

CHAPTER 200 EXTENSIONS OF TIME TO OPPOSE

201 In General

202 Time for Filing Request

203 Form of Request

204 Fee

205 Mark on Supplemental Register Not Subject to Opposition

206 Identification of Potential Opposer

207 Requirements for Showing of Cause

208 Essential Element Omitted

209 Action by Board on Request

210 Objections to Request

211 Relief From Action of Board

212 Amendment of Application During or After Extension

213 Effect of Restoration of Jurisdiction

214 Effect of Republication

215 Effect of Letter of Protest

216 Inadvertently Issued Registration

217 Relinquishment of Extension

218 Abandonment of Application

219 Amendment to Allege Use; Statement of Use

EXTENSIONS OF TIME TO OPPOSE

201 In General

15 U.S.C. §1063 (a) Any person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 12 of this Act of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Commissioner for good cause when requested prior to the expiration of an extension. The Commissioner shall notify the applicant of each extension of the time for filing opposition. An opposition may be amended under such conditions as may be prescribed by the Commissioner.

37 CFR §2.101 Filing an opposition.

(a) An opposition proceeding is commenced by the filing of an opposition in the Patent and Trademark Office.

(b) Any entity which believes that it would be damaged by the registration of a mark on the Principal Register may oppose the same by filing an opposition, which should be addressed to the Trademark Trial and Appeal Board. The opposition need not be verified, and may be signed by the opposer or the opposer's attorney or other authorized representative.

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

* * *

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

(a) Any person who believes that he would be damaged by the registration of a mark on the Principal Register may file a written request to extend the time for filing an opposition. The written request may be signed by the potential opposer or by an attorney at law or other person authorized, in accordance with §2.12(b) and (c) and §2.17(b), to represent the potential opposer.

(b) The written request to extend the time for filing an opposition must identify the potential opposer with reasonable certainty. Any opposition filed during an

EXTENSIONS OF TIME TO OPPOSE

extension of time should be in the name of the person to whom the extension was granted, but an opposition may be accepted if the person in whose name the extension was requested was misidentified through mistake or if the opposition is filed in the name of a person in privity with the person who requested and was granted the extension of time.

(c) The written request to extend the time for filing an opposition must be filed in the Patent and Trademark Office before the expiration of thirty days from the date of publication or within any extension of time previously granted, should specify the period of extension desired, and should be addressed to the Trademark Trial and Appeal Board. A first extension of time for not more than thirty days will be granted upon request. Further extensions of time may be granted by the Board for good cause. In addition, extensions of time to file an opposition aggregating more than 120 days from the date of publication of the application will not be granted except upon (1) a written consent or stipulation signed by the applicant or its authorized representative, or (2) a written request by the potential opposer or its authorized representative stating that the applicant or its authorized representative has consented to the request, and including proof of service on the applicant or its authorized representative, or (3) a showing of extraordinary circumstances, it being considered that a potential opposer has an adequate alternative remedy by a petition for cancellation.

(d) Every request to extend the time for filing a notice of opposition should be submitted in triplicate (original plus two copies).

Any person (whether natural or juristic--*see* TBMP §303.02) who believes that he, she, or it would be damaged by the registration of a mark upon the Principal Register may, upon payment of the prescribed fee, file an opposition in the PTO, stating the grounds therefor, within 30 days after the publication of the mark in the *Official Gazette* for purposes of opposition. *See* Section 13(a) of the Act, 15 U.S.C. §1063(a), and 37 CFR §2.101. For further information concerning the filing of an opposition, *see* TBMP chapter 300.

Similarly, any person who believes that he, she, or it would be damaged by the registration of a mark upon the Principal Register may file a written request to extend the time for filing an opposition. *See* Section 13(a) of the Act, 15 U.S.C. §1063(a), and 37 CFR §2.102. Requests for extension of time to oppose are determined by the Board. *See* 37 CFR §2.102(c), and *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075 (TTAB 1993).

EXTENSIONS OF TIME TO OPPOSE

The time for filing a request for an extension of time to oppose is governed by Section 13(a) of the Act, 15 U.S.C. §1063(a), and 37 CFR §2.102(c). For further information concerning the time for filing a request for extension of time to oppose, *see* TBMP §202.

Other requirements for a request for extension of time to oppose are specified in 37 CFR §2.102. Moreover, certain requirements for papers filed in inter partes proceedings before the Board also apply to a request for extension of time to oppose. For information concerning the requirements (other than the time requirement) for a request for extension of time to oppose, *see* TBMP §§203-208.

202 Time for Filing Request

202.01 In General

15 U.S.C. §1063 (a) Any person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 12 of this Act of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Commissioner for good cause when requested prior to the expiration of an extension. The Commissioner shall notify the applicant of each extension of the time for filing opposition. An opposition may be amended under such conditions as may be prescribed by the Commissioner.

37 CFR §2.102(c) The written request to extend the time for filing an opposition must be filed in the Patent and Trademark Office before the expiration of thirty days from the date of publication or within any extension of time previously granted, should specify the period of extension desired, and should be addressed to the Trademark Trial and Appeal Board. ...

A first request for an extension of time to oppose an application for registration of a mark must be filed prior to the expiration of the thirty-day period after publication of the mark in the *Official Gazette*, pursuant to Section 12(a) of the Act, 15 U.S.C. §1062(a), for purposes of opposition. Any request for a further extension of time to oppose must be filed prior to the expiration of an extension

EXTENSIONS OF TIME TO OPPOSE

granted to the requesting party or its privy. *See* Section 13(a) of the Act, 15 U.S.C. §1063(a), and 37 CFR §2.102(c). *See also In re Cooper*, 209 USPQ 670 (Comm'r 1980).

A potential opposer which has requested an extension of time to oppose should not wait until it has received notification from the Board of the grant or denial of the request before filing an opposition or a request for a further extension of time to oppose. If a request for an extension of time to oppose is granted, the length of the granted extension will be no greater (and may be less) than that sought in the extension request, and it will run from the expiration of the thirty-day opposition period after publication, in the case of a first request, or from the date of expiration of the previously granted extension, in the case of a request for a further extension. *See In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093 (Comm'r 1990). While the Board attempts to notify a potential opposer of the grant of an extension request prior to the expiration of the granted extension, particularly where the length of the granted extension is less than that requested, the Board is under no obligation to do so, and in many cases cannot. *See Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310 (Comm'r 1991), and *In re Societe Des Produits Nestle S.A.*, *supra*. *Cf. In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984); *In re L.R. Sport Inc.*, 25 USPQ2d 1533 (Comm'r 1992); and *In re Application Papers Filed November 12, 1965*, 152 USPQ 194 (Comm'r 1966).

202.02 Date of Publication of Mark

Normally, the date of publication of a mark is the cover date of the issue of the *Official Gazette* in which the mark is published, pursuant to Section 12(a) of the Act, 15 U.S.C. §1062(a), for purposes of opposition. However, when an issue of the *Official Gazette* is mailed late, the date of publication of the marks published therein for opposition is considered by the Commissioner to be the date on which the *Official Gazette* was mailed, as specified in the Commissioner's Notice of the late mailing.

202.03 Late-mailed *Official Gazette*

EXTENSIONS OF TIME TO OPPOSE

Ordinarily, an issue of the *Official Gazette* is mailed to subscribers during the business week of the date appearing on its cover, and that cover date is considered to be the date of publication of the marks published therein, pursuant to Section 12(a) of the Act, 15 U.S.C. §1062(a), for purposes of opposition. However, it sometimes happens that an issue of the *Official Gazette* is mailed to subscribers late, that is, after the business week of the date appearing on its cover.

When an issue of the *Official Gazette* is mailed late, the date of publication of the marks published therein for opposition is considered by the Commissioner to be the date on which the *Official Gazette* was mailed, and the thirty-day opposition period is considered by the Commissioner to run from the *Official Gazette* mailing date, rather than from its cover date. Applicants and potential opposers are notified of the late mailing, and of the consequent change in both the publication date and the opposition period expiration date, by a Commissioner's Notice published in a subsequent issue of the *Official Gazette*. Cf. *In re BPJ Enterprises Ltd.*, 7 USPQ2d 1375, 1376, at fn.1 (Comm'r 1988). In such cases, extensions of time to oppose run from the opposition period expiration date specified in the Commissioner's Notice, and the 120-day period of 37 CFR §2.102(c) runs from the *Official Gazette* mailing date specified in the Notice.

The *Official Gazette* mailing date, and the opposition period expiration date, specified in the Commissioner's Notice will be used by the Board as the basis for calculating the expiration date of a first extension of time to oppose, even if an extension request specifies an extension expiration date calculated from the *Official Gazette* cover date. Ordinarily, the dates specified in the Commissioner's Notice will also be used by the Board in calculating the expiration dates of further extensions of time to oppose. However, if a request for a further extension specifies a different extension expiration date, and the request meets the requirements of 37 CFR §2.102, the extension will be set to expire on the specified date.

202.04 Premature Request

Section 13(a) of the Act, 15 U.S.C. §1063(a), provides that an opposition to the registration of a mark upon the Principal Register may be filed "within thirty days after" the publication of the mark in the *Official Gazette*, pursuant to Section 12(a) of the Act, 15 U.S.C. §1062(a), for opposition. Section 13(a) also provides for extensions of this time for filing an opposition, under certain conditions. Thus,

EXTENSIONS OF TIME TO OPPOSE

any opposition, and any request for an extension of time to oppose, filed prior to the publication of the mark sought to be opposed, is premature, and will be rejected by the Board, even if the mark has been published by the time of the Board's action. *Cf.* TBMP §§119.03 and 307.03.

