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201 In General

15 U.S.C. § 1063 (a) Any person who believes that he would be damaged by the registration of a mark upon the principal register, including as a result of dilution under section 43(c), may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 12 of this Act of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Director for good cause when requested prior to the expiration of an extension. The Director shall notify the applicant of each extension of the time for filing opposition. An opposition may be amended under such conditions as may be prescribed by the Director.

37 CFR § 2.101 Filing an opposition.

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

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

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

* * * *

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

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

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

(c) The written request to extend the time for filing an opposition must be filed in the Patent and Trademark Office before the expiration of thirty days from the date of publication or within any

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

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

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

Similarly, any person who believes that he, she, or it would be damaged by the registration of a mark upon the Principal Register may file a written request to extend the time for filing an opposition.² Requests for extensions of time to oppose are determined by the Board.³

An extension request, though it does not invest the Board with technical jurisdiction over the application, requires the Board to take custody of the file to process the extension. Thus, communications with the Office in regard to an application that is subject to an extended opposition period must be directed to the Board.

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

Other requirements for a request for extension of time to oppose are specified in 37 CFR § 2.102. Moreover, certain requirements for papers filed in inter partes proceedings before the Board also

¹ *See* Section 13(a) of the Act, 15 U.S.C. § 1063(a), and 37 CFR § 2.101. *For further information concerning the filing of an opposition, see* TBMP chapter 300.

² *See* Section 13(a) of the Act, 15 U.S.C. § 1063(a), and 37 CFR § 2.102.

³ *See* 37 CFR § 2.102(c), and *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1075 n.2 (TTAB 1993) (Trademark Rule 2.102(c) delegates the authority to the Board to grant, ex parte, extensions of time to oppose).

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apply to a request for extension of time to oppose. *For information concerning the requirements (other than the time requirement) for a request for extension of time to oppose, see TBMP §§ 203-208.* The Electronic System for Trademark Trials and Appeals (ESTTA) is available for filing extensions of time to oppose electronically. Available forms and instructions can be found at www.uspto.gov.

202 Time for Filing Request

202.01 In General

U.S.C. § 1063 (a) Any person who believes that he would be damaged by the registration of a mark upon the principal register, including as a result of dilution under section 43(c), may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 12 of this Act of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Director for good cause when requested prior to the expiration of an extension. The Director shall notify the applicant of each extension of the time for filing opposition. An opposition may be amended under such conditions as may be prescribed by the Director.

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

A first request for an extension of time to oppose an application for registration of a mark must be filed prior to the expiration of the thirty-day period after publication of the mark in the *Official Gazette*, pursuant to Section 12(a) of the Act, 15 U.S.C. § 1062(a), for purposes of opposition. Any request for a further extension of time to oppose must be filed prior to the expiration of an extension granted to the requesting party or its privy.⁴

The timely filing of documents in the USPTO requires that the documents actually be received in the USPTO within the set time period unless such documents are filed in accordance with 37 CFR §§ 1.8 and 1.10 which provide for filing of papers by certificate of mailing and Express Mail, respectively. Papers filed in accordance with these rules are considered as having been filed on the date of deposit as first class mail or Express Mail even though the mailed

⁴ See Section 13(a) of the Act, 15 U.S.C. § 1063(a), and 37 CFR § 2.102(c). See also *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980) (timeliness of extension requests is statutory and cannot be waived).

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correspondence will not be received in the USPTO until after the due date.⁵ The Express Mail filing procedure applies only to the “Express Mail” of the United States Postal Service, not any third-party carrier that offers overnight delivery.⁶

In the event that a particular extension request is timely filed with an appropriate certificate of mailing, pursuant to 37 CFR § 1.8, but is not received in the USPTO, the correspondence will be considered timely if the party that submitted it supplies an additional copy of the previously mailed extension request and certificate, and includes a statement attesting to the previous timely mailing. The statement must be verified if it is made by a person other than a practitioner, as defined in § 37 CFR 10.1(r).⁷ The only evidence accepted by the Office to prove deposit of the missing extension request is an exact copy of the disputed document including a copy of the executed original certificate of mailing.⁸ A reconstructed request and certificate of mailing will not suffice.

A potential opposer that has requested an extension of time to oppose should not wait until it has received notification from the Board of the grant or denial of the request before filing an opposition or a request for a further extension of time to oppose. If a request for an extension of time to oppose is granted, the length of the granted extension will be no greater (and may be less) than that sought in the extension request. The extension will run from the expiration of the thirty-day opposition period after publication. In the case of a subsequent extension, it will run from the date of expiration of the previously granted extension.⁹ While the Board attempts to notify a potential opposer of the grant of an extension request before a granted extension expires, particularly when the length of the granted extension is less than that requested, the Board is under no obligation to do so, and in many cases cannot.¹⁰

⁵ See *In re Pacesetter Group, Inc.*, 45 USPQ2d 1703, 1704 (Comm’r 1994) and TBMP § 110.01 (Certificate of Mailing or Transmission Procedure).

⁶ See *In re Pacesetter Group, Inc.*, *supra*.

⁷ See 37 CFR § 1.8(b) and TBMP § 110.01 (Certificate of Mailing or Transmission Procedure – In General).

⁸ See *In re Sasson Licensing Corp.*, 35 USPQ2d 1510, 1512 (Comm’r 1995) (a declaration attesting to the filing and to the certificate of mailing is not acceptable as evidence of timely filing).

⁹ See *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093, 1094 (Comm’r 1990).

¹⁰ See *Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310, 1312 (Comm’r 1991) (where misdirection of initial extension prevented Board from addressing calculation error in the request) and *In re Societe Des Produits Nestle S.A.*, *supra* (potential opposer was not notified of partial grant of extension request until after date had passed). Cf. *In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273, 275 (Fed. Cir. 1984) (no statute or regulation imposes obligation on Office to notify parties of defects in sufficient time to allow correction); *In re L.R. Sport Inc.*, 25 USPQ2d 1533, 1534 (Comm’r 1992) (no obligation to notify of defective statement of use); and *In re Application Papers Filed November 12, 1965*, 152 USPQ 194, 195 (Comm’r 1966) (no obligation to discover deficiencies within a specified time).

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202.02 Date of Publication of Mark

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

202.03 Premature Request

Section 13(a) of the Act, 15 U.S.C. § 1063(a), provides that an opposition to the registration of a mark upon the Principal Register may be filed "within thirty days after" the publication of the mark in the *Official Gazette*, pursuant to Section 12(a) of the Act, 15 U.S.C. § 1062(a), for opposition. Section 13(a) also provides for extensions of this time for filing an opposition under certain conditions. Thus, any opposition, and any request for an extension of time to oppose, filed before the publication of the mark sought to be opposed, is premature, and the Board will reject the opposition even if the mark has been published by the time of the Board's action.¹¹

202.04 Late Request

A request for an extension of time to oppose must be filed prior to the expiration of the thirty-day period after publication (for opposition) of the mark which is the subject of the request, in the case of a first request, or prior to the expiration of an extension granted to the requesting party or its privy, in the case of a request for a further extension.¹² Because these timeliness requirements are statutory, they cannot be waived by stipulation of the parties, nor can the Director upon petition waive them.¹³ Accordingly, a first request filed after the expiration of the thirty-day period following publication of the subject mark, or a request for a further extension filed after the expiration of the previous extension granted to the requesting party or its privy, must be denied by the Board as late, even if the applicant has consented to the granting of the late filed request.

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

¹¹ Cf. TBMP §§ 119.03 (Papers and Fees Generally Not Returnable) and 306.03 (Premature Opposition).

¹² See Section 13(a) of the Act, 15 U.S.C. § 1063(a), and 37 CFR §§ 2.102(b) and (c). See also *In re Cooper*, 209 USPQ 670 (Comm'r Pats 1980) and TBMP § 206.02 (regarding further extension requests filed by privy).

¹³ See *In re Sasson Licensing Corp.*, 35 USPQ2d 1510, 1512 (Comm'r 1995) (waiver of Rule 1.8 would effectively waive Section 13 and, in any event, fact that potential opposer did not retain executed hard copies of documents filed with Office and cannot prove document was timely is not an extraordinary circumstance justifying a waiver of Rule 1.8); *In re Kabushiki Kaisha Hitachi Seisakusho*, 33 USPQ2d 1477, 1478 (Comm'r 1994); and *In re Cooper*, 209 USPQ 670, 671 (Comm'r Pats 1980).

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203 Form of Request

203.01 In General

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

* * * *

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

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

A request for an extension of time to oppose must be made in writing.¹⁴ The request should specify the period of extension desired, and should be addressed to the mailing address of the Trademark Trial and Appeal Board (*see* TBMP § 103).

In addition, every request for an extension of time to oppose should be filed in triplicate, so that if the request is approved, it may be so stamped; one copy may be placed in the application file; and the other copies may be mailed to the potential opposer and the applicant.¹⁵ If only a single copy of an extension request is filed, the request will not be refused consideration, but action thereon may be delayed because the Board itself will have to make the extra copies.

