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### 101 Applicable Authority

#### 101.01 Statute and Rules of Practice

All proceedings before the Trademark Trial and Appeal Board ("TTAB" or "Board") are governed by the Trademark Act of 1946 ("Act of 1946" or "Act"), 15 U.S.C. §1051 et seq.; the rules of practice in trademark cases (commonly known as the Trademark Rules of Practice), which may be found in Part 2 of Title 37 of the Code of Federal Regulations ("CFR"); the rules pertaining to assignments in trademark cases, which may be found in Part 3 of 37 CFR; and the rules relating to representation of others before the Patent and Trademark Office, which may be found in Part 10 of 37 CFR. In addition, Trademark Rule 2.1, 37 CFR §2.1, makes applicable to trademark cases certain rules from Part 1 of 37 CFR, which contains the rules of practice in patent cases. The PTO rules governing procedure in inter partes proceedings before the Board are adapted, in large part, from the Federal Rules of Civil Procedure, with modifications due primarily to the administrative nature of Board proceedings. *See Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988).

A copy of 37 CFR may be obtained at a nominal cost from the U.S. Government Printing Office. Price and ordering information may be obtained by calling (202) 512-1800. Written orders sent by mail should be sent to the U.S. Government Printing Office, Superintendent of Documents, P.O. Box 371954, Pittsburgh, PA 15250-7954. In addition, orders or inquiries may be submitted by fax to (202) 512-2250.

#### 101.02 Federal Rules

Inter partes proceedings before the Board are also governed by the Federal Rules of Civil Procedure ("FRCP"), except as otherwise provided in the Trademark Rules of Practice, and wherever applicable and appropriate; and by the Federal Rules of Evidence ("FRE"). *See* 37 CFR §§2.116, 2.120(a), and 2.122(a).

There is no provision in the Trademark Rules of Practice concerning the applicability of the Federal Rules of Evidence to ex parte appeals before the Board. Certain of the principles embodied in the Federal Rules of Evidence are

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applied by the Board, in practice, in evaluating the probative value of evidence submitted in ex parte cases. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re American OleanTile Co.*, 1 USPQ2d 1823 (TTAB 1986); and *In re Foundry Products, Inc.*, 193 USPQ 565 (TTAB 1976). For information concerning the treatment of evidence in Board ex parte proceedings, see TBMP §1208, and authorities cited therein.

### 101.03 Decisional Law

Proceedings before the Board are also governed, to a large extent, by published decisions in prior cases. These decisions include not only the decisions of the Board itself, but also the decisions of the Court of Appeals for the Federal Circuit (which determines appeals from decisions of the Board); the Court of Customs and Patent Appeals (predecessor of the Court of Appeals for the Federal Circuit); and the Commissioner (who determines petitions seeking review of Board actions on procedural matters).

Decisions of the Board, the Commissioner, and the Court of Appeals for the Federal Circuit may or may not be designated for publication. Those decisions which are designated for publication are published in the *United States Patent Quarterly* ("USPQ"), a periodical publication of The Bureau of National Affairs, Inc., Washington, D.C. They may also be found in Mead Data Central, Inc.'s "LEXIS" legal data base, and in the Intellectual Property Library of West Publishing Company's WESTLAW data base.

Decisions which are designated for publication in full are citable as precedent. Decisions which are not designated for publication, or which are designated for publication only in digest form, are not citable as precedent, even if a complete copy of the unpublished or digest decision is submitted. See *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270 (TTAB 1992); *In re American Olean Tile Co.*, 1 USPQ2d 1823 (TTAB 1986); *Marcon, Ltd. v. Merle Norman Cosmetics, Inc.*, 221 USPQ 644 (TTAB 1984); and *Roberts Proprietaries, Inc. v. Rumby International, Inc.*, 212 USPQ 302 (TTAB 1981). See also *Franklin Pierce Law Center v. Georgetown University*, 14 USPQ2d 1255, Editor's Note at 1256 (Fed. Cir. 1990). An unpublished or digest decision will, however, be considered in determining issues of claim preclusion, issue preclusion, judicial estoppel, law of the case, or the like, provided that (1) a party to the pending Board proceeding, or

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its privy, was also a party to the prior proceeding, and (2) a complete copy of the decision is submitted. *See General Mills Inc. v. Health Valley Foods, supra.*

### 101.04 Commissioner's Orders and Notices

Occasionally, the Commissioner of Patents and Trademarks, or another PTO official acting under the Commissioner's authority, publishes in the *Official Gazette* an Order or Notice relating to a particular PTO policy, practice, procedure, or other such matter of interest to the public. Some of these Orders and Notices affect practice and procedure before the Trademark Trial and Appeal Board. One example is a Commissioner's Notice announcing the late mailing of an issue of the *Official Gazette* and the consequent change in the time for opposing marks published therein, pursuant to Section 12(a) of the Act, 15 U.S.C. §1062(a), for purposes of opposition. *See* TBMP §202.03.

## 102 Nature of Board Proceedings

### 102.01 Jurisdiction of Board

The Trademark Trial and Appeal Board is an administrative tribunal of the United States Patent and Trademark Office. The Board is empowered to determine only the right to register. *See* Sections 17, 18, 20, and 24 of the Act of 1946, 15 U.S.C. §§1067, 1068, 1070, and 1092.

The Board is not authorized to determine the right to use, nor may it decide broader questions of infringement or unfair competition. *See Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477 (Fed. Cir. 1990) [Board cannot adjudicate unfair competition issues; function of Board is to determine whether there is a right to secure or to maintain a registration]; *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768 (TTAB 1994) [Board has no jurisdiction over claims of trademark infringement and unfair competition]; *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460 (TTAB 1992) [Board is not empowered to render declaratory judgment that one party's use of mark is not an infringement of mark of other party]; *Devries v. NCC Corp.*, 227 USPQ 705 (TTAB 1985) [dilution and tarnishment are not matters which may be entertained by the Board as grounds for cancellation]; *Andersen Corp. v. Therm-O-Shield Int'l, Inc.*, 226

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USPQ 431 (TTAB 1985) [Board may not entertain any claim based on Section 43(a) of the Act, 15 U.S.C. 1125(a)]; *Electronic Water Conditioners, Inc. v. Turbomag Corp.*, 221 USPQ 162 (TTAB 1984) [unfair competition and Section 43(a) claims are outside the jurisdiction of the Board]; *Hershey Foods Corp. v. Cerreta*, 195 USPQ 246 (TTAB 1977) [determination of whether opposer is guilty of unfair business practices is not within the province of the Board]; *Yasutomo & Co. v. Commercial Ball Pen Co.*, 184 USPQ 60 (TTAB 1974) [Board does not have jurisdiction to address itself to anti-trust issues]; and *American-International Travel Service, Inc. v. AITS, Inc.*, 174 USPQ 175 (TTAB 1972) [Board is without jurisdiction to determine whether opposer violated criminal statute]. *But see Loglan Institute Inc. v. Logical Language Group Inc.*, 962 F.2d 1038, 22 USPQ2d 1531 (Fed. Cir. 1992) [Board may have erred in stating that it lacked jurisdiction over equitable defenses which were based on allegations of trademark infringement and unfair competition, but error was harmless because equitable defenses are not applicable against claim that mark is generic]; *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983) [although other courts would be the proper tribunals in which to litigate a cause of action for enforcement or breach of contract, that is not sufficient reason for the Board to decline to consider an agreement, its construction, or its validity if necessary to decide the issues properly before it, including the issue of estoppel]; and *Knickerbocker Toy Co. v. Faultless Starch Co.*, 467 F.2d 501, 175 USPQ 417 (CCPA 1972) [Board has no jurisdiction over the issues raised by the pleadings insofar as they allege copyright infringement, unfair competition, and the like, but Board is not precluded from passing on the validity of a copyright if it is necessary to do so in the course of the exercise of its statutory jurisdiction]. *See also Scotch Whiskey Ass'n v. United States Distilled Products Co.*, 13 USPQ2d 1711 (TTAB 1989), recon. denied, 17 USPQ2d 1240 (TTAB 1990) [Board cannot consider claims of unfair competition standing alone, but can consider such claims in determining the registrability of a mark, that is, in determining a separate, properly pleaded ground for opposition or cancellation], dismissed, *Scotch Whiskey Ass'n v. United States Distilled Products Co.*, 18 USPQ2d 1391 (TTAB 1991) [because petitioner has not pleaded a separate ground on which to base the petition to cancel, petitioner's claims under Articles 10 and 10bis of the Paris Convention cannot be considered by Board], *rev'd on other grounds*, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991).

Similarly, the Board, being an administrative tribunal, has no authority to declare any portion of the Act of 1946, or any other act of Congress, unconstitutional. *See Harjo v. Pro Football Inc.*, 30 USPQ2d 1828 (TTAB 1994), and *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991).

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### 102.02 Types of Board Proceedings

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

An opposition is a proceeding in which the plaintiff seeks to prevent the issuance of a registration of a mark on the Principal Register. "Any person who believes that he would be damaged by the registration" of a mark may file an opposition thereto, but the opposition may be filed only in response to the publication of the mark, under Section 12(a) of the Act, in the *Official Gazette* of the Patent and Trademark Office ("PTO"). See Section 13 of the Act of 1946, 15 U.S.C. §1063.

A cancellation proceeding is a proceeding in which the plaintiff seeks to cancel an existing registration of a mark. The proceeding may only be filed after the issuance of the registration. A petition for cancellation may be filed by "any person who believes that he is or will be damaged by the registration" of the mark. See Sections 14 and 24 of the Act of 1946, 15 U.S.C. §§1064 and 1092.

An interference is a proceeding in which the Board determines which, if any, of the owners of conflicting applications (or of one or more applications and one or more registrations which are in conflict), is entitled to registration. See Section 18 of the Act, 15 U.S.C. §1068. The proceeding is declared by the PTO only upon petition to the Commissioner showing extraordinary circumstances therefor, that is, that the party who filed the petition would be unduly prejudiced without an interference. See Section 16 of the Act of 1946, 15 U.S.C. §1066; 37 CFR §2.91; and TBMP §1002. An interference which has been declared by the Commissioner is not instituted by the Board until after all of the marks which are to be involved in the proceeding have been published in the *Official Gazette* for opposition. See TBMP §1003. For further information concerning interference proceedings, see TBMP chapter 1000.

A concurrent use proceeding is a proceeding in which the Board determines whether one or more applicants is entitled to a concurrent registration, that is, a registration with conditions and limitations, fixed by the Board, as to the mode or place of use of the applicant's mark or the goods and/or services on or in connection with which the mark is used (usually, a concurrent registration is restricted as to the territory which it covers). See TBMP §1101.01, and authorities

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cited therein. The proceeding may be generated only through the filing of an application for registration as a lawful concurrent user, and is instituted by the Board only after each of the one or more involved applications has been published for opposition in the *Official Gazette*, and all oppositions thereto (if any) have been withdrawn or dismissed. *See* TBMP §§1102.01 and 1105, and authorities cited therein. For further information concerning concurrent use proceedings, *see* TBMP chapter 1100.

The Board also has jurisdiction over ex parte appeals, that is, appeals from an Examining Attorney's final refusal to register a mark in an application. *See* Sections 12(b) and 20 of the Act of 1946, 15 U.S.C. §§1062(b) and 1070; 37 CFR §§2.141 and 2.142; and TBMP chapter 1200.

### 102.03 General Description of Board Proceedings

An inter partes proceeding before the Board is very similar to a civil action in a Federal district court. There are pleadings (at least in an opposition or cancellation proceeding); a wide range of possible motions; discovery; testimony periods; briefs; and an oral hearing (if requested), followed by a decision on the case. However, because the Board is an administrative tribunal, its rules and procedures necessarily differ in some respects from those prevailing in the Federal district courts. *See Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988). *See also La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234 (Comm'r 1976). *Cf.* TBMP §§502.01 and 702. The principal difference is that proceedings before the Board are conducted in writing, and the Board's actions in a particular case are based upon the written record therein. For example, the Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. Indeed, a party to a proceeding before the Board need never come to the offices of the Board at all, unless the Board requests that the parties meet with the Board at its offices for a pre-trial conference pursuant to 37 CFR §2.120(i)(2), or unless the party wishes to argue its case at oral hearing (an oral hearing is held only if requested by a party to the proceeding).

