

Chapter 700

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701 Statutory Authority for Examination

Extract from 15 U.S.C. §1062.

(a) Upon the filing of an application for registration and payment of the prescribed fee, the Director shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made....

(b) If the applicant is found not entitled to registration, the examiner shall advise the applicant thereof and of the reason therefor. The applicant shall have a period of six months in which to reply or amend his application, which shall then be reexamined. This procedure may be repeated until (1) the examiner finally refuses registration of the mark or (2) the applicant fails for a period of six months to reply or amend or appeal, whereupon the application shall be deemed to have been abandoned, unless it can be shown to the satisfaction of the Director that the delay in responding was unintentional, whereupon such time may be extended.

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702 Order of Work

702.01 Order of Examination

In general, examining attorneys should examine applications in the order in which they are received in the Office, unless the application is made “special.” See TMEP §702.02 regarding “special” applications.

Generally, amended applications (*i.e.*, applications that contain a response from the applicant), remands from the Trademark Trial and Appeal Board, and statements of use are also reviewed in the order in which they are received in the Office.

Examining attorneys should act on applications that have been suspended as soon as they are removed from suspension. See TMEP §§716 *et seq.* regarding suspension.

Examining attorneys should immediately act on inquiries regarding applications approved for publication or issue that are returned to the examining attorney to take action or provide information.

Where appropriate, the managing attorney may direct that a particular case be given special handling.

When an examining attorney resigns, the examining attorney should spend his or her remaining time in the Office acting on older cases or those with involved records, and in getting his or her amended cases (including statements of use under 15 U.S.C. §1051(d) and appeal briefs) ready for final disposition.

702.02 “Special” Applications

While the Office normally processes applications in the order in which they are received, there is a procedure whereby an application can be made “special,” and thereby expedited. The following applications are deemed “special” and should be expedited.

- (1) *Petition to Make Special Granted.* Applications made “special” as a result of a petition under 37 C.F.R. §2.146 (*see* TMEP §§1710 *et seq.*);
- (2) *Registration Inadvertently Cancelled Under 15 U.S.C. §1058 or §1059.* A new application for registration of a mark that was the subject of a previous registration that was inadvertently cancelled or expired under 15 U.S.C. §1058 or §1059 will be made “special” upon the applicant’s request. No petition fee is required in this situation. However, *both the mark and the goods or services in the new application must be identical to the mark and goods or services in the cancelled or expired registration*, or the Office will not make the application “special.” To ensure that these applications are processed as “special,” the applicant should include a cover letter requesting that the application be made “special,” together with a copy of the cancelled or expired registration, when filing the application; and

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- (3) *Revived or Reinstated Applications.* Applications that have been abandoned and then revived or reinstated are made “special.” See TMEP §1712.01 regarding requests for reinstatement, and TMEP §1714 regarding petitions to revive. The applicant does not have to file a separate petition to make “special” in these situations.

Once an application is made “special,” the file wrapper is flagged accordingly. Legal docket review clerks in the law offices should put new applications marked “special” at the front of the new case docket. The examining attorney should promptly examine any application that has been made “special.”

Once an application is made “special,” the Office will expedite initial examination, examination of responses and amendments, and appeal. However, the Office cannot change the publication and issuance cycles. Therefore, “special” status terminates when the date of publication in the *Official Gazette* is assigned to the application.

702.03 Related Applications

702.03(a) Companion Applications

The term “companion applications” refers to pending applications filed by the same applicant. An application is pending until it registers or abandons. Pending applications include applications that have been approved for publication or for registration on the Supplemental Register, applications in the ITU Unit of the Office, and revived or reinstated applications.

When assigned a new application, the examining attorney must search the Office’s automated records to determine whether the applicant has any companion applications. If the applicant has companion applications, the examining attorney must follow the procedures set forth in TMEP §§702.03(a)(i) through (a)(iv).

702.03(a)(i) Companion Applications for the Same or Similar Marks [R-2]

If an applicant has multiple pending applications for the same or similar mark(s), the issues in the applications are likely to be similar.

The examining attorney must check the Trademark Reporting and Monitoring (TRAM) automated system to determine whether a companion application has been assigned to an examining attorney. If TRAM indicates that the companion application has not been assigned, the examining attorney is encouraged to send an e-mail request for the unassigned file to the supervisory legal instruments examiner (SLIE) in the law office where the file is located.

If TRAM indicates that a companion application was previously assigned to a different examining attorney, the examining attorney should **not** transfer his or her application to that person. However, the examining attorney should review the file of the earlier companion application before taking action in a later companion case, and should act consistently, unless

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it would be clear error to do so. If the Examining Attorney believes that acting consistently with the prior action(s) would be erroneous, he or she should bring the issue to the attention of the managing attorney or senior attorney.

See TMEP §702.03(a)(iv) regarding classification and identification in companion applications that have been published for opposition.

702.03(a)(ii) Companion Applications for Different Marks

If an applicant has multiple pending applications, but the companion applications are not for the same or similar marks, examining attorneys should *not* transfer the companion cases to one examining attorney. However, examining attorneys should act consistently in companion cases, unless it would be clear error to do so. If necessary, the examining attorney should review the case file for an earlier companion application before taking action in a later companion case.

See TMEP §702.03(a)(iv) regarding classification and identification in companion applications that have been published for opposition.

702.03(a)(iii) Companion Registrations

If the applicant previously filed another application that has matured into a registration, the examining attorney should *not* transfer his or her application to the prior examining attorney. Generally, in the later application, the examining attorney should act consistently with the registration, unless it would be clear error to do so. However, the Office is not bound by the decisions of the examiners who examined the applications for the applicant's previously registered marks, based on different records. Eligibility for registration must be determined on the basis of the facts that exist at the time registration is sought. *See* TMEP §1216.01 and cases cited therein.

See TMEP §702.03(a)(iv) regarding classification and identification in companion registrations.

702.03(a)(iv) Classification and Identification in Companion Applications That Have Registered or Been Published for Opposition

If a companion application has been published for opposition or has registered, the examining attorney may presume that the classification and identification of goods or services in the companion application or registration are acceptable, unless the identification or classification is clearly wrong. If the examining attorney accepts the classification and identification of goods or services because they were accepted in a companion application or registration, the examining attorney should note the companion application serial number or registration number in the "Notes to the File" section of the file wrapper.

Sometimes the classification and identification of goods or services in the prior companion application or registration will be clearly wrong. For example, the Nice Agreement

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classification system (*see* TMEP §§1401.02 *et seq.*) and Office policy on acceptable identifications change periodically. In these cases, the examining attorney cannot adopt the classification and identification listed in the companion application or registration.

702.03(b) Conflicting Applications

The term “conflicting applications” refers to two or more pending applications that are filed by different applicants and may ultimately require a refusal of registration under §2(d) of the Trademark Act, 15 U.S.C. §1052(d), due to a likelihood of confusion between the marks. When assigned a new application, the examining attorney must search the Office’s automated records to determine whether there are any conflicting applications. If there are conflicting applications, the examining attorney should *not* transfer the conflicting application to the examining attorney who acted on the first conflicting application. Instead, the examining attorney should simply examine the assigned application and issue an Office action that includes a notice to the applicant that there is a prior-filed application to register a mark that may be likely to cause confusion with the applicant’s mark. *See* TMEP §§1208 *et seq.* The actions of the examining attorney handling the later-filed application should be consistent with the actions of the examining attorney who handled the earlier-filed application, unless it would be clear error to act consistently. If necessary, the examining attorney should review the case file for the earlier application before taking an action in the later-filed conflicting application.

703 Office Does Not Issue Duplicate Registrations

The Office will not issue two or more identical registrations. Applications filed under §1 of the Trademark Act are considered identical if the only difference between them is that one is based on use in commerce under §1(a) and the other is based on intent-to-use under §1(b). However, an application filed under §1 and an application filed under §44 that are otherwise identical are *not* regarded as duplicate registrations.

If two applications would result in registrations that are exact duplicates, the Office will permit only one application to mature into registration, and will refuse registration in the other application. If practicable, the Office will permit the applicant to choose which application should mature into registration.

When an application is a duplicate of a registration owned by the applicant, and Office records show that the registration is still active, the examining attorney must refuse registration. If the registration is subject to cancellation for failure to file an affidavit of continued use or excusable nonuse under 15 U.S.C. §1058, or due to expire for failure to file a renewal application under 15 U.S.C. §1059, the examining attorney should suspend the application until the TRAM system is updated to show that the registration is cancelled or expired. *See* TMEP §1611 for information about how a registrant who has not timely filed a §8 affidavit or renewal application may expedite the cancellation or expiration of its own registration.

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A typed drawing and a special form drawing of the same mark are not considered identical. Also, identifications that include some of the same goods or services but also different goods or services are not identical.

If eligible, marks registered under the Acts of 1881, 1905 and 1920 may also be registered under the Act of 1946 (*see* §46(b) of the Trademark Act of 1946). If the mark and the goods or services in a registration issued under the 1946 Act are identical to the mark and goods or services in a registration issued under a prior Act, the registrations are not considered duplicates. *See* TMEP §§1601.04, 1601.05, 1602.02 and 1602.03 regarding registrations issued under prior Acts.

704 Initial Examination

704.01 Initial Examination Should be Complete

37 C.F.R. §2.61(a). Applications for registration, including amendments to allege use under §1(c) of the Act, and statements of use under §1(d) of the Act, will be examined and, if the applicant is found not entitled to registration for any reason, applicant will be notified and advised of the reasons therefor and of any formal requirements or objections.

The initial examination of an application by the examining attorney should be a *complete* examination. A complete examination includes a search for conflicting marks and an examination of the written application, the drawing and any specimen(s), to determine whether the mark is eligible for the type of registration requested, whether amendment is necessary, and whether all required fees have been paid.

If, on initial examination, the examining attorney finds the mark in an application for registration on the Principal Register to be in condition for publication for opposition, the examining attorney will not issue an Office action. The examining attorney will approve the application for publication. Similarly, if the examining attorney finds the mark in an application for registration on the Supplemental Register to be in condition for registration, the examining attorney will approve the application for registration. The Publication and Issue Section of the Office will send a notice of publication or certificate of registration to the applicant, in due course.

If the application is not in condition to be approved for publication or issue, the examining attorney will write, call or e-mail the applicant, informing the applicant of the reason(s) why the mark may not be registered and of the defect(s) that can be corrected or amended to make the application acceptable.

The examining attorney's first Office action should be complete, so the applicant will be advised of all requirements for amendment and all grounds for refusal, with the exception of use-related issues that are considered for the first time in the examination of an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d) in an intent-to-use application. *See* TMEP §§1102.01 and 1202 *et seq.* regarding use-related issues that are considered for the first time in the examination of an amendment to allege use or a statement of use. Every effort should be made to avoid piecemeal prosecution, because it

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prolongs the time needed to dispose of an application. *See also* TMEP §706 regarding new issues raised by the examining attorney after the first Office action.

Examining attorneys should also clearly explain all requirements. For example, if the identification of goods or services is indefinite, the examining attorney should explain to the applicant why the identification is not acceptable and, if possible, suggest an acceptable identification. *See* TMEP §§705 *et seq.* for further information about examining attorneys' Office actions.

704.02 Examining Attorney's Search

After conducting a search, the examining attorney must place a copy of the search strategy in the file.

If the examining attorney finds no conflicting marks, but must write to the applicant about other matters, the examining attorney must inform the applicant that no conflicting marks have been found. This is commonly called the "search clause."

If the examining attorney cannot make a proper search or cannot examine the application properly due to lack of adequate information, the examining attorney should specifically indicate what information is needed, request that it be furnished, and state that further action on the matter will be taken as soon as the information is received. *See* TMEP §814 regarding requirements for additional information.

704.03 Supervisory Examining Attorney May Indicate Action for Non-Signatory Examining Attorney

When a non-signatory examining attorney examines an application, a supervisory examining attorney must thoroughly review the action. The usual procedure is for the non-signatory examining attorney to explain relevant information to the supervisory examining attorney, discussing any reference marks or other grounds for refusal, and any requirements or objections. The supervisory examining attorney may indicate the action to be taken.

705 The Examining Attorney's Letter or Action

If an examining attorney determines that a mark is not entitled to registration, or that amendment is required, the examining attorney will notify the applicant in a written Office action, or by a telephone conversation that is normally followed by a written action. This constitutes the examining attorney's official action.

Written Office actions may be of a variety of styles, including: (1) an "examiner's amendment," in which the examining attorney formally makes amendments to the application (*see* TMEP §§707 *et seq.*); (2) a "priority action," setting forth requirements and/or reasons for refusal discussed by telephone with the applicant or the applicant's attorney (*see* TMEP §§708 *et seq.*); (3) a letter explaining bases for refusal and requirements; (4) an examiner's amendment combined with a priority action (*see* TMEP §708.05); or (5) a

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suspension notice (*see* TMEP §§716 *et seq.*). Office actions may be prepared through the use of standardized form paragraphs, or written specifically to address the particular facts. The examining attorney may send the Office action by regular mail, fax, or by e-mail, if the applicant has authorized e-mail communications. *See* TMEP §§304 *et seq.* regarding electronic mail.

The Office encourages the use of examiner's amendments and priority actions, whenever appropriate.

705.01 Language in Examining Attorney's Letter

The examining attorney should indicate the status of the application at the beginning of each letter.

In first actions, this may be done by stating that the examining attorney has reviewed the application and made the determinations that follow, or by using language such as "Upon examination of this application...." The examining attorney should acknowledge any paper received before the first action by identifying the paper and the date of its receipt.