203.02 Identifying Information

203.02(a) In General

A request for an extension of time to oppose should bear at its top the heading "IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD," followed by information identifying

¹⁴ *See* Section 13(a) of the Act, 15 U.S.C. § 1063(a), and 37 CFR §§ 2.102(a) and 1.2.

¹⁵ *See* 37 CFR § 2.102(d).

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the application to which the request pertains, namely, the name of the applicant, and the application serial number, filing date, mark, and date of publication in the *Official Gazette*.¹⁶ The request should also bear an appropriate title describing its nature, such as "Request for Extension of Time to Oppose" or "Request for Further Extension of Time to Oppose."

203.02(b) Requirement for Identification of Potential Opposer

A request for an extension of time to oppose must identify the potential opposer with reasonable certainty.¹⁷ If a request for extension of time to oppose fails to identify the potential opposer with reasonable certainty, the Board can allow the defect to be corrected only if the correction is made prior to the expiration of the time for filing the request, that is, before the expiration of the thirty-day opposition period following publication of the subject mark in the case of a first request, or of the previous extension in the case of a request for a further extension.¹⁸

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

203.03 Signature

37 CFR § 2.102(a) *Any person who believes that he would be damaged by the registration of a mark on the Principal Register may file a written request to extend the time for filing an*

¹⁶ Cf. 37 CFR § 1.5(c), and *In re Merck & Co.*, 24 USPQ2d 1317, 1318 (Comm'r 1992) (Board's refusal to institute opposition as untimely was proper where potential opposer had misidentified applicant and serial number in its extension request).

¹⁷ 37 CFR § 2.102(b).

¹⁸ See *In re Spang Industries, Inc.*, 225 USPQ 888, 888 (Comm'r 1985) (since extension request failed to identify any party except attorney filing request, and since privity does not include attorney/client relationship, subsequent notice of opposition was untimely).

Cf. *In re Su Wung Chong*, 20 USPQ2d 1399, 1400 (Comm'r 1991) (inadvertence is not extraordinary circumstance to waive rule requiring that statement indicating consent or showing extraordinary circumstances for extension over 120 days must be submitted at time extension request is filed, not after the fact); *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093, 1094 (Comm'r 1990) (subsequently obtained consent is not sufficient and omission, in itself, is not extraordinary circumstance to waive requirement that consent accompany extension request); and *In re Software Development Systems, Inc.*, 17 USPQ2d 1094, 1095 (Comm'r 1989) (inadvertent oversight does not constitute extraordinary circumstance to waive [former] requirement for proof of service).

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opposition. The written request may be signed by the potential opposer or by an attorney at law or other person authorized, in accordance with §2.12(b) and (c) and §2.17(b), to represent the potential opposer.

A request for an extension of time to oppose may be signed either by the potential opposer or by its attorney or other authorized representative.¹⁹ Under the written signature there should appear the name, in typed or printed form, of the person signing; a description of the capacity in which he or she signs (e.g., as the individual who is the potential opposer, if the potential opposer is an individual; as a corporate officer, specifying the particular office held, if the potential opposer is a corporation; as potential opposer's attorney; etc.); and his or her business address (to which correspondence relating to the request will be sent) and telephone number. Requests for extensions of time to oppose filed through the electronic filing system, ESTTA, 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.²⁰

While a request for an extension of time to oppose must be signed, an unsigned request will not be refused consideration if a signed copy is submitted to the USPTO within the time limit set in the written notification of this defect by the Board.²¹

A potential opposer which has submitted an unsigned request for an extension of time to oppose should not wait until it has submitted a signed copy of the request (in response to the Board's written notification of the defect), and the Board has acted on the request, before filing an opposition or a request for a further extension of time to oppose. If the extension request is ultimately granted, the length of the granted extension will be no greater (and may be less) than that sought in the extension request, and it will run from the expiration of the thirty-day opposition period after publication, in the case of a first request, or from the date of expiration of the previously granted extension, in the case of a request for a further extension. If no opposition or request for further extension of time to oppose is filed prior to the expiration of any extension ultimately granted (after submission of a signed copy of the request) to the potential opposer, the time for opposing will be deemed to have expired, and the application which was the subject of the request will be sent to issue.²²

¹⁹ See 37 CFR § 2.102(a). See also *La Maur, Inc. v. Andis Clipper Co.*, 181 USPQ 783, 784 (Comm'r 1974) (petition filed by applicant denied; extension requests were filed on behalf of potential opposer by its attorney as its representative not as another party).

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

²¹ See 37 CFR § 2.119(e) and TBMP § 106.02 (Signature of Papers).

²² Cf. TBMP § 202.01 (Time for Filing Request).

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203.04 Service

Trademark Rule 2.119(a), 37 CFR § 2.119(a), requires, in part, that with certain stated exceptions, every paper filed in the USPTO in inter partes cases must be served upon the other parties, and that proof of such service must be made before the Board will consider the paper. Trademark Rule 2.101(a), 37 CFR § 2.101(a), provides that the filing of an opposition in the USPTO commences an opposition proceeding. Inasmuch as a request for an extension of time to oppose is a paper filed prior to the commencement of the opposition, it is ex parte, rather than inter partes, in nature. Accordingly, the request need not include proof of service upon the applicant.²³ Once the Board has acted upon a request for an extension of time to oppose, the Board will send the applicant a copy of the extension request together with the Board's action thereon.²⁴

203.05 Duplicate Requests

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

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

204 Fee

There is no fee for filing a request for an extension of time to oppose.²⁵

²³ See 37 CFR § 2.102(c) and, for example, *In re Docrate Inc.*, 40 USPQ2d 1636, 1638 (Comm'r 1996) (request for extension of time aggregating more than 120 days does not have to include proof of service on applicant or applicant's attorney when the request includes a statement that applicant has consented to the extension); and *La Maur, Inc. v. Andis Clipper Co.*, *supra*.

²⁴ See Section 13 of the Act, 15 U.S.C. § 1063.

²⁵ Cf. 37 CFR § 2.6.

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205 Mark on Supplemental Register Not Subject to Opposition

Although the mark in an application for registration on the Principal Register is published for, and subject to, opposition, the mark in an application for registration on the Supplemental Register is not.²⁶ If it appears after examination of an application to register a mark on the Supplemental Register, that applicant is entitled to the registration; a certificate of registration is issued without any publication for opposition.²⁷ Upon issuance of the registration, the mark appears in the *Official Gazette*, not for opposition, but rather to give notice of the registration's issuance.²⁸

Accordingly, the Board must deny any request for an extension of time to oppose the mark in an application for registration on the Supplemental Register. The remedy of the would-be opposer lies in the filing of a petition to cancel the registration of the mark, once the registration has issued.²⁹

206 Who May File an Extension of Time to Oppose

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

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

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

206.01 General Rule

Any person (whether natural or juristic--see TBMP § 303.02) who believes that he, she, or it would will be damaged by the registration of a mark upon the Principal Register may, upon

²⁶ See Sections 12(a), 13(a), and 24 of the Act, 15 U.S.C. §§ 1062(a), 1063(a), and 1092, and 37 CFR § 2.82.

²⁷ See Sections 23(b) and 24 of the Act, 15 U.S.C. §§ 1091(b) and 1092, and 37 CFR § 2.82.

²⁸ See Section 24 of the Act, 15 U.S.C. § 1092; 37 CFR § 2.82; and TMEP § 1502.

²⁹ See Section 24 of the Act, 15 U.S.C. § 1092.

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payment of the prescribed fee, file an opposition in the USPTO, stating the grounds therefor, within 30 days after the publication of the mark in the *Official Gazette* for purposes of opposition.³⁰

Similarly, any person who believes that he, she, or it would be damaged by the registration of a mark upon the Principal Register may file a written request to extend the time for filing an opposition.³¹ Moreover, a request for an extension of time to oppose must identify the potential opposer with reasonable certainty.³²

An extension of time to oppose is a personal privilege which inures only to the benefit of the party to which it was granted and those in privity with that party.³³ For this reason, a request for a further extension of time to oppose, or an opposition filed during an extension of time, ordinarily must be filed in the name of the party to which the extension was granted.³⁴ A request for a further extension, or an opposition, filed in a different name will be accepted if a person in privity with the person granted the previous extension files it, or if the person that requested the extension was misidentified through mistake.

206.02 Request for Further Extension Filed by Privy

A request for a further extension, or an opposition, filed by a different party will not be rejected on that ground if it is shown to the satisfaction of the Board that the different party is in privity with the party granted the previous extension.³⁵ The "showing" should be in the form of a recitation of the facts upon which the claim of privity is based, and must be submitted either with the request or opposition, or during the time allowed by the Board in its action requesting an explanation of the discrepancy. If the request for a further extension, or the opposition, is filed both in the name of the party granted the previous extension and in the name of one or more

³⁰ See Section 13(a) of the Act, 15 U.S.C. § 1063(a), and 37 CFR § 2.101. For further information concerning the filing of an opposition, see TBMP chapter 300, generally, and § 303 regarding who may file an opposition.