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



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The Board includes both interlocutory attorneys, and administrative trademark judges (known also as Board members). Interlocutory motions, requests, and other matters not actually or potentially dispositive of a proceeding may be acted upon by a single Board judge, or by a single interlocutory attorney to whom such authority has been delegated. *See* 37 CFR §2.127(c). Decisions on the case, and on potentially dispositive motions, are rendered by a panel of at least three Board judges. *See* Section 17 of the Act, 15 U.S.C. §1067.

### 103 Location and Address of Board

The Board is located at 2900 Crystal Drive, Ninth Floor, Arlington, Virginia 22202-3513. The mailing address of the Board, however, is Box TTAB No Fee (or Box TTAB Fee), Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513. If papers are not accompanied by a fee, "Box TTAB No Fee" should be used. If papers are accompanied by a fee, "Box TTAB Fee" should be used.

### 104 Business to be Conducted in Writing

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

All business with the Board should be transacted in writing. The personal attendance of parties or their attorneys or other authorized representatives at the offices of the Board is unnecessary, except in the case of a pre-trial conference as provided in 37 CFR §2.120(i)(2), or upon oral argument at final hearing, if a party so desires, as provided in 37 CFR §2.129. Decisions of the Board will be based exclusively on the written record before it. *Cf. In re Sovran Financial Corp.*, 25 USPQ2d 1537 (Comm'r 1992); *In re Merck & Co.*, 24 USPQ2d 1317 (Comm'r 1992); and *In re Investigacion Y Desarrollo de Cosméticos S.A.*, 19 USPQ2d 1717 (Comm'r 1991).

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### 105 Contact With Board Personnel

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

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

Parties or their attorneys or other authorized representatives may telephone the Board, or come to the offices of the Board, to inquire about the status of a case or to ask for procedural information, but not to discuss the merits of a case or of any particular issue. The telephone number of the Board is (703) 308-9300. If an inquiry involves a particular case, the person making the inquiry should be prepared to give the number of the proceeding or application in question.

### 106 Identification, Signature, and Form of Papers

#### 106.01 Identification of Papers

A paper filed in a proceeding before the Board should bear at its top the heading "IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD," followed by the name and number of the inter partes proceeding (or, in the case of an ex parte appeal, the application) to which it relates. *Cf.* 37 CFR §1.5(c). The paper should also include a title describing its nature, i.e., "Notice of Opposition," "Answer," "Motion to Compel," "Brief in Opposition to Respondent's Motion for Summary Judgment," "Notice of Reliance," etc.

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Papers filed in an application which is the subject of an inter partes proceeding before the Board should be filed with the Board, and should bear at the top of its first page both the application serial number, and the inter partes proceeding number and title. Similarly, requests under Section 7 of the Act, 15 U.S.C. §1057, to amend, correct, or surrender a registration which is the subject of a Board inter partes proceeding, and any new power of attorney, designation of domestic representative, or change of address submitted in connection with such a registration, should be filed with the Board, and should bear at the top of its first page both the registration number, and the inter partes proceeding number and title. *Cf.* 37 CFR §1.5(c).

### 106.02 Signature of Papers

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

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

**37 CFR §10.18(a)** *Except where a copy, including a photocopy or facsimile transmission, of a personally signed piece of correspondence is permitted to be filed pursuant to §1.4 of this chapter, every piece of correspondence filed by a practitioner on behalf of himself or herself or representing an applicant or a party to a proceeding in the Patent and Trademark Office must bear an original signature personally signed in permanent ink by such practitioner except for correspondence which is required to be signed by the applicant or party. The signature of a practitioner on correspondence filed by the practitioner, regardless of whether the correspondence has an original signature or is a copy, including a*

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*photocopy or facsimile transmission, of correspondence bearing an original signature, constitutes a certificate that:*

- (1) The correspondence has been read by the practitioner;*
- (2) The filing of the correspondence is authorized;*
- (3) To the best of practitioner's knowledge, information, and belief, there is good ground to support the correspondence, including any allegations of improper conduct contained or alleged therein; and*
- (4) The correspondence is not interposed for delay.*

*(b) Any practitioner knowingly violating the provisions of this section is subject to disciplinary action. See §10.23(c)(15).*

**37 CFR §1.4(d)** *Each piece of correspondence, except as provided in paragraphs (e) and (f) of this section, filed in a patent or trademark application, reexamination proceeding, patent or trademark interference proceeding, patent file or trademark registration file, trademark opposition proceeding, trademark cancellation proceeding, or trademark concurrent use proceeding, which requires a person's signature, must either:*

- (1) be an original, that is, have an original signature personally signed in permanent ink by that person; or*
- (2) be a copy, such as a photocopy or facsimile transmission (§1.6(d)), or 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 Patent and Trademark Office may require submission of the original.*

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

Every paper filed in an inter partes or ex parte proceeding before the Board, and every request for an extension of time to file an opposition, must be personally signed by the party filing it, or by the party's attorney or other authorized representative, as appropriate. *See* 37 CFR §§1.4(d); 2.119(e); and 10.18(a).

A party may act in its own behalf in a proceeding before the Board, or the party may be represented by an attorney or other authorized representative. *See* 37 CFR §10.14, and TBMP §114.01. *Cf.* 37 CFR §2.11. When an individual who is a party to a Board proceeding elects to act in his or her own behalf, the individual must sign any papers which he or she files with the Board. If a party which is a partnership elects to act in its own behalf, papers filed by the partnership should be

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signed by a partner. If a party which is a corporation or association elects to act in its own behalf, papers filed by the corporation or association should be signed by an officer thereof who is authorized to sign for the corporation or association. *See* 37 CFR §10.14(e).

If a paper is filed on behalf of a party by the party's attorney or other authorized representative, it must bear the signature of, and be personally signed by, that attorney or other representative, unless it is a paper required to be signed by the party. An attorney or other authorized representative who signs a paper, and then files it with the Board on behalf of a party, should remember that his or her signature to the paper constitutes a certification of the elements specified in 37 CFR §10.18(a), and that a knowing violation of the provisions of that rule by an attorney or other authorized representative will leave him or her open to disciplinary action. *See* 37 CFR §10.18. *Cf.* FRCP 11. For information concerning the meaning of the designation "other authorized representative," *see* TBMP §114.04.

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

It is not appropriate for one person to sign a paper for another person, as, for example, "John Smith, for John Doe" or "John Doe, by John Smith." *See* 37 CFR §§2.119(e) and 10.18(a); *In re Cowan*, 18 USPQ2d 1407 (Comm'r 1990); and *Cerveceria India Inc. v. Cerveceria Centroamericana, S.A.*, 10 USPQ2d 1064 (TTAB 1989), *aff'd Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989).

Either the original of the personally signed paper, or a legible copy thereof, may be filed with the Board. If a copy is filed, the original should be retained as evidence of authenticity. If a question as to the authenticity of a filed copy arises,

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the PTO may require submission of the original. *See* 37 CFR §1.4(d). For information concerning fax copies, *see* TBMP §107.

Notwithstanding the requirement that a paper filed before the Board be signed, an unsigned paper will not be refused consideration if a signed copy is submitted to the Board within the time limit set in the notification of this defect by the Board. *See* 37 CFR §2.119(e). Similarly, a telegram, being in effect an unsigned paper, will not be refused consideration if the subject matter thereof is subsequently presented in a properly signed paper filed within the time limit set by the Board in its notification of the defect.

### 106.03 Form of Papers

Apart from proper identification and signature, there is no particular form which papers filed in proceedings before the Board must follow. Nor does the PTO have printed forms for any papers filed in such proceedings. As an aid to litigants, however, the PTO has prepared suggested formats for certain types of papers filed in Board proceedings. These include the notice of opposition, petition for cancellation, notice of appeal to the Board, designation of domestic representative, certificate of mailing or certificate of transmission under 37 CFR §1.8(a), and certificate of "Express Mail" under 37 CFR §1.10. Copies of these formats are included in this manual at the place where the particular type of paper or certificate is discussed (e.g., the suggested format for a notice of opposition is included in the chapter on pleadings), as well as in an appendix to the manual.

A paper filed with the Board may be either the original or a legible copy thereof, on good quality paper. *See*, with respect to fax copies: TBMP §107. Ordinarily, extra copies of a paper should not be submitted. *See SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707 (TTAB 1994). However, in inter partes cases, briefs at final hearing must be submitted in triplicate (*see* 37 CFR §2.128(b)); stipulations to extend trial dates should be submitted in multiple form, i.e., one copy for the Board proceeding file plus as many other copies as there are parties (*see* 37 CFR §2.121(d)); and the notice of opposition and petition for cancellation must be submitted in duplicate (*see* 37 CFR §§2.104(a) and 2.112(a)). In addition, requests for extensions of time to oppose should be filed in triplicate (*see* 37 CFR §2.102(e)).

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With the exception of deposition transcripts, exhibits thereto, and inter partes briefs on the case, papers filed with the Board should not be bound. Proceeding papers, with the noted exceptions, are placed by the Board on the prongs of the proceeding file to which they pertain. *See* TBMP §120.01. If proceeding papers, other than the noted exceptions, are filed in bound form, the Board must remove the binding in order to place the papers on the proceeding file prongs. Because of their size, deposition transcripts, exhibits thereto, and inter partes briefs on the case are not kept by the Board on proceeding file prongs, and thus may be filed in bound form.

Briefs at final hearing in inter partes cases, and appeal briefs in ex parte cases, are required to be submitted in typewritten or printed form, double spaced, on letter-size paper. *See* 37 CFR §§2.128(b) and 2.142(b)(2). The Board prefers that other papers, too, be submitted in typewritten or printed form, double spaced. Although other papers may be submitted on either legal or letter-size paper, letter-size paper is recommended. This is the size preferred by many Federal district courts, and their size preference is significant because review of a final decision of the Board may be had either by way of appeal to the Court of Appeals for the Federal Circuit or by way of civil action in a Federal district court. *See* Section 21 of the Act of 1946, 15 U.S.C. §1071; 37 CFR §2.145; and TBMP §§901-903.

### 107 How and Where to File Papers and Fees

#### ***37 CFR §1.6 Receipt of correspondence.***

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

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

*(1) No correspondence is received in the Patent and Trademark Office on Saturdays, Sundays or Federal holidays within the District of Columbia;*

*(2) Correspondence filed in accordance with §1.10 will be stamped with the date of deposit as "Express Mail" with the United States Postal Service unless the date of deposit is a Saturday, Sunday, or Federal holiday within the District of Columbia in which case the date stamped will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia;*

*(3) Correspondence transmitted by facsimile to the Patent and Trademark Office will be stamped with the date on which the complete transmission is received in the Patent and Trademark Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the date*

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*stamped will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.*

***(b) Patent and Trademark Office Post Office pouch.***

*Mail placed in the Patent and Trademark Office pouch up to midnight on any day, except Saturdays, Sundays and Federal holidays within the District of Columbia, by the post office at Washington, D.C. serving the Patent and Trademark Office, is considered as having been received in the Patent and Trademark Office on the day it was so placed in the pouch by the U.S. Postal Service.*

***(c) Correspondence delivered by hand.***

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

***(d) Facsimile transmission.***

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

- (1) Correspondence as specified in §1.4(e), requiring an original signature;*
- (2) Certified documents as specified in §1.4(f);*
- (3) Correspondence which cannot receive the benefit of the certificate of mailing or transmission as specified in §1.8(a)(2)(i)(A) through (D) and (F); 1.8(a)(2)(ii)(A) and (D); and 1.8(a)(2)(iii)(A);*
- (4) Drawings submitted under §§1.81, 1.83 through 1.85, 1.152, 1.165, 1.174, 1.437, 2.51, 2.52, or 2.72;*
- (5) A request for reexamination under §1.510;*



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(6) *Correspondence to be filed in a patent application subject to a secrecy order under §§5.1 through 5.8 of this chapter and directly related to the secrecy order content of the application;*

(7) *Requests for cancellation or amendment of a registration under section 7(e) of the Trademark Act, 15 U.S.C. 1057(e); and certificates of registration surrendered for cancellation or amendment under section 7(e) of the Trademark Act, 15 U.S.C. 1057(e);*

(8) *Correspondence to be filed with the Trademark Trial and Appeal Board, except the notice of ex parte appeal;*

(9) *Correspondence to be filed in an interference proceeding which consists of a preliminary statement under §1.621; a transcript of a deposition under §1.676 or interrogatories, cross-interrogatories, or recorded answers under §1.684(c); or an evidentiary record and exhibits under §1.653.*

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

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

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

*(2) Accompanied by a statement indicating that such correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service. Such statement must be a verified statement if made by a person other than a practitioner as defined in §10.1(r) of this chapter.*

Papers relating to proceedings before the Board, and *not accompanied by a fee*, may be filed during regular office hours by delivery (by hand or by courier service) to the Board at 2900 Crystal Drive, South Tower Building, Ninth Floor, Arlington, Virginia 22202-3513; or to the Intake Processing Unit at 2900 Crystal Drive, South Tower Building, Third Floor, Room 3C06, Arlington, Virginia 22202-3513; or to the Customers' Window at 2011 S. Clark Place, Crystal Plaza Building 2, Room 1B-03, Arlington, Virginia 22202; or (by courier delivery only) to the Patent and Trademark Office Mail Room (Correspondence and Mail Division) at 2011 S. Clark Place, Crystal Plaza Building 2, Room 1A-01, Arlington, Virginia 22202 (*but delivery of papers intended for the Board to one of the Crystal Plaza Building 2 locations is not recommended, because papers delivered to these locations, rather than to one of the South Tower Building locations, may take considerably longer to reach the Board*). Such papers may

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also be filed by depositing them in the mail addressed to the Board's mailing address (Box TTAB No Fee, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513). *See "Change of Address For Trademark Applications and Trademark Related [sic] Papers," 1163 TMOG 80 (June 28, 1994).* The Board's physical address, which is subject to change, should not be used on papers sent to the Board.

