



Wednesday
September 8, 1999

Part II

**Department of
Commerce**

Patent and Trademark Office

37 CFR Part 1 et al.
Trademark Law Treaty Implementation
Act Changes; Final Rule

DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Parts 1, 2, 3 and 6

[Docket No. 980826226-9185-02]

RIN 0651-AB00

Trademark Law Treaty Implementation Act Changes

AGENCY: Patent and Trademark Office, Commerce.

ACTION: Final rule.

SUMMARY: The Patent and Trademark Office (Office) is amending its rules to implement the Trademark Law Treaty Implementation Act of 1998 (TLTIA), Pub. L. 105-330, 112 Stat. 3064 (15 U.S.C. 1051), and to otherwise simplify and clarify procedures for registering trademarks, and for maintaining and renewing trademark registrations. TLTIA implements the Trademark Law Treaty (TLT). TLT is to make the procedural requirements of the different national trademark offices more consistent.

DATES:*Effective Date:* October 30, 1999.*Applicability Dates:* See**SUPPLEMENTARY INFORMATION.****FOR FURTHER INFORMATION CONTACT:**

Mary Hannon, Office of Assistant Commissioner for Trademarks, by telephone at (703) 308-8910, extension 137; by facsimile transmission addressed to her at (703) 308-9395; or by mail marked to her attention and addressed to Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

SUPPLEMENTARY INFORMATION:**Applicability Dates**

Pending Applications for Registration: The TLTIA amendments to the Act, and these rule changes, shall apply to any application for registration of a trademark pending on, or filed on or after, October 30, 1999.

Informal Applications: Application papers filed before October 30, 1999, but not reviewed by the Office for compliance with minimum filing requirements until after October 30, 1999, will be required to meet the minimum filing requirements (§ 2.21) in effect as of the date of filing. If the application fails to meet the minimum filing requirements in effect on the date of filing, but meets the minimum filing requirements in effect on the date the papers are reviewed, the application will be assigned a filing date of October 30, 1999.

Petitions to Revive: Petitions to revive pending on October 30, 1999, will be

reviewed under the unintentional delay standard. See the discussion below of the changes to § 2.66.

Post Registration: The revised provisions of sections 8 and 9 of the Act, and these amendments to the rules, apply only to affidavits and renewal applications filed on or after October 30, 1999. The old law applies to affidavits and renewal applications filed before October 30, 1999, even if the sixth or tenth anniversary, or the expiration date of the registration is on or after October 30, 1999. This is true even for affidavits and renewal applications that are filed before, but examined after, October 30, 1999.

The revised provisions of section 9 of the Act do not apply to applications for renewal of registrations that expire before October 30, 1999, even if the applications are examined after October 30, 1999. For example, if a registration expires on October 29, 1999, the registrant may file a renewal application within the three-month grace period provided under the old law. The new six-month grace period does not apply to registrations with expiration dates prior to October 30, 1999.

Likewise, the new law does not apply to a section 8 affidavit due before October 30, 1999, even if the affidavit is not examined until after October 30, 1999. For example, if a registration issued on October 29, 1993, the registrant must meet the statutory requirements of section 8 of the Act on or before October 29, 1999. The registrant cannot take advantage of the six-month grace period, or the deficiency period, provided under the new law.

The revised provisions of section 8 of the Trademark Act, 15 U.S.C. 1058, and these rule changes, apply to the filing of an affidavit of continued use or excusable nonuse under section 8 of the Act if: (1) The sixth or tenth anniversary of registration, or the sixth anniversary of publication under section 12(c) of the Act, is on or after October 30, 1999; and (2) the affidavit is filed on or after October 30, 1999. However, the provisions of section 8(a)(3) of the Act, requiring the filing of a section 8 affidavit at the end of each successive ten year period after registration, do not apply to a registration issued or renewed for a twenty year term (*i.e.*, a registration issued or renewed before November 16, 1989) until a renewal application is due.

A Notice of Proposed Rulemaking was published in the **Federal Register** (64 FR 25223) on May 11, 1999, and in the *Official Gazette* of the Patent and Trademark Office (1223 TMOG 41) on

June 8, 1999. A public hearing was held on June 10, 1999.

Written comments were submitted by two organizations, two law firms, and five trademark attorneys. Three organizations and one attorney testified at the oral hearing.

References below to "the Act," "the Trademark Act" or "the statute" refer to the Trademark Act of 1946, as amended, 15 U.S.C. 1051 *et seq.* "TMEP" is the *Trademark Manual of Examining Procedure* (2nd ed., Rev. 1.1, August 1997).

Application Filing Dates

TLTIA section 103 adds sections 1(a)(4) and 1(b)(4) of the Act to give the Office authority to establish and change filing date requirements. The Office is amending § 2.21 to require the following elements for receipt of a filing date: (1) The name of the applicant; (2) a name and address for correspondence; (3) a clear drawing of the mark; (4) a list of the goods or services; and (5) the filing fee for at least one class of goods or services.

Comment: One comment stated that the proposed requirement in § 2.21(a)(3) for a "clear drawing of the mark" was confusing, and that it could impose a hardship on some applicants, *e.g.*, where the attorney's only copy of the drawing is a fax received from a foreign client.

Response: The requirement for a "clear drawing of the mark" is intended to be more lenient than the current requirement for a drawing "substantially meeting all the requirements of § 2.52." A clear drawing of the mark is essential, so that the application can be properly examined, and so that the public will have adequate notice of the mark.

The following elements will no longer be required for receipt of a filing date: a certified copy of the foreign registration in a section 44(e) application; an allegation of the applicant's use or bona fide intention to use the mark in commerce; a specimen and date of first use in commerce in a section 1(a) application; a stated filing basis; and a signature. These elements will instead be required during examination.

Comment: One comment stated that while a filing date should not be denied if the application does not include a filing basis, the basis should be made of record as soon as possible.

Response: The Office expects that most applicants will state the filing basis in the original application. If the application does not include the filing basis, this information will be required in the first Office action.

Bulky Specimens

Amended § 2.56(d)(1) requires that specimens be flat and no larger than 8½ inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long. This is consistent with current § 2.56. Section 2.56(d)(2) is added, stating that if an applicant submits a specimen that exceeds the size requirement (a "bulky specimen"), the Office will create a facsimile of the specimen that meets the requirements of the rule (*i.e.*, is flat and no larger than 8½ inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long), insert it in the application file wrapper, and destroy the original bulky specimen.

Currently, when an applicant submits a specimen that does not meet the requirements of § 2.56 (*i.e.*, is not flat, exceeds the size limitation, etc.), the Office retains the specimen even though it is impossible to attach it to the application file wrapper. This requires substantial special handling because the Office must store and track the specimens separately from the application file wrappers. Because the number of newly filed applications has increased from approximately 83,000 to over 233,000 per year over the past ten years, and the number of pending applications has increased from less than 100,000 to over 350,000 in the same period, it has become increasingly difficult to ensure that the bulky specimens follow the application files. As the number of applications has increased, bulky materials submitted as specimens have also increased, requiring an increased use of limited resources to handle the bulky materials. Further, because specimens of this nature are often misplaced or lost during examination processing, the Office must then require new specimens, slowing examination and inconveniencing applicants.

Because the requirement for flat specimens can be easily satisfied through the use of photographs, photocopies, or other means of reproduction, the Office will no longer retain bulky materials submitted as specimens. In very limited circumstances, the Office will continue to accept specimens consisting of videotapes, audiotapes, CDs, computer diskettes, and similar materials where there are no non-bulky alternatives, and the submission is the only means available for showing use of the mark.

Comment: One comment supported the proposed procedure for creating facsimiles of bulky specimens. Another comment supported the proposed procedure, provided that the Office makes copies of the front, back, and all portions of the specimens.

Response: The Office will attempt to capture the mark as used on the specimen, but may not copy all portions of the bulky specimens. If an additional specimen is needed, the examining attorney will require a substitute specimen that meets the size requirements of the rules.

Number of Specimens Required

The Office is amending §§ 2.56(a), 2.76(b)(2), 2.86(b), and 2.88(b)(2) to require one rather than three specimens with an application under section 1 of the Act, or an amendment to allege use or statement of use of a mark in an application under section 1(b) of the Act. The Office previously required three specimens so that an interested party, such as a potential opposer, could permanently remove a specimen from an application file, yet not leave the file without specimens. TMEP § 905.01. However, multiple copies of specimens are no longer necessary because the public may make photocopies of a single specimen.

Comment: Three comments opposed the proposed requirement for only one specimen, stating that if only one specimen is required, and that specimen is lost, the file will be left with no specimen; that multiple specimens enable interested third parties to obtain an original without having to contact the applicant directly; and that current photocopying technology does not adequately reproduce color, small details, tones, low-contrast images, or highly ornate/intricate or densely worded specimens.

Response: The Office does not permit the removal of other documents from application files and will no longer permit specimens to be removed from files. Prohibiting the removal of specimens will ensure that there is a complete record of the submissions made by the applicant. Where removal is permitted, a third party could mistakenly remove a unique specimen, thinking it is merely a duplicate. This would leave the application file incomplete.

Currently, 10% of new applications for registration are filed electronically, and the Office expects this number to increase dramatically in the near future. Only one specimen is required with an electronically filed application, and it is submitted as a digitized image (§ 2.56(d)(4)). Considering the increasing number of electronic filings and the move in the future to a paperless Office, the Office believes that three specimens are unnecessary.

Comment: One comment stated that it generally supports the proposed requirement for only one specimen, but

noted that there will be a greater urgency for the Office to ensure that the single specimen is always available for public inspection.

Response: As noted above, the Office will no longer permit specimens to be removed from files. The Office now microfilms all incoming applications, so that a record of the specimen is available to the public if it is lost. In the near future, the Office will be scanning all incoming applications and allegations of use and will have an electronic image of any specimen that is lost.

Comment: One comment asked whether more than one specimen may be submitted.

Response: Yes, while only one specimen will be required, a party may choose to file more than one specimen. Multiple specimens will be retained in the file as long as they do not exceed the size limitations of § 2.56(d)(1).

Persons Who May Sign

Currently, sections 1(a)(1)(A) and 1(b)(1)(A) of the Act require that an application by a juristic applicant be signed "by a member of the firm or an officer of the corporation or association applying." TLTA section 103 amends sections 1(a) and 1(b) of the Act to eliminate the specification of the appropriate person to sign on behalf of an applicant.

The applicant or registrant, and the applicant's or registrant's attorney, are best able to determine who should sign documents filed in the Office. Therefore, the Office will no longer question the authority of the person who signs a verification, or a renewal application, unless there is an inconsistency in the record as to the signatory's authority to sign.

Proposed § 2.33(a) stated that a person properly authorized to sign on behalf of the applicant "includes a person with legal authority to bind the applicant and/or a person with firsthand knowledge and actual or implied authority to act on behalf of the applicant."

Comment: One comment suggested that § 2.33(a) be amended to state that a person who is properly authorized to sign on behalf of the applicant includes: (1) A person with legal authority to bind the applicant, (2) a person with firsthand knowledge of the facts asserted, and actual or implied authority to act on behalf of the applicant, and (3) an attorney as defined in § 10.1(c) of this chapter who has an actual or implied, written or verbal power of attorney from the applicant, provided that the Office may require written confirmation of

such power of attorney subsequent to the filing of the verified statement.

Response: The suggestion has been adopted, but modified slightly. The Office will not require written confirmation of a power of attorney, but will accept the attorney's word that he or she is authorized to sign on behalf of the applicant.

Comment: One comment suggested that "and/or" be changed to "or."

Response: The suggestion has been adopted.

Comment: One comment suggested that "implied authority" be changed to "apparent authority."

Response: The suggestion has not been adopted. The Office believes that the "implied authority" standard is broad enough to cover most circumstances and to allow applicants flexibility in determining who can sign verifications.

Comment: Four comments requested clarification as to whether attorneys can sign on behalf of clients, and whether any special power of attorney is needed.

Response: Sections 2.33(a) and 2.161(b) have been amended to provide for signature of verifications by attorneys. No special power of attorney will be required.

Renewal applications may also be signed by attorneys. Verification of renewal applications is no longer required. Section 2.183(a) requires that the renewal application be executed by "the registrant or the registrant's representative."

Filing by Owner

Although TLTIA amends the statute to eliminate the specification of the proper party to sign on behalf of an applicant or registrant, the statute still requires that the owner of the mark file an application for registration, amendment to allege use, statement of use, request for extension of time to file a statement of use, and section 8 affidavit. See sections 1(a)(1), 1(b)(1), 1(d)(1), 1(d)(2), and 8(b) of the Act.

TLTIA section 105 amends section 8 of the Act to require that the owner of the mark file an affidavit of continued use or excusable nonuse within the time period set forth in section 8(a) of the Act. The legislative history states:

Throughout the revised section 8, the term "registrant" has been replaced by the term "owner." The practice at the Patent and Trademark Office has been to require that the current owner of the registration file all the post-registration affidavits needed to maintain a registration. The current owner of the registration must aver to actual knowledge of the use of the mark in the subject registration. However, the definition of "registrant" in section 45 of the Act states

that the "terms 'applicant' and 'registrant' embrace the legal representatives, predecessors, successors and assigns of each applicant and registrant." Therefore, use of the term "registrant" in section 8 of the Act would imply that any legal representative, predecessor, successor or assign of the registrant could successfully file the affidavits required by sections 8 and 9. To correct this situation, and to keep with the general principal (sic), as set out in section 1, that the owner is the proper person to prosecute an application, section 8 has been amended to state that the owner must file the affidavits required by the section.

H.R. Rep. No. 194, 105th Cong., 1st Sess. 18-19 (1997).

Therefore, the Office is amending §§ 2.163(a) and 2.164(b) to make it clear that filing by the owner is a minimum requirement that cannot be cured after expiration of the filing period set forth in section 8 of the Act.

Under sections 1(a) and 1(b) of the Act, an application for registration of a mark must also be filed by the owner. Therefore, new § 2.71(d) states that although a mistake in setting out the applicant's name can be corrected, the application cannot be amended to set forth a different entity as the applicant; and that an application is void if it is filed in the name of an entity that did not own the mark as of the filing date of the application. This codifies current practice. TMEP § 802.07. *Huang v. Tzu Wei Chen Food Co. Ltd.*, 7 USPQ2d 1335 (Fed. Cir. 1988) (application filed in name of individual two days after mark was acquired by newly formed corporation held void); *Accu Personnel Inc. v. Accustaff Inc.*, 38 USPQ2d 1443 (TTAB 1996) (application filed in name of entity that did not yet exist not void); *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689 (TTAB 1991) (application filed by joint venturer void where mark owned by joint venture); *U.S. Pioneer Electronics Corp. v. Evans Marketing, Inc.*, 183 USPQ 613 (Comm'r Pats. 1974) (misidentification of applicant's name may be corrected).

The Office is also amending §§ 2.88(e)(3), 2.89(a)(3), and 2.89(b)(3) to state that if a statement of use or request for an extension of time to file a statement of use is unsigned or signed by the wrong party, a substitute verification must be submitted before the expiration of the statutory period for filing the statement of use. This is consistent with current practice. See TMEP §§ 1105.05(f)(i)(A) and 1105.05(d). Sections 1(d)(1) and (2) of the Act require verification by the owner within the statutory period for filing the statement of use. Therefore, the Office cannot extend or waive the deadline for filing the verification. *In re*

Kinsman, 33 USPQ2d 1057 (Comm'r Pats. 1993).

Material Alteration

The Federal Circuit held in *In re ECCS*, 94 F.3d 1578, 39 USPQ2d 2001 (Fed. Cir. 1996) that an applicant may amend an application based on use to correct an "internal inconsistency" in the original application. *Id.* at 1581, 39 USPQ2d at 2004. An application is "internally inconsistent" if the mark on the drawing does not agree with the mark on the specimens filed with the application. *Id.* As a result, the Office has been accepting all amendments to drawings in use-based applications if there is an inconsistency in the initial application.

However, the Office does not believe that it is in the public interest to accept amendments that materially alter the mark on the original drawing. When the Office receives a new application, the mark on the drawing is promptly filed in the Trademark Search Library and entered into the Office's electronic and administrative systems. Because the granting of a filing date to an application potentially establishes a date of constructive use of the mark under section 7(c) of the Act, timely and accurate public notification of the filing of applications is important. Accepting an amendment that materially alters the mark on the original drawing is unfair to third parties who search Office records between the application filing date and the date of the amendment, because they do not have accurate information about earlier-filed applications. Relying on the search of Office records, a third party may innocently begin using a mark that conflicts with the amended mark, but not with the original mark. Also, an examining attorney may approve a later-filed application for registration of a mark that conflicts with the amended mark, but not with the original mark. Therefore, the Office is amending § 2.72 to prohibit amendments that materially alter the mark on the original drawing.

Comments: One law firm opposed any amendment of § 2.72, stating that the decisions in *ECCS* and *In re Dekra*, 44 USPQ2d 1693 (TTAB 1997) established a fair compromise between the rights of the applicant and the rights of third parties. One organization stated that minor changes like the change permitted in *ECCS* should be allowed, but that it "does not endorse the type of substantial change to a drawing permitted in *Dekra*," and expressed concern that the amendment to § 2.72 could lead to a more stringent standard for determining material alteration than the standard set forth in *ECCS*. The

comment further noted that the standard for determining whether the mark in the drawing agrees with the mark in the foreign registration in a section 44 application is stricter than the standard used to determine whether specimens support use of a mark in an application under section 1 of the Trademark Act, and suggested that if a uniform standard for determining material alteration is adopted, the more liberal standard applied to section 1(a) or section 1(b) applications should be used.

Response: *ECCS* held that under current § 2.72(b), the specimens filed with the original application in a use-based application must be considered in determining what mark the applicant seeks to register. However, the court specifically noted that seven decisions cited in the *ECCS* decision were not affected: "We have carefully examined all * * * (seven) cases and find that none has any bearing on the situation before us in which an original application is *internally inconsistent* as to what the mark is, the specimen displaying one mark and the drawing a *slightly different mark*." * * * *Id.* at 1581, 39 USPQ2d at 2004 (emphasis added). *ECCS* specifically cited *In re Abolio y Rubio S.A.C.I. y G.*, 24 USPQ2d 1152 (TTAB 1992) and *In re Meditech Int'l Corp.*, 25 USPQ2d 1159 (TTAB 1990). *ECCS* at 1581, 39 USPQ2d at 2004. *Abolio y Rubio* involved an application based on a foreign registration (15 U.S.C. 1026(e)) in which the drawing omitted the design shown in the foreign registration submitted with the application. *Meditech* concerned a use-based application in which the drawing contained the typed words "DESIGN OF A BLUE STAR" while the specimens showed a design of twenty blue stars without the words shown in the drawing. In both of these cases, the applicants were not permitted to amend their drawings. Subsequently, the Federal Circuit in *In re Hacot-Colombier*, affirmed the Board's refusal to permit an applicant to amend its drawing in an application based on a foreign-filed application, 15 U.S.C. 1126(d), 105 F.3d 616, 41 USPQ2d 1523 (Fed. Cir. 1997). Citing *Abolio y Rubio* with approval, the Court gave deference to the agency's interpretation that § 2.72 includes both a prohibition against material alterations and a requirement that any alteration conform to the mark in the foreign registration. *Id.* at 619, 41 USPQ2d at 1526. The present amendment to § 2.72 is not intended to change the standard for determining what constitutes a material alteration as discussed in the Board cases cited in *ECCS*, or in *Hacot-Colombier*.

Color Drawings

Section 2.52 is amended to delete the color lining chart currently in § 2.52(e).

Comment: One comment asked whether the Office would accept drawings in actual color.

Response: The Office will no longer deny an application a filing date if the mark is depicted in color. However, the Office does not yet have the technology to scan marks in color, and the marks will be uploaded into the Office's automated systems in black and white.

Comment: One comment asked whether marks would be published in the *Official Gazette* and issued in color.

Response: The Office will not publish and issue marks in color on October 30, 1999. However, the Office anticipates publishing and issuing marks in color in the future.

Comment: Two comments requested that color photocopiers be made available to the public.

Response: Color photocopiers are very expensive and will not be available to the public on October 30, 1999. The Office is looking into purchasing a color copier for use by the public, for a fee, and will make it available as soon as possible.

Comment: One comment suggested that the Office should permit the use of lining or stippling to indicate color on a drawing, at least until an alternative method of indicating color gains wide acceptance.

Response: There will be a transition period in which the Office will continue to publish and register marks that contain the color linings currently in § 2.52(e). An *Official Gazette* notice will advise when color lining is no longer acceptable.

Comment: One comment noted that proposed § 2.52(a)(2)(i) referred to color lining, while the color lining chart was deleted from § 2.52(e).

Response: The reference to color lining has been deleted from § 2.52(a)(2)(i).

Comment: One comment suggested that the Office clarify what is a sufficient description and location of color applied to a mark.

Response: The application must include a clear and specific description of the mark, identifying the mark as consisting of the particular color as applied to the goods or services. If the color is applied only to a portion of the goods, the description must indicate the specific portion. Similarly, if the mark includes gradations of color, the description should so indicate. The Office will issue an examination guide giving further guidance as to how it will process color drawings.

Comment: One comment suggested that the Office accept color photographs to describe the color claimed in a mark.

Response: In addition to a written description of a mark, the Office will accept color photographs for the record to describe the color claimed in a mark.

Comment: Two comments suggested that applicants should have the option to identify color using a generally accepted color identification system.

Response: The Office does not endorse any one commercial color identification system. However, in addition to a written description of the color contained in a mark, an applicant may refer to a commercial color identification system to describe color.

Revival of Abandoned Applications

Effective October 30, 1999, sections 1(d)(4) and 12(b) of the Act, and section 2.66 permit the revival of an abandoned application where the delay in responding to an Office action or notice of allowance is "unintentional." A showing of "unavoidable" delay is no longer required. All petitions to revive pending on or filed on or after October 30, 1999, will be reviewed under the unintentional delay standard.

Under § 2.66(a), the applicant must file a petition to revive (1) within two months of the mailing date of the notice of abandonment; or (2) within two months of actual knowledge of the abandonment, if the applicant did not receive the notice of abandonment, and the applicant was diligent in checking the status of the application. These deadlines will be strictly enforced.

The written statement that the delay was unintentional must be signed by someone with firsthand knowledge of the facts, but it need not be verified or supported by a declaration under § 2.20.

It is not necessary to explain the circumstances that caused the unintentional delay. The Office will generally not question the applicant's assertion that the delay in responding to an Office action or notice of allowance was unintentional, and will grant the petition, unless there is information in the record indicating that the delay was in fact intentional.

See the discussion below of the amendments to § 2.66 for further information on the requirements for filing a petition to revive.

Comment: One comment suggested that § 2.66(a) (1) and (2) be amended to provide for filing a petition to revive within two months of "the mailing date of an adverse decision on a Request For Reinstatement," so as to avoid a disincentive for filing requests for reinstatement.

Response: The suggestion has not been adopted because it is unnecessary. When the Office denies a request for reinstatement, the Office routinely gives the applicant an opportunity to pay the petition fee and convert the request for reinstatement into a petition to revive.

Comment: One comment suggested that § 2.66(a) be amended to provide for the filing of a petition to revive where the applicant did not timely respond to "a decision on the petition (other than a petition to revive under this rule)," because "(t)here may be instances where a decision on petition is misdirected by the U.S. Postal Service and results in the abandonment of the application. For example, consider a petition for an extension of time to commence judicial review under 37 CFR 2.145(e)."

Response: The suggestion has not been adopted. Sections 1(d)(1) and 12(b) of the Act, 15 U.S.C. 1051(d)(1) and 1062(b), provide for revival of an abandoned application based on a showing of unintentional delay only where there is a delay in responding to an Office action or filing a statement of use or request for an extension of time to file a statement of use. In the example provided, the remedy is found in § 2.145(e)(2), which provides that the Commissioner may extend the time for filing an appeal or commencing a civil action "upon written request after the expiration of the period for filing an appeal or commencing a civil action upon a showing that the failure to act was the result of excusable neglect." In other situations, the remedy is to file a petition to the Commissioner under § 2.146(a)(5), under which the Commissioner may waive any provision of the rules that is not a provision of the statute, where an extraordinary situation exists, justice requires, and no other party is injured thereby.

Due Diligence

Sections 2.66(a)(2) and 2.146(i) are amended to indicate that where a petitioner seeks to reactivate an application or registration that was abandoned or cancelled due to the alleged loss or mishandling of papers mailed to or from the Office, the petition will be denied if the petitioner was not diligent in checking the status of the application or registration. This codifies the long-standing past practice of the Office. TMEP sections 413, 1112.05(b)(ii), and 1704. To be considered diligent, the petitioner must check the status of the application or registration that is the subject of the petition within one year of the last filing or receipt of a notice from the Office for which further action by the Office is expected.

The Office now denies petitions when the petitioner waits too long before checking the status of an application or registration. The rationale is that granting the petition would be unfair to third parties who may have searched Office records and relied to their detriment on information that an application was abandoned or that a registration had expired or been cancelled. A third party may have diligently searched Office records and begun using a mark because the search showed no earlier-filed conflicting marks, or an examining attorney may have searched Office records and approved a later-filed application for a conflicting mark.

A party can check the status through the Trademark Status Line ((703) 305-8747) or through the Trademark Applications and Registrations Retrieval (TARR) database on the Office's World Wide Web site at <http://www.uspto.gov/go/tarr/>. Written status inquiries are discouraged.

Comment: One comment suggested that the one-year due diligence standard be expressly incorporated into §§ 2.66(a)(2) and 2.146(i).

Response: The suggestion has been adopted.

Comment: One comment requested guidance as to how one proves that he or she has been diligent in monitoring the status of a pending matter.

Response: A party may call the Status Line, or access status information through the World Wide Web, and make a notation in the party's own file noting the date of the status inquiry, and the substance of the information learned. If it is ever necessary to petition for corrective action, the dates and substance of the status inquiries should be summarized in the petition. No further documentation is necessary.

Comment: One comment objected to the requirement that petitioners be diligent in monitoring the status of pending matters, noting that docketing a one-year status check every time a paper is filed or received results in a maze of confusing entries in docketing systems that makes it difficult to tell which dates have been superseded.

Response: To protect the interests of third parties and to maintain the integrity of the register, the Office believes that requests to reactivate abandoned applications or cancelled registrations must be made within a reasonable time; the Office does not believe that requiring a status check once per year is unreasonable. Therefore, the Office will continue its long-standing practice of denying petitions to revive under § 2.66 and petitions to the Commissioner under

§ 2.146 if the petitioner has waited too long before investigating the problem.

Amendment of Basis After Publication

Proposed § 2.35(b) prohibited an amendment to add or substitute a basis after publication.

Comments: Four comments opposed the proposed prohibition against amending the basis after publication, and one comment supported the proposal.

Response: Because of the arguments submitted by the opponents of the proposed rule prohibiting amendment of the basis after publication, the Office is withdrawing the proposal. Section 2.35(b) is instead amended to incorporate current practice, *i.e.*, to state that an application that is not the subject of an *inter partes* proceeding before the Trademark Trial and Appeal Board may be amended to add or substitute a basis after publication, if the applicant files a petition to the Commissioner; and that republication will always be required. TMEP § 1006.04. An application that is the subject of an *inter partes* proceeding before the Trademark Trial and Appeal Board is governed by § 2.133(a).

Specification of Type of Commerce No Longer Required

The Office will no longer require a specification of the type of commerce in which a mark is used in an application for registration based on use in commerce under section 1(a) of the Act, allegation of use in an application based on section 1(b) of the Act, affidavit of continued use under section 8 of the Act (section 8 affidavit), or affidavit of incontestability under section 15 of the Act (section 15 affidavit).

The Office proposed to eliminate the requirements that sections 8 and 15 affidavits specify the type of commerce in which the mark is used, currently required by §§ 2.162(e) and 2.167(c). Sections 8 and 15 of the Act do not require that the affidavits list the type of commerce. Because the definition of "commerce" in section 45 of the Act is "all commerce which may lawfully be regulated by Congress," the Office will presume that a registrant who states that the mark is in use in commerce is stating that the mark is in use in a type of commerce that Congress can regulate.

Comment: No comments opposed the proposed deletion of the requirement that section 8 and section 15 affidavits specify the type of commerce. One comment suggested that §§ 2.33(b)(1), 2.34(a)(1)(iii), 2.76(b)(1)(ii), and 2.88(b)(1)(ii) be amended to require an allegation that the mark is in "use in

commerce that can be regulated by the Congress of the United States of America," rather than a specification of the type of commerce in which the mark is used, in an application for registration or allegation of use.

Response: The suggestion has been adopted, but modified slightly. Sections 1(a), 1(c), and 1(d) of the Act do not require that an applicant specify the type of commerce in which the mark is used in an application or allegation of use. Sections 2.33(b)(1), 2.34(a)(1)(iii), 2.76(b)(1)(ii), and 2.88(b)(1)(ii) are amended to delete the requirement that the applicant specify the type of commerce in which the mark is used. The Office will not require that the applicant specifically state that the mark is in use in commerce that the United States Congress can regulate. Instead, the Office will presume that an applicant who states that the mark is in use in commerce is stating that the mark is in use in a type of commerce that Congress can regulate.

Statement of Method of Use or Intended Use of Marks No Longer Required

The rules no longer require a statement of the applicant's method or intended method of use of a mark, because sections 1(a), 1(b), and 1(d) of the Act have been amended to omit these requirements.

Post Registration

TLTIA sections 105 and 106 amend: (1) section 8 of the Act, 15 U.S.C. 1058, to add a requirement for filing an affidavit or declaration of continued use or excusable nonuse in the year before the end of every ten-year period after the date of registration; and (2) section 9 of the Act, 15 U.S.C. 1059, to delete the requirement for a declaration of continued use or excusable nonuse in a renewal application. Thus, every tenth year, the owner of a registration must file both a section 8 affidavit and a renewal application.

The statutory filing periods for the ten year section 8 affidavits are the same as the statutory filing periods for renewal applications. The Office will create a combined "Sections 8 and 9" form to make it easy to make both filings in a single document. In substance, the requirements of the combined filing under amended sections 8 and 9 of the Act will be the same as the requirements for renewal under current law.

A section 8 affidavit between the fifth and sixth year after the date of registration is also required. This is consistent with current law. No renewal application is required during the sixth year.

TLTIA sections 105 and 106 amend sections 8 and 9 of the Act to permit filing within a six-month grace period after the deadline set forth in the statute, with an additional surcharge. The surcharge for filing a section 8 affidavit or section 9 renewal application during the grace period is \$100 per class. If a combined filing under sections 8 and 9 of the Act is filed during the grace period, two grace period surcharges must be included for each class, one for the section 8 affidavit and another for the section 9 renewal application.

TLTIA sections 105 and 106 also amend sections 8(c)(2) and 9(a) of the Act to allow for the correction of most deficiencies after the deadline set forth in the statute, with payment of an additional surcharge. The surcharge for correcting a deficiency in a section 8 affidavit or a section 9 renewal application is \$100. Only a single deficiency surcharge will be required for correcting deficiencies in a combined sections 8 and 9 filing, even if both the section 8 affidavit and the renewal application are deficient.

Comment: One comment requested clarification as to how the deficiency and grace period fees would be applied to section 8 affidavits and renewal applications pending before or around the date of implementation.

Response: The new fees do not apply to section 8 affidavits and renewal applications filed before October 30, 1999. The revised provisions of sections 8 and 9 of the Act, and these amendments to the rules, apply only to affidavits and renewal applications filed on or after October 30, 1999. The old law, and the old fees, apply to affidavits and renewal applications filed before October 30, 1999, even if the sixth or tenth anniversary, or the expiration date, of the registration is on or after October 30, 1999. This is true even for affidavits and renewal applications that are filed before, but examined after, October 30, 1999. See the discussion under the heading "Dates/Applicability Dates," supra, for further information about the effective date of TLTIA and this final rule.

Comment: One comment suggested that it would be unfair to charge the deficiency surcharge if large backlogs prevent examination in a timely manner.

Response: Ultimately, it is the registrant who is responsible for filing documents that meet the requirements of the Act and the rules. The surcharges required by sections 8(c)(2) and 9(a) of the Act will be charged regardless of whether there are backlogs in examination. Under current law, statutory requirements must be met

before the end of the filing period set forth in the Act, or the registration will be cancelled. The new law provides a benefit to registrants because it permits correction of most statutory deficiencies after the expiration of the statutory filing period, albeit for an additional fee. To avoid deficiency fees, registrants are encouraged to file section 8 affidavits and renewal applications early in the statutory period. Under both sections 8 and 9 of the Act, there is a one-year period in which a section 8 affidavit or renewal application can be filed, plus an additional six-month grace period. Section 8 affidavits are now examined within six months of filing, and renewal applications are examined less than two months after filing.

Comment: One comment stated that it would be unfair to charge a deficiency surcharge if the information needed to cure defects is within the control of the PTO, e.g., an assignment or change of name waiting to be recorded.

Response: If the party who filed was the owner of the registration at the time of filing, there will be no deficiency surcharge for recording documents or submitting other evidence of ownership, before or after the expiration of the filing periods set forth in the Act.

Comment: One comment asked why there was a surcharge for correcting deficiencies in a section 8 affidavit, but not for a section 15 affidavit.

Response: Section 8(c)(2) of the Act requires a surcharge for correcting deficiencies after expiration of the deadline set forth in section 8 of the Act, while section 15 of the Act does not require a deficiency surcharge. There is no statutory cutoff date for filing a section 15 affidavit. Amendments or corrections to section 15 affidavits are not accepted, but substitute affidavits may be filed. TMEP § 1604.03.

Comment: The Office had proposed decreasing the renewal fee from \$300 to \$200 per class, and increasing the filing fees for sections 8 and 15 affidavits from \$100 to \$200 per class. Two comments objected to the proposed increase in filing fees for sections 8 and 15 affidavits.

Response: The Office is withdrawing these proposals at this time.

Comment: One comment suggested that the automated records of the Office should specify which affidavits had been filed under section 8 of the Act, e.g., "first section 8 affidavit," "second section 8 affidavit," etc.

Response: The Office's automated records will identify a section 8 affidavit as "Section 8 (6 year)" or "Section 8 (10 year). Further information may be obtained from the Status Line at (703) 305-8747, or from the Trademark

Applications and Registrations Retrieval (TARR) database on the Office's World Wide Web site at <http://www.uspto.gov/go/tarr/>. The prosecution history will show the number of section 8 affidavits that have been filed.

Recording Assignments and Changes of Name

Currently, the Office will record only an original document or a true copy of an original. TLIA section 107 amends section 10 of the Act to allow recordation of a document that is not an original or a true copy.

Comment: One comment suggested that § 3.25(a)(4) should be amended to delete the requirement for signature by the assignee when an assignment is supported by a statement explaining how the conveyance affects title. The comment noted that assignments signed only by the assignor have been routinely recorded for many years; that the rule as written would be a major change in policy; that the assignment of trademarks and the associated goodwill is regarded as a matter of state law, and signature by the assignee is not required by the law of a number of states; and that the proposed rule would seek to impose by Federal law an additional requirement in a transaction that is clearly covered by state law, and raises a question as to whether there is Federal authority for doing so.

Response: The suggestion has not been adopted. Section 3.25(a) sets forth a number of types of underlying documents one can submit to the Office to support a request to record an assignment. Section 3.25(a)(4) is not a requirement, but only one alternative available to a party seeking to record an assignment. Traditionally, the only document that the Office accepted to support a request to record an assignment was the original assignment document or a true copy of the original document. Amended § 3.25(a) provides a wider range of supporting documents. The Office will continue to accept an original assignment document, or a true copy of an original, that is signed only by the assignor.

Comment: One comment suggested that § 3.25(b) should be amended to continue the current requirement for an original or a true copy of an original with a request to record a change of name. The comment noted that it is generally easy to obtain a document reflecting a name change, and would therefore not be a significant burden to parties seeking to record assignments; and that the proposed rule requiring only a legible cover sheet would result in a burden to members of the public

seeking to confirm the change in ownership.

Response: The suggestion has not been adopted. The deletion of the requirement for an underlying document supporting a request to record a change of name was made because section 10 of the Act no longer requires an underlying document in a request to record a name change.

Assignment of Section 1(b) Applications

TLIA section 107 amends section 10 of the Act to permit an assignment after the applicant files an amendment to allege use under section 1(c) of the Act. Currently, a section 1(b) application cannot be assigned until after the filing of a statement of use under section 1(d) of the Act, except to a successor to the applicant's business, or the portion of the business to which the mark pertains. This amendment corrects an oversight in the Trademark Law Revision Act of 1988 (Title 1 of Pub. L. 100-667, 102 Stat. 3935 (15 U.S.C. 1051)), which amended section 10 of the Act to permit an assignment of a section 1(b) application to someone other than a successor to the applicant's business only after the filing of a statement of use under section 1(d) of the Act. The substance of statements of use and amendments to allege use are the same, and the only difference is the time of filing, so there is no reason to treat them differently.

Discussion of Specific Rules Changed or Added

The Office is amending rules 1.1, 1.4, 1.5, 1.6, 1.23, 2.1, 2.6, 2.17, 2.20, 2.21, 2.31, 2.32, 2.33, 2.34, 2.35, 2.37, 2.38, 2.39, 2.45, 2.51, 2.52, 2.56, 2.57, 2.58, 2.59, 2.66, 2.71, 2.72, 2.76, 2.86, 2.88, 2.89, 2.101, 2.111, 2.146, 2.151, 2.155, 2.156, 2.160, 2.161, 2.162, 2.163, 2.164, 2.165, 2.166, 2.167, 2.168, 2.173, 2.181, 2.182, 2.183, 2.184, 2.185, 2.186, 3.16, 3.24, 3.25, 3.28, 3.31, and 6.1.

Section 1.1(a)(2) is amended to set forth all the addresses for filing trademark correspondence in one rule.

Section 1.1(a)(2)(i) is amended to exempt papers filed electronically from the requirement that correspondence be mailed to the street address of the Office.