202.05 Late Request

A request for an extension of time to oppose must be filed prior to the expiration of the thirty-day period after publication (for opposition) of the mark which is the subject of the request, in the case of a first request, or prior to the expiration of an extension granted to the requesting party or its privy, in the case of a request for a further extension. *See* Section 13(a) of the Act, 15 U.S.C. §1063(a), and 37 CFR §§2.102(b) and (c). *See also In re Cooper*, 209 USPQ 670 (Comm'r Pats 1980). Because these timeliness requirements are statutory, they cannot be waived by stipulation of the parties, nor can they be waived by the Commissioner upon petition. *See In re Cooper, supra*. Accordingly, a first request filed after the expiration of the thirty-day period following publication of the subject mark, or a request for a further extension filed after the expiration of the previous extension granted to the requesting party or its privy, must be denied by the Board as late, even if the applicant has consented to the granting of the late filed request.

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

203 Form of Request

203.01 In General

37 CFR §2.102(a) Any person who believes that he would be damaged by the registration of a mark on the Principal Register may file a written request to extend the time for filing an opposition. The written request may be signed by the potential opposer or by an attorney at law or other person authorized, in accordance with §2.12(b) and (c) and §2.17(b), to represent the potential opposer.

EXTENSIONS OF TIME TO OPPOSE

* * *

37 CFR §2.102(c) *The written request to extend the time for filing an opposition must be filed in the Patent and Trademark Office before the expiration of thirty days from the date of publication or within any extension of time previously granted, should specify the period of extension desired, and should be addressed to the Trademark Trial and Appeal Board. ...*

37 CFR §2.102(d) *Every request to extend the time for filing a notice of opposition should be submitted in triplicate (original plus two copies).*

A request for an extension of time to oppose must be made in writing. *See* Section 13(a) of the Act, 15 U.S.C. §1063(a), and 37 CFR §§2.102(a) and 1.2. The request should specify the period of extension desired, and should be addressed to the mailing address of the Trademark Trial and Appeal Board (*see* TBMP §103).

In addition, every request for an extension of time to oppose should be filed in triplicate, so that if the request is approved, it may be so stamped; one copy may be placed in the application file; and the other copies may be mailed to the potential opposer and the applicant. *See* 37 CFR §2.102(d). If only a single copy of an extension request is filed, the request will not be refused consideration, but action thereon may be delayed because the Board itself will have to make the extra copies.

203.02 Identifying Information

A request for an extension of time to oppose should bear at its top the heading "IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD," followed by information identifying the application to which the request pertains, namely, the name of the applicant, and the application serial number, filing date, mark, and date of publication in the *Official Gazette*. *Cf.* 37 CFR §1.5(c), and *In re Merck & Co.*, 24 USPQ2d 1317 (Comm'r 1992) (misidentification by potential opposer of application to which request for extension of time to oppose pertains). The request should also bear an appropriate title describing its nature, such as "Request for Extension of Time to Oppose" or "Request for Further Extension of Time to Oppose." In addition, the request must identify the potential opposer with reasonable certainty. *See* 37 CFR §2.102(b), and TBMP §206.

EXTENSIONS OF TIME TO OPPOSE

203.03 Signature

37 CFR §2.102(a) Any person who believes that he would be damaged by the registration of a mark on the Principal Register may file a written request to extend the time for filing an opposition. The written request may be signed by the potential opposer or by an attorney at law or other person authorized, in accordance with §2.12(b) and (c) and §2.17(b), to represent the potential opposer.

A request for an extension of time to oppose may be signed either by the potential opposer or by its attorney or other authorized representative. *See* 37 CFR §2.102(a). *See also La Maur, Inc. v. Andis Clipper Co.*, 181 USPQ 783 (Comm'r 1974). Under the written signature there should appear the name, in typed or printed form, of the person signing; a description of the capacity in which he or she signs (e.g., as the individual who is the potential opposer, if the potential opposer is an individual; as a corporate officer, specifying the particular office held, if the potential opposer is a corporation; as potential opposer's attorney; etc.); and his or her business address (to which correspondence relating to the request will be sent) and telephone number.

While a request for an extension of time to oppose must be signed, an unsigned request will not be refused consideration if a signed copy is submitted to the PTO within the time limit set in the written notification of this defect by the Board. *See* 37 CFR §2.119(e) and TBMP §106.02.

A potential opposer which has submitted an unsigned request for an extension of time to oppose should not wait until it has submitted a signed copy of the request (in response to the Board's written notification of the defect), and the Board has acted thereon, before filing an opposition or a request for a further extension of time to oppose. If the extension request is ultimately granted, the length of the granted extension will be no greater (and may be less) than that sought in the extension request, and it will run from the expiration of the thirty-day opposition period after publication, in the case of a first request, or from the date of expiration of the previously granted extension, in the case of a request for a further extension. If no opposition or request for further extension of time to oppose is filed prior to the expiration of any extension ultimately granted (after submission of a signed copy of the request) to the potential opposer, the time for opposing will be deemed

EXTENSIONS OF TIME TO OPPOSE

to have expired, and the application which was the subject of the request will be sent to issue. Cf. TBMP §202.01.

203.04 Service

Rule 2.119(a), 37 CFR §2.119(a), requires, in part, that with certain stated exceptions, every paper filed in the PTO in inter partes cases must be served upon the other parties, and that proof of such service must be made before the paper will be considered by the Office. Rule 2.101(a), 37 CFR §2.101(a), provides that an opposition proceeding is commenced by the filing of an opposition in the PTO. Inasmuch as a request for an extension of time to oppose is a paper filed prior to the commencement of the opposition, it is ex parte, rather than inter partes, in nature. Accordingly, the request need not include proof of service upon the applicant unless the request seeks an extension beyond 120 days from the date of publication, and is based upon a statement by the potential opposer or its authorized representative that the applicant or its authorized representative has consented to the request. See 37 CFR §2.102(c) and *La Maur, Inc. v. Andis Clipper Co.*, 181 USPQ 783 (Comm'r 1974). However, once the Board has acted upon a request for an extension of time to oppose, the Board itself will send the applicant a copy of the extension request (unless it bears proof of service by potential opposer) together with the Board's action thereon. See Section 13 of the Act, 15 U.S.C. §1063.

203.05 Duplicate Requests

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

When duplicate requests have been filed, and the first request has been granted, the second request is given no consideration, and the attorneys are notified in writing of the duplicate filings and are requested to take appropriate action to avoid the filing of duplicate requests in the future. If requests filed by different attorneys on behalf of the same party are duplicates but for the fact that the second

EXTENSIONS OF TIME TO OPPOSE

request seeks a longer extension than the first, the second request will be granted, if otherwise appropriate, but the attorneys will be requested in writing to avoid the filing of further duplicate requests.

204 Fee

There is no fee for filing a request for an extension of time to oppose. *Cf.* 37 CFR §2.6.

205 Mark on Supplemental Register Not Subject to Opposition

Although the mark in an application for registration on the Principal Register is published for, and subject to, opposition, the mark in an application for registration on the Supplemental Register is not. *See* Sections 12(a), 13(a), and 24 of the Act, 15 U.S.C. §§1062(a), 1063(a), and 1092, and 37 CFR §2.82. If it appears, after examination of an application for registration of a mark on the Supplemental Register, that applicant is entitled to the registration sought, a certificate of registration is issued, without any publication for opposition. *See* Sections 23(b) and 24 of the Act, 15 U.S.C. §§1091(b) and 1092, and 37 CFR §2.82. Upon issuance of the registration, the mark is published in the *Official Gazette*, not for opposition, but rather to give notice of the registration's issuance. *See* Section 24 of the Act, 15 U.S.C. §1092; 37 CFR §2.82; and TMEP §1502.

Accordingly, the Board must deny any request for an extension of time to oppose the mark in an application for registration on the Supplemental Register. The remedy of the would-be opposer lies in the filing of a petition to cancel the registration of the mark, once the registration has issued. *See* Section 24 of the Act, 15 U.S.C. §1092.

206 Identification of Potential Opposer

37 CFR §2.102(b) The written request to extend the time for filing an opposition must identify the potential opposer with reasonable certainty. Any opposition filed during an extension of time should be in the name of the person to whom the

EXTENSIONS OF TIME TO OPPOSE

extension was granted, but an opposition may be accepted if the person in whose name the extension was requested was misidentified through mistake or if the opposition is filed in the name of a person in privity with the person who requested and was granted the extension of time.

206.01 Requirement for Identification

A request for an extension of time to oppose must identify the potential opposer with reasonable certainty. *See* 37 CFR §2.102(b). If a request for extension of time to oppose fails to identify the potential opposer with reasonable certainty, the Board can allow the defect to be corrected only if the correction is made prior to the expiration of the time for filing the request, that is, prior to the expiration of the thirty-day opposition period following publication of the subject mark, in the case of a first request, or prior to the expiration of the previous extension, in the case of a request for a further extension. *See In re Spang Industries, Inc.*, 225 USPQ 888 (Comm'r 1985). *Cf. In re Su Wung Chong*, 20 USPQ2d 1399 (Comm'r 1991); *In re Software Development Systems, Inc.*, 17 USPQ2d 1094 (Comm'r 1989); and *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093 (Comm'r 1990).