³¹ See Section 13(a) of the Act, 15 U.S.C. § 1063(a), and 37 CFR § 2.102.

³² 37 CFR § 2.102(b). For a discussion of this matter, see TBMP § 203.02.

³³ See *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1077 (TTAB 1993) (a party cannot claim the benefit of an extension granted to another, unrelated party).

³⁴ See 37 CFR § 2.102(b); TMEP § 1503.04; *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994); and *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980). Cf. TBMP § 206.02 (Request by Privy)

³⁵ See 37 CFR § 2.102(b); TMEP § 1503.04; *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994) (licensee, as party in privity with opposer, could have joined opposer in filing opposition during extension of time to oppose); and *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980) (two unrelated entities that merely share same objection to registration are not in privity).

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different parties, an explanation will be requested as to each different party, and the request will not be granted, or the opposition accepted, as to any different party which fails to make a satisfactory showing of privity.

In the field of trademarks, the concept of privity generally includes, *inter alia*, the relationship of successive ownership of a mark (e.g., assignor, assignee) and the relationship of "related companies" within the meaning of Sections 5 and 45 of the Act, 15 U.S.C. §§ 1055 and 1127.³⁶ It does not, however, include the attorney/client relationship.³⁷

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

206.03 Misidentification of Potential Opposer

A request for a further extension, or an opposition, filed in a different name will not be rejected on that ground if it is shown to the satisfaction of the Board that the party in whose name the extension was requested was misidentified through mistake.³⁸ The phrase "misidentification by mistake," as used in 37 CFR § 2.102(b), means a mistake in the form of the potential opposer's name or its entity type, not the naming of a different existing legal entity that is not in privity with the party that should have been named.³⁹

³⁶ See *International Nutrition Co. v. Horphag Research Ltd.*, 55 USPQ2d 1492, 1495 (Fed. Cir. 2000) (discussion of various 'privity' relationships). Cf. *Rolex Watch U.S.A., Inc. v. Madison Watch Co.*, 211 USPQ 352, 358 (TTAB 1981) (regarding right of owner, or one in privity with owner, to maintain opposition or cancellation based on Section 2(d)); *In re Cooper, supra* (two unrelated entities that merely share same objection to registration are not in privity); *Argo & Co. v. Carpetsheen Manufacturing, Inc.*, 187 USPQ 366, 367 (TTAB 1975) (motion to suspend granted in view of privity of applicant with parties in civil action); and *F. Jacobson & Sons, Inc. v. Excelled Sheepskin & Leather Coat Co.*, 140 USPQ 281, 282 (Comm'r 1963) (parent in privity). *But see Tokaido v. Honda Associates Inc.*, 179 USPQ 861, 862 (TTAB 1973) (respondent's motion to suspend for civil action between respondent and third party denied where petitioner as nonexclusive licensee of third party was not in privity with third party).

³⁷ See *In re Spang Industries, Inc.*, 225 USPQ 888 (Comm'r 1985).

³⁸ See 37 CFR § 2.102(b), and *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075 (TTAB 1993).

³⁹ See *Cass Logistics Inc. v. McKesson Corp., supra* (word processing error resulting in identification of different legal entity was not a "mistake" within the meaning of the rule). See also TMEP § 1503.04.

Cf. *Arbrook, Inc. v. La Citrique Belge, Naamloze Vennootschap*, 184 USPQ 505, 506 (TTAB 1974) (motion to substitute granted where opposition was mistakenly filed in name of original owner); *Davidson v. Instantype, Inc.*, 165 USPQ 269, 271 (TTAB 1970) (leave to amend to substitute proper party granted where opposition was filed in name of the individual rather than in the name of the corporation); *Pyco, Inc. v. Pico Corp.*, 165 USPQ 221, 222 (TTAB 1969) (where succession occurred prior to filing of opposition, erroneous identification of opposer as a

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

207 Requirements for Showing of Cause; Extraordinary Circumstances

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

partner in a firm which no longer existed was not fatal); and *Raker Paint Factory v. United Lacquer Mfg. Corp.*, 141 USPQ 407, 409 (TTAB 1964) (sole owner substituted for partnership where original plaintiff identified as partnership composed of that individual since originally named plaintiff was not actually in existence when opposition was filed and even it were, as a partner, he is a successor to the partnership).

Cf. also TMEP § 803.06; *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689, 1690 (TTAB 1991) (correction not permitted where joint venture owned the mark but the application was filed by a corporation which was one member of the joint venture); *In re Atlantic Blue Print Co.*, 19 USPQ2d 1078, 1079 (Comm'r 1990) (permitted to amend name of registrant in Sections 8 and 15 declaration where trade name was inadvertently substituted for corporate name); *In re Techsonic Industries, Inc.*, 216 USPQ 619, 620 (TTAB 1982) (allowed to correct application where applicant was identified by only a portion of its earlier used name and earlier name had already been supplanted by new name at time application was filed, but at all times was one single entity); *Argo & Company v. Springer, et al.*, 198 USPQ 626, 634 (TTAB 1978) (Board granted applicant's motion to change its name from corporation which was defectively incorporated to individuals who were true owners of mark at time of filing); *In re Eucryl, Ltd.*, 193 USPQ 377, 378 (TTAB 1976) (exclusive U.S. distributor is owner only if it has agreement providing for right to apply; since distributor had no right to apply, subsequent assignment to proper applicant did not cure defect); *Argo & Co. v. Springer*, 189 USPQ 581, 582 (TTAB 1976) (defendant can be substituted when originally named party was not in existence at time of filing complaint); and *U.S. Pioneer Electronics Corp. v. Evans Marketing, Inc.*, 183 USPQ 613, 614 (Comm'r 1974) (deletion of "company" permissible).

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207.01 First Extension of Thirty Days

A first extension of time to oppose for not more than thirty days will be granted upon written request, if the request is otherwise appropriate (e.g., is timely filed; identifies the potential opposer with reasonable certainty). No showing of cause is required.⁴⁰

207.02 Further Extensions

The Board may grant extensions of time to oppose beyond the first thirty-day extension for good cause, provided that the extensions do not aggregate more than 120 days from the date of publication of the subject mark.⁴¹ Thus, a potential opposer may seek up to a 90-day extension of time, even in a single request, provided good cause for the extension is shown. If a request for extension of time to oppose beyond the first thirty-day extension does not include a showing of good cause, the Board can allow the defect to be corrected only if the correction is made prior to the expiration of the time for filing the request, that is, before the previous extension expires.⁴² A showing of good cause for a further extension of time to oppose should set forth the reasons why additional time is needed for filing an opposition. The merits of the potential opposition are not relevant to the issue of whether good cause exists for the requested extension.

A first request for an extension of time to oppose may seek an extension of more than thirty days, but good cause must be shown for the time in excess of thirty days.⁴³ If an otherwise proper first extension request seeks an extension of more than thirty days, but does not include a

⁴⁰ See Section 13(a) of the Act, 15 U.S.C. § 1063(a); 37 CFR § 2.102(c); and *Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310, 1312 (Comm'r 1991).

⁴¹ See 37 CFR § 2.102(c), and *Lotus Development Corp. v. Narada Productions, Inc.*, *supra*.

⁴² Cf. *In re Spang Industries, Inc.*, 225 USPQ 888, 888 (Comm'r 1985) (defect of failure to identify potential opposer with reasonable certainty may not be corrected after opposition period has expired). Cf. also, regarding requirements for extensions beyond 120 days, *In re Su Wung Chong*, 20 USPQ2d 1399, 1400 (Comm'r 1991) (since potential opposer failed to submit required showing of extraordinary circumstances with extension request as required by Rule 2.102(c)(3), question on petition was not whether any such extraordinary circumstances existed at time of request but instead whether potential opposer showed extraordinary circumstances existed that prevented compliance with that rule); *In re Software Development Systems, Inc.*, 17 USPQ2d 1094, 1095 (Comm'r 1989) (inadvertent failure to provide proof of service not extraordinary circumstance to waive [former] rule requiring proof of service); and *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093, 1094 (Comm'r 1990) (extraordinary circumstances not shown so as to waive requirement that showing of extraordinary circumstances be submitted with extension request).

⁴³ See *Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310, 1312 (Comm'r 1991) (potential opposer only entitled to extension of 30 days where initial request exceeded thirty days by two days and potential opposer did not assert good cause for additional days); *Kimberly-Clark Corp. v. Paper Converting Industry, Inc.*, 21 USPQ2d 1875, 1877 (Comm'r 1991) (initial request for 60 days with showing of good cause in compliance with the rules).

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showing of good cause for the time in excess of thirty days, the potential opposer will be granted an extension of only thirty days. However, a request for a further extension, showing good cause, may be submitted during that thirty-day extension period.

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

207.03 Extensions Beyond 120 Days From Publication

Extensions of time to oppose aggregating more than 120 days from the date of publication of the subject mark will not be granted unless the potential opposer submits, in addition to the showing of good cause required for extensions of time beyond the first thirty-day extension period, one of the following: (1) a written consent or stipulation signed by the applicant or its authorized representative, or (2) a written request by the potential opposer or its authorized representative stating that the applicant or its authorized representative has consented to the request,⁴⁴ or (3) a showing of extraordinary circumstances.⁴⁵ Consent must be express, though it may be provided orally, and the extension request must state that such consent has been provided. It is not sufficient to indicate in the request that the parties are discussing settlement; the request must expressly state that applicant has consented to the extension.⁴⁶ In addition, the statement of consent should appear in the body of the request, not merely in the title (e.g. "Consented Request to Extend") of the filing.

If one of these elements (i.e., the showing of extraordinary circumstances, or applicant's written consent, or the statement that applicant has consented) is omitted from an extension request based in whole or in part upon the omitted element, the Board can allow the defect to be corrected only if the correction is made prior to the expiration of the time for filing the request, that is, prior to the expiration of the previous extension.⁴⁷

⁴⁴ *NOTE: Proof of service of the request on applicant is no longer required. See 37 CFR § 2.102(c), as amended. See also In re Docrine Inc.*, 40 USPQ2d 1636, 1638 (Comm'r 1996).

⁴⁵ *See 37 CFR § 2.102(c).*

⁴⁶ *See In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093, 1094 (Comm'r 1990) (mere existence of settlement discussions does not constitute extraordinary circumstances).

⁴⁷ *See In re Su Wung Chong*, 20 USPQ2d 1399, 1400 (Comm'r 1991) (since potential opposer failed to submit required showing of extraordinary circumstances with extension request as required by Rule 2.102(c)(3), question on petition was not whether any such extraordinary circumstances existed at time of request but instead whether potential opposer showed extraordinary circumstances existed that prevented compliance with that rule); *In re Software Development Systems, Inc.*, 17 USPQ2d 1094, 1095 (Comm'r 1989) (inadvertent failure to provide proof of service not extraordinary circumstance to waive [former] rule requiring proof of service); and *In re Societe Des Produits Nestle S.A.*, *supra* at 1094 (extraordinary circumstances not shown to waive requirement that showing of

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

A request for a further extension of time to oppose may seek an extension for a period beginning prior to 120 days from the date of publication of the subject mark and ending after the 120th day. If such a request includes a showing of good cause, but does not meet the requirements of 37 CFR § 2.102(c) for extensions aggregating more than 120 days from publication (i.e., does not include a showing of extraordinary circumstances; or applicant's written consent; or a statement that applicant has consented, accompanied by proof of service on applicant), any extension granted to potential opposer will be limited to the time for which good cause has been shown, and will end on or before the 120th day after publication.⁴⁸

208 Essential Element Omitted

If any element (e.g., identification of potential opposer, showing of good cause, showing of extraordinary circumstances, applicant's written consent, statement that applicant has consented) essential to a particular request for extension of time to oppose is omitted from the request, the Board can allow the defect to be corrected only if the correction is made prior to the expiration of the time for filing the request, that is, prior to the expiration of the thirty-day opposition period following publication of the subject mark, in the case of a first request, or prior to the expiration of the previous extension, in the case of a request for a further extension.⁴⁹

extraordinary circumstances be submitted with extension request and subsequently obtained consent insufficient). Cf. *In re Spang Industries, Inc.*, 225 USPQ 888, 888 (Comm'r 1985) (identification of potential opposer omitted).

⁴⁸ See *Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310, 1312 (Comm'r 1991) (mistake in calculating expiration of initial request resulted in request for extension beyond thirty days with no showing of cause and ran subsequent requests beyond 120 days without meeting requirements for that period), and *In re Societe Des Produits Nestle S.A.*, *supra*.

⁴⁹ See *In re Su Wung Chong*, *supra*; (showing of extraordinary circumstances omitted); *In re Societe Des Produits Nestle S.A.*, *supra*; (extraordinary circumstances not shown and subsequently obtained consent untimely); and *In re Spang Industries, Inc.*, *supra* (identification of potential opposer omitted).

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While a request for an extension of time to oppose must be signed, an unsigned request will not be refused consideration if a signed copy is submitted to the USPTO within the time limit set in the written notification of this defect by the Board.⁵⁰

209 Action by Board on Request

209.01 Suspension; Grant or Denial of Extensions - General Policy

209.01(a) Suspension Policy

The Board will not suspend the running of an extension of time to oppose for any reason. A potential opposer must either continue to file timely requests for extensions of time, if it wishes to preserve its right to oppose, or go forward with the notice of opposition.

209.01(b) Grant or Denial of Extensions

The time for filing an opposition generally will not be extended beyond 360 days from the date of publication pending, for example, the final determination of another proceeding between the potential opposer and the applicant, or the conclusion of unduly prolonged settlement negotiations, or the filing of a new application, and its prosecution to publication or registration by the potential opposer or applicant.

After 120 days from the date of publication of applicant's mark, the Board as a general rule will not grant extensions for more than sixty days at a time for requests made without the consent of the applicant, or more than ninety days at a time for requests made with the applicant's consent. Again, however, the general rule will be applied flexibly and reasonably, depending upon the circumstances in a particular case.

Extension requests based on settlement discussions. When a potential opposer files repeated extension requests based upon applicant's consent coupled with an assertion that the parties are negotiating for settlement, the Board ordinarily will require, for extensions aggregating more than 180 days from the date of publication of applicant's mark, that the extension request include also a report on the status of their settlement negotiations. In such a case, the Board, in writing, will advise potential opposer that any further extension requests made on the basis of consent and settlement negotiations should include a summary of the progress of the negotiations. If the subsequent request fails to include this summary, the request may be denied.

As a general rule, the Board will not grant extensions of time to oppose beyond 360 days from the date of publication, unless settlement has been reached and only needs to be

⁵⁰ See 37 CFR § 2.119(e) and TBMP § 106.02 (Signature of Papers).

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executed. The general rule, however, will be applied flexibly and reasonably, depending upon the circumstances in a given case. For example, if a foreign party is involved, or if parties are trying to settle several cases at once, or if numerous parties are involved, more time may be allowed.

209.02 Determination of Extension Expiration Date

The extension expiration date stamped on an approved request, or stated in an action granting an extension, is the date upon which the extension actually expires, even if that date is a Saturday, Sunday, or a Federal holiday within the District of Columbia. If the expiration date falls on a Saturday, Sunday, or a Federal holiday within the District of Columbia, an opposition, or a request for a further extension, filed by the potential opposer on the next succeeding day which is not a Saturday, Sunday, or a Federal holiday will be considered timely.⁵¹ However, the beginning date for calculating the further extension is the actual expiration date of the previous extension, regardless of whether the expiration date fell on a weekend or Federal holiday.⁵²

A first request for an extension of time to oppose sometimes asks for an extension of "thirty days," (for which a showing of good cause is not required) but specifies an extension expiration date which is different from the expiration date of the requested "thirty days." In this case, the extension, if granted, will be set to expire on whichever date is later, provided that, if the date specified by the potential opposer is beyond thirty days, potential opposer has shown good cause for the time in excess of thirty days. If good cause for the time beyond thirty days has not been shown, the time will be set to expire on the thirtieth day.⁵³

Similarly, a request for a further extension of time to oppose (that is, beyond the first thirty day request) sometimes asks for a certain number of days, but specifies an extension expiration date which is longer or shorter than the expiration date of the requested number of days. In this case, the extension, if granted, will normally be set to expire on whichever date is later. However, if part of the extension would fall beyond 120 days from the date of publication, and the request does not meet the 37 CFR § 2.102(c) requirements for extensions aggregating more than 120 days from publication (i.e., does not include a showing of extraordinary circumstances; or applicant's written consent; or a statement that applicant has consented), the extension, if granted, will be set to expire no later than 120 days from the date of publication.⁵⁴

⁵¹ See 37 CFR § 1.6; *Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310, 1312 (Comm'r 1991) (potential opposer miscalculated first 30-day extension request and threw off all subsequent periods); and TBMP § 112 (Time for Taking Action).

⁵² See *Lotus Development Corp. v. Narada Productions, Inc.*, *supra* at 1312.

⁵³ Cf. 37 CFR § 2.102(c), and TBMP § 207.02 (Further Extensions).

⁵⁴ See *Lotus Development Corp. v. Narada Productions, Inc.* *supra*, and *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093 (Comm'r 1990). See also 37 CFR § 2.102(c), and TBMP § 207.03 (Extensions Beyond 120 Days).

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A first request for an extension of time to oppose may seek an extension of more than thirty days, but good cause must be shown for the time in excess of thirty days.⁵⁵ If an otherwise proper first extension request seeks an extension of more than thirty days, but does not include a showing of good cause for the time in excess of thirty days, potential opposer will be granted an extension of only thirty days.