Section 1.1(a)(2)(v) is amended to state that an applicant may transmit an application for trademark registration electronically, but only if the applicant uses the Office's electronic form.

Section 1.4(a)(2) is amended to correct a cross-reference.

Section 1.4(d)(1)(iii) is added to provide for signature of electronically transmitted trademark filings, where permitted.

Section 1.5(c) is amended to clarify the requirements for identifying trademark applications and registrations.

Section 1.6(a) is amended to provide that the Office will consider trademark-related correspondence transmitted electronically to have been filed on the date of transmission, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. This is consistent with the treatment of correspondence filed as Express Mail with the United States Postal Service (USPS) under § 1.10.

Comment: One comment suggested that § 1.6(a)(1) be amended to state that Express Mail deposited on a Saturday, Sunday, or Federal holiday will receive a filing date as of the date of deposit with the USPS.

Response: The suggestion has not been adopted. Sections 1.6(a)(2) and 1.10(a) already state that correspondence filed by Express Mail will be considered filed as of the date of deposit with USPS, and these sections do not limit the date of deposit as Express Mail to a day that is not a weekend or Federal holiday. Therefore, it is not necessary to repeat this information in § 1.6(a)(1). The Office now stamps correspondence filed by Express Mail under § 1.10 with the USPS "date in," regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. TMEP § 702.02(f); MPEP § 513.

The current text of § 1.23 is designated as paragraph (a), and amended to clarify that payment must be made in U.S. dollars, and in the form of a cashier's or certified check, Treasury note, or USPS money order to be considered unconditional payment of a fee. As with current practice, payment of a fee by other forms (e.g., by personal or corporate check, or authorization to charge a credit card) is subject to actual collection of the fee.

Section 1.23 is also amended to add a paragraph (b), providing that payments of money for fees in electronically filed trademark applications, or electronic submissions in trademark applications, may also be made by credit card. The Office previously limited fee payment by credit card to the fees required for information products, and will continue to accept payment of information product fees by credit card.

Section 1.23(b) will also provide that payment of a fee by credit card must specify the amount to be charged and such other information as is necessary to process the charge, and is subject to collection of the fee.

Section 1.23(b) will further provide that the Office will not accept a general authorization to charge fees to a credit card. The Office cannot accept an authorization to charge "all required fees" or "the filing fee" to a credit card, because the Office cannot determine with certainty the amount of an unspecified fee (the amount of the "required fee" or the applicable "filing fee") within the time frame for reporting a charge to the credit card company. Also, the Office cannot accept charges to credit cards that require the use of a personal identification number (PIN) (e.g., certain debit cards or check cards).

Section 1.23(b) also contains a warning that if credit card information is provided on a form or document other than a form provided by the Office for the payment of fees by credit card, the Office will not be liable if the credit card number is made public. The Office currently provides an electronic form for use when paying a fee in an electronically filed trademark application or electronic submission in a trademark application. This form will not be included in the records open to public inspection in the file of a trademark matter. However, the inclusion of credit card information on forms or documents other than the electronic form provided by the Office may result in the release of credit card information.

Section 2.1 is amended to update a cross-reference.

Section 2.6(a)(6) is amended to delete reference to the three-month renewal grace period. TLTI changes the grace period to six months.

Section 2.6(a)(14) is removed because it is unnecessary. The cost of a combined affidavit or declaration under sections 8 and 15 of the Act is the sum of the cost of the individual filings.

Section 2.6(a)(14) is added, requiring a \$100 surcharge per class for filing a section 8 affidavit during the grace period.

Section 2.6(a)(20) is added, requiring a \$100 surcharge for correcting a deficiency in a section 8 affidavit.

Section 2.6(a)(21) is added, requiring a \$100 surcharge for correcting a deficiency in a renewal application.

Section 2.17(c) is added, stating that to be recognized as a representative in a trademark case, an attorney as defined in § 10.1(c) may file a power of attorney, appear in person, or sign a paper that is filed with the Office on behalf of an applicant or registrant. This codifies current practice.

Section 2.17(d) is added, stating that someone may file a power of attorney that relates to more than one trademark application or registration, or to all

existing and future applications and registrations; and that someone relying on such a power of attorney must: (1) Include a copy of the previously filed power of attorney; or (2) refer to the previously filed power of attorney, specifying: The filing date; the application serial number, registration number, or *inter partes* proceeding number for which the original power of attorney was filed; and the name of the party who signed the power of attorney; or, if the application serial number is not known, submit a copy of the application or a copy of the mark, and specify the filing date.

Comment: One comment requested clarification as to whether a "global" power of attorney will be effective for all registrations, including those that have no immediate deadline.

Response: Yes, the power of attorney will be effective for registrations that have no immediate deadline. When the attorney later takes an action, such as filing an affidavit of continued use or a renewal application, he or she must comply with the requirements of § 2.17(d) in order to rely on the power of attorney.

Comment: One comment asked whether a global power of attorney will remain valid if the application for which the power was filed is abandoned.

Response: Yes. The Office will maintain a record of the power of attorney, and the power will remain valid even if the original power was filed with an application that is later abandoned, or with a registration that is later cancelled.

Comment: One comment suggested that the Office should require attorneys to set forth the jurisdiction in which they are admitted and their bar number in a power of attorney.

Response: The suggestion has not been adopted, because the Office does not need this information to process applications and other documents. The purpose of TLT is to minimize the number of formal requirements for applications, powers of attorney and other documents, and to make the procedural requirements of the different national trademark offices more consistent. Instituting a new requirement that an attorney include the jurisdiction in which he or she is admitted and a bar number would not serve this purpose.

Section 2.20 is revised to delete the requirement for a declaration by a "member of the firm or an officer of the corporation or association," because this requirement has been deleted from sections 1(a) and 1(b) of the Act.

Comment: One comment suggested that § 2.20 be amended to permit the use of the language of 28 U.S.C. 1746 in a declaration.

Response: The suggestion has been adopted. Section 2.20 is amended to permit the filing of a verification under 28 U.S.C. 1746 in lieu of either an affidavit or a declaration under § 2.20. This reflects current practice. TMEP § 803.02.

Section 2.21 is revised to require the following minimum requirements for receipt of an application filing date: (1) The name of the applicant; (2) a name and address for correspondence; (3) a clear drawing of the mark; (4) an identification of goods or services; and (5) the filing fee for at least one class of goods or services. See the discussion under the heading "Supplementary Information/Application Filing Dates," *supra*.

The following minimum requirements for receiving a filing date have been deleted: A stated basis for filing; a verification or declaration signed by the applicant; an allegation of use in commerce, specimen, and date of first use in commerce in an application under section 1(a) of the Act; an allegation of the applicant's bona fide intention to use the mark in commerce in an application under section 1(b) or section 44 of the Act; a claim of priority in an application under section 44(d) of the Act; and a certified copy of a foreign registration in an application under section 44(e) of the Act. A claim of priority under section 44(d) must be filed before the end of the priority period. All other elements must be provided during examination.

Section 2.21(a)(3) is amended to require a "clear drawing of the mark" rather than the drawing "substantially meeting all the requirements of § 2.52" that is now required.

Section 2.21(b) is amended to state that the Office "may" rather than "will" return the papers and fees to the applicant when an application does not meet the minimum filing requirements. A new procedure is being considered under which the Office would retain applications that do not meet the minimum filing requirements. Applicants would have an opportunity to supply the missing element and receive a filing date as of the date the Office receives the missing element. Until a new policy is announced, the Office will continue to return the papers and fees to the applicant.

Comment: One comment stated that it reserves judgment on the possible future change in procedures for handling informal applications.

Response: If the Office does decide to change procedures for handling informal applications, it will seek input from the public before instituting the changes.

The center heading "THE WRITTEN APPLICATION" before § 2.31 is deleted because it is unnecessary. The heading "APPLICATION FOR REGISTRATION," immediately before § 2.21, encompasses the rules that now fall under the heading "THE WRITTEN APPLICATION."

Section 2.31 is removed and reserved. The substance of the requirement that the application be in English has been moved to revised § 2.32(a).

The heading of § 2.32 is changed to "Requirements for a complete application." Revised § 2.32(a) lists the requirements for the written application, now listed in § 2.33(a)(1).

Proposed § 2.32(a)(3)(ii) required that a juristic applicant set forth the state or nation under the laws of which the applicant is organized. This is consistent with current § 2.33(a)(1)(ii).

Comment: One comment suggested that "state or nation" in § 2.32(a)(3)(ii) be changed to "jurisdiction (usually state or nation)," because juristic persons such as corporations may be incorporated under the law of a jurisdiction that is not a state or nation.

Response: The suggestion has been adopted.

Section 2.32(a)(6) requires a list of the goods or services on or in connection with which the applicant uses or intends to use the mark, and states that in an application filed under section 44 of the Act, the scope of the goods or services covered by the section 44 basis may not exceed the scope of the goods or services in the foreign application or registration.

Comment: One comment suggested that § 2.32(a)(6) be amended to state that an application may be filed under multiple bases, with some of the goods/services supported by only one of the bases.

Response: The suggestion has not been adopted because it is unnecessary. Section 2.34(b)(1) clearly states that an applicant may claim more than one basis in a single application, and § 2.34(b)(2) indicates that the goods/services in such an application may be covered by different bases.

The heading of § 2.33 is changed to "Verified statement."

Section 2.33(a) is amended to state that the application must include a statement that is signed and verified by a person properly authorized to sign on behalf of the applicant. Section 2.33(a) further states that a person who is properly authorized to sign on behalf of

the applicant is: (1) A person with legal authority to bind the applicant; or (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the applicant; or (3) an attorney as defined in § 10.1(c) of this chapter who has an actual or implied written or verbal power of attorney from the applicant. See the discussion under the heading "Supplementary Information/Persons Who May Sign," *supra*.

The substance of current § 2.32(b) is moved to § 2.33(c). Revised § 2.33 states that the Office may require a substitute verification of the applicant's continued use or bona fide intention to use the mark when the applicant does not file the verified statement within a reasonable time after the date it is signed. This codifies present practice. Section 2.32(b) now states only that a verification of the applicant's continued use of the mark is required where the application is not filed within a reasonable time after it is signed. However, the Office also requires verification of the applicant's continued *bona fide intention to use* the mark in commerce when a verification under section 1(b) or section 44 of the Act is not filed within a reasonable time after it is signed. TMEP § 803.04.

Section 2.33(b)(1) is amended to delete the requirement that the applicant specify the type of commerce in which the mark is used. See the discussion under the heading "Supplementary Information/Specification of Type of Commerce No Longer Required," *supra*.

Section 2.33(d) is added, stating that where an electronically transmitted filing is permitted, the person who signs the verified statement must either: (1) Place a symbol comprised of numbers and/or letters between two forward slash marks in the signature block on the electronic document; and print, sign and date in permanent ink, and maintain a paper copy of the electronic submission; or (2) use some other form of electronic signature that the Commissioner may designate.

Section 2.34 is added, setting forth the requirements for the four bases for filing. New § 2.34(a)(1) lists the requirements for an application under section 1(a) of the Act, now listed in section §§ 2.21(a)(5)(i), 2.33(a)(1)(iv), 2.33(a)(1)(vii), 2.33(a)(2), and § 2.33(b)(1). Section 2.34(a)(2) lists the requirements for an application under section 1(b) of the Act, now listed in §§ 2.21(a)(5)(iv) and 2.33(a)(1)(iv).

Section 2.34(a)(iii) is amended to delete the requirement that the applicant specify the type of commerce in which the mark is used. See the

discussion under the heading "Supplementary Information/Specification of Type of Commerce No Longer Required," *supra*.

Comment: One comment suggested that § 2.34(a)(1)(i), which pertains to applications based on use in commerce under section 1(a) of the Act, be amended to change "application filing date" to "application filing date (in the case of an application claiming priority under section 44(d), such use in commerce shall be required as of the U.S. filing date not the filing date of the priority application)," to avoid any confusion, because in a section 44(d) application that claims priority, the effective filing date is the filing date of the foreign application.

Response: The suggestion has not been adopted, because it is unnecessary, and could be confusing to domestic applicants who base their applications solely on use in commerce and are unfamiliar with the requirements of section 44(d). Under § 1.6, correspondence is stamped with the date of receipt in the Office, unless the correspondence is filed under § 1.10, which provides for the filing of papers and fees by Express Mail. The term "application filing date" is now commonly used to refer to the date the application is received in the Patent and Trademark Office, and the priority date in a section 44(d) application is referred to as the "effective filing date." TMEP § 708.02. The Office knows of no instances in which a party whose application was based on both sections 44(d) and 1(a) mistakenly believed that the requirements for the section 1(a) basis must be met as of the priority date.

Section 2.34(a)(3) lists the requirements for an application under section 44(e) of the Act, now listed in §§ 2.21(a)(5)(ii) and 2.33(a)(1)(viii). Section 2.34(a)(3)(ii) requires a certified copy of a foreign registration. Currently, a section 44(e) applicant must submit a foreign certificate to receive a filing date. However, TLTIA section 108 amends section 44(e) of the Act to delete the requirement that the application be "accompanied by" the foreign certificate. The Office will require that the applicant submit the certificate during examination.

New § 2.34(a)(3)(iii) is added, stating that if it appears that the foreign registration will expire before the mark in the United States application will register, the applicant must submit a certification from the foreign country's trademark office, showing that the registration has been renewed and will be in force at the time the United States registration will issue. This codifies current practice. TMEP § 1004.03.

Comment: One comment suggested that the phrase "before the United States registration will issue," be changed to "before the United States registration is expected to issue assuming no unusual delays," because at the time of examination the exact date of issue is subject to wide variance.

Response: The suggestion has not been adopted. Even if there is a delay in issuance of a registration in an application under section 44(e) of the Act, due to an opposition or for other reasons, the United States registration will not issue unless the foreign registration has been renewed and is in force.

New § 2.34(a)(4) lists the requirements for an application under section 44(d) of the Act, now listed in §§ 2.21(a)(5)(iii), 2.33(a)(1)(ix), and 2.39. Section 2.34(a)(4)(i) requires that a priority claim be filed within six months of the filing date of the foreign application. This is consistent with Articles 4(C)(1) and 4(D)(1) of the Paris Convention for the Protection of Industrial Property, as revised at Stockholm on July 14, 1967 (Paris Convention).

New § 2.34(b)(1) states that an applicant may claim more than one basis, provided that the applicant meets the requirements for all bases claimed. This codifies current practice. Section 2.34(b)(1) also states that the applicant may not claim both sections 1(a) and 1(b) for the identical goods or services in one application.

Revised § 2.34(b)(2) requires that the applicant specify which basis covers which goods or services when an applicant claims more than one basis.

New § 2.34(c) sets forth the definition of "commerce," currently found in § 2.33(a)(3).

Section 2.37 is removed.

Section 2.35 is redesignated as § 2.37.

Section 2.35 is added: "Adding, deleting, or substituting bases."

New § 2.35(a) states that the applicant may add or substitute a basis for registration before publication, and that the applicant may delete a basis at any time.

Section 2.35(b) is amended to state that an application may be amended to add or substitute a basis after publication, if the applicant files a petition to the Commissioner; and that republication will always be required. This codifies current practice. TMEP § 1006.04. See the discussion under "Supplementary Information/Amendment of Basis After Publication," *supra*.

New § 2.35(c) changes current practice to allow a section 44(d) applicant to retain the priority filing date when the applicant substitutes a

new basis after the expiration of the six-month priority period. Currently, if an application is filed solely under section 44(d), and the applicant amends to substitute a different basis after the expiration of the six-month priority period, the effective filing date of the application becomes the date the applicant perfects the amendment claiming the new basis. TMEP § 1006.03.

Comment: Proposed § 2.35(c) stated that when the applicant substitutes a basis, the Office will presume that the original basis was valid, unless there is contradictory evidence in the record. One comment questioned whether an application that was amended from section 1(a) to section 1(b) would be subject to attack on the ground that the original basis was invalid because there was no use as a mark.

Response: A party who filed an application based on use in commerce, but later discovered that what he or she thought was appropriate trademark use was not in fact technical trademark use, clearly had a bona fide intention to use the mark in commerce as of the filing date. If the use basis is invalid, the applicant is entitled to retain the original filing date because the applicant had a bona fide intention to use the mark in commerce at all times. Section 2.35(c) is therefore amended to delete the statement that the Office will presume that the original basis was valid and substitute a statement that the Office will presume that there was a continuing valid basis, unless there is contradictory evidence in the record.

New § 2.35(d) states that if an applicant properly claims a section 44(d) basis in addition to another basis, the applicant will retain the priority filing date under section 44(d) no matter which basis the applicant perfects. This codifies current practice. TMEP § 1006.01.

New § 2.35(e) states that the applicant may add or substitute a section 44(d) basis only within the six-month priority period following the filing date of the foreign application. This is consistent with current practice (TMEP § 1006.05), and with Articles 4(C)(1) and 4(D)(1) of the Paris Convention.

New § 2.35(f) states that an applicant who adds a basis must state which basis covers which goods or services.

New § 2.35(g) states that if an applicant deletes a basis, the applicant must also delete any goods or services covered solely by the deleted basis. This codifies current practice.

New § 2.35(h) states that once an applicant claims a section 1(b) basis as to any or all of the goods or services, the applicant may not amend the

application to seek registration under section 1(a) of the Act for those goods or services unless the applicant files an allegation of use under section 1(c) or section 1(d) of the Act.

Section 2.38(a) is amended to update a cross-reference.

Section 2.39 is removed and reserved. The requirements for filing a priority claim under section 44(d) of the Act are moved to § 2.34(a)(4), discussed above.

Sections 2.45 (a) and (b) are revised to: (1) Delete the requirement for a statement of the method or intended method of use in a certification mark application; and (2) require a copy of the standards that determine whether others may use the certification mark on their goods and/or in connection with their services. Sections 1(a) and 1(b) of the Act, as amended, no longer require a statement of the method or intended method of use of a mark. The requirement for a copy of the certification standards codifies current practice. TMEP § 1306.06(g)(ii).

Sections 2.51 (c) through (e) are removed. The substance of those rules is moved to new § 2.52.

Section 2.52(a) is revised to define the term "drawing," to indicate that a drawing may only depict a single mark, and to define the terms "typed drawing" and "special form drawing."

Section 2.52(a) is revised to add guidelines for drawings of various types of unusual marks, such as marks that include color, three-dimensional objects, motion, sound or scent; and to add guidelines for showing placement of the mark on goods, packaging for goods, or in advertising of services.

Section 2.52(b) is revised to indicate the recommended format for the drawing of a mark.

Section 2.52(c) is revised to state that for an electronically filed application, if the mark cannot be shown as a "typed drawing," the applicant must attach a digitized image of the mark to the application.

Sections 2.56, 2.57, and 2.58 are consolidated into § 2.56.

Sections 2.57 and 2.58 are removed and reserved.

Section 2.56(a) is revised to require one rather than three specimens with an application under section 1(a) of the Act, or an allegation of use under section 1(c) or section 1(d) of the Act in an application under section 1(b) of the Act. See the discussion under "Supplementary Information/Number of Specimens Required," *supra*.