In second or subsequent actions, examining attorneys should begin letters with a sentence such as, "This letter responds to the communication filed on _____ [date]." Other papers received, such as supplemental amendments, affidavits, and new drawings, should also be acknowledged.

Refusals to register should be couched in the statutory language of the section of the Trademark Act that is the basis of the refusal, and the examining attorney should cite the appropriate section of the Act. For example, registration of a trademark should not be refused "because it is a surname," but "because it *consists of matter that is primarily merely a surname under §2(e)(4) of the Trademark Act.*"

Registration must be refused only as to the specific register (*i.e.*, Principal or Supplemental) for which registration is requested. However, when refusing registration on the Principal Register, the examining attorney should also state, to the extent possible, whether the record indicates that an amendment to the Supplemental Register or to seek registration on the Principal Register under §2(f) may be appropriate.

The words "capable" and "incapable" should be reserved for the Supplemental Register.

Examining attorneys are encouraged to use form paragraphs to accelerate the preparation of Office actions and increase the uniformity of the substance and appearance of these actions. However, examining attorneys should use the form paragraphs only if they apply to a particular situation, and should expand on the form paragraphs when necessary to explain any requirements or refusals.

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705.02 Examining Attorneys Should Not Volunteer Statements

In Office actions, and e-mail and telephone communications, examining attorneys should not volunteer statements about applicants' rights that are gratuitous and unnecessary to the examination of the matters presented in applications. The examining attorney's responsibility is limited to evaluating the registrability of the mark presented in the application. *See In re American Physical Fitness Research Institute Inc.*, 181 USPQ 127 (TTAB 1974). *See also* TMEP §1801.

705.03 Citation of Reference Marks

When refusing registration under 15 U.S.C. §1052(d) based on a likelihood of confusion with a previously registered mark, the examining attorney must give the registration number(s), attach a copy (or electronic equivalent) of each cited registration to the Office action, and place a copy of the cited registration in the application file. The examining attorney should explain the reasons that the mark in each cited registration is grounds for refusal under §2(d).

If an applicant notifies the Office that the Office failed to attach a copy (or electronic equivalent) of a cited registration, the Office will re-mail the Office action with a new mailing date.

705.04 Reference to Matter in Printed Publications

When the examining attorney refers to matter in a printed publication, the examining attorney should provide the citation for the publication, and include a copy of the relevant material with the Office action.

It is not necessary to send a photocopy of a published legal decision to an applicant's attorney. A citation is sufficient. *See* TMEP §705.05 regarding citation of decisions.

See TMEP §710.01(a) regarding evidence from a research data base.

705.05 Citation of Decisions and Office Publications

When citing court or administrative decisions, the *United States Patents Quarterly* (USPQ or USPQ2d) citation should be given. If convenient, a parallel citation to the United States Reports (U.S.), Federal Reporter (F., F.2d, or F.3d) or Federal Supplement (F. Supp. or F. Supp.2d) should be given. The court or tribunal (2d Cir., C.C.P.A., Fed. Cir., TTAB, etc.) and the date of the decision should always be given.

The examining attorney may cite sections of the *Trademark Manual of Examining Procedure* (TMEP) or *Trademark Trial and Appeal Board Manual of Procedure* (TBMP). The abbreviations "TMEP" and "TBMP" are usually sufficient; however, if the person prosecuting the case appears to be unfamiliar with Office practice, the examining attorney should identify the Manuals by their full names in the first citation to the Manuals. It is not necessary to provide a copy of the relevant section(s) of the Manuals.

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When the examining attorney cites a Director's order or notice, the examining attorney should provide the title and date of the notice, and the specific issue of the *Official Gazette* in which it may be found. The examining attorney should also send a copy of the order or notice to the applicant.

Unpublished decisions that are not available to the public should not be cited. Regarding citation of "unpublished" or "digest" decisions, the Trademark Trial and Appeal Board has stated as follows:

Upon reflection the Board has decided that citation of "unpublished" or "digest" Board decisions as precedent will no longer be allowed. In the future, the Board will disregard citation as precedent of any unpublished or digest decision. Even if a complete copy of the unpublished or digest decision is submitted, the Board will disregard citation as precedent thereof. An exception exists, of course, for those situations in which a party is asserting issues of claim preclusion, issue preclusion, judicial estoppel, law of the case or the like based on a decision of the Board rendered in a nonprecedential (*i.e.*, unpublished or digest) decision.

General Mills Inc. v. Health Valley Foods, 24 USPQ2d 1270, 1275 n.9 (TTAB 1992).

This policy applies to both *ex parte* and *inter partes* cases. Accordingly, examining attorneys should not cite unpublished or digest decisions as precedent in Office actions or appeal briefs, and should not send informational copies of unpublished decisions with Office actions.

705.06 Reviewing, Initialing and Signing of Letters

The name, law office, telephone number, and e-mail address of the examining attorney who prepares the action will be typed at the bottom of the action.

The examining attorney must review and sign the action. If the examining attorney does not have signatory authority, he or she should sign the action and forward the action and file to the authorized signatory examining attorney, who will initial the action. Initialing by a reviewer should ordinarily be done within one working day after receipt from the non-signatory examining attorney.

705.07 Mailing and Processing Letters

The date is placed on all copies of paper Office actions when they are being mailed. For outgoing e-mail communications, the date is applied automatically when the communication is released to the Office's electronic mail system.

The original action signed by the authorized examining attorney is placed in the file wrapper. One copy of any evidence that supports the examining attorney's action, and one copy of registered marks or pending applications cited as a bar to registration, should be placed in the file wrapper and one copy should be mailed to the applicant with the action.

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705.08 Six-Month Response Clause

Generally, the examining attorney's letter or Office action should include a "six-month response clause" notifying the applicant that the applicant must respond to the action within six months of the mailing date to avoid abandonment under 15 U.S.C. §1062(b). *See* TMEP §711 *et seq.* regarding the deadline for response to an Office action.

The examining attorney should *not* include a six-month response clause in an examiner's amendment (*see* TMEP §§707 *et seq.*), suspension notice (*see* TMEP §§716 *et seq.*), or in a situation where the time for response runs from the mailing date of a previous action (*see* TMEP §§711.01 and 715.03(c)).

706 New Matter Raised by Examining Attorney After First Action

If in the first Office action the examining attorney inadvertently failed to refuse registration on a clearly applicable ground or to make a necessary requirement, the examining attorney must take appropriate action to correct the inadvertent error in a subsequent action. Examining attorneys should exercise great care to avoid these situations, and should take this step only when absolutely necessary. After the first action, supervisors (*e.g.*, supervisors reviewing the quality of the examining attorney's work) should not introduce any new reason for refusal that is not clearly justified under the Act or rules.

Since it is unusual to make a new refusal or requirement that could have been raised in the first action, an examining attorney who does make a new refusal or requirement should clearly explain why the refusal or requirement is necessary, and apologize for the delay in raising the issue, if appropriate. *See* TMEP §711.02 regarding supplemental Office actions.

Sometimes the examining attorney must issue a new refusal or requirement because the applicant submits information that raises a new issue.

See TMEP §1109.08 regarding application of the "clear-error" standard in the examination of statements of use under §1(d) of the Act.

707 Examiner's Amendment

An examiner's amendment should be used whenever appropriate to expedite prosecution of an application. The examiner's amendment is a communication to the applicant in which the examining attorney states that the application has been amended in a specified way. Except in the situations listed in TMEP §707.02, the amendment must be authorized by the applicant or the applicant's attorney. Authorization is usually given in a telephone conversation, e-mail communication (if the applicant has authorized e-mail communications), or interview between the examining attorney and the applicant or the applicant's attorney. *See* TMEP §§304 *et seq.* regarding e-mail.

The examining attorney may issue an examiner's amendment whenever the required amendment does not have to be verified by the applicant. For example, in appropriate circumstances, an examiner's amendment may be used to amend the identification of goods

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or services, enter a disclaimer, add the state of incorporation or change from the Principal to the Supplemental Register.

The following matters may *not* be changed by examiner's amendment: the dates of use, if verification would be required (*see* TMEP §903.05); the mark on a special form drawing, if the changes would require the filing of a substitute special form drawing (*see* TMEP §807.07); and amendments that require the submission of substitute specimen(s) (*see* TMEP §904.09). An application cannot be expressly abandoned (*see* TMEP §718.01) by examiner's amendment.

Examiner's amendments are generally used when there are no statutory refusals. However, if there is a potential statutory refusal, and an amendment will obviate the refusal, the examining attorney may attempt to resolve the issues through an examiner's amendment. For example, in appropriate cases, the applicant may overcome a surname refusal of a mark that is in use in commerce by amending the application to the Supplemental Register.

A non-signatory examining attorney must have proper authorization from the managing attorney, senior attorney, or a reviewing examining attorney before initiating an examiner's amendment.

See TMEP §707.03 regarding the form of an examiner's amendment.

A written response by the applicant is not required for an examiner's amendment. Applicants should *not* file correspondence confirming an examiner's amendment, because this will delay processing of the application.

If the applicant or counsel wishes to object to the examiner's amendment, this should be done immediately (preferably by phone, e-mail or fax), so that the objection can be considered before publication or issue. *See* TMEP §1402.07(e) regarding an applicant's objection to an examiner's amendment of the identification of goods or services on the ground that the examiner's amendment does not reflect the agreement between the applicant and the examining attorney.

Often an applicant will seek to respond to an outstanding Office action with an amendment or other response by telephone. The examining attorney is encouraged to enter an examiner's amendment if this amendment will immediately place the application in condition for publication for opposition, issuance of a registration, or suspension. *See* TMEP §§716 *et seq.* regarding suspension. However, an applicant or an applicant's attorney does not have a right to the entry of an examiner's amendment in response to an Office action. If the applicant does not agree to an amendment that the examining attorney believes will immediately place the application in condition for publication for opposition or issuance of a registration, the applicant must file a complete written response to the outstanding Office action.

See TMEP §708.05 regarding combined examiner's amendment/priority actions.

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707.01 Approval of Examiner's Amendment by Applicant or Applicant's Attorney

Ordinarily, the examining attorney may amend the application by examiner's amendment only after securing approval of the amendment from the applicant or the applicant's attorney by telephone or e-mail, or in person during an interview. *See* TMEP §707.02 regarding situations when an examiner's amendment is permitted without prior authorization by the applicant or the applicant's attorney.

The broad definition of "persons properly authorized to sign on behalf of an applicant" in 37 C.F.R. §2.33(a) (*see* TMEP §804.04) does not apply to examiner's amendments. Only the applicant or the applicant's attorney can authorize an examiner's amendment. If the applicant has an attorney, the examining attorney must speak to the attorney of record. If the applicant is *pro se*, the examining attorney must speak to the individual applicant or to someone with legal authority to bind a juristic applicant (*e.g.*, a corporate officer or general partner of a partnership). 37 C.F.R. §10.14(e). For joint applicants who are not represented by an attorney, each joint applicant must authorize the examiner's amendment.

A non-attorney who is authorized to verify facts on behalf of an applicant under 37 C.F.R. §2.33(a)(2) is *not* entitled to authorize an examiner's amendment unless he or she has legal authority to bind the applicant. *See* TMEP §§712.01 *et seq.* for guidelines on persons who have legal authority to bind various types of applicants.

If an examining attorney contacts an applicant and reaches agreement to issue an examiner's amendment, but later determines that an Office action must be issued instead to state a refusal or requirement, the examining attorney should telephone the applicant immediately to advise the applicant of the change of position.

Examining attorneys without partial signatory authority should generally advise applicants that issuance of the examiner's amendment is subject to approval by a supervisory attorney.

707.02 Examiner's Amendment Without Prior Authorization by Applicant or Applicant's Attorney

Examining attorneys have the discretion to amend applications by examiner's amendment without prior approval by the applicant or the applicant's attorney, in the following situations:

- (1) changes to international classification, either before or after publication (*see Groening v. Missouri Botanical Garden*, 59 USPQ2d 1601 (Comm'r Pats. 1999) regarding amendments to international classification after publication);
- (2) deletion of "TM," "SM," "©" or "®" from the drawing;
- (3) addition of a formal description of the mark where it is necessary (*see* TMEP §§808 *et seq.*) *and* where the record already contains an informal indication of what the mark comprises;

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Example - The cover letter with the application refers to the mark as a stylized golf ball design. If appropriate, the examining attorney could enter an amendment that “the mark consists of the stylized design of a golf ball.”

- (4) amendment of the application to clarify that the mark is in typed form when the record clearly indicates that the drawing is intended to be in typed form;
- (5) addition of lining and stippling statements, other than color lining statements, where the statement is necessary (*see* TMEP §807.09(e)), and where the significance of the lining or stippling is indicated by the specimen or other information of record;
- (6) correction of obvious misspellings in the identification of goods and services.

Example - The goods are recited as “T-shurtz.” The examining attorney could amend to “T-shirts.” However, “shirtz” could not be amended to “shirts” without calling the applicant, because “shirtz” (without the “T-” prefix) might also be a misspelling of “shorts.”

If the examining attorney must contact the applicant or the applicant’s attorney about other matters, or if the record contains any ambiguity as to the applicant’s intent, the examining attorney should advise the applicant that the above changes have been made.

A copy of the examiner’s amendment will be mailed to the applicant or applicant’s attorney. Any applicant or applicant’s attorney who disagrees with any of these changes should contact the examining attorney immediately after receipt of the examiner’s amendment, preferably by phone, e-mail or fax.