Papers *accompanied by fees* may be filed by mailing them to the Board's mailing address for fee papers, i.e., Box TTAB Fee, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513. Papers with fees may also be filed by delivery (by hand or by courier service) to the Intake Processing Unit at 2900 Crystal Drive, South Tower Building, Third Floor, Room 3C06, Arlington, Virginia 22202-3513 (from which the paper will be routed in due course to the PTO's Office of Finance for handling of the fee); or to the Finance Window at 2900 Crystal Drive, South Tower Building, Third Floor, Arlington, Virginia 22202-3513 (which will record the fee as "received" or "posted" immediately and then give the paper to the Intake Processing Unit on the same floor--this procedure saves the time involved in routing a paper to the Office of Finance); or to the Customers' Window at 2011 S. Clark Place, Crystal Plaza Building 2, Room 1B-03, Arlington, Virginia 22202; or (by courier delivery only) to the Patent and Trademark Office Mail Room (Correspondence and Mail Division) at 2011 S. Clark Place, Crystal Plaza Building 2, Room 1A-01, Arlington, Virginia 22202 (*but delivery of papers intended for the Board to one of the Crystal Plaza Building 2 locations is not recommended, because papers delivered to these locations, rather than to one of the South Tower Building locations, may take considerably longer to reach the Board*).

To facilitate the handling of mail intended for the Board, the PTO has established two special box designations which may be used thereon. The box designations are as follows:

**BOX TTAB  
NO FEE**

For use on papers intended for the Board which do not include a fee, such as extension requests, motions, briefs, etc.

**BOX TTAB  
FEE**

For use on papers intended for the Board which include a fee, such as a notice of opposition, a petition for cancellation, or a notice of

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appeal in an ex parte appeal

It is strongly recommended that these box designations be used on all papers intended for the Board. Documents being sent to a TTAB box should be addressed as follows (with the designation "**BOX TTAB**" on one line, and the "**NO FEE**" or "**FEE**" indicator on the line below):

**BOX TTAB**

**FEE (or "NO FEE")**

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

For best results, the TTAB box designation, including the "FEE/NO FEE" indicator, should be used both on the mailing envelope and on the cover sheet or first page of each document intended for the Board. Preferably, envelopes addressed to a TTAB box designation should include only documents designated for the box specified on the envelope. The inclusion in a single envelope of documents destined for more than one location may cause delay in the processing of those documents. However, documents destined for more than one location may be included in a single envelope (albeit this is not the preferred practice), provided that each document bears on its cover sheet or first page its box designation, including the "FEE/NO FEE" indicator, and provided also that each complete filing is stapled or secured in some fashion. If documents destined for more than one location are included in a single envelope, all of the box designations, with "FEE/NO FEE" indicators, of the included documents should be listed on the envelope. *See "Special Boxes and 'Fee/No Fee' Indicators For Trademark-Related Mail And Guidelines For Filing Requests To Extend Time To Oppose With The Trademark Trial And Appeal Board (TTAB)," 1168 TMOG 89 (November 22, 1994).*

With the exception of the notice of appeal in an ex parte appeal, papers to be filed with the Board may not be filed by facsimile transmission ("fax"). *See* 37 CFR §1.6(d)(8). If papers other than the notice of appeal in an ex parte appeal are filed with the Board by fax transmission, they will not receive a filing date.

However, the Board will accept, and give filing dates to, fax copies of papers, when the fax copies are hand delivered to the Board, or are sent to the Board by mail or courier service. In addition, the Board may request that a party send by fax transmission a copy of a paper which has already been filed in the PTO by one

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of the acceptable methods described above, such as by mail, but which paper has not yet been received by the Board and/or entered in the proceeding file for which it is intended. The Board may make such a request when, for example, (1) a Board attorney needs a copy of the paper in order to make an immediate ruling, by telephone conference, on a motion, or (2) the Board needs to see a copy of a paper which was assertedly filed in the PTO, but which the Board does not have or cannot locate. When the Board requests that a copy of a paper be sent to the Board by fax transmission, the name of the Board employee making the request must appear on the cover sheet of the transmission, so that the Board staff member receiving the transmission will know that the transmission is authorized, and can immediately give the paper to the employee who requested it. If the name of the requesting Board employee does not appear on the cover sheet, the staff member receiving the transmission will presume that the transmission is unauthorized, and return the paper to its sender.

When correspondence allowed to be submitted by fax transmission is submitted in that manner, the requirements of 37 CFR §1.6(d) should be met. In addition, it is recommended that the fax cover sheet specify the number of pages being transmitted, and the name, address, fax number, and telephone number of the transmitting party.

A document transmitted by fax must be legible. The document that is used as the original for the fax transmission should be retained by the sender as evidence of the content of the transmission. *See* 37 CFR §1.4(d).

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

The Board's fax machines are attended between the business hours of 8:30 a.m. and 5:00 p.m., Eastern Standard Time, Monday through Friday, excluding holidays. Normally, the machines may be accessed 24 hours a day. However, there may be times when reception is not possible because of equipment failure or maintenance requirements. Accordingly, persons transmitting correspondence to the Board by fax should be cautious about relying on the availability of this

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service near time deadlines, such as the end of the six-month period for filing a notice of appeal in an ex parte appeal to the Board.

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

### 108 Filing Receipts

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

If a paper intended for the Board is delivered by hand or by courier service to the offices of the Board, or to the Intake Processing Unit at 2900 Crystal Drive, South Tower Building, Third Floor, Room 3C06, Arlington, Virginia 22202-3513, or to the Finance Window on the same floor of that building, the receipt may take the form of a postcard bearing appropriate identifying information, or a duplicate copy of the paper, or a transmittal letter with appropriate identifying information. The receipt and the paper will be date-stamped and the receipt will be handed back to the person who delivered the paper. If a paper is delivered by hand or by courier service to the Customers' Window at 2011 S. Clark Place, Crystal Plaza Building 2, Room 1B03, Arlington, Virginia 22202, the receipt may be in the form of a postcard, or, alternatively, a handwritten receipt will be furnished. If a paper is delivered by courier service to the Patent and Trademark Office Mail Room (Correspondence and Mail Division) at 2011 S. Clark Place, Crystal Plaza Building 2, Room 1A-01, Arlington, Virginia 22202, the postcard receipt must be used.

When a paper is submitted to the Board by fax transmission, the Board will not formally acknowledge receipt of the paper. However, the Board fax machine usually will confirm to the sending unit that the transmission is complete. With the exception of the notice of appeal in an ex parte appeal to the Board, papers intended for the Board may not be filed by fax transmission. *See* 37 CFR §1.6(d)(8). *See also* TBMP §107.

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### 109 Filing Date

#### **37 CFR §1.6 Receipt of correspondence.**

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

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

*(1) No correspondence is received in the Patent and Trademark Office on Saturdays, Sundays or Federal holidays within the District of Columbia;*

*(2) Correspondence filed in accordance with §1.10 will be stamped with the date of deposit as "Express Mail" with the United States Postal Service unless the date of deposit is a Saturday, Sunday, or Federal holiday within the District of Columbia in which case the date stamped will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia;*

*(3) Correspondence transmitted by facsimile to the Patent and Trademark Office will be stamped with the date on which the complete transmission is received in the Patent and Trademark Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the date stamped will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.*

##### **(b) Patent and Trademark Office Post Office pouch.**

*Mail placed in the Patent and Trademark Office pouch up to midnight on any day, except Saturdays, Sundays and Federal holidays within the District of Columbia, by the post office at Washington, D.C. serving the Patent and Trademark Office, is considered as having been received in the Patent and Trademark Office on the day it was so placed in the pouch by the U.S. Postal Service.*

##### **(c) Correspondence delivered by hand.**

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

##### **(d) Facsimile transmission.**

*Except in the cases enumerated below, correspondence, including authorizations to charge a deposit account, may be transmitted by facsimile. The receipt date accorded to the correspondence will be the date on which the complete transmission is received in the Patent and Trademark Office, unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. See*

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*§1.6(a)(3). To facilitate proper processing, each transmission session should be limited to correspondence to be filed in a single application or other proceeding before the Patent and Trademark Office. The application number of a patent or trademark application, the control number of a reexamination proceeding, the interference number of an interference proceeding, the patent number of a patent, or the registration number of a trademark should be entered as a part of the sender's identification on a facsimile cover sheet. Facsimile transmissions are not permitted and if submitted, will not be accorded a date of receipt, in the following situations:*

- (1) Correspondence as specified in §1.4(e), requiring an original signature;*
- (2) Certified documents as specified in §1.4(f);*
- (3) Correspondence which cannot receive the benefit of the certificate of mailing or transmission as specified in §1.8(a)(2)(i)(A) through (D) and (F); 1.8(a)(2)(ii)(A) and (D); and 1.8(a)(2)(iii)(A);*
- (4) Drawings submitted under §§1.81, 1.83 through 1.85, 1.152, 1.165, 1.174, 1.437, 2.51, 2.52, or 2.72;*
- (5) A request for reexamination under §1.510;*
- (6) Correspondence to be filed in a patent application subject to a secrecy order under §§5.1 through 5.8 of this chapter and directly related to the secrecy order content of the application;*
- (7) Requests for cancellation or amendment of a registration under section 7(e) of the Trademark Act, 15 U.S.C. 1057(e); and certificates of registration surrendered for cancellation or amendment under section 7(e) of the Trademark Act, 15 U.S.C. 1057(e);*
- (8) Correspondence to be filed with the Trademark Trial and Appeal Board, except the notice of ex parte appeal;*
- (9) Correspondence to be filed in an interference proceeding which consists of a preliminary statement under §1.621; a transcript of a deposition under §1.676 or interrogatories, cross-interrogatories, or recorded answers under §1.684(c); or an evidentiary record and exhibits under §1.653.*

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

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

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

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*(2) Accompanied by a statement indicating that such correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service. Such statement must be a verified statement if made by a person other than a practitioner as defined in §10.1(r) of this chapter.*

Correspondence received in the PTO is stamped with the date of receipt (i.e., the "filing" date) unless the correspondence is filed by the "Express Mail" procedure provided in 37 CFR §1.10, or by fax transmission (for correspondence which is permitted to be filed by fax) in accordance with 37 CFR §1.6(d), in which case the correspondence is date-stamped as described below. *See* 37 CFR §1.6(a). The "date of receipt" of correspondence mailed to the PTO is the date stamped by the Post Office on the mail bags in which the correspondence is delivered to the PTO. *See* 37 CFR §1.6(b), and *In re Klein*, 6 USPQ2d 1528, 1536 (Dep't Comm.. 1986).