Section 2.56(b)(1) is added, stating that a trademark specimen is a label, tag, or container for the goods, or a display associated with the goods; and that the Office may accept another document

related to the goods or the sale of the goods when it is not possible to place the mark on the goods or packaging for the goods. This is consistent with the current § 2.56.

Comment: One comment suggested that the second sentence of § 2.56(b)(1) should be amended to substitute "will" for "may," and that the following sentence be added at the end of the paragraph: "The Office may accept a display associated with the goods when this is the customary method of use of a trademark in the relevant trade or industry."

Response: The suggestion has not been adopted. The first sentence of § 2.56(b)(1) already states that a specimen may be a display associated with the goods, so the suggested third sentence is unnecessary. The word "may" is used in the second sentence of § 2.56(b)(1) because it is within the discretion of the examining attorney to determine whether specimens are acceptable.

Section 2.56(b)(2) is added, stating that a service mark specimen must show the mark as actually used in the sale or advertising of the services. This is consistent with the current § 2.58(a).

Section 2.56(b)(3) is added, stating that a collective trademark or collective service mark specimen must show how a member uses the mark on the member's goods or in the sale or advertising of the member's services. This codifies current practice. TMEP § 1303.02(b).

Section 2.56(b)(4) is added, stating that a collective membership mark specimen must show use by members to indicate membership in the collective organization. This codifies current practice. TMEP § 1304.09(c).

Section 2.56(b)(5) is added, stating that a certification mark specimen must show how a person other than the owner uses the mark to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of the person's goods or services; or that members of a union or other organization performed the work or labor on the goods or services. This codifies current practice. TMEP § 1306.06(c).

Section 2.56(c) is added, stating that a photocopy or other reproduction of a specimen is acceptable, but that a photocopy or facsimile that merely reproduces the drawing is not a proper specimen. This is consistent with the current § 2.57.

New § 2.56(d)(1) states that a specimen must be flat and no larger than 8½ inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long. This is consistent with the current § 2.56.

Section 2.56(d)(2) is added, stating that if the applicant files a specimen that is too large (a "bulky specimen"), the Office will create a facsimile of the specimen that meets the requirements of the rule (i.e., is flat and no larger than 8½ inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long) and put it in the file wrapper. See the discussion under "Supplementary Information/Bulky Specimens," *supra*.

Section 2.56(d)(4) is added, stating that if the application is filed electronically, the specimen must be submitted as a digitized image.

Section 2.59, which governs the filing of substitute specimens, is revised to clarify and simplify the language. Section 2.59(b)(1) provides that when an applicant submits substitute specimens after filing an amendment to allege use under § 2.76, the applicant must verify the substitute specimens were in use in commerce prior to filing the amendment to allege use.

Comment: One comment suggested that § 2.59(b)(1) be amended to provide for the filing of substitute specimens that were in use "prior to filing the substitute specimen(s)," even if the specimens were not in use as of the filing date of the amendment to allege use. The comment noted that under the current rule, if the substitute specimens are not in use as of the filing date of the amendment to allege use, then the applicant must cancel the first amendment to allege use and substitute a new one, and stated that this serves no useful purpose.

Response: The suggestion has not been adopted. Section 1(c) of the Act provides for the filing of an amendment to allege use only after the applicant "has made use of the mark in commerce." Under § 2.76(e)(2), a minimum filing requirement for an amendment to allege use is a specimen showing that the mark is in use in commerce on or in connection with the goods or services. If the applicant cannot show use in commerce as of the filing date of the amendment to allege use, then the amendment cannot be considered "filed" as of that date. The Office believes that its records should accurately show the date when an intent-to-use applicant files an acceptable amendment to allege use under section 1(c) of the Act, because this date can be significant. For example, under § 2.75(b), if an intent-to-use applicant amends to the Supplemental Register, the effective filing date of the application becomes the date the amendment to allege use was perfected. It would be unfair to grant the intent-to-use applicant an effective filing date on the

Supplemental Register before the mark was actually in use in commerce.

Section 2.66 is revised to set forth the requirements for filing a petition to revive an abandoned application when the delay in responding to an Office action or notice of allowance is "unintentional." See the discussion under "Supplementary Information/Revival of Abandoned Applications," *supra*.

Sections 2.66(a)(1) and (2) are added, requiring that the applicant file a petition to revive within (1) two months of the mailing date of the notice of abandonment; or (2) two months of actual knowledge of abandonment. Currently, the deadline for filing a petition to revive is sixty days from the mailing date of the notice of abandonment or the date of actual knowledge of abandonment. TMEP § 1112.05(a). The two-month deadline will make it easier to calculate the due date for a petition because it will not be necessary to count days.

Section 2.66(a)(2) states that an applicant must be diligent in checking the status of an application, and that to be diligent, the applicant must check the status of the application within one year of the last filing or receipt of a notice from the Office for which further action by the Office is expected. This codifies current practice. TMEP sections 413 and 1112.05(b)(ii). See the discussion under the heading "Supplementary Information/Due Diligence," *supra*.

Sections 2.66(b)(2) and (c)(2) are amended to require "a statement, signed by someone with firsthand knowledge of the facts, that the delay * * * was unintentional." This statement need not be verified.

Section 2.66(b)(3) is amended to state that if the applicant did not receive the Office action, the applicant need not include a proposed response to an Office action with a petition to revive. This codifies current practice.

Sections 2.66(c)(3) and (4) are amended to state that if the applicant did not receive the notice of allowance and requests cancellation of the notice of allowance, the petition to revive need not include a statement of use or request for an extension of time to file a statement of use, or the fees for the extension requests that would have been due if the application had never been abandoned. This codifies current practice.

Section 2.66(c)(5) is added, stating that the applicant must file any further requests for extensions of time to file a statement of use under § 2.89 that become due while the petition is pending, or file a statement of use

unless: (1) A statement of use is filed with or before the petition to revive, or (2) the petition states that the applicant did not receive the notice of allowance and requests cancellation of the notice of allowance. This codifies current practice.

Section 2.66(f)(3) is added, stating that if the Commissioner denies the petition to revive, the applicant may request reconsideration by: (1) Filing the request within two months of the mailing date of the decision denying the petition; and (2) paying a second petition fee under § 2.6. Currently, the rules do not specifically provide for requests for reconsideration of petition decisions, but the Commissioner has the discretion to consider these requests under § 2.146(a)(3). The Office believes that an additional fee should be required to pay for the work done in processing the request for reconsideration. This is consistent with new § 2.146(j).

Section 2.71(a) is revised to state that the applicant may amend the identification to clarify or limit, but not broaden, the identification of goods and/or services. This simplifies the language of the current § 2.71(b).

New § 2.71(b)(1) states that if the declaration or verification of an application under § 2.33 is unsigned or signed by the wrong person, the applicant may submit a substitute verification or declaration under § 2.20. This changes current practice. Currently, the applicant must submit a signed verification to receive an application filing date, and if the verification is signed by the wrong party, the applicant cannot file a substitute verification unless the party who originally signed had "color of authority" (*i.e.*, firsthand knowledge of the facts and actual or implied authority to act on behalf of the applicant). TMEP Section 803. As discussed above, the Office is deleting the requirement that the applicant submit a signed verification in order to receive a filing date. If the verification is unsigned or signed by the wrong party, the applicant must replace the declaration during examination.

The requirement for a verification "by the applicant, a member of the applicant firm, or an officer of the applicant corporation or association" has been removed from § 2.71(c). This is consistent with the amendments to sections 1(a) and 1(b) of the Act. See the discussion under "Supplementary Information/Persons Who May Sign," *supra*.

The "color of authority" provisions have been deleted from § 2.71(c). Because the statute no longer specifies

who has "statutory" authority to sign, the "color of authority" provisions are unnecessary.

New § 2.71(b)(2) states that if the declaration or verification of a statement of use under § 2.88 or a request for extension of time to file a statement of use under § 2.89 is unsigned or signed by the wrong party, the applicant must submit a substitute verification before the expiration of the statutory deadline for filing the statement of use.

Section 2.71(d) is added, stating that a mistake in setting out the applicant's name can be corrected, but the application cannot be amended to set forth a different entity as the applicant; and that an application filed in the name of an entity that did not own the mark on the filing date of the application is void. This codifies current practice. TMEP § 802.07. See the discussion under "Supplementary Information/Filing by Owner," *supra*.

Section 2.72 is revised to remove paragraph (a), and redesignate paragraphs (b) through (d) as (a) through (c).

New paragraphs (a) through (c) will each state that an applicant may not amend the description or drawing of the mark if the amendment materially alters the mark; and that the Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark in the original application. See the discussion under the heading "Supplementary Information/Material Alteration," *supra*.

Comment: One comment suggested that § 2.72(b) should be amended to provide that in an application based on section 1(b) of the Act, the applicant "may amend the heading on the drawing to reflect a change in applicant's name, jurisdiction of citizenship or organization, and/or address at any time," to encourage the prompt amendment of applications to reflect changes in the applicant's name, address and/or jurisdiction.

Response: The suggestion has not been adopted because it is unnecessary. Section 2.72(b) pertains only to amendment of the "description or drawing of the mark," not to amendment of the heading on a drawing. An applicant who submits a substitute drawing is free to amend the heading in the substitute drawing.

Comment: One comment suggested that § 2.72(c)(1) be amended to provide that in an application based on § 44(d) of the Act, the applicant may amend the drawing of the mark if the amendment is supported by the foreign application, "because there may never be a 'foreign

registration certificate' if the foreign priority application lapses."

Response: The suggestion has not been adopted. Section 44(d) is a basis for filing an application, not a basis for registration. If the applicant perfects the section 44(e) basis, the mark in the United States application must be a substantially exact representation of the mark in the home country registration. If the applicant elects not to perfect the section 44(e) basis, the mark in the United States application must be a substantially exact representation of the mark on the specimens filed with a section 1(a) application or with an allegation of use in a section 1(b) application. A mark would not be registrable if it were a substantially exact representation of the mark in the foreign registration in a section 44(e) application, or the specimens in a use-based application.

Section 2.76(b)(1) is revised to state that a complete amendment to allege use must include a statement that is verified or supported by a declaration under section 2.20 by a person properly authorized to sign on behalf of the applicant.

Section 2.76(b)(1) is further revised to delete the requirement for a statement of the method or manner of use of the mark in an amendment to allege use, because this requirement has been removed from section 1(a) of the Act.

Section 2.76(b)(1)(ii) is amended to delete the requirement that the applicant specify the type of commerce in which the mark is used. See the discussion under the heading "Supplementary Information/Specification of Type of Commerce No Longer Required," *supra*.

Section 2.76(b)(2) is revised to require one rather than three specimens with an amendment to allege use.

Section 2.76(i) is added, stating that if an amendment to allege use is not filed within a reasonable time after it is signed, the Office may require a substitute verification or declaration under § 2.20 that the mark is still in use in commerce. This codifies current practice. TMEP § 803.04.

Section 2.76(j) is added, noting that the requirements for multi-class applications are stated in § 2.86.

The heading of § 2.86 is changed to "Application may include multiple classes." The current § 2.86(a), which states that an applicant may recite more than one item of goods, or more than one service, in a single class, if the applicant either has used or has a bona fide intention to use the mark on all the goods or services, is removed. The

substance of this provision is moved to §§ 2.34(a)(1)(v), 2.34(a)(2)(ii), 2.34(a)(3)(iv), and 2.34(a)(4)(iv).

Section 2.86(a) is revised to include sections now found in § 2.86(b), stating that the applicant may apply to register the same mark for goods and/or services in multiple classes in a single application, provided that the applicant specifically identifies the goods and services in each class; submits a fee for each class; and either includes dates of use and one specimen, or a statement of a bona fide intention to use the mark in commerce, for each class.

Section 2.86(a)(3) is amended to add a provision that the applicant may not claim both use in commerce and a bona fide intention to use the mark in commerce for the identical goods or services in one application.

Section 2.86(b) is amended to state that a statement of use or amendment to allege use must include the required fee, dates of use, and one specimen for each class.

Section 2.86(b) is amended to add a provision that the applicant may not file the statement of use or amendment to allege use until the applicant has used the mark on all the goods or services, unless the applicant files a request to divide. This is consistent with the current §§ 2.76(c) and 2.88(c).

Section 2.86(c), which prohibits an applicant from claiming both use in commerce and intent-to-use in a single multi-class application, is deleted. However, new § 2.86(a)(3) will state that the applicant may not claim both use in commerce and intent-to-use for the identical goods or services in one application.

The substance of the last sentence of the current § 2.86(b) is moved to new § 2.86(c).

Section 2.88(b)(1) is revised to state that a complete statement of use must include a statement that is verified or supported by a declaration under § 2.20 by a person properly authorized to sign on behalf of the applicant.

Section 2.88(b)(1) is revised to delete the requirement for a statement of the method or manner of use in a statement of use. This requirement has been removed from section 1(d)(1) of the Act.

Section 2.88(b)(1)(ii) is amended to delete the requirement that the applicant specify the type of commerce in which the mark is used. See the discussion under the heading "Supplementary Information/Specification of Type of Commerce No Longer Required," *supra*.

Section 2.88(b)(2) is revised to require one specimen with a statement of use, rather than the three specimens now required.

Section 2.88(e)(3) is revised to state that if the verification or declaration is unsigned or signed by the wrong party, the applicant must submit a substitute verification or declaration on or before the statutory deadline for filing the statement of use. This is consistent with current practice. TMEP

§ 1105.05(f)(i)(A). Section 1(d)(1) of the Act specifically requires verification by the applicant within the statutory period for filing the statement of use.

Section 2.88(k) is added, stating that if the statement of use is not filed within a reasonable time after it is signed, the Office may require a substitute verification or declaration under § 2.20 stating that the mark is still in use in commerce. This codifies current practice. TMEP § 803.04.

Section 2.88(l) is added, noting that the requirements for multi-class applications are stated in § 2.86.

Sections 2.89(a)(3) and (b)(3) are revised to require that the statement that the applicant has a bona fide intention to use the mark in commerce in a request for an extension of time to file a statement of use be verified or supported by a declaration under § 2.20 by a person properly authorized to sign on behalf of the applicant; and that if the extension request is unsigned or signed by the wrong party, the applicant must submit a substitute verification or declaration on or before the statutory deadline for filing the statement of use. This is consistent with current practice. TMEP § 1105.05(d). Sections 1(d)(1) and (2) of the Act specifically require verification by the applicant within the statutory filing period.

Section 2.89(d) is revised to remove paragraph (1), which requires a statement that the applicant has not yet made use of the mark in commerce on all the goods and services. The Commissioner has held that an extension request that omits this allegation is substantially in compliance with § 2.89(d) if the request contains a statement that the applicant has a continued bona fide intention to use the mark in commerce. *In re Schering-Plough Healthcare Products Inc.*, 24 USPQ2d 1709 (Comm'r Pats. 1992). Therefore, the requirement is unnecessary.

Section 2.89(g) is amended to change the time limit for filing a petition to the Commissioner from the denial of a request for an extension of time to file a statement of use from one month to two months. The two-month deadline is consistent with the deadline for filing a petition to revive an unintentionally abandoned application under § 2.66, and with the amendment of the

deadline for filing petitions under § 2.146(d).

Section 2.89(h) is added, stating that if the extension request is not filed within a reasonable time after it is signed, the Office may require a substitute verification or declaration under § 2.20 that the applicant still has a bona fide intention to use the mark in commerce. This codifies current practice. TMEP § 803.04.

Section 2.101(d)(1) is revised to update a cross-reference.

Section 2.111(c)(1) is revised to update a cross-reference.

Section 2.146(d) is revised to delete "sixty days" and substitute "two months" as the deadline for filing certain petitions. This will make it easier to calculate the due date for a petition, because it will not be necessary to count days.

Section 2.146(i) is added, stating that where a petitioner seeks to reactivate an application or registration that was abandoned or cancelled due to the loss or mishandling of papers mailed to or from the Office, the petition will be denied if the petitioner was not diligent in checking the status of the application or registration; and that to be considered diligent, the applicant must check the status of the application or registration within one year of the last filing or receipt of a notice from the Office for which further action by the Office is expected. This codifies current practice. TMEP sections 413 and 1704. See the discussion under the heading "Supplementary Information/Due Diligence," *supra*.

Section 2.146(j) is added, stating that if the Commissioner denies the petition, the petitioner may request reconsideration by: (1) Filing the request within two months of the mailing date of the decision denying the petition; and (2) paying a second petition fee under § 2.6. Currently, the rules do not specifically provide for requests for reconsideration of petition decisions, but the Commissioner has the discretion to consider these requests under § 2.146(a)(3). The Office believes that an additional fee should be required to pay for the work done in processing the request for reconsideration. This is consistent with new § 2.66(f)(3), discussed above.

Section 2.151 is revised to update a cross-reference and simplify the language.

Section 2.155 is revised to update a cross-reference and simplify the language.

Section 2.156 is revised to update a cross-reference and simplify the language.

Section 2.160 is added, "Affidavit or declaration of continued use or excusable nonuse required to avoid cancellation." New §§ 2.160(a) (1) and (2) list the deadlines for filing the affidavit or declaration, and new § 2.160(a)(3) states that the owner may file the affidavit or declaration within six months after expiration of these deadlines, with an additional grace period surcharge. Currently, there is no grace period for filing a section 8 affidavit.

Comment: Since many registrations are still in twenty-year registration terms, one comment suggested that § 2.160(a)(2) be amended to require filing of an affidavit or declaration of continued use or excusable nonuse "within the year before the end of every ten-year period after the date of registration or renewal."

Response: The suggestion has not been adopted. The language of new § 2.160(a)(2) tracks the language of § 8(a)(3) of the Act. However, the provisions of section (a)(3) of the Act, requiring the filing of a section 8 affidavit at the end of each successive ten year period after registration, do not apply to a twenty-year registration until a renewal application is due. See the discussion under the heading "Dates/ Applicability Dates," *supra*.

Comment: One comment suggested that § 2.160(a)(1)(i) should be amended to require filing "after the fifth anniversary of the date of registration and no later than the sixth anniversary of the date of registration," rather than "between the fifth and sixth year after the date of registration," because the phrase "between the fifth and the sixth year" could be interpreted to be a single day.

Response: The suggestion has been adopted, but modified slightly.

Section 2.160(a)(1)(i) is amended to state that an affidavit of continued use or excusable nonuse must be filed "on or after the fifth anniversary and no later than the sixth anniversary after the date of registration." This makes it clear that the affidavit may be filed on the fifth anniversary of the registration. A similar amendment is made to § 2.160(a)(1)(ii).

Comment: One comment suggested that § 2.160(a)(2) be amended to require filing "after the ninth anniversary of either the date of registration or the most recent renewal, and no later than the tenth anniversary of the date of registration or the date of the most recent renewal, respectively," rather than "within the year before the end of every ten-year period after the date of registration," because the "rule as proposed appears to allow the filing of a renewal application (sic) on the ninth

anniversary of the date of registration, which may not be allowed by the statute."

Response: The suggestion has not been adopted. The Office will accept section 8 affidavits filed on either the ninth or the tenth anniversary after the date of registration. This is consistent with current practice, which permits the filing of a section 8 affidavit on either the fifth or the sixth anniversary after the date of registration. TMEP § 1603.03.