707.03 Form of the Examiner’s Amendment [R-2]

An examiner’s amendment should include the following information: the name, telephone number and e-mail address of the examining attorney; the name of the person interviewed; the date of the interview; the actual amendment; and, if applicable, a statement to the effect that the amendment has been authorized by the applicant or the applicant’s attorney.

The examiner’s amendment should not include a six-month response clause, because a written response by the applicant is not required for an examiner’s amendment.

The examiner’s amendment should include a search clause (*see* TMEP §704.02) if it is a first action or if the applicant has not previously been advised of the results of a search.

The examining attorney should not state in the examiner’s amendment that the application is ready for publication or issue, because some unforeseen circumstance might require that further action be taken in the application.

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708 Priority Action

708.01 Priority Action Defined

A “priority action” is an Office action that is issued following a telephone interview, personal interview, or e-mail communication in which the examining attorney and the applicant or applicant’s attorney discuss the various issues raised in an application, and the applicant agrees to take some action that will place the application in condition for publication or registration. The use of priority actions is encouraged to expedite examination.

A priority action should be issued according to the following procedure: (1) the examining attorney telephones or e-mails the applicant or applicant’s attorney, and requests that the applicant take some specific action, explaining the reasons; (2) the applicant or applicant’s attorney agrees to take the action; (3) the examining attorney prepares and signs a priority action indicating the requirements with which the applicant should comply; and (4) the Office sends a copy of the priority action to the applicant or applicant’s attorney.

If an applicant responds within two months of the mailing date of the priority action, the examining attorney will expedite examination of the response. If the applicant does not respond within two months, the applicant must still file a proper response within six months of the mailing date of the priority action to avoid abandonment. 15 U.S.C. §1062(b).

A priority action is sometimes appropriate where there is a potential statutory refusal, if the examining attorney believes that an amendment or explanation will obviate the refusal. *See* TMEP §708.04.

See TMEP §708.03 regarding the form of a priority action.

708.02 Discussion of Issues and Agreements

The examining attorney must discuss the issues with the individual applicant, the applicant’s attorney, or a person with legal authority to bind a juristic applicant. The broad definition of “persons properly authorized to sign on behalf of an applicant” in 37 C.F.R. §2.33(a) (*see* TMEP §804.04) does not apply to priority actions. Priority actions are governed by 37 C.F.R. §10.14(e). Only the applicant or the applicant’s attorney can agree to a priority action. If the applicant has an attorney, the examining attorney must speak to the attorney of record. If the applicant is *pro se*, the examining attorney must speak to the individual applicant or to someone with legal authority to bind a juristic applicant (*e.g.*, a corporate officer or general partner of a partnership). A non-attorney who is authorized to verify facts on behalf of an applicant under 37 C.F.R. §2.33(a)(2) is *not* entitled to authorize a priority action unless he or she has legal authority to bind the applicant. *See* TMEP §§712.01 *et seq.* for guidelines on persons who have legal authority to bind various types of applicants.

During the telephone conversation or other communication with the applicant or the applicant’s attorney, the examining attorney should fully discuss all issues and requirements relating to the application, and should explain the reason for each requirement. The examining attorney should suggest appropriate language for amendments, where appropriate.

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A priority action is *not* appropriate when the examining attorney leaves a voice mail or e-mail message for the applicant or the applicant's attorney, but the applicant or attorney does not call back or respond.

An agreement as to precisely how all issues will be resolved is not necessary. For example, the priority action may state that "the applicant will submit an acceptable identification of goods that specifies the common commercial names of the 'computer equipment.'" It is not necessary that there be an agreement that "the applicant will amend the identification of goods to read: computer keyboards, computer monitors and computer printers."

The priority action may state that the applicant will follow one of two alternative courses of action, for example, providing either an amended drawing or a new specimen.

708.03 Form of the Priority Action

The priority action should reference the date of the telephone call, e-mail message or other communication, and the name and title (where appropriate) of the person who authorized the priority action. *See* TMEP §708.02 for information about who is authorized to agree to a priority action.

The priority action should also discuss all refusals and requirements, and reference all agreements reached during the communication between the examining attorney and the applicant. *See* TMEP §708.02 regarding agreements.

The examining attorney should discuss each issue separately, stating the reason for the requirement and/or citing the relevant sections of the statute, rules, and/or TMEP. In view of the initial discussion between the examining attorney and the applicant or applicant's attorney, the explanation of a requirement may be more abbreviated in a priority action than in a regular Office action. However, the essential nature of the requirement must be clearly stated in the priority action, because the action of the Office is based exclusively on the written record. 37 C.F.R. §1.2.

A priority action must include a six-month response clause (*see* TMEP §705.08) so that it is clear that the applicant must timely respond to the issues raised in the priority action to avoid abandonment of the application.

The priority action should include a search clause (*see* TMEP §704.02) if it is a first action, or if the applicant has not previously been advised of the results of a search.

A priority action may be used for a final or nonfinal refusal or requirement. *See* TMEP §708.04 regarding refusal of registration in a priority action, and TMEP §§714 *et seq.* regarding final actions.

708.04 Refusal of Registration in Priority Action

Priority actions are generally used when there are no statutory refusals. However, if there is a potential statutory refusal, and the examining attorney believes that an amendment or

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explanation will obviate the refusal, the examining attorney may attempt to resolve the issues through a priority action. An example would be a surname refusal where it is evident that the mark has been used in commerce for more than five years, and thus the refusal could be overcome by the submission of a claim of acquired distinctiveness under §2(f) of the Trademark Act. *See* TMEP §§1212 *et seq.* regarding §2(f).

When the applicant agrees to submit evidence to overcome a statutory refusal, the examining attorney should issue the refusal in the priority action, stating the basis for the refusal, citing the relevant sections of the statute and rules, and indicating the resolutions agreed upon.

If the priority action includes a final refusal, the priority action must clearly indicate that the refusal is FINAL, and should contain the supporting evidence necessary for a complete record on appeal. *See* TMEP §§714 *et seq.* regarding final actions.

708.05 Combined Examiner's Amendment/Priority Action

An examining attorney may issue an Office action that combines an examiner's amendment and priority action. The action must include a six-month response clause (*see* TMEP §705.08) so that it is clear that the applicant must timely respond to the issues raised in the priority action to avoid abandonment of the application. The action must also include the subheadings "Priority Action" and "Examiner's Amendment" to facilitate processing in the law office. The action should be reported in the Office's automated TRAM system as a priority action.

709 Interviews

A discussion between the applicant or applicant's attorney and the examining attorney in which the applicant presents matters for the examining attorney's consideration is considered an interview. An interview can be conducted in person, by telephone, or by e-mail (if the applicant has authorized e-mail communications). *See* TMEP §§304 *et seq.* regarding e-mail.

The application will not normally be processed out of turn as a result of the interview, and the interview does not extend the deadline for response to an outstanding Office action.

The examining attorney may not discuss *inter partes* questions with any of the interested parties. *See* TMEP §1801.

709.01 How Interviews are Conducted

Personal interviews with examining attorneys concerning applications and other matters pending before the Office are permissible on any working day and must be in the office of the respective examining attorney, within office hours that the examining attorney may designate.

Personal interviews should be arranged in advance, preferably by fax, e-mail or telephone. This will ensure that the assigned examining attorney will be available for the interview at the scheduled time and will have an opportunity to review the application and be familiar

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with it. The unexpected appearance of an attorney or applicant requesting an interview without any previous notice to the examining attorney is not appropriate.

An interview should be conducted only when it could serve to develop and clarify specific issues and lead to a mutual understanding between the examining attorney and the applicant. Interviews should not extend beyond a reasonable time.

The examining attorney should not hesitate to state that matter presented for consideration during the interview requires further research, if this is the case. Furthermore, the examining attorney may conclude an interview when it appears that no common ground can be reached.

During an interview with a pro se applicant who is not familiar with Office procedure, the examining attorney may in his or her discretion make suggestions that will advance the prosecution of the application, but these interviews should not be allowed to become unduly long.

When an agreement is reached during an interview but it is not possible to resolve all issues through an examiner's amendment, the examining attorney should make a note to the file concerning the agreement and request that the applicant incorporate the agreement in its response.

Sometimes the examining attorney who conducted the interview is transferred, resigns or retires, and examination of the application is taken over by another examining attorney. If there is an indication in the record that an interview was held, the second examining attorney should endeavor to ascertain whether any agreements were reached during the interview. In the absence of clear error, the second examining attorney should take a position consistent with agreements previously reached.

Except in unusual situations, no interview on the merits is permitted after the brief on appeal is filed, or after an application has been forwarded for publication or issue.

709.02 Persons Who May Represent Applicant in an Interview

In general, interviews are not granted to persons who lack proper authority from the applicant or the attorney of record. *See* TMEP §§602 *et seq.* regarding persons who may represent an applicant before the Office in a trademark matter, and TMEP §§712.01 *et seq.* for information as to persons who have authority to bind various types of juristic applicants.

When an attorney claims to be the applicant's representative and requests an appointment for an interview, the examining attorney will comply with that request, even if the person requesting the interview is not the attorney of record. However, the examining attorney may request proof of the attorney's authority if there is any reason to suspect that the attorney is not, in fact, the applicant's representative. 37 C.F.R. §2.17(a).

For an interview with an examining attorney who does not have signatory authority, arrangements should be made for the presence of an examining attorney who does have such authority and who is familiar with the application, so that authoritative agreement may be reached, if possible, at the time of the interview.

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Office employees are forbidden to engage in oral or written communication with a disbarred attorney regarding an application unless the disbarred attorney is the applicant.

Requests for interviews from third parties are inappropriate and should be directed to the Office of the Commissioner for Trademarks. *See* TMEP §1801.

709.03 Making Substance of Interview of Record

The substance of an interview must always be made of record in the application, since the action of the Office is based exclusively on the written record. 37 C.F.R. §1.2. This should be done promptly after the interview while the matters discussed are fresh in the minds of the parties.

To ensure that any agreements reached at an interview will be followed, and to avoid subsequent misunderstanding, the examining attorney should include, in the “Notes-to-the-File” section of the file jacket, a summary of the conclusions reached and the significance of any exhibits considered at an interview.

If possible, agreements reached in the interview may be incorporated in an examiner’s amendment or priority action.

The applicant or the applicant’s attorney may also make the substance of an interview part of the record by incorporating a summary of the interview in the applicant’s response to the Office action. If there is any disagreement between the examining attorney and the applicant as to the substance of the interview, the written record governs. 37 C.F.R. §1.2.

709.04 Telephone Communications

Use of the telephone is encouraged. Examining attorneys should initiate telephone interviews whenever possible to expedite prosecution of an application. Similarly, applicants and attorneys for applicants may telephone examining attorneys if they feel that a call will advance prosecution of an application.

All amendments and other papers filed in the Office should include the telephone number of the applicant or the applicant’s attorney.

The examining attorney should return telephone calls within a reasonable time, normally the same working day and never later than the next working day.

Generally, the examining attorney who prepared the action, and not the supervisory or reviewing examining attorney, should be the person contacted in a telephone interview. However, a non-signatory examining attorney must secure proper authorization from the managing attorney, senior attorney or reviewing examining attorney before approving an amendment.

The action of the Office is based exclusively on the written record. 37 C.F.R. §1.2. Therefore, the examining attorney must use either an examiner’s amendment (*see* TMEP §§707 *et seq.*), priority action (*see* TMEP §§708 *et seq.*), telephone memo to the file, or

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notation in the “Notes to the File” section of the file wrapper to make the substance of the call or the resolution of any issue part of the record. *See* TMEP §709.03.

709.05 Informal Submissions

An applicant may conduct informal communications with an examining attorney regarding a particular application by fax, e-mail (*see* TMEP §§304 *et seq.*), or other means. Informal communications should be conducted only if they serve to develop and clarify specific issues and lead to a mutual understanding between the examining attorney and the applicant.

Informal communications must be made part of the record, because the Office uses them in decision making, and anything used in decision making must be made of record. 37 C.F.R. §1.2. When a communication is informal, the applicant should clearly identify it as such. If it is unclear whether a communication is an informal inquiry or a response to an Office action, the Office will process the communication as a response.

Filing an informal communication does not extend the deadline for response to an outstanding Office action.

709.06 Interviews Prior to Filing Application

No interviews are permitted before the filing of an application. If a party has general questions, he or she can call the Trademark Assistance Center at (703) 308-9000 or (800) 786-9199. *See* TMEP §108.03.

Office employees cannot give advice on trademark law. It is inappropriate for Office personnel to give legal advice or to act as a counselor for individuals, or to recommend an attorney.

710 Evidence

710.01 Evidence Supporting Refusal or Requirement

The examining attorney should support his or her action with relevant evidence whenever appropriate.

All evidence that the examining attorney relies on in making any requirement or refusal to register must be placed in the record and copies must be sent to the applicant.

In appropriate cases, the examining attorney may also present evidence that may appear contrary to the Office’s position, with an appropriate explanation as to why this evidence was not considered controlling. In some cases, this may foreclose objections from an applicant and present a more complete picture if there is an appeal. *Cf. In re Federated Department Stores Inc.*, 3 USPQ2d 1541, 1542 n.2 (TTAB 1987).

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710.01(a) Evidence From Research Database

If evidence is obtained from a research database, the record should include an indication of the specific search that was conducted. The record should indicate the libraries and/or files that were searched and the results. If the examining attorney does not review all of the documents the search locates, the record should indicate the number of documents that were reviewed. The printout that summarizes the search should be made a part of the record and will provide most of this information. Information not indicated on the printout, such as the number of documents viewed, should be stated in narrative in the Office action. The Office action should include a citation to the research service, indicating the service, the library and the file searched, and the date of the search (e.g., “LEXIS®, NEXIS® library, CURRNT file as of January 4, 2002”).