If a request for a further extension of time to oppose does not specifically name the potential opposer, but it is clear from the circumstances that the request is being submitted on behalf of the same potential opposer which obtained an earlier extension(s) (for example, the request is submitted by the same attorney(s) who submitted the earlier request(s) on behalf of the potential opposer, and, asks for an "additional" or "further" extension; or the request indicates that the "potential opposer" was granted an earlier extension(s) until a specified time, and asks for an additional or further extension; etc.), the request may be construed by the Board as identifying the potential opposer with reasonable certainty. However, the better, and safer, practice is to specifically name the potential opposer in each request for an extension of time to oppose.

206.02 Request for Further Extension Filed by Privy

An extension of time to oppose is a personal privilege which inures only to the benefit of the party to which it was granted and those in privity with that party.

EXTENSIONS OF TIME TO OPPOSE

For this reason, a request for a further extension of time to oppose, or an opposition, filed during an extension of time ordinarily must be filed in the name of the party to which the extension was granted. However, a request for a further extension, or an opposition, filed by a different party will not be rejected on that ground if it is shown to the satisfaction of the Board that the different party is in privity with the party granted the previous extension(s). See 37 CFR §2.102(b); TMEP §1503.04(d); *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707 (TTAB 1994); and *In re Cooper*, 209 USPQ 670 (Comm'r 1980). The "showing" should be in the form of a recitation of the facts upon which the claim of privity is based, and must be submitted either with the request or opposition, or during the time allowed by the Board in its letter requesting an explanation of the discrepancy. If the request for a further extension, or the opposition, is filed both in the name of the party granted the previous extension and in the name of one or more different parties, an explanation will be requested as to each different party, and the request will not be granted, or the opposition accepted, as to any different party which fails to make a satisfactory showing of privity.

The term "privity" is defined in *Black's Law Dictionary* (Fifth Edition, 1979) as follows:

Mutual or successive relationship to the same rights of property. In its broadest sense, "privity" is defined as mutual or successive relationships to the same right of property, or such an identification of interest of one person with another as to represent the same legal right.

In the field of trademarks, the concept of privity generally includes, inter alia, the relationship of successive ownership of a mark (e.g., assignor, assignee) and the relationship of "related companies" within the meaning of Sections 5 and 45 of the Act, 15 U.S.C. §§1055 and 1127. Cf. *Rolex Watch U.S.A., Inc. v. Madison Watch Co.*, 211 USPQ 352, 358 (TTAB 1981); *In re Cooper*, 209 USPQ 670 (Comm'r 1980); *Argo & Co. v. Carpetsheen Mfg., Inc.*, 187 USPQ 366, 367 (TTAB 1975); and *F. Jacobson & Sons, Inc. v. Excelled Sheepskin & Leather Coat Co.*, 140 USPQ 281 (Comm'r 1963). But see *Tokaido v. Honda Associates Inc.*, 179 USPQ 861 (TTAB 1973). It does not, however, include the attorney/client relationship. See *In re Spang Industries, Inc.*, 225 USPQ 888 (Comm'r 1985).

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

EXTENSIONS OF TIME TO OPPOSE

of privity when an opposition or subsequent extension request is later filed by one or more of them.

206.03 Misidentification

Ordinarily, a request for a further extension of time to oppose, or an opposition, filed during an extension of time to oppose must be filed in the name of the party to which the previous extension was granted. *See* 37 CFR §2.102(b). However, a request for a further extension, or an opposition, filed in a different name will not be rejected on that ground if it is shown to the satisfaction of the Board that the party in whose name the extension was requested was misidentified through mistake. *See* 37 CFR §2.102(b), and *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075 (TTAB 1993). The phrase "misidentification by mistake," as used in 37 CFR §2.102(b), means a mistake in the form of the potential opposer's name or its entity type, not the naming of a different existing legal entity that is not in privity with the party that should have been named. *See Cass Logistics Inc. v. McKesson Corp.*, *supra*. *See also* TMEP §1503.04. *Cf. Arbrook, Inc. v. La Citrique Belge, Naamloze Vennootschap*, 184 USPQ 505 (TTAB 1974); *Davidson v. Instantype, Inc.*, 165 USPQ 269 (TTAB 1970); *Pyco, Inc. v. Pico Corp.*, 165 USPQ 221 (TTAB 1969); and *Raker Paint Factory v. United Lacquer Mfg. Corp.*, 141 USPQ 407 (TTAB 1964). *Cf. also* TMEP §§802.06 and 802.07; *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689 (TTAB 1991); *In re Atlantic Blue Print Co.*, 19 USPQ2d 1078 (Comm'r 1990); *In re Techsonic Industries, Inc.*, 216 USPQ 619 (TTAB 1982); *Argo & Co. v. Springer*, 198 USPQ 626 (TTAB 1978); *In re Eucryl, Ltd.*, 193 USPQ 377 (TTAB 1976); *Argo & Co. v. Springer*, 189 USPQ 581 (TTAB 1976); and *U.S. Pioneer Electronics Corp. v. Evans Marketing, Inc.*, 183 USPQ 613 (Comm'r 1974).

The "showing" submitted in support of a claim of misidentification by mistake should be in the form of a recitation of the facts upon which the claim of misidentification by mistake is based, and must be submitted either with the request or opposition, or during the time allowed by the Board in its letter requesting an explanation of the discrepancy.

207 Requirements for Showing of Cause

EXTENSIONS OF TIME TO OPPOSE

37 CFR §2.102(c) *The written request to extend the time for filing an opposition must be filed in the Patent and Trademark Office before the expiration of thirty days from the date of publication or within any extension of time previously granted, should specify the period of extension desired, and should be addressed to the Trademark Trial and Appeal Board. A first extension of time for not more than thirty days will be granted upon request. Further extensions of time may be granted by the Board for good cause. In addition, extensions of time to file an opposition aggregating more than 120 days from the date of publication of the application will not be granted except upon (1) a written consent or stipulation signed by the applicant or its authorized representative, or (2) a written request by the potential opposer or its authorized representative stating that the applicant or its authorized representative has consented to the request, and including proof of service on the applicant or its authorized representative, or (3) a showing of extraordinary circumstances, it being considered that a potential opposer has an adequate alternative remedy by a petition for cancellation.*

207.01 First Extension of Thirty Days

A first extension of time to oppose for not more than thirty days will be granted upon written request therefor, if the request is otherwise appropriate (i.e., is timely filed; identifies the potential opposer with reasonable certainty; etc.). No showing of cause is required. *See* Section 13(a) of the Act, 15 U.S.C. §1063(a); 37 CFR §2.102(c); and *Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310 (Comm'r 1991).

207.02 Further Extensions

Extensions of time to oppose beyond the first thirty-day extension may be granted by the Board for good cause, provided that the extensions do not aggregate more than 120 days from the date of publication of the subject mark. *See* 37 CFR §2.102(c), and *Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310 (Comm'r 1991). If a request for a further extension of time to oppose does not include a showing of good cause, the Board can allow the defect to be corrected only if the correction is made prior to the expiration of the time for filing the request, that is, prior to the expiration of the previous extension. *Cf. In re Su Wung Chong*, 20 USPQ2d 1399 (Comm'r 1991); *In re Software Development*

EXTENSIONS OF TIME TO OPPOSE

Systems, Inc., 17 USPQ2d 1094 (Comm'r 1989); *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093 (Comm'r 1990); and *In re Spang Industries, Inc.*, 225 USPQ 888 (Comm'r 1985).

A showing of good cause for a further extension of time to oppose should be in the form of a recitation of the reasons why additional time is needed for filing an opposition. The merits of the potential opposition are not relevant to the issue of whether good cause exists for the requested extension.

A first request for an extension of time to oppose may seek an extension of more than thirty days, but good cause must be shown for the time in excess of thirty days. See *Kimberly-Clark Corp. v. Paper Converting Industry, Inc.*, 21 USPQ2d 1875 (Comm'r 1991). If an otherwise proper first extension request seeks an extension of more than thirty days, but does not include a showing of good cause for the time in excess of thirty days, the potential opposer will be granted an extension of only thirty days. However, a request for a further extension, showing good cause, may be submitted during that thirty-day extension period.

If a request for a further extension of time to oppose includes a showing which constitutes good cause for part, but not all, of the requested extension, any extension granted to a potential opposer will be limited to the time for which good cause has been shown.

207.03 Extensions Beyond 120 Days From Publication

Extensions of time to oppose aggregating more than 120 days from the date of publication of the subject mark will not be granted unless the potential opposer submits, in addition to the showing of good cause required for extensions of time beyond the first thirty-day extension period, one of the following: (1) a written consent or stipulation signed by the applicant or its authorized representative, or (2) a written request by the potential opposer or its authorized representative stating that the applicant or its authorized representative has consented to the request, and including proof of service on the applicant or its authorized representative, or (3) a showing of extraordinary circumstances. See 37 CFR §2.102(c). If one of these elements (i.e., the showing of extraordinary circumstances, or applicant's written consent, or the statement that applicant has consented, or the proof of service upon applicant) is omitted from an extension request based in whole or in part upon the omitted element, the Board can allow

EXTENSIONS OF TIME TO OPPOSE

the defect to be corrected only if the correction is made prior to the expiration of the time for filing the request, that is, prior to the expiration of the previous extension. *See In re Su Wung Chong*, 20 USPQ2d 1399 (Comm'r 1991); *In re Software Development Systems, Inc.*, 17 USPQ2d 1094 (Comm'r 1989); and *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093 (Comm'r 1990). *Cf. In re Spang Industries, Inc.*, 225 USPQ 888 (Comm'r 1985).