A request for a further extension of time to oppose may seek an extension for a period beginning prior to 120 days from the date of publication of the subject mark and ending after the 120th day. If such a request includes a showing of good cause, but does not meet the requirements of 37 CFR § 2.102(c) for extensions aggregating more than 120 days from publication (i.e., does not include a showing of extraordinary circumstances; or applicant's written consent; or a statement that applicant has consented), any extension granted to potential opposer will be limited to the time for which good cause has been shown, and will end on or before the 120th day after publication.⁵⁶

210 Objections to Request

Since a request for an extension of time to oppose is *ex parte* in nature, there is no requirement that a copy has to be served upon the applicant.⁵⁷ For the same reason, an applicant is not notified of the filing of an extension request before the Board has acted on it. Not until after the Board has acted on an extension request does the Board send the applicant a copy of the request (if there is no proof of service by potential opposer), together with notification of the Board's action.

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

⁵⁵ See 37 CFR § 2.102(c); *Kimberly-Clark Corp. v. Paper Converting Industry, Inc.*, 21 USPQ2d 1875, 1877 (Comm'r 1991) (initial request for 60 days with required showing granted); and TBMP § 207.02 (Further Extensions).

⁵⁶ See 37 CFR § 2.102(c); *Lotus Development Corp. v. Narada Productions, Inc.*, *supra*; *In re Societe Des Produits Nestle S.A.*, *supra*; and TBMP § 207.03.

⁵⁷ See TBMP § 203.04 (Service).

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An applicant that receives notification from the Board that an extension request has been filed and granted may submit objections in the form of a request for reconsideration.⁵⁸

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

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

211 Relief From Action of Board

211.01 Request for Reconsideration

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

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

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

The filing of a request for reconsideration of the denial, or the granting, of a request for an extension of time to oppose does not relieve the potential opposer of the responsibility of filing an opposition, or a request for a further extension of time to oppose, before the expiration of the relevant extension.⁵⁹

⁵⁸ For information concerning a request for reconsideration of an action of the Board relating to a request for extension of time to oppose, see TBMP § 211.01.

⁵⁹ Cf. 37 CFR § 2.89(g).

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211.02 Relief after Institution of Opposition

If an applicant is dissatisfied with an action of the Board on a request for an extension of time to oppose and the opposition has been filed and instituted, the applicant may raise the issue by means of a motion to dismiss the opposition for lack of jurisdiction.⁶⁰

211.03 Petition to the Director

If an applicant or potential opposer is dissatisfied with an action of the Board on a request for an extension of time to oppose, it may file a petition to the Director, pursuant to 37 CFR § 2.146, for review of the action in question.⁶¹

The petition to the Director must include a statement of the facts relevant to the petition; the points to be reviewed; the action or relief requested; and the requisite fee, as specified in 37 CFR § 2.6. Any brief in support of the petition must be embodied in or accompany the petition. If facts are to be proved, the proof must be in the form of affidavits or declarations in accordance with 37 CFR § 2.20, and these affidavits or declarations, with any exhibits thereto, must accompany the petition.⁶²

A petition from the denial of a request for an extension of time to oppose must be filed within 15 days from the mailing date of the denial of the request and must be served on the attorney or other authorized representative of the applicant, if any, or on the applicant. Proof of service of the petition must be made as provided in 37 CFR § 2.119(a).⁶³ Applicant may file a response within 15 days from the date of service of the petition. A copy of the response must be served upon the petitioner, with proof of service as provided by 37 CFR § 2.119(a). No further paper relating to the petition may be filed.⁶⁴

Trademark Rule 2.146(e)(1), 37 CFR § 2.146(e)(1), the provisions of which are summarized in the preceding paragraph, presently makes no reference to a petition from the granting of a

⁶⁰ See *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1075 n.2 and, generally, TBMP § 502 (regarding motions). See also *Central Manufacturing Inc. v. Third Millennium Technology Inc.*, 61 USPQ2d 1210, 1215 (TTAB 2001) (motion to dismiss granted where it was found that opposer's allegations of consent and good cause [i.e., that the parties were engaged in settlement discussions] to extend beyond 120 days were untrue).

⁶¹ See also TMEP § 1704.

⁶² See 37 CFR § 2.146(c).

⁶³ See also TBMP §§ 113.03 (Elements of Certificate) and 113.04 (Manner of Service).

⁶⁴ See 37 CFR § 2.146(e)(1).

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request for an extension of time to oppose. However, the provisions of the rule may appropriately be followed in the case of such a petition.

The filing of a petition by the potential opposer from the denial or by the applicant from the granting of a request for an extension of time to oppose does not relieve the potential opposer of the responsibility of filing an opposition, or a request for a further extension of time to oppose, prior to the expiration of the extension which is the subject of the petition.⁶⁵ The filing of a petition will constitute good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark, but will not constitute extraordinary circumstances justifying an extension of time beyond 120 days from publication.

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

If opposer files a timely opposition during the pendency of its petition to the Director, the Board will institute the opposition. At the same time, the Board will normally suspend the opposition pending resolution of the petition. If, along with the notice of opposition, the opposer files a motion to suspend the opposition, citing the pending petition as the reason for suspension, the Board will institute the opposition, grant the motion to suspend, and state that the opposition is suspended pending resolution of the petition to the Director. A copy of the Board's action will be sent to both parties and a copy of the notice, along with a copy of the motion to suspend, will be sent to the applicant.

If the decision on the petition is unfavorable to opposer, the opposition will be dismissed as a nullity, and the fee will be refunded

212 Amendment of Application During or After Extension

212.01 Jurisdiction to Consider Amendment

The Board has no jurisdiction over an application unless and until the application becomes involved in a Board inter partes proceeding.⁶⁶ In the absence of an inter partes proceeding, the Board has jurisdiction only over matters relating to any requested extension(s) of time to oppose.

⁶⁵ See, e.g., *In re Doctrite Inc.*, 40 USPQ2d 1636, 1637 n.1 (Comm'r 1996) (citing Trademark Rule 2.146(g) and stating that filing petition to review denial of request to extend time to oppose does not stay time to file opposition or further extensions of time to oppose).

⁶⁶ Compare Trademark Rules 2.84 and 2.133.

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Thus, if, in an application which is the subject of a request for an extension of time to oppose, an amendment or other paper (such as a request for republication, a request for reconsideration of a refusal to approve an amendment) relating to the application is filed by the applicant, and the application is not involved in any Board inter partes proceeding, it is the Examining Attorney who must determine the propriety of the amendment or other paper.⁶⁷

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

Any amendment proposed by an applicant, whether of its own volition or to accommodate a concern of a potential opposer must be sent to the Board's attention, not to the Examining Attorney who approved the mark for publication. The Board will note the amendment and transfer the file to the Examining Attorney. Because the Examining Attorney eventually will consider the amendment, any phone inquiry for discussion of the content of the amendment should be directed to the Examining Attorney.

212.02 Conditions for Examining Attorney Approval of Amendment

During the time between the publication of a mark in the *Official Gazette* for opposition, and the printing of a certificate of registration or notice of allowance, an application not involved in an inter partes proceeding before the Board may be amended upon request by the applicant, provided that the amendment does not necessitate issuance of a refusal or requirement by the Examining Attorney. If a refusal or requirement by the Examining Attorney would be needed, the amendment cannot be made unless applicant (1) successfully petitions the Director to restore jurisdiction over the application to the Examining Attorney for consideration of the amendment and further examination, and (2) is able to satisfy any requirement or overcome any refusal asserted in any Office action issued after the restoration of jurisdiction.⁶⁸

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

⁶⁷ See 37 CFR § 2.84, and *In re MCI Communications Corp.*, 21 USPQ2d 1534 (Comm'r 1991). Cf. *Groening v. Missouri Botanical Garden*, 59 USPQ2d 1601, 1603 (Comm'r 1999) (mark originally published in wrong class may be amended by Examining Attorney to the correct class and republished in the correct class without either applicant's approval or a restoration of jurisdiction).

⁶⁸ See 37 CFR § 2.84(b) and TMEP §§ 1504.01 and 1505 *et seq*

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or an application under Section 1(b) of the Act, 15 U.S.C. § 1051(b), in which an acceptable amendment to allege use has been filed) to convert an application for an unrestricted registration to one for concurrent use registration.⁶⁹

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

212.03 Form of Amendment

An amendment or other paper relating to an application which is the subject of a request for an extension of time to oppose should be in the normal form for an amendment or other document relating to an application, except that it should be directed to the attention of the Trademark Trial and Appeal Board (i.e., Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514).