When correspondence intended for the Board is filed by the "Express Mail Post Office to Addressee" service of the United States Postal Service *with* a certificate of mailing, in accordance with the procedure described in 37 CFR §1.10, it is stamped with the date the correspondence is shown to have been deposited with the United States Postal Service (unless the date of deposit is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the date assigned will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia). *See* 37 CFR §§1.6(a)(2) and 1.10. If the correspondence is filed by the "Express Mail Post Office to Addressee" service *without* a certificate of mailing by "Express Mail," or with a deficient certificate, *and the correspondence is actually received at the PTO bearing a clear indication on the "Express Mail" label of the "date in,"* the paper will be stamped with the "date in" as the date of receipt (unless the "date in" is a Saturday, Sunday, or Federal holiday within the District of Columbia). *See "Waiver of Certificate of Mailing Requirement Under 37 CFR 1.10,"* 1174 TMOG 92 (May 16, 1995).

If correspondence which is permitted to be filed by fax transmission to the Board is filed by that method with a certificate of transmission in accordance with 37 CFR §1.8(a), the transmission date specified in the certificate of transmission is used for purposes of determining the timeliness of the correspondence. The date of receipt, as described in 37 CFR §1.6(a)(3), is used for all other purposes. *See* 37 CFR §1.8(a). For further information concerning correspondence which may be filed by fax transmission to the Board, *see* TBMP §107.



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When correspondence intended for the Board is filed by first-class mail with a certificate of mailing, in accordance with the procedure described in 37 CFR §1.8(a), it is stamped with the date of receipt of the correspondence in the PTO, i.e., the date on the mail bags in which the correspondence is delivered to the PTO. The mailing date specified in the certificate of mailing is used for purposes of determining the timeliness of the correspondence. The date of receipt is used for all other purposes. *See* 37 CFR §§1.6(a) and 1.8(a).

For information concerning the date stamped by the PTO on correspondence when interruptions or emergencies occur in the United States Postal Service, *see* 37 CFR §1.6(e).

### 110 Certificate of Mailing or Transmission Procedure

#### 110.01 In General

##### ***37 CFR §1.8 Certificate of mailing or transmission.***

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

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

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

*(A) deposited with the U.S. Postal Service with sufficient postage as first class mail addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231; or*

*(B) transmitted by facsimile to the Patent and Trademark Office in accordance with §1.6(d); and*

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

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

*(i) Relative to Patents and Patent Applications*

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\* \* \*

### *(ii) Relative to Trademark Registrations and Trademark Applications*

*A. The filing of a trademark application;*

*B. The filing of an affidavit showing that a mark is still in use or containing an excuse for nonuse under section 8(a) or (b) or section 12(c) of the Trademark Act, 15 U.S.C. 1058(a), 1058(b), 1062(c);*

*C. The filing of an application for renewal of a registration under section 9 of the Trademark Act, 15 U.S.C. 1059;*

*D. The filing of a petition to cancel a registration of a mark under section 14, subsection (1) or (2) of the Trademark Act, 15 U.S.C. 1064;*

*E. In an application under section 1(b) of the Trademark Act, 15 U.S.C. 1051(b), the filing of an amendment to allege use in commerce under section 1(c) of the Trademark Act, 15 U.S.C. 1051(c); or the filing of a statement of use under section 1(d)(1) of the Trademark Act, 15 U.S.C. 1051(d)(1);*

*F. In an application under section 1(b) of the Trademark Act, 15 U.S.C. 1051(b), the filing of a request under section 1(d)(2) of the Trademark Act, 15 U.S.C. 1051(d)(2), for an extension of time to file a statement of use under section 1(d)(1) of the Trademark Act, 15 U.S.C. 1051(d)(1).*

### *(iii) Relative to Disciplinary Proceedings*

*A. Correspondence filed in connection with a disciplinary proceeding under Part 10 of this chapter.*

*B. Reserved.*

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

*(1) informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence,*

*(2) supplies an additional copy of the previously mailed or transmitted correspondence and certificate, and*

*(3) includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. Such statement must be a verified statement if made by a person other than a practitioner as defined in §10.1(r) of this chapter. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.*

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

Except in certain instances, specified in 37 CFR §1.8(a), as amplified by 37 CFR §1.6(d), correspondence required to be filed within a set period of time will be considered as being timely filed, even though the correspondence is not received by the PTO until after the expiration of the set period, if, prior to the expiration of the set period, (1) the correspondence is mailed to the PTO by first-class mail, with the proper address, or (for correspondence which is permitted to be filed by fax) is transmitted to the PTO by fax, in accordance with 37 CFR §1.6(d), and (2) includes a certificate of mailing or transmission which meets the requirements specified in 37 CFR §1.8(a). *See* 37 CFR §1.8(a), and *In re LS Bedding*, 16 USPQ2d 1451 (Comm'r 1990).

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

However, the PTO, in its discretion, may require additional evidence to determine if correspondence which bears a certificate of mailing or a certificate of transmission was timely filed, i.e., was mailed or transmitted on the date stated in the certificate. *See* 37 CFR §1.8(c), and *In re Klein*, 6 USPQ2d 1547 (Comm'r 1987), *aff'd sub nom. Klein v. Peterson*, 696 F. Supp. 695, 8 USPQ2d 1434 (D.D.C. 1988), *aff'd* 866 F.2d 412, 9 USPQ2d 1558 (Fed. Cir. 1989), *cert. denied*, 490 U.S. 1091, 109 S.Ct. 2432 (1989).

The certificate of mailing procedure applies to the filing of all types of correspondence in Board proceedings, except the filing of a petition to cancel a registration of a mark under Section 14(1) or 14(2) of the Act, 15 U.S.C. §1064(1) or 1064(2). *See* 37 CFR §1.8(a), and TBMP §110.07.

The certificate of transmission procedure is available in Board proceedings only for the filing of a notice of ex parte appeal to the Board. *See* 37 CFR §§1.6(d) and 1.8(a), and TBMP §107.

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### 110.02 Requirements for Certificate

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

1. *Prior to the expiration of the set period*, the correspondence must be either (i) deposited with the U.S. Postal Service, with sufficient postage as first-class mail, addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, or (ii) (for correspondence which is permitted to be filed by fax) transmitted to the PTO by fax, in the manner described in 37 CFR §1.6(d); and

2. Each piece of correspondence must include a certificate which states the date of deposit or transmission, and which is signed (separate and apart from any signature for the piece of correspondence itself) by a person who has reasonable basis to expect that the correspondence will be mailed or transmitted on or before the date indicated.

*See 37 CFR §1.8(a), and "Change of Address For Trademark Applications and Trademark Related Papers," 1163 TMOG 80 (June 28, 1994).*

Alternatively, until such time as 37 CFR §1.8 has been amended to specify that trademark-related mail (except for trademark-related documents sent to the Assignment Branch for recordation and requests for certified copies of trademark application and registration documents) must be addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, such correspondence may continue to be sent to the Commissioner of Patents and Trademarks, Washington, D.C. 20231 address. Any certificate of mailing used on correspondence sent to the Washington, D.C. address should specify that address. *See "Change of Address For Trademark Applications and Trademark Related Papers," 1163 TMOG 80 (June 28, 1994).*

Trademark-related documents sent to the Assignment Branch for recordation, and requests for certified copies of trademark application and registration documents, should be addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231. If a certificate of mailing is used on such correspondence, it should specify that address.

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

A certificate of mailing or a certificate of transmission should be clearly labeled as such.

### 110.03 Suggested Format

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

#### Certificate of Mailing

I hereby certify that this correspondence  
is being deposited with the United States  
Postal Service with sufficient postage as  
first-class mail in an envelope addressed to:

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

on \_\_\_\_\_  
Date Signature

\_\_\_\_\_  
Typed or printed name  
of person signing  
certificate

*See "Changes in Signature and Filing Requirements for Correspondence filed in the Patent and Trademark Office," 1157 TMOG 86 ( December 28, 1993), and "Change of Address For Trademark Applications and Trademark Related Papers," 1163 TMOG 80 (June 28, 1994).*

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

### **Certificate of Transmission**

I hereby certify that this correspondence is  
being facsimile transmitted to the Patent and  
Trademark Office on \_\_\_\_\_

Date .

\_\_\_\_\_  
Signature

\_\_\_\_\_  
Typed or printed name  
of person signing  
certificate

*See "Changes in Signature and Filing Requirements for Correspondence filed in the Patent and Trademark Office," 1157 TMOG 86 ( December 28, 1993).*

### **110.04 Location of Certificate**

If one of the simple certificate of mailing or certificate of transmission formats shown in TBMP §110.03 is used, it may be applied by rubber stamp to the first page of the correspondence, if feasible. Otherwise, it should be stamped or typed in its entirety on the last page of the correspondence to which it pertains. If the certificate is typed, and there is not enough room on the last page to type the certificate in its entirety, it should at least be started on the last page, so that only part of it continues over to another page. The simple certificate of mailing or certificate of transmission format should never be used by itself on a separate page at the end of the correspondence. If it is, and the page becomes detached from the rest of the submission, there will be no way of determining the identity of the correspondence to which it relates, and the benefit of the certificate will be lost.

In some cases, there may not be room for a certificate of mailing or a certificate of transmission on a piece of correspondence. In such a case, the certificate may be typed on a separate sheet of paper securely attached to the correspondence. However, the simple certificate formats shown in TBMP §110.03 are not appropriate for use on a separate sheet of paper. Rather, a certificate placed on a

## **GENERAL INFORMATION**

separate sheet of paper must include additional information, namely, a description of the nature of the correspondence to which it pertains, as well as the identity of the application, registration, or PTO proceeding in connection with which the correspondence is being filed. If there is any doubt concerning the identity of the correspondence to which a certificate of mailing or certificate of transmission on a separate sheet pertains, the certificate will not be accepted.

### **110.05 Loss of Certificate of Mailing**

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

### **110.06 Nonreceipt of Correspondence Bearing Certificate**

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

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

### **110.07 Excluded Filings**

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

- (1) A petition to cancel the registration of a mark under Section 14(1) or 14(2) of the Act, 15 U.S.C. §1064(1) or 1064(2);
- (2) Certain other filings, as specified in 37 CFR §1.8(a), not pertaining to Board proceedings.

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

At present, the certificate of transmission procedure is not applicable to any correspondence intended for the Board, except for the notice of appeal in an ex parte appeal to the Board. *See* 37 CFR §1.6(d). *See also* TBMP §107.

### **110.08 A Certificate of Mailing or Transmission is Not...**

As is evident from the requirements for a certificate of mailing, specified in 37 CFR §1.8(a), the certificate of mailing procedure is not the same as mailing by certified mail. Correspondence sent to the Board by certified mail, and not in compliance with the 37 CFR §1.8(a) requirements for a certificate of mailing, will be stamped with the date of receipt of the correspondence in the PTO, and that date will be used for all purposes, including the timeliness of the filing of the correspondence. *See* 37 CFR §§1.6 and 1.8.



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Further, a certificate of mailing or certificate of transmission is not the equivalent of a certificate of service. A certificate of mailing or certificate of transmission indicates when correspondence was sent *to the PTO* pursuant to the provisions of 37 CFR §1.8(a). The mailing date recited in a certificate of mailing, or the transmission date recited in a certificate of transmission, is used for purposes of determining the timeliness of the filing of the correspondence bearing the certificate. A certificate of service, on the other hand, indicates the date when a copy of the correspondence was served (by hand delivery, first-class mail, "Express Mail," or overnight courier) *upon another party*. A certificate of service has no bearing on the timeliness of the filing of the correspondence.

### 111 Certificate of Mailing by "Express Mail" Procedure

#### 111.01 In General

##### ***37 CFR §1.10 Filing of papers and fees by "Express Mail" with certificate.***

*(a) Any paper or fee to be filed in the Patent and Trademark Office can be filed utilizing the "Express Mail Post Office to Addressee" service of the United States Postal Service and be considered as having been filed in the Office on the date the paper or fee is shown to have been deposited as "Express Mail" with the United States Postal Service unless the date of deposit is a Saturday, Sunday, or Federal holiday within the District of Columbia. See §1.6(a).*

*(b) Any paper or fee filed by "Express Mail" must have the number of the "Express Mail" mailing label placed thereon prior to mailing, be addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231, and any such paper or fee must also include a certificate of mailing by "Express Mail" which states the date of mailing by "Express Mail" and is signed by the person mailing the paper or fee.*

*(c) The Patent and Trademark Office will accept the certificate of mailing by "Express Mail" and accord the paper or fee the certificate date under 35 U.S.C. 21(a) (unless the certificate date is a Saturday, Sunday, or Federal holiday within the District of Columbia--see §1.6(a)) without further proof of the date on which the mailing by "Express Mail" occurred unless a question is present regarding the date of mailing. If more than a reasonable time has elapsed between the certificate date and the Patent and Trademark Office receipt date or if other*

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*questions regarding the date of mailing are present, the person mailing the paper or fee may be required to file a copy of the "Express Mail" receipt showing the actual date of mailing and a statement from the person who mailed the paper or fee averring to the fact that the mailing occurred on the date certified. Such statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office.*

Any paper or fee to be filed in the PTO, including any paper or fee intended for the Board, can be filed by the certificate of mailing by "Express Mail" procedure described in 37 CFR §1.10. Under this procedure, papers or fees can be filed utilizing the "Express Mail Post Office to Addressee" service (not the "Express Mail Post Office to Post Office" service) of the United States Postal Service, and be considered as having been filed in the PTO on the date the paper or fee is shown to have been deposited as "Express Mail" with the United States Postal Service (unless the date of deposit is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the date assigned will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia). *See* 37 CFR §1.10(a).

In effect, the certificate of mailing by "Express Mail" procedure permits all types of correspondence to be sent to the PTO by the "Express Mail Post Office to Addressee" service even on the due date for the correspondence and still be considered timely, notwithstanding the fact that the mailed correspondence may not be received in the PTO until after the due date.

NOTE: Pending amendment of 37 CFR §1.10 to delete the requirement for a certificate of mailing and to incorporate requirements for the resubmission of misplaced correspondence which parallel those requirements specified in 37 CFR §1.8, if correspondence is filed by the "Express Mail Post Office to Addressee" service *without* a certificate of mailing by "Express Mail," or with a deficient certificate, *and the correspondence is actually received at the PTO bearing a clear indication on the "Express Mail" label of the "date in,"* the paper will be stamped with the "date in" as the date of receipt (unless the "date in" is a Saturday, Sunday, or Federal holiday within the District of Columbia). *See "Waiver of Certificate of Mailing Requirement Under 37 CFR 1.10,"* 1174 TMOG 92 (May 16, 1995).

### **111.02 Requirements for Certificate**

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Trademark-related papers (except for trademark-related documents sent to the Assignment Branch for recordation and requests for certified copies of trademark application and registration documents) filed by the certificate of mailing by "Express Mail" procedure must:

1. Have the number of the "Express Mail" mailing label placed thereon prior to mailing;
2. Be addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513; and
3. Include a certificate of mailing by "Express Mail" which states the date of mailing by "Express Mail" and is signed by the person mailing the paper or fee. *See 37 CFR §1.10(b), and "Change of Address For Trademark Applications and Trademark Related Papers," 1163 TMOG 80 (June 28, 1994).*

Alternatively, until such time as 37 CFR §1.10 has been amended to specify that trademark-related mail (except for trademark-related documents sent to the Assignment Branch for recordation and requests for certified copies of trademark application and registration documents) must be addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, such correspondence may continue to be sent to the Commissioner of Patents and Trademarks, Washington, D.C. 20231 address. Any certificate of mailing by "Express Mail" used on correspondence sent to the Washington, D.C. address should specify that address. *See "Change of Address For Trademark Applications and Trademark Related Papers," 1163 TMOG 80 (June 28, 1994).*

Trademark-related documents sent to the Assignment Branch for recordation, and requests for certified copies of trademark application and registration documents, should be addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231. If a certificate of mailing by "Express Mail" is used on such correspondence, it should specify that address.

When a piece of mail is sent by the "Express Mail Post Office to Addressee" service of the United States Postal Service, the Postal Service applies a numbered mailing label, with the date of mailing written thereon, to the envelope. Each paper or fee filed by the certificate of mailing by "Express Mail" procedure must bear both the number of this "Express Mail" mailing label and the required certificate of mailing by "Express mail."

A party which wishes to send mail to the PTO by the "Express Mail" service of the U.S. Postal Service should be careful to use the "Express Mail Post Office to Addressee" service, rather than the "Express Mail Post Office to Post Office"

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service. Mail sent to the PTO, pursuant to 37 CFR §1.10, by the "Express Mail Post Office to Addressee" service of the United States Postal Service is delivered to a PTO employee. Mail sent to an addressee by the "Express Mail Post Office to Post Office" service, on the other hand, is sent to a post office near the addressee, where it is held for 15 days for pickup by the addressee and then, if no pickup is made, returned to the sender. The PTO does not pick up mail from post offices. Thus, correspondence sent to the PTO by the "Express Mail Post Office to Post Office" service will not reach the PTO but instead will be returned to the sender.

### 111.03 Location of Certificate

When correspondence is filed with the PTO by the certificate of mailing by "Express Mail" procedure provided in 37 CFR §1.10, the number of the "Express Mail" mailing label, and the certificate of mailing by "Express Mail," should be placed directly on the piece of correspondence itself, or, if that is not feasible, on a separate paper securely attached thereto. *Cf.*: TBMP §110.04. As in the case of a certificate of mailing by first-class mail or a certificate of transmission, the certificate of mailing by "Express Mail" may be applied to a piece of correspondence by means of a rubber stamp.

### 111.04 Suggested Format

Shown below is a suggested format for a certificate of mailing by "Express Mail" under 37 CFR §1.10:

#### **Certificate of Mailing by "Express Mail"**

"Express Mail" mailing label number \_\_\_\_\_

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service in an envelope addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on \_\_\_\_\_.

Date

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Signature of person mailing correspondence

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Typed or printed name of person mailing  
correspondence

### **111.05 Questionable Date of Mailing**

If more than a reasonable time has elapsed between the "Express Mail" mailing date specified in a 37 CFR §1.10 certificate of mailing by "Express Mail" and the date of receipt of the correspondence by the PTO, or if there are other questions regarding the date of mailing, the party filing the correspondence may be required to file a copy of the "Express Mail" receipt (furnished by the Postal Service at the time of mailing) showing the actual date of mailing, together with a statement from the person who mailed the correspondence averring to the fact that the mailing occurred on the date specified. If the person who makes the statement is not registered to practice before the PTO, the statement must be verified. *See* 37 CFR §1.10(c).

### **112 Times for Taking Action**

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

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

*See also Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310 (Comm'r 1991); and *Strang Corp. v. Stouffer Corp.*, 16 USPQ2d 1309 (TTAB 1990).

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

If, because of some unscheduled event, such as adverse weather conditions, the PTO is officially closed by Executive Order of the President or by the Office of Personnel Management for an *entire* day, that day will be regarded by the PTO as a federal holiday within the District of Columbia. Any action due to be taken, or fee due to be paid, on that day, will be considered timely if the action is taken, or the fee paid, on the next succeeding business day on which the PTO is open. If, because of an unscheduled event, the PTO is closed for *part* of a business day, but is open for business for some part of the day between 8:30 a.m. and 5:00 p.m., any action due to be taken, or fee due to be paid, on that day remains due on that day. See "*Filing of Papers During Unscheduled Closings of the Patent and Trademark Office*," 1076 TMOG 6 (March 10, 1987).

### 113 Service of Papers

#### ***37 CFR §2.119 Service and signing of papers.***

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

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

*(1) By delivering a copy of the paper to the person served;*

*(2) By leaving a copy at the usual place of business of the person served, with someone in the person's employment;*

*(3) When the person served has no usual place of business, by leaving a copy at the person's residence, with a member of the person's family over 14 years of age and of discretion;*

*(4) Transmission by the "Express Mail Post Office to Addressee" service of the United States Postal Service or by first-class mail, which may also be certified or registered;*

*(5) Transmission by overnight courier.*

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

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

\* \* \*

### **113.01 Requirement for Service of Papers**

Every paper filed in an inter partes proceeding before the Board, including a notice of appeal from a decision of the Board, must be served by the filing party upon every other party to the proceeding. The only exceptions to this rule are the notice of opposition and petition for cancellation, which are mailed by the Board to the defendant or defendants; and any requests for discovery filed by an opposer or petitioner with the notice of opposition or petition for cancellation (i.e., the complaint) for service by the Board along with the complaint. *See* 37 CFR §2.119(a), and FRCP 33(a), 34(b), and 36(a).

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

### **113.02 Requirement for Proof of Service**

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

### **113.03 Elements of Certificate of Service**

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



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to, the paper being filed. If the statement is on a separate sheet attached to the paper being filed, it should clearly identify the paper and proceeding to which it relates. *See* 37 CFR §2.119(a).

### 113.04 Manner of Service

When a party to an inter partes proceeding before the Board files a paper required, by 37 CFR §2.119(a), to be served upon every other party to the proceeding, service may be made in any of the ways specified in 37 CFR §2.119(b). They are: (1) by hand delivering a copy of the paper to the person being served; (2) by leaving a copy of the paper at the usual place of business of the person being served, with someone in the person's employment; (3) when the person being served has no usual place of business, by leaving a copy of the paper at the person's address, with a member of the person's family over 14 years of age and of discretion; (4) transmission by the "Express Mail Post Office to Addressee" service of the United States Postal Service or by first-class mail, which may also be certified or registered; and (5) transmission by overnight courier. In addition, whenever it is satisfactorily shown to the Commissioner that none of the specified modes of serving the paper is practicable, service may be made by notice published in the *Official Gazette* of the PTO.

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

A party filing a paper in a Board inter partes proceeding may always, as a courtesy, send a copy of the paper to an adverse party by telephonic facsimile transmission ("fax"). However, transmission of the paper by fax does not

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constitute "service" thereof under the provisions of 37 CFR §2.119.

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

### **113.05 Additional Time for Taking Action After Service by Mail**

Whenever a party to an inter partes proceeding before the Board is required to take some action within a prescribed period of time after the service of a paper upon that party by another party to the proceeding, and the paper is served by first-class mail, "Express Mail," or overnight courier, the time for taking action is enlarged by 5 days. *See* 37 CFR §2.119(c).

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

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

### **113.06 A Certificate of Service is Not...**

A certificate of service is not the equivalent of a certificate of mailing or transmission *for any purpose*. *Cf.* TBMP §110.08.

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### 114 Representation of a Party

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

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

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

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

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

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

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### **114.01 Party May Represent Itself**

A party may represent itself in an ex parte or inter partes proceeding before the Board, or the party may be represented by an attorney or other authorized representative. *See* 37 CFR §10.14(e).

If a partnership which is a party to a Board proceeding elects to represent itself, the partnership may act through an individual who is a partner. If a party electing to represent itself is a corporation or an association, the party may act through any individual who is an officer of the party and who is authorized to represent it. *See* 37 CFR §10.14(e).

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

### **114.02 Selection of Attorney**

The Board cannot aid a party in the selection of an attorney, nor does the PTO maintain a register or list of trademark attorneys. *See* 37 CFR §2.11.

### **114.03 Representation by Attorney**

Any attorney, as that term is defined in 37 CFR §10.1(c) [i.e., "an individual who is a member in good standing of the bar of any United States court or the highest court of any state"], is eligible to represent others before the PTO in trademark cases, including proceedings before the Board, and in other non-patent cases. Such an attorney is not required to apply to the PTO for registration or recognition to practice before the PTO in trademark and other non-patent cases. *See* 37 CFR §§10.1(c) and 10.14(a), and *Weiffenbach v. Klempsay*, 29 USPQ2d 2027 (Dep't Comm. 1993).

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An attorney, as defined in 37 CFR §10.1(c), will be accepted as a representative of a party in a proceeding before the Board if the attorney either (1) makes an appearance in the proceeding (as, for example, by filing a paper) on behalf of the party and satisfactorily identifies himself or herself as an attorney, *see Djeredjian v. Kashi Co.*, 21 USPQ2d 1613 (TTAB 1991), or (2) files a written power of attorney signed by the party the attorney represents.

