ESTTA Tracking number: **ESTTA156610**

Filing date: **08/14/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92028142
Party	Defendant PATSY'S BRAND, INC.
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Date	08/14/2007
Attachments	Opposition by Patsy's to IOB request for reconsideration.pdf (35 pages)(1938402 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

I.O.B. REALTY, INC., Petitioner, v. PATSY'S BRAND, