

Trademark Laws and Regulations

[47 FR 38695, Sept. 2, 1982, as amended at 54 FR 37591, Sept. 11, 1989]

37 CFR 2.58 Specimens or facsimiles in the case of a service mark.

(a) In the case of service marks, specimens or facsimiles as specified in §§2.56 and 2.57, of the mark as used in the sale or advertising of the services shall be furnished unless impossible because of the nature of the mark or the manner in which it is used, in which event some other representation acceptable to the Commissioner must be submitted.

(b) In the case of service marks not used in printed or written form, three audio cassette tape recordings will be accepted.

[30 FR 13193, Oct. 16, 1965, as amended at 51 FR 2992, Aug. 21, 1986]

37 CFR 2.59 Filing substitute specimens.

(a) In an application under §1(a) of the Act, the applicant may submit substitute specimens of the mark as used on or in connection with the goods, or in the sale or advertising of the services, provided that any substitute specimens submitted are supported by applicant's affidavit or declaration in accordance with §2.20 verifying that the substitute specimens were in use in commerce at least as early as the filing date of the application. The verification requirement shall not apply if the specimens are duplicates or facsimiles, such as photographs, of specimens already of record in the application.

(b) In an application under §1(b) of the Act, after filing either an amendment to allege use under §2.76 or a statement of use under §2.88, the applicant may submit substitute specimens of the mark as used on or in connection with the goods, or in the sale or advertising of the services, provided that the use in commerce of any substitute specimens submitted is supported by applicant's affidavit or declaration in accordance with §2.20. In the case of a statement of use under §2.88, the applicant must verify that the substitute specimens were in use in commerce prior to the filing of the statement of use or prior to the expiration of the time allowed to applicant for filing a statement of use.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37591, Sept. 11, 1989]

EXAMINATION OF APPLICATION AND ACTION BY APPLICANTS

Authority: Sections 2.61 to 2.69 also issued under §12, 60 Stat. 432; 15 U.S.C. 1062.

37 CFR 2.61 Action by examiner.

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

(b) The examiner may require the applicant to furnish such information and exhibits as may be reasonably necessary to the proper examination of the application.

(c) Whenever it shall be found that two or more parties whose interests are in conflict are represented by the same attorney, each party and also the attorney shall be notified of this fact.

[30 FR 13193, Oct. 16, 1965, as amended at 37 FR 2880, Feb. 9, 1972; 54 FR 37592, Sept. 11, 1989]

37 CFR 2.62 Period for response.

The applicant has six months from the date of mailing of any action by the examiner to respond thereto. Such response may be made with or without amendment and must include such proper action by the applicant as the nature of the action and the condition of the case may require.

37 CFR 2.63 Reexamination.

(a) After response by the applicant, the application will be reexamined or reconsidered. If registration is again refused or any formal requirement[s] is repeated, but the examiner's action is

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not stated to be final, the applicant may respond again.

(b) After reexamination the applicant may respond by filing a timely petition to the Commissioner for relief from a formal requirement if:

- (1) The requirement is repeated, but the examiner's action is not made final, and the subject matter of the requirement is appropriate for petition to the Commissioner (see §2.146(b)); or
- (2) the examiner's action is made final and such action is limited to subject matter appropriate for petition to the Commissioner.

If the petition is denied, the applicant shall have until six months from the date of the Office action which repeated the requirement or made it final or thirty days from the date of the decision on the petition, whichever date is later, to comply with the requirement. A formal requirement which is the subject of a petition decided by the Commissioner may not subsequently be the subject of an appeal to the Trademark Trial and Appeal Board.

[48 FR 23214, May 23, 1983]

37 CFR 2.64 Final action.

(a) On the first or any subsequent reexamination or reconsideration the refusal of the registration or the insistence upon a requirement may be stated to be final, whereupon applicant's response is limited to an appeal, or to a compliance with any requirement, or to a petition to the Commissioner if permitted by §2.63(b).

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

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

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

[48 FR 23134, May 23, 1983, as amended at 54 FR 37592, Sept. 11, 1989]

37 CFR 2.65 Abandonment.

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

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

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(c) If an applicant in an application under §1(b) of the Act fails to timely file a statement of use under §2.88, the application shall be deemed to be abandoned.

[48 FR 23134, May 23, 1983, as amended at 54 FR 37592, Sept. 11, 1989]

37 CFR 2.66 Revival of abandoned applications.

(a) An application abandoned for failure to timely respond, or for failure to timely file a statement of use under §2.88 in an application under §1(b) of the Act, may be revived as a pending application if it is shown to the satisfaction of the Commissioner that the delay was unavoidable.

(b) A petition to revive an application abandoned for failure to timely respond must be accompanied by:

- (1) The required fee,
- (2) A showing which is verified or which includes a declaration in accordance with §2.20 of the causes of the delay, and (3) The proposed response, unless a response has been previously filed.

(c) A petition to revive an application abandoned for failure to timely file a statement of use under §2.88 in an application under §1(b) of the Act must be accompanied by:

- (1) The required petition fee,
- (2) A showing which is verified or which includes a declaration in accordance with §2.20 of the causes of the delay,
- (3) The required fees for the number of requests (in accordance with §2.89 for extensions of time to file a statement of use) which should have been filed if the application had not been abandoned, and
- (4) Either a statement of use in accordance with §2.88 (unless the same has been previously filed) or a request in accordance with §2.89 for an extension of time to file a statement of use.

(d) The petition must be filed promptly. No petition to revive will be granted in an application under §1(b) of the Act if granting the petition would permit the filing of a statement of use more than 36 months after the issuance of a notice of allowance under §13(b)(2) of the Act.

[31 FR 5261, Apr. 1, 1966, as amended at 54 FR 37592, Sept. 11, 1989]

37 CFR 2.67 Suspension of action by the Patent and Trademark Office.

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

[37 FR 3998, Feb. 24, 1972]

37 CFR 2.68 Express abandonment (withdrawal) of application.

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

[38 FR 7958, Mar. 27, 1973, as amended at 54 FR 34897, Aug. 22, 1989]

*Trademark Laws and Regulations***37 CFR 2.69 Compliance with other laws.**

When the sale or transportation of any product for which registration of a trademark is sought is regulated under an Act of Congress, the Patent and Trademark Office may make appropriate inquiry as to compliance with such Act for the sole purpose of determining lawfulness of the commerce recited in the application.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37592, Sept. 11, 1989]

AMENDMENT OF APPLICATION

Authority: Sections 2.71 to 2.75 also issued under §12, 60 Stat. 432; 15 U.S.C. 1062.

37 CFR 2.71 Amendments to correct informalities.

(a) The application may be amended to correct informalities, or to avoid objections made by the Patent and Trademark Office, or for other reasons arising in the course of examination.

(b) The identification of goods or services may be amended to clarify or limit the identification, but additions will not be permitted.

(c) If the verification or declaration filed with the application is defective, the defect may be corrected only by the submission of a substitute or supplemental verification or declaration in accordance with §2.20. A verification or declaration required under §§2.21(a)(6), 2.76(e)(3) or 2.88(e)(3), to be properly signed, must be signed by the applicant, a member of the applicant firm, or an officer of the applicant corporation or association. A verification or declaration which is signed by a person having color of authority to sign, is acceptable for the purpose of determining the timely filing of the paper. Persons having color of authority to sign are those who have first-hand knowledge of the truth of the statements in the verification or declaration and who also have actual or implied authority to act on behalf of the applicant. However, a properly signed substitute verification or declaration must be submitted before the application will be approved for publication or registration, as the case may be.

(d)(1) No amendment to the dates of use will be permitted unless the amendment is supported by applicant's affidavit or declaration in accordance with §2.20 and by such showing as may be required.

(2) In an application under §1(a) of the Act, no amendment to specify a date of use which is subsequent to the filing date of the application will be permitted.

(3) In an application under §1(b) of the Act, after the filing of a statement of use under §2.88, no amendment will be permitted to the statement of use to recite dates of use which are subsequent to the expiration of the time allowed to applicant for filing a statement of use.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37592, Sept. 11, 1989]

37 CFR 2.72 Amendments to description or drawing of the mark.

(a) Amendments may not be made to the description or drawing of the mark if the character of the mark is materially altered. The determination of whether a proposed amendment materially alters the character of the mark will be made by comparing the proposed amendment with the description or drawing of the mark as originally filed.

(b) In applications under §1(a) of the Act, amendments to the description or drawing of the mark may be permitted only if warranted by the specimens (or facsimiles) as originally filed, or supported by additional specimens (or facsimiles) and a supplemental affidavit or declaration in accordance with §2.20 alleging that the mark shown in the amended drawing was in use prior to the filing date of the application.

(c) In applications under §1(b) of the Act, amendments to the description or drawing of the mark, which are filed after submission of an amendment to allege use under §2.76 or a statement of use under §2.88, may be permitted only if warranted by the specimens (or facsimiles) filed, or supported by additional specimens (or facsimiles) and a supplemental affidavit or declaration in accordance with §2.20 alleging that the mark shown in the amended drawing is in use in commerce. In the case

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of a statement of use under §2.88, applicant must verify that the mark shown in the amended drawing was in use in commerce prior to the filing of the statement of use or prior to the expiration of the time allowed to applicant for filing a statement of use.

(d) In applications under §44 of the Act, amendments to the description or drawing of the mark may be permitted only if warranted by the description or drawing of the mark in the foreign registration certificate.

[48 FR 23134, May 23, 1983, as amended at 54 FR 37593, Sept. 11, 1989]

37 CFR 2.73 Amendment to recite concurrent use.

(a) An application under §1(a) of the Act may be amended so as to be treated as an application for a concurrent registration, provided the application as amended satisfies the requirements of §2.42. The examiner will determine whether the application, as amended, is acceptable.

(b) An application under §1(b) of the Act may not be amended so as to be treated as an application for a concurrent registration until an acceptable amendment to allege use under §2.76 or statement of use under §2.88 has been filed in the application, after which time such an amendment may be made, provided the application as amended satisfies the requirements of §2.42. The examiner will determine whether the application, as amended, is acceptable.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37593, Sept. 11, 1989]

37 CFR 2.74 Form of amendment.

(a) In every amendment the exact word or words to be stricken out or inserted in the application must be specified and the precise point indicated where the deletion or insertion is to be made. Erasures, additions, insertions, or mutilations of the papers and records must not be made by the applicant or his attorney or agent.

(b) When an amendatory clause is amended, it must be wholly rewritten so that no interlineation or erasure will appear in the clause, as finally amended, when the application is passed to registration. If the number or nature of the amendments shall render it otherwise difficult to consider the case or to arrange the papers for printing or copying, or when otherwise desired to clarify the record, the examiner may require the entire statement to be rewritten.

37 CFR 2.75 Amendment to change application to different register.

(a) An application for registration on the Principal Register under §1(a) or 44 of the Act may be changed to an application for registration on the Supplemental Register and vice versa by amending the application to comply with the rules relating to the appropriate register, as the case may be.

(b) An application under §1(b) of the Act may be amended to change the application to a different register only after submission of an acceptable amendment to allege use under §2.76 or statement of use under §2.88. When such an application is changed from the Principal Register to the Supplemental Register, the effective filing date of the application is the date of the filing of the allegation of use under §1(c) or 1(d) of the Act.

[41 FR 758, Jan. 5, 1976, as amended at 54 FR 37593, Sept. 11, 1989]

37 CFR 2.76 Amendment to allege use.

(a) An application under §1(b) of the Act may be amended to allege use of the mark in commerce under §1(c) of the Act at any time between the filing of the application and the date the examiner approves the mark for publication or the date of expiration of the six-month response period after issuance of a final action. Thereafter, an allegation of use may be submitted only as a statement of use under §2.88 after the issuance of a notice of allowance under §13(b)(2) of the Act. If an amendment to allege use is filed outside the time period specified in this paragraph, it will be returned to the applicant.

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

- (1) A verified statement that the applicant is believed to be the owner of the mark sought to be registered and that the mark is in use in commerce, specifying the