When an attorney, as defined in 37 CFR §10.1(c), acting in a representative capacity signs a paper or appears in person in a proceeding before the Board, his or her personal signature or appearance constitutes, *inter alia*, a representation to the PTO that, under the provisions of 37 CFR §10.14 (which specifies the types of individuals who may practice before the PTO in trademark and other non-patent cases) and the laws he or she is authorized to represent the particular party in whose behalf he or she acts. If there is some question as to whether an individual who makes such an appearance is authorized to act in a representative capacity, further proof of his or her authority may be required. *See 37 CFR §2.17(a).*

If a formal power of attorney is filed in a proceeding before the Board, it should state the name and address of the individual or individuals to whom the power is granted, identify the party granting the power, indicate the power being granted (e.g., "to represent Opposer in this proceeding, with full power of substitution and revocation, and to transact all business in the United States Patent and Trademark Office in connection therewith" ), and be signed by the party granting the power. The PTO requires that a power of attorney specify the names of one or more individuals. A power which specifies both the names of one or more individuals and the name of a firm will be regarded as a power to the individual(s). A power which specifies only the name of a firm will be regarded not as a power to the firm but rather simply as a designation of an address to which correspondence is to be sent. *See* TMEP §602.01 and TBMP §117.

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

The only non-lawyers permitted to represent others in trademark cases before the PTO, including proceedings before the Board, are those who were recognized to practice before the PTO in trademark cases under Chapter 1 of 37 CFR prior to January 1, 1957. *See* 37 CFR §10.14(b); *Weiffenbach v. Klempsay*, 29 USPQ2d 2027 (Dep't Comm. 1993); and *Weiffenbach v. Frank*, 18 USPQ2d 1397 (Comm'r

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1991). Before such a representative may take any action of any kind in a proceeding before the Board, however, the representative must file in the proceeding a written authorization from the party which he or she represents, or from another person entitled to prosecute the case (e.g., the party's appointed attorney of record). *See* 37 CFR §2.17(b).

### **114.05 Representation by Foreign Attorney or Agent**

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

### **114.06 Individual Not Entitled to Represent Others**

An individual who is not entitled, under 37 CFR §10.14(a), (b), or (c), to practice before the PTO in trademark cases, will not be permitted to represent a party in a proceeding before the Board. For information concerning who is entitled to practice before the PTO in trademark cases, *see* TBMP §§114.03-114.05.

If it comes to the attention of the Board that an individual who is not entitled, under 37 CFR §10.14(a), (b), or (c), to practice before the PTO in trademark cases, is attempting to represent a party in a Board proceeding, the Board will notify the individual that he or she is not entitled to do so. If the individual signs and files a paper on behalf of a party to a Board proceeding, the paper will not be considered unless a new copy thereof, signed by the party or by an authorized representative who is entitled to practice before the PTO in trademark cases, is filed. Moreover, no Board correspondence intended for the party will be sent to the individual. Rather, such correspondence will be sent by the Board to the party itself, or to the party's attorney or other authorized representative entitled to practice before the PTO in trademark cases. *See* 37 CFR §2.18 and TBMP §117.

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### 114.07 Designation of Domestic Representative

#### ***37 CFR §2.24 Designation of representative by foreign applicant.***

*If an applicant is not domiciled in the United States, the applicant must designate by a written document filed in the Patent and Trademark Office the name and address of some person resident in the United States on whom may be served notices or process in proceedings affecting the mark. If this document does not accompany or form part of the application, it will be required and registration refused unless it is supplied. Official communications of the Patent and Trademark Office will be addressed to the domestic representative unless the application is being prosecuted by an attorney at law or other qualified person duly authorized, in which event official communications will be sent to the attorney at law or other qualified person duly authorized. The mere designation of a domestic representative does not authorize the person designated to prosecute the application unless qualified under paragraph (a), (b) or (c) of §10.14 of this subchapter and authorized under §2.17(b).*

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

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

#### Designation of Domestic Representative

(Name of Domestic Representative), whose postal  
address is \_\_\_\_\_

\_\_\_\_\_,  
is hereby designated (Name of Designating Party)'s

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representative upon whom notice or process in this proceeding may be served.

---

(Signature of Designating Party)

---

(Identification of Person Signing)

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(Date of Signature)

Once a party has appointed a domestic representative, all correspondence in the case will be sent to the domestic representative, unless the party is represented by an attorney or other authorized representative located in the United States, or by a foreign attorney or agent duly qualified under 37 CFR §10.14(c). *See* TBMP §117.06.

### **114.08 Adverse Parties Represented by Same Practitioner**

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

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

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

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



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

As a general rule, a practitioner (i.e., attorney or other authorized representative) may not represent parties with conflicting interests in proceedings before the PTO. That is, a practitioner normally may not accept proffered employment, or continue multiple employment, if the exercise of the practitioner's independent professional judgment on behalf of one client is likely to be adversely affected by the practitioner's representation of another client, or if the employment would be likely to involve the practitioner in representing differing interests. *See* 37 CFR §§10.66(a) and (b); *Gilman Corp. v. Gilman Brothers Co.*, 20 USPQ2d 1238 (Comm'r 1991); *Halcon International, Inc. v. Werbow*, 228 USPQ 611 (Comm'r 1980); *Unico American Corp. v. Unico Banking Group*, 223 USPQ 684 (Comm'r 1984); *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 221 USPQ 1077 (Comm'r 1984); and *Plus Products v. Con-Stan Industries, Inc.*, 221 USPQ 1071 (Comm'r 1984). *See also* Rules 1.7 and 1.9 of the American Bar Association's Model Rules of Professional Conduct.

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

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

It is the responsibility of a practitioner to ensure that there is no violation of the rules cited above. If an impermissible conflict exists, a practitioner should take appropriate action immediately. A practitioner who fails to do so may be subjected to disciplinary action. *See* 37 CFR §10.20(b).

### **115 Conduct of Practitioner**

#### **115.01 Applicable Rules**

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The conduct of an attorney or other authorized representative in proceedings before the Board is governed by Part 10 of 37 CFR. Part 10 contains both Canons (set out in Rules 10.21, 10.30, 10.46, 10.56, 10.61, 10.76, 10.83, 10.100, and 10.110) and Disciplinary Rules (set out in Rules 10.22-10.24, 10.31-10.40, 10.47-10.57, 10.62-10.68, 10.77, 10.78, 10.84, 10.85, 10.87-10.89, 10.92, 10.93, 10.101-10.103, 10.111, and 10.112). Canons are "statements of axiomatic norms, expressing in general terms the standards of professional conduct expected of practitioners in their relationships with the public, with the legal system, and with the legal profession," while Disciplinary Rules are "mandatory in character and state the minimum level of conduct below which no practitioner can fall without being subjected to disciplinary action." *See* 37 CFR §10.20.

### 115.02 Disciplinary Proceedings

#### ***37 CFR 10.130 Reprimand, suspension or exclusion.***

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

\* \* \*

*See Klein v. Peterson*, 866 F.2d 412, 9 USPQ2d 1558 (Fed. Cir. 1989); *Weiffenbach v. Logan*, 27 USPQ2d 1870 (Comm'r 1993); *McCandlish v. Doe*, 22 USPQ2d 1223 (Comm'r 1992); *Weiffenbach v. Turner*, 20 USPQ2d 1103 (Comm'r 1991); *Weiffenbach v. Frank*, 18 USPQ2d 1397 (Comm'r 1991); *Small v. Weiffenbach*, 10 USPQ2d 1898 (Comm'r 1989); *In re Kalil*, 2 USPQ2d 1614 (Dep't Comm. 1986); and *In re Slater*, 231 USPQ 497 (Comm'r 1985). *See also Weiffenbach v. Klempay*, 29 USPQ2d 2027 (Dep't Comm. 1993).

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

### 115.03 Petitions to Disqualify

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

Petitions to disqualify practitioners representing parties in ex parte or inter partes cases before the Board are *not* disciplinary proceedings and hence are not governed by 37 CFR §§10.130-10.170. Rather, petitions to disqualify are governed by 37 CFR §10.130(b). For examples of cases involving petitions to disqualify, *see* the decisions cited in TBMP §114.08.

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

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

## 116 Termination of Representation

### 116.01 Revocation of Authority

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

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

\* \* \*

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

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new written authorization of that person, signed by the party, is filed in the proceeding.

### **116.02 Withdrawal as Representative--In General**

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

#### **37 CFR §10.40 Withdrawal from employment.**

*(a) A practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office (see §§1.36 and 2.19 of this subchapter). In any event, a practitioner shall not withdraw from employment until the practitioner has taken reasonable steps to avoid foreseeable prejudice to the rights of the client, including giving due notice to his or her client, allowing time for employment of another practitioner, delivering to the client all papers and property to which the client is entitled, and complying with applicable laws and rules. A practitioner who withdraws from employment shall refund promptly any part of a fee paid in advance that has not been earned.*

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

*(1) The practitioner knows or it is obvious that the client is bringing a legal action, commencing a proceeding before the Office, conducting a defense, or asserting a position in litigation or any proceeding pending before the Office, or is otherwise having steps taken for the client, merely for the purpose of harassing or maliciously injuring any person;*

*(2) The practitioner knows or it is obvious that the practitioner's continued employment will result in violation of a Disciplinary Rule;*

*(3) The practitioner's mental or physical condition renders it unreasonably difficult for the practitioner to carry out the employment effectively; or*

*(4) The practitioner is discharged by the client.*

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

*(1) The petitioner's client:*

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*(i) Insists upon presenting a claim or defense that is not warranted under existing law and cannot be supported by good faith argument for an extension, modification, or reversal of existing law;*

*(ii) Personally seeks to pursue an illegal course of conduct;*

*(iii) Insists that the practitioner pursue a course of conduct that is illegal or that is prohibited under a Disciplinary Rule;*

*(iv) By other conduct renders it unreasonably difficult for the practitioner to carry out the employment effectively;*

*(v) Insists, in a matter not pending before a tribunal, that the practitioner engage in conduct that is contrary to the judgment and advice of the practitioner but not prohibited under the Disciplinary Rule; or*

*(vi) Has failed to pay one or more bills rendered by the practitioner for an unreasonable period of time or has failed to honor an agreement to pay a retainer in advance of the performance of legal services.*

*(2) The practitioner's continued employment is likely to result in a violation of a Disciplinary Rule;*

*(3) The practitioner's inability to work with co-counsel indicates that the best interests of the client likely will be served by withdrawal;*

*(4) The practitioner's mental or physical condition renders it difficult for the practitioner to carry out the employment effectively;*

*(5) The practitioner's client knowingly and freely assents to termination of the employment; or*

*(6) The practitioner believes in good faith, in a proceeding pending before the Office, that the Office will find the existence of other good cause for withdrawal.*

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

### **116.03 When Withdrawal is Mandatory**

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

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### **116.04 When Withdrawal is Permissive**

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

### **116.05 Request to Withdraw**

A practitioner who wishes to withdraw from employment as the attorney or other authorized representative of a party to a proceeding before the Board must file a written request with the Board for permission to do so. The request to withdraw must be based upon one of the grounds for mandatory or permissive withdrawal listed in 37 CFR §§10.40(b) and (c). Moreover, the practitioner must comply with the requirements of 37 CFR §10.40(a). *See* 37 CFR §§2.19(b) and 10.40. *Cf. In re Legendary Inc.*, 26 USPQ2d 1478 (Comm'r 1992).