When evidence is obtained from a research database, the examining attorney does not have to make all stories of record. It is sufficient to include only a portion of the search results, as long as that portion is a representative sample of what the entire search revealed. *In re Vaughan Furniture Co. Inc.*, 24 USPQ2d 1068, 1069 n. 2 (TTAB 1992). *See also In re Federated Department Stores Inc.*, 3 USPQ2d 1541, 1542 n. 2 (TTAB 1987).

710.01(b) Internet Evidence [R-2]

Printouts of articles downloaded from the Internet are admissible as evidence of information available to the general public, and of the way in which a term is being used by the public. However, the weight given to this evidence must be carefully evaluated, because the source is often unknown. *See In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1475-76 (TTAB 1999); *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370-71 (TTAB 1998). When making this evidence part of the record, the examining attorney should provide complete information as to the source or context of the evidence. Any information that would aid a party in locating the document retrieved through Internet research should be included in the citation (e.g., the URL address of the website, the time and date the search was conducted, and the terms searched). This can often be done by printing out the pages and noting the date the printouts were run.

Evidence of actual use of a phrase by a website has far greater probative value than the summary results of a search for key words, which may indicate only that the words in a phrase appear separately in the website literature. *In re Fitch IBCA Inc.*, 64 USPQ2d 1058 (TTAB 2002).

When a document found on the Internet is not the original publication, then the examining attorney or Trademark Law Library staff should try to obtain a copy of the originally published document, if practicable. Electronic-only documents are considered to be original publications, and scanned images are considered to be copies of original publications. *See notice at 64 Fed. Reg. 33056, 33063 (June 21, 1999).*

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710.01(c) Record Must Be Complete Prior to Appeal

The record in any application must be complete prior to appeal. 37 C.F.R. §2.142(d). Accordingly, if an examining attorney or applicant attempts to introduce new evidence at the time of the appeal, the new evidence will generally be excluded from the record. TBMP §§1207.01 *et seq.* See *Rexall Drug Co. v. Manhattan Drug Co.*, 284 F.2d 391, 128 USPQ 114 (C.C.P.A. 1960); *In re Psygnosis Ltd.*, 51 USPQ2d 1594 (TTAB 1999). However, the Board may consider evidence submitted after appeal, despite its untimeliness, if the nonoffering party: (1) does not object to the evidence; *and* (2) discusses the evidence or otherwise treats it as being of record. See TBMP §1207.03 and cases cited therein. Therefore, examining attorneys and applicants should either consider or object to new evidence.

Whenever an examining attorney objects to evidence submitted by an applicant, the objection should be raised as soon as possible and continued in the examining attorney's brief, or the Board may consider the objection to be waived. *In re Broyhill Furniture Industries, Inc.*, 60 USPQ2d 1511, 1513 n. 3 (TTAB 2001).

If the applicant or examining attorney wishes to introduce new evidence at the time of or during appeal, the party seeking to introduce the new evidence may request the Board to suspend the appeal and remand the case. See TMEP §§1504.05 *et seq.* and TBMP §1207.02 regarding requests for remand.

The Board may take judicial notice of definitions from printed dictionaries, even if they are not made of record by the applicant or examining attorney prior to appeal. *In re Dodd International, Inc.*, 222 USPQ 268 (TTAB 1983); *In re Canron, Inc.*, 219 USPQ 820 (TTAB 1983); TBMP §§712 *et seq.* However, the better practice is to photocopy the relevant material to ensure that it is in the record. Definitions from on-line dictionaries and other Internet evidence must be made of record prior to appeal, so that the applicant will have the opportunity to check the reliability of the evidence and offer rebuttal evidence. *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999).

710.02 Evidence Indicating No Refusal or Requirement Necessary

It is Office practice to indicate the results of a search for evidence when the examining attorney considers an issue and determines that no action will be taken on it. This information is helpful for internal review. The "Notes-to-the-File" section of the file wrapper should be used to reflect the results of a search for evidence in any case where the examining attorney determines that no action is required, but that inclusion of the results of the search would be useful in review and approval of the file. The examining attorney should simply note the parameters and results of the search conducted *without stating any opinions or conclusions*.

For instance, in the case of a search of telephone directories for surnames, the record should indicate only the directories investigated and the number of occurrences of the surname. Or, in the case of a search for the meaning of a term, the record should show the sources checked and whether the term was found. Examining attorneys should provide the same information

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indicated in TMEP §710.01(a) regarding searches of research databases in this type of case. Copies of relevant evidence may be placed in the file, if appropriate.

Examining attorneys should *not* provide any analysis, opinions, or conclusions regarding the evidence when the examining attorney determines that a refusal or requirement is not appropriate. The examining attorney should not place in the record copies of e-mail messages or other communications between the examining attorney and other Office personnel concerning the application. Also, the examining attorney should not refer to any registration or pending application that was considered in a §2(d) search unless the examining attorney determines that there is a conflict and issues an Office action based on the application or registration. The examining attorney should not place in the file copies of marks not cited under §2(d).

710.03 Evidence of Third-Party Registrations

The Trademark Trial and Appeal Board does not take judicial notice of registrations, and the submission of a list of registrations does not make these registrations part of the record. *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974). Furthermore, the submission of a copy of a commercial search report is not proper evidence of third party registrations. *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983).

To make registrations of record, soft copies of the registrations or the complete electronic equivalent (*i.e.*, printouts of the registrations taken from the electronic search records of the United States Patent and Trademark Office) must be submitted. *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998); *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455 (TTAB 1998); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1560 n.6 (TTAB 1996); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 n. 3 (TTAB 1994); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1231-32 (TTAB 1992).

If the applicant submits improper evidence of third-party registrations, the examining attorney should object to the evidence in the next Office action, or the Board may consider the objection to be waived. *See In re Broyhill Furniture Industries, Inc.*, 60 USPQ2d 1511, 1513 n. 3 (TTAB 2001) (objection to evidence waived where it was not interposed in response to applicant's reliance on listing of third-party registrations in response to initial Office action). If the applicant files an appeal, the examining attorney should continue the objection to the evidence in his or her appeal brief.

See TMEP §1207.01(d)(iii) regarding the relevance of third-party registrations to a determination of likelihood of confusion under 15 U.S.C. §1052(d).

711 Deadline for Response to Office Action [R-1]

The statutory period for response to an examining attorney's Office action is six months. 15 U.S.C. §1062(b); 37 C.F.R. §2.62. The examining attorney has no discretion to shorten or extend this period. The applicant must file a response within six months of the mailing date

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of the Office action, unless the examining attorney has issued a supplemental action resetting the period for response. *See* TMEP §711.02 regarding supplemental Office actions.

See TMEP §310 for information about computing the response period; TMEP §§304.05, 305.02 and 306.05 for certificate of transmission by electronic mail, certificate of mailing, and certificate of facsimile transmission procedures to avoid lateness; and TMEP §§718.02 and 718.03 *et seq.* regarding abandonment for failure to respond to an Office action.

711.01 Time May Run from Previous Action

In some situations the examining attorney's letter does not start the beginning of a statutory response period. For example, a notice that an applicant's response was incomplete (*see* TMEP §§718.03 *et seq.*), or a notice that an applicant's request for reconsideration of a final action fails to overcome a refusal or satisfy an outstanding requirement (*see* TMEP §§715.03(a) and (c)), does not begin a new response period. In all cases where the statutory response period runs from the date of a previous Office action, the examining attorney should include a statement to that effect in the Office action, and should omit the six-month response clause.

711.02 Supplemental Office Action Resetting Response Period

Sometimes the examining attorney must issue a supplemental Office action that resets the period for response. If the examining attorney discovers after mailing an action that a refusal or requirement that should have been raised was overlooked, the examining attorney must issue a supplemental Office action addressing the issue and resetting the period for response. *See* TMEP §706. The examining attorney must also issue a supplemental Office action if a new issue arises after the mailing date of the Office action. For example, a new issue might arise during examination of an amendment to allege use. *See* TMEP §1104.09(h).

If the examining attorney issues a supplemental Office action, a new six-month response period will begin running from the mailing date of the supplemental action. 15 U.S.C. §1062(b). In a supplemental Office action, the examining attorney should indicate that the action is supplemental to the previous action, and should incorporate all outstanding issues by reference to the previous action. The examining attorney should also include the standard six-month response clause.

See TMEP §§717 *et seq.* regarding remailing of Office actions.

712 Signature of Response to Office Action

A response to an Office action must be signed by the applicant or the applicant's attorney. *See* TMEP §§712.01 *et seq.* as to persons who can sign the response.

712.01 Persons Who Can Sign Response

If the applicant has an attorney, the attorney must sign the response. 37 C.F.R. §10.18(a).

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If the applicant is not represented by an attorney, the response must be signed by someone with legal authority to bind the applicant (*e.g.*, an appropriate corporate officer or general partner of a partnership). A non-attorney who is authorized to verify facts on behalf of an applicant under 37 C.F.R. §2.33(a)(2) (*see* TMEP §804.04) is *not* entitled to sign responses to Office actions, or to authorize examiner's amendments and priority actions, unless he or she has legal authority to bind the applicant.

Example: A corporate manager might have the firsthand knowledge and implied authority to act on behalf of the applicant that are required to verify facts under 37 C.F.R. §2.33(a)(2), but not have legal authority to bind the applicant. *See* TMEP §712.01(a)(iv) regarding signature of responses filed by corporations.

Authorizing an amendment to an application, or responding to an Office action, is, in effect, representing the applicant in a trademark matter. Under 5 U.S.C. §500(d) and 37 C.F.R. §10.14(e), non-attorneys may not represent a party in a trademark proceeding before the Office.

See TMEP §§712.01(a) *et seq.* for guidelines on persons who have legal authority to bind various types of applicants.

Generally, the examining attorney should presume that a proper person signed the response unless there is evidence in the record indicating that the person was not authorized to sign. If a response to an Office action is signed by an unauthorized person, the examining attorney should require that the response be confirmed by a person with legal authority to bind the applicant, or by the applicant's attorney. This may be done by fax, e-mail, or by an examiner's amendment. *See* TMEP §602.03 regarding the situation in which an examining attorney suspects that an individual who does not meet the requirements of 37 C.F.R. §10.14 is representing an applicant in the prosecution of a trademark application.

These same principles apply to authorizations of examiner's amendments and priority actions. If the applicant has an attorney, the examining attorney must speak to the attorney of record. If the applicant is *pro se*, the examining attorney must speak to the individual applicant, or to someone with legal authority to bind a juristic applicant. *See* TMEP §§707.01 and 708.02.

712.01(a) Guidelines on Who Should Sign Response to Office Action

As noted in TMEP §712.01, if the applicant has an attorney, the attorney must sign the response. 37 C.F.R. §10.18(a). This section provides guidelines for determining who should sign a response to an Office action, or authorize an examiner's amendment or priority action on behalf of a juristic applicant who is not represented by an attorney. This section does not apply to verification of an application, or other verifications of facts by an applicant. *See* 37 C.F.R. §2.33(a) and TMEP §804.04 regarding persons who can verify facts on behalf of an applicant.

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The examining attorney may presume that a proper person signed the response unless there is evidence in the record indicating that the person was not authorized to sign.

712.01(a)(i) Signature By Joint Applicants

A response to an Office action by joint applicants who are not represented by an attorney must be signed by each of the applicants, since they are individual parties and not a single entity.

712.01(a)(ii) Signature By Partnership

A response to an Office action by a partnership that is not represented by an attorney must be signed by a general partner of the applicant. Signature by all the general partners is not necessary.

In appropriate cases, a response by a partnership may be signed by an official other than a general partner, if the record contains an explanation or documentation indicating that the person signing the response is duly authorized to act for the partnership.

712.01(a)(iii) Signature By Joint Venture

A response to an Office action by a joint venture that is not represented by an attorney must be signed by each party to the venture. Although a joint venture has many attributes of a partnership, it is a special partnership, which is very limited in nature and scope. Generally, signature by each party to the joint venture is necessary.

In appropriate cases, a response by a joint venture may be signed by a general manager or other official rather than by each of the joint venturers, if the applicant states that the person who signed the response is duly authorized to act for the joint venture under relevant state law.

712.01(a)(iv) Signature By Corporation

A response to an Office action by a corporation that is not represented by an attorney must be signed by a corporate officer. An officer is a person who holds an office established in the articles of incorporation or corporate bylaws.

The usual titles for officers are President, Vice-President, Secretary, Treasurer, Chief Executive Officer, Chief Operating Officer and Chief Financial Officer. Modifications of these basic titles are acceptable, such as Vice-President for Sales; Executive Vice-President; Assistant Treasurer; Vice-Chairman of the Board of Directors. In some organizations the Treasurer is called a Comptroller or Controller, and those terms are acceptable.

In Maine and Massachusetts the term “Clerk” identifies an officer of a corporation. The signature of the Chairman or Chairman of the Board of Directors is also acceptable, but not the signature of an individual director. The terms “Executive Secretary” and “Administrative Secretary” are acceptable, because they include the officer-title “Secretary.”

There are some titles that are generally *not* accepted because they usually are not officers. For

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instance, a General Manager, or any other type of manager, is usually merely an employee, not an officer. The corporation cannot delegate authority to sign responses to someone who is not a corporate officer. *In re Textron, Inc.*, 183 USPQ 301 (Comm'r Pats. 1974).