If a showing of extraordinary circumstances is submitted in support of a request for an extension running beyond 120 days from the date of publication, the requirement for a showing of good cause is satisfied thereby. If a request for an extension running beyond 120 days from publication is based upon applicant's consent, but includes no recitation of other facts relating to good cause, applicant's consent will be construed as good cause for that request, but potential opposer will be advised by the Board, in writing, that any further extension request based upon applicant's consent must include also a recitation of circumstances showing good cause for the request.

A request for a further extension of time to oppose may seek an extension for a period beginning prior to 120 days from the date of publication of the subject mark and ending after the 120th day. If such a request includes a showing of good cause, but does not meet the requirements of 37 CFR §2.102(c) for extensions aggregating more than 120 days from publication (i.e., does not include a showing of extraordinary circumstances; or applicant's written consent; or a statement that applicant has consented, accompanied by proof of service on applicant), any extension granted to potential opposer will be limited to the time for which good cause has been shown, and will end on or before the 120th day after publication. *See Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310 (Comm'r 1991), and *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093 (Comm'r 1990).

208 Essential Element Omitted

If any element (e.g., identification of potential opposer, showing of good cause, showing of extraordinary circumstances, applicant's written consent, statement that applicant has consented, proof of service on applicant) essential to a particular request for extension of time to oppose is omitted from the request, the Board can allow the defect to be corrected only if the correction is made prior to the expiration of the time for filing the request, that is, prior to the expiration of the

EXTENSIONS OF TIME TO OPPOSE

thirty-day opposition period following publication of the subject mark, in the case of a first request, or prior to the expiration of the previous extension, in the case of a request for a further extension. *See In re Su Wung Chong*, 20 USPQ2d 1399 (Comm'r 1991); *In re Software Development Systems, Inc.*, 17 USPQ2d 1094 (Comm'r 1989); *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093 (Comm'r 1990); and *In re Spang Industries, Inc.*, 225 USPQ 888 (Comm'r 1985).

While a request for an extension of time to oppose must be signed, an unsigned request will not be refused consideration if a signed copy is submitted to the PTO within the time limit set in the written notification of this defect by the Board. *See* 37 CFR §2.119(e) and TBMP §106.02.

209 Action by Board on Request

209.01 Obtaining Application File

When a first request for an extension of time to oppose is received by the Board, the Board pulls the file of the involved application from issue. The application file generally is retained at the offices of the Board until all Board proceedings relating to the application have ended, that is, until the opposition period has expired without any opposition having been filed, or until all Board inter partes proceedings involving the application have been finally determined. Thereafter, the application is either sent to issue (if no opposition was filed, or if all oppositions filed were dismissed, and the decision in any interference or concurrent use proceeding was favorable to applicant), or stamped "ABANDONED" and sent to the PTO warehouse for storage (if an opposition was sustained, or if the decision in an interference or concurrent use proceeding was unfavorable to applicant).

The file of an application which is the subject matter of an opposition, an extension of time to oppose, an interference, or a concurrent use proceeding, is readily available at the offices of the Board for public inspection and copying. However, 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*. *See* TBMP §121.01.

EXTENSIONS OF TIME TO OPPOSE

209.02 Notification of Action on Request

A request for an extension of time to oppose is examined by a member of the Board's administrative staff. Ordinarily, if the request is granted, it is stamped "APPROVED"; marked with both the date of approval and the date of expiration of the extension granted; and signed by the administrative staff member who granted it. One copy of the approved extension request is placed in the file of the subject application, one copy is mailed to the potential opposer, and one copy is mailed to the applicant.

Sometimes it is necessary for the administrative staff member to prepare a letter in connection with an extension that is being granted, as, for example, when the extension granted is shorter than that sought because a request for a further extension shows good cause for only part, rather than all, of the requested extension. In such a case, one copy each of the request and letter is placed in the file of the subject application, one copy of each is mailed to the applicant, and a copy of the letter is mailed to the potential opposer.

If a request for an extension of time to oppose is denied, a letter stating the reason(s) for the denial is prepared by the administrative staff member. One copy each of the request and letter is placed in the file of the subject application, one copy of each is mailed to the applicant, and a copy of the letter is mailed to the potential opposer.

209.03 Grant or Denial of Extensions - General Policy

The Board is relatively liberal in granting extensions of time to oppose. A liberal policy is necessary in order to afford potential opposers adequate time to make appropriate investigations and to decide, on the basis of the information so gathered, whether or not to oppose. The policy also allows potential opposers and applicants a reasonable opportunity to negotiate for settlement prior to the filing of an opposition. *Cf. Pickering & Co. v. Bose Corp.*, 174 USPQ 172 (Comm'r 1972).

Balanced against these considerations, however, must be applicant's interest in obtaining a registration quickly; the need of third parties, who may be using marks similar to applicant's and/or own conflicting applications, to know as soon as possible whether or not applicant's application will be opposed and, if so, on what

EXTENSIONS OF TIME TO OPPOSE

basis; and the PTO's interest in minimizing application pendency time. *See In re Universal Card Group Inc.*, 25 USPQ2d 1157 (Comm'r 1992).

In view thereof, the time for filing an opposition will not be suspended, or extended for an inordinate period, pending, for example, the final determination of another proceeding between the potential opposer and the applicant; or the conclusion of unduly prolonged settlement negotiations between them; or the filing of a new application, and prosecution thereof to publication or registration, by the potential opposer or applicant.

When a potential opposer files a request to suspend, or further extend, its time to oppose, pending the final determination of another proceeding between potential opposer and applicant, the request will be granted to the extent that potential opposer will be given a reasonable extension of time to oppose. However, potential opposer will be advised by the Board, in writing, that it is not the practice of the Board to suspend, or extend for an inordinate period, the time for opposing pending the final determination of another proceeding, and that any further request for an extension of time to oppose should be based upon other circumstances.

When a potential opposer files repeated extension requests based upon applicant's consent coupled with an assertion that the parties are negotiating for settlement, the Board ordinarily will require, for extensions aggregating more than 180 days from the date of publication of applicant's mark, that the extension request include also a short summary of the progress of the negotiations. In such a case, potential opposer will be advised by the Board, in writing, that any further extension requests made on the basis of consent and settlement negotiations should include a summary of the progress of the negotiations.

As a general rule, the Board will not grant extensions of time to oppose beyond 360 days from the date of publication, unless settlement has been reached and only needs to be executed. The general rule, however, will be applied flexibly and reasonably, depending upon the circumstances in a given case. For example, if a foreign party is involved, or if parties are trying to settle several cases at once, or if numerous parties are involved, more time may be allowed.

After 120 days from the date of publication of applicant's mark, the Board, as a general rule, will not grant extensions for more than sixty days at a time for requests made without the consent of the applicant, or more than ninety days at a time for requests made with the consent of the applicant. Again, however, the

EXTENSIONS OF TIME TO OPPOSE

general rule will be applied flexibly and reasonably, depending upon the circumstances in a particular case.

209.04 Determination of Extension Expiration Date

The extension expiration date stamped on an approved request, or stated in a letter granting an extension, is the date upon which the extension actually expires, even if that date is a Saturday, Sunday, or a Federal holiday within the District of Columbia. However, if the expiration date falls on a Saturday, Sunday, or a Federal holiday within the District of Columbia, an opposition, or a request for a further extension, filed by the potential opposer on the next succeeding day which is not a Saturday, Sunday, or a Federal holiday will be considered timely. *See* 37 CFR §1.6; *Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310 (Comm'r 1991); and TBMP §112.

A first request for an extension of time to oppose sometimes asks for an extension of "thirty days," but specifies an extension expiration date which is different from the expiration date of the requested thirty days. In this case, the extension, if granted, will be set to expire on the thirtieth day, rather than on the specified date, unless the specified date is beyond thirty days, and good cause has been shown for the time in excess of thirty days. *Cf.* 37 CFR §2.102(c), and TBMP §207.02.

Similarly, a request for a further extension of time to oppose sometimes asks for a certain number of days, but specifies an extension expiration date which is different from the expiration date of the requested number of days. In this case, the extension, if granted, will normally be set to expire on the specified date. However, if part of the extension would fall beyond 120 days from the date of publication, and the request does not meet the 37 CFR §2.102(c) requirements for extensions aggregating more than 120 days from publication (i.e., does not include a showing of extraordinary circumstances; or applicant's written consent; or a statement that applicant has consented, accompanied by proof of service on applicant), the extension, if granted, will be set to expire no later than 120 days from the date of publication. *See Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310 (Comm'r 1991), and *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093 (Comm'r 1990). *See also* 37 CFR §2.102(c), and TBMP §207.03.

EXTENSIONS OF TIME TO OPPOSE

A first request for an extension of time to oppose may seek an extension of more than thirty days, but good cause must be shown for the time in excess of thirty days. *See* 37 CFR §2.102(c); *Kimberly-Clark Corp. v. Paper Converting Industry, Inc.*, 21 USPQ2d 1875 (Comm'r 1991); and TBMP §207.02. If an otherwise proper first extension request seeks an extension of more than thirty days, but does not include a showing of good cause for the time in excess of thirty days, potential opposer will be granted an extension of only thirty days.

A request for a further extension of time to oppose may seek an extension for a period beginning prior to 120 days from the date of publication of the subject mark and ending after the 120th day. If such a request includes a showing of good cause, but does not meet the requirements of 37 CFR §2.102(c) for extensions aggregating more than 120 days from publication (i.e., does not include a showing of extraordinary circumstances; or applicant's written consent; or a statement that applicant has consented, accompanied by proof of service on applicant), any extension granted to potential opposer will be limited to the time for which good cause has been shown, and will end on or before the 120th day after publication. *See* 37 CFR §2.102(c); *Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310 (Comm'r 1991); *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093 (Comm'r 1990); and TBMP §207.03.

When an issue of the *Official Gazette* is mailed late (*see* TBMP §202.03), extensions of time to oppose run from the opposition period expiration date specified in the Commissioner's Notice of the late mailing, and the 120-day period of 37 CFR §2.102(c) runs from the *Official Gazette* mailing date specified in the Notice. The *Official Gazette* mailing date, and the opposition period expiration date, specified in the Commissioner's Notice will be used by the Board as the basis for calculating the expiration date of a first extension of time to oppose, even if an extension request specifies an extension expiration date calculated from the *Official Gazette* cover date. Normally, the dates specified in the Commissioner's Notice will also be used by the Board in calculating the expiration dates of further extensions of time to oppose. However, if a request for a further extension specifies a different extension expiration date, and the request meets the requirements of 37 CFR §2.102, the extension will be set to expire on the specified date.

210 Objections to Request

EXTENSIONS OF TIME TO OPPOSE

Inasmuch as a request for an extension of time to oppose is ex parte in nature, there is no requirement that a copy thereof be served upon the applicant, unless the request seeks an extension beyond 120 days from the date of publication and is based upon an allegation of applicant's oral consent. *See* TBMP §203.04. For the same reason, an applicant is not notified of the filing of an extension request prior to action thereon by the Board. It is not until after the Board has acted upon an extension request that the Board sends the applicant a copy of the request (if there is no proof of service by potential opposer), together with notification of the Board's action thereon.

An applicant may learn of the filing of an extension request, and file objections thereto, before applicant receives anything from the Board relating to the request. This may happen, for example, when potential opposer serves a courtesy copy of the request upon applicant; or when the request is based upon an allegation of applicant's oral consent thereto, so that proof of service upon applicant is a required element of the request. If the objections are received by the Board before it acts upon the request, the Board will consider them in determining the request. If the objections are received after action on the request, and the request has been granted, they will be treated as a request for reconsideration of the Board's action.

An applicant which receives notification from the Board that an extension request has been filed and granted may, if it so desires, submit objections thereto in the form of a request for reconsideration of the Board's action. For information concerning a request for reconsideration of an action of the Board relating to a request for extension of time to oppose, *see* TBMP §211.01.

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

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

EXTENSIONS OF TIME TO OPPOSE

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

211 Relief From Action of Board

211.01 Request for Reconsideration

If an applicant or potential opposer is dissatisfied with an action of the Board relating to a request for an extension of time to oppose, it may file a request for reconsideration of the action, stating the reasons therefor. The request should be filed promptly after receipt by the filing party of the action in question.

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

There is no requirement that a request for reconsideration be served upon the nonfiling party. If there is no indication that service has been made, the Board will send the nonfiling party a copy of the request together with that party's copy of the Board's letter granting or denying the request.

The filing of a request for reconsideration of the denial, or the granting, of a request for an extension of time to oppose does not relieve the potential opposer of the responsibility of filing an opposition, or a request for a further extension of time to oppose, prior to the expiration of the extension which is the subject of the request. *Cf.* 37 CFR §2.89(g).

211.02 Petition to the Commissioner

If an applicant or potential opposer is dissatisfied with an action of the Board relating to a request for an extension of time to oppose, it may file a petition to the Commissioner, pursuant to 37 CFR §2.146, for review of the action in question. *See also* TMEP §§1702 and 1704.

EXTENSIONS OF TIME TO OPPOSE

The petition to the Commissioner must include a statement of the facts relevant to the petition; the points to be reviewed; the action or relief requested; and the requisite fee, as specified in 37 CFR §2.6. Any brief in support of the petition must be embodied in or accompany the petition. If facts are to be proved, the proof must be in the form of affidavits or declarations in accordance with 37 CFR §2.20, and these affidavits or declarations, with any exhibits thereto, must accompany the petition. *See* 37 CFR §2.146(c).

A petition from the denial of a request for an extension of time to oppose must be filed within 15 days from the mailing date of the denial of the request and must be served on the attorney or other authorized representative of the applicant, if any, or on the applicant. Proof of service of the petition must be made as provided in 37 CFR §2.119(a) (*see also* TBMP §§113.03 and 113.04). Applicant may file a response within 15 days from the date of service of the petition. A copy of the response must be served upon the petitioner, with proof of service as provided by 37 CFR §2.119(a). No further paper relating to the petition may be filed. *See* 37 CFR §2.146(e)(1).

Rule 2.146(e)(1), 37 CFR §2.146(e)(1), the provisions of which are summarized in the preceding paragraph, presently makes no reference to a petition from the granting of a request for an extension of time to oppose. However, the provisions of the rule may appropriately be followed in the case of such a petition.

The filing of a petition from the denial, or from the granting, of a request for an extension of time to oppose does not relieve the potential opposer of the responsibility of filing an opposition, or a request for a further extension of time to oppose, prior to the expiration of the extension which is the subject of the petition. That is, if the Commissioner's decision on the petition is favorable to the potential opposer, the term of the extension which was the subject of the petition will run from the expiration of the previously existing period for filing an opposition, not from the date of the Commissioner's decision on the petition. *Cf.* 37 CFR §§2.89(g) and 2.146(g). Any opposition, or request for a further extension of time to oppose, filed by the involved potential opposer during the pendency of the petition to the Commissioner will be held by the Board for appropriate action after determination of the petition. In order to avoid the need for filing repeated requests for further extensions of time to oppose during the pendency of the petition, the potential opposer may simply file, prior to the expiration of the extension which is the subject of the petition, or prior to the expiration of a subsequent extension, a request for a further extension of time to oppose until a

EXTENSIONS OF TIME TO OPPOSE

specified time, such as 30 days, after the Board's action following determination of the petition.

If a petition from the granting of a request for an extension of time to oppose is granted, any opposition or request for further extension of time to oppose filed during or after the extension period in question will be rejected by the Board as untimely.

212 Amendment of Application During or After Extension

212.01 Jurisdiction to Consider Amendment

If a request for an extension of time to oppose is filed, the Board obtains the file of the application and generally retains physical possession thereof until all Board proceedings relating to the application have ended, that is, until the opposition period has expired without any opposition having been filed, or until all Board inter partes proceedings involving the application have been finally determined. However, the Board has no jurisdiction over the application unless and until the application becomes involved in a Board inter partes proceeding. In the absence of an inter partes proceeding, the Board has jurisdiction only over matters relating to the requested extension(s) of time to oppose.

During the time between the publication of a mark in the *Official Gazette* for opposition, and the printing of a certificate of registration (in an application under Section 1(a) or 44 of the Act, 15 U.S.C. §1051(a) or 1126) or notice of allowance (in an application under Section 1(b) of the Act, 15 U.S.C. §1051(b)), the Examining Attorney may approve an amendment to the application under certain conditions, provided that the application is not involved in an inter partes proceeding before the Board. *See* 37 CFR §2.84; *In re MCI Communications Corp.*, 21 USPQ2d 1534 (Comm'r 1991); and TMEP §§1504.01, 1504.03, and 1505 *et seq.*

Thus, if, in an application which is the subject of a request for an extension of time to oppose, an amendment or other paper (such as, a request for republication, a request for reconsideration of a refusal to approve an amendment, etc.) relating to the application is filed by the applicant, and the application is not involved in any Board inter partes proceeding, it is the Examining Attorney who must determine

EXTENSIONS OF TIME TO OPPOSE

the propriety of the amendment or other paper. *See* 37 CFR §2.84, and *In re MCI Communications Corp.*, 21 USPQ2d 1534 (Comm'r 1991).

However, the Board does determine the propriety of a request filed by an attorney or other authorized representative to withdraw as applicant's representative, in an application which is the subject of a request for an extension of time to oppose. The Board has jurisdiction to consider the request to withdraw as representative in such a case, because applicant's representative of record acts in applicant's behalf in matters relating to the requested extension(s) of time to oppose.

212.02 Conditions for Examining Attorney Approval of Amendment

During the time between the publication of a mark in the *Official Gazette* for opposition, and the printing of a certificate of registration (in an application under Section 1(a) or 44 of the Act, 15 U.S.C. §1051(a) or 1126) or notice of allowance (in an application under Section 1(b) of the Act, 15 U.S.C. §1051(b)), an application not involved in an inter partes proceeding before the Board may be amended upon request by the applicant, provided that the amendment does not necessitate issuance of a refusal or requirement by the Examining Attorney. If a refusal or requirement by the Examining Attorney would be needed, the amendment cannot be made unless applicant (1) successfully petitions the Commissioner to restore jurisdiction over the application to the Examining Attorney for consideration of the amendment and further examination, and (2) is able to satisfy any requirement or overcome any refusal asserted in any Office action issued after the restoration of jurisdiction. *See* 37 CFR §2.84(b) and TMEP §§1504.01 and 1505 *et seq.*

Examples of the types of amendments which may be made under the conditions described above include acceptable amendments to the identification of goods, to the drawing, to add a disclaimer, and (in the case of an application under Section 1(a) of the Act, 15 U.S.C. §1051(a), or an application under Section 1(b) of the Act, 15 U.S.C. §1051(b) in which an acceptable amendment to allege use has been filed) to convert an application for an unrestricted registration to one for concurrent registration.

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

EXTENSIONS OF TIME TO OPPOSE

212.03 Form of Amendment

An amendment or other paper relating to an application which is the subject of a request for an extension of time to oppose should be in the normal form for an amendment or other paper relating to an application, except that it should be directed to the attention of the Trademark Trial and Appeal Board (i.e., BOX TTAB NO FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513), because the application file will be in the physical possession of the Board.

212.04 Action by Board--Upon Receipt of Amendment

When an amendment relating to an application which is the subject of a request for an extension of time to oppose is filed in the PTO, it is forwarded within the PTO to the physical location of the application. Normally, the file of such an application will be located at the offices of the Board. After the amendment has been placed in the application file, a Board administrative staff member will prepare a letter acknowledging receipt of the amendment, forwarding the application file to the Examining Attorney for consideration of the amendment, and explaining the effect the filing of the amendment has on the extension of time to oppose. *See, for example, In re MCI Communications Corp.*, 21 USPQ2d 1534 (Comm'r 1991).

For example, if an extension of time to oppose is running when the letter is prepared, the letter will acknowledge receipt of the amendment; note that the amendment requires consideration by the Examining Attorney; state that potential opposer has been granted an extension of time to oppose until a specified date; suspend the running of potential opposer's extension of time to oppose; forward the application to the Examining Attorney for consideration of the amendment; instruct the Examining Attorney to act on the amendment (either by approving it for entry or by telephoning the applicant, explaining why the amendment cannot be approved, and placing a record of the telephone call in the file), and then return the application to the Board; and indicate that after the application has been returned to the Board, proceedings with respect to the potential opposition will be resumed, and further appropriate action will be taken. *See In re MCI Communications Corp.*, 21 USPQ2d 1534 (Comm'r 1991). If the amendment is

EXTENSIONS OF TIME TO OPPOSE

filed during an extension of time to oppose, and the Board's letter will not be ready for mailing prior to the date set for the expiration of the extension, the letter will include a statement that the filing of the amendment prior to the date set for the expiration of the extension served to suspend the running of the extension.

The reason for the suspension of the running of the extension period, in the example above, is that the potential opposer is entitled to know, before it files an opposition, whether or not the amendment has been approved. However, the suspension is solely for the benefit of the potential opposer, that is, to preserve potential opposer's time for opposing until potential opposer has been notified of the disposition of the amendment and has had adequate time thereafter to file an opposition. If, notwithstanding the Board's letter suspending the running of the extension, an opposition is filed prior to the expiration of the extension as originally set, the opposition will not be rejected by the Board as having been filed during the suspension; rather, potential opposer will be deemed to have waived the suspension of the running of its extension, and the opposition will be deemed timely. If the amendment is approved, and opposer does not wish to oppose the application as amended, opposer may request that the opposition not be instituted (or, if already instituted, that the institution be vacated), and that the opposition fee be refunded.

If an amendment is filed after the expiration of potential opposer's extension of time to oppose, and no opposition or request for a further extension of time to oppose has been timely filed, the Board's letter will acknowledge receipt of the amendment; note that the amendment requires consideration by the Examining Attorney; indicate that potential opposer's extension of time to oppose has expired, and that no opposition or request for a further extension of time to oppose has been timely filed; forward the application to the Examining Attorney for consideration of the amendment; and state that the Examining Attorney may treat the amendment in the same manner as any amendment after publication (TMEP §§1504.01 and 1505 *et seq.*), and need not return the application to the Board after consideration of the amendment.

If an amendment is filed prior to action by the Board on a request for an extension of time to oppose, and the request is appropriate for granting, the letter will acknowledge receipt of the request and the amendment; note that the amendment requires consideration by the Examining Attorney; grant the request; suspend the running of the extension period; forward the application to the Examining Attorney for consideration of the amendment; instruct the Examining Attorney to act on the amendment (either by approving it for entry or by telephoning the

EXTENSIONS OF TIME TO OPPOSE

applicant, explaining why the amendment cannot be approved, and placing a record of the telephone call in the file), and then return the application to the Board; and indicate that after the application has been returned to the Board, proceedings with respect to the potential opposition will be resumed, and further appropriate action will be taken.

If an amendment is filed prior to action by the Board on a request for an extension of time to oppose, and the request is not appropriate for granting, the letter will acknowledge receipt of the request and the amendment; note that the amendment requires consideration by the Examining Attorney; deny the request; forward the application to the Examining Attorney for consideration of the amendment; and state that the Examining Attorney may treat the amendment in the same manner as any amendment after publication (TMEP §§1504.01 and 1505 *et seq.*), and need not return the application to the Board after consideration of the amendment.

If an amendment is filed after a request for an extension of time to oppose has been denied by the Board, but before the Board has forwarded the application to issue, the letter will acknowledge receipt of the amendment; note that the amendment requires consideration by the Examining Attorney; indicate that potential opposer's request for an extension of time to oppose has been denied; forward the application to the Examining Attorney for consideration of the amendment; and state that the Examining Attorney may treat the amendment in the same manner as any amendment after publication (TMEP §§1504.01 and 1505 *et seq.*), and need not return the application to the Board after consideration of the amendment.

When the Board's letter is ready for mailing, one copy is placed in the file of the subject application, one copy is mailed to the applicant, and one copy each of the amendment and letter is mailed to the potential opposer. The application is then forwarded to the Examining Attorney for consideration of the amendment.

212.05 Action by Board--After Consideration of Amendment

When an amendment in an application which is the subject of an extension of time to oppose is forwarded to the Examining Attorney for consideration, the Examining Attorney acts on the amendment, either by approving it for entry or by telephoning the applicant, explaining why the amendment cannot be approved, and placing a record of the telephone call in the file. *See In re MCI Communications*

EXTENSIONS OF TIME TO OPPOSE

Corp., 21 USPQ2d 1534 (Comm'r 1991). The Examining Attorney then returns the application to the Board (unless the time for opposing expired prior to the filing of the amendment).

After the application has been returned to the Board, a Board administrative staff member will prepare a letter indicating whether or not the amendment was approved, resuming proceedings with respect to the potential opposition, and taking further appropriate action relating thereto.

For example, sometimes a potential opposer, in a request for an extension of time to oppose or in a separate paper, states that it has agreed not to oppose if applicant's application is amended in a certain manner. If the amendment submitted by applicant conforms to the agreement, and is approved by the Examining Attorney, the Board's resumption letter will indicate that the amendment has been approved; that potential opposer has agreed not to oppose if the amendment is approved; and that the application is accordingly being forwarded to issue. If the amendment was not approved, the letter will so state, and the Board will reset potential opposer's time to oppose (potential opposer is usually allowed thirty days for the purpose; the suspension period is deemed to have commenced with the filing of the amendment; and the running of the 120-day period of 37 CFR §2.102(c) is considered to have been tolled for the length of the suspension, if the suspension began during the 120-day period).

If there is no statement by potential opposer that it will not oppose if the amendment submitted by applicant is approved, the Board's resumption letter will state whether the amendment was approved, and the Board will reset potential opposer's time to oppose (in the manner indicated in the preceding paragraph).

Sometimes an Examining Attorney considering an amendment to an application which is the subject of an extension of time to oppose, does not approve the amendment submitted by the applicant, but instead makes a different amendment by Examiner's Amendment (*see* TMEP §1111). In such a case, the Board, in its resumption letter, will so state; specify the amendment made by Examiner's Amendment; resume proceedings with respect to the potential opposition; and take further appropriate action relating thereto.

When the Board's resumption letter is ready for mailing, one copy is placed in the file of the subject application, one copy is mailed to the applicant, and one copy is mailed to the potential opposer.

EXTENSIONS OF TIME TO OPPOSE

212.06 Amendment During Opposition

If an amendment is filed in an application which is the subject of an opposition, the Board has jurisdiction over the application and will determine the propriety of the amendment. Once an opposition has commenced, the application which is the subject of the opposition may not be amended in substance, except with the consent of the other party or parties and the approval of the Board, or except upon motion granted by the Board. *See* 37 CFR §2.133, and TBMP §514.

213 Effect of Restoration of Jurisdiction

If the Examining Attorney wishes to refuse registration or make a requirement in an application which is the subject of a request for an extension of time to oppose, the Examining Attorney must request the Commissioner to restore jurisdiction over the application to the Examining Attorney for that purpose. *See* 37 CFR §2.84(a) and TMEP §§1504.01 and 1504.02. If the application is also the subject of an opposition, the Examining Attorney's request for jurisdiction must be directed to the Board. *See* 37 CFR §2.130 and TMEP §1504.02.

When a request for jurisdiction is granted in an application for which there is an unexpired extension of time to oppose, the application is no longer subject to the filing of a new opposition, and the restoration of jurisdiction serves to stay the running of the extension period. After the Board learns of the restoration of jurisdiction, a Board administrative staff member will prepare a letter advising potential opposer and applicant thereof and taking further appropriate action. Examples of three such letters are described below.

If the restoration of jurisdiction occurred during the running of an extension of time to oppose, and the Board's letter will be ready for mailing prior to the date set for the expiration of the extension, the letter will inform potential opposer and applicant that jurisdiction over the application has been restored to the Examining Attorney; that the application is no longer subject to the filing of a new opposition; that the running of the extension is suspended pending determination by the Examining Attorney of the registrability of the mark; and that if the application is subsequently approved by the Examining Attorney, and the mark is not republished, potential opposer's time for filing an opposition will be reset.

EXTENSIONS OF TIME TO OPPOSE

One copy of the Board's letter will be placed in the file of the subject application, one copy will be mailed to the applicant, and one copy each of the letter and of the Examining Attorney's Office action will be mailed to the potential opposer. Before the application is sent to the Examining Attorney, the administrative staff member will attach to the front of the file a note reading: "EXAMINER NOTE: IF THIS APPLICATION IS ULTIMATELY APPROVED, APPLICATION FILE MUST BE RETURNED TO TTAB FOR ACTION WITH RESPECT TO EXTENSION OF TIME TO OPPOSE." If the Examining Attorney does subsequently approve the application, and the mark is not republished, the Board administrative staff member will prepare a letter so advising potential opposer and applicant, and resetting potential opposer's time to oppose (potential opposer is usually allowed thirty days for the purpose; the suspension period is deemed to have commenced with the restoration of jurisdiction; and the running of the 120-day period of 37 CFR §2.102(c) is considered to have been tolled for the length of the suspension, if the suspension began during the 120-day period). If the mark is republished, potential opposer's time for opposing will recommence on the date of republication.

If the restoration of jurisdiction occurred during the running of an extension of time to oppose, and the Board's letter notifying potential opposer and applicant of the restoration of jurisdiction will not be ready for mailing prior to the date set for the expiration of the extension, the letter will include a statement that the restoration of jurisdiction prior to the date set for the expiration of the extension served to suspend the running of the extension.

If the restoration of jurisdiction occurred prior to the expiration of the extension sought in a well-taken request for an extension of time to oppose, and the extension request has not yet been determined when the Board's letter is being prepared, the Board, in its letter, will inform potential opposer and applicant that jurisdiction over the application has been restored to the Examining Attorney; state that the application is no longer subject to the filing of a new opposition; grant the extension request; suspend the running of the extension pending determination by the Examining Attorney of the registrability of the mark; and indicate that if the application is subsequently approved by the Examining Attorney, and the mark is not republished, potential opposer's time for filing an opposition will be reset.

214 Effect of Republication

EXTENSIONS OF TIME TO OPPOSE

The Examining Attorney may determine that the mark in an application which is the subject of a request for an extension of time to oppose must be republished. This may happen, for example, when the mark was originally published in the wrong class; when the goods or services, although properly identified in the application itself, were published incorrectly; when a disclaimer was mistakenly included, or not included, in the original publication; or when the application has been amended after publication (but before the filing of an opposition), and the amendment is of such nature as to require republication (*see* TMEP §1505.01).

If a mark is republished by order of the Examining Attorney, any opposition filed during the original thirty-day opposition period, or within a granted extension thereof, is considered by the Board to be timely. If the change reflected in the republication is one which might have an effect upon the opposition, the Board will notify opposer and applicant, in writing, of the republication, and of the reason therefor; explain that the opposition will be determined on the basis of applicant's correct (or amended) mark, goods or services, disclaimer status, etc.; and allow opposer time to indicate whether it wishes to proceed with the opposition on that basis, or to have its opposition fee refunded, and the opposition not instituted.

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

If there has been an error in the first publication, or the application has been amended thereafter, republication is often necessary in order to give potential opposers fair notice of the registration sought by applicant. Sometimes, however, a mark which has been published correctly, and has not been amended thereafter, is republished not because there is any need for republication, but by inadvertence. When there is no need for republication, and a mark is republished solely by mistake (as, for example, when an application has survived an opposition, and is

EXTENSIONS OF TIME TO OPPOSE

ready to go to issue, but is inadvertently sent to publication rather than to issue), the application may not properly be subjected to another opposition period.

Accordingly, when it comes to the attention of the Board that an application has been republished by mistake, the Board will not entertain any opposition or request for an extension of time to oppose filed in response to the republication. An opposition filed in response to the inadvertent republication will be returned to the opposer, and the opposition fee will be refunded. The remedy of a would-be opposer or potential opposer in such a case lies in the filing of a petition for cancellation, under Section 14 of the Act, 15 U.S.C. §1064, after applicant's registration has been issued.

215 Effect of Letter of Protest

A third party which has knowledge of facts bearing upon the registrability of a mark in a pending application may bring such information to the attention of the PTO by filing, with the Director of the Trademark Examining Groups, a "letter of protest," that is, a letter which recites the facts and which is accompanied by supporting evidence. *See* TMEP §1116; *In re BPJ Enterprises Ltd.*, 7 USPQ2d 1375 (Comm'r 1988); and *In re Pohn*, 3 USPQ2d 1700 (Comm'r 1987). The Director will determine whether the letter of protest should be "granted," that is, whether the information should be given to the Examining Attorney for consideration. *See* TMEP §1116. For information concerning the standard applied by the Director in determining whether a letter of protest should be granted, *see* "Changes in Practice Concerning Letters of Protest," 1172 TMOG 93 (March 28, 1995).

A letter of protest may be filed either before or after publication of the subject mark for opposition. However, a letter of protest filed after publication ordinarily must be filed within thirty days after publication in order to be considered timely. *See In re BPJ Enterprises Ltd.*, 7 USPQ2d 1375 (Comm'r 1988); *In re Pohn*, 3 USPQ2d 1700 (Comm'r 1987); and TMEP §1116.02(a). Moreover, even if the Director decides to grant a post-publication letter of protest, the submitted information cannot be considered by the Examining Attorney unless the Commissioner, upon written request by the Director, concurs in the decision to grant the letter of protest and restores jurisdiction over the application to the Examining Attorney. *See* TMEP §1116.02. If the application is the subject of an

EXTENSIONS OF TIME TO OPPOSE

opposition, the request for jurisdiction should be directed to the Board. *See* 37 CFR §2.130 and TMEP §1504.02.

The filing of a letter of protest after publication does not serve to stay the time for filing an opposition to the subject mark. *See* TMEP §1116. If a party which files a letter of protest after publication wishes to preserve its right to oppose in the event that the letter of protest is denied, it must file a timely request for an extension of time to oppose. *Cf. In re BPJ Enterprises Ltd.*, 7 USPQ2d 1375 (Comm'r 1988).

If a potential opposer indicates, in a first or a subsequent request for an extension of time to oppose, that potential opposer filed a letter of protest (not yet determined by the Director) with respect to the subject mark within thirty days after publication, the Board will grant the extension request, if otherwise appropriate, and then suspend the running of the extension pending determination of the letter of protest.

The Board will not suspend the running of an extension of time to oppose pending the determination of a letter of protest if the letter of protest was filed by a third party, or was filed more than thirty days after publication of the subject mark, or if the filing of the letter of protest is not brought to the attention of the Board.

If a potential opposer indicates, in a first or a subsequent request for an extension of time to oppose, that potential opposer filed a letter of protest (not yet determined by the Director) with respect to the subject mark more than thirty days after publication, the Board will consider such filing to be good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark, but will not consider the filing to constitute extraordinary circumstances justifying an extension of time beyond 120 days from publication. The filing by a third party of a letter of protest (not yet determined by the Director), with respect to a mark which is the subject of a request for an extension of time to oppose, will not be considered by the Board to constitute good cause for the granting of an extension to the potential opposer.

Following determination of a letter of protest filed with respect to an application which is the subject of a request for an extension of time to oppose, the Board will take further appropriate action. Two examples are described below.

Often, when the application comes to the Board for further appropriate action, the letter of protest has been granted; jurisdiction over the application has been

EXTENSIONS OF TIME TO OPPOSE

restored to the Examining Attorney; the Examining Attorney has issued an Office action asserting a refusal or a requirement; and an extension of time to oppose is running, or the running of the extension has been suspended pending determination of the letter of protest. In such a case, a Board administrative staff member will prepare a letter notifying potential opposer and applicant that the letter of protest has been granted; that jurisdiction over the application has been restored to the Examining Attorney; that an Office action has been issued; that the application is no longer subject to the filing of a new opposition; that the running of the extension is suspended pending determination by the Examining Attorney of the registrability of applicant's mark; and that if the application is subsequently approved by the Examining Attorney, and the mark is not republished, potential opposer's time for filing an opposition will be reset. One copy of the Board's letter will be placed in the file of the subject application, one copy will be mailed to the applicant, and one copy each of the letter and of the Examining Attorney's Office action will be mailed to the potential opposer. If the Examining Attorney does subsequently approve the application, and the mark is not republished, a Board administrative staff member will prepare a letter so advising potential opposer and applicant, and resetting potential opposer's time to oppose (potential opposer is usually allowed thirty days for the purpose; and the running of the 120-day period of 37 CFR §2.102(c) is considered to have been tolled for the length of the suspension, if the suspension began during the 120-day period).

If the running of the extension of time to oppose has been suspended pending the determination of a letter of protest, and the letter of protest is denied, the Board's letter will so advise potential opposer and applicant, and will reset potential opposer's time to oppose (again, potential opposer is usually allowed thirty days for the purpose; and the running of the 120-day period of 37 CFR §2.102(c) is considered to have been tolled for the length of the suspension, if the suspension began during the 120-day period).

216 Inadvertently Issued Registration

Sometimes a registration is issued, mistakenly, from an application which, at the time of such issuance, is the subject of an unexpired extension of time to oppose, or a timely opposition. Such a registration is called an "inadvertently issued" registration.

EXTENSIONS OF TIME TO OPPOSE

The Board is without authority, within the context of either an extension of time to oppose, or an opposition proceeding, to cancel an inadvertently issued registration and restore it to application status. Rather, it is the Commissioner who has such authority, and the Commissioner exercises this authority with caution. *See In re Trademark Registration of Mc Lachlan Touch Inc.*, 6 USPQ2d 1395 (Comm'r 1987).

Accordingly, when it comes to the attention of the Board that a registration has issued inadvertently from an application which is the subject of an unexpired extension of time to oppose, or a timely opposition, the Board will forward the registration file to the Commissioner for such action as the Commissioner deems appropriate. The Commissioner, in turn, may either cancel the registration as inadvertently issued, and restore it to application status, or decline to do so.

If the Commissioner cancels, and restores to application status, a registration which issued inadvertently during an extension of time to oppose, the Board will reset potential opposer's time to oppose. In such cases, the running of potential opposer's extension of time to oppose is deemed to have been suspended by the inadvertent issuance of the registration, because a potential opposer cannot file an opposition to an issued registration. When potential opposer's time to oppose is reset, potential opposer normally will be allowed thirty days for the purpose; and the running of the 120-day period of 37 CFR §2.102(c) is considered to have been tolled for the length of the suspension, if the suspension began during the 120-day period. *See In re Siemens Aktiengesellschaft*, 34 USPQ2d 1862 (Comm'r 1995). Potential opposer and applicant will be informed of the inadvertent issuance of the registration; its cancellation by the Commissioner; and the resetting of potential opposer's time to oppose, in a letter prepared by a Board administrative staff member.

If a registration issued inadvertently during an extension of time to oppose is not cancelled by the Commissioner, and restored to application status, any opposition which may have been filed by the potential opposer will be returned; any submitted opposition fee will be refunded; and potential opposer may have remedy by way of a petition to cancel the registration.

If a registration issues inadvertently during a timely opposition, the Commissioner normally will cancel the registration as inadvertently issued, and restore it to application status. However, if the opposition has already been finally determined in applicant's favor when the inadvertent issuance is discovered, applicant may

EXTENSIONS OF TIME TO OPPOSE

either keep the registration, or request that it be cancelled as inadvertently issued, restored to application status, and then reissued.

217 Relinquishment of Extension

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

If a potential opposer which has requested or obtained an extension of time to oppose thereafter agrees unconditionally, in writing, not to oppose, applicant may submit a copy of the agreement to the Board, with an appropriate cover letter bearing proof of service upon potential opposer, and the Board will immediately forward the subject application to issue. *Cf.* TBMP §211.05.

218 Abandonment of Application

If an applicant files an express abandonment of an application which is the subject of a pending request for an extension of time to oppose, or of a granted extension, the application stands abandoned and any pending request for an extension of time to oppose is moot. An application which has been abandoned is no longer subject to the filing of a new opposition. Any opposition filed on or after the filing date of the abandonment will be returned by the Board to the opposer, and the opposition fee will be refunded. *See Societe des Produits Nestle S.A. v. Basso Fedele & Figli*, 24 USPQ2d 1079 (TTAB 1992), and *In re First National Bank of Boston*, 199 USPQ 296 (TTAB 1978). *Cf.* TBMP §§307.11 and 602.01.

The express abandonment of an application which is not the subject of an inter partes proceeding before the Board (e.g., an opposition, interference, or concurrent use proceeding) is without prejudice to the applicant; it is not necessary that applicant obtain a potential opposer's consent thereto. *See* 37 CFR §2.68.

In contrast, after the commencement of an opposition, interference, or concurrent use proceeding, if applicant files an express abandonment of its application or

EXTENSIONS OF TIME TO OPPOSE

mark without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant. *See* 37 CFR §2.135. However, if an applicant files an abandonment after the commencement of an opposition, interference, or concurrent use proceeding, but before applicant has been notified thereof by the Board, applicant will be given an opportunity to obtain the written consent of every adverse party, or to withdraw the abandonment and litigate the proceeding, failing which judgement shall be entered against applicant. *See In re First National Bank of Boston*, 199 USPQ 296 (TTAB 1978). *Cf.* TBMP §§307.11 and 602.01.

An applicant which wishes to expressly abandon its application may do so by filing in the PTO a written statement of abandonment or withdrawal of the application, signed by the applicant or by the applicant's attorney or other authorized representative. *See* 37 CFR §2.68.

When an applicant files an express abandonment of an application which is the subject of a pending request for an extension of time to oppose, or of a granted extension, a Board administrative staff member will prepare a letter acknowledging receipt of the abandonment, and notifying potential opposer that the application is no longer subject to the filing of a new opposition.

219 Amendment to Allege Use; Statement of Use

An amendment to allege use under Section 1(c) of the Act, 15 U.S.C. §1051(c), filed in an intent-to-use application (i.e., an application under Section 1(b) of the Act, 15 U.S.C. §1051(b)) after approval for publication is late-filed. *See* 37 CFR §2.76(a); "Waiver of Trademark Rule 2.76(a)," 1156 TMOG 12 (November 2, 1993); and *In re Sovran Financial Corp.*, 25 USPQ2d 1537 (Comm'r 1992). Thus, *an amendment to allege use filed during an extension of time to oppose, or during an opposition, is late-filed.*

A statement of use under Section 1(d) of the Act, 15 U.S.C. §1051(d), is premature if it is filed in an intent-to-use application prior to the issuance of a notice of allowance under Section 13(b)(2) of the Act, 15 U.S.C. §1063(b)(2). *See* Section 1(d)(1) of the Act, 15 U.S.C. §1051(d)(1), and 37 CFR §2.88(a). A notice of allowance is issued in an intent-to-use application (for which no amendment to allege use has been timely filed and accepted) only after the time for opposing has expired, and all oppositions filed have been dismissed. *See* Section 13(b)(2) of the

EXTENSIONS OF TIME TO OPPOSE

Act, 15 U.S.C. §1063(b)(2), and 37 CFR §2.81(b). Thus, *a statement of use filed during an extension of time to oppose, or during an opposition, is premature.*

Any late-filed amendment to allege use, or premature statement of use, will be returned to the applicant, and any fee submitted therewith will be refunded. *See* 37 CFR §§2.76(a) and 2.88(a).

If an intent-to-use application has already been published, and is the subject of an extension of time to oppose, when a timely filed amendment to allege use (i.e., an amendment to allege use filed prior to approval for publication) is associated with the application, the Board will suspend the running of any granted extension and return the application to the Trademark Examining Attorney for appropriate action with respect to the amendment to allege use. The Examining Attorney, in turn, will process the amendment to allege use in the same manner (described in TMEP §1105.05(a)(i)(A)) as any other timely filed amendment to allege use which is not associated with the application file until after publication. In the event that the amendment to allege use is ultimately withdrawn by the applicant, or approved by the Examining Attorney, the application should be returned by the Examining Attorney to the Board (prior to any scheduled republication of applicant's mark) for further appropriate action with respect to the extension of time to oppose. *See* TMEP §1105.05(a)(i)(A). If the application is abandoned while it is before the Examining Attorney, the Board should be notified.

If an intent-to-use application has already been published, and is the subject of an opposition, when a timely filed amendment to allege use (i.e., an amendment to allege use filed prior to approval for publication) is associated with the application, the Board normally will suspend the opposition and return the application to the Trademark Examining Attorney for appropriate action (as described in TMEP §1105.05(a)(i)(A)) with respect to the amendment to allege use. In the event that the amendment to allege use is ultimately withdrawn by the applicant, or approved by the Examining Attorney, the application should be returned by the Examining Attorney to the Board (prior to any scheduled republication of applicant's mark) for further appropriate action with respect to the opposition. *See* TMEP §1105.05(a)(i)(A). If the application is abandoned while it is before the Examining Attorney, the Board should be notified.

Sometimes a notice of allowance is issued, mistakenly, in an intent-to-use application which, at the time of such issuance, is the subject of an unexpired extension of time to oppose, or a timely opposition. If a notice of allowance is inadvertently issued in an intent-to-use application which is the subject of an

EXTENSIONS OF TIME TO OPPOSE

unexpired extension of time to oppose, or a timely opposition, and a statement of use is filed, the notice of allowance will be cancelled (by the Intent To Use Division of the Office of Trademark Services) as inadvertently issued, the statement of use will be returned, and the fee submitted therewith will be refunded. If the inadvertently issued notice of allowance has already been cancelled when the Board receives the statement of use, the Board itself will return the statement of use and refund the fee submitted therewith. If the inadvertently issued notice of allowance has not already been cancelled when the Board receives the statement of use, the Intent To Use Division will return the statement of use, and refund the fee, when it cancels the notice of allowance.