

Trademark Laws and Regulations

applicant has complied with the law and that he is entitled to registration of his mark on the Principal Register or on the Supplemental Register, as the case may be. The certificate will state the date on which the application for registration was filed in the Patent and Trademark Office, the act under which the mark is registered, the date of issue and the number of the certificate. Attached to the certificate and forming a part thereof will be a reproduction of the mark and pertinent data from the application. A notice of the affidavit or declaration requirements of §8(a) of the Act (§2.161) will be printed on the certificate.

PUBLICATION OF MARKS REGISTERED UNDER 1905 ACT

Authority: Sections 2.153 to 2.156 also issued under §12, 60 Stat. 432; 15 U.S.C. 1062.

37 CFR 2.153 Publication requirements.

A registrant of a mark registered under the provisions of the Acts of 1881 or 1905 may at any time prior to the expiration of the period for which the registration was issued or renewed, upon the payment of the prescribed fee, file an affidavit or declaration in accordance with §2.20 setting forth those goods stated in the registration on which said mark is in use in commerce, specifying the nature of such commerce, and stating that the registrant claims the benefits of the Trademark Act of 1946.

[31 FR 5262, Apr. 1, 1966]

37 CFR 2.154 Publication in Official Gazette.

A notice of the claim of benefits under the Act of 1946 and a reproduction of the mark will then be published in the Official Gazette as soon as practicable. The published mark will retain its original registration number.

37 CFR 2.155 Notice of publication.

A notice of such publication of the mark and of the requirement for the affidavit or declaration specified in §8(b) of the Act (§2.161) will be sent to the registrant.

37 CFR 2.156 Not subject to opposition; subject to cancellation.

The published mark is not subject to opposition on such publication in the Official Gazette, but is subject to petitions to cancel as specified in §2.111 and to cancellation for failure to file the affidavit or declaration specified in §2.161.

REREGISTRATION OF MARKS REGISTERED UNDER PRIOR ACTS**37 CFR 2.158 Reregistration of marks registered under Acts of 1881, 1905, and 1920.**

Trademarks registered under the Act of 1881, the Act of 1905 or the Act of 1920 may be reregistered under the Act of 1946, either on the Principal Register, if eligible, or on the Supplemental Register, but a new complete application for registration must be filed complying with the rules relating thereto, and such application will be subject to examination and other proceedings in the same manner as other applications filed under the Act of 1946. See §2.26 for use of old drawing.

CANCELLATION FOR FAILURE TO FILE AFFIDAVIT OR DECLARATION DURING SIXTH YEAR

Authority: Sections 2.161 to 2.165 also issued under §8, 60 Stat. 431; 15 U.S.C. 1058.

37 CFR 2.161 Cancellation for failure to file affidavit or declaration during sixth year.

Any registration under the provisions of the Act and any registration published under the provisions of §12(c) of the Act (§2.153) shall be cancelled as to any goods or services recited in the registration at the end of six years following the date of registration or the date of such publication,

Trademark Laws and Regulations

unless within one year next preceding the expiration of such six years the registrant shall file in the Patent and Trademark Office an affidavit or declaration in accordance with §2.20 setting forth those goods or services recited in the registration on or in connection with which the mark is in use in commerce and attaching a specimen or facsimile showing current use of the mark, or an affidavit or declaration under §2.20 showing that its nonuse as to any goods or services recited in the registration is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark as to those goods or services.

[48 FR 3977, Jan. 28, 1983, as amended at 54 FR 37597, Sept. 11, 1989]

37 CFR 2.162 Requirements for affidavit or declaration during sixth year.

The affidavit or declaration required by §2.161 must:

- (a) Be executed by the registrant after expiration of the five-year period following the date of registration or of publication under §12(c) of the Act;
- (b) Be filed in the Patent and Trademark Office before the expiration of the sixth year following the date of registration or of publication under §12(c) of the Act;
- (c) Identify the certificate of registration by the registration number and date of registration;
- (d) Include the required fee for each class to which the affidavit or declaration pertains in the registration. If no fee, or a fee insufficient to cover at least one class, is filed before the expiration of the sixth year following the date of registration or of publication under §12(c) of the Act, the affidavit or declaration will not be refused if the required fee(s) (See §2.6) are filed in the Patent and Trademark Office within the time limit set forth in the notification of this defect by the Office. If insufficient fees are included to cover all classes in the registration, the particular class or classes to which the affidavit or declaration pertains should be specified.
- (e) State that the registered mark is in use in commerce, list the goods or services recited in the registration on or in connection with which the mark is in use in commerce, and specify the nature of such commerce (except under paragraph (f) of this section). The statement must be accompanied by a specimen or facsimile, for each class of goods or services, showing current use of the mark. If the specimen or facsimile is found to be deficient, a substitute specimen or facsimile may be submitted and considered even though filed after the sixth year has expired, provided it is supported by an affidavit or declaration pursuant to §2.20 verifying that the specimen or facsimile was in use in commerce prior to the expiration of the sixth year;
- (f) If the registered mark is not in use in commerce on or in connection with the goods or services recited in the registration, recite facts to show that nonuse as to those goods or services is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark as to those goods or services. If the facts recited are found insufficient, further evidence or explanation may be submitted and considered even though filed after the sixth year has expired; and
- (g) Contain the statement of use in commerce or statement as to nonuse and appropriate specimen or facsimile, as required in paragraphs (e) and (f) of this section, for each class to which the affidavit or declaration pertains in this registration.

[41 FR 761, Jan. 5, 1976, as amended at 47 FR 41282, Sept. 17, 1982; 48 FR 3977, Jan. 28, 1983; 54 FR 37597, Sept. 11, 1989]

37 CFR 2.163 Notice to registrant.

If no affidavit or declaration is filed within a reasonable time prior to expiration of the sixth year, the registrant may be notified that the registration will be cancelled by the Commissioner at the end of such sixth year unless the owner files in the Patent and Trademark Office the affidavit or declaration of use or excusable nonuse required by §8. Failure to notify the registrant does not, however, relieve the registrant of the responsibility of filing the affidavit or declaration within the period required by statute.

37 CFR 2.164 Acknowledgment of receipt of affidavit or declaration.

The registrant will be notified by the Examiner of Trademarks of the receipt of the affidavit or declaration and, if satisfactory, of its acceptance.

*Trademark Laws and Regulations***37 CFR 2.165 Reconsideration of affidavit or declaration.**

(a)(1) If the affidavit or declaration filed pursuant to §2.162 is insufficient or defective, the affidavit or declaration will be refused and the registrant will be notified of the reason. Reconsideration of the refusal may be requested within six months from the date of the mailing of the action. The request for reconsideration must state the grounds for the request. A supplemental or substitute affidavit or declaration required by §8 of the Act of 1946 cannot be considered unless it is filed before the expiration of six years from the date of the registration or from the date of publication under §12(c) of the Act. The "Certificate of Mailing or Transmission" procedure provided by §1.8 does not apply to affidavits or declarations or to supplemental or substitute affidavits or declarations filed under §8(a) or (b) of the Act, but the certificate of mailing by "Express Mail" procedure provided by §1.10 does apply thereto.

- (2) A request for reconsideration shall be a condition precedent to a petition to the Commissioner to review the refusal of the affidavit or declaration unless the first action refusing the affidavit or declaration directs the registrant to petition the Commissioner for relief, in which event the petition must be filed within six months from the date of mailing of the action.

(b) If the refusal of the affidavit or declaration is adhered to, the registrant may petition the Commissioner to review the action under §2.146(a)(2). The petition to the Commissioner requesting review of the action adhering to the refusal of the affidavit or declaration must be filed within six months from the date of mailing of the action which denied reconsideration.

(c) The decision of the Commissioner on the petition will constitute the final action of the Patent and Trademark Office. If there is no petition to the Commissioner, the Commissioner will notify the registrant of the refusal of the affidavit or declaration after the expiration of six years from the date of registration or from the date of publication under §12(c) of the Act of 1946, and such notice will constitute the final action of the Office.

(d) A petition to the Commissioner for review of the action shall be a condition precedent to an appeal to or action for review by any court.

[48 FR 23143, May 23, 1983, as amended at 58 FR 54503, Oct. 22, 1993]

37 CFR 2.166 Time of cancellation.

If no affidavit or declaration is filed within the sixth year following registration or publication under §12(c) of the Act, the registration will be cancelled forthwith by the Commissioner. If the affidavit or declaration is filed but is refused, cancellation of the registration will be withheld pending further proceedings.

