

Trademark Laws and Regulations

date of the applicant's first use of the mark and first use of the mark in commerce, the type of commerce, those goods or services specified in the application on or in connection with which the mark is in use in commerce and the mode or manner in which the mark is used on or in connection with such goods or services;

- (2) Three specimens or facsimiles, conforming to the requirements of §§2.56, 2.57 and 2.58, of the mark as used in commerce; and
- (3) The fee prescribed in §2.6.

(c) An amendment to allege use may be filed only when the applicant has made use of the mark in commerce on or in connection with all of the goods or services, as specified in the application, for which applicant will seek registration in that application unless the amendment to allege use is accompanied by a request in accordance with §2.87 to divide out from the application the goods or services to which the amendment pertains. If more than one item of goods or services is specified in the amendment to allege use, the dates of use required in paragraph (b)(1) of this section need be for only one of the items specified in each class, provided the particular item to which the dates apply is designated.

(d) The title "Amendment to allege use under §2.76" should appear at the top of the first page of the paper.

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

- (1) The fee prescribed in §2.6;
- (2) At least one specimen or facsimile of the mark as used in commerce; and
- (3) A verification or declaration signed by the applicant stating that the mark is in use in commerce.

(f) A timely filed amendment to allege use which meets the minimum requirements specified in paragraph (e) of this section will be examined in accordance with §§2.61 through 2.69. If, as a result of the examination of the amendment to allege use, applicant is found not entitled to registration for any reason not previously stated, applicant will be so notified and advised of the reasons and of any formal requirements or refusals. The notification shall restate or incorporate by reference all unresolved refusals or requirements previously stated. The amendment to allege use may be amended in accordance with §§2.59 and 2.71 through 2.75. If the amendment to allege use is acceptable in all respects, the applicant will be notified of its acceptance. The filing of such an amendment shall not constitute a response to any outstanding action by the Trademark Examining Attorney.

(g) If the amendment to allege use is filed within the permitted time period but does not meet the minimum requirements specified in paragraph (e) of this section, applicant will be notified of the deficiency. The deficiency may be corrected provided the mark has not been approved for publication or the six-month response period after issuance of a final action has not expired. If an acceptable amendment to correct the deficiency is not filed prior to approval of the mark for publication or prior to the expiration of the six-month response period after issuance of a final action, the amendment will not be examined.

(h) An amendment to allege use may be withdrawn for any reason prior to approval of a mark for publication or expiration of the six-month response period after issuance of a final action.

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

37 CFR 2.77 Amendments between notice of allowance and statement of use.

An application under §1(b) of the Act may not be amended during the period between the issuance of the notice of allowance under §13(b)(2) of the Act and the filing of a statement of use under §2.88, except to delete specified goods or services. Other amendments filed during this period will be placed in the application file and considered when the statement of use is examined.

[54 FR 37594, Sept. 11, 1989]

PUBLICATION AND POST PUBLICATION

37 CFR 2.80 Publication for opposition.

If, on examination or reexamination of an application for registration on the Principal Register, it appears that the applicant is entitled to have his mark registered, the mark will be published in the Official Gazette for opposition. The mark will also be published in the case of an application to be placed in interference or concurrent use proceedings, if otherwise registrable.

[41 FR 758, Jan. 5, 1976]

37 CFR 2.81 Post publication.

(a) Except in an application under §1(b) of the Act for which no amendment to allege use under §2.76 has been submitted and accepted, if no opposition is filed within the time permitted or all oppositions filed are dismissed, and if no interference is declared and no concurrent use proceeding is instituted, the application will be prepared for issuance of the certificate of registration as provided in §2.151.

(b) In an application under §1(b) of the Act for which no amendment to allege use under §2.76 has been submitted and accepted, if no opposition is filed within the time permitted or all oppositions filed are dismissed, and if no interference is declared, a notice of allowance will issue. The notice of allowance will state the serial number of the application, the name of the applicant, the correspondence address, the mark, the identification of goods or services, and the issue date of the notice of allowance. The mailing date that appears on the notice of allowance will be the issue date of the notice of allowance. Thereafter, the applicant shall submit a statement of use as provided in §2.88.

[48 FR 23135, May 23, 1983, as amended at 54 FR 37594, Sept. 11, 1989]

37 CFR 2.82 Marks on Supplemental Register published only upon registration.

In the case of an application for registration on the Supplemental Register the mark will not be published for opposition but if it appears, after examination or reexamination, that the applicant is entitled to have the mark registered, a certificate of registration will issue as provided in §2.151. The mark will be published in the Official Gazette when registered.

[30 FR 13193, Oct. 16, 1965. Redesignated at 37 FR 2880, Feb. 9, 1972, as amended at 54 FR 37594, Sept. 11, 1989]

37 CFR 2.83 Conflicting marks.

(a) Whenever an application is made for registration of a mark which so resembles another mark or marks pending registration as to be likely to cause confusion or mistake or to deceive, the mark with the earliest effective filing date will be published in the Official Gazette for opposition if eligible for the Principal Register, or issued a certificate of registration if eligible for the Supplemental Register.

(b) In situations in which conflicting applications have the same effective filing date, the application with the earliest date of execution will be published in the Official Gazette for opposition or issued on the Supplemental Register.

(c) Action on the conflicting application which is not published in the Official Gazette for opposition or not issued on the Supplemental Register will be suspended by the Examiner of Trademarks until the published or issued application is registered or abandoned.

[37 FR 2880, Feb. 9, 1972, as amended at 54 FR 37594, Sept. 11, 1989]

37 CFR 2.84 Jurisdiction over published applications.

(a) The examiner may exercise jurisdiction over an application up to the date the mark is published in the Official Gazette. After publication of an application under §1(a) or 44 of the Act the examiner may, with the permission of the Commissioner, exercise jurisdiction over the application. After publication of an application under §1(b) of the Act, the examiner may exercise jurisdiction over the application after the issuance of the notice of allowance under §13(b)(2) of the Act. After

Trademark Laws and Regulations

publication, and prior to issuance of a notice of allowance in an application under §1(b), the examiner may, with the permission of the Commissioner, exercise jurisdiction over the application.

(b) After publication, but before the printing of the certificate of registration in an application under §1(a) or 44 of the Act, or before the printing of the notice of allowance in an application under §1(b) of the Act, an application which is not the subject of an inter partes proceeding before the Trademark Trial and Appeal Board may be amended if the amendment does not necessitate republication of the mark or issuance of an Office action. Otherwise, an amendment to such an application may be submitted only upon petition to the Commissioner to restore jurisdiction of the application to the examiner for consideration of the amendment and further examination. The amendment of an application which is the subject of an inter partes proceeding before the Trademark Trial and Appeal Board is governed by §2.133.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37595, Sept. 11, 1989]

CLASSIFICATION

Authority: Sections 2.85 to 2.88 also issued under §30, 60 Stat. 436; 15 U.S.C. 1112.

37 CFR 2.85 Classification schedules.

(a) Section 6.1 of Part 6 of this chapter specifies the system of classification for goods and services which applies for all statutory purposes to trademark applications filed in the Patent and Trademark Office on or after September 1, 1973, and to registrations issued on the basis of such applications. It shall not apply to applications filed on or before August 31, 1973, nor to registrations issued on the basis of such applications.

(b) With respect to applications filed on or before August 31, 1973, and registrations issued thereon, including older registrations issued prior to that date, the classification system under which the application was filed will govern for all statutory purposes, including, inter alia, the filing of petitions to revive, appeals, oppositions, petitions for cancellation, affidavits under §8 and renewals, even though such petitions to revive, appeals, etc., are filed on or after September 1, 1973.

(c) Section 6.2 of Part 6 of this chapter specifies the system of classification for goods and services which applies for all statutory purposes to all trademark applications filed in the Patent and Trademark Office on or before August 31, 1973, and to registrations issued on the basis of such applications, except when the registration may have been issued under a classification system prior to that set forth in §6.2. Moreover, this classification will also be utilized for facilitating trademark searches until all pending and registered marks in the search file are organized on the basis of the international system of classification.

(d) Renewals filed on registrations issued under a prior classification system will be processed on the basis of that system.

(e) Where the amount of the fee received on filing an appeal in connection with an application or on an application for renewal or in connection with a petition for cancellation is sufficient for at least one class of goods or services but is less than the required amount because multiple classes in an application or registration are involved, the appeal or renewal application or petition for cancellation will not be refused on the ground that the amount of the fee was insufficient if the required additional amount of the fee is received in the Patent and Trademark Office within the time limit set forth in the notification of this defect by the Office, or if action is sought only for the number of classes equal to the number of fees submitted.

(f) Sections 6.3 and 6.4 specify the system of classification which applies to certification marks and collective membership marks.

(g) Classification schedules shall not limit or extend the applicant's rights.

[38 FR 14681, June 4, 1973, as amended at 39 FR 16885, May 1 1974; 47 FR 41282, Sept 17, 1982]

37 CFR 2.86 Application may include multiple goods or services comprised in single class or multiple classes.

(a) An application may recite more than one item of goods, or more than one service,

Trademark Laws and Regulations

comprised in a single class, provided the goods or services are specifically identified and the applicant either has used the mark on or in connection with all of the specified goods or services, or has a bona fide intention to use the mark on or in connection with all of the specified goods or services.

(b) An application also may be filed to register the same mark for goods and/or services comprised in multiple classes, provided the goods or services are specifically identified; a fee equaling the sum of the fees for filing an application in each class is submitted; and the application includes either dates of use and three specimens for each class, or a statement of a bona fide intention to use the mark on or in connection with all of the goods or services specified in each class. An amendment to allege use under §2.76 or a statement of use under §2.88, filed in a multiple class application under §1(b) of the Act, must include, for each class, the required fee, dates of use and three specimens. A single certificate of registration for the mark shall be issued, unless the application is divided pursuant to §2.87.

(c) The applicant may not allege use as to certain goods or services and a bona fide intention to use as to other goods or services in the same application, regardless of the number of classes contained therein.

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37954, Sept. 11, 1989]

37 CFR 2.87 Dividing an application.

(a) An application may be physically divided into two or more separate applications upon the payment of a fee for each new application created and submission by the applicant of a request in accordance with paragraph (d) of this section.

(b) In the case of a request to divide out one or more entire classes from an application, only the fee under paragraph (a) of this section will be required. However, in the case of a request to divide out some, but not all, of the goods or services in a class, an application filing fee for each new separate application to be created by the division must be submitted, together with the fee under paragraph (a) of this section. Any outstanding time period for action by the applicant in the original application at the time of the division will be applicable to each new separate application created by the division.

(c) A request to divide an application may be filed at any time between the filing of the application and the date the Trademark Examining Attorney approves the mark for publication or the date of expiration of the six-month response period after issuance of a final action; or during an opposition, upon motion granted by the Trademark Trial and Appeal Board. Additionally, a request to divide an application under §1(b) of the Act may be filed with a statement of use under §2.88 or at any time between the filing of a statement of use and the date the Trademark Examining Attorney approves the mark for registration or the date of expiration of the six-month response period after issuance of a final action.

(d) A request to divide an application should be made in a separate paper from any other amendment or response in the application. The title "Request to divide application." should appear at the top of the first page of the paper.

[37 FR 3898, Feb. 24, 1972, as amended at 54 FR 37595, Sept. 11, 1989; 57 FR 38190, Aug. 21, 1992]

POST NOTICE OF ALLOWANCE**37 CFR 2.88 Filing statement of use after notice of allowance.**

(a) In an application under §1(b) of the Act, a statement of use, required under §1(d) of the Act, must be filed within six months after issuance of a notice of allowance under §13(b)(2) of the Act, or within an extension of time granted under §2.89. A statement of use that is filed prior to issuance of a notice of allowance is premature, will not be considered, and will be returned to the applicant.

(b) A complete statement of 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