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101 Applicable Authority

101.01 Statute and Rules of Practice

All proceedings before the Trademark Trial and Appeal Board ("TTAB" or "Board") are governed by the Lanham Trademark Act of 1946, as amended, ("Act of 1946" or "Act"), 15 U.S.C. § 1051 et seq.; the rules of practice in trademark cases (commonly known as the Trademark Rules of Practice), which may be found in Part 2 of Title 37 of the Code of Federal Regulations ("CFR"); the rules pertaining to assignments in trademark cases, which may be found in Part 3 of 37 CFR; and the rules relating to representation of others before the United States Patent and Trademark Office which may be found in Part 10 of 37 CFR. In addition, Trademark Rule 2.1, 37 CFR § 2.1, makes certain rules of practice in patent cases from Part 1 of 37 CFR applicable to trademark cases. The United States Patent and Trademark Office (USPTO) rules governing procedure in inter partes proceedings before the Board are adapted, in large part, from the Federal Rules of Civil Procedure, with modifications due primarily to the administrative nature of Board proceedings.¹

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

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

101.02 Federal Rules

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

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

² See 37 CFR § 2.116(a).

³ See 37 CFR §§ 2.116(a), 2.120(a), and 2.122(a); *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1753 n.3 (Fed. Cir. 1998); and *Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc.*, 392 F.2d 1021, 13 USPQ2d 1307, 1311 (Fed. Cir. 1989) (In applying the burden of proof provisions of Fed. R. Evid. 301, the court stated "[t]he Federal Rules of Evidence generally apply to TTAB proceedings.").

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

101.03 Decisional Law

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

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

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

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

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

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

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101.04 Director's Orders and Notices

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

102 Nature of Board Proceedings

102.01 Jurisdiction of Board

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

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

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

⁸ See *Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car Inc.*, 62 USPQ2d 1857, 1858 (TTAB 2002), *aff'd*, 300 F.3d 1333, 66 USPQ2d 1811 (Fed. Cir. 2003) (no jurisdiction to decide issues arising under state dilution laws); *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1481 (Fed. Cir. 1990) (cannot adjudicate unfair competition issues); *Ross v. Analytical Technology Inc.*, 51 USPQ2d 1269, 1270 n.2 (TTAB 1999) (no jurisdiction over unfair competition claims); *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1771 n.5 (TTAB 1994) (no jurisdiction over claims of trademark infringement and unfair competition); *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460, 1464 (TTAB 1992) (not empowered to render declaratory judgment); *Andersen Corp. v. Therm-O-Shield Int'l, Inc.*, 226 USPQ 431, 432 n.5 (TTAB 1985) (may not entertain any claim based on Section 43(a) of the Act, 15 U.S.C. 1125(a)); *Electronic Water Conditioners, Inc. v. Turbomag Corp.*, 221 USPQ 162, 163-64 (TTAB 1984) (unfair competition and Section 43(a) claims are outside the Board's jurisdiction); *Hershey Foods Corp. v. Cerreta*, 195 USPQ 246, 252 (TTAB 1977) (determination of whether opposer is guilty of unfair business practices is not within the province of the Board); *Yasutomo & Co. v. Commercial Ball Pen Co.*, 184 USPQ 60, 61 (TTAB 1974) (no jurisdiction to address anti-trust issues); and *American-International Travel Service, Inc. v. AITS, Inc.*, 174 USPQ 175, 179 (TTAB 1972) (no jurisdiction to determine whether opposer violated criminal statute).

But see Loglan Institute Inc. v. Logical Language Group Inc., 962 F.2d 1038, 22 USPQ2d 1531, 1534 (Fed. Cir. 1992) (Board may have erred in stating that it lacked jurisdiction over equitable defenses which were based on allegations of trademark infringement and unfair competition); *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641, 647 (Fed. Cir. 1983) (regarding Board's authority to consider an agreement, its construction, or its validity if necessary to decide the issues properly before it, including the issue of estoppel); and *Knickerbocker Toy Co. v. Faultless Starch Co.*, 467 F.2d 501, 175 USPQ 417, 423 (CCPA 1972) (Board is not precluded from passing on the validity of a copyright if it is necessary to do so in the course of the exercise of its statutory jurisdiction); *M-5 Steel Mfg. Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086 (TTAB 2001) (contractual estoppel considered); *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701, 1702 (TTAB 2000) (noting that by rule change effective

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

102.02 Types of Board Proceedings

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

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

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

An interference is a proceeding in which the Board determines which, if any, of the owners of conflicting applications (or of one or more applications and one or more registrations which are

August 5, 1999, the 1946 Act was amended to allow parties to bring dilution claims under Section 43(c) in opposition and cancellation proceedings); and *British-American Tobacco Co. v. Philip Morris Inc.*, 55 USPQ2d 1585, 1589 (TTAB 2000) (a claim under Article 8 of the Pan American Convention is within the jurisdiction of the Board since it pertains expressly to the registrability of marks and provides for the cancellation of registrations).

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

⁹ *See Harjo v. Pro Football Inc.*, 30 USPQ2d 1828, 1832-33 (TTAB 1994) (no authority to declare provisions of the Act unconstitutional nor to determine whether Section 2(a) is overbroad or vague) and *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1735 n.88 (TTAB 1999); and *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991) (no jurisdiction to determine whether Section 7(c) of the Act, the constructive use provision, violates the commerce clause of the constitution). *See also, for example, Capital Speakers Inc. v. Capital Speakers Club of Washington, D.C. Inc.*, 41 USPQ2d 1030, 1034 n.3 (TTAB 1996) (no authority to determine whether private activities rendered to members of private club constitute "commerce").

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

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

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

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

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

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

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

¹⁴ See 37 CFR § 2.91(a).

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

¹⁶ See TBMP § 1101.01 and authorities cited therein.

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

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

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102.03 General Description of Board Proceedings

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

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

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

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

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

²¹ See 37 CFR § 2.127(c).

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

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103 Location and Address of Board

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

104 Business to be Conducted in Writing

37 CFR § 1.2 All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

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

105 Contact With Board Personnel

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

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

Parties or their attorneys or other authorized representatives may telephone the Board, or come to the offices of the Board, to inquire about the status of a case or to ask for procedural information, but not to discuss the merits of a case or of any particular issue. The telephone number of the

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

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

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Board is (703) 308-9300. If an inquiry involves a particular case, the person making the inquiry should be prepared to give the number of the proceeding or application in question.

106 Identification, Signature, and Form of Papers

106.01 Identification of Papers

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

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

106.02 Signature of Papers

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

37 CFR § 10.14(e) No individual other than those specified in paragraphs (a), (b), and (c) of this section will be permitted to practice before the Office in trademark cases. Any individual may appear in a trademark or other non-patent case in his or her own behalf. Any individual may appear in a trademark case for (1) a firm of which he or she is a member or (2) a corporation or association of which he or she is an officer and which he or she is authorized to represent, if

²⁵ Cf. 37 CFR § 1.5(c).

²⁶ Cf. 37 CFR § 1.5(c).

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such firm, corporation, or association is a party to a trademark proceeding pending before the Office.

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

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

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

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

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

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

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

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

(c) *Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom. Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Director, or the Director's designee, which may include, but are not limited to, any combination of-*

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

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

37 CFR § 1.4(d)(1) *Each piece of correspondence, except as provided in paragraphs (e) and (f) of this section, filed in an application, patent file, trademark registration file, or other proceeding in the Office which requires a person's signature, must:*

- (i) Be an original, that is, have an original signature personally signed in permanent ink by that person; or*
- (ii) Be a direct or indirect copy, such as a photocopy or facsimile transmission (§ 1.6(d)), of an original. In the event that a copy of the original is filed, the original should be retained as evidence of authenticity. If a question of authenticity arises, the Office may require submission of the original; or*
- (iii) Where an electronically transmitted trademark filing is permitted, the person who signs the filing must either:*
 - (A) Place a symbol comprised of numbers and/or letters between two forward slash marks in the signature block on the electronic submission; or*
 - (B) Sign the verified statement using some other form of electronic signature specified by the Director.*

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

37 CFR § 1.4(f) *When a document that is required by statute to be certified must be filed, a copy, including a photocopy or facsimile transmission, of the certification is not acceptable.*

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

²⁷ See 37 CFR §§ 1.4(d); 2.119(e); and 10.18(a).

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Documents filed through the electronic filing systems available at the Board do not require a conventional signature. Instead the party or its representative enters a “symbol” that they have adopted as a signature. The Board will accept *any* combination of letters, numbers, space and/or punctuation marks as a valid signature if it is placed between two forward slash (“/”) symbols.²⁸

A party may act in its own behalf in a proceeding before the Board, or the party may be represented by an attorney or other authorized representative.²⁹ When an individual who is a party to a Board proceeding elects to act in his or her own behalf, the individual must sign any papers that he or she files with the Board. If a party which is a partnership elects to act in its own behalf, papers filed by the partnership should be signed by a partner. If a party which is a corporation or association elects to act in its own behalf, papers filed by the corporation or association should be signed by an officer thereof who is authorized to sign for the corporation or association.³⁰

If a paper is filed on behalf of a party by the party's attorney or other authorized representative, it must bear the signature of, and be signed by, that attorney or other representative, unless it is a paper required to be signed by the party. An attorney or other authorized representative who signs a paper, and then files it with the Board on behalf of a party, should remember that his or her signature to the paper constitutes a certification of the elements specified in 37 CFR § 10.18(b), and that a knowing violation of the provisions of that rule by an attorney or other authorized representative will leave him or her open to disciplinary action.³¹

It is not appropriate for one person to sign a paper for another person, as, for example, "John Smith, for John Doe" or "John Doe, by John Smith."³²

²⁸ See 37 CFR § 1.4(d)(1)(ii). See also TMEP § 804.05.

²⁹ See 37 CFR § 10.14 and TBMP § 114 (Representation of a Party). Cf. 37 CFR § 2.11.

³⁰ See 37 CFR § 10.14(e).

³¹ See 37 CFR § 10.18. Cf. Fed. R. Civ. P. 11 and TBMP § 527.02 (regarding motions for Rule 11 sanctions). See also, for example, *The Clorox Co. v. Chemical Bank*, 40 USPQ2d 1098, 1100 n.9 (TTAB 1996) (accuracy in factual representations is expected). For information concerning the meaning of the designation "other authorized representative," see TBMP § 114.04.

³² See 37 CFR §§ 2.119(e) and 10.18(a). See also *Boyd's Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017 (TTAB 2003) (response to motion to suspend signed by person on behalf of practitioner is inappropriate); *Cerveceria India Inc. v. Cerveceria Centroamericana, S.A.*, 10 USPQ2d 1064, 1067 (TTAB 1989) (Section 8 declaration signed by someone other than named person, while perhaps unacceptable, does not constitute fraud), *aff'd Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989) and *In re Cowan*, 18 USPQ2d 1407, 1409 (Comm'r 1990) (Section 8 declaration in name of sole proprietor, but signed for him by his attorney, not acceptable).

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

In accordance with 37 CFR § 1.4(d) either the original of the signed paper, or a legible copy thereof, may be filed with the Board. If a paper copy is filed, the original should be retained as evidence of authenticity. If a question as to the authenticity of a filed copy arises, the USPTO may require submission of the original.³³

Notwithstanding the requirement that a paper filed before the Board be signed, an unsigned paper will not be refused consideration if a signed copy is submitted to the Board within the time limit set in the notification of this defect by the Board.³⁴

106.03 Form of Papers

Apart from proper identification and signature, there is no particular form which written papers filed in proceedings before the Board must follow. Nor does the USPTO have printed forms for any papers filed in such proceedings. As an aid to litigants, however, the USPTO has prepared suggested formats for certain types of papers filed in Board proceedings. These include the notice of opposition, petition for cancellation, notice of appeal to the Board, designation of domestic representative, certificate of mailing or certificate of transmission under 37 CFR § 1.8(a), and a certificate of service. Copies of all of these formats can be found in an appendix to this manual (Appendix of Forms) and certain formats may also be included in this manual at the place where the particular type of paper or certificate is discussed (e.g., the suggested format for a notice of ex parte appeal to the Board is included in the chapter on ex parte appeals).

Recently the Board has made available the Electronic System for Trademark Trials and Appeals (ESTTA) on the USPTO web site. Using ESTTA, a person can complete and submit forms to the Board over the Internet, making an official filing online, or print out the completed form for mailing to the Board. ESTTA gives step-by-step instructions for properly completing a form. Available forms and instructions can be found at: <http://estta.uspto.gov>.

³³ See 37 CFR § 1.4(d)(1)(ii). For information concerning fax copies, see TBMP § 107.

³⁴ See 37 CFR § 2.119(e).

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A paper filed with the Board may be either the original or a legible copy thereof, on good quality paper.³⁵ Ordinarily, extra copies of a paper should not be submitted.³⁶ In inter partes cases, filings which require more than one copy include: briefs at final hearing must be submitted in triplicate;³⁷ stipulations to extend trial dates should be submitted in multiple form, i.e., one copy for the Board proceeding file plus as many other copies as there are parties;³⁸ and the notice of opposition and petition for cancellation must be submitted in duplicate.³⁹ In addition, requests for extensions of time to oppose should be filed in triplicate.⁴⁰

With the exception of deposition transcripts, exhibits thereto, and inter partes briefs on the case, papers filed with the Board should not be bound.

Prior to trial, discovery requests and responses are not to be submitted to the Board unless filed in conjunction with a motion to compel. The Board no longer accepts written discovery requests with a plaintiff's complaint.

Briefs at final hearing in inter partes cases, briefs on motions, and appeal briefs in ex parte cases, are subject to page limitations and are required to be submitted in typewritten or printed form, double spaced, on letter-size paper.⁴¹ The Board prefers that other papers, too, be submitted in the same format. Letter-size paper is recommended as it is the size preferred by many Federal district courts, and their size preference is significant because review of a final decision of the Board may be had either by way of appeal to the Court of Appeals for the Federal Circuit or by way of civil action in a Federal district court.⁴²

³⁵ See, with respect to fax copies, TBMP § 107.

³⁶ See *DeLorme Publishing Co. v. Eartha's Inc.*, 60 USPQ2d 1222, 1222 n.1 (TTAB 2000) (papers should be filed in single copies only unless otherwise required by rule); *ITC Entertainment Group Ltd. v. Nintendo of America Inc.*, 45 USPQ2d 2021, 2022-23 (TTAB 1998) (unnecessary copies and attachments to motions resulted in undue delay and a waste of Board resources); and *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1708 n.1 (TTAB 1994).

³⁷ See 37 CFR § 2.128(b).

³⁸ See 37 CFR § 2.121(d).

³⁹ See 37 CFR §§ 2.104(a) and 2.112(a).

⁴⁰ See 37 CFR § 2.102(d).

⁴¹ See 37 CFR §§ 2.127(a), 2.128(b) and 2.142(b)(2).

⁴² See Section 21 of the Act of 1946, 15 U.S.C. § 1071; 37 CFR § 2.145; and TBMP §§ 901-903 (Appeals).

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107 How and Where to File Papers and Fees

37 CFR § 1.6 Receipt of correspondence.

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

Correspondence received in the Patent and Trademark Office is stamped with the date of receipt except as follows:

- (1) The Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for correspondence transmitted by facsimile under paragraph (a)(3) of this section, or filed electronically under paragraph (a)(4) of this section, no correspondence is received in the Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.*
- (2) Correspondence filed in accordance with § 1.10 will be stamped with the date of deposit as "Express Mail" with the United States Postal Service.*
- (3) Correspondence transmitted by facsimile to the Patent and Trademark Office will be stamped with the date on which the complete transmission is received in the Patent and Trademark Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the date stamped will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.*
- (4) Trademark-related correspondence transmitted electronically will be stamped with the date on which the Office receives the transmission.*

* * * *

(c) Correspondence delivered by hand.

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

(d) Facsimile transmission.

Except in the cases enumerated below, correspondence, including authorizations to charge a deposit account, may be transmitted by facsimile. The receipt date accorded to the correspondence will be the date on which the complete transmission is received in the Patent and Trademark Office, unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. See § 1.6(a)(3). To facilitate proper processing, each transmission session should be limited to correspondence to be filed in a single application or other proceeding before the Patent and Trademark Office. The application number of a patent or trademark application, the control number of a reexamination proceeding, the interference number of an interference proceeding, the patent number of a patent, or the registration number of a trademark should be entered as a part of the sender's identification on a facsimile cover sheet. Facsimile transmissions are not permitted and if submitted, will not be accorded a date of receipt, in the following situations:

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- (1) Correspondence as specified in § 1.4(e), requiring an original signature;
- (2) Certified documents as specified in § 1.4(f);
- (3) Correspondence which cannot receive the benefit of the certificate of mailing or transmission as specified in § 1.8(a)(2)(i)(A) through (D) and (F), § 1.8(a)(2)(ii)(A), and § 1.8(a)(2)(iii)(A), except that a continued prosecution application under § 1.53(d) may be transmitted to the Office by facsimile;
- (4) Drawings submitted under §§ 1.81, 1.83 through 1.85, 1.152, 1.165, 1.174, 1.437, 2.51, 2.52, or 2.72;
- (5) A request for reexamination under § 1.510, or § 1.913;
- (6) Correspondence to be filed in a patent application subject to a secrecy order under §§ 5.1 through 5.5 of this chapter and directly related to the secrecy order content of the application;
- (7) Requests for cancellation or amendment of a registration under section 7(e) of the Trademark Act, 15 U.S.C. 1057(e); and certificates of registration surrendered for cancellation or amendment under section 7(e) of the Trademark Act, 15 U.S.C. 1057(e);
- (8) Correspondence to be filed with the Trademark Trial and Appeal Board, except the notice of ex parte appeal;
- (9) Correspondence to be filed in an interference proceeding which consists of a preliminary statement under § 1.621; a transcript of a deposition under § 1.676 or of interrogatories, cross-interrogatories, or recorded answers under § 1.684(c); or an evidentiary record and exhibits under § 1.653.

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

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

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

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

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addressed to the Board's mailing address (Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514).

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

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

With the exception of the notice of ex parte appeal to the Board, or in the absence of a specific request by the Board, papers to be filed with the Board may not be filed by facsimile transmission ("fax").⁴³ If papers other than the notice of appeal in an ex parte appeal are filed with the Board by fax transmission, they will not receive a filing date.

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

⁴³ See 37 CFR § 1.6(d)(8).

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When a fax transmission is authorized, the requirements of 37 CFR § 1.6(d) should be met. In addition, it is recommended that the fax cover sheet specify the number of pages being transmitted, and the name, address, fax number, and telephone number of the transmitting party, as well as the proceeding number to which the document pertains.

A document transmitted by fax must be legible. The document that is used as the original for the fax transmission should be retained by the sender as evidence of the content of the transmission.⁴⁴

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

The Board's fax machines are attended between the business hours of 8:30 a.m. and 5:00 p.m., Eastern Standard Time, Monday through Friday, excluding holidays. Normally, the machines may be accessed 24 hours a day. However, there may be times when reception is not possible because of equipment failure or maintenance requirements. Accordingly, persons transmitting correspondence to the Board by fax should be cautious about relying on the availability of this service near time deadlines, such as the end of the six-month period for filing a notice of appeal in an ex parte appeal to the Board.⁴⁵

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

108 Filing Receipts

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

⁴⁴ See 37 CFR § 1.4(d).

⁴⁵ Cf. TMEP § 306.02.

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

When a paper is submitted to the Board by fax transmission, the Board will not formally acknowledge receipt of the paper. However, the Board fax machine usually will confirm to the sending unit that the transmission is complete. Parties are reminded that, with the exception of the notice of ex parte appeal to the Board, or unless otherwise specifically authorized by the Board, papers intended for the Board may not be filed by fax transmission.⁴⁶

109 Filing Date

37 CFR §1.6 Receipt of correspondence.

(a) Date of receipt and Express Mail date of deposit. *Correspondence received in the Patent and Trademark Office is stamped with the date of receipt except as follows:*

- (1) The Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for correspondence transmitted by facsimile under paragraph(a)(3) of this section, or filed electronically under paragraph (a)(4) of this section, no correspondence is received in the Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.*
- (2) Correspondence filed in accordance with § 1.10 will be stamped with the date of deposit as "Express Mail" with the United States Postal Service.*
- (3) Correspondence transmitted by facsimile to the Patent and Trademark Office will be stamped with the date on which the complete transmission is received in the Patent and Trademark Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the date stamped will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.*
- (4) Trademark-related correspondence transmitted electronically will be stamped with the date on which the Office receives the transmission.*

⁴⁶ See 37 CFR § 1.6(d)(8). See also TBMP § 107 (How and Where to File Papers).

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* * * *

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

(d) Facsimile transmission. *Except in the cases enumerated below, correspondence, including authorizations to charge a deposit account, may be transmitted by facsimile. The receipt date accorded to the correspondence will be the date on which the complete transmission is received in the Patent and Trademark Office, unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. See § 1.6(a)(3). To facilitate proper processing, each transmission session should be limited to correspondence to be filed in a single application or other proceeding before the Patent and Trademark Office. The application number of a patent or trademark application, the control number of a reexamination proceeding, the interference number of an interference proceeding, the patent number of a patent, or the registration number of a trademark should be entered as a part of the sender's identification on a facsimile cover sheet. Facsimile transmissions are not permitted and if submitted, will not be accorded a date of receipt, in the following situations:*

- (1) Correspondence as specified in § 1.4(e), requiring an original signature;*
- (2) Certified documents as specified in § 1.4(f);*
- (3) Correspondence which cannot receive the benefit of the certificate of mailing or transmission as specified in § 1.8(a)(2)(i)(A) through (D) and (F), § 1.8(a)(2)(ii)(A), and § 1.8(a)(2)(iii)(A), except that a continued prosecution application under § 1.53(d) may be transmitted to the Office by facsimile;*
- (4) Drawings submitted under §§ 1.81, 1.83 through 1.85, 1.152, 1.165, 1.174, 1.437, 2.51, 2.52, or 2.72;*
- (5) A request for reexamination under § 1.510, or § 1.913;*
- (6) Correspondence to be filed in a patent application subject to a secrecy order under §§ 5.1 through 5.5 of this chapter and directly related to the secrecy order content of the application;*
- (7) Requests for cancellation or amendment of a registration under section 7(e) of the Trademark Act, 15 U.S.C. 1057(e); and certificates of registration surrendered for cancellation or amendment under section 7(e) of the Trademark Act, 15 U.S.C. 1057(e);*
- (8) Correspondence to be filed with the Trademark Trial and Appeal Board, except the notice of ex parte appeal;*
- (9) Correspondence to be filed in an interference proceeding which consists of a preliminary statement under § 1.621; a transcript of a deposition under § 1.676 or of interrogatories, cross-interrogatories, or recorded answers under § 1.684(c); or an evidentiary record and exhibits under § 1.653.*

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

- (1) Promptly filed after the ending of the designated interruption or emergency; and*

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(2) Accompanied by a statement indicating that such correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service.

Correspondence received in the USPTO is stamped with the date of receipt (i.e., the "filing" date) unless the correspondence is filed by the "Express Mail" procedure provided in 37 CFR § 1.10, or by fax transmission (for correspondence which is permitted to be filed by fax) in accordance with 37 CFR § 1.6(d), in which case the correspondence is date-stamped as described below.⁴⁷ The "date of receipt" of correspondence mailed to the USPTO is the date stamped by the Post Office on the mail bags in which the correspondence is delivered to the USPTO.⁴⁸

When correspondence intended for the Board is filed by the "Express Mail Post Office to Addressee" service of the United States Postal Service the paper will be stamped with the "date in" as the date of receipt (unless the "date in" is a Saturday, Sunday, or Federal holiday within the District of Columbia). If the deposit date cannot be determined, the correspondence will be stamped with the date of actual receipt.⁴⁹

If correspondence which is permitted to be filed by fax transmission to the Board is filed by that method with a certificate of transmission in accordance with 37 CFR § 1.8(a), the transmission date specified in the certificate of transmission is used for purposes of determining the timeliness of the correspondence.⁵⁰ The date of receipt of the transmission, as described in 37 CFR § 1.6(a)(3), is used for all other purposes.⁵¹

When correspondence intended for the Board is filed by first-class mail with a certificate of mailing, in accordance with the procedure described in 37 CFR § 1.8(a), it is stamped with the date of receipt of the correspondence in the USPTO, i.e., the date on the mail bags in which the correspondence is delivered to the USPTO. The mailing date specified in the certificate of

⁴⁷ See 37 CFR § 1.6(a).

⁴⁸ See 37 CFR § 1.6(b); *In re Amethyst Investment Group*, 37 USPQ2d 1735 (Comm'r 1995); and *In re Klein*, 6 USPQ2d 1528, 1536 (Dep't Comm. 1986).

⁴⁹ See 37 CFR §§ 1.6(a)(2) and 1.10. See 37 CFR § 1.10 regarding procedures for petitioning the Director for any filing date discrepancy.

⁵⁰ See 37 CFR § 1.8(a). For further information concerning correspondence that may be filed by fax transmission to the Board, see TBMP § 107.

⁵¹ See 37 CFR § 1.8(a). For further information concerning correspondence that may be filed by fax transmission to the Board, see TBMP § 107.

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mailing is used for purposes of determining the timeliness of the correspondence. The date of receipt is used for all other purposes.⁵²

110 Certificate of Mailing or Transmission Procedure

110.01 In General

37 CFR § 1.8 Certificate of mailing or transmission.

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

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

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

(A) Addressed as set out in Sec. 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail; or

(B) Transmitted by facsimile to the Patent and Trademark Office in accordance with Sec. 1.6(d); and

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

(2) The procedure described in paragraph (a)(1) of this section does not apply to, and no benefit will be given to a Certificate of Mailing or Transmission on the following:

(i) Relative to Patents and Patent Applications--

* * * *

(ii) Relative to Trademark Registrations and Trademark Applications--

(A) The filing of a trademark application.

(B)-(F) [Reserved]

(iii) Relative to Disciplinary Proceedings--

(A) Correspondence filed in connection with a disciplinary proceeding under part 10 of this chapter.

(B) [Reserved]

⁵² See 37 CFR §§ 1.6(a) and 1.8(a). For information concerning the date stamped by the USPTO on correspondence when interruptions or emergencies occur in the United States Postal Service, see 37 CFR § 1.6(e).

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

- (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;*
- (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and*
- (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.*

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

Except in certain instances, specified in 37 CFR § 1.8(a), as amplified by 37 CFR § 1.6(d), correspondence required to be filed within a set period of time will be considered as being timely filed, even though the correspondence is not received by the USPTO until after the expiration of the set period, if, prior to the expiration of the set period, (1) the correspondence is mailed to the USPTO by first-class mail, with the proper address, or (for correspondence which is permitted to be filed by fax) is transmitted to the USPTO by fax, in accordance with 37 CFR § 1.6(d), and (2) includes a certificate of mailing or transmission which meets the requirements specified in 37 CFR § 1.8(a).⁵³

In effect, the certificate of mailing or transmission procedure permits certain types of correspondence, as specified in 37 CFR §§ 1.8(a) and 1.6(d), to be sent to the USPTO by first-class mail, or by fax transmission, even on the due date for the correspondence and still be considered timely, notwithstanding the fact that the mailed correspondence will not be received in the USPTO until after the due date, or that the fax transmission may not, because of equipment failure or maintenance requirements, be completed until the next day.⁵⁴

⁵³ See 37 CFR § 1.8(a) and *In re LS Bedding*, 16 USPQ2d 1451, 1452-53 (Comm'r 1990) (certificate of mailing procedure is used to determine timeliness, while the actual receipt date is used for all other purposes, such as an application filing date). See also *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1734 n.2 (TTAB 2001) (no certificate of mailing).

⁵⁴ See *Luemme Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758, 1759 n.1 (TTAB 1999) (motion to extend filed by a certificate of mailing dated next business day was timely).

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However, the USPTO, in its discretion, may require additional evidence to determine if correspondence which bears a certificate of mailing or a certificate of transmission was timely filed, i.e., was mailed or transmitted on the date stated in the certificate.⁵⁵

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

The certificate of transmission procedure is available in Board proceedings only for the filing of a notice of ex parte appeal to the Board.⁵⁶

110.02 Requirements for Certificate

37 CFR § 1.1 Addresses for correspondence with the United States Patent and Trademark Office.

(a) In general. Except as provided in paragraphs (a)(3)(i), (a)(3)(ii) and (d)(1) of this section, all correspondence intended for the United States Patent and Trademark Office must be addressed to either "Director of the United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450" or to specific areas within the Office as set out in paragraphs (a)(1), (a)(2) and (3)(iii) of this section. When appropriate, correspondence should also be marked for the attention of a particular office or individual.

* * * *

(2) Trademark correspondence.

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

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

(ii) Electronic applications. An applicant may transmit an application for trademark registration electronically, but only if the applicant uses the Patent and Trademark Office's electronic form.

⁵⁵ See 37 CFR § 1.8(c); *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293 (TTAB 1997) (where prima facie proof of certificate of mailing is rebutted by other evidence, person signing certificate must submit an affidavit specifying the date of actual deposit); and *In re Klein*, 6 USPQ2d 1547, 1551-52 (Comm'r 1987), *aff'd sub nom. Klein v. Peterson*, 696 F. Supp. 695, 8 USPQ2d 1434 (D.D.C. 1988), *aff'd* 866 F.2d 412, 9 USPQ2d 1558 (Fed. Cir. 1989), *cert. denied*, 490 U.S. 1091, 109 S.Ct. 2432 (1989).

⁵⁶ See 37 CFR §§ 1.6(d) and 1.8(a), and TBMP § 107 (How and Where to File Papers).

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* * * *

(4) Office of Public Records correspondence.

- (i) Assignments.** *All ... trademark-related documents to be recorded by Assignment Services Division, except for documents filed together with a new application or under § 3.81 of this chapter, should be addressed to:*

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

See § 3.27

- (ii) Documents.** *All requests for certified or uncertified copies of patent or trademark documents should be addressed to:*

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

The requirements for filing trademark-related papers (except for trademark-related documents sent to the Assignment Services Division for recordation and requests for certified copies of trademark application and registration documents) by the certificate of mailing or transmission procedure are as follows:⁵⁷

1. *Prior to the expiration of the set period*, the correspondence must be either (i) deposited with the U.S. Postal Service, with sufficient postage as first-class mail, addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514, or (ii) (for correspondence which is permitted to be filed by fax) transmitted to the USPTO by fax, in the manner described in 37 CFR § 1.6(d); and
2. Each piece of correspondence must include a certificate which states the date of deposit or transmission, and is signed (separate and apart from any signature for the piece of correspondence itself) by a person who has a reasonable basis to expect that the correspondence will be mailed or transmitted on or before the date indicated.

Trademark-related documents sent to the Assignment Services Division for recordation should be addressed to: Mail Stop Assignment Recordation Services, Director of the United States

⁵⁷ See 37 CFR § 1.8(a).

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Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450. If a certificate of mailing is used on such correspondence, it should specify that address.

Requests for copies (certified or uncertified) of trademark documents pertaining to applications and registrations are handled by the Certification Division, Office of Public Records. With the exception of coupon orders for uncertified copies of registrations, the address for all such requests mailed to the USPTO is: Mail Stop Document Services, Director of the United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450.⁵⁸

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

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

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

110.03 Suggested Format

Shown below is a suggested format for a certificate of mailing, under 37 CFR § 1.8, for trademark-related mail (except for trademark-related documents sent to the Assignment Services Division for recordation and requests for certified copies of trademark application and registration documents)

Certificate of Mailing

I hereby certify that this correspondence
is being deposited with the United States
Postal Service with sufficient postage as

⁵⁸ See 37 CFR §§ 1.1(a)(4)(i) and (ii).