If the applicant states that the person who signed the response is authorized to bind the applicant under the articles of incorporation or bylaws, the examining attorney should accept the signature.

712.01(a)(v) Signature By Foreign Companies and Corporations

There are significant differences between the legal entities established under the laws of the United States and legal entities established and recognized under the laws of foreign countries, and the titles and duties of officers of foreign corporations and companies often differ from those in the United States. In the case of foreign entities that are in the nature of corporations, the Office will accept the signature of a person considered to be equivalent to an officer under the law of the foreign country.

In foreign countries, a person who holds the title “Manager” or “Director” is normally an officer or the equivalent of an officer.

The term “Procurist” is used in a number of countries to indicate an officer. For British companies, the terms “Registrar” and “Confidential Clerk” are the equivalent of officers.

If the applicant or the applicant’s attorney states that the person who signed the response holds a position equivalent to that of an officer of a U.S. corporation, the Office will accept the signature.

See TMEP §803.03(i) regarding terms used to identify a foreign entity as applicant.

712.01(a)(vi) Signature By Unincorporated Association

For organizations that are less formally organized than corporations (*e.g.* fraternal societies, unions, unincorporated associations and governmental bodies), the titles for officers are less standardized. These organizations frequently use more individualistic terms for titles than the terms customarily used by corporations, and the officer positions themselves may not be as clearly or as formally provided for as is the case with corporations. Regardless of how unfamiliar the title is or how informal the position seems to be, the Office will accept the signature if the signer has, within the framework of the particular organization, authority equivalent to that of an officer to act on behalf of the organization. Some titles that have been accepted are Director, National Director, National Commander, Permanent Chairman, International Sponsor, Supreme Ruler, Royal Impresario, Chairman of the Steering Committee.

712.01(a)(vii) Signature By Limited Liability Company

A limited liability company has attributes of both a corporation and a partnership. *See* TMEP §803.03(h). Laws vary to some extent as to the authority conferred on various individuals associated with the limited liability company. Generally, a “manager” has authority equivalent

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to an officer in a corporation. Therefore, anyone identified as a manager, or equivalent, may sign a response to an Office action on behalf of a limited liability company that is not represented by an attorney. In addition, anyone with a corporate-officer-type title may sign. In some states the members, who are the owners, also have authority to act on behalf of the limited liability company.

712.02 Unsigned Response [R-1]

A response to an Office action must be signed by the applicant or the applicant's attorney. 37 C.F.R. §10.18; TMEP §712. Upon receipt of an unsigned response, the examining attorney should act on the matter at once. The examining attorney should treat the unsigned response as an incomplete response, and should grant the applicant additional time to perfect the response, pursuant to 37 C.F.R. §2.65(b) and TMEP §718.03(b). The applicant must ratify the response through an examiner's amendment, or submit a signed copy of the response by fax (unless it is excluded by 37 C.F.R. §1.6(d)) or e-mail. *See* TMEP §304.08 regarding signature of documents submitted by electronic mail. *See also* 37 C.F.R. §10.18(a) regarding the signature of papers filed by attorneys.

713 Examination of Amendments and Responses to Office Actions [R-2]

37 C.F.R. §2.63. Reexamination.

(a) After response by the applicant, the application will be reexamined or reconsidered. If registration is again refused or any formal requirement[s] is repeated, but the examiner's action is not stated to be final, the applicant may respond again.

(b) After reexamination the applicant may respond by filing a timely petition to the Director for relief from a formal requirement if: (1) The requirement is repeated, but the examiner's action is not made final, and the subject matter of the requirement is appropriate for petition to the Director (see §2.146(b)); or (2) the examiner's action is made final and such action is limited to subject matter appropriate for petition to the Director. If the petition is denied, the applicant shall have until six months from the date of the Office action which repeated the requirement or made it final or thirty days from the date of the decision on the petition, whichever date is later, to comply with the requirement. A formal requirement which is the subject of a petition decided by the Director may not subsequently be the subject of an appeal to the Trademark Trial and Appeal Board.

The examining attorney will consider the applicant's response and will determine whether the mark may be approved for publication or registration. The examining attorney must carefully consider all arguments, comments, and amendments made or proposed by the applicant.

If the applicant's response has put the application in condition for approval for publication for opposition or registration on the Supplemental Register, the examining attorney will forward the application for publication or registration, as appropriate.

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If the applicant's response has not put the application in condition for publication or registration, the examining attorney will issue an Office action, or call or e-mail the applicant, depending on the circumstances. If the examining attorney's action is not stated to be final, the applicant may respond again, within six months of the mailing date. This procedure may be repeated until an examining attorney's action is made final or until the applicant fails to properly respond to an examining attorney's action. 15 U.S.C. §1062(b).

If the applicant's response does not present any new issues, and the applicant has had an opportunity to reply to all points raised by the examining attorney, the examining attorney's next action should be stated to be final. *See* TMEP §§714 *et seq.*

If the examining attorney has cited a prior-filed conflicting application, and the applicant responds by arguing that there is no likelihood of confusion, the examining attorney should suspend the application pending disposition of the conflicting application, if applicant's arguments are not persuasive. *See* TMEP §716.02(c) regarding suspension pending disposition of an earlier-filed conflicting application, TMEP §716.03 regarding the applicant's request to remove an application from suspension, and TMEP §§1208 *et seq.* regarding conflicting marks in pending applications.

713.01 Previous Action by Different Examining Attorney

When assigned to act on an application that was previously handled by a different examining attorney, the examining attorney should not take an approach that is entirely different from that of the previous examining attorney unless it is clearly appropriate to do so.

713.02 Noting All Outstanding Requirements

When acting on an amended application, the examining attorney should note all outstanding refusals and requirements in every Office action. The examining attorney should indicate whether particular refusals or requirements are withdrawn or whether the applicant's response is acceptable, where appropriate.

To prevent any misunderstanding, every refusal or requirement in the prior action that is still outstanding must be repeated or referred to. Even when suspending action on an application, the examining attorney should note all outstanding refusals or requirements.

713.03 Response to Applicant's Arguments

When the applicant submits arguments attempting to overcome a refusal or requirement, the examining attorney should respond to the applicant's arguments.

714 Final Action [R-2]

37 C.F.R. §2.64. Final action.

(a) On the first or any subsequent reexamination or reconsideration the refusal of the registration or the insistence upon a requirement may be stated to be final, whereupon

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applicant's response is limited to an appeal, or to a compliance with any requirement, or to a petition to the Director if permitted by §2.63(b).

(b) During the period between a final action and expiration of the time for filing an appeal, the applicant may request the examiner to reconsider the final action. The filing of a request for reconsideration will not extend the time for filing an appeal or petitioning the Director, but normally the examiner will reply to a request for reconsideration before the end of the six-month period if the request is filed within three months after the date of the final action. Amendments accompanying requests for reconsideration after final action will be entered if they comply with the rules of practice in trademark cases and the Act of 1946.

(c)(1) If an applicant in an application under §1(b) of the Act files an amendment to allege use under §2.76 during the six-month response period after issuance of a final action, the examiner shall examine the amendment. The filing of such an amendment will not extend the time for filing an appeal or petitioning the Director.

(2) If the amendment to allege use under §2.76 is acceptable in all respects, the applicant will be notified of its acceptance.

(3) If, as a result of the examination of the amendment to allege use under §2.76, the applicant is found not entitled to registration for any reason not previously stated, applicant will be notified and advised of the reasons and of any formal requirements or refusals. The Trademark Examining Attorney shall withdraw the final action previously issued and shall incorporate all unresolved refusals or requirements previously stated in the new non-final action.

714.01 Not Permissible on First Action

A first action by an examining attorney may not be made final. An applicant is entitled to at least one opportunity to reply to any issue raised by the examining attorney.

714.02 Not Permissible on Suspension

A letter of suspension cannot be made final. *See* TMEP §§716 *et seq.* regarding suspension.

714.03 When Final Action is Appropriate [R-2]

Final action is appropriate when a clear issue has been developed between the examining attorney and the applicant, *i.e.*, the examining attorney has previously raised all outstanding issues and the applicant has had an opportunity to respond to them.

For a second action to be made final, all requirements or refusals must have been made in the first action. No requirement may be made final, even if it is a repeated requirement, unless the entire action is made final. Thus, if the examining attorney makes a new refusal or requirement in a second or subsequent action, a repeated refusal or requirement may not be made final.

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In §44(d) applications, the examining attorney may not issue a final action until the applicant submits a copy of the foreign registration. When the application is otherwise in condition for final refusal, the examining attorney should suspend action on the application pending receipt of a copy of the foreign registration. The notice of suspension should indicate all outstanding refusals or requirements that will be made final upon receipt of the foreign registration if no new issues are raised. *See* TMEP §§716.02(b) and 1003.04.

Second actions should be final actions whenever possible. While an applicant is entitled to a full and fair hearing, it is in the interest of the public that prosecution be limited to as few actions as is consistent with proper examination. Neither the Act nor the rules of practice give an applicant the right to an extended prosecution.

See TMEP §§714.05 *et seq.* for further discussion of when an examining attorney should issue a nonfinal action rather than a final action, and TMEP §714.06 regarding final actions that are premature.

714.04 Form of the Final Action

When making an action final, the examining attorney should restate any requirements or refusals that remain outstanding, and should cite the rule(s) and/or statute(s) that provide the basis for these refusals or requirements. The examining attorney should place all evidence in support of his or her refusal in the record at the time the final action is issued.

The final action should include a clear and unequivocal statement that the refusal or requirement is final. When there is more than one ground set out as the basis for the final action, the action may conclude with a paragraph containing wording such as “This action is made FINAL” or “This is a FINAL action,” which covers all grounds.

The final action should also mention any refusals or requirements that have been withdrawn.

The examining attorney should include a statement that the only proper response to a final action is an appeal (or a petition, if permitted under 37 C.F.R. §2.63(b)), or compliance with an outstanding requirement. 37 C.F.R. §2.64(a).

A final action must include a six-month response clause (*see* TMEP §705.08) so that it is clear that the applicant must file a timely response to avoid abandonment of the application.

714.05 Delineating New Issues Requiring Issuance of Nonfinal Action

It is sometimes difficult to determine what constitutes a new issue requiring a new nonfinal action, rather than a final action, after receipt of a response. *See* TMEP §§714.05(a) through 714.05(c) regarding the propriety of issuing a final action in specific situations, and TMEP §715.03(b) regarding new issues presented in a request for reconsideration of an examining attorney’s final action.

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714.05(a) Unacceptable Amendment Proposed By Applicant

Generally, an amendment that is unacceptable raises a new issue requiring a nonfinal action, unless the amendment is a direct response to a previous requirement.

If an amendment was not offered in direct response to a requirement, and the amendment is not acceptable, the examining attorney generally must issue a new, nonfinal action addressing the issues raised by the amendment and continuing all other refusals and requirements. The following are examples of amendments that would require a new nonfinal action:

- (1) Amendments to the drawing, unless the examining attorney had previously required that the drawing be amended;
- (2) Amendments to the Supplemental Register and amendments to assert acquired distinctiveness under 15 U.S.C. §1052(f), unless the amendment is irrelevant to an outstanding refusal (*see* TMEP §714.05(a)(i));
- (3) Amendments to disclaim the entire mark (*see* TMEP §1213.06).

However, evidence or amendments that are merely cumulative and are not significantly different from material previously submitted do *not* raise a new issue that requires the examining attorney to issue a nonfinal action. *See In re GTE Education Services*, 34 USPQ2d 1478 (Comm'r Pats. 1994) (examining attorney properly determined that no new issue had been raised in request for reconsideration of final refusal based on inadequate specimens, where the substitute specimens submitted with the request were deficient for same reason as the original specimens). Generally, the examining attorney may issue a final action if the same refusal or requirement was made before.

714.05(a)(i) Amendment to Supplemental Register or Submission of Claim of Acquired Distinctiveness

If registration is refused under §2(e)(1), §2(e)(2) or §2(e)(4) of the Trademark Act, 15 U.S.C. §1052(e)(1), §1052(e)(2) or §1052(e)(4), or on grounds pertaining to other non-inherently distinctive subject matter (*e.g.*, product or container configurations (*see* TMEP §§1202.02(b)(i) and (ii)), color marks (*see* TMEP §1202.05 *et seq.*), or marks that comprise matter that is purely ornamental (*see* TMEP §1202.03 *et seq.*)), an amendment to the Supplemental Register or to claim acquired distinctiveness under 15 U.S.C. §1052(f) presents a new issue. This is true even if the examining attorney previously issued an advisory statement indicating that the examining attorney believed the mark to be unregistrable on the Supplemental Register or under §2(f).

If the examining attorney determines that the amendment does not overcome the refusal, the examining attorney should issue a nonfinal refusal of registration. *See* TMEP §816.04 regarding refusal of registration after an amendment to the Supplemental Register, and TMEP §1212.02(h) regarding refusal of registration after an applicant submits a claim of acquired distinctiveness under §2(f).

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However, if the amendment is irrelevant to an outstanding refusal, the examining attorney may issue a final refusal or requirement. For example, if registration is refused under §2(a) (*see* TMEP §1203 *et seq.*), §2(b) (*see* TMEP §1204), §2(d) (*see* TMEP §§1207 *et seq.*), §2(e)(3) (*see* TMEP §1210.01(b)) or §2(e)(5) (*see* TMEP §§1202.02(a) *et seq.*) of the Trademark Act, an amendment to the Supplemental Register or a claim of distinctiveness under §2(f) does *not* raise a new issue, and the examining attorney may issue a final refusal. *See In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1696 (TTAB 1992) (amendment to the Supplemental Register in response to a refusal of registration under §2(a) does not raise a new issue).

Exception: An amendment to the Supplemental Register in a §1(b) application for which no allegation of use has been filed does raise a new issue, because the examining attorney must refuse registration under §23 of the Trademark Act, 15 U.S.C. §1091, on the ground that the mark is not in lawful use in commerce. 37 C.F.R. §2.75(b); TMEP §1102.03.

See TMEP §715.03(b) regarding new issues presented in a request for reconsideration of an examining attorney's final action.

714.05(a)(ii) Amendment of Identification of Goods and Services

If the applicant responds to a nonfinal Office action requiring an amendment to the identification of goods and services, and the examining attorney determines that the identification is still unacceptable, generally the examining attorney must issue a final requirement to amend the identification of goods and services. There are only two exceptions to this rule:

- (1) If the amended identification is broader in scope than the original identification, *and* the prior Office action failed to advise the applicant that amendments broadening the identification are prohibited under 37 C.F.R. §2.71(a), the examining attorney cannot issue a final Office action.
- (2) If the amended identification sets forth goods and services in multiple classes, but the applicant has not submitted all the requirements for a multiple-class application (*e.g.*, specimens and fees for all classes), *and* the prior Office action failed to advise the applicant that the missing elements were required, the examining attorney cannot issue a final Office action. *See* TMEP §§1403 *et seq.* regarding multiple-class applications.

714.05(b) Section 2(d) Refusal Based on Prior-Filed Application That Has Matured Into Registration

The examining attorney must issue a nonfinal action when first refusing registration under §2(d) of the Trademark Act, 15 U.S.C. §1052(d), even if the applicant had been advised of the existence of the prior-filed application before it matured into the registration on which the refusal is based.

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714.05(c) Advisory Statement Cannot Serve as Foundation for Final Refusal or Requirement

Except as provided in TMEP §714.05(a)(ii), an advisory statement in an Office action indicating that a refusal or requirement will be issued if specified circumstances arise cannot serve as the foundation for issuing a final requirement or refusal in the next action. To establish the foundation for issuing a final refusal or requirement in the next Office action, an initial requirement or refusal must relate to matter that is of record at the time of the action.

714.06 Applicant's Recourse When Final Action is Premature

If an applicant believes that a refusal to register or a requirement has been made final prematurely, the applicant must raise the issue while the application is still pending before the examining attorney. It is not a ground for appeal to the Trademark Trial and Appeal Board. TBMP §1201.02. The applicant may raise the matter by filing a request for reconsideration with the examining attorney, or by contacting the managing attorney or senior attorney in the examining attorney's law office. If the examining attorney does not withdraw the finality, the applicant may file a petition under 37 C.F.R. §2.146. *See* TMEP Chapter 1700 regarding petitions

If, on request for reconsideration, the examining attorney finds the final action to have been premature, the examining attorney should issue a new nonfinal action.

715 Action After Issuance of Final Action

715.01 Proper Response to Final Action

An applicant must respond to a final action within six months of the mailing date. 37 C.F.R. §2.62.

In general, the only proper response to a final action is an appeal (or a petition, if permitted under 37 C.F.R. §2.63(b)(2)), or compliance with an outstanding requirement. 37 C.F.R. §2.64(a).

After a final refusal to register on the Principal Register, an amendment requesting registration on the Supplemental Register or registration on the Principal Register under §2(f) of the Trademark Act may be a proper response in some circumstances. *See* TMEP §§714.05(a)(i), 816.04 and 1212.02(h).

715.02 Action After Final Action

Once an action has been properly made final, the examining attorney normally should not change his or her position. However, this does not mean that no amendment or argument will be considered after final action. An amendment that will place the application in condition for publication or issue, or will put the application in better form for appeal, may be accepted and entered. For example, an amendment requesting registration on the Supplemental Register or on the Principal Register under §2(f) may be a proper response to a

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final refusal of registration on the Principal Register in some circumstances. *See* TMEP §§714.05(a)(i), 816.04 and 1212.02(h).

If the applicant files a response that complies with all outstanding requirements and overcomes all outstanding refusals, the examining attorney should approve the application for publication or registration, as appropriate.

The applicant may request reconsideration after final action, within six months of the mailing date of the final action. However, the filing of a request for reconsideration does *not* extend the time for filing an appeal or other proper response to the final action. 37 C.F.R. §2.64(b).

See TMEP §716.06 regarding suspension after final action.

715.03 Request for Reconsideration After Final Action

Under 37 C.F.R. §2.64(b), the applicant may file a request for reconsideration before the deadline for filing an appeal.

However, the filing of a request for reconsideration does *not* extend the deadline for appeal. 37 C.F.R. §2.64(b); TMEP §715.03(c). Therefore, if an applicant files a request for reconsideration of a final action and wants to preserve the right to appeal if the request is unsuccessful, the applicant must file a notice of appeal (with the fee required by 37 C.F.R. §2.6) before the expiration of the six-month period for response to the final action, or the application will be abandoned. *See* TMEP §715.04 for information about processing a request for reconsideration filed with a notice of appeal.

The examining attorney should construe any paper filed after final action that contains new amendments, new evidence, or new arguments as a request for reconsideration, and should issue a written action granting or denying the request. *See* TMEP §715.03(a).

715.03(a) Examining Attorney's Action After Request for Reconsideration

When responding to a request for reconsideration, the examining attorney must issue a written action that advises the applicant of the status of the application.

If the examining attorney determines that no new issues have been raised in the request for reconsideration, the examining attorney should deny the request. The examining attorney should issue a written action acknowledging the request for reconsideration, restating the final refusal, and advising the applicant that the time for appeal runs from the mailing date of the final Office action. The Office cannot extend the statutory deadline for filing an appeal. 15 U.S.C. §1062(b); 37 C.F.R. §2.142(a).

The Office action should *not* include a six-month response clause (*see* TMEP §705.08). If the six-month period for response to the final action has expired, and the applicant has not filed a notice of appeal, the examining attorney should state in the Office action that the application is abandoned. If there is time remaining in the response period, the examining attorney should advise the applicant that the applicant has the remainder of the response

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period to comply with any outstanding requirement and/or to appeal. *See* TMEP §715.03(b) regarding the examining attorney's action when the request for reconsideration raises a new issue, and TMEP §715.04 regarding a request for reconsideration filed in conjunction with an appeal.

In an Office action denying the applicant's request for reconsideration, the examining attorney may introduce additional evidence directed to the issue(s) for which reconsideration is sought. TBMP §1207.04.

If the request for reconsideration convinces the examining attorney that a refusal or requirement is not appropriate, the examining attorney may withdraw the refusal or requirement and approve the application for publication or registration, if otherwise in condition for such action. The examining attorney should inform the applicant of any action that renders the appeal moot. This may be done by telephone, with an appropriate note to the file.

If, in a request for reconsideration, the applicant makes a good faith, but incomplete, attempt to comply with all outstanding requirements and to overcome all outstanding refusals, the examining attorney has the discretion under 37 C.F.R. §2.65(b) to give the applicant additional time to resolve the matters that remain outstanding. *See* TMEP §718.03(b). This should be done *only* if the record indicates that the applicant can place the application in condition for approval by completing the response. In this situation, if the examining attorney believes that an examiner's amendment (*see* TMEP §§707 *et seq.*) will immediately put the application into condition for publication or registration, the examining attorney may issue the examiner's amendment. If the examining attorney grants the applicant additional time to complete a response under 37 C.F.R. §2.65(b), this does *not* extend the deadline for appeal. 15 U.S.C. §1062(b); 37 C.F.R. §2.142(a).

If the examining attorney denies the request for reconsideration and holds the application abandoned, the applicant may file a petition under 37 C.F.R. §2.146 to reverse the examining attorney's holding of abandonment. However, the examining attorney's action will be reversed on petition only if there is clear error or abuse of discretion. *See* TMEP §1713. The unintentional delay standard of 37 C.F.R. §2.66 does not apply in this situation. *See* TMEP §1714.01(f)(ii).

715.03(b) Examining Attorney Must Issue New Nonfinal Action If New Issue Presented in Request for Reconsideration [R-1]

If the request for reconsideration includes an amendment that presents a new issue, the examining attorney must issue a nonfinal action. For example, in the case of an amendment that asserts a claim of acquired distinctiveness under §2(f) for the first time, or an amendment to the Supplemental Register for the first time, but fails to place the application in condition for approval, a nonfinal action may be appropriate. *See* TMEP §714.05(a)(i).

When the examining attorney issues a *nonfinal* action after review of the applicant's request for reconsideration, the Office action should explain that the applicant must respond to all requirements or refusals within six months of the mailing date of the action, but that the

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applicant should not file an appeal because an appeal would be premature under 15 U.S.C. §1070 and 37 C.F.R. §2.141.

Evidence or amendments that are merely cumulative and are not significantly different from material previously submitted do *not* raise a new issue that requires the examining attorney to issue a nonfinal action. *In re GTE Education Services*, 34 USPQ2d 1478 (Comm'r Pats. 1994) (examining attorney properly determined that no new issue had been raised in request for reconsideration of final refusal based on inadequate specimens, where the substitute specimens submitted with the request were deficient for the same reason as original specimens).

Submission of new arguments in response to the same refusal or requirement does not raise a new issue that requires the examining attorney to issue a nonfinal action. Generally, if the same refusal or requirement was made before, the examining attorney does not have to issue a new final or nonfinal action.

See TMEP §§714.05 *et seq.* for further information about delineating new issues that require issuance of a nonfinal action.

When an application has been suspended after final action, and the grounds for refusal remain operative after the application is removed from suspension and no new issues have been raised, the examining attorney must issue a new *final* action. *See* TMEP §716.06.

715.03(c) Time for Appeal Runs from Mailing Date of Final Action if No New Issue Is Presented and Requirement(s) or Refusal(s) Is Not Withdrawn

Filing a request for reconsideration does not stay the time for responding to a final refusal. 15 U.S.C. §1062(b); 37 C.F.R. §2.142(a). If the examining attorney denies the applicant's request for reconsideration, the deadline for appeal runs from the mailing date of the final action. If this deadline has expired and the applicant has not filed a notice of appeal, the application is abandoned. The applicant may not file a petition to revive under 37 C.F.R. §2.66. *See* TMEP §1714.01(f)(ii).

715.04 Request for Reconsideration Filed In Conjunction With Notice of Appeal

If the applicant files a notice of appeal with a request for reconsideration, the application should first be sent to the Trademark Trial and Appeal Board for processing of the appeal. The Board will acknowledge the appeal, suspend further proceedings with respect to the appeal (including the applicant's time to file an appeal brief), and remand the application to the examining attorney for review of the request for reconsideration. TBMP §1204.

If an applicant files a notice of appeal with a request for reconsideration and later fails to respond to an Office action issued in response to the request for reconsideration, the examining attorney should return the application to the Board for appropriate action. The examining attorney should not abandon the application.

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If, after suspension of the Board proceeding and remand, the examining attorney approves the application for publication (or for registration on the Supplemental Register), the appeal is moot. The examining attorney should notify the applicant that the refusal or requirement is withdrawn, and that the application is being approved for publication or registration. This may be done by telephone, with an appropriate note to the file.

See TMEP §§1501 *et seq.* and TBMP Chapter 1200 for further information about *ex parte* appeals.

716 Suspension of Action by Office [R-2]

37 C.F.R. §2.67. *Suspension of action by the Patent and Trademark Office.*

Action by the Patent and Trademark Office may be suspended for a reasonable time for good and sufficient cause. The fact that a proceeding is pending before the Patent and Trademark Office or a court which is relevant to the issue of registrability of the applicant's mark, or the fact that the basis for registration is, under the provisions of Section 44(e) of the Act, registration of the mark in a foreign country and the foreign application is still pending, will be considered prima facie good and sufficient cause. An applicant's request for a suspension of action under this section filed within the 6-month response period (see §2.62) may be considered responsive to the previous Office action. The first suspension is within the discretion of the Examiner of Trademarks and any subsequent suspension must be approved by the Director.

The term “suspension of action” means suspending action *by the examining attorney*. It does not mean suspending or extending an applicant's time to respond. The Trademark Act requires that an applicant respond within six months of an examining attorney's Office action, and the examining attorney has no discretion to suspend or extend the time for the applicant's response. 15 U.S.C. §1062(b).

The examining attorney should suspend an application only after all issues have been resolved or are in condition for final action, except the matter on which suspension is based.

716.01 Form of Suspension Notice

In a suspension notice, the examining attorney must specifically state that action is suspended and must omit any reference to a six-month response period. The examining attorney should also inform the applicant of the status of the application, *i.e.*, that the mark appears to be otherwise entitled to be approved for publication or issue, or that the application is in condition for a final action.

If the application is in condition for a final action but for the matter necessitating suspension, the notice of suspension should clearly indicate which refusal(s) or requirement(s) will be made final when the application is removed from suspension. When the application is removed from suspension, the examining attorney should promptly issue a final action, assuming that no new issues have arisen.

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716.02 Circumstances Under Which Action May Be Suspended [R-1]

Under 37 C.F.R. §2.67, an examining attorney has the discretion to suspend an application “for good and sufficient cause.” The most common reasons for suspension of an application are discussed below.

As a general rule, the Office will not suspend an application to give an applicant time to secure a consent agreement.

716.02(a) Applicant’s Petition to Cancel Cited Registration

If the examining attorney refuses registration under §2(d) of the Trademark Act in view of the mark in a prior registration, the applicant may file a petition to cancel the registration under 15 U.S.C. §1064 and, within a proper response period, inform the examining attorney that the petition to cancel has been filed. This will constitute a proper response to the §2(d) refusal, and may be done by phone, if there are no other outstanding issues that require a written response. The examining attorney will then suspend further action until the termination of the cancellation proceeding, if the application is otherwise in condition for approval or final refusal. The applicant should provide the number of the cancellation proceeding, if available; however, if the applicant does not provide the cancellation number, the examining attorney may ascertain it from Office records.

The examining attorney should suspend only if the applicant states that the cancellation proceeding has already been filed or is being filed concurrently with the response to the Office action.

Although the examining attorney will determine the status of the cancellation proceeding through a routine status check (*see* TMEP §716.04), the applicant may call or e-mail to advise the examining attorney when the proceeding is terminated in order to avoid any possible delay in removing the application from suspension.

See TMEP §716.02(e) regarding suspension pending cancellation of a cited registration under §8 of the Act or expiration of a cited registration for failure to renew under §9 of the Act.

716.02(b) Submission of Copy of Foreign Registration in §44(d) Application [R-2]

When an applicant who claims the benefit of a prior foreign application under 15 U.S.C. §1126(d) is required to submit a copy of a foreign registration, the applicant may respond to the requirement by stating that the foreign application is still pending. The examining attorney should then suspend further action pending receipt of a copy of the foreign certificate, if the application is otherwise in condition for approval or final refusal. *See* TMEP §1003.04. The examining attorney may also suspend further action pending renewal of a foreign registration on which registration in the United States is based in an application under §44(e). *See* TMEP §1004.01(a).

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If an applicant claims §44(d) in addition to another basis, before suspending the application, the examining attorney must inquire whether the applicant wishes to retain §44(e) as a second basis for registration (based on the foreign registration that will issue from the application on which the applicant relied for priority). This inquiry should be made in the first Office action, or by telephone if no Office action is issued. If the applicant responds that it does want to assert a dual basis for registration and the application is otherwise in condition for publication or final refusal, then the examining attorney should suspend further action pending receipt of a copy of the foreign registration. *See* TMEP §806.02(f) for further information. The applicant may elect not to perfect a §44(e) basis and still retain the priority filing date. 37 C.F.R. §§2.35(c) and (d). *See* TMEP §806.04(b).

During the suspension period, the examining attorney will issue an Office action approximately every six months after suspension to inquire as to the status of the foreign application. If the applicant does not respond to the inquiry, the application will be abandoned. *See* TMEP §716.05.

716.02(c) Conflicting Marks in Pending Applications

When there are conflicting marks in pending applications, action on the application with the later effective filing date will be suspended (after examination on all other issues is concluded or in condition for a final action) until the mark in the conflicting application with the earlier effective filing date is either registered or abandoned. 37 C.F.R. §2.83(c). *See* TMEP §§1208 *et seq.* for more information about conflicting marks in pending applications.

If the examining attorney has cited a prior-filed pending application, the applicant may respond by arguing that there is no likelihood of confusion between the marks. If the examining attorney is not persuaded by the applicant's arguments, the examining attorney should suspend the later-filed application pending disposition of the conflicting application. *See* TMEP §716.03 regarding the applicant's request to remove an application from suspension.

If the examining attorney discovers that a prior-filed pending application was abandoned, but that a petition to revive is pending, the examining attorney should suspend the later-filed application pending disposition of the petition to revive. If the petition to revive is granted, the later-filed application will remain suspended until the mark in the earlier-filed application is registered or the earlier-filed application is again abandoned.

When an application is suspended pending the disposition of more than one earlier-filed conflicting application, and one of the conflicting applications matures into registration, the examining attorney will normally not issue a refusal of registration until the remaining conflicting application(s) are registered or abandoned, in order to avoid issuing piecemeal refusals. However, if deemed appropriate, the examining attorney does have the discretion to issue a refusal of registration under §2(d) in this situation.

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716.02(d) *Inter Partes* or Court Proceeding

When an examining attorney learns that a proceeding relevant to the registrability of an applicant's mark is pending before the Trademark Trial and Appeal Board or a court, the examining attorney should call the proceeding to the applicant's attention. If the applicant is not a party to the *inter partes* or court proceeding, the examining attorney must explain why the proceeding is relevant to the registrability of the applicant's mark. If the examining attorney believes the proceeding may result in a decision that supports a refusal of registration of the applicant's mark, the examining attorney must issue the refusal and give the applicant an opportunity to respond before suspending the application.

An applicant may request suspension because a proceeding relevant to the registrability of the applicant's mark is pending before the Office or a court. The applicant must submit a copy of the relevant pleadings, the docket number of the proceeding, and a written explanation of why the proceeding is relevant to the registrability of the mark. Normally, a court proceeding is not considered relevant to the registrability of a mark unless the remedy requested in the proceeding is cancellation, abandonment, or amendment of a relevant application or registration. However, when resolution of the court action requires the court to consider questions of Office policy or procedure, the examining attorney should not assume that the court would prefer to decide such questions absent the Office's decision in the consideration of an application. In these instances, action on an application should generally not be suspended. It is important to review the relevant pleadings, including the complaint and answer, before determining whether suspension is appropriate. The Office of the Solicitor may be consulted if there is a question as to whether suspension of the application is appropriate.

Before an application is suspended, the applicant must respond to all outstanding issues raised in the examining attorney's Office action that are not related to the proceeding. The examining attorney should not suspend the application unless all matters not related to the proceeding are resolved or in condition for final action.

See TMEP §716.02(a) regarding suspension pending disposition of an applicant's petition to cancel a cited registration under 15 U.S.C. §1064, and TMEP §716.03 regarding the applicant's request to remove an application from suspension.

716.02(e) Suspension Pending Cancellation or Expiration of Cited Registration

When the applicant submits a timely affidavit or declaration of continued use or excusable nonuse under 15 U.S.C. §1058 (§8 affidavit) and/or an application for renewal under 15 U.S.C. §1059, the Office's automated records are updated to indicate receipt of the paper and the action taken on the paper. The Office's automated records are updated three months after the grace period expires to indicate that a registration is cancelled or expired if:

- (1) No §8 affidavit has been filed before the end of the six-month grace period following the sixth year after the date of registration or publication under §12(c) of the Trademark Act, 15 U.S.C. §1062(c); or

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- (2) No §8 affidavit has been filed before the end of the six-month grace period following the expiration of the previous term of registration; or
- (3) No §9 renewal application has been filed before the end of the six-month grace period following the expiration of the previous term of registration.

See TMEP §§1602 *et seq.* regarding the duration of a registration, TMEP §1604.04 regarding the due dates for §8 affidavits, and TMEP §1606.03 regarding the due dates for §9 renewal applications.

The Office waits until three months *after* the expiration of the grace period for filing the §8 affidavit or renewal application before updating its records to show that the registration is cancelled or expired, to avoid inadvertent cancellation or expiration of a registration due to a delay in matching a timely filed §8 affidavit or renewal application with the registration file.

The examining attorney must confirm the status of the cited registration to ensure that it is still active before issuing any refusal of registration under Trademark Act §2(d), or filing a brief on appeal of a §2(d) refusal.

If the examining attorney is ready to issue a *nonfinal* refusal of registration under §2(d), and TRAM shows that the registration is still active, the examining attorney must issue the refusal even if the grace period for filing a §8 affidavit and/or a §9 renewal application for the cited registration has passed and TRAM does not indicate that the registrant has filed a §8 affidavit and/or renewal application. The examining attorney should not suspend the application, but should advise the applicant that the grace period for filing the §8 affidavit or renewal application has passed and that it appears that the registration may be subject to cancellation under §8 or expiration under §9.

If the examining attorney is ready to issue a *final* refusal of registration under §2(d), but the grace period for filing a §8 affidavit and/or a §9 renewal application for the cited registration has passed, the examining attorney should not issue a final refusal until the Office's automated records indicate that the registrant has filed the §8 affidavit or renewal application, and the Office has accepted the §8 affidavit or granted renewal. Instead, the examining attorney should suspend action for six months pending final disposition of the cited registration.

If the examining attorney is ready to write an appeal brief, but the grace period for filing a §8 affidavit and/or a §9 renewal application for the cited registration has passed, the examining attorney should request a remand so the application can be suspended pending final disposition of the cited registration. The Board will issue an order suspending the appeal and remanding the case to the examining attorney. If the cited registration is cancelled or expires, the examining attorney should withdraw the §2(d) refusal and notify the applicant that it has been withdrawn. If an appropriate affidavit or renewal application is filed for the cited registration, the examining attorney should notify the Board and return the file to the Board; the Board will resume proceedings and reset the time for filing the examining attorney's appeal brief. Similarly, if the cited registration is cancelled or expires, but the §2(d) refusal is only one of the issues on appeal, the examining attorney should notify the

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Board of the status of the cited registration and return the file to the Board. The Board will resume proceedings and reset the time for filing a brief. *See* TBMP §1213 regarding the suspension of an *ex parte* appeal pending cancellation of the cited registration under §8 or §9 of the Act.

The examining attorney cannot withdraw a refusal of registration under §2(d) until the TRAM system shows that the registration has actually been cancelled or expired.

See TMEP §1611 for information about how a registrant who has not timely filed a §8 affidavit or §9 renewal application may expedite the cancellation or expiration of its own registration.

716.03 Applicant's Request to Remove Application from Suspension

If an examining attorney suspends action on an application, and the applicant believes the suspension is improper, the applicant may file a request to remove the application from suspension. The applicant should state the reasons for the belief that the suspension is improper and attach any relevant evidence.

If persuaded by the request, the examining attorney should remove the application from suspension, and resume examination of the application and take appropriate action.

If not persuaded by the request, the examining attorney should issue a new suspension action that addresses the applicant's arguments *and explains the reasons why the request is not granted*. The applicant's recourse is to file a petition to the Director to review the examining attorney's action continuing the suspension. The Director will reverse the examining attorney's action only if there is clear error or abuse of discretion. *See* TMEP Chapter 1700 for information about petitions.

716.04 Suspended Docket Checked by Examining Attorney

An examining attorney will review each suspended case in his or her docket at least every six months to determine whether continued suspension is appropriate. If the examining attorney determines that the application should remain suspended, he or she should perform the appropriate TRAM transaction to report the suspension check.

716.05 Inquiry by Examining Attorney Regarding Suspended Application [R-2]

If the application has been suspended for six months or more, the examining attorney will issue an Office action inquiring as to the status of the matter on which suspension was based, unless the information is available to the examining attorney in the Office's databases. If the applicant does not respond to the Office action, the application will be abandoned.

For example, if action is suspended pending the receipt of a copy of a foreign registration, or pending the renewal of a foreign registration, the examining attorney will inquire every six months during the suspension period as to the status of the foreign application or registration.

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Similarly, for applications that are suspended pending the outcome of a civil action, the examining attorney will inquire every six months as to the status of the proceeding. If the foreign application or the civil action is still pending, a statement by the applicant to this effect is a proper response.

The examining attorney should *not* issue any inquiry about the status of a proceeding pending in the Office (*e.g.*, an *inter partes* proceeding).

716.06 Suspension After Final Action

If the examining attorney determines that action on an application should be suspended after issuance of a final refusal, the examining attorney must issue a suspension notice. This may occur, for example, when the applicant files a petition to cancel a cited registration. *See* TMEP §716.02(a). The examining attorney should not “withdraw the finality” of the refusal in order to suspend; however, in the suspension notice, the examining attorney should inform the applicant that the refusal of registration is continued but that it is not necessary to respond to the final refusal until the application is removed from suspension.

If the application is eventually removed from suspension and the grounds for refusal remain operative, the examining attorney should reissue the final refusal, and the applicant will have six months to respond to the final refusal. It is inappropriate to remove the case from suspension and immediately declare the application abandoned.

717 Remailing of Office Action

Sometimes an Office action must be remailed because the action has been returned by the United States Postal Service as undeliverable and/or the applicant notifies the Office that the applicant did not receive the Office action. In these situations, the Office will not give the remailed correspondence a new mailing date unless the Office action was sent to the wrong address due to an Office error. If there was an Office error, the Office will remail the Office action with a new mailing date, and stamp it “Remailed.” If there was no Office error, the Office will send a copy of the action to the applicant, but will *not* remail the action with a new mailing date.

An “Office error in sending the Office action to the wrong address” means that the Office either entered the correspondence address incorrectly or failed to enter a proper notice of change of address filed *before* the mailing date of the action. The transmittal of a response on letterhead bearing a new address is *not* a proper notice of change of address. The applicant or applicant’s attorney must specifically instruct the Office to change the correspondence address. *See* TMEP §603.02(a).

717.01 Returned Office Action

If an examining attorney’s Office action is returned to the Office because the United States Postal Service has not been able to deliver it, the supervisory legal instruments examiner

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(SLIE) in the law office will review the file to determine whether the correspondence address was entered correctly and/or whether the applicant has filed a notice of change of address.

If the Office action was sent to the wrong address due to an Office error (*see* TMEP §717), the Office action will be remailed with a new mailing date. However, if the Office action was sent to the correspondence address of record (*see* TMEP §§603 *et seq.*), the Office will try to obtain the correct address and forward the Office action, but the Office action will not be given a new mailing date, and the deadline for response will not be extended.

If the Office is ultimately unsuccessful in delivering or redelivering the Office action, the returned action and envelope should be placed in the file wrapper. If no communication from the applicant is received within the period for response, the application will be abandoned.