212.04 Action by Board -- Upon Receipt of Amendment

When an amendment relating to an application which is the subject of a request for an extension of time to oppose is filed, a Board administrative staff member will issue an action acknowledging receipt of the amendment, forwarding the application file to the Examining Attorney for consideration of the amendment, and explaining the effect the filing of the amendment has on the extension of time to oppose.⁷⁰

If an amendment is filed during the running of a well taken request for an extension of time, the action will acknowledge receipt of the amendment; note that the amendment requires consideration by the Examining Attorney; approve the extension (or if already approved, note that potential opposer has been granted an extension of time to oppose until a specified date); indicate the application is forwarded to the Examining Attorney for consideration of the amendment; instruct the Examining Attorney to act on the amendment (either by approving it for entry or by telephoning the applicant, explaining why the amendment cannot be approved, and placing a record of the telephone call in the file), and then return the application to the Board; and indicate that after the application has been returned to the Board, further appropriate action will be taken with respect to the potential opposition. The action will also advise potential opposer that the filing of the amendment does not relieve the potential opposer of the

⁶⁹ See *In re MCI Communications Corp.*, 21 USPQ2d 1534, 1539 (Comm'r 1991) (disclaimer). Cf. *In re Little Caesar Enterprises, Inc.*, 48 USPQ2d 1222 (Comm'r 1998) (regarding request to divide certain items out of a class of goods during extension of time to oppose, and petition to waive rule requiring that request to divide be filed before application is approved for publication).

⁷⁰ See, for example, *In re MCI Communications Corp.*, 21 USPQ2d 1534, 1539 (Comm'r 1991) (entry of disclaimer as means of settling potential opposition).

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responsibility of filing an opposition, or a further request for extension of time to oppose, prior to the expiration of the previous request.

If an amendment is filed after the expiration of potential opposer's extension of time to oppose, and no opposition or request for a further extension of time to oppose has been timely filed, the Board's action will acknowledge receipt of the amendment; note that the amendment requires consideration by the Examining Attorney; indicate that potential opposer's extension of time to oppose has expired, and that no opposition or request for a further extension of time to oppose has been timely filed; forward the application to the Examining Attorney for consideration of the amendment; and state that the Examining Attorney may treat the amendment in the same manner as any amendment after publication⁷¹ and need not return the application to the Board after consideration of the amendment.

If an amendment is filed prior to action by the Board on a request for an extension of time to oppose, and the request is not granted, the letter will acknowledge receipt of the request and the amendment; note that the amendment requires consideration by the Examining Attorney; deny the request; forward the application to the Examining Attorney for consideration of the amendment; and state that the Examining Attorney may treat the amendment in the same manner as any amendment after publication⁷² and need not return the application to the Board after consideration of the amendment.

If an amendment is filed after a request for an extension of time to oppose has been denied by the Board, but before the Board has forwarded the application to issue, the action will acknowledge receipt of the amendment; note that the amendment requires consideration by the Examining Attorney; indicate that potential opposer's request for an extension of time to oppose has been denied; forward the application to the Examining Attorney for consideration of the amendment; and state that the Examining Attorney may treat the amendment in the same manner as any amendment after publication⁷³ and need not return the application to the Board after consideration of the amendment.

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

⁷¹ TMEP §§ 1504.01 and 1505 *et seq.*

⁷² TMEP §§ 1504.01 and 1505 *et seq.*

⁷³ TMEP §§ 1504.01 and 1505 *et seq.*

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If an amendment is filed prior to the Board's institution of a timely opposition, the Board will institute the opposition, and at the same time suspend the opposition pending consideration of the amendment by the Examining Attorney.

212.05 Action by Board -- During Consideration of Amendment by Examining Attorney

The filing of the amendment will be considered good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark, but it will not constitute extraordinary circumstances justifying an extension of time beyond 120 days from publication.

If a timely opposition is filed while the amendment is still pending before the Examining Attorney, the Board will institute the opposition, and at the same time the Board will normally suspend the opposition pending consideration of the amendment by the Examining Attorney. If, along with the notice of opposition, the opposer files a motion to suspend the opposition, citing the pending amendment as the reason for suspension, the Board will institute the opposition, grant the motion to suspend, and state that the opposition is suspended pending consideration of the amendment by the Examining Attorney. A copy of the institution order will be mailed to both parties, and a copy of the notice of opposition and motion to suspend will be mailed to the applicant.

212.06 Action by Board -- After Consideration of Amendment by Examining Attorney

When an amendment in an application which is the subject of an extension of time to oppose is forwarded to the Examining Attorney for consideration, the Examining Attorney acts on the amendment, either by approving it for entry or by telephoning the applicant, explaining why the amendment cannot be approved and placing a record of the telephone call in the file.⁷⁴ The Examining Attorney then returns the application to the Board (unless the time for opposing expired prior to the filing of the amendment).

If the application is returned to the Board during the running of a well taken request for an extension of time, a Board administrative staff member will issue an action approving the extension (or, if already approved, noting that potential opposer has been granted an extension of time to oppose until a specified date); indicating whether or not the amendment was approved; and taking further appropriate action relating thereto.

For example, sometimes a potential opposer, in a request for an extension of time to oppose or in a separate document, states that it has agreed not to oppose if applicant's application is amended

⁷⁴ See *In re MCI Communications Corp.*, 21 USPQ2d 1534, 1539 (Comm'r 1991) (entry of voluntary disclaimer).

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in a certain manner. If the amendment submitted by applicant conforms to the agreement and the Examining Attorney approves it, the Board's action will indicate that the amendment has been approved; that potential opposer has agreed not to oppose if the amendment is approved; and that the application is accordingly being forwarded to issue. If the amendment was not approved, the action will so state, and potential opposer will be advised that it will need to continue to file timely requests for extensions of time or file its notice of opposition.

If there is no statement by potential opposer that it will not oppose if the amendment submitted by applicant is approved, the Board's action will state whether the amendment was approved, and will advise the potential opposer that it will need to continue to file timely requests for extensions of time, or file its notice of opposition.

Sometimes an Examining Attorney considering an amendment to an application that is the subject of an extension of time to oppose, does not approve the amendment submitted by the applicant, but instead makes a different amendment by Examiner's Amendment.⁷⁵ In such a case, the Board, in its action, will so state; specify the amendment made by Examiner's Amendment; and advise potential opposer that it will need to continue to file timely requests for extensions of time, or file its notice of opposition.

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

If an opposition was instituted prior to the Examining Attorney's action on the amendment, and the amendment is subsequently approved, the Board will prepare an action notifying the parties that the amendment was approved; advising the parties that the opposition will go forward on the basis of the application as amended; and allowing opposer time to indicate whether it wishes to proceed with the opposition on that basis, or to have the opposition dismissed as a nullity and the fee refunded. If opposer chooses to go forward, proceedings in the opposition will be resumed and appropriate dates will be set. If the amendment is not approved, the parties will be so advised, and proceedings will be resumed with appropriate dates set.

212.07 Amendment During Opposition

If an amendment is filed in an application that is the subject of an opposition, the Board has jurisdiction over the application and will determine the propriety of the amendment. Once an opposition has commenced, the application that is the subject of the opposition may not be amended in substance, except with the consent of the other party or parties and the approval of the Board, or except upon motion granted by the Board.⁷⁶

⁷⁵ See TMEP § 707.

⁷⁶ See 37 CFR § 2.133, and TBMP § 514 (Motion to Amend Application or Registration).

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213 Effect of Restoration of Jurisdiction

If the Examining Attorney wishes to refuse registration or make a requirement in an application that is the subject of a request for an extension of time to oppose, the Examining Attorney must request the Director to restore jurisdiction over the application to the Examining Attorney for that purpose.⁷⁷ If the application is also the subject of an opposition, the Examining Attorney's request for jurisdiction must be directed to the Board.⁷⁸

A request for jurisdiction, which is granted during an unexpired extension of time to oppose, does not relieve the potential opposer of the responsibility of filing an opposition, or a request for a further extension of time to oppose, before the expiration of the previous request. After the Board learns that the Examining Attorney's jurisdiction has been restored, a Board administrative staff member will prepare an action advising potential opposer and applicant thereof and taking further appropriate action. Examples are described below.

If the restoration of jurisdiction occurs during the running of an extension of time to oppose, the action will inform the potential opposer and applicant that jurisdiction over the application has been restored to the Examining Attorney; approve the extension of time, if appropriate (or, if already approved, note that potential opposer has been granted an extension of time to oppose until a specified date); instruct the Examining Attorney that if the application is subsequently approved, and the mark is not republished, the application must be returned to the Board; and advise potential opposer that the filing of the amendment does not relieve the potential opposer of the responsibility of filing an opposition, or a further request for extension of time to oppose, prior to the expiration of the previous request.

The restoration of jurisdiction (or the filing of a request for jurisdiction) will constitute good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark, but will not constitute extraordinary circumstances justifying an extension of time beyond 120 days from publication.

One copy of the Board's action will be placed in the file of the subject application, one copy will be mailed to the applicant, and one copy each of the Board's action and of the Examining Attorney's Office action will be mailed to the potential opposer. Before the application is sent to the Examining Attorney, the administrative staff member will attach to the front of the file a note reading: "EXAMINER NOTE: IF THIS APPLICATION IS ULTIMATELY APPROVED, APPLICATION FILE MUST BE RETURNED TO TTAB FOR ACTION WITH RESPECT TO EXTENSION OF TIME TO OPPOSE."