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first-class mail in an envelope addressed to:

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

on _____
Date Signature

Typed or printed name of
person signing certificate

Shown below is a suggested format for a certificate of transmission under 37 CFR § 1.8:

Certificate of Transmission

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

on _____
Date Signature

Typed or printed name of
person signing certificate

110.04 Location of Certificate

If one of the simple certificate of mailing or certificate of transmission formats shown in TBMP § 110.03 is used, it may be applied by rubber stamp to the first page of the correspondence, if feasible. Otherwise, it should be stamped or typed in its entirety on the last page of the correspondence to which it pertains. If the certificate is typed, and there is not enough room on the last page to type the certificate in its entirety, it should at least be started on the last page, so that only part of it continues over to another page. The simple certificate of mailing or certificate of transmission format should never be used by itself on a separate page at the end of the correspondence. If it is, and the page becomes detached from the rest of the submission, there

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will be no way of determining the identity of the correspondence to which it relates, and the benefit of the certificate will be lost.

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

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

110.05 Loss of Certificate of Mailing

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

110.06 Nonreceipt of Correspondence Bearing Certificate

In the event that correspondence intended for the USPTO is timely filed with an appropriate certificate of mailing or certificate of transmission, pursuant to 37 CFR § 1.8, but is not received in the USPTO, and there is a resulting USPTO action, in a proceeding or an application, which is adverse to the submitting party, the correspondence will be considered timely if the party which submitted it (1) informs the USPTO of the previous mailing or facsimile transmission of the correspondence promptly after becoming aware that the USPTO has no evidence of receipt of the correspondence, (2) supplies an additional copy of the previously mailed or transmitted correspondence and certificate, and (3) includes a statement attesting, on a personal knowledge basis or to the satisfaction of the Director, to the previous timely mailing or transmission. The statement must be verified if it is made by a person other than a practitioner, as defined in 37 CFR § 10.1(r). If the correspondence was appropriate for filing by fax transmission, a copy of the sending fax machine's report confirming transmission may be used to support the statement.⁵⁹

⁵⁹ *See* 37 CFR § 1.8(b).

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If the document is not one authorized to be filed by facsimile transmission, the document will not be accepted.

For lost or misplaced correspondence intended for the Board, the evidence required by 37 CFR § 1.8(b) should be submitted to the Board for consideration. If the requirements of 37 CFR § 1.8(b) cannot be met, the only alternative is a petition to the Director.

110.07 Excluded Filings

The certificate of mailing procedure is not applicable to the filing of certain types of correspondence. The excluded filings include:

- (1) The filing of a trademark application; and
- (2) Certain other filings, as specified in 37 CFR § 1.8(a), which do not pertain to Board proceedings.

The certificate of mailing procedure is applicable to all types of filings in Board proceedings, including a notice of opposition; a petition to cancel; a request for an extension of time to oppose; a notice of appeal to the Board from a final refusal of registration; a notice of appeal to the Court of Appeals for the Federal Circuit from a decision of the Board; and a notice of election (in an inter partes proceeding) to proceed by civil action under Section 21(a)(1) of the Act of 1946, 15 U.S.C. § 1071(a)(1), in response to another party's appeal to the Court of Appeals for the Federal Circuit.

At present, the certificate of transmission procedure is not applicable to any correspondence intended for the Board, except for the notice of appeal in an ex parte appeal to the Board.⁶⁰

110.08 What a Certificate of Mailing or Transmission is Not ...

As is evident from the requirements for a certificate of mailing, specified in 37 CFR § 1.8(a), the certificate of mailing procedure is not the same as mailing by certified mail. Correspondence sent to the Board by certified mail, and not in compliance with the 37 CFR § 1.8(a) requirements for a certificate of mailing, will be stamped with the date of receipt of the correspondence in the USPTO, and that date will be used for all purposes, including the timeliness of the filing of the correspondence.⁶¹

Further, a certificate of mailing or certificate of transmission is not the equivalent of a certificate of service. A certificate of mailing or certificate of transmission indicates when correspondence

⁶⁰ See 37 CFR § 1.6(d). See also TBMP § 107 (How and Where to File Papers).

⁶¹ See 37 CFR §§ 1.6 and 1.8.

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was sent *to the USPTO* pursuant to the provisions of 37 CFR § 1.8(a). The mailing date recited in a certificate of mailing, or the transmission date recited in a certificate of transmission, is used for purposes of determining the timeliness of the filing of the correspondence bearing the certificate. A certificate of service, on the other hand, indicates the date when a copy of the correspondence was served (by hand delivery, first-class mail, "Express Mail," or overnight courier) *upon another party*. A certificate of service cannot be used to prove the timeliness of the filing of the correspondence.⁶²

111 "Express Mail" Procedure

111.01 In General

37 CFR § 1.10 Filing of correspondence by "Express Mail."

(a)

(1) Any correspondence received by the U.S. Patent and Trademark Office (USPTO) that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed with the USPTO on the date of deposit with the USPS, except for documents described in the following paragraphs (a)(1)(i) and (ii) of this section:

* * * *

(2) The date of deposit with the USPS is shown by the "date-in" on the "Express Mail" label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the USPTO receipt date as the filing date. See § 1.6(a).

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

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

⁶² See TBMP § 113 for information concerning a certificate of service.

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

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

- (1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;*
- (2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; and*
- (3) The petition includes a showing which establishes, to the satisfaction of the Director, that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.*

(e) Any person mailing correspondence addressed as set out in § 1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS but not received by the Office, may petition the Director to consider such correspondence filed in the Office on the USPS deposit date, provided that:

- (1) The petition is filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;*
- (2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail";*
- (3) The petition includes a copy of the originally deposited paper(s) or fee(s) that constitute the correspondence showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, a copy of the "Express Mail" mailing label showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section that the requested filing date was*

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the date the correspondence was deposited in the "Express Mail Post Office to addressee" service prior to the last scheduled pickup for that day; and

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

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

Certain papers or fees to be filed in the USPTO, including any paper or fee intended for the Board, can be filed utilizing the "Express Mail Post Office to Addressee" service (not the "Express Mail Post Office to Post Office" service) of the United States Postal Service, and be considered as having been filed in the USPTO on the date appearing on the "date-in" portion of the "Express Mail" mailing label.⁶³

In effect, the "Express Mail" procedure permits all types of correspondence intended for the Board to be sent by the "Express Mail Post Office to Addressee" service even on the due date for the correspondence and still be considered timely, notwithstanding the fact that the mailed correspondence may not be received by the Board until after the due date. This filing procedure applies only to the "Express Mail" of the United States Postal Service, not any third-party carrier that offers overnight delivery.⁶⁴

111.02 Requirements for "Express Mail"

Trademark Rule 1.10(b) provides that prior to the original mailing, the "Express Mail" mailing label number should be placed on correspondence filed under Rule 1.10. The number of the mailing label should be placed on each separate submission and each fee transmitted, either directly on the document or on a separate paper firmly and securely attached to the document.

A party which wishes to send mail to the Board by the "Express Mail" service of the U.S. Postal Service should be careful to use the "Express Mail Post Office to Addressee" service, rather than the "Express Mail Post Office to Post Office" service. Mail sent to the USPTO, pursuant to 37 CFR § 1.10, by the "Express Mail Post Office to Addressee" service of the United States Postal Service is delivered to a USPTO employee. Mail sent to an addressee by the "Express Mail Post

⁶³ See 37 CFR § 1.10(a)(1) and TMEP § 305.03 for "Express Mail" procedures for the Trademark Examining Operation.

⁶⁴ See *In re Pacesetter Group, Inc.*, 45 USPQ2d 1703, 1704 (Comm'r 1994).

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Office to Post Office" service, on the other hand, is sent to a post office near the addressee, where it is held for 15 days for pickup by the addressee and then, if no pickup is made, returned to the sender. The USPTO does not pick up mail from post offices. Thus, correspondence sent to the USPTO by the "Express Mail Post Office to Post Office" service will not reach the USPTO but instead will be returned to the sender.

111.03 Questionable Date of Mailing

If the "date-in" appearing on the "Express Mail" label is illegible, the filing date will be the actual receipt date by the USPTO. If there is a discrepancy between the filing date assigned by the Office and the date of deposit, the person who filed the correspondence may petition the Director to accord the "date-in" date by providing the evidence set forth in 37 CFR §§ 1.10 (c), (d) and (e).⁶⁵

112 Times for Taking Action

37 CFR § 1.7 Expiration on Saturday, Sunday or Federal holiday.

Whenever periods of time are specified in this part in days, calendar days are intended. When the day, or the last day fixed by statute or by or under this part for taking any action or paying any fee in the Patent and Trademark Office falls on Saturday, Sunday or on a Federal holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding day which is not a Saturday, Sunday or a Federal holiday. See § 1.304 for time for appeal or for commencing civil action.

For example, if, as set by the Board, an answer to a complaint falls due on a Saturday, Sunday, or Federal holiday within the District of Columbia, an answer filed on the next business day will be considered timely. If, as set by the Board, the close of discovery falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, written requests for discovery (i.e., interrogatories, requests for production of documents, and requests for admission) may be served, and discovery depositions may be taken, on the next business day. Similarly, if, as set by the Board, the close of a testimony period falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, testimony depositions may be taken, and other evidence may be offered, on the next business day.⁶⁶

If, because of some unscheduled event, such as adverse weather conditions, the USPTO is officially closed by Executive Order of the President or by the Office of Personnel Management

⁶⁵ For further information on petition procedures, see Section 305.03(h) of the TMEP.

⁶⁶ See, for example, *Strang Corp. v. Stouffer Corp.*, 16 USPQ2d 1309, 1310 (TTAB 1990) (when the five-year anniversary date of a registration falls on a weekend or holiday, petition filed on next business day is considered to have been filed within five years from the issue date).

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for an *entire* day, that day will be regarded by the USPTO as a federal holiday within the District of Columbia. Any action due to be taken, or fee due to be paid, on that day, will be considered timely if the action is taken, or the fee paid, on the next succeeding business day on which the USPTO is open. If, because of an unscheduled event, the USPTO is closed for *part* of a business day, but is open for business for some part of the day between 8:30 a.m. and 5:00 p.m., any action due to be taken, or fee due to be paid, on that day remains due on that day.⁶⁷ Notification of any change in this policy, given the particular circumstances of an unscheduled event, will be posted on the USPTO website at www.uspto.gov.⁶⁸

113 Service of Papers

37 CFR § 2.119 Service and signing of papers.

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

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

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

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

⁶⁷ See "Filing of Papers During Unscheduled Closings of the Patent and Trademark Office," 1076 TMOG 6 (March 10, 1987).

⁶⁸ See, for example, "Notifications Related to Security Issues and Emergencies - Emergency Closure – September 11, 2001" posted on the USPTO website.

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

* * * *

113.01 Requirement for Service of Papers

Every paper filed in an inter partes proceeding before the Board, including a notice of appeal from a decision of the Board, must be served by the filing party upon every other party to the proceeding. The only exceptions to this rule are the notice of opposition and petition for cancellation, which are mailed by the Board to the defendant or defendants.⁶⁹

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

113.02 Requirement for Proof of Service

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

⁶⁹ See 37 CFR § 2.119(a).

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or mark without the written consent of every adverse party to the proceeding, judgment shall be entered against the applicant).⁷⁰

113.03 Elements of Certificate of Service

The Board will accept, as prima facie proof that a party filing a paper in a Board inter partes proceeding has served a copy of the paper upon every other party to the proceeding, a statement signed by the filing party, or by its attorney or other authorized representative, clearly stating the date and manner in which service was made. The statement should also specify the name of each party or person upon whom service was made, and the address. The statement must appear on, or be securely attached to, the paper being filed. If the statement is on a separate sheet attached to the paper being filed, it should clearly identify the paper and proceeding to which it relates.⁷¹

Suggested Format

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

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

113.04 Manner of Service

When a party to an inter partes proceeding before the Board files a paper required by 37 CFR § 2.119(a), to be served upon every other party to the proceeding, service may be made in any of the ways specified in 37 CFR § 2.119(b). They are: (1) by hand delivering a copy of the paper to the person being served; (2) by leaving a copy of the paper at the usual place of business of the person being served, with someone in the person's employment; (3) when the person being served has no usual place of business, by leaving a copy of the paper at the person's address, with a member of the person's family over 14 years of age and of discretion; (4) transmission by the "Express Mail Post Office to Addressee" service of the United States Postal Service or by first-class mail, which may also be certified or registered; and (5) transmission by overnight courier.

⁷⁰ See also, for example, *Central Manufacturing Inc. v. Third Millennium Technology Inc.*, 61 USPQ2d 1210, 1212 n.3 (TTAB 2001) (unserved copy of objection to further extensions of time to oppose filed prior to institution of proceeding forwarded to opposer).

⁷¹ See 37 CFR § 2.119(a).

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In addition, whenever it is satisfactorily shown to the Director that none of the specified modes of serving the paper is practicable, service may be made by notice published in the *Official Gazette* of the USPTO.

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

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

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

113.05 Additional Time for Taking Action After Service by Mail

Whenever a party to an inter partes proceeding before the Board is required to take some action within a prescribed period of time after the service of a paper upon that party by another party to the proceeding, and the paper is served by first-class mail, "Express Mail," or overnight courier, the time for taking action is enlarged by 5 days.⁷²

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

⁷² See 37 CFR § 2.119(c).

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

113.06 A Certificate of Service is Not...

A certificate of service is not the equivalent of a certificate of mailing or transmission *for any purpose*.⁷³

114 Representation of a Party

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

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

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

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

⁷³ Cf. TBMP § 110.08 (What a Certificate of Mailing or Transmission is Not...).

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

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

114.01 Party May Represent Itself

A party may represent itself in an ex parte or inter partes proceeding before the Board, or the party may be represented by an attorney or other authorized representative.⁷⁴

If a partnership which is a party to a Board proceeding elects to represent itself, the partnership may act through an individual who is a partner. If a party electing to represent itself is a corporation or an association, the party may act through any individual who is an officer of the party and who is authorized to represent it.⁷⁵

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

114.02 Selection of Attorney

The Board cannot aid a party in the selection of an attorney, nor does the USPTO maintain a register or list of trademark attorneys.⁷⁶

114.03 Representation by Attorney

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

⁷⁴ See 37 CFR § 10.14(e).

⁷⁵ See 37 CFR § 10.14(e).

⁷⁶ See 37 CFR § 2.11.

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registration or recognition to practice before the USPTO in trademark and other non-patent cases.⁷⁷

An attorney, as defined in 37 CFR § 10.1(c), will be accepted as a representative of a party in a proceeding before the Board if the attorney either (1) makes an appearance in the proceeding (as, for example, by filing a paper) on behalf of the party and satisfactorily identifies himself or herself as an attorney,⁷⁸ or (2) files a written power of attorney signed by the party the attorney represents.

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

When an attorney, as defined in 37 CFR § 10.1(c), acting in a representative capacity signs a paper or appears in person in a proceeding before the Board, his or her personal signature or appearance constitutes, inter alia, a representation to the USPTO that, under the provisions of 37 CFR § 10.14 (which specifies the types of individuals who may practice before the USPTO in trademark and other non-patent cases) and the laws of the jurisdiction where the attorney is licensed to practice that he or she is authorized to represent the particular party in whose behalf he or she acts. If there is some question as to whether an individual who makes such an appearance is authorized to act in a representative capacity, further proof of his or her authority may be required.⁷⁹

If a formal power of attorney is filed in a proceeding before the Board, it should state the name and address of the individual or individuals to whom the power is granted, identify the party granting the power, indicate the power being granted (e.g., "to represent Opposer in this proceeding, with full power of substitution and revocation, and to transact all business in the United States Patent and Trademark Office in connection therewith"), and be signed by the party granting the power. The USPTO requires that a power of attorney specify the names of one or more individuals. A power which specifies both the names of one or more individuals and the name of a firm will be regarded as a power to the individual(s).⁸⁰ A power that specifies only the

⁷⁷ See 37 CFR §§ 10.1(c) and 10.14(a), and *Weiffenbach v. Klempay*, 29 USPQ2d 2027, 2031 (Dep't Comm. 1993).

⁷⁸ See *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1613 n.1 (TTAB 1991) (appearance made by filing motion on behalf of respondent).

⁷⁹ See 37 CFR § 2.17(a).

⁸⁰ See, e.g., *HKG Industries Inc. v. Perma-Pipe Inc.*, 49 USPQ2d 1156, 1158 (TTAB 1998) (other named attorneys appointed by petitioner were authorized to represent petitioner and assume responsibility for the case.)

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name of a firm will be regarded not as a power to the firm but rather simply as a designation of an address to which correspondence is to be sent.⁸¹

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

The only non-lawyers permitted to represent others in trademark cases before the USPTO, including proceedings before the Board, are those who were recognized to practice before the USPTO in trademark cases under Chapter 1 of 37 CFR prior to January 1, 1957.⁸² Before such a representative may take any action of any kind in a proceeding before the Board, however, the representative must file in the proceeding a written authorization from the party which he or she represents, or from another person entitled to prosecute the case (e.g., the party's appointed attorney of record).⁸³

114.05 Representation by Foreign Attorney or Agent

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

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

⁸¹ See TMEP § 602.01 and TBMP § 117 (Correspondence – With Whom Held).

⁸² See 37 CFR § 10.14(b); *Weiffenbach v. Klempay*, 29 USPQ2d 2027, 2031 (Dep't Comm. 1993) (patent agent, admitted to practice before the Office in patent cases after January 1, 1957, was excluded from practice before the Office); and *Weiffenbach v. Frank*, 18 USPQ2d 1397, 1400 (Comm'r 1991) (patent agent engaged in unauthorized representation).

⁸³ See 37 CFR § 2.17(b).

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

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

114.06 Individual Not Entitled to Represent Others

An individual who is not entitled, under 37 CFR § 10.14(a), (b), or (c), to practice before the USPTO in trademark cases, will not be permitted to represent a party in a proceeding before the Board.⁸⁴

If it comes to the attention of the Board that an individual who is not entitled, under 37 CFR § 10.14(a), (b), or (c), to practice before the USPTO in trademark cases, is attempting to represent a party in a Board proceeding, the Board will notify the individual that he or she is not entitled to do so. If the individual signs and files a paper on behalf of a party to a Board proceeding, the paper will not be considered unless a new copy thereof, signed by the party or by an authorized representative who is entitled to practice before the USPTO in trademark cases, is filed. Moreover, no Board correspondence intended for the party will be sent to the individual. Rather, such correspondence will be sent by the Board to the party itself, or to the party's attorney or other authorized representative entitled to practice before the USPTO in trademark cases.⁸⁵

114.07 Designation of Domestic Representative

37 CFR § 2.24 Designation of representative by foreign applicant.

If an applicant is not domiciled in the United States, the applicant may designate by a document filed in the United States Patent and Trademark Office the name and address of some person resident in the United States on whom may be served notices or process in proceedings affecting the mark. If the applicant does not file a document designating the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, or if the last person designated cannot be found at the address given in the designation, then notices or process in proceedings affecting the mark may be served on the Director. The mere designation of a domestic representative does not authorize

⁸⁴ For information concerning who is entitled to practice before the USPTO in trademark cases, see TBMP §§ 114.03-114.05. Cf. TMEP § 602.

⁸⁵ See 37 CFR § 2.18 and TBMP § 117 (Correspondence – With Whom Held).

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the person designated to prosecute the application unless qualified under paragraph (a), (b) or (c) of § 10.14 of this subchapter and authorized under § 2.17(b).

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

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

Designation of Domestic Representative

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

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

(Signature of Designating Party)

(Identification of Person Signing)

(Date of Signature)

Once a party has appointed a domestic representative, all correspondence in the case will be sent to the domestic representative, unless the party is represented by an attorney or other authorized

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representative located in the United States, or by a foreign attorney or agent duly qualified under 37 CFR § 10.14(c).⁸⁶

If the party has not appointed a domestic representative and the proceeding is not being prosecuted by an attorney at law or other qualified person, the Office will send correspondence directly to the party, unless the party designates in writing another address to which correspondence is to be sent.⁸⁷

114.08 Adverse Parties Represented by Same Practitioner

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

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

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

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

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

As a general rule, a practitioner (i.e., attorney or other authorized representative) may not represent parties with conflicting interests in proceedings before the USPTO. That is, a practitioner normally may not accept proffered employment, or continue multiple employment, if

⁸⁶ See TBMP § 117.06 (Correspondence with Foreign Party).

⁸⁷ See 37 CFR § 2.119(d).

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the exercise of the practitioner's independent professional judgment on behalf of one client is likely to be adversely affected by the practitioner's representation of another client, or if the employment would be likely to involve the practitioner in representing differing interests.⁸⁸

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

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

It is the responsibility of a practitioner to ensure that there is no violation of the rules cited above. If an impermissible conflict exists, a practitioner should take appropriate action immediately. A practitioner who fails to do so may be subjected to disciplinary action.⁸⁹

115 Conduct of Practitioner

115.01 Applicable Rules

The conduct of an attorney or other authorized representative in proceedings before the Board is governed by Part 10 of 37 CFR. Part 10 contains both Canons (set out in Rules 10.21, 10.30, 10.46, 10.56, 10.61, 10.76, 10.83, 10.100, and 10.110) and Disciplinary Rules (set out in Rules 10.22-10.24, 10.31-10.40, 10.47-10.57, 10.62-10.68, 10.77, 10.78, 10.84, 10.85, 10.87-10.89, 10.92, 10.93, 10.101-10.103, 10.111, and 10.112). Canons are "statements of axiomatic norms, expressing in general terms the standards of professional conduct expected of practitioners in their relationships with the public, with the legal system, and with the legal profession," while

⁸⁸ See 37 CFR §§ 10.66(a) and (b) and *Gilman Corp. v. Gilman Brothers Co.*, 20 USPQ2d 1238, 1240 (Comm'r 1991) (petitioner's former attorney in patent matter not disqualified from representing respondent in trademark cancellation proceeding); *Unico American Corp. v. Unico Banking Group*, 223 USPQ 684, 685 (Comm'r 1984) (opposer has no right to seek disqualification of applicant's counsel based on any possible conflict between applicant and third parties); *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 221 USPQ 1077, 1082 (Comm'r 1984) (attorney was disqualified, but law firm was not); *Plus Products v. Con-Stan Industries, Inc.*, 221 USPQ 1071, 1075 (Comm'r 1984) (attorney representing respondent in an opposition disqualified in view of his previous representation of petitioner in USPTO proceedings and in infringement litigation concerning the same trademark issues); and *Halcon International, Inc. v. Werbow*, 228 USPQ 611, 613 (Comm'r 1980) (attorney representing one party in a patent interference proceeding disqualified in view of his previous representation of the adverse party in connection with a process similar to the process involved in the interference). See also Rules 1.7 and 1.9 of the American Bar Association's Model Rules of Professional Conduct.

⁸⁹ See 37 CFR § 10.20(b).

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Disciplinary Rules are "mandatory in character and state the minimum level of conduct below which no practitioner can fall without being subjected to disciplinary action."⁹⁰

115.02 Disciplinary Proceedings

37 CFR § 1.4 Nature of correspondence and signature requirements.

(d) * * * *

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

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

* * * *

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

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

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

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

⁹⁰ 37 CFR § 10.20.

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

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

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

37 CFR § 10.130 Reprimand, suspension or exclusion.

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

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

By rule change effective December 1, 1997, 37 CFR § 1.4(d)(2) was amended to provide that by presenting a paper to the Office, the signer makes the certifications set forth in 37 CFR § 10.18(b), and is subject to sanctions under 37 CFR § 10.18(c) for violation of 37 CFR § 10.18(b)(2), regardless of whether the party is a practitioner or non-practitioner.⁹¹

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

115.03 Petitions to Disqualify

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

⁹¹ For examples of cases involving disciplined practitioners, see *Klein v. Peterson*, 866 F.2d 412, 9 USPQ2d 1558, 1560 (Fed. Cir. 1989) (patent attorney excluded from practice for certificate of mailing violations); *Weiffenbach v. Logan*, 27 USPQ2d 1870, 1875 (Comm'r 1993) (patent attorney suspended from practice before USPTO for five years for altering an office action in a patent application and engaging in other unethical conduct); and *McCandlish v. Doe*, 22 USPQ2d 1223, 1227 (Comm'r 1992) (patent attorney reprimanded by Commissioner for misrepresenting facts and knowingly allowing documents to remain of record which had been withdrawn).

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Petitions to disqualify practitioners representing parties in ex parte or inter partes cases before the Board are *not* disciplinary proceedings and hence are not governed by 37 CFR §§ 10.130-10.170. Rather, petitions to disqualify are governed by 37 CFR § 10.130(b).⁹²

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

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

116 Termination of Representation

116.01 Revocation of Authority

37 CFR § 2.19 Revocation of power of attorney or of other authorization to represent; withdrawal.

(a) Authority to represent an applicant or a party to a proceeding may be revoked at any stage in the proceedings of a case upon notification to the Director; and when it is so revoked, the Office will communicate directly with the applicant or party to the proceeding or with such other qualified person as may be authorized. The Patent and Trademark Office will notify the person affected of the revocation of his or her authorization.

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

116.02 Withdrawal as Representative--In General

37 CFR § 2.19(b) An individual authorized to represent an applicant or party in a trademark case may withdraw upon application to and approval by the Director.

37 CFR § 10.40 Withdrawal from employment.

(a) A practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office (see §§1.36 and 2.19 of this subchapter). In any event, a practitioner

⁹² *For examples of cases involving petitions to disqualify, see the decisions cited in TBMP § 114.08 (Adverse Parties Represented by Same Practitioner).*

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shall not withdraw from employment until the practitioner has taken reasonable steps to avoid foreseeable prejudice to the rights of the client, including giving due notice to his or her client, allowing time for employment of another practitioner, delivering to the client all papers and property to which the client is entitled, and complying with applicable laws and rules. A practitioner who withdraws from employment shall refund promptly any part of a fee paid in advance that has not been earned.

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

- (1) The practitioner knows or it is obvious that the client is bringing a legal action, commencing a proceeding before the Office, conducting a defense, or asserting a position in litigation or any proceeding pending before the Office, or is otherwise having steps taken for the client, merely for the purpose of harassing or maliciously injuring any person;*
- (2) The practitioner knows or it is obvious that the practitioner's continued employment will result in violation of a Disciplinary Rule;*
- (3) The practitioner's mental or physical condition renders it unreasonably difficult for the practitioner to carry out the employment effectively; or*
- (4) The practitioner is discharged by the client.*

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

- (1) The petitioner's client:*
 - (i) Insists upon presenting a claim or defense that is not warranted under existing law and cannot be supported by good faith argument for an extension, modification, or reversal of existing law;*
 - (ii) Personally seeks to pursue an illegal course of conduct;*
 - (iii) Insists that the practitioner pursue a course of conduct that is illegal or that is prohibited under a Disciplinary Rule;*
 - (iv) By other conduct renders it unreasonably difficult for the practitioner to carry out the employment effectively;*
 - (v) Insists, in a matter not pending before a tribunal, that the practitioner engage in conduct that is contrary to the judgment and advice of the practitioner but not prohibited under the Disciplinary Rule; or*
 - (vi) Has failed to pay one or more bills rendered by the practitioner for an unreasonable period of time or has failed to honor an agreement to pay a retainer in advance of the performance of legal services.*
- (2) The practitioner's continued employment is likely to result in a violation of a Disciplinary Rule;*
- (3) The practitioner's inability to work with co-counsel indicates that the best interests of the client likely will be served by withdrawal;*

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- (4) The practitioner's mental or physical condition renders it difficult for the practitioner to carry out the employment effectively;*
- (5) The practitioner's client knowingly and freely assents to termination of the employment; or*
- (6) The practitioner believes in good faith, in a proceeding pending before the Office, that the Office will find the existence of other good cause for withdrawal.*

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

116.03 When Withdrawal is Mandatory

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

116.04 When Withdrawal is Permissive

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

116.05 Request to Withdraw

A practitioner who wishes to withdraw from employment as the attorney or other authorized representative of a party to a proceeding before the Board must file a written request with the Board for permission to do so. The request to withdraw must be based upon one of the grounds for mandatory or permissive withdrawal listed in 37 CFR §§ 10.40(b) and (c). Moreover, the practitioner must comply with the requirements of 37 CFR § 10.40(a). *See* 37 CFR §§ 2.19(b) and 10.40.⁹³

The propriety of a request for permission to withdraw as counsel in an application which is the subject of a potential opposition is determined by the Board, and not the examining operation.⁹⁴

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

⁹³ *Cf. In re Legendary Inc.*, 26 USPQ2d 1478, 1479 (Comm'r 1992).

⁹⁴ *See* TBMP § 212.01 (Jurisdiction to Consider Amendment).

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117 Correspondence - With Whom Held

37 CFR § 2.18 Correspondence, with whom held.

If papers are transmitted by an attorney at law, or a written power of attorney is filed, the United States Patent and Trademark Office will send correspondence to the attorney at law transmitting the papers, or to the attorney at law designated in the power of attorney. If an application or proceeding is not being prosecuted by an attorney at law, and the applicant, registrant or party to a proceeding before the Office has appointed a domestic representative, the Office will send correspondence to the domestic representative, unless the applicant, registrant or party designates in writing another address to which correspondence is to be sent. If the application or proceeding is not being prosecuted by an attorney and the applicant, registrant or party has not designated a domestic representative, the Office will send correspondence directly to the applicant, registrant or party, unless the applicant, registrant or party designates in writing another address to which correspondence is to be sent. Correspondence will continue to be sent to such address until the applicant, registrant or party, or the attorney or other authorized representative of the applicant, registrant or party, indicates in writing that correspondence is to be sent to another address. The Office will not undertake double correspondence, and if more than one attorney at law or other authorized representative appears or signs a paper, the Office's reply will be sent to the address already established in the record until another correspondence address is specified by the applicant, registrant or party or by the attorney or other authorized representative of the applicant, registrant or party.

37 CFR § 2.24 Designation of representative by foreign applicant.

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

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

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

117.01 In General

Whenever the Board takes an action in a proceeding before it, the Board sends a copy of the action to each party or to the party's attorney or other authorized representative. If a party is domiciled in the United States, such correspondence will be sent to the party at the party's address of record in the proceeding, unless an appearance is made on behalf of the party by an attorney (as defined in 37 CFR § 10.1(c)), or a written power of attorney is filed, or written authorization of some other person entitled to be recognized is filed, or the party designates in writing another address to which correspondence is to be sent. If one of these events occurs, correspondence will be sent not to the party's address of record, but rather to the attorney who makes the appearance, or to the attorney designated in the power of attorney, or to the other person designated in the written authorization, or to the address designated by the party for correspondence.⁹⁵ Correspondence will continue to be sent to such address until the party, or the party's attorney or other representative, indicates in writing that correspondence is to be sent to another address.⁹⁶

The mailing of correspondence in accordance with standard Office mailing procedures creates a presumption of receipt of correspondence.⁹⁷

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

If a power of attorney names more than one individual, and does not specify which of them is to have primary responsibility for the case and receive correspondence, the name(s) of the individual attorney(s) in the signature block of the covering transmittal letter will be used by the Board on the proceeding file, on correspondence for the party, and on the final decision of the Board, to identify counsel for the party, unless the party or one of the named attorneys requests

⁹⁵ See *Societe des Produits Nestle S.A. v. Basso Fedele & Figli*, 24 USPQ2d 1079, 1079 (TTAB 1992) (new power of attorney filed); and *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1613 (TTAB 1991) (appearance made by filing motion in the proceeding).

⁹⁶ See 37 CFR § 2.18.

⁹⁷ See *Jack Lenor Larsen Inc. v. Chas. O. Larson Co.*, 44 USPQ2d 1950, 1953 (TTAB 1997).

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otherwise in writing. This is because the typing of a large number of names on a proceeding file, correspondence, and final decision consumes an excessive amount of space and time, and hence is impractical and burdensome. If there is no transmittal letter, and no other indication as to which of the named attorneys is to have primary responsibility for the case and receive correspondence, the name of the first listed attorney will be used by the Board on the proceeding file, on correspondence for the party, and on the Board's final decision, unless the party or one of the named attorneys requests otherwise in writing.

Double correspondence, that is, the sending of correspondence to two addresses on behalf of a single party, ordinarily will not be undertaken by the Board. If more than one attorney or other authorized representative makes an appearance on behalf of a party, the papers filed by the additional attorney(s) or other authorized representative(s) will be accepted, but the Board will send correspondence to only one of them, to be determined according to the circumstances in the case.⁹⁸

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

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

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

⁹⁸ See 37 CFR § 2.18.

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written power of attorney to another attorney, the Board will send subsequent correspondence to the appointed attorney.

If a power of attorney from a party to one attorney ("A") has been filed, and thereafter A files an "associate power of attorney" to another attorney ("B"), the correspondence address will remain unchanged, and the Board will continue to send correspondence to A, unless A or the party directs otherwise.⁹⁹

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

If oppositions or petitions for cancellation filed by different opposers or petitioners against the same application or registration are consolidated, or if an opposition or petition for cancellation is filed by joint opposers or petitioners, and the different plaintiffs are represented by different attorneys or other authorized representatives, rather than by the same one(s), the Board, in its discretion, may request that the plaintiffs appoint one lead counsel, to whom the Board may send correspondence intended for the plaintiffs.¹⁰⁰ After the lead counsel has been appointed, the Board will send one copy of any forthcoming Board order, decision, or other communication to the applicant or its attorney or other authorized representative, and one copy to plaintiffs' lead counsel. Lead counsel in turn will be responsible for making and distributing copies of such Board correspondence to each plaintiff or its attorney or other authorized representative. In these cases, the lead counsel is not substituted for the separate counsel of each plaintiff, but rather is responsible for coordinating the conduct of the plaintiffs' cases. A Board action requesting the appointment of lead counsel normally includes a detailed explanation of the anticipated duties and responsibilities of lead counsel.

In special circumstances, the Board, in its discretion, may send a particular item of correspondence to more than one address on behalf of a single party. However, the Board will

⁹⁹ Cf. TMEP § 603.

¹⁰⁰ Cf. *Internet Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435, 1436 n.2 (TTAB 1996) (in three proceedings where defendant in one case was one of two plaintiffs in the two other cases, and where each plaintiff retained separate counsel, Board indicated that it would send correspondence to attorneys for the plaintiff which was a party to all three cases unless otherwise advised).

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not send correspondence to more than one address on behalf of a single party on a continuing basis.

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

In the case of a party whose application is the subject of a Board proceeding, any appearance or power of attorney (or designation of other authorized representative) of record in the application file at the time of the commencement of the Board proceeding is considered to be effective for purposes of the proceeding, and correspondence will be sent initially to that address.¹⁰¹ Thereafter, the correspondence address may be changed in appropriate circumstances.

However, in the case of a party whose registration is the subject of a proceeding before the Board, any representation which may be of record in the registration file at the time of the commencement of the Board proceeding is not considered to be effective for purposes of the Board proceeding. Rather, correspondence is sent to the registrant itself or its domestic representative unless and until an attorney makes an appearance in the Board proceeding in the registrant's behalf, or a written power of attorney is filed in the proceeding by the registrant, or written authorization of some other person entitled to be recognized is filed in the proceeding by the registrant, or the registrant designates in writing another address to which correspondence is to be sent.¹⁰²

Changes of attorney addresses or powers of attorney in registration files are accepted by the Office when submitted with post-registration filings, such as those under Sections 7, 8, 9 or 15 of the Act, 15 U.S.C. §§ 1057, 1058, 1059 or 1065; as well as in a cancellation or concurrent use proceeding before the Board. The attorney representing the registrant is responsible for insuring that registrant's correspondence address is updated. Separate address changes for registrants and domestic representatives are accepted by the Office, but global changes of address (when one paper is filed listing all involved registrations) will be returned by the Office.

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

When an attorney is appointed in a power of attorney accompanying an opposition, or makes an appearance by filing an opposition on behalf of the opposer, correspondence will be sent by the Board to that attorney, notwithstanding the fact that another attorney or attorneys may have obtained one or more extensions of time to oppose on behalf of the opposer. If, however, a

¹⁰¹ See 37 CFR § 2.105.

¹⁰² See 37 CFR §§ 2.18 and 2.113.

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power of attorney filed with an opposition names several attorneys, and there is no transmittal letter and no other indication as to which of them is to have primary responsibility for the case and receive correspondence, but one of the named attorneys obtained an extension of time to oppose, correspondence will be sent to that attorney; if none of the named attorneys obtained an extension of time to oppose, correspondence will be sent to the first named attorney. Thereafter, the correspondence address may be changed in appropriate circumstances.

117.05 Correspondence After Revocation or Withdrawal

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

117.06 Correspondence With Foreign Party

If a party to a Board proceeding is not domiciled in the United States and is not represented by an attorney or other authorized representative located in the United States, or by a foreign attorney or agent duly qualified under 37 CFR § 10.14(c), correspondence will be sent to the party's domestic representative, if one has been appointed. If the party has not appointed a domestic representative and the proceeding is not being prosecuted by an attorney or other qualified person, the Office will send correspondence directly to the party, unless the party designates in writing another address to which correspondence is to be sent.¹⁰³

117.07 Change of Address

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

A party or its attorney or other authorized representative should not assume that the inclusion of a new address on a paper directed to another matter, or on the envelope in which the paper is filed, is sufficient to notify the Board of a change of address. Mail sent to the USPTO is opened in the USPTO Mail Room, and ordinarily the envelopes are discarded there before the mail is

¹⁰³ See 37 CFR § 2.119(d).

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sent on to its ultimate destination within the USPTO. Thus, the Board rarely sees the return addresses on the mailing envelopes of papers filed in Board proceedings. Moreover, while it is the normal practice of the Board to check the address on newly filed papers and to change its records to reflect any noted change of address, the Board has no obligation to do so. The responsibility for any failure to receive correspondence due to a change of address of which the Board has not been given separate written notice lies with the party or its attorney or other authorized representative.

117.08 Individual Not Entitled to Represent Others

An individual who is not entitled, under 37 CFR § 10.14(a), (b), or (c), to practice before the USPTO in trademark cases, will not be permitted to represent a party in a proceeding before the Board, and may not file papers on behalf of the party.¹⁰⁴ If it comes to the attention of a Board attorney that such an individual is attempting to represent a party in a Board proceeding, the Board attorney will bring the matter to the attention of the Chief Administrative Trademark Judge, who will coordinate appropriate action with the Office of Enrollment and Discipline. Moreover, no Board correspondence intended for the party will be sent to the individual. Rather, such correspondence will be sent by the Board to the party itself, or to the party's attorney or other authorized representative entitled to practice before the USPTO in trademark cases.¹⁰⁵

118 Payment of Fees

118.01 Lists of Fees and Charges

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

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

118.02 Fees Payable in Advance

37 CFR § 1.22 Fees payable in advance.

(a) Patent and trademark fees and charges payable to the Patent and Trademark Office are required to be paid in advance, that is, at the time of requesting any action by the Office for which a fee or charge is payable with the exception that under § 1.53 applications for patent may be assigned a filing date without payment of the basic filing fee.

¹⁰⁴ Cf. TMEP § 602.03.

¹⁰⁵ See 37 CFR § 2.18.

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(b) All fees paid to the United States Patent and Trademark Office must be itemized in each individual application, patent, trademark registration file, or other proceeding in such a manner that it is clear for which purpose the fees are paid. The Office may return fees that are not itemized as required by this paragraph. The provisions of § 1.5(a) do not apply to the resubmission of fees returned pursuant to this paragraph.

118.03 Method of Payment--In General

37 CFR § 1.23 Method of payment.

(a) All payments of money required for United States Patent and Trademark Office fees, including fees for the processing of international applications (§ 1.445), shall be made in U.S. dollars and in the form of a cashier's or certified check, Treasury note, or United States Postal Service money order. If sent in any other form, the Office may delay or cancel the credit until collection is made. Checks and money orders must be made payable to the Director of the United States Patent and Trademark Office. (Checks made payable to the Commissioner of Patents and Trademarks will continue to be accepted.) Payments from foreign countries must be payable and immediately negotiable in the United States for the full amount of the fee required. Money sent by mail to the Office will be at the risk of the sender, and letters containing money should be registered with the United States Postal Service.

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

It is the practice of the USPTO to routinely accept, as "conditional" payment of a fee, a signed uncertified check. If such a check is returned for insufficient funds, the fee remains unpaid, and the filing date of the fee will be the filing date of any resubmitted adequate payment.¹⁰⁶ An unsigned check will be returned to its sender, but the Director has the discretion to accept such a check, as "conditional" payment, upon petition showing sufficient cause therefor.¹⁰⁷

¹⁰⁶ See *In re Cantatore*, 231 USPQ 742, 744 (Comm'r 1986) (petition to revive was denied because filing fee check was returned for insufficient funds).

¹⁰⁷ See *Dubost v. U.S. Patent and Trademark Office*, 777 F.2d 1561, 227 USPQ 977, 980 (Fed. Cir. 1985), *on remand*, *In re Dubost*, 231 USPQ 887, 889 (Comm'r 1986) (sufficient cause not shown).

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

Papers accompanied by fees may be filed by delivery to the finance window at 2900 Crystal Drive, South Tower Building, Third Floor, Arlington, VA.¹⁰⁸

118.04 Method of Payment--Deposit Accounts

For the convenience of attorneys and the general public in paying fees and charges to the USPTO, deposit accounts may be established in the USPTO.¹⁰⁹ The USPTO has an automated financial system, the Revenue Accounting and Management (RAM) system, which allows transactions to occur over the Internet through the USPTO website at www.uspto.gov. Deposit accounts can be maintained through the Internet and funds replenished using a credit card.

The fees for filing an ex parte appeal to the Board, an opposition, and a petition for cancellation, may all be charged to a deposit account, provided that the requirements of 37 CFR § 1.25 are met. However, the charging of a fee against an account that does not contain sufficient funds to cover it cannot be regarded as payment of the fee.¹¹⁰ Thus, the overdrawn of a deposit account may result in the loss of a vital date.¹¹¹

It is Office policy not to accept ex parte appeals if the notice of appeal is not accompanied by at least a \$100 fee or specific authorization to charge the deposit account for that fee, as opposed to a general authorization which may have been provided when the application was filed. A general authorization to charge a deposit account will only be effective upon petition to the Director.¹¹² Because the general authorization can only be invoked on petition, the Board itself cannot accept the general authorization as a basis for treating the appeal fee as timely submitted.

¹⁰⁸ For further information concerning how and where to file fees, see TBMP § 107.

¹⁰⁹ For information concerning the establishment of a deposit account in the USPTO, see 37 CFR § 1.25.

¹¹⁰ See 37 CFR § 1.25(b).

¹¹¹ See Notice at 824 TMOG 1200 (February 23, 1966).

¹¹² See *In re Sky is the Ltd.*, 42 USPQ2d 1799, 1800 (Comm'r Pats. 1996).

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119 Papers and Fees Generally Not Returnable

119.01 Fee Refunds--General Rule

37 CFR § 1.26 Refunds.

(a) The Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent or trademark filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested, and will not notify the payor of such amounts. If a party paying a fee or requesting a refund does not provide the banking information necessary for making refunds by electronic funds transfer (31 U.S.C. 3332 and 31 CFR part 208), or instruct the Office that refunds are to be credited to a deposit account, the Director may require such information, or use the banking information on the payment instrument to make a refund. Any refund of a fee paid by credit card will be by a credit to the credit card account to which the fee was charged.

(b) Any request for refund must be filed within two years from the date the fee was paid, except as otherwise provided in this paragraph or in § 1.28(a). If the Office charges a deposit account by an amount other than an amount specifically indicated in an authorization (§ 1.25(b)), any request for refund based upon such charge must be filed within two years from the date of the deposit account statement indicating such charge, and include a copy of that deposit account statement. The time periods set forth in this paragraph are not extendable.

* * * *

119.02 Papers and Fees--Ex Parte Cases

After an application has received a filing date, papers filed in connection therewith, including ex parte appeal papers, will not normally be returned.¹¹³

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

¹¹³ See 37 CFR § 2.25.

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

119.03 Papers and Fees--Inter Partes Cases

After an inter partes proceeding before the Board has been filed, papers and other materials filed in connection therewith normally will not be returned, unless filed in contravention of Board rules. Exhibits to testimony and confidential materials filed under a protective order ordinarily are returned after the conclusion of a proceeding, including any appeal period, to the party which filed them.¹¹⁴

However, if because of a defect in an opposition or a petition for cancellation filed with the Board, a proceeding is not instituted, the papers will be returned to the party which filed them, and any fee submitted therewith will be refunded.

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

- (1) If an opposition filed during an extension of time to oppose is in the name of someone other than the person who obtained the extension, and the opposer is unable to show, pursuant to 37 CFR § 2.102(b), that it is in privity with the person who obtained the extension, or that the person in whose name the extension was requested was misidentified by mistake, no proceeding will be instituted, the opposition papers will be returned, and any fee submitted therewith will be refunded.
- (2) If an opposition or a petition for cancellation is filed prematurely (i.e., prior to publication of the subject mark in the *Official Gazette* for purposes of opposition, or prior to issuance of a registration of the subject mark, respectively), no proceeding will be instituted, the papers will be returned, and any fee submitted therewith will be refunded.

¹¹⁴ Cf. TBMP § 806 (Termination of Proceeding).

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(3) If an opposition is filed after the time for opposing has expired; or is filed unsigned, and a signed copy is not submitted within the time limit set in the notification of this defect by the Board; or is filed without the required fee, and the fee is not submitted within the time allowed by the Board; or if the opposed application was abandoned before the opposition was filed.¹¹⁵

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

(1) If a petition to cancel a Principal Register registration that is more than five years old does not allege any ground upon which such a registration can be cancelled (*see* Section 14 of the Act of 1946, 15 U.S.C. § 1064), the cancellation will be instituted and the Board will issue an order to show cause why the petition should not be dismissed for failure to state a claim. Any fee submitted therewith will not be refunded.

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

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

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

120 Access to Files

37 CFR § 2.27(d) Except as provided in paragraph (e) of this section, after a mark has been registered, or published for opposition, the file of the application and all proceedings relating

¹¹⁵ See TBMP § 218 (Abandonment of Application).

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thereto are available for public inspection and copies of the papers may be furnished upon paying the fee therefor.

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

120.01 Nonconfidential Files

Except for materials filed under seal pursuant to a protective agreement, the files of applications and registrations which are the subject matter of pending proceedings before the Board, all pending proceeding files and exhibits thereto, and the files of applications which are the subject matter of "potential oppositions," are available for public inspection and copying at the offices of the Board.¹¹⁶

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

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

The electronic image files on TTABIS are available to the public in the Trademark Search Library.

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

¹¹⁶ See 37 CFR § 2.27.

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120.02 Confidential Materials

Materials filed with the Board under seal pursuant to a protective order entered by any court or by the Board and filed in compliance with TBMP § 412.06, will be kept confidential and will *not* be made available for public inspection or copying unless otherwise ordered by the court or the Board, or unless the party protected by the order voluntarily discloses the matter subject thereto. These materials may be inspected only by those individuals who are entitled, under the terms of the protective order, to have access to the protected information.¹¹⁷

Except for materials filed under seal pursuant to a protective order, the files of applications and registrations which are the subject matter of pending proceedings before the Board and all pending proceeding files and exhibits thereto are available for public inspection and copying. Therefore, only the particular discovery responses, exhibits, deposition transcript pages, or those portions of a brief, pleading or motion which disclose confidential information should be filed under seal pursuant to a protective order. If a party submits any brief, pleading, motion or other such filing containing confidential information under seal, the party must also submit for the public record a redacted version of said papers.¹¹⁸ Confidential materials filed in the absence of a protective order may not be kept confidential by the Board.¹¹⁹

120.03 Files of Terminated Proceedings

When an inter partes proceeding has been finally determined, i.e., when the proceeding is over, the USPTO takes certain further steps based on the final decision, including those steps necessary to give effect to the decision. This process is referred to as the "termination" of the proceeding. For example, when a decision dismissing an opposition has become final, the word "TERMINATED" is stamped on the file of the opposition proceeding, the opposition file is sent to the warehouse where the files of terminated proceedings are stored, and the registration sought by the applicant is issued.¹²⁰

Pursuant to the National Archives retention schedule, terminated inter partes proceeding files which result in a final decision by the Board, e.g., motion for summary judgment, motion to

¹¹⁷ See 37 CFR §§ 2.27(e); 2.120(f), and 2.125(e); and TBMP §§ 412.02 (Protective Orders Upon Stipulation), 526 (Motion for Protective Order) and 703.01(p) (Confidential or Trade Secret Material).

¹¹⁸ See 37 CFR § 2.27(d) and (e); *Duke University v. Haggard Clothing Inc.*, 54 USPQ2d 1443, 1445 (TTAB 2000); and Rany L. Simms, *TIPS FROM THE TTAB: Stipulated Protective Agreements*, 71 Trademark Rep. 653 (1981).

¹¹⁹ See *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1714 (TTAB 1999) (Board agreed to hold exhibits marked confidential for thirty days pending receipt of motion for protective order but advised that in absence of such motion the exhibits would be placed in the proceeding file).

¹²⁰ See TBMP § 806 (Termination of Proceeding).

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dismiss, or final decision on the merits, are transferred to a warehouse for 3 years, then to the Federal Records Center for 27 years and then to the National Archives for permanent retention. All other terminated proceedings are transferred to a warehouse for 3 years and then transferred to the National Records Center where they remain for 27 years before destruction. The files of existing registrations are also stored at the warehouse. The files of cancelled and expired registrations are destroyed two years after the date of cancellation or expiration; the files of abandoned applications are destroyed two years after the date of abandonment. In addition, the files of terminated opposition proceedings numbered from 30,000 through 53,999, and of terminated cancellation proceedings numbered from 1 through 9399, have been destroyed.

An individual who wishes to inspect and/or copy a file stored by the USPTO in a warehouse can go to the Public Service Window located on the second floor of the South Tower building, 2900 Crystal Drive, Arlington, Virginia, and place an order for the file. Alternatively, the individual can order the file electronically from a computer terminal located in the Trademark Search Library, or from a computer terminal located in the Patent Search Room. Within a few days, the USPTO will obtain the ordered file from the warehouse, and make it available to the individual for inspection and/or copying at the Trademark Search Library. The file may not be taken away from the premises of the Trademark Search Library.¹²¹

121 Copying of Files

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

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

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

¹²¹ See TMEP § 109.

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registrations with information as to the current status and title of the registration, and abstracts of title to trademark applications and registrations.

All requests for certified and uncertified copies of trademark documents relating to applications or registrations, including copies of papers from the files of Board proceedings, and abstracts of title, are handled by the USPTO's Document Services, Office of Public Records. A written request (with the required fee) for copies should be addressed to Mail Stop Document Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450. The written request, with fee, may also be hand delivered to the Public Service Window at 2900 Crystal Drive, South Tower Building, Second Floor, Arlington, Virginia 22202-3514; or to the Office of Public Records, Crystal Gateway 4, Third Floor, 1213 Jefferson Davis Highway, Arlington, Virginia 22202-3513; or to the Attorneys' Window at 2201 S. Clark Place, Crystal Plaza Building 4, First Floor, Arlington, Virginia 22202. Finally, if the written request includes an authorization to charge the required fee to a deposit account, the request may be sent by facsimile transmission to (703) 305-8759.¹²² Orders may also be placed over the Internet through the USPTO homepage at www.uspto.gov.

122 Certification

122.01 Court Requirements

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

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

122.02 Certified Copies

Certified copies, bearing a seal, of USPTO proceeding files, including Board proceeding files, or portions thereof, may be ordered from the USPTO's Document Services, Office of Public Records, upon written request and payment of the required fee.¹²³

¹²² See "Notice of a Change in Procedure Regarding Requests for Certification Services," 1165 TMOG 13 (August 2, 1994).

¹²³ See TBMP §§ 121 (Copying of Files) and 122.02 (Certified Copies).

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123 Status Information for Applications, Registrations and Board Proceedings

The USPTO maintains a Trademark Status Line which provides access, by push-button telephone, to current status, status date (i.e., the date that a record entered its current status), and status location information for all active Federal trademark application and registration records maintained in the automated Trademark Reporting and Monitoring (TRAM) System.¹²⁴ The line is available on (703) 305-8747 from 6:30 a.m. until midnight, Eastern Time, Monday through Friday (except for Federal holidays). The Trademark Assistance Center provides general information about the registration process and can also answer status questions. The Center can be reached at 703-308-9000. Trademark application and registration information can also be obtained through the USPTO website at www.uspto.gov and through the Trademark Applications and Registrations Retrieval (TARR) database at <http://tarr.uspto.gov>. The status of Board proceedings and of requests for extensions of time to oppose can be obtained through the Board Information Systems Index (BISX) at www.uspto.gov. Electronic images of proceeding files on TTABIS and the electronic filing system, ESTTA, are both available to the public in the Trademark Library Search Room.

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

124 Action by Assignee

When a mark which is the subject of a Federal application or registration has been assigned, together with the application or registration, in accordance with Section 10 of the Act, 15 U.S.C. § 1060, any action with respect to the application or registration which may or must be taken by the applicant or registrant may be taken by the assignee (acting itself, or through its attorney or other authorized representative), provided that the assignment has been recorded or that proof of the assignment has been submitted.¹²⁵ Similarly, when a mark which is not the subject of a Federal application or registration, but which is owned and pleaded by a plaintiff in a Board inter partes proceeding, has been assigned, the assignee may act in the proceeding (either itself, or through its attorney or other authorized representative) in place of the assignor, provided that proof of the assignment has been submitted in the proceeding.¹²⁶

¹²⁴ See *In re Sovran Financial Corp.*, 25 USPQ2d 1537, 1538 (Comm'r 1992).

¹²⁵ See 37 CFR §§ 3.71 and 3.73(b).

¹²⁶ See TBMP § 512.01 (Assignment of Mark).