See TMEP §403 for more information about returned correspondence.

717.02 Non-Receipt of Office Action

If an applicant or applicant's attorney notifies the Office before the expiration of the response period that the applicant did not receive an action, the examining attorney must check to determine whether the action was properly addressed, *i.e.*, mailed to the correspondence address of record. *See* TMEP §§603 *et seq.*

If the Office action was mailed to the correspondence address of record, and there is time remaining in the response period, the examining attorney should send a copy of the action to the applicant, and should advise the applicant that the deadline for response runs from the original mailing date, and that a response must be received in the Office before this deadline to avoid abandonment. If the response period has expired, the examining attorney should advise the applicant that the application is abandoned, and that the applicant may file a petition to revive under 37 C.F.R. §2.66. *See* TMEP §§1714 *et seq.* regarding petitions to revive. In either situation, the examining attorney should make an appropriate note to the file.

If there is evidence in the file that the Office sent the Office action to the wrong address due to an Office error (*see* TMEP §717), the examining attorney will take the file to the SLIE, who will re-mail the Office action with a new mailing date, and stamp it "Remailed." The deadline for response will run from the new mailing date. If the application had been abandoned, it will be reinstated. *See* TMEP §1712.01 regarding reinstatement of applications that are abandoned due to Office error.

718 Abandonment

An abandoned application is an application for registration that is removed from the Office docket of pending applications because of express abandonment or because the applicant failed to take appropriate action within a specified response period.

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718.01 Express Abandonment by Applicant or Applicant's Attorney

37 C.F.R. §2.68. Express abandonment (withdrawal) of application.

An application may be expressly abandoned by filing in the Patent and Trademark Office a written statement of abandonment or withdrawal of the application signed by the applicant, or the attorney or other person representing the applicant. Except as provided in §2.135, the fact that an application has been expressly abandoned shall not, in any proceeding in the Patent and Trademark Office, affect any rights that the applicant may have in the mark which is the subject of the abandoned application.

A letter expressly abandoning an application must be signed by the applicant or the applicant's attorney. An application cannot be expressly abandoned by examiner's amendment.

When an applicant files a letter of express abandonment that meets the requirements of 37 C.F.R. §2.68, the examining attorney should perform a transaction expressly abandoning the application in TRAM. TRAM will generate a letter notifying the applicant that the application is now abandoned.

If it is unclear whether a document is a letter of abandonment, the examining attorney should contact the applicant to inquire about his or her intention before abandoning the application.

If an applicant files an express abandonment of an application that is not the subject of an *inter partes* proceeding before the Trademark Trial and Appeal Board, and wants to withdraw the abandonment to resume prosecution of the application, the applicant must petition the Director under 37 C.F.R. §2.146(a)(3) to request withdrawal of the express abandonment. However, such a petition will be granted only in an extraordinary situation. *In re Glaxo Group Limited*, 33 USPQ2d 1535 (Comm'r Pats. 1993).

If an applicant whose application is the subject of an opposition proceeding files an express abandonment of the application after the commencement of the opposition proceeding, but before receipt of the Board's notice of the filing of the opposition, the Board will allow the applicant an opportunity to withdraw the abandonment because the abandonment, if not withdrawn, may result in entry of judgment against the applicant in the opposition. *See* TBMP §§218, 307.11 and 602.01.

718.02 Failure by Applicant to Take Required Action During Statutory Period

15 U.S.C. §1062(b). If the applicant is found not entitled to registration, the examiner shall advise the applicant thereof and of the reason therefor. The applicant shall have a period of six months in which to reply or amend his application, which shall then be reexamined. This procedure may be repeated until (1) the examiner finally refuses registration of the mark or (2) the applicant fails for a period of six months to reply or amend or appeal, whereupon the application shall be deemed to have been abandoned, unless it can be shown to the satisfaction of the Director that the delay in responding was unintentional, whereupon such time may be

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extended.

Trademark Rule 2.65(a), 37 C.F.R. §2.65(a), specifies that an application becomes abandoned if the applicant fails to respond, or fails to respond completely, within the six-month statutory response period. *See* TMEP §§718.03 *et seq.* regarding incomplete responses.

The examining attorney has no authority to accept a late response. If an applicant files a late response, the examining attorney should immediately write to the applicant or applicant's attorney, stating that the response was untimely; that the application is abandoned; and that the applicant may file a petition to revive under 37 C.F.R. §2.66 if the failure to respond on time was unintentional. *See* TMEP §§1714 *et seq.* regarding petitions to revive.

718.03 Incomplete Response [R-2]

Extract from 37 C.F.R. §2.65.

(a) If an applicant fails to respond, or to respond completely, within six months after the date an action is mailed, the application shall be deemed to have been abandoned. A timely petition to the Director pursuant to §§2.63(b) and 2.146 is a response which avoids abandonment of an application.

(b) When action by the applicant filed within the six-month response period is a bona fide attempt to advance the examination of the application and is substantially a complete response to the examiner's action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, opportunity to explain and supply the omission may be given before the question of abandonment is considered.

Abandonment may result when the applicant's response, although received within the response period, is incomplete. The applicant must respond completely to each issue raised in the examining attorney's Office action to avoid abandonment. 37 C.F.R. §2.65(a).

However, the examining attorney should not hold an application abandoned because an applicant files an incomplete response to a nonfinal action (*i.e.*, does not address one or more of the requirements or refusals made in the Office action). Instead, the examining attorney should issue a final action, making all outstanding requirements and refusals final.

When an applicant files an incomplete response to a final action, the examining attorney has the discretion to hold the application abandoned for failure to respond completely (TMEP §718.03(a)), or to grant the applicant additional time to perfect the response if the applicant meets the requirements of 37 C.F.R. §2.65(b) (TMEP §718.03(b)). *See* TMEP §715.01 regarding a proper response to a final refusal, and TMEP §715.03(a) regarding the examining attorney's response to an applicant's request for reconsideration of a final Office action.

The examining attorney cannot abandon an application for failure to file a complete response before the expiration of the statutory period for response to the outstanding Office action. If the applicant files an incomplete response to a final action, and there is time remaining in the period for response to the Office action when the examining attorney acts on the incomplete

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response, the examining attorney should issue a written action, without a six-month response clause (*see* TMEP §705.08), explaining why the response is incomplete, and advising the applicant that the response must be completed within the period for response to the previous Office action to avoid abandonment.

An inquiry, a request to extend the response period, or a communication on a matter unrelated to the preceding Office action, does not constitute a proper response and will be treated as an incomplete response.

A written disagreement with the examining attorney's refusal or requirement may be a complete response to a *nonfinal* action with respect to that refusal or requirement.

718.03(a) Holding of Abandonment for Failure to Respond Completely

If the examining attorney holds an application abandoned for failure to file a complete response, the examining attorney should issue a written action, without a six-month response clause (*see* TMEP §705.08), stating that the application is being abandoned, and explaining the specific reason. After mailing this Office action, the examining attorney should abandon the application. *See* TMEP §718.03(c) regarding an applicant's request for reconsideration of an examining attorney's holding of abandonment for failure to file a complete response, and TMEP §1713 regarding a petition for review of the examining attorney's holding of abandonment for failure to file a complete response.

718.03(b) Granting Additional Time to Perfect Response

Under 37 C.F.R. §2.65(b), the examining attorney has discretion to give an applicant additional time to perfect the response if:

- (1) a response was filed within the six-month period;
- (2) the response was a bona fide attempt to advance the examination;
- (3) the response was a substantially complete response to the examining attorney's action; and
- (4) consideration of some matter or compliance with some requirement was inadvertently omitted.

If the examining attorney decides that the response meets all four criteria, he or she should write an action explaining why the response is considered incomplete and giving the applicant 30 days, or to the end of the response period set forth in the action, whichever is longer, to complete the response. The examining attorney must omit the six-month response clause.

If the examining attorney grants the applicant additional time to complete a response to a final action under 37 C.F.R. §2.65(b), this does *not* extend the time for appeal. The applicant

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must file a notice of appeal within six months of the mailing date of the final action. 15 U.S.C. §1062(b); 37 C.F.R. §2.142(a).

718.03(c) Reconsideration of Holding of Abandonment

If an examining attorney holds an application abandoned for failure to file a complete response, the applicant may file a request for reconsideration of the examining attorney's holding, arguing that the response was not incomplete. While the examining attorney has no authority to act on an application if no response was filed, the examining attorney does have the authority to reverse his or her holding as to whether or not a response received during the statutory period was a complete response. If the examining attorney reverses his or her holding of abandonment for failure to file a complete response, the TRAM System must be updated to withdraw the abandonment and show the correct status of the application.

The applicant may also contact the managing attorney or senior attorney and request review of the examining attorney's action. If the managing attorney or senior attorney believes that the holding of abandonment was improper, he or she will direct the examining attorney to reverse the holding of abandonment.

If the examining attorney does not reverse the holding of abandonment, the applicant may petition the Director to reverse the holding. A petition to reverse a holding of abandonment is not the same as a petition to revive an abandoned application. The Director will reverse the examining attorney's holding of abandonment only if there is clear error or abuse of discretion. The "unintentional delay" standard does not apply. *See* TMEP §1713.

718.04 Failure to File Statement of Use

Under 15 U.S.C. §1051(d)(4), an application under §1(b) of the Act is abandoned if the applicant fails to timely file a statement of use or request for an extension of time to file a statement of use. 37 C.F.R. §§2.65(c) and 2.88(h); TMEP §§1108.01 and 1109.04.

The Intent-to-Use Unit will abandon the application if the applicant fails to file a statement of use or request for an extension of time to file a statement of use within six months of the mailing date of the notice of allowance, or within a previously granted extension period. The Office will send a computer-generated notice of abandonment to the applicant.

If the failure to timely file the statement of use or extension request was unintentional, the applicant may file a petition to revive under 15 U.S.C. §1051(d)(4) and 37 C.F.R. §2.66. *See* TMEP §§1714 *et seq.*

718.05 Failure to Perfect Appeal

An application may become abandoned because of withdrawal of, or failure to prosecute, an appeal to the Trademark Trial and Appeal Board. 15 U.S.C. §1062(b); TBMP §1202.01.

An application may also become abandoned because of failure to perfect an appeal, or dismissal of an appeal, to the Court of Appeals for the Federal Circuit or civil court.

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718.06 Notice by Office of Abandonment for Failure to Receive a Response

If no response is received by the Office within six months of the mailing date of an Office action, the application is sent to the examining attorney to be abandoned. The examining attorney should check the file to ensure that there is no response and that the Office action was sent to the correspondence address of record. *See* TMEP §§603 *et seq.* Regarding the remailing of an Office action that was sent to the wrong address due to an Office error, *see* TMEP §§717 *et seq.*

When an application is abandoned, the Office stamps the word “ABANDONED” on the file wrapper. The application is considered to be abandoned as of the day after the date on which a response was due, although the examining attorney performs the TRAM transaction that reports the abandonment at a later date. The Office sends a computer-generated notice of abandonment to the correspondence address listed in the application file.

Applications that are abandoned after *ex parte* appeals or *inter partes* proceedings are considered abandoned as of the date of the action by the Board that caused the application to abandon (*e.g.*, affirming the examining attorney’s refusal or sustaining an opposition). However, the TRAM transaction reporting the abandonment is not performed until a month after expiration of the period for appeal from the Board’s decision.

718.07 Ordering Abandoned Application Files

The Office destroys abandoned application files and cancelled or expired registration files two years after they become abandoned, cancelled or expired.

Office personnel may order abandoned application files through the file ordering system on the Office’s computer network.

See TMEP §109.02 regarding the ordering of abandoned application files by the public.

Files should be returned promptly when no longer needed.

718.08 Revival or Reinstatement of Abandoned Application - New Search Required [R-2]

When an abandoned application is revived or reinstated, the examining attorney must conduct a new search of Office records for conflicting marks. If the search shows that a later-filed conflicting application has been approved for publication, the examining attorney should request jurisdiction and suspend the later-filed application pending disposition of the earlier-filed (revived) application. 37 C.F.R. §2.83(c); TMEP §§1208.02(c) and 1504.04(a).

If the new search shows that a later-filed conflicting application has been approved for registration, the examining attorney should withdraw the application from issue (if possible) and suspend it. However, if a later-filed conflicting application is already registered, the Office is without authority to cancel the registration. The examining attorney must refuse registration of the earlier-filed (revived) application under 15 U.S.C. §1052(d). In this

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situation, an applicant has the option of filing a petition to cancel the registration under Section 14 of the Trademark Act.

See TMEP §§1714 *et seq.* regarding petitions to revive, TMEP §1712.01 regarding reinstatement of applications abandoned due to Office error, and TMEP §1713 regarding petitions to reverse a holding of abandonment.

719 Fraud Upon the Office

If an examining attorney suspects the possibility of fraud upon the Office in the *ex parte* examination of a trademark application, the following procedure must be followed.

- (1) The examining attorney must bring the matter to the attention of the managing attorney in his or her law office.
- (2) If the managing attorney concurs with the examining attorney as to the possibility of fraud upon the Office, the managing attorney will bring the matter to the attention of the Administrator for Trademark Policy and Procedure.
- (3) If the Administrator believes that the matter warrants further action, he or she will make an appropriate recommendation to the Commissioner for Trademarks.

Under no circumstances should any Office communication pertaining to fraud be made, either orally or in writing, by anyone in the Trademark Examining Operation, except as set forth in paragraphs 1 and 2 above.

These issues are ultimately referred to the Office of Enrollment and Discipline.