AFFIDAVIT OR DECLARATION UNDER §15**37 CFR 2.167 Affidavit or declaration under §15.**

The affidavit or declaration in accordance with §2.20 provided by §15 of the Act for acquiring incontestability for a mark registered on the Principal Register or a mark registered under the Act of 1881 or 1905 and published under §12(c) of the Act (§2.153) must:

- (a) Be signed by the registrant;
- (b) Identify the certificate of registration by the certificate number and date of registration;
- (c) Recite the goods or services stated in the registration on or in connection with which the mark has been in continuous use in commerce for a period of five years subsequent to the date of registration or date of publication under §12(c) of the Act, and is still in use in commerce, specifying the nature of such commerce;
- (d) Specify that there has been no final decision adverse to registrant's claim of ownership of such mark for such goods or services, or to registrant's right to register the same or to keep the same on the register;
- (e) Specify that there is no proceeding involving said rights pending in the Patent and Trademark Office or in a court and not finally disposed of;

Trademark Laws and Regulations

(f) Be filed within one year after the expiration of any five-year period of continuous use following registration or publication under §12(c).

The registrant will be notified of the receipt of the affidavit or declaration.

(g) Include the required fee for each class to which the affidavit or declaration pertains in the registration. If no fee, or a fee insufficient to cover at least one class, is filed at an appropriate time, the affidavit or declaration will not be refused if the required fee(s) (See §2.6) are filed in the Patent and Trademark Office within the time limit set forth in the notification of this defect by the Office. If insufficient fees are included to cover all classes in the registration, the particular class or classes to which the affidavit or declaration pertains should be specified.

[30 FR 13193, Oct. 16, 1965, as amended at 47 FR 41282, Sept. 17, 1982]

37 CFR 2.168 Combined with other affidavits or declarations.

(a) The affidavit or declaration filed under §15 of the Act may also be used as the affidavit or declaration required by §8, provided it also complies with the requirements and is filed within the time limit specified in §§2.161 and 2.162.

(b) In appropriate circumstances the affidavit or declaration filed under §15 of the Act may be combined with the affidavit or declaration required for renewal of a registration (see §2.183).

CORRECTION, DISCLAIMER, SURRENDER, ETC.**37 CFR 2.171 New certificate on change of ownership.**

In case of change of ownership of a registered mark, upon request of the assignee, a new certificate of registration may be issued in the name of the assignee for the unexpired part of the original period. The assignment must be recorded in the Patent and Trademark Office, and the request for the new certificate must be signed by the assignee and accompanied by the required fee. The original certificate of registration, if available, must also be submitted.

[31 FR 5262, Apr. 1, 1966]

37 CFR 2.172 Surrender for cancellation.

Upon application by the registrant, the Commissioner may permit any registration to be surrendered for cancellation. Application for such action must be signed by the registrant and must be accompanied by the original certificate of registration, if not lost or destroyed. When there is more than one class in a registration, one or more entire class but less than the total number of classes may be surrendered as to the specified class or classes. Deletion of less than all of the goods or services in a single class constitutes amendment of registration as to that class (see §2.173).

[41 FR 761, Jan. 5, 1976]

37 CFR 2.173 Amendment and disclaimer in part.

(a) Upon application by the registrant, the Commissioner may permit any registration to be amended or any registered mark to be disclaimed in part. Application for such action must specify the amendment or disclaimer and be signed by the registrant and verified or include a declaration in accordance with §2.20, and must be accompanied by the required fee. If the amendment involves a change in the mark, new specimens showing the mark as used in connection with the goods or services, and a new drawing of the amended mark must be submitted. The certificate of registration or, if said certificate is lost or destroyed, a certified copy thereof, must also be submitted in order that the Commissioner may make appropriate entry thereon and in the records of the Office. The registration when so amended must still contain registrable matter and the mark as amended must be registrable as a whole, and such amendment or disclaimer must not involve such changes in the registration as to alter materially the character of the mark.

(b) No amendment in the identification of goods or services in a registration will be permitted except to restrict the identification or otherwise to change it in ways that would not require republication of the mark. No amendment seeking the elimination of a disclaimer will be permitted.

(c) A printed copy of the amendment or disclaimer shall be attached to each printed copy of