New § 2.160(b) advises that § 2.161 lists the requirements for the affidavit or declaration.

The heading of § 2.161 is changed to "Requirements for a complete affidavit or declaration of continued use or excusable nonuse." Section 2.161 is revised to list the requirements for the affidavit or declaration.

Section 2.161(a) is revised to state that the owner must file the affidavit or declaration within the period set forth in section 8 of the Act.

Comment: One comment suggested that § 2.161(a) be amended to require that the affidavit "be filed within the time period set forth in § 2.160 by the owner, provided that if the owner is an assignee or other transferee, then such assignment or transfer shall be recorded with the Office on or before the filing of a section 8 (affidavit), or within six months after an official action requiring such recordal."

Response: The suggestion has not been adopted. An assignee is not required to record the assignment in order to file a section 8 affidavit. Under § 3.73(b), the assignee also has the option of submitting other proof of the change of ownership (*i.e.*, material showing the transfer of title). TMEP section 502 and § 1603.05(a).

Section 2.161(b) is revised to state that the affidavit or declaration must include a verified statement that is signed and verified (sworn to) or supported by a declaration under § 2.20 by a person properly authorized to sign on behalf of the owner, attesting to the continued use or excusable nonuse of the mark within the period set forth in section 8 of the Act. Section 2.161(b) further states that a person properly authorized to sign on behalf of the owner is: (1) A person with legal authority to bind the owner; or (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or (3) an attorney as defined in § 10.1(c) of this chapter who has an actual or implied written or verbal power of attorney from the owner. See the discussion under the heading "Supplementary Information/ Persons Who May Sign," *supra*.

Section 2.161(b) also states that the verified statement must be executed on or after the beginning of the filing period specified in § 2.160(a).

Section 2.161(d)(2) is added, requiring a surcharge for filing an affidavit or declaration of continued use or excusable nonuse during the grace period.

Section 2.161(d)(3) is added, stating that if the fee submitted is enough to pay for at least one class, but not enough to pay for all the classes, and the particular class(es) covered by the affidavit or declaration are not specified, the Office will issue a notice requiring either the submission of additional fee(s) or an indication of the class(es) to which the original fee(s) should be applied; that additional fee(s) may be submitted if the requirements of § 2.164 are met; and that if additional fees are not submitted and the class(es) to which the original fee(s) should be applied are not specified, the Office will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class.

New § 2.161(e) requires that the affidavit or declaration list both the goods or services on which the mark is in use in commerce and the goods or services for which excusable nonuse is claimed. Currently, a list of the goods or services is not required when excusable nonuse is claimed. *In re Conusa Corp.*, 32 USPQ2d 1857 (Comm'r Pats. 1993). However, TLTIA section 105 amends section 8(b)(2) of the Act to specifically require "an affidavit setting forth those goods on or in connection with which the mark is not in use."

Comment: One comment stated that if the goods for which excusable nonuse is claimed are not listed in a section 8 affidavit, registrants should be given the opportunity to correct the oversight.

Response: If the goods or services for which excusable nonuse is claimed are not listed in an affidavit, the registrant will be given an opportunity to correct the deficiency. However, because section 8(b)(2) of the Act specifically requires that the affidavit set forth the goods or services on or in connection with which the mark is not in use in commerce, a deficiency surcharge will be required if the deficiency is corrected after the deadline specified in section 8 of the Act.

The requirement that the affidavit or declaration specify the type of commerce in which the mark is used, currently required by § 2.162(e), is removed. See the discussion under the heading "Supplementary Information/ Specification of Type of Commerce No Longer Required," *supra*.

The substance of § 2.162(f) is moved to § 2.161(f)(2). New § 2.161(f)(2) is revised to add a requirement that the affidavit state the date when use of the mark stopped and the approximate date when use will resume. This codifies current practice. Office actions are often issued requiring a statement as to when use of the mark stopped and when use will resume, because this information is needed to determine whether the nonuse is excusable, within the meaning of section 8 of the Act.

The substance of § 2.162(e) is moved to § 2.161(g). New § 2.161(g) is revised to state that the affidavit must include a specimen for each class of goods or services; that the specimen should be no larger than 8½ inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long; and that if the applicant files a specimen that exceeds these size requirements (a "bulky specimen"), the Office will create a facsimile of the specimen that meets the requirements of the rule (*i.e.*, is flat and no larger than 8½ inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long) and put it in the file wrapper. See the discussion under "Supplementary Information/Bulky Specimens," *supra*.

Section 2.161(h) is added, requiring a designation of a domestic representative if the registrant is not domiciled in the United States. This reflects section 8(f) of the Act, as amended, and is consistent with current practice.

The substance of § 2.163 is moved to § 2.162. New § 2.162 is revised to state that the only notice of the requirement for filing the section 8 affidavit or declaration of continued use or excusable nonuse is sent with the certificate of registration when it is originally issued. This merely clarifies, and does not change, current practice.

The substance of current § 2.164 is moved to the introductory text of new § 2.163.

New § 2.163(a) states that if the owner of the registration files the affidavit or declaration within the time periods set forth in section 8 of the Act, deficiencies may be corrected if the requirements of § 2.164 are met.

Section 2.163(b) is added, stating that a response to an examiner's Office action must be filed within six months of the mailing date, or before the end of the filing period set forth in section 8(a) or section 8(b) of the Act, whichever is later, or the registration will be cancelled.

Section 2.164 is added, "Correcting deficiencies in affidavit or declaration." This section changes current practice. There are now some deficiencies that can be corrected after the statutory deadline for filing the affidavit or

declaration, while other requirements must be satisfied before the expiration of the statutory deadline to avoid cancellation of the registration.

TLTIA section 105 adds section 8(c)(2) of the Act to allow correction of deficiencies, with payment of a deficiency surcharge. The Act does not define "deficiency," but instead gives the Office broad discretion to set procedures and fees for correcting deficiencies.

New § 2.164(a)(1) states that if the owner files the affidavit or declaration within the period set forth in section 8(a) or section 8(b) of the Act, deficiencies can be corrected before the end of this period without paying a deficiency surcharge; and deficiencies can be corrected after the expiration of this period with payment of the deficiency surcharge.

New § 2.164(a)(2) states that if the owner files the affidavit or declaration during the grace period, deficiencies can be corrected before the expiration of the grace period without paying a deficiency surcharge, and after the expiration of the grace period with a deficiency surcharge.

New § 2.164(b) states that if the affidavit or declaration is not filed within the time periods set forth in section 8 of the Act, or if it is filed within that period by someone other than the owner, the registration will be cancelled. These deficiencies cannot be cured.

See the discussion under the heading "Supplementary Information/Post Registration," *supra*, for additional information about curing deficiencies in section 8 affidavits.

The heading of § 2.165 is changed to "Petition to Commissioner to review refusal." The last two sentences of the current § 2.165(a)(1) are removed.

Old § 2.166 is removed because it is unnecessary. New §§ 2.163(b) and 2.165(b) set forth the times when a registration will be cancelled.

New § 2.166 is added, "Affidavit of continued use or excusable nonuse combined with renewal application," stating that an affidavit or declaration under section 8 of the Act and a renewal application under section 9 of the Act may be combined in a single document.

Section 2.167(c) is revised to delete the requirement that an affidavit or declaration under section 15 of the Act specify the type of commerce in which the mark is used.

The heading of § 2.168 is changed to "Affidavit or declaration under section 15 combined with affidavit or declaration under section 8, or with renewal application." Section 2.168(a) is revised to state that a section 15

affidavit may be combined with a section 8 affidavit, if the combined affidavit meets the requirements of both sections 8 and 15 of the Act. Section 2.168(b) is revised to state that a section 15 affidavit can be combined with a renewal application under section 9 of the Act, if the requirements of both sections 9 and 15 of the Act are met.

Section 2.173(a) is revised to simplify the language.

Sections 2.181(a)(1) and (2) are revised to indicate that renewal of a registration is subject to the provisions of section 8 of the Act. This is consistent with the amendment to section 9(a) of the Act.

Comment: One comment suggested that § 2.181(a)(1) should be amended to provide that registrations remain in force "from their date of issue or the date of expiration of their preceding term," rather than "from their date of issue or expiration," because an expired registration cannot be renewed.

Response: The suggestion has been adopted and modified slightly to simplify the language. Section 2.181(a)(1) is amended to state that registrations issued prior to November 16, 1989, remain in force for twenty years "from their date of issue or the date of renewal." A similar amendment is made to § 2.181(a)(2).

The heading of § 2.182 is changed to "Time for filing renewal application." The section is revised to state that the renewal application must be filed within one year before the expiration date of the registration, or within the six-month grace period after the expiration date with an additional fee.

The heading of § 2.183 is changed to "Requirements for a complete renewal application." This section is revised to delete the present renewal requirements and substitute new ones based on amended section 9 of the Act. The requirements for a specimen and declaration of use or excusable nonuse on or in connection with the goods or services listed in the registration are removed, because these requirements have been removed from section 9 of the Act. The new requirements for renewal are: (1) A request for renewal, signed by the registrant or the registrant's representative; (2) a renewal fee for each class; (3) a grace period surcharge for each class if the renewal application is filed during the grace period; (4) if the registrant is not domiciled in the United States, a designation of a domestic representative; and (5) if the renewal application covers less than all the goods or services, a list of the particular goods or services to be renewed.

New § 2.183(f) states that if the fee submitted is enough to pay for at least

one class, but not enough to pay for all the classes, and the class(es) covered by the renewal application are not specified, the Office will issue a notice requiring either the submission of additional fee(s) or an indication of the class(es) to which the original fee(s) should be applied; that additional fee(s) may be submitted if the requirements of § 2.185 are met; and that if the required fee(s) are not submitted and the class(es) to which the original fee(s) should be applied are not specified, the Office will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class.

Section 2.184 is revised to simplify the language and to transfer some of its provisions to new § 2.186. Section 2.184 states that the Office will issue a notice if the renewal application is not acceptable; that a response to the refusal of renewal must be filed within six months of the mailing date of the Office action, or before the expiration date of the registration, whichever is later; and that the registration will expire if the renewal application is not filed within the time periods set forth in section 9(a) of the Act.

Section 2.185 is added, "Correcting deficiencies in renewal application."

Under amended section 9, the renewal application must be filed within the renewal period or grace period specified in section 9(a) of the Act, or the registration will expire. However, if the renewal application is timely filed, any deficiencies may be corrected after expiration of the statutory filing period, with payment of a deficiency surcharge.

New § 2.185(a)(1) states that if the renewal application is filed within one year before the registration expires, deficiencies may be corrected before the registration expires without paying a deficiency surcharge, or after the registration expires with payment of the deficiency surcharge required by section 9(a) of the Act.

New § 2.185(a)(2) states that if the renewal application is filed during the grace period, deficiencies may be corrected before the expiration of the grace period without paying a deficiency surcharge, and after the expiration of the grace period with payment of the deficiency surcharge required by section 9(a) of the Act.

New § 2.185(b) states that if the renewal application is not filed within the time periods set forth in section 9(a) of the Act, the registration will expire. This deficiency cannot be cured.

Comment: One comment noted that § 2.184(c) appears to be a duplicate of § 2.185(b) and suggested that one be deleted.

Response: The suggestion has not been adopted. Sections 2.184 and 2.185 are not duplicates, and both are necessary for the following reason. Section 2.184(c) states the general rule that a registration will expire if the renewal application is not filed during the proper time period. Section 2.185(b) specifically addresses whether the failure to file a renewal application in the proper time period will be considered a deficiency that can be cured during a six-month deficiency period. The rule states that "[t]his deficiency cannot be cured" (emphasis added).

Section 2.186 is added, "Petition to Commissioner to review refusal of renewal."

New § 2.186(a) states that a response to the examiner's initial refusal is required before filing a petition to the Commissioner, unless the examiner directs otherwise. This is consistent with the current § 2.184(a).

New § 2.186(b) states that if the examiner maintains the refusal of the renewal application, a petition to the Commissioner to review the action may be filed within six months of the mailing date of the Office action maintaining the refusal; and that if no petition is filed within six months of the mailing date of the Office action, the registration will expire. This is consistent with the current § 2.184(b).

New § 2.186(c) states that a decision by the Commissioner is necessary before filing an appeal or commencing a civil action in any court. This is consistent with the current § 2.184(d).

Section 3.16 is amended to state that an applicant may assign an application based on section 1(b) of the Act once the applicant files an amendment to allege use under section 1(c) of the Act.

The heading of § 3.24 is changed to "Requirements for documents and cover sheets relating to patents and patent applications." The recording requirements for patents are listed in § 3.24. New § 3.25 is added to list the recording requirements for trademark applications and registrations.

Section 3.25 identifies the types of documents one can submit when recording documents that affect some interest in trademark applications or registrations. The section also sets forth the Office's preferred format for cover sheets and other documents.

Section 3.28 is revised to state that separate cover sheets should be used for patents and trademarks.

Section 3.31(a)(4) is revised to set forth the requirements for identifying a trademark application when the application serial number is not known.

Section 3.31(a)(7) requires that a cover sheet state that the assignee of a trademark application or registration who is not domiciled in the United States has designated a domestic representative. This is consistent with current § 3.31(a)(8).

Comment: One comment suggested that § 3.31(a)(7) be amended to require that the domestic representative "either sign the cover sheet or countersign the indication," in order to prevent a foreign assignee from designating a domestic representative who is unaware of the designation.

Response: The suggestion has not been adopted. The Office has never required a domestic representative to countersign a designation or a cover sheet, and knows of no instances where an assignee or applicant designated a domestic representative who is not aware of the fact that he or she has been designated. Instituting a new requirement that a domestic representative sign each cover sheet could be burdensome to assignees and is contrary to the goal of minimizing formal requirements and making the procedural requirements of the different national trademark offices more consistent.

The requirement currently in § 3.31(a)(9) that a cover sheet contain a statement that the information on the cover sheet is correct and that any copy of the document submitted is a true copy is deleted.

Section 3.31(b) is amended to state that a cover sheet should not refer to both patents and trademarks; and to put the public on notice that if a cover sheet contains both patent and trademark information, all information will become public after recordation.

Section 3.31(d) is added, stating that a trademark cover sheet should include the serial number or registration number of the trademark affected by the conveyance or transaction, an identification of the mark, and a description of the mark.

Section 3.31(e) is added, stating that the cover sheet should include the total number of applications, registrations, or patents identified on the cover sheet and the total fee.

Section 6.1 is revised to incorporate classification changes that became effective January 1, 1997, as listed in the International Classification of Goods and Services for the Purposes of the Registration of Marks (7th ed. 1996), published by the World Intellectual Property Organization (WIPO).

Rulemaking Requirements

The Office has determined that the rule changes have no federalism

implications affecting the relationship between the National Government and the State as outlined in Executive Order 12612.

The Chief Counsel for Regulation of the Department of Commerce has certified to the Chief Counsel for Advocacy of the Small Business Administration, that the rule changes will not have a significant impact on a substantial number of small entities (Regulatory Flexibility Act, 5 U.S.C. 605(b)). This rule implements the Trademark Law Treaty Implementation Act and simplifies and clarifies procedures for registering trademarks and maintaining and renewing trademark registrations. The rule will not significantly impact any businesses. The principal effect of the rule is to make it easier for applicants to obtain a filing date. No additional requirements are added to maintain registrations.

Furthermore, this rule simplifies the procedures for registering trademarks in new §§ 2.21, 2.32, 2.34, 2.45, 2.76, 2.88, 2.161, 2.167 and 2.183 of the Trademark rules. As a result, an initial regulatory flexibility analysis was not prepared.

The rule changes are in conformity with the requirements of the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*), Executive Order 12612, and the Paperwork Reduction Act of 1995 (PRA) (44 U.S.C. 3501 *et seq.*). No comments were received regarding the certification under the Regulatory Flexibility Act. The changes have been determined to be not significant for purposes of Executive Order 12866.

Notwithstanding any other provision of law, no person is required to nor shall a person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the PRA unless that collection of information displays a currently valid OMB control number.

This final rule contains collections of information requirements subject to the PRA. This rule discusses changes in the information required from the public to obtain registrations for trademarks and service marks, to submit affidavits or declarations of continued use or excusable nonuse, statements of use, requests for extensions of time to file statements of use, and to renew registrations. This rule deletes requirements to identify the method of use of a mark and the type of commerce in which a mark is used. Additionally, the rule removes the requirement that requests for recordation of documents be accompanied by originals or true copies of these documents. The rule allows the filing of powers of attorney that pertain to multiple registrations or applications for registration, and sets

forth certain requirements for filing such powers of attorney. Additionally, the rule sets forth requirements for submitting section 8 affidavits of continued use or excusable nonuse combined with section 9 renewal applications, or section 15 affidavits or declarations of incontestability combined with either section 8 affidavits or declarations or with section 9 renewal applications.

An information collection package supporting the changes to the above information requirements, as discussed in this final rule, was submitted to OMB for review and approval. This information collection has been approved by OMB under OMB Control Number 0651-0009. The public reporting burden for this collection of information is estimated to average as follows: Seventeen minutes for applications to obtain registrations based on an intent to use the mark under section 1(b) of the Act, if completed using paper forms; fifteen minutes for applications to obtain registrations based on an intent to use the mark under section 1(b) of the Act, if completed using an electronic form; twenty-three minutes for applications to obtain registrations based on use of the mark under section 1(a) of the Act, if completed using paper forms; twenty-one minutes for applications to obtain registrations based on use of the mark under section 1(a) of the Act, if completed using an electronic form; twenty minutes for applications to obtain registrations based on an earlier-filed foreign application under section 44(d) of the Act, if completed using paper forms; nineteen minutes for applications to obtain registrations based on an earlier-filed foreign application under section 44(d) of the Act, if completed using an electronic form; twenty minutes for applications to obtain registrations based on registration of a mark in a foreign applicant's country of origin under section 44(e) of the Act; thirteen minutes for allegations of use of the mark under sections 2.76 and 2.88; ten minutes for requests for extension of time to file statements of use under section 2.89; fourteen minutes for renewal applications under section 9 of the Act combined with affidavits or declarations of continued use or excusable nonuse under section 8 of the Act; fourteen minutes for combined affidavits/declarations of use and incontestability under sections 8 and 15 of the Act; eleven minutes for an affidavit or declaration of continued use or excusable nonuse under section 8 of the Act; eleven minutes for a renewal application under section 9 of the Act;

eleven minutes for a declaration of incontestability under section 15 of the Act; three minutes for powers of attorney and designations of domestic representatives; and thirty minutes for a trademark recordation form cover sheet. These time estimates include the time for reviewing instructions, searching existing data sources, gathering and maintaining the data needed, and completing and reviewing the collection of information. Comments are invited on: (1) Whether the collection of information is necessary for proper performance of the functions of the agency; (2) the accuracy of the agency's estimate of the burden; (3) ways to enhance the quality, utility, and clarity of the information to be collected; and (4) ways to minimize the burden of the collection of information to respondents.