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

## **117 Correspondence - With Whom Held**

### ***37 CFR §2.18 Correspondence, with whom held.***

*Correspondence will be sent to the applicant or a party to a proceeding at its address unless papers are transmitted by an attorney at law, or a written power of attorney is filed, or written authorization of other person entitled to be recognized is filed, or the applicant or party designates in writing another address to which correspondence is to be sent, in which event correspondence will be sent to the attorney at law transmitting the papers, or to the attorney at law designated in the power of attorney, or to the other person designated in the written authorization, or to the address designated by the applicant or party for correspondence. Correspondence will continue to be sent to such address until the applicant or party, or the attorney at law or other authorized representative of the applicant or party, indicates in writing that correspondence is to be sent to another address.*

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*Correspondence will be sent to the domestic representative of a foreign applicant unless the application is being prosecuted by an attorney at law or other qualified person duly authorized, in which event correspondence will be sent to the attorney at law or other qualified person duly authorized. Double correspondence will not be undertaken by the Patent and Trademark Office, and if more than one attorney at law or other authorized representative appears or signs a paper, the Office reply will be sent to the address already established in the file until another correspondence address is specified by the applicant or party or by the attorney or other authorized representative of the applicant or party.*

### ***37 CFR §2.24 Designation of representative by foreign applicant.***

*If an applicant is not domiciled in the United States, the applicant must designate by a written document filed in the Patent and Trademark Office the name and address of some person resident in the United States on whom may be served notices or process in proceedings affecting the mark. If this document does not accompany or form part of the application, it will be required and registration refused unless it is supplied. Official communications of the Patent and Trademark Office will be addressed to the domestic representative unless the application is being prosecuted by an attorney at law or other qualified person duly authorized, in which event official communications will be sent to the attorney at law or other qualified person duly authorized. The mere designation of a domestic representative does not authorize the person designated to prosecute the application unless qualified under paragraph (a), (b) or (c) of §10.14 of this subchapter and authorized under §2.17(b).*

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

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### 117.01 In General

Whenever the Board takes an action in a proceeding before it, the Board sends a copy of the action to each party or to the party's attorney or other authorized representative. If a party is domiciled in the United States, such correspondence will be sent to the party at the party's address of record in the proceeding, unless an appearance is made on behalf of the party by an attorney (as defined in 37 CFR §10.1(c)), or a written power of attorney is filed, or written authorization of some other person entitled to be recognized is filed, or the party designates in writing another address to which correspondence is to be sent. If one of these events occurs, correspondence will be sent not to the party's address of record, but rather to the attorney who makes the appearance, or to the attorney designated in the power of attorney, or to the other person designated in the written authorization, or to the address designated by the party for correspondence. *See Societe des Produits Nestle S.A. v. Basso Fedele & Figli*, 24 USPQ2d 1079 (TTAB 1992) (power of attorney); and *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613 (TTAB 1991) (appearance). Correspondence will continue to be sent to such address until the party, or the party's attorney or other representative, indicates in writing that correspondence is to be sent to another address. *See* 37 CFR §2.18.

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

If a power of attorney names more than one individual, and does not specify which of them is to have primary responsibility for the case and receive correspondence, the name(s) of the individual attorney(s) in the signature block of the covering transmittal letter will be used by the Board on the proceeding file, on correspondence for the party, and on the final decision of the Board, to identify counsel for the party, unless the party or one of the named attorneys requests otherwise in writing. This is because the typing of a large number of names on a proceeding file, correspondence, and final decision consumes an excessive amount of space and time, and hence is impractical and burdensome. If there is no transmittal letter, and no other indication as to which of the named attorneys is to have primary responsibility for the case and receive correspondence, the name of the first listed attorney will be used by the Board on the proceeding file, on correspondence for the party, and on the Board's final decision, unless the party or one of the named attorneys requests otherwise in writing.



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Double correspondence, that is, the mailing of correspondence to two addresses on behalf of a single party, ordinarily will not be undertaken by the Board. If more than one attorney or other authorized representative makes an appearance on behalf of a party, the papers filed by the additional attorney(s) or other authorized representative(s) will be accepted, but the Board will send correspondence to only one of them, to be determined according to the circumstances in the case. *See* 37 CFR §2.18.

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

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

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

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If a power of attorney from a party to one attorney ("A") has been filed, and thereafter A files an "associate power of attorney" to another attorney ("B"), the correspondence address will remain unchanged, and the Board will continue to send correspondence to A, unless A or the party directs otherwise. Cf. TMEP §603.

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

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

In special circumstances, the Board, in its discretion, may send a particular item of correspondence to more than one address on behalf of a single party. However, the Board will not send correspondence to more than one address on behalf of a single party on a continuing basis.

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

In the case of a party whose application is the subject of a Board proceeding, any appearance or power of attorney (or designation of other authorized representative) of record in the application file at the time of the commencement of the Board proceeding is considered to be effective for purposes of the proceeding, and correspondence will be sent initially to that address. *See* 37 CFR §2.105. Thereafter, the correspondence address may be changed in appropriate circumstances.

However, in the case of a party whose registration is the subject of a proceeding before the Board, any representation which may be of record in the registration file at the time of the commencement of the Board proceeding is not considered to be effective for purposes of the Board proceeding. Rather, correspondence is sent to the registrant itself unless and until an attorney makes an appearance in the Board proceeding in the registrant's behalf, or a written power of attorney is filed in the proceeding by the registrant, or written authorization of some other person entitled to be recognized is filed in the proceeding by the registrant, or the registrant designates in writing another address to which correspondence is to be sent. *See* 37 CFR §§2.18 and 2.113.

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

When an attorney is appointed in a power of attorney accompanying an opposition, or makes an appearance by filing an opposition on behalf of the opposer, correspondence will be sent by the Board to that attorney, notwithstanding the fact that another attorney or attorneys may have obtained one or more extensions of time to oppose on behalf of the opposer. If, however, a power of attorney filed with an opposition names several attorneys, and there is no transmittal letter and no other indication as to which of them is to have primary responsibility for the case and receive correspondence, but one of the named attorneys obtained an extension of time to oppose, correspondence will be sent to that attorney; if none of the named attorneys obtained an extension of time to oppose, correspondence will be sent to the first named attorney. Thereafter, the correspondence address may be changed in appropriate circumstances.

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### **117.05 Correspondence After Revocation or Withdrawal**

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

### **117.06 Correspondence With Foreign Party**

If a party to a Board proceeding is not domiciled in the United States and is not represented by an attorney or other authorized representative located in the United States, or by a foreign attorney or agent duly qualified under 37 CFR §10.14(c), correspondence will be sent to the party's domestic representative. *See* 37 CFR §§2.24 and 2.119(d).

### **117.07 Change of Address**

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

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

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

### **117.08 Individual Not Entitled to Represent Others**

An individual who is not entitled, under 37 CFR §10.14(a), (b), or (c), to practice before the PTO in trademark cases, will not be permitted to represent a party in a proceeding before the Board, and may not file papers on behalf of the party. *Cf.* TMEP §602.04. If it comes to the attention of a Board attorney that such an individual is attempting to represent a party in a Board proceeding, the Board attorney will bring the matter to the attention of the Chairman of the Board, who will coordinate appropriate action with the Office of Enrollment and Discipline. Moreover, no Board correspondence intended for the party will be sent to the individual. Rather, such correspondence will be sent by the Board to the party itself, or to the party's attorney or other authorized representative entitled to practice before the PTO in trademark cases. *See* 37 CFR §2.18.

## **118 Payment of Fees**

### **118.01 Lists of Fees and Charges**

A list of the fees and charges established by the PTO for trademark cases may be found in 37 CFR §2.6.

A list of fees and charges established by the PTO for miscellaneous services may be found in 37 CFR §1.21.

### **118.02 Fees Payable in Advance**

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### **37 CFR §1.22 Fees payable in advance.**

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

*(b) All patent and trademark fees paid to the Patent and Trademark Office should be itemized in each individual application, patent or other proceeding in such a manner that it is clear for which purpose the fees are paid.*

### **118.03 Method of Payment--In General**

#### **37 CFR §1.23 Method of Payment.**

*All payments of money required for Patent and Trademark Office fees, including fees for the processing of international applications ( §1.445), should be made in U.S. specie, Treasury notes, national bank notes, post office money orders, or by certified check. If sent in any other form, the Office may delay or cancel the credit until collection is made. Money orders and checks must be made payable to the Commissioner of Patents and Trademarks. Remittances 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 Patent and Trademark Office will be at the risk of the sender; letters containing money should be registered.*

It is the practice of the PTO to routinely accept, as "conditional" payment of a fee, a signed uncertified check. If such a check is returned for insufficient funds, the fee remains unpaid, and the filing date of the fee will be the filing date of any resubmitted adequate payment. *See In re Cantatore*, 231 USPQ 742 (Comm'r 1986). An unsigned check will be returned to its sender, but the Commissioner has the discretion to accept such a check, as "conditional" payment, upon petition showing sufficient cause therefor. *See Dubost v. U.S. Patent and Trademark Office*, 777 F.2d 1561, 227 USPQ 977 (Fed. Cir. 1985), *on remand*, *In re Dubost*, 231 USPQ 887 (Comm'r 1986).

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

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### 118.04 Method of Payment--Deposit Accounts

For the convenience of attorneys and the general public in paying fees and charges to the PTO, deposit accounts may be established in the PTO. For information concerning the establishment of a deposit account in the PTO, *see* §1.25.

The fees for filing an ex parte appeal to the Board, an opposition, and a petition for cancellation, may all be charged to a deposit account, provided that the requirements of 37 CFR §1.25 are met. However, the charging of a fee against an account that does not contain sufficient funds to cover it cannot be regarded as payment of the fee. *See* 37 CFR §1.25(b). Thus, the overdrawing of a deposit account may result in the loss of a vital date. *See* notice at 824 TMOG 1200 (February 23, 1966)..

### 118.05 Method of Payment--Coupons

For the convenience of the general public, the PTO sells coupons for use in purchasing copies of trademark registrations, patents, designs, defensive publications, and statutory invention registrations. For information concerning these coupons, *see* 37 CFR §1.24.

## 119 Papers and Fees Generally Not Returnable

### 119.01 Fee Refunds--General Rule

#### **37 CFR §1.26 Refunds.**

*(a) Money paid in excess will be refunded, but a mere change of purpose after the payment of money, as when a party desires to withdraw an application, an appeal, or a request for oral hearing, will not entitle a party to demand such a return. Amounts of twenty-five dollars or less will not be returned unless specifically requested within a reasonable time, nor will the payer be notified of such amount; amounts over twenty-five dollars may be returned by check or if requested, by credit to a deposit account.*

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### **119.02 Papers and Fees--Ex Parte Cases**

After an application has received a filing date, papers filed in connection therewith, including ex parte appeal papers, will not normally be returned. *See* 37 CFR §2.25.

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

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

### **119.03 Papers and Fees--Inter Partes Cases**

After an inter partes proceeding before the Board has been filed, papers and other materials filed in connection therewith normally will not be returned, except that exhibits to testimony, and confidential materials filed under a protective order,



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ordinarily are returned, after the conclusion of a proceeding, to the party which filed them. *Cf.* TBMP §806.

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

For example, if an opposition is filed after the time for opposing has expired; or is filed unsigned, and a signed copy is not submitted within the time limit set in the notification of this defect by the Board; or is filed without the required fee, and the fee is not submitted within the time allowed by the Board; or if the opposed application was abandoned before the opposition was filed (*see* TBMP §307.11), no proceeding will be instituted, the opposition papers will be returned, and any fee submitted therewith will be refunded.

If an opposition filed during an extension of time to oppose is in the name of someone other than the person who obtained the extension, and the opposer is unable to show, pursuant to 37 CFR §2.102(b), that it is in privity with the person who obtained the extension, or that the person in whose name the extension was requested was misidentified by mistake, no proceeding will be instituted, the opposition papers will be returned, and any fee submitted therewith will be refunded.

If an opposition or a petition for cancellation is filed prematurely (i.e., prior to publication of the subject mark in the *Official Gazette* for purposes of opposition, or prior to issuance of a registration of the subject mark, respectively), no proceeding will be instituted, the papers will be returned, and any fee submitted therewith will be refunded.

If a petition to cancel a Principal Register registration that is more than five years old does not allege any ground upon which such a registration can be cancelled (*see* Section 14 of the Act of 1946, 15 U.S.C. §1064), no proceeding will be instituted, the petition papers will be returned, and any fee submitted therewith will be refunded.

If a petition for cancellation is filed with respect to a registration which, at the time of the filing of the petition, was not a "live" registration (i.e., the time for filing an affidavit of use under Section 8 of the Act of 1946, 15 U.S.C. §1058, had expired, and no acceptable affidavit had been filed; the registration had already been cancelled as the result of a previous cancellation proceeding; etc.), no proceeding

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will be instituted, the petition papers will be returned, and any fee submitted therewith will be refunded.

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

### 120 Proceeding Files and Exhibits

#### 120.01 Description of Files

Papers in proceedings before the Board (both those filed by parties, and those mailed by the Board) are kept in three-fold manila file wrappers or jackets, known simply as "files." In the case of an ex parte appeal, the papers are simply added to the existing application file (described in TMEP §710).

In the case of a "potential opposition," that is, when the mark in an application has been published in the *Official Gazette* for purposes of opposition, and a request for extension of time to oppose has been filed pursuant to 37 CFR §2.102, but no opposition has yet been filed, the papers relating to the potential opposition are fastened by the Board to the inner left-hand side of the application file in question. In the event that an opposition is ultimately filed, the potential opposition papers are removed from the application file and placed instead in the file of the new opposition.

