers and Fees--Inter Partes Cases

After an inter partes proceeding before the Board has been filed, papers and other materials filed in connection therewith, normally will not be returned. Exhibits to testimony and confidential materials filed under a protective order ordinarily are returned after the conclusion of a proceeding, including any appeal period, to the party that filed them.¹²⁴

If because of a defect in an opposition or a petition for cancellation filed with the Board, a proceeding is not instituted, any submitted fee will be refunded.

No proceeding will be instituted, and any submitted filing fee will be refunded in the following circumstances:

- (1) If an opposition filed during an extension of time to oppose is in the name of someone other than the person who obtained the extension, and the opposer is unable to show, pursuant to 37 CFR § 2.102(b), that it is in privity with the person who obtained the extension, or that the person in whose name the extension was requested was misidentified by mistake.
- (2) If an opposition or a petition for cancellation is filed prematurely (i.e., prior to publication of the subject mark in the *Official Gazette* for purposes of opposition, or prior to issuance of a registration of the subject mark, respectively, even if the registration has issued by the time of the Board's action).
- (3) If an opposition is filed after the time for opposing has expired; or, is filed unsigned, and a signed copy is not submitted within the time limit set in the notification of this defect by the Board; or is filed without the required fee; or if the opposed application was abandoned before the opposition was filed.¹²⁵

Electronic filings will not be accepted if any of the above-identified conditions exist.

Proceedings will be instituted, and the filing fee charged in the following circumstances:

- (1) If a petition to cancel a Principal Register registration that is more than five years old does not allege any ground upon which such a registration can be

¹²⁴ Cf. TBMP § 806 (Termination of Proceeding).

¹²⁵ See TBMP § 218 (Abandonment of Application).

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cancelled (*see* Section 14 of the Act of 1946, 15 U.S.C. § 1064), the cancellation will be instituted and the Board will issue an order to show cause why the petition should not be dismissed for failure to state a claim.

(2) If a petition for cancellation is filed with respect to a registration which, at the time of the filing of the petition, was not a "live" registration (e.g., the time for filing an affidavit of use under Section 8 of the Act of 1946, 15 U.S.C. § 1058, had expired, and no acceptable affidavit had been filed; the registration had already been cancelled as the result of a previous cancellation proceeding), the proceeding will be instituted, and then dismissed as moot.

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

When a proceeding is erroneously instituted, the proceeding will be dismissed as a nullity, rather than vacated, so as to maintain the integrity of the proceeding numbers. All documents will be retained by the Board.

120 Access to Files

37 CFR § 2.27(d) Except as provided in paragraph (e) of this section, after a mark has been registered, or published for opposition, the file of the application and all proceedings relating thereto are available for public inspection and copies of the papers may be furnished upon paying the fee therefor.

37 CFR § 2.27(e) Anything ordered to be filed under seal pursuant to a protective order issued or made by any court or by the Trademark Trial and Appeal Board in any proceeding involving an application or a registration shall be kept confidential and shall not be made available for public inspection or copying unless otherwise ordered by the court or the Board, or unless the party protected by the order voluntarily discloses the matter subject thereto. When possible, only confidential portions of filings with the Board shall be filed under seal.

120.01 Nonconfidential Files

Except for materials filed under seal pursuant to a protective agreement, the files of applications and registrations which are the subject matter of pending proceedings before the Board, all pending proceeding files and exhibits thereto, and the files of applications which are the subject

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matter of "potential oppositions," are available for public inspection and copying at the offices of the Board.¹²⁶ The electronic files of the Board are accessible via the Internet at <http://ttabvue.uspto.gov>.

An individual who wishes to inspect and/or copy one of the paper files may come to the Board's reception desk, where the Board maintains an electronic log of file requests, and ask for the file. The individual must identify the file by its number, so that the Board may locate it. If the request is logged in before noon, the file is generally available that afternoon. When the individual returns, the file will be given to him or her for inspection and/or copying on the premises of the Board. Files or portions thereof may *not* be taken away from the offices of the Board, and a person who removes papers from a file for copying at the offices of the Board should always return the papers to the file *in their proper order*.

To save time, an individual who wishes to inspect a file that is in the possession of the Board may call and ask that the file be located. When the file has been located, the Board will call the individual back to tell him or her that the file is available.

Electronic images of Board proceeding files can be viewed using TTABVUE at <http://ttabvue.uspto.gov>. The electronic image files are also available to the public in the Trademark Library Search Room.

For information concerning access to the files of cases that are on appeal from a decision of the Board, see TBMP § 904.

120.02 Confidential Materials

Materials filed with the Board under seal pursuant to a protective order entered by any court or by the Board and filed in compliance with TBMP § 412.06, will be kept confidential and will not be made available for public inspection or copying unless otherwise ordered by the court or the Board, or unless the party protected by the order voluntarily discloses the matter subject thereto. These materials may be inspected only by those individuals who are entitled, under the terms of the protective order, to have access to the protected information.¹²⁷

To be handled as confidential, and kept out of the public record, submissions to the Board that are confidential must be filed under a separate cover. Both the submission and its cover must be

¹²⁶ See 37 CFR § 2.27.

¹²⁷ See 37 CFR §§ 2.27(e); 2.120(f), and 2.125(e); and TBMP §§ 412.02 (Protective Orders Upon Stipulation), 526 (Motion for Protective Order) and 703.01(p) (Confidential or Trade Secret Material).

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marked confidential and must identify the case number and the parties. A copy of the submission with the confidential portions redacted must also be submitted.¹²⁸

Except for materials filed under seal pursuant to a protective order, the files of applications and registrations which are the subject matter of pending proceedings before the Board and all pending proceeding files and exhibits thereto are available for public inspection and copying. Therefore, only the particular discovery responses, exhibits, deposition transcript pages, or those portions of a brief, pleading or motion that disclose confidential information should be filed under seal pursuant to a protective order. If a party submits any brief, pleading, motion or other such filing containing confidential information under seal, the party must also submit for the public record a redacted version of said papers.¹²⁹ A good practice would be to stamp each page as “confidential” of a submission that contains such matter. Confidential materials filed in the absence of a protective order will not be kept confidential by the Board.¹³⁰

120.03 Files of Terminated Proceedings

When an inter partes proceeding has been finally determined, i.e., when the proceeding is over, the Office takes certain further steps based on the final decision, including those steps necessary to give effect to the decision. This process is referred to as the "termination" of the proceeding.¹³¹ The electronic files of terminated proceedings continue to remain available through the electronic databases.

Pursuant to the National Archives retention schedule, terminated paper inter partes proceeding files that result in a final decision by the Board, e.g., motion for summary judgment, motion to dismiss, or final decision on the merits, are transferred to a warehouse for 3 years, then to the Federal Records Center for 27 years and then to the National Archives for permanent retention. All other terminated paper proceedings are transferred to a warehouse for 3 years and then transferred to the National Records Center where they remain for 27 years before destruction. The paper files of existing registrations are also stored at the warehouse. The paper files of cancelled and expired registrations are destroyed two years after the date of cancellation or

¹²⁸ See 37 CFR § 2.126(d).

¹²⁹ See 37 CFR §§ 2.27(d) and (e); and 2.126(d); *Duke University v. Haggard Clothing Co.*, 54 USPQ2d 1443, 1445 (TTAB 2000); and Rany L. Simms, *TIPS FROM THE TTAB: Stipulated Protective Agreements*, 71 Trademark Rep. 653 (1981).

¹³⁰ See *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1714 (TTAB 1999) (Board agreed to hold exhibits marked confidential for thirty days pending receipt of motion for protective order but advised that in absence of such motion the exhibits would be placed in the proceeding file), *rev'd on other grounds*, 284 F. Supp. 2d 96, 68 USPQ2d 1225 (D.D.C. 2003).

¹³¹ See TBMP § 806 (Termination of Proceeding).

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expiration; the paper files of abandoned applications are destroyed two years after the date of abandonment. In addition, the paper files of terminated opposition proceedings numbered from 30,000 through 53,999, and of terminated cancellation proceedings numbered from 1 through 9399, have been destroyed.

An individual who wishes to inspect and/or copy a paper file stored by the Office in a warehouse may go to the Trademark Search Library and place an order for the file. Within a few days, the USPTO will obtain the ordered file from the warehouse, and make it available to the individual for inspection and/or copying at the Trademark Search Library. The file may not be removed from the premises of the Trademark Search Library.¹³²

121 Copying of Files

The Board has, on its office premises, a photocopier that is intended for use by members of the public who wish to photocopy files, exhibits, or other materials in the possession of the Board. Payment for use of the machine is made by way of a magnetic card, known as a "copy card," which may be purchased at, *inter alia*, the USPTO Finance Window located on the third floor of the South Tower Building, 2900 Crystal Drive, Arlington, Virginia, or from a machine located in the Trademark Search Library on the second floor of the South Tower Building. The photocopier will not operate until such a card has been inserted in it.

Electronic files can be accessed by the public through the Internet and copies of the documents in the electronic files can be downloaded and printed out by the user through TTABVUE.

Paper files or portions thereof *may not* be taken away from the offices of the Board, and a person who removes papers from a file for copying at the offices of the Board should always return the papers to the file *in their proper order*.

Alternatively, the USPTO Office of Public Records will furnish photocopies (either certified or uncertified) of trademark application and registration files, or of one or more papers therefrom, or of papers from the files of Board proceedings, upon written request and payment of the fee prescribed in 37 CFR § 2.6. The Office will also furnish, upon written request and payment of the fee prescribed in 37 CFR § 2.6, printed copies of trademark registrations, certified copies of registrations with information as to the current status and title of the registration, and abstracts of title to trademark applications and registrations.

All requests for certified and uncertified copies of trademark documents relating to applications or registrations, including copies of papers from the files of Board proceedings, and abstracts of title, are handled by the USPTO's Document Services, Office of Public Records. A written request (with the required fee) for copies should be addressed to Mail Stop Document Services,

¹³² See TMEP § 109.

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Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450. The written request, with fee, may also be hand delivered to the Public Service Window at 2900 Crystal Drive, South Tower Building, Second Floor, Arlington, Virginia 22202-3514; or to the Office of Public Records, Crystal Gateway 4, Third Floor, 1213 Jefferson Davis Highway, Arlington, Virginia 22202-3513; or to the Attorneys' Window at 2201 S. Clark Place, Crystal Plaza Building 4, First Floor, Arlington, Virginia 22202. Finally, if the written request includes an authorization to charge the required fee to a deposit account, the request may be sent by facsimile transmission to (703) 305-8759.¹³³ Orders may also be placed over the Internet through the Office homepage at www.uspto.gov.

122 Certification

122.01 Court Requirements

If a copy of a Board proceeding file, or a portion thereof, is needed for use before a district court, the court may require a certified copy (which bears a seal). This may be obtained from the USPTO Document Services of the Office of Public Records.

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

122.02 Certified Copies

Certified copies, bearing a seal, of Office proceeding files, including Board proceeding files, or portions thereof, may be ordered from the USPTO's Document Services, Office of Public Records, upon written request and payment of the required fee.¹³⁴

123 Status Information for Applications, Registrations and Board Proceedings

The Office maintains a Trademark Status Line which provides access, by push-button telephone, to current status, status date (i.e., the date that a record entered its current status), and status location information for all active Federal trademark application and registration records

¹³³ See *"Notice of a Change in Procedure Regarding Requests for Certification Services,"* 1165 TMOG 13 (August 2, 1994).

¹³⁴ See TBMP §§ 121 (Copying of Files) and 122.02 (Certified Copies).

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maintained in the automated Trademark Reporting and Monitoring (TRAM) System.¹³⁵ The line is available on (703) 305-8747 from 6:30 a.m. until midnight, Eastern Time, Monday through Friday (except for Federal holidays). The Trademark Assistance Center provides general information about the registration process and can also answer status questions. The Center can be reached at 703-308-9000. Trademark application and registration information can also be obtained through the Office web site at www.uspto.gov and through the Trademark Applications and Registrations Retrieval (TARR) database at <http://tarr.uspto.gov>. The status of Board proceedings and of requests for extensions of time to oppose can be obtained through the Board Information Systems Index (BISX) at www.uspto.gov. Electronic images of Board proceeding files can be viewed using TTABVUE at <http://ttabvue.uspto.gov>. The electronic image files are also available to the public in the Trademark Library Search Room.

For further information concerning the Trademark Status Line, see TMEP § 1707.05, and TMEP §§ 108 et seq.

124 Action by Assignee

When a mark which is the subject of a Federal application or registration has been assigned, together with the application or registration, in accordance with Section 10 of the Act, 15 U.S.C. § 1060, any action with respect to the application or registration which may or must be taken by the applicant or registrant may be taken by the assignee (acting itself, or through its attorney or other authorized representative), provided that the assignment has been recorded or that proof of the assignment has been submitted.¹³⁶ Similarly, when a mark which is not the subject of a Federal application or registration, but which is owned and pleaded by a plaintiff in a Board inter partes proceeding, has been assigned, the assignee may act in the proceeding (either itself, or through its attorney or other authorized representative) in place of the assignor, provided that proof of the assignment has been submitted in the proceeding.¹³⁷

NOTE: Section 10 of the Act, 15 U.S.C. § 1060, and part 3 of 37 CFR are not applicable to 66(a) applications and registrations.¹³⁸ Except in limited circumstances, requests to record assignments of 66(a) applications and registrations must be filed directly with the International Bureau.¹³⁹ The International Bureau will notify the USPTO of any changes in ownership

¹³⁵ See *In re Sovran Financial Corp.*, 25 USPQ2d 1537, 1538 (Comm'r 1992).

¹³⁶ See 37 CFR §§ 3.71 and 3.73(b). See also 37 CFR § 7.22 et seq. regarding assignments of 66(a) applications and registrations.

¹³⁷ See TBMP § 512.01 (Assignment of Mark).

¹³⁸ See 37 CFR § 7.22 et seq for information on recording changes to 66(a) applications and registrations.

¹³⁹ See Section 72 of the Trademark Act, 15 U.S.C. 1141/; and 37 CFR § 7.22. See also Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act; Final Rule, published in the *Federal*

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recorded in the International Register. The USPTO will record only those assignments, or other documents of title, that have been recorded in the International Register.¹⁴⁰

Register on September 26, 2003 at 68 FR 55748, 55751; Exam Guide No. 2-03, Guide to Implementation of Madrid Protocol in the United States (part V.I) (October 28, 2003); and Exam Guide No. 1-03, Changes Affecting All Applications and Registrations (part V.D) (October 30, 2003).

¹⁴⁰ See Exam Guide No. 2-03, *supra* (parts IV.F and VI.A.1) (October 28, 2003).