This final rule also involves information requirements associated with amendments, oppositions, and petitions to cancel. The amendments and the oppositions have been previously approved by OMB under control number 0651-0009. The petitions to cancel have been previously approved by OMB under control number 0651-0040. These requirements are not being resubmitted for review at this time. Send comments regarding this burden estimate, or any other aspect of this data collection, including suggestions for reducing the burden, to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 (Attn: Ari Leifman), and to the Office of Information and Regulatory Affairs, Office of Management and Budget, 725 17th Street, NW, Washington, DC 20230 (Attn: PTO Desk Officer).

List of Subjects

37 CFR Part 1

Administrative practice and procedure, Patents.

37 CFR Part 2

Administrative practice and procedure, Courts, Lawyers, Trademarks.

37 CFR Part 3

Administrative practice and procedure, Patents, Trademarks.

37 CFR Part 6

Trademarks.

For the reasons given in the preamble and under the authority contained in 35 U.S.C. 6 and 15 U.S.C. 41, as amended, the Patent and Trademark Office is amending parts 1, 2, 3, and 6 of title 37 as follows:

PART 1—RULES OF PRACTICE IN PATENT CASES

1. The authority citation for part 1 continues to read as follows:

Authority: 35 U.S.C. 6, unless otherwise noted.

2. Amend § 1.1 by revising paragraph (a)(2) to read as follows:

§ 1.1 Addresses for correspondence with the Patent and Trademark Office.

- (a) * * *
- (2) *Trademark correspondence.* (i) Send all trademark filings and correspondence, except as specified below or unless submitting electronically, to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.
- (ii) Send trademark-related documents for the Assignment Division to record to: Commissioner of Patents and Trademarks, Box Assignment, Washington, DC 20231.
- (iii) Send requests for certified or uncertified copies of trademark applications and registrations, other than coupon orders for uncertified copies of registrations, to: Commissioner of Patents and Trademarks, Box 10, Washington, DC 20231.
- (iv) Send requests for coupon orders for uncertified copies of registrations to: Commissioner of Patents and Trademarks, Box 9, Washington, DC 20231.
- (v) An applicant may transmit an application for trademark registration electronically, but only if the applicant uses the Patent and Trademark Office's electronic form.

* * * * *

3. Amend § 1.4 by revising the last sentence of paragraph (a)(2), revising paragraphs (d)(1), introductory text, and (d)(1)(ii), and adding a new paragraph (d)(1)(iii) to read as follows:

§ 1.4 Nature of correspondence and signature requirements.

- (a) * * *
- (2) * * * See particularly the rules relating to the filing, processing, or other proceedings of national applications in subpart B, §§ 1.31 to 1.378; of international applications in subpart C, §§ 1.401 to 1.499; of reexamination of patents in subpart D, §§ 1.501 to 1.570; of interferences in subpart E, §§ 1.601 to 1.690; of extension of patent term in subpart F, §§ 1.710 to 1.785; and of trademark applications and registrations, §§ 2.11 to 2.186.

* * * * *

(d)(1) Each piece of correspondence, except as provided in paragraphs (e) and

(f) of this section, filed in an application, patent file, trademark registration file, or other proceeding in the Office which requires a person's signature, must:

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

* * * * *

4. Amend § 1.5 by revising paragraph (c) to read as follows:

§ 1.5 Identification of application, patent or registration.

- * * * * *
- (c)(1) A letter about a trademark application should identify the serial number, the name of the applicant, and the mark.
- (2) A letter about a registered trademark should identify the registration number, the name of the registrant, and the mark.

* * * * *

5. Amend § 1.6 by revising paragraph (a)(1), and adding new paragraph (a)(4), to read as follows:

§ 1.6 Receipt of correspondence.

- (a) * * *
- (1) The Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for correspondence transmitted by facsimile under paragraph (a)(3) of this section, or filed electronically under paragraph (a)(4) of this section, no correspondence is received in the Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.
- * * * * *
- (4) Trademark-related correspondence transmitted electronically will be stamped with the date on which the Office receives the transmission.

* * * * *

6. Revise § 1.23 to read as follows:

§ 1.23 Method of payment.

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

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

PART 2—RULES APPLICABLE TO TRADEMARK CASES

7. The authority citation for part 2 continues to read as follows:

Authority: 15 U.S.C. 1123; 35 U.S.C. 6, unless otherwise noted.

8. Revise § 2.1 to read as follows:

§ 2.1 Sections of part 1 applicable.

Sections 1.1 to 1.26 of this chapter apply to trademark cases, except those parts that specifically refer to patents, and except § 1.22 to the extent that it is inconsistent with §§ 2.85(e), 2.101(d), 2.111(c), 2.164, or 2.185. Other sections of part 1 incorporated by reference in part 2 also apply to trademark cases.

9. Section 2.6 is amended by revising the introductory text, paragraphs (a)(6) and (a)(14) and by adding paragraphs (a)(20) and (a)(21) to read as follows:

§ 2.6 Trademark fees.

The Patent and Trademark Office requires the following fees and charges:

(a) * * *	
(6) Additional fee for filing a renewal application during the grace period, per class	\$100.00
* * * * *	
(14) Additional fee for filing a section 8 affidavit during the grace period, per class	\$100.00
* * * * *	
(20) For correcting a deficiency in a section 8 affidavit	\$100.00
(21) For correcting a deficiency in a renewal application	\$100.00

* * * * *

10. Amend § 2.17 by adding paragraphs (c) and (d) to read as follows:

§ 2.17 Recognition for representation.

* * * * *

(c) To be recognized as a representative, an attorney as defined in § 10.1(c) of this chapter may file a power of attorney, appear in person, or sign a paper on behalf of an applicant or registrant that is filed with the Office in a trademark case.

(d) A party may file a power of attorney that relates to more than one trademark application or registration, or to all existing and future applications and registrations of that party. A party relying on such a power of attorney must:

- (1) Include a copy of the previously filed power of attorney; or
- (2) Refer to the power of attorney, specifying the filing date of the previously filed power of attorney; the application serial number (if known), registration number, or *inter partes* proceeding number for which the original power of attorney was filed; and the name of the party who signed the power of attorney; or, if the application serial number is not known, submit a copy of the application or a copy of the mark, and specify the filing date.

11. Revise § 2.20 to read as follows:

§ 2.20 Declarations in lieu of oaths.

Instead of an oath, affidavit, verification, or sworn statement, the language of 28 U.S.C. 1746, or the following language, may be used:

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

12. Revise § 2.21 to read as follows:

§ 2.21 Requirements for receiving a filing date.

(a) The Office will grant a filing date to an application that contains all of the following:

- (1) The name of the applicant;
 - (2) A name and address for correspondence;
 - (3) A clear drawing of the mark;
 - (4) A listing of the goods or services; and
 - (5) The filing fee for at least one class of goods or services, required by § 2.6.
- (b) If the applicant does not submit all the elements required in paragraph (a) of this section, the Office may return the papers with an explanation of why the filing date was denied.

(c) The applicant may correct and resubmit the application papers. If the resubmitted papers and fee meet all the requirements of paragraph (a) of this section, the Office will grant a filing date as of the date the Office receives the corrected papers.

§ 2.31 [Removed and reserved]

- 13. Remove and reserve § 2.31.
- 14. Revise § 2.32 to read as follows:

§ 2.32 Requirements for a complete application.

(a) The application must be in English and include the following:

- (1) A request for registration;
- (2) The name of the applicant(s);
- (3)(i) The citizenship of the applicant(s); or
- (ii) If the applicant is a corporation, association, partnership or other juristic person, the jurisdiction (usually state or nation) under the laws of which the applicant is organized; and
- (iii) If the applicant is a partnership, the names and citizenship of the general partners;
- (4) The address of the applicant;
- (5) One or more bases, as required by § 2.34(a);
- (6) A list of the particular goods or services on or in connection with which the applicant uses or intends to use the mark. In a United States application filed under section 44 of the Act, the

scope of the goods or services covered by the section 44 basis may not exceed the scope of the goods or services in the foreign application or registration; and

(7) The international class of goods or services, if known. See § 6.1 of this chapter for a list of the international classes of goods and services.

(b) The application must include a verified statement that meets the requirements of § 2.33.

(c) The application must include a drawing that meets the requirements of §§ 2.51 and 2.52.

(d) The application must include fee required by § 2.6 for each class of goods or services.

(e) For the requirements for a multiple class application, see § 2.86.

15. Revise § 2.33 to read as follows:

§ 2.33 Verified statement.

(a) The application must include a statement that is signed and verified (sworn to) or supported by a declaration under § 2.20 by a person properly authorized to sign on behalf of the applicant. A person who is properly authorized to sign on behalf of the applicant is:

- (1) A person with legal authority to bind the applicant; or
- (2) A person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the applicant; or
- (3) An attorney as defined in § 10.1(c) of this chapter who has an actual or implied written or verbal power of attorney from the applicant.

(b)(1) In an application under section 1(a) of the Act, the verified statement must allege:

That the applicant has adopted and is using the mark shown in the accompanying drawing; that the applicant believes it is the owner of the mark; that the mark is in use in commerce; that to the best of the declarant's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when applied to the goods or services of the other person, to cause confusion or mistake, or to deceive; that the specimen shows the mark

as used on or in connection with the goods or services; and that the facts set forth in the application are true.

(2) In an application under section 1(b) or section 44 of the Act, the verified statement must allege:

That the applicant has a bona fide intention to use the mark shown in the accompanying drawing in commerce on or in connection with the specified goods or services; that the applicant believes it is entitled to use the mark; that to the best of the declarant's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when applied to the goods or services of the other person, to cause confusion or mistake, or to deceive; and that the facts set forth in the application are true.

(c) If the verified statement is not filed within a reasonable time after it is signed, the Office may require the applicant to submit a substitute verification or declaration under § 2.20 of the applicant's continued use or bona fide intention to use the mark in commerce.

(d) Where an electronically transmitted filing is permitted, the person who signs the verified statement must either:

(1) Place a symbol comprised of numbers and/or letters between two forward slash marks in the signature block on the electronic submission; and print, sign and date in permanent ink, and maintain a paper copy of the electronic submission; or

(2) Sign the verified statement using some other form of electronic signature specified by the Commissioner.

16. Add § 2.34 to read as follows:

§ 2.34 Bases for filing.

(a) The application must include one or more of the following four filing bases:

(1) *Use in commerce under section 1(a) of the Act.* The requirements for an application based on section 1(a) of the Act are:

(i) The trademark owner's verified statement that the mark is in use in commerce on or in connection with the goods or services listed in the application. If the verification is not filed with the initial application, the verified statement must allege that the mark was in use in commerce on or in connection with the goods or services listed in the application as of the application filing date;

(ii) The date of the applicant's first use of the mark anywhere on or in connection with the goods or services;

(iii) The date of the applicant's first use of the mark in commerce as a trademark or service mark; and

(iv) One specimen showing how the applicant actually uses the mark in commerce.

(v) An application may list more than one item of goods, or more than one service, provided the applicant has used the mark on or in connection with all the specified goods or services. The dates of use required by paragraphs (a)(1) (ii) and (iii) of this section may be for only one of the items specified.

(2) *Intent-to-use under section 1(b) of the Act.* (i) In an application under section 1(b) of the Act, the trademark owner must verify that it has a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application. If the verification is not filed with the initial application, the verified statement must allege that the applicant had a bona fide intention to use the mark in commerce as of the filing date of the application.

(ii) The application may list more than one item of goods, or more than one service, provided the applicant has a bona fide intention to use the mark in commerce on or in connection with all the specified goods or services.

(3) *Registration of a mark in a foreign applicant's country of origin under section 44(e) of the Act.* The requirements for an application under section 44(e) of the Act are:

(i) The trademark owner's verified statement that it has a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application. If the verification is not filed with the initial application, the verified statement must allege that the applicant had a bona fide intention to use the mark in commerce as of the filing date of the application.

(ii) A certification or certified copy of a registration in the applicant's country of origin showing that the mark has been registered in that country, and that the registration is in full force and effect. The certification or certified copy must show the name of the owner, the mark, and the goods or services for which the mark is registered. If the certification or certified copy is not in the English language, the applicant must submit a translation.

(iii) If the record indicates that the foreign registration will expire before the United States registration will issue, the applicant must submit a certification or certified copy from the country of origin to establish that the registration has been renewed and will be in force at the time the United States registration will issue. If the certification or certified copy is not in the English language, the applicant must submit a translation.

(iv) The application may list more than one item of goods, or more than

one service, provided the applicant has a bona fide intention to use the mark in commerce on or in connection with all the specified goods or services.

(4) *Claim of priority, based upon an earlier-filed foreign application, under section 44(d) of the Act.* The requirements for an application under section 44(d) of the Act are:

(i) A claim of priority, filed within six months of the filing date of the foreign application. Before publication or registration on the Supplemental Register, the applicant must either:

(A) Specify the filing date and country of the first regularly filed foreign application; or

(B) State that the application is based upon a subsequent regularly filed application in the same foreign country, and that any prior-filed application has been withdrawn, abandoned or otherwise disposed of, without having been laid open to public inspection and without having any rights outstanding, and has not served as a basis for claiming a right of priority.

(ii) Include the trademark owner's verified statement that it has a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application. If the verification is not filed with the initial application, the verified statement must allege that the applicant had a bona fide intention to use the mark in commerce as of the filing date of the application.

(iii) Before the application can be approved for publication, or for registration on the Supplemental Register, the applicant must establish a basis under section 1(a), section 1(b) or section 44(e) of the Act.

(iv) The application may list more than one item of goods, or more than one service, provided the applicant has a bona fide intention to use the mark in commerce on or in connection with all the specified goods or services.

(b)(1) The applicant may claim more than one basis, provided that the applicant satisfies all requirements for the bases claimed. However, the applicant may not claim both sections 1(a) and 1(b) for the identical goods or services in the same application.

(2) If the applicant claims more than one basis, the applicant must list each basis, followed by the goods or services to which that basis applies. If some or all of the goods or services are covered by more than one basis, this must be stated.

(c) The word "commerce" means commerce that Congress may lawfully regulate, as specified in section 45 of the Act.

§ 2.37 [Removed]

17. Remove § 2.37.

§ 2.35 [Redesignated as § 2.37]

18. Redesignate § 2.35 as § 2.37.

19. Add new § 2.35, to read as follows:

§ 2.35 Adding, deleting, or substituting bases.

(a) Before publication, the applicant may add or substitute a basis, if the applicant meets all requirements for the new basis, as stated in § 2.34. The applicant may delete a basis at any time.

(b) An applicant may amend an application that is not the subject of an *inter partes* proceeding before the Trademark Trial and Appeal Board to add or substitute a basis after the mark has been published for opposition, but only with the express permission of the Commissioner, after consideration on petition. Republication will be required. The amendment of an application that is the subject of an *inter partes* proceeding before the Board is governed by § 2.133(a).

(c) When the applicant substitutes one basis for another, the Office will presume that there was a continuing valid basis, unless there is contradictory evidence in the record, and the application will retain the original filing date, including a priority filing date under section 44(d), if appropriate.

(d) If an applicant properly claims a section 44(d) basis in addition to another basis, the applicant will retain the priority filing date under section 44(d) no matter which basis the applicant perfects.

(e) The applicant may add or substitute a section 44(d) basis only within the six-month priority period following the filing date of the foreign application.

(f) When the applicant adds or substitutes a basis, the applicant must list each basis, followed by the goods or services to which that basis applies.

(g) When the applicant deletes a basis, the applicant must also delete any goods or services covered solely by the deleted basis.

(h) Once an applicant claims a section 1(b) basis as to any or all of the goods or services, the applicant may not amend the application to seek registration under section 1(a) of the Act for those goods or services unless the applicant files an allegation of use under section 1(c) or section 1(d) of the Act.

20. Amend § 2.38 by revising paragraph (a) to read as follows:

§ 2.38 Use by predecessor or by related companies.

(a) If the first use of the mark was by a predecessor in title or by a related company (sections 5 and 45 of the Act), and the use inures to the benefit of the applicant, the dates of first use (§§ 2.34(a)(1) (ii) and (iii)) may be asserted with a statement that first use was by the predecessor in title or by the related company, as appropriate.

* * * * *

§ 2.39 [Removed and reserved]

21. Remove and reserve § 2.39.

22. Revise § 2.45 to read as follows:

§ 2.45 Certification mark.

(a) In an application to register a certification mark under section 1(a) of the Act, the application shall include all applicable elements required by the preceding sections for trademarks. In addition, the application must: Specify the conditions under which the certification mark is used; allege that the applicant exercises legitimate control over the use of the mark; allege that the applicant is not engaged in the production or marketing of the goods or services to which the mark is applied; and include a copy of the standards that determine whether others may use the certification mark on their goods and/or in connection with their services.

(b) In an application to register a certification mark under section 1(b) or section 44 of the Act, the application shall include all applicable elements required by the preceding sections for trademarks. In addition, the application must: specify the conditions under which the certification mark is intended to be used; allege that the applicant intends to exercise legitimate control over the use of the mark; and allege that the applicant will not engage in the production or marketing of the goods or services to which the mark is applied. When the applicant files an amendment to allege use under section 1(c) of the Act, or a statement of use under section 1(d) of the Act, the applicant must submit a copy of the standards that determine whether others may use the certification mark on their goods and/or in connection with their services.

§ 2.51 [Amended]

23. In § 2.51, remove paragraphs (c), (d) and (e).

24. Revise § 2.52 to read as follows:

§ 2.52 Types of drawings and format for drawings.

(a) A drawing depicts the mark sought to be registered. The drawing must show only one mark. The applicant must include a clear drawing of the mark

when the application is filed. There are two types of drawings:

(1) *Typed drawing*. The drawing may be typed if the mark consists only of words, letters, numbers, common forms of punctuation, or any combination of these elements. In a typed drawing, every word or letter must be typed in uppercase type. If the applicant submits a typed drawing, the application is not limited to the mark depicted in any special form or lettering.

(2) *Special form drawing*. A special form drawing is required if the mark has a two or three-dimensional design; or color; or words, letters, or numbers in a particular style of lettering; or unusual forms of punctuation.

(i) Special form drawings must be made with a pen or by a process that will provide high definition when copied. A photolithographic, printer's proof copy, or other high quality reproduction of the mark may be used. Every line and letter, including lines used for shading, must be black. All lines must be clean, sharp, and solid, and must not be fine or crowded. Gray tones or tints may not be used for surface shading or any other purpose.

(ii) If necessary to adequately depict the commercial impression of the mark, the applicant may be required to submit a drawing that shows the placement of the mark by surrounding the mark with a proportionately accurate broken-line representation of the particular goods, packaging, or advertising on which the mark appears. The applicant must also use broken lines to show any other matter not claimed as part of the mark. For any drawing using broken lines to indicate placement of the mark, or matter not claimed as part of the mark, the applicant must include in the body of the application a written description of the mark and explain the purpose of the broken lines.

(iii) If the mark has three-dimensional features, the applicant must submit a drawing that depicts a single rendition of the mark, and the applicant must include a description of the mark indicating that the mark is three-dimensional.

(iv) If the mark has motion, the applicant may submit a drawing that depicts a single point in the movement, or the applicant may submit a square drawing that contains up to five freeze frames showing various points in the movement, whichever best depicts the commercial impression of the mark. The applicant must also submit a written description of the mark.

(v) If the mark has color, the applicant may claim that all or part of the mark consists of one or more colors. To claim color, the applicant must submit a

statement explaining where the color or colors appear in the mark and the nature of the color(s).

(vi) If a drawing cannot adequately depict all significant features of the mark, the applicant must also submit a written description of the mark.

(3) *Sound, scent, and non-visual marks.* The applicant is not required to submit a drawing if the applicant's mark consists only of a sound, a scent, or other completely non-visual matter. For these types of marks, the applicant must submit a detailed written description of the mark.

(b) *Recommended format for special form drawings—(1) Type of paper and ink.* The drawing should be on a piece of non-shiny, white paper that is separate from the application. Black ink should be used to depict the mark.

(2) *Size of paper and size of mark.* The drawing should be on paper that is 8 to 8½ inches (20.3 to 21.6 cm.) wide and 11 to 11.69 inches (27.9 to 29.7 cm.) long. One of the shorter sides of the sheet should be regarded as its top edge. The drawing should be between 2.5 inches (6.1 cm.) and 4 inches (10.3 cm.) high and/or wide. There should be at least a 1 inch (2.5 cm.) margin between the drawing and the edges of the paper, and at least a 1 inch (2.5 cm.) margin between the drawing and the heading.

(3) *Heading.* Across the top of the drawing, beginning one inch (2.5 cm.) from the top edge, the applicant should type the following: Applicant's name; applicant's address; the goods or services recited in the application, or a typical item of the goods or services if numerous items are recited in the application; the date of first use of the mark and first use of the mark in commerce in an application under section 1(a) of the Act; the priority filing date of the relevant foreign application in an application claiming the benefit of a prior foreign application under section 44(d) of the Act. If the information in the heading is lengthy, the heading may continue onto a second page, but the mark should be depicted on the first page.

(c) *Drawings in electronically transmitted applications.* For an electronically transmitted application, if the drawing is in special form, the applicant must attach a digitized image of the mark to the electronic submission.

25. Revise § 2.56 to read as follows:

§ 2.56 Specimens.

(a) An application under section 1(a) of the Act, an amendment to allege use under § 2.76, and a statement of use under § 2.88 must each include one specimen showing the mark as used on

or in connection with the goods, or in the sale or advertising of the services in commerce.

(b)(1) A trademark specimen is a label, tag, or container for the goods, or a display associated with the goods. The Office may accept another document related to the goods or the sale of the goods when it is not possible to place the mark on the goods or packaging for the goods.

(2) A service mark specimen must show the mark as actually used in the sale or advertising of the services.

(3) A collective trademark or collective service mark specimen must show how a member uses the mark on the member's goods or in the sale or advertising of the member's services.

(4) A collective membership mark specimen must show use by members to indicate membership in the collective organization.

(5) A certification mark specimen must show how a person other than the owner uses the mark to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of that person's goods or services; or that members of a union or other organization performed the work or labor on the goods or services.

(c) A photocopy or other reproduction of a specimen of the mark as actually used on or in connection with the goods, or in the sale or advertising of the services, is acceptable. However, a photocopy of the drawing required by § 2.51 is not a proper specimen.

(d)(1) The specimen should be flat, and not larger than 8½ inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long. If a specimen of this size is not available, the applicant may substitute a suitable photograph or other facsimile.

(2) If the applicant files a specimen exceeding these size requirements (a "bulky specimen"), the Office will create a facsimile of the specimen that meets the requirements of the rule (*i.e.*, is flat and no larger than 8½ inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long) and put it in the file wrapper.

(3) In the absence of non-bulky alternatives, the Office may accept an audio or video cassette tape recording, CD-ROM, or other appropriate medium.

(4) For an electronically transmitted application, or other electronic submission, the specimen must be submitted as a digitized image.

§ 2.57 [Removed and reserved]

26. Remove and reserve § 2.57.

§ 2.58 [Removed and reserved]

27. Remove and reserve § 2.58.

28. Revise § 2.59 to read as follows:

§ 2.59 Filing substitute specimen(s).

(a) In an application under section 1(a) of the Act, the applicant may submit substitute specimens of the mark as used on or in connection with the goods, or in the sale or advertising of the services. The applicant must verify by an affidavit or declaration under § 2.20 that the substitute specimens were in use in commerce at least as early as the filing date of the application. Verification is not required if the specimen is a duplicate or facsimile of a specimen already of record in the application.

(b) In an application under section 1(b) of the Act, after filing either an amendment to allege use under § 2.76 or a statement of use under § 2.88, the applicant may submit substitute specimens of the mark as used on or in connection with the goods, or in the sale or advertising of the services. If the applicant submits substitute specimen(s), the applicant must:

(1) For an amendment to allege use under § 2.76, verify by affidavit or declaration under § 2.20 that the applicant used the substitute specimen(s) in commerce prior to filing the amendment to allege use.

(2) For a statement of use under § 2.88, verify by affidavit or declaration under § 2.20 that the applicant used the substitute specimen(s) in commerce either prior to filing the statement of use or prior to the expiration of the deadline for filing the statement of use.

29. Revise § 2.66 to read as follows:

§ 2.66 Revival of abandoned applications.

(a) The applicant may file a petition to revive an application abandoned because the applicant did not timely respond to an Office action or notice of allowance, if the delay was unintentional. The applicant must file the petition:

(1) Within two months of the mailing date of the notice of abandonment; or

(2) Within two months of actual knowledge of the abandonment, if the applicant did not receive the notice of abandonment, and the applicant was diligent in checking the status of the application. To be diligent, the applicant must check the status of the application within one year of the last filing or receipt of a notice from the Office for which further action by the Office is expected.

(b) The requirements for filing a petition to revive an application abandoned because the applicant did not timely respond to an Office action are:

(1) The petition fee required by § 2.6;

(2) A statement, signed by someone with firsthand knowledge of the facts,

that the delay in filing the response on or before the due date was unintentional; and

(3) Unless the applicant alleges that it did not receive the Office action, the proposed response.

(c) The requirements for filing a petition to revive an application abandoned because the applicant did not timely respond to a notice of allowance are:

(1) The petition fee required by § 2.6;

(2) A statement, signed by someone with firsthand knowledge of the facts, that the delay in filing the statement of use (or request for extension of time to file a statement of use) on or before the due date was unintentional;

(3) Unless the applicant alleges that it did not receive the notice of allowance and requests cancellation of the notice of allowance, the required fees for the number of requests for extensions of time to file a statement of use that the applicant should have filed under § 2.89 if the application had never been abandoned;

(4) Unless the applicant alleges that it did not receive the notice of allowance and requests cancellation of the notice of allowance, either a statement of use under § 2.88 or a request for an extension of time to file a statement of use under § 2.89; and

(5) Unless a statement of use is filed with or before the petition, or the applicant alleges that it did not receive the notice of allowance and requests cancellation of the notice of allowance, the applicant must file any further requests for extensions of time to file a statement of use under § 2.89 that become due while the petition is pending, or file a statement of use under § 2.88.

(d) In an application under section 1(b) of the Act, the Commissioner will not grant the petition if this would permit the filing of a statement of use more than 36 months after the mailing date of the notice of allowance under section 13(b)(2) of the Act.

(e) The Commissioner will grant the petition to revive if the applicant complies with the requirements listed above and establishes that the delay in responding was unintentional.

(f) If the Commissioner denies a petition, the applicant may request reconsideration, if the applicant:

(1) Files the request within two months of the mailing date of the decision denying the petition; and

(2) Pays a second petition fee under § 2.6.

30. Revise § 2.71 to read as follows:

§ 2.71 Amendments to correct informalities.

The applicant may amend the application during the course of examination, when required by the Office or for other reasons.

(a) The applicant may amend the application to clarify or limit, but not to broaden, the identification of goods and/or services.

(b)(1) If the declaration or verification of an application under § 2.33 is unsigned or signed by the wrong party, the applicant may submit a substitute verification or declaration under § 2.20.

(2) If the declaration or verification of a statement of use under § 2.88, or a request for extension of time to file a statement of use under § 2.89, is unsigned or signed by the wrong party, the applicant must submit a substitute verification before the expiration of the statutory deadline for filing the statement of use.

(c) The applicant may amend the dates of use, provided that the applicant supports the amendment with an affidavit or declaration under § 2.20, except that the following amendments are not permitted:

(1) In an application under section 1(a) of the Act, the applicant may not amend the application to specify a date of use that is subsequent to the filing date of the application;

(2) In an application under section 1(b) of the Act, after filing a statement of use under § 2.88, the applicant may not amend the statement of use to specify a date of use that is subsequent to the expiration of the deadline for filing the statement of use.

(d) The applicant may amend the application to correct the name of the applicant, if there is a mistake in the manner in which the name of the applicant is set out in the application. The amendment must be supported by an affidavit or declaration under § 2.20, signed by the applicant. However, the application cannot be amended to set forth a different entity as the applicant. An application filed in the name of an entity that did not own the mark as of the filing date of the application is void.

31. Revise § 2.72 to read as follows:

§ 2.72 Amendments to description or drawing of the mark.

(a) In an application based on use in commerce under section 1(a) of the Act, the applicant may amend the description or drawing of the mark only if:

(1) The specimens originally filed, or substitute specimens filed under § 2.59(a), support the proposed amendment; and

(2) The proposed amendment does not materially alter the mark. The Office

will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application.

(b) In an application based on a bona fide intention to use a mark in commerce under section 1(b) of the Act, the applicant may amend the description or drawing of the mark only if:

(1) The specimens filed with an amendment to allege use or statement of use, or substitute specimens filed under § 2.59(b), support the proposed amendment; and

(2) The proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application.

(c) In an application based on a claim of priority under section 44(d) of the Act, or on a mark duly registered in the country of origin of the foreign applicant under section 44(e) of the Act, the applicant may amend the description or drawing of the mark only if:

(1) The description or drawing of the mark in the foreign registration certificate supports the amendment; and

(2) The proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application.

32. Amend § 2.76 by revising paragraphs (b), (e)(2), and (e)(3), and adding paragraphs (i) and (j) to read as follows:

§ 2.76 Amendment to allege use.

* * * * *

(b) A complete amendment to allege use must include:

(1) A statement that is signed and verified (sworn to) or supported by a declaration under § 2.20 by a person properly authorized to sign on behalf of the applicant (see § 2.33(a)(2)) that:

(i) The applicant believes it is the owner of the mark; and

(ii) The mark is in use in commerce, specifying the date of the applicant's first use of the mark and first use of the mark in commerce, and those goods or services specified in the application on or in connection with which the applicant uses the mark in commerce.

(2) One specimen of the mark as actually used in commerce. See § 2.56 for the requirements for specimens; and

(3) The fee per class required by § 2.6.

* * * * *

(e) * * *

(2) One specimen or facsimile of the mark as used in commerce; and

(3) A statement that is signed and verified (sworn to) or supported by a declaration under § 2.20 by a person properly authorized to sign on behalf of the applicant that the mark is in use in commerce.

* * * * *

(i) If the applicant does not file the amendment to allege use within a reasonable time after it is signed, the Office may require a substitute verification or declaration under § 2.20 stating that the mark is still in use in commerce.

(j) For the requirements for a multiple class application, see § 2.86.

33. Revise § 2.86 to read as follows:

§ 2.86 Application may include multiple classes.

(a) In a single application, an applicant may apply to register the same mark for goods and/or services in multiple classes. The applicant must:

(1) Specifically identify the goods or services in each class;

(2) Submit an application filing fee for each class; and

(3) Include either dates of use (see §§ 2.34(a)(1)(ii) and (iii)) and one specimen for each class, or a statement of a bona fide intention to use the mark in commerce on or in connection with all the goods or services specified in each class. The applicant may not claim both use in commerce and a bona fide intention to use the mark in commerce for the identical goods or services in one application.

(b) An amendment to allege use under § 2.76 or a statement of use under § 2.88 must include, for each class, the required fee, dates of use, and one specimen. The applicant may not file the amendment to allege use or statement of use until the applicant has used the mark on all the goods or services, unless the applicant files a request to divide. See § 2.87 for information regarding requests to divide.

(c) The Office will issue a single certificate of registration for the mark, unless the applicant files a request to divide. See § 2.87 for information regarding requests to divide.

34. Amend § 2.88 by revising paragraphs (b) and (e) and by adding paragraphs (k) and (l) to read as follows:

§ 2.88 Filing statement of use after notice of allowance.

* * * * *

(b) A complete statement of use must include:

(1) A statement that is signed and verified (sworn to) or supported by a

declaration under § 2.20 by a person properly authorized to sign on behalf of the applicant (see § 2.33(a)(2)) that:

(i) The applicant believes it is the owner of the mark; and

(ii) The mark is in use in commerce, specifying the date of the applicant's first use of the mark and first use of the mark in commerce, and those goods or services specified in the notice of allowance on or in connection with which the applicant uses the mark in commerce;

(2) One specimen of the mark as actually used in commerce. See § 2.56 for the requirements for specimens; and

(3) The fee per class required by § 2.6.

* * * * *

(e) The Office will review a timely filed statement of use to determine whether it meets the following minimum requirements:

(1) The fee for at least a single class, required by § 2.6;

(2) One specimen of the mark as used in commerce;

(3) A statement that is signed and verified (sworn to) or supported by a declaration under § 2.20 by a person properly authorized to sign on behalf of the applicant that the mark is in use in commerce. If the verification or declaration is unsigned or signed by the wrong party, the applicant must submit a substitute verification on or before the statutory deadline for filing the statement of use.

* * * * *

(k) If the statement of use is not filed within a reasonable time after the date it is signed, the Office may require a substitute verification or declaration under § 2.20 stating that the mark is still in use in commerce.

(l) For the requirements for a multiple class application, see § 2.86.

35. Amend § 2.89 by revising paragraphs (a), (b), and (d), amending the fifth sentence of paragraph (g), and by adding paragraph (h) to read as follows:

§ 2.89 Extensions of time for filing a statement of use.

(a) The applicant may request a six-month extension of time to file the statement of use required by § 2.88. The extension request must be filed within six months of the mailing date of the notice of allowance under section 13(b)(2) of the Act and must include the following:

(1) A written request for an extension of time to file the statement of use;

(2) The fee per class required by § 2.6; and

(3) A statement that is signed and verified (sworn to) or supported by a declaration under § 2.20 by a person

properly authorized to sign on behalf of the applicant (see § 2.33(a)(2)) that the applicant still has a bona fide intention to use the mark in commerce, specifying the relevant goods or services. If the verification is unsigned or signed by the wrong party, the applicant must submit a substitute verification within six months of the mailing date of the notice of allowance.

(b) Before the expiration of the previously granted extension of time, the applicant may request further six month extensions of time to file the statement of use by submitting the following:

(1) A written request for an extension of time to file the statement of use;

(2) The fee per class required by § 2.6;

(3) A statement that is signed and verified (sworn to) or supported by a declaration under § 2.20 by a person properly authorized to sign on behalf of the applicant (see § 2.33(a)(2)) that the applicant still has a bona fide intention to use the mark in commerce, specifying the relevant goods or services. If the verification is unsigned or signed by the wrong party, the applicant must submit a substitute verification before the expiration of the previously granted extension; and

(4) A showing of good cause, as specified in paragraph (d) of this section.

* * * * *

(d) The showing of good cause must include a statement of the applicant's ongoing efforts to make use of the mark in commerce on or in connection with each of the relevant goods or services. Those efforts may include product or service research or development, market research, manufacturing activities, promotional activities, steps to acquire distributors, steps to obtain governmental approval, or other similar activities. In the alternative, the applicant must submit a satisfactory explanation for the failure to make efforts to use the mark in commerce.

* * * * *

(g) * * * A petition from the denial of a request for an extension of time to file a statement of use shall be filed within two months of the mailing date of the denial of the request. If the petition is granted, the term of the requested six month extension that was the subject of the petition will run from the date of the expiration of the previously existing six month period for filing a statement of use.

(h) If the extension request is not filed within a reasonable time after it is signed, the Office may require a substitute verification or declaration under § 2.20 stating that the applicant

still has a bona fide intention to use the mark in commerce.

36. Amend § 2.101 by revising paragraph (d)(1) to read as follows:

§ 2.101 Filing an opposition.

* * * * *

(d)(1) The opposition must be accompanied by the required fee for each party joined as opposer for each class in the application for which registration is opposed (see § 2.6). If no fee, or a fee insufficient to pay for one person to oppose the registration of a mark in at least one class, is submitted within thirty days after publication of the mark to be opposed or within an extension of time for filing an opposition, the opposition will not be refused if the required fee(s) is submitted to the Patent and Trademark Office within the time limit set in the notification of this defect by the Office.

* * * * *

37. Amend § 2.111 by revising paragraph (c)(1) to read as follows:

§ 2.111 Filing petition for cancellation.

* * * * *

(c)(1) The petition must be accompanied by the required fee for each class in the registration for which cancellation is sought (see § 2.6). If the fee submitted is insufficient for a cancellation against all of the classes in the registration, and the particular class or classes against which the cancellation is filed are not specified, the Office will issue a written notice allowing petitioner a set time in which to submit the required fees(s) (provided that the five-year period, if applicable, has not expired) or to specify the class or classes sought to be cancelled. If the required fee(s) is not submitted, or the specification made, within the time set in the notice, the cancellation will be presumed to be against the class or classes in ascending order, beginning with the lowest numbered class, and including the number of classes in the registration for which the fees submitted are sufficient to pay the fee due for each class.

* * * * *

38. Amend § 2.146 by revising paragraph (d) and by adding paragraphs (i) and (j) to read as follows:

§ 2.146 Petitions to the Commissioner.

* * * * *

(d) A petition must be filed within two months of the mailing date of the action from which relief is requested, unless a different deadline is specified elsewhere in this chapter.

* * * * *

(i) Where a petitioner seeks to reactivate an application or registration

that was abandoned or cancelled because papers were lost or mishandled, the Commissioner may deny the petition if the petitioner was not diligent in checking the status of the application or registration. To be considered diligent, the applicant must check the status of the application or registration within one year of the last filing or receipt of a notice from the Office for which further action by the Office is expected.

(j) If the Commissioner denies a petition, the petitioner may request reconsideration, if the petitioner:

- (1) Files the request within two months of the mailing date of the decision denying the petition; and
- (2) Pays a second petition fee under § 2.6.

39. Revise § 2.151 to read as follows:

§ 2.151 Certificate.

When the Office determines that a mark is registrable, a certificate will be issued stating that the applicant is entitled to registration on the Principal Register or on the Supplemental Register. The certificate will state the date on which the application for registration was filed in the Office, the act under which the mark is registered, the date of issue, and the number of the registration. A reproduction of the mark and pertinent data from the application will be sent with the certificate. A notice of the requirements of section 8 of the Act will accompany the certificate.

40. Revise § 2.155 to read as follows:

§ 2.155 Notice of publication.

The Office will send the registrant a notice of publication of the mark and of the requirement for filing the affidavit or declaration required by section 8 of the Act.

41. Revise § 2.156 to read as follows:

§ 2.156 Not subject to opposition; subject to cancellation.

The published mark is not subject to opposition, but is subject to petitions to cancel as specified in § 2.111 and to cancellation for failure to file the affidavit or declaration required by section 8 of the Act.

42. Add § 2.160 to read as follows:

§ 2.160 Affidavit or declaration of continued use or excusable nonuse required to avoid cancellation of registration.

(a) During the following time periods, the owner of the registration must file an affidavit or declaration of continued use or excusable nonuse, or the registration will be cancelled:

- (1)(i) For registrations issued under the Trademark Act of 1946, on or after

the fifth anniversary and no later than the sixth anniversary after the date of registration; or

(ii) For registrations issued under prior Acts, on or after the fifth anniversary and no later than the sixth anniversary after the date of publication under section 12(c) of the Act; and

(2) For all registrations, within the year before the end of every ten-year period after the date of registration.

(3) The affidavit or declaration may be filed within a grace period of six months after the end of the deadline set forth in paragraphs (a)(1) and (a)(2) of this section, with payment of the grace period surcharge required by section 8(c)(1) of the Act and § 2.6.

(b) For the requirements for the affidavit or declaration, see § 2.161.

43. Revise § 2.161 to read as follows:

§ 2.161 Requirements for a complete affidavit or declaration of continued use or excusable nonuse.

A complete affidavit or declaration under section 8 of the Act must:

(a) Be filed by the owner within the period set forth in § 2.160(a);

(b) Include a statement that is signed and verified (sworn to) or supported by a declaration under § 2.20 by a person properly authorized to sign on behalf of the owner, attesting to the continued use or excusable nonuse of the mark within the period set forth in section 8 of the Act. The verified statement must be executed on or after the beginning of the filing period specified in § 2.160(a). A person who is properly authorized to sign on behalf of the owner is:

- (1) A person with legal authority to bind the owner; or
- (2) A person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or

(3) An attorney as defined in § 10.1(c) of this chapter who has an actual or implied written or verbal power of attorney from the owner.

(c) Include the registration number;

(d)(1) Include the fee required by § 2.6 for each class of goods or services that the affidavit or declaration covers;

(2) If the affidavit or declaration is filed during the grace period under section 8(c)(1) of the Act, include the late fee per class required by § 2.6;

(3) If at least one fee is submitted for a multi-class registration, but the class(es) to which the fee(s) should be applied are not specified, the Office will issue a notice requiring either the submission of additional fee(s) or an indication of the class(es) to which the original fee(s) should be applied. Additional fee(s) may be submitted if the requirements of § 2.164 are met. If

the required fee(s) are not submitted and the class(es) to which the original fee(s) should be applied are not specified, the Office will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class;

(e)(1) Specify the goods or services for which the mark is in use in commerce, and/or the goods or services for which excusable nonuse is claimed under § 2.161(f)(2);

(2) If the affidavit or declaration covers less than all the goods or services, or less than all the classes in the registration, specify the goods or services being deleted from the registration;

(f)(1) State that the registered mark is in use in commerce on or in connection with the goods or services in the registration; or

(2) If the registered mark is not in use in commerce on or in connection with all the goods or services in the registration, set forth the date when use of the mark in commerce stopped and the approximate date when use is expected to resume; and recite facts to show that nonuse as to those goods or services is due to special circumstances that excuse the nonuse and is not due to an intention to abandon the mark;

(g) Include a specimen showing current use of the mark for each class of goods or services, unless excusable nonuse is claimed under § 2.161(f)(2). The specimen must:

(1) Show the mark as actually used on or in connection with the goods or in the sale or advertising of the services. A photocopy or other reproduction of the specimen showing the mark as actually used is acceptable. However, a photocopy that merely reproduces the registration certificate is not a proper specimen;

(2) Be flat and no larger than 8½ inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long. If a specimen exceeds these size requirements (a "bulky specimen"), the Office will create a facsimile of the specimen that meets the requirements of the rule (*i.e.*, is flat and no larger than 8½ inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long) and put it in the file wrapper;

(h) If the registrant is not domiciled in the United States, the registrant must list the name and address of a United States resident upon whom notices or process in proceedings affecting the registration may be served.

44. Revise § 2.162 to read as follows:

§ 2.162 Notice to registrant.

When a certificate of registration is originally issued, the Office includes a notice of the requirement for filing the

affidavit or declaration of use or excusable nonuse under section 8 of the Act. However the affidavit or declaration must be filed within the time period required by section 8 of the Act even if this notice is not received.

45. Revise § 2.163 to read as follows:

§ 2.163 Acknowledgment of receipt of affidavit or declaration.

The Office will issue a notice as to whether an affidavit or declaration is acceptable, or the reasons for refusal.

(a) If the owner of the registration filed the affidavit or declaration within the time periods set forth in section 8 of the Act, deficiencies may be corrected if the requirements of § 2.164 are met.

(b) A response to the refusal must be filed within six months of the mailing date of the Office action, or before the end of the filing period set forth in section 8(a) or section 8(b) of the Act, whichever is later. If no response is filed within this time period, the registration will be cancelled.

46. Revise § 2.164 to read as follows:

§ 2.164 Correcting deficiencies in affidavit or declaration.

(a) If the owner of the registration files an affidavit or declaration within the time periods set forth in section 8 of the Act, deficiencies may be corrected, as follows:

(1) *Correcting deficiencies in affidavits or declarations timely filed within the periods set forth in sections 8(a) and 8(b) of the Act.* If the owner timely files the affidavit or declaration within the relevant filing period set forth in section 8(a) or section 8(b) of the Act, deficiencies may be corrected before the end of this filing period without paying a deficiency surcharge. Deficiencies may be corrected after the end of this filing period with payment of the deficiency surcharge required by section 8(c)(2) of the Act and § 2.6.

(2) *Correcting deficiencies in affidavits or declarations filed during the grace period.* If the affidavit or declaration is filed during the six-month grace period provided by section 8(c)(1) of the Act, deficiencies may be corrected before the expiration of the grace period without paying a deficiency surcharge. Deficiencies may be corrected after the expiration of the grace period with payment of the deficiency surcharge required by section 8(c)(2) of the Act and § 2.6.

(b) If the affidavit or declaration is not filed within the time periods set forth in section 8 of the Act, or if it is filed within that period by someone other than the owner, the registration will be cancelled. These deficiencies cannot be cured.

47. Revise § 2.165 to read as follows:

§ 2.165 Petition to Commissioner to review refusal.

(a) A response to the examiner's initial refusal to accept an affidavit or declaration is required before filing a petition to the Commissioner, unless the examiner directs otherwise. See § 2.163(b) for the deadline for responding to an examiner's Office action.

(b) If the examiner maintains the refusal of the affidavit or declaration, a petition to the Commissioner to review the action may be filed. The petition must be filed within six months of the mailing date of the action maintaining the refusal, or the Office will cancel the registration and issue a notice of the cancellation.

(c) A decision by the Commissioner is necessary before filing an appeal or commencing a civil action in any court.

48. Revise § 2.166 to read as follows:

§ 2.166 Affidavit of continued use or excusable nonuse combined with renewal application.

An affidavit or declaration under section 8 of the Act and a renewal application under section 9 of the Act may be combined into a single document, provided that the document meets the requirements of both sections 8 and 9 of the Act.

49. Amend § 2.167 by revising paragraph (c) to read as follows:

§ 2.167 Affidavit or declaration under section 15.

* * * * *

(c) Recite the goods or services stated in the registration on or in connection with which the mark has been in continuous use in commerce for a period of five years after the date of registration or date of publication under section 12(c) of the Act, and is still in use in commerce;

* * * * *

50. Revise § 2.168 to read as follows:

§ 2.168 Affidavit or declaration under section 15 combined with affidavit or declaration under section 8, or with renewal application.

(a) The affidavit or declaration filed under section 15 of the Act may also be used as the affidavit or declaration required by section 8, if the affidavit or declaration meets the requirements of both sections 8 and 15.

(b) The affidavit or declaration filed under section 15 of the Act may be combined with an application for renewal of a registration under section 9 of the Act, if the requirements of both sections 9 and 15 are met.

51. Amend § 2.173 by revising the heading and paragraph (a) to read as follows:

§ 2.173 Amendment of registration.

(a) The registrant may apply to amend the registration or to disclaim part of the mark in the registration. A written request specifying the amendment or disclaimer must be submitted. The request must be signed by the registrant and verified or supported by a declaration under § 2.20, and accompanied by the required fee. If the amendment involves a change in the mark, a new specimen showing the mark as used on or in connection with the goods or services, and a new drawing of the amended mark, must be submitted. The certificate of registration or, if the certificate is lost or destroyed, a certified copy of the certificate, must also be submitted. The registration as amended must still contain registrable matter, and the mark as amended must be registrable as a whole. An amendment or disclaimer must not materially alter the character of the mark.

* * * * *

52. Amend § 2.181 by revising paragraph (a) to read as follows:

§ 2.181 Term of original registrations and renewals.

(a)(1) Subject to the provisions of section 8 of the Act requiring an affidavit or declaration of continued use or excusable nonuse, registrations issued or renewed prior to November 16, 1989, whether on the Principal Register or on the Supplemental Register, remain in force for twenty years from their date of issue or the date of renewal, and may be further renewed for periods of ten years, unless previously cancelled or surrendered.

(2) Subject to the provisions of section 8 of the Act requiring an affidavit or declaration of continued use or excusable nonuse, registrations issued or renewed on or after November 16, 1989, whether on the Principal Register or on the Supplemental Register, remain in force for ten years from their date of issue or the date of renewal, and may be further renewed for periods of ten years, unless previously cancelled or surrendered.

* * * * *

53. Revise § 2.182 to read as follows:

§ 2.182 Time for filing renewal application.

An application for renewal must be filed within one year before the expiration date of the registration, or within the six-month grace period after the expiration date of the registration. If

no renewal application is filed within this period, the registration will expire.

54. Revise § 2.183 to read as follows:

§ 2.183 Requirements for a complete renewal application.

A complete renewal application must include:

- (a) A request for renewal of the registration, signed by the registrant or the registrant's representative;
- (b) The fee required by § 2.6 for each class;
- (c) The additional fee required by § 2.6 for each class if the renewal application is filed during the six-month grace period set forth in section 9(a) of the Act;
- (d) If the registrant is not domiciled in the United States, the name and address of a United States resident on whom notices or process in proceedings affecting the registration may be served; and
- (e) If the renewal application covers less than all the goods or services in the registration, a list of the particular goods or services to be renewed.

(f) If at least one fee is submitted for a multi-class registration, but the class(es) to which the fee(s) should be applied are not specified, the Office will issue a notice requiring either the submission of additional fee(s) or an indication of the class(es) to which the original fee(s) should be applied. Additional fee(s) may be submitted if the requirements of § 2.185 are met. If the required fee(s) are not submitted and the class(es) to which the original fee(s) should be applied are not specified, the Office will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class.

55. Revise § 2.184 to read as follows:

§ 2.184 Refusal of renewal.

- (a) If the renewal application is not acceptable, the Office will issue a notice stating the reason(s) for refusal.
- (b) A response to the refusal of renewal must be filed within six months of the mailing date of the Office action, or before the expiration date of the registration, whichever is later, or the registration will expire.
- (c) If the renewal application is not filed within the time periods set forth in section 9(a) of the Act, the registration will expire.

56. Add § 2.185 to read as follows:

§ 2.185 Correcting deficiencies in renewal application.

(a) If the renewal application is filed within the time periods set forth in section 9(a) of the Act, deficiencies may be corrected, as follows:

(1) *Correcting deficiencies in renewal applications filed within one year before the expiration date of the registration.* If the renewal application is filed within one year before the expiration date of the registration, deficiencies may be corrected before the expiration date of the registration without paying a deficiency surcharge. Deficiencies may be corrected after the expiration date of the registration with payment of the deficiency surcharge required by section 9(a) of the Act and § 2.6.

(2) *Correcting deficiencies in renewal applications filed during the grace period.* If the renewal application is filed during the six-month grace period, deficiencies may be corrected before the expiration of the grace period without paying a deficiency surcharge. Deficiencies may be corrected after the expiration of the grace period with payment of the deficiency surcharge required by section 9(a) of the Act and § 2.6.

(b) If the renewal application is not filed within the time periods set forth in section 9(a) of the Act, the registration will expire. This deficiency cannot be cured.

57. Add § 2.186 to read as follows:

§ 2.186 Petition to Commissioner to review refusal of renewal.

(a) A response to the examiner's initial refusal of the renewal application is required before filing a petition to the Commissioner, unless the examiner directs otherwise. See § 2.184(b) for the deadline for responding to an examiner's Office action.

(b) If the examiner maintains the refusal of the renewal application, a petition to the Commissioner to review the refusal may be filed. The petition must be filed within six months of the mailing date of the Office action maintaining the refusal, or the renewal application will be abandoned and the registration will expire.

(c) A decision by the Commissioner is necessary before filing an appeal or commencing a civil action in any court.

PART 3—ASSIGNMENT, RECORDING AND RIGHTS OF ASSIGNEE

58. The authority citation for part 3 continues to read as follows:

Authority: 15 U.S.C. 1123; 35 U.S.C. 6, unless otherwise noted.

59. Revise § 3.16 to read as follows:

§ 3.16 Assignability of trademarks prior to filing of an allegation of use.

Before an allegation of use under either 15 U.S.C. 1051(c) or 15 U.S.C. 1051(d) is filed, an applicant may only assign an application to register a mark

under 15 U.S.C. 1051(b) to a successor to the applicant's business, or portion of the business to which the mark pertains, if that business is ongoing and existing.

60. Amend § 3.24 by revising the heading to read as follows:

§ 3.24 Requirements for documents and cover sheets relating to patents and patent applications.

* * * * *

61. Add § 3.25 to read as follows:

§ 3.25 Recording requirements for trademark applications and registrations.

(a) *Documents affecting title.* To record documents affecting title to a trademark application or registration, a legible cover sheet (see § 3.31) and one of the following must be submitted:

- (1) The original document;
- (2) A copy of the document;
- (3) A copy of an extract from the document evidencing the effect on title;

or

(4) A statement signed by both the party conveying the interest and the party receiving the interest explaining how the conveyance affects title.

(b) *Name changes.* Only a legible cover sheet is required (See § 3.31).

(c) *All documents.* All documents submitted to the Office should be on white and non-shiny paper that is no larger than 8½ × 14 inches (21.6 × 33.1 cm.) with a one-inch (2.5 cm) margin on all sides. Only one side of each page should be used.

62. Revise § 3.28 to read as follows:

§ 3.28 Requests for recording.

Each document submitted to the Office for recording must include at least one cover sheet as specified in § 3.31 referring either to those patent applications and patents, or to those trademark applications and registrations, against which the document is to be recorded. If a document to be recorded includes interests in, or transactions involving, both patents and trademarks, separate patent and trademark cover sheets should be submitted. Only one set of documents and cover sheets to be recorded should be filed. If a document to be recorded is not accompanied by a completed cover sheet, the document and the incomplete cover sheet will be returned pursuant to § 3.51 for proper completion. The document and a completed cover sheet should be resubmitted.

63. Amend § 3.31 by revising paragraphs (a) and (b) and by adding paragraphs (d) and (e) to read as follows:

§ 3.31 Cover sheet content.

(a) Each patent or trademark cover sheet required by § 3.28 must contain:

(1) The name of the party conveying the interest;

(2) The name and address of the party receiving the interest;

(3) A description of the interest conveyed or transaction to be recorded;

(4) Identification of the interests involved:

(i) *For trademark assignments and trademark name changes:* Each trademark registration number and each trademark application number, if known, against which the Office is to record the document. If the trademark application number is not known, a copy of the application or a reproduction of the trademark must be submitted, along with an estimate of the date that the Office received the application; or

(ii) *For any other document affecting title to a trademark or patent application, registration or patent:* Each trademark or patent application number or each trademark registration number or patent against which the document is to be recorded, or an indication that the document is filed together with a patent application;

(5) The name and address of the party to whom correspondence concerning the request to record the document should be mailed;

(6) The date the document was executed;

(7) An indication that the assignee of a trademark application or registration who is not domiciled in the United States has designated a domestic representative (see § 3.61); and

(8) The signature of the party submitting the document.

(b) A cover sheet should not refer to both patents and trademarks, since any information, including information about pending patent applications, submitted with a request for recordation of a document against a trademark application or trademark registration will become public record upon recordation.

* * * * *

(d) Each trademark cover sheet required by § 3.28 seeking to record a document against a trademark application or registration should include, in addition to the serial number or registration number of the trademark, identification of the trademark or a description of the trademark, against which the Office is to record the document.

(e) Each patent or trademark cover sheet required by § 3.28 should contain the number of applications, patents or registrations identified in the cover sheet and the total fee.

PART 6—CLASSIFICATION OF GOODS AND SERVICES UNDER THE TRADEMARK ACT

64. The authority citation for part 6 continues to read as follows:

Authority: 15 U.S.C. 1112, 1123; 35 U.S.C. 6, unless otherwise noted.

65. Revise § 6.1 to read as follows:

§ 6.1 International schedule of classes of goods and services.

Goods

1. Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins; unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.

2. Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.

3. Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

4. Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles, wicks.

5. Pharmaceutical, veterinary, and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

6. Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; nonelectric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores.

7. Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs.

8. Hand tools and implements (hand-operated); cutlery; side arms; razors.

9. Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire extinguishing apparatus.

10. Surgical, medical, dental, and veterinary apparatus and instruments, artificial limbs, eyes, and teeth; orthopedic articles; suture materials.

11. Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply, and sanitary purposes.

12. Vehicles; apparatus for locomotion by land, air, or water.

13. Firearms; ammunition and projectiles; explosives; fireworks.

14. Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewelry, precious stones; horological and chronometric instruments.

15. Musical instruments.

16. Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks.

17. Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal.

18. Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

19. Building materials (non-metallic); nonmetallic rigid pipes for building; asphalt, pitch and bitumen; nonmetallic transportable buildings; monuments, not of metal.

20. Furniture, mirrors, picture frames; goods (not included in other classes) of

wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.

21. Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush making materials; articles for cleaning purposes; steel wool; unworked or semi worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

22. Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials.

23. Yarns and threads, for textile use.

24. Textiles and textile goods, not included in other classes; beds and table covers.

25. Clothing, footwear, headgear.

26. Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.

27. Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non textile).

28. Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

29. Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats.

30. Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

31. Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals; malt.

32. Beers; mineral and aerated waters and other nonalcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

33. Alcoholic beverages (except beers).

34. Tobacco; smokers' articles; matches.

Services

35. Advertising; business management; business administration; office functions.

36. Insurance; financial affairs; monetary affairs; real estate affairs.

37. Building construction; repair; installation services.

38. Telecommunications.

39. Transport; packaging and storage of goods; travel arrangement.

40. Treatment of materials.

41. Education; providing of training; entertainment; sporting and cultural activities.

42. Providing of food and drink; temporary accommodation; medical, hygienic and beauty care; veterinary and agricultural services; legal services; scientific and industrial research; computer programming; services that cannot be classified in other classes.

Dated: August 30, 1999.

Q. Todd Dickinson,

Acting Assistant Secretary of Commerce and Acting Commissioner of Patents and Trademarks.

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