When an inter partes proceeding is commenced, a proceeding file is set up by the Board, and the proceeding papers are placed on prongs at the top of the inside center portion of the file, in inverse order by date of receipt in the PTO or mailing by the Board, so that the oldest paper is on the bottom of the prongs, and the most recent paper is on top. A numbered chronological list of proceeding docket entries, that is, of the papers and other materials filed and mailed in the proceeding, appears on the inside right-hand side of the file. The outside center portion, or "front," of the file bears information identifying the proceeding to

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which the file pertains, i.e., the proceeding name and number, the number(s) of the application(s) or registration(s) which is (are) the subject matter of the proceeding, the initials of the Board interlocutory attorney to whom the case has been assigned, etc. The outer left-hand side of the file bears the name of each party and each party's correspondence address (if a party is represented by counsel, the correspondence address usually consists of the name and address of such counsel).

Because of their bulkiness, deposition transcripts, exhibits thereto, and inter partes briefs on the case are not placed on the prongs in the proceeding file, and hence may be filed in bound form.. If a proceeding paper, other than a deposition transcript, an exhibit thereto, or an inter partes brief on the case, is filed in bound form, the Board must remove the binding in order to place the paper on the proceeding file prongs. Thus, proceeding papers, with the noted exceptions, should not be filed in bound form.

For information concerning the disposition of inter partes proceeding files and exhibits after the proceeding has ended, *see* TBMP §806.

### **120.02 Storage of Files and Exhibits**

The files of pending Board inter partes proceedings, together with the files of the applications or registrations which are the subject matter of the proceedings, are stored in the Board's offices. They are kept on shelves, where they are arranged in terminal two-digit numerical order. When a paper is filed in connection with a proceeding, or it is time for the Board to take some action in the proceeding, the proceeding file is removed from the shelf for entry and consideration of the paper, drafting of the action, etc. When a case is ready for a final decision on the merits, everything pertaining to the proceeding is given to the Board Member assigned to draft the decision.

The files of applications which are on appeal to the Board, and the files of applications with "potential oppositions," are also stored at the offices of the Board. They too are kept on shelves, in terminal two-digit numerical order.

Exhibits (and the like), filed in connection with pending Board inter partes and ex parte proceedings, often are too bulky to put in the proceeding files. These exhibits are kept in the boxes or envelopes in which they were mailed, or, sometimes, in PTO inter-office envelopes. Information clearly identifying the

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proceedings to which the packages of exhibits pertain is prominently written on the outside of each box and envelope. Those bulky exhibits which are kept in envelopes are stored together on shelves (separate from the proceeding files) in terminal two-digit numerical order. Those bulky exhibits which are so large that they must be kept in boxes are stored together in a room at the offices of the Board.

For information concerning the disposition of inter partes proceeding files and exhibits after the proceeding has ended, *see* TBMP §806.

### 120.03 Storage of Confidential Materials

Confidential materials filed under seal pursuant to a protective order (*see* 37 CFR §§2.27, 2.120(f), and 2.125(e); and TBMP §§416, 526, and 713.16) in a pending Board proceeding are stored by the Board in a locked file cabinet. These materials may include certain responses to discovery requests, exhibits, portions of deposition transcripts, or portions of briefs. As in the case of nonconfidential exhibits, the boxes or envelopes in which these materials are kept are clearly marked with information identifying the proceedings to which the materials pertain. In addition, the designation "Cab." is written both on the boxes or envelopes and on the numbered list of docket entries in the pertinent proceeding files, next to the entry relating to the confidential materials.

### 121 Access to Files

**37 CFR §2.27(d)** *Except as provided in paragraph (e) of this section, after a mark has been registered, or published for opposition, the file of the application and all proceedings relating thereto are available for public inspection and copies of the papers may be furnished upon paying the fee therefor.*

**37 CFR §2.27(e)** *Anything ordered to be filed under seal pursuant to a protective order issued or made by any court or by the Trademark Trial and Appeal Board in any proceeding involving an application or a registration shall be kept confidential and shall not be made available for public inspection or copying unless otherwise ordered by the court or the Board, or unless the party protected*

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*by the order voluntarily discloses the matter subject thereto. When possible, only confidential portions of filings with the Board shall be filed under seal.*

### **121.01 Nonconfidential Files**

Except for materials filed under seal pursuant to a protective order, the files of applications and registrations which are the subject matter of pending proceedings before the Board, all pending proceeding files and exhibits thereto, and the files of applications which are the subject matter of "potential oppositions," are available for public inspection and copying at the offices of the Board. *See* 37 CFR §2.27.

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

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

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

### **121.02 Confidential Materials**

Materials filed with the Board under seal pursuant to a protective order issued by any court or by the Board will be kept confidential and will *not* be made available for public inspection or copying unless otherwise ordered by the court or the Board, or unless the party protected by the order voluntarily discloses the matter

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subject thereto. These materials may be inspected only by those individuals who are entitled, under the terms of the protective order, to have access to the protected information. *See* 37 CFR §2.27(e).

### **121.03 Files of Terminated Proceedings**

When an inter partes proceeding has been finally determined, i.e., when the proceeding is over, the PTO takes certain further steps based on the final decision, including those steps necessary to give effect to the decision. This process is referred to as the "termination" of the proceeding. For example, when a decision dismissing an opposition has become final, the word "TERMINATED" is stamped on the file of the opposition proceeding, the opposition file is sent to the warehouse where the files of terminated proceedings are stored, and the registration sought by the applicant is issued. *See* TBMP §806.

The files of terminated inter partes proceedings are stored by the PTO in a warehouse. The files of existing registrations; registrations which expired or were cancelled within the last two years; and applications abandoned within the last two years, are also stored in a warehouse.

The files of cancelled and expired registrations are destroyed two years after the date of cancellation or expiration; the files of abandoned applications are destroyed two years after the date of abandonment. In addition, the files of terminated opposition proceedings numbered from 30,000 through 53,999, and of terminated cancellation proceedings numbered from 1 through 9399, have been destroyed.

An individual who wishes to inspect and/or copy a file stored by the PTO in a warehouse can go to the Public Service Window located on the second floor of the South Tower building, 2900 Crystal Drive, Arlington, Virginia, and place an order for the file. Alternatively, the individual can order the file electronically from a computer terminal located in the Trademark Search Library, or from a computer terminal located in the Patent Search Room. Within a few days, the PTO will obtain the ordered file from the warehouse, and make it available to the individual for inspection and/or copying at the Trademark Search Library. The file may not be taken away from the premises of the Trademark Search Library. *See* TMEP §303.02.

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### 122 Copying of Files

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

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

Alternatively, the PTO will furnish photocopies (either certified or uncertified) of trademark application and registration files, or of one or more papers therefrom, or of papers from the files of Board proceedings, upon written request and payment of the fee prescribed in 37 CFR §2.6. The PTO will also furnish, upon written request and payment of the fee prescribed in 37 CFR §2.6, printed copies of trademark registrations, certified copies of registrations with information as to the current status and title of the registration, and abstracts of title to trademark applications and registrations.

All requests for certified and uncertified copies of trademark documents relating to applications or registrations, including copies of papers from the files of Board proceedings, and abstracts of title, are handled by the PTO's Certification Division, Office of Public Records. If a written request (with the required fee) for copies is mailed to the PTO, it should be addressed to the Commissioner of Patents and Trademarks, Box 10, Certification Division, Washington, D.C. 20231. The written request, with fee, may also be delivered by hand to the Public Service Window at 2900 Crystal Drive, South Tower Building, Second Floor, Arlington, Virginia 22202-3513; or to the Office of Public Records, 2800 Crystal Drive, North Tower Building, Tenth Floor, Arlington, Virginia 22202-3513; or to the Attorneys' Window at 2201 S. Clark Place, Crystal Plaza Building 4, First Floor, Arlington, Virginia 22202. Finally, if the written request includes an authorization to charge the required fee to a deposit account, the request may be sent by

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facsimile transmission to (703) 308-7048. *See "Notice of a Change in Procedure Regarding Requests for Certification Services," 1165 TMOG 13 (August 2, 1994).*

### **123 Certification**

#### **123.01 Court Requirements**

If a copy of a Board proceeding file, or a portion thereof, is needed for use before a district court, the court may require a certified copy (which bears a seal). Some district courts, however, will accept a verification letter (which does not bear a seal) by the Board, together with a plain photocopy of the proceeding file or portion thereof.

An individual who needs a copy of a Board proceeding file, or a portion thereof, for use in a district court should contact the clerk of the court to determine whether the court will accept a Board verification letter, or will require a formal certified copy.

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

#### **123.02 Certified Copies**

Certified copies, bearing a seal, of PTO proceeding files, including Board proceeding files, or portions thereof, may be ordered from the PTO's Certification Division, Office of Public Records, upon written request and payment of the required fee. *See* TBMP §122.

#### **123.03 Verified Copies**

The Board, upon proper request, will prepare a verification letter, signed by the Board's Administrator (or, in the Administrator's absence, by a Member of the



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Board), stating that a particular proceeding (identified in the letter by name and number), involving a specified application(s) or registration(s), is pending before the Board, and that attached to the letter is a true and correct copy of a paper or papers (identified in the letter by title and filing date) filed in connection with that proceeding.

An individual who wishes to obtain a verification letter from the Board may bring to the Offices of the Board a photocopy of the matter to be verified, or make a photocopy thereof at the Board's offices (*see* TBMP §122). The Board Administrator or Member will compare the photocopy with the file original, to verify that it is a true copy, before signing the verification letter. If necessary (that is, if required by the court before which the verification letter is to be used), the signature of the Board Administrator or Member may be notarized.

Board verification letters normally will be prepared by the Board immediately, on a "while you wait" basis. To save time, it is recommended that an individual seeking such a letter call the Board in advance of his or her visit and ask that the involved proceeding file be located and pulled prior to the visit.

An individual who is unable to come to the offices of the Board, or to send a local representative, but needs to obtain a Board verification letter quickly, may send a written request therefor (addressed to the Board at its physical location and including a photocopy of the matter to be verified) by any overnight courier service, and enclose a prepaid self-addressed overnight courier return envelope. In those cases where time is not of the essence, a written request for a verification letter may be sent to the Board by mail. When a request for a verification letter is sent to the Board by mail or by overnight courier, the individual sending the request should notify the Board's Administrator thereof by telephone so that the Administrator can watch for the request and respond to it as soon as it arrives at the offices of the Board.

The Board will issue other types of verification letters as well. For example, the Board may issue, upon request therefor, a verification letter stating simply that a particular proceeding (identified in the letter by name and number) involving a specified application or registration is pending before the Board; or that a specified application or registration is not the subject of any proceeding presently pending before the Board; or that a particular opposition (identified in the letter) to a specified application is pending before the Board, and no certificate of registration can be issued to the applicant unless and until the opposition is ultimately terminated in applicant's favor.

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There is no fee for a Board verification letter.

### **124 Application and Registration Status Information**

The PTO maintains a Trademark Status Line which provides access, by push-button telephone, to current status, status date (i.e., the date that a record entered its current status), and status location information for all active Federal trademark application and registration records maintained in the automated Trademark Reporting and Monitoring (TRAM) System. *See In re Sovran Financial Corp.*, 25 USPQ2d 1537 (Comm'r 1992). The line is available on (703) 305-8747 from 6:30 a.m. until midnight, Eastern Time, Monday through Friday (except for Federal holidays).

For further information concerning the Trademark Status Line, *see* TMEP §413, and notices at 1112 TMOG 49 (March 27, 1990) and 1132 TMOG 33 (November 19, 1991).

### **125 Action by Assignee**

When a mark which is the subject of a Federal application or registration has been assigned, together with the application or registration, in accordance with Section 10 of the Act, 15 U.S.C. §1060, any action with respect to the application or registration which may or must be taken by the applicant or registrant may be taken by the assignee (acting itself, or through its attorney or other authorized representative), provided that the assignment has been recorded or that proof of the assignment has been submitted. *See* 37 CFR §§3.71 and 3.73(b). Similarly, when a mark which is not the subject of a Federal application or registration, but which is owned and pleaded by a plaintiff in a Board inter partes proceeding, has been assigned, the assignee may act in the proceeding (either itself, or through its attorney or other authorized representative) in place of the assignor, provided that proof of the assignment has been submitted in the proceeding. *See* TBMP §512.01.