⁷⁷ See 37 CFR § 2.84(a); TMEP §§ 1504.01 and 1504.02 and *In re Hershey*, 6 USPQ2d 1470, 1471 n.2 (TTAB 1988) (restoration of jurisdiction to Examining Attorney by [Director] is not subject to review by the Board).

⁷⁸ See 37 CFR § 2.130 and TMEP § 1504.02.

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If, during the running of an extension of time, the Examining Attorney approves the application, and the mark is not republished, the Board administrative staff member will issue an action so advising the potential opposer and applicant. The action will also approve the extension of time, if appropriate (or, if already approved, note that potential opposer has been granted an extension of time to oppose until a specified date). If the mark is republished, or if registration is ultimately denied, the extension request, if not yet approved, will be moot. No further extension of the original opposition period will be granted. Rather, a potential opposer's time for opposing will recommence on the date of republication.

If a timely opposition is filed while the question of registrability is still before the Examining Attorney, the Board will institute the opposition. At the same time, the Board will normally suspend proceedings until the registrability of the mark has been finally determined. If, along with the notice of opposition, the opposer files a motion to suspend the opposition, citing the restoration of jurisdiction as the reason for suspension, the Board will institute the opposition, grant the motion to suspend, and indicate that the opposition is suspended pending final determination of the registrability of the mark. A copy of the Board's action will be sent to both parties and a copy of the notice of opposition, along with a copy of the motion to suspend, will be sent to the applicant.

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

If registration is ultimately denied, the opposition will not be instituted, or if already instituted, will be dismissed as a nullity and the fee refunded.

214 Effect of Republication

The Examining Attorney may determine that the mark in an application that is the subject of a request for an extension of time to oppose must be republished. This may happen, for example, when the mark was originally published in the wrong class; when the goods or services, although properly identified in the application itself, were published incorrectly; when a disclaimer was mistakenly included in the original publication; or when the application has been amended after

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publication (but before the filing of an opposition), and the amendment is of such nature as to require republication.⁷⁹

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

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

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

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

⁷⁹ See TMEP § 1505.01. See also, for example, *Groening v. Missouri Botanical Garden*, 59 USPQ2d 1601, 1603 (Comm'r 1999) (mark originally published in wrong class may be amended by Examining Attorney to the correct class and republished in the correct class without either applicant's approval or a restoration of jurisdiction).

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215 Effect of Letter of Protest

A third party that has knowledge of facts bearing upon the registrability of a mark in a pending application may bring such information to the attention of the USPTO by filing, with the Office of the Commissioner for Trademarks, a "letter of protest," that is, a letter which recites the facts and which is accompanied by supporting evidence.⁸⁰ The Administrator for Trademark Identifications, Classifications and Practice (Administrator) will determine whether the letter of protest should be "granted," that is, whether the information should be given to the Examining Attorney for consideration.⁸¹

A letter of protest may be filed either before or after publication of the subject mark for opposition. However, a letter of protest filed after publication ordinarily must be filed within thirty days after publication in order to be considered timely.⁸² Moreover, even if the Director decides to grant a post-publication letter of protest, the Examining Attorney cannot consider the submitted information unless the Commissioner for Trademarks, upon written request by the Administrator, concurs in the decision to grant the letter of protest and restores jurisdiction over the application to the Examining Attorney.⁸³ If the application is the subject of an opposition, the request for jurisdiction should be directed to the Board.⁸⁴

The filing of a letter of protest does not stay the time for filing an opposition to the subject mark, regardless of when the letter of protest was filed.⁸⁵ If a party that files a letter of protest after publication wishes to preserve its right to oppose in the event that the letter of protest is denied, it must file a timely request for an extension of time to oppose.⁸⁶

⁸⁰ See TMEP § 1715; *In re Urbano*, 57 USPQ2d 1776, 1778 n.5 (TTAB 1999) (letter of protest provided additional information to the Examining Attorney to maintain a refusal); *In re BPJ Enterprises Ltd.*, 7 USPQ2d 1375, 1379 (Comm'r 1988) (Director committed clear error by allowing Examining Attorney to be involved in deciding whether the letter of protest was to be granted); and *In re Pohn*, 3 USPQ2d 1700, 1703 (Comm'r 1987) (guidelines for timeliness of letter of protest).

⁸¹ See TMEP § 1715. For information concerning the standard applied by the Administrator in determining whether a letter of protest should be granted, see TMEP § 1715 *et seq.*

⁸² See *In re G. Heileman Brewing Co., Inc.*, 34 USPQ2d 1476, 1478 (Comm'r 1994) (letter of protest, filed more than a year after publication and accompanied by evidence of descriptiveness which was available 2 months prior to publication, was untimely); *In re BPJ Enterprises Ltd.*, *supra* (filed 44 days after publication but before timeliness standard enunciated); *In re Pohn*, *supra*; and TMEP § 1715.03.

⁸³ See TMEP § 1715.03.

⁸⁴ See 37 CFR § 2.130 and TMEP § 1504.02.

⁸⁵ Cf. TMEP § 1715.03(b).

⁸⁶ Cf. *In re BPJ Enterprises Ltd.*, *supra*.

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

The filing by a third party of a letter of protest (not yet determined by the Administrator), with respect to a mark which is the subject of a request for an extension of time to oppose, will not be considered by the Board to constitute good cause for the granting of an extension to the potential opposer.

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

Often, when the application comes to the Board for further appropriate action, the letter of protest has been granted; jurisdiction over the application has been restored to the Examining Attorney; and the Examining Attorney has issued an Office action asserting a refusal or a requirement. If a well taken request for an extension of time to oppose is running at this time, a Board administrative staff member will prepare an action notifying the potential opposer and applicant that the letter of protest has been granted; that jurisdiction over the application has been restored to the Examining Attorney; that an Office action has been issued by the Examining Attorney; that the extension request is approved (or, if already approved, that potential opposer has been granted an extension of time to oppose until a specified date); that if the application is subsequently approved, and the mark is not republished, that the application must be returned to the Board; and that the filing of the amendment does not relieve the potential opposer of the responsibility of filing an opposition, or a further request for extension of time to oppose, prior to the expiration of the previous request.

If, during the running of a well taken request for an extension of time, the Examining Attorney ultimately approves the application, and the mark is not republished, the Board administrative staff member will issue an action so advising potential opposer and applicant and approving the extension of time (or, if already approved, noting that potential opposer has been granted an extension of time to oppose until a specified date). If the mark is republished, or if registration is ultimately denied, the extension request, if not yet granted, will be moot. No further extension of the original opposition period will be granted. Rather a potential opposer's time for opposing will recommence on the date of republication.

If, during the running of an extension of time, the letter of protest is denied, the Board will so advise potential opposer and applicant and take appropriate action on the extension request.

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One copy of the Board's action will be placed in the file of the subject application, one copy will be mailed to the applicant, and one copy each of the Board's action and of the Examining Attorney's Office action will be mailed to the potential opposer.

If opposer files a timely opposition while its letter of protest is pending (or if the letter of protest is granted, while the question of registrability is still before the Examining Attorney), the Board will institute the opposition. At the same time, however, the Board will normally suspend the opposition until the letter of protest is decided (or, if the letter of protest has already been granted, until the registrability of the mark has been finally determined). If, along with the notice of opposition, the opposer files a motion to suspend the opposition, citing the filing of its letter of protest (or the restoration of jurisdiction) as the reason for suspension, the Board will institute the opposition, grant the motion to suspend, and state that the opposition is suspended pending a decision on the letter of protest (or if the letter of protest has already been granted, pending final determination of the application before the Examining Attorney). A copy of the Board's letter will be sent to both parties, and a copy of the notice of opposition along with a copy of the motion to suspend will be sent to the applicant.

If the Examining Attorney subsequently approves the application, and the mark is republished, and if the change reflected in the republication is one that might have an effect upon the opposition, the Board will issue an action notifying opposer and applicant of the republication. The Board will inform them of the reason for republication; explain that the opposition will be determined on the basis of applicant's correct (or amended) mark, goods or services, disclaimer status, etc.; and allow the opposer time to indicate whether it wishes to proceed with the opposition on that basis, or to have its opposition fee refunded and the opposition dismissed as a nullity. If opposer chooses to go forward, proceedings in the opposition will be resumed, and appropriate dates will be set.

If registration is ultimately denied, the opposition will not be instituted, or if already instituted, will be dismissed as a nullity and the fee refunded.

216 Inadvertently Issued Registration

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

The Board is without authority, within the context of either an extension of time to oppose, or an opposition proceeding, to cancel an inadvertently issued registration and restore it to application status. Rather, it is the Director who has such authority, and the Director exercises this authority with caution.⁸⁷ A registration will ordinarily be deemed to have been issued inadvertently if a

⁸⁷ See *In re Trademark Registration of Mc Lachlan Touch Inc.*, 6 USPQ2d 1395, 1396 (Comm'r 1987).

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notice of opposition or a request for extension of time to oppose was timely and properly filed but inadvertently overlooked by the Board.⁸⁸ The Director will not find that a registration issued inadvertently if (1) the notice of opposition was defective in some manner, and (2) that defect prevented the Office from identifying the application in question, and from withholding the issuance of a registration.⁸⁹

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

The inadvertent issuance of the registration will be considered good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark, but it will not constitute extraordinary circumstances justifying an extension of time beyond 120 days from publication.

If, during the running of an extension of time, the Director cancels and restores to application status a registration that issued inadvertently during an extension of time to oppose, the potential opposer and applicant will be informed of the inadvertent issuance of the registration, its cancellation by the Director, and the status of the extension request in an action prepared by a Board administrative staff member.

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

If a timely opposition is filed while the matter of the registration is pending before the Director, the Board will institute the opposition. At the same time, however, the Board will normally

⁸⁸ See *Quality S. Manufacturing Inc. v. Tork Lift Central Welding of Kent, Inc.*, 60 USPQ2d 1703, 1704 (Comm'r 2000).

⁸⁹ See *Quality S. Manufacturing Inc. v. Tork Lift Central Welding of Kent, Inc.*, *supra* at 1704 (where notice of opposition misidentified the serial number of opposed application, Director declined to cancel registration finding that error which caused the registration to issue was made by opposer not as result of inadvertent act by the Office).

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suspend the opposition until the matter is resolved. If, with the notice of opposition, the opposer files a motion to suspend the opposition, citing the inadvertently issued registration as the reason for suspension, the Board will institute the opposition, grant the motion to suspend, and state that the opposition is suspended pending a decision on the matter of the registration. A copy of the Board's action will be sent to both parties, and a copy of the notice of opposition, will be sent to the applicant with a copy of the motion to suspend.

If the Director cancels and restores the registration to application status, the opposition will be resumed and appropriate dates will be set. If the Director declines to cancel the registration, the opposition will be dismissed as a nullity and the fee will be refunded.

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

217 Relinquishment of Extension

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

If a potential opposer that has requested or obtained an extension of time to oppose thereafter agrees unconditionally in writing not to oppose, applicant may submit a copy of the agreement to the Board, with an appropriate cover letter bearing proof of service upon potential opposer, and the Board will immediately forward the subject application to issue.⁹⁰

218 Abandonment of Application

If an applicant files an express abandonment of an application that is the subject of a pending request for an extension of time to oppose, or of a granted extension, the application stands abandoned and any pending request for an extension of time to oppose is moot. An application that has been abandoned is no longer subject to the filing of a new opposition. Any opposition filed on or after the filing date of the abandonment will be returned by the Board to the opposer, and the opposition fee will be refunded.⁹¹

⁹⁰ Cf. TBMP § 212.06 (Action by Board—After Consideration of Amendment).

⁹¹ See *Societe des Produits Nestle S.A. v. Basso Fedele & Figli*, 24 USPQ2d 1079, 1081 n.1 (TTAB 1992) and *In re First National Bank of Boston*, 199 USPQ 296, 297 (TTAB 1978) (notice of opposition and abandonment both filed on same day; no opposition). Cf. TBMP § 602.01 (Withdrawal by Applicant).

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The express abandonment of an application that is not the subject of an inter partes proceeding before the Board (i.e., an opposition, interference, or concurrent use proceeding) is without prejudice to the applicant. It is not necessary that applicant obtain a potential opposer's consent thereto.⁹²

In contrast, after the commencement of an opposition, interference, or concurrent use proceeding, if an applicant files an express abandonment of its application or mark without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant.⁹³ However, if an applicant files an abandonment after the commencement of an opposition, interference, or concurrent use proceeding, but before applicant has been notified thereof by the Board, the applicant will be given an opportunity to obtain the written consent of every adverse party, or to withdraw the abandonment and litigate the proceeding, failing which judgment shall be entered against applicant.⁹⁴

An applicant may expressly abandon its application by filing in the USPTO a written statement of abandonment or withdrawal of the application, signed by the applicant or by the applicant's attorney or other authorized representative.⁹⁵

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

219 Amendment to Allege Use; Statement of Use

An amendment to allege use under Section 1(c) of the Act, 15 U.S.C. § 1051(c), filed in an intent-to-use application (i.e., an application under Section 1(b) of the Act, 15 U.S.C. § 1051(b)) after approval for publication is late-filed.⁹⁶ Thus, *an amendment to allege use filed during an extension of time to oppose or during an opposition is late-filed.*

⁹² See 37 CFR § 2.68.

⁹³ See 37 CFR § 2.135.

⁹⁴ See *In re First National Bank of Boston*, *supra*. Cf. TBMP § 602.01 (Withdrawal by Applicant).

⁹⁵ See 37 CFR § 2.68.

⁹⁶ See 37 CFR § 2.76(a); and *In re Sovran Financial Corp.*, 25 USPQ2d 1537, 1538 (Comm'r 1992) (amendment to allege use filed during blackout period denied as untimely).

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A statement of use under Section 1(d) of the Act, 15 U.S.C. § 1051(d), is premature if it is filed in an intent-to-use application prior to the issuance of a notice of allowance under Section 13(b)(2) of the Act, 15 U.S.C. § 1063(b)(2).⁹⁷ A notice of allowance is issued in an intent-to-use application (for which no amendment to allege use has been timely filed and accepted) only after the time for opposing has expired and all oppositions filed have been dismissed.⁹⁸ Thus, *a statement of use filed during an extension of time to oppose or during an opposition is premature.*

Any late-filed amendment to allege use or premature statement of use will be returned to the applicant, and any fee submitted therewith will be refunded.⁹⁹

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

The Board will then return the application to the Trademark Examining Attorney for appropriate action with respect to the amendment to allege use. The Examining Attorney, in turn, will process the amendment to allege use in the same manner¹⁰⁰ as any other timely filed amendment to allege use that is not associated with the application file until after publication. In the event that the amendment to allege use is ultimately withdrawn by the applicant, or approved by the Examining Attorney, the Examining Attorney should return the application to the Board (before any scheduled republication of applicant's mark) for further appropriate action with respect to the extension of time to oppose.¹⁰¹ If the application is abandoned while it is before the Examining Attorney, the Board should be notified.

The filing of the amendment to allege use will be considered good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark, but it will not

⁹⁷ See Section 1(d)(1) of the Act, 15 U.S.C. § 1051(d)(1), and 37 CFR § 2.88(a).

⁹⁸ See Section 13(b)(2) of the Act, 15 U.S.C. § 1063(b)(2), and 37 CFR § 2.81(b).

⁹⁹ See 37 CFR §§ 2.76(a) and 2.88(a).

¹⁰⁰ Described in TMEP § 1104.04.

¹⁰¹ See TMEP § 1104.04.

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constitute extraordinary circumstances justifying an extension of time beyond 120 days from publication.

If an intent-to-use application has already been published, and is the subject of an opposition, when a timely filed amendment to allege use (i.e., an amendment to allege use filed prior to approval for publication) is associated with the application, the Board normally will suspend the opposition and return the application to the Trademark Examining Attorney for appropriate action¹⁰² with respect to the amendment to allege use. In the event that the amendment to allege use is ultimately withdrawn by the applicant, or approved by the Examining Attorney, the Examining Attorney should return the application to the Board (prior to any scheduled republication of applicant's mark) for further appropriate action with respect to the opposition.¹⁰³ If the application is abandoned while it is before the Examining Attorney, the Board should be notified.

220 Inadvertent Issuance of a Notice of Allowance

Sometimes a notice of allowance is issued mistakenly in an intent-to-use application that, at the time of such issuance, is the subject of an unexpired extension of time to oppose or a timely opposition. If a notice of allowance is inadvertently issued in an intent-to-use application which is the subject of an unexpired extension of time to oppose or a timely opposition, and a statement of use is filed, the notice of allowance will be cancelled (by the Intent To Use Division of the Office of Trademark Services) as inadvertently issued. The statement of use will be returned, and the fee submitted therewith will be refunded. If the inadvertently issued notice of allowance has already been cancelled when the Board receives the statement of use, the Board itself will return the statement of use and refund the fee submitted therewith. If the inadvertently issued notice of allowance has not already been cancelled when the Board receives the statement of use, the Intent To Use Division will return the statement of use and refund the fee when it cancels the notice of allowance.

Sometimes a notice of allowance issues between the time an extension request is submitted but not yet approved. Additionally, by the time the Board receives the file for action the extension requested has expired, and no opposition or further extension requests have been filed. In that case, the Board will issue an action acknowledging the extension request; indicating that it was well taken but that time has since expired and no opposition or further request has been filed. The Board will also indicate that a notice of allowance was inadvertently issued during the requested extension period, but since the requested time period has run without subsequent action by the potential opposer, the notice of allowance will not be withdrawn.

¹⁰² As described in TMEP § 1104.04.

¹⁰³ See TMEP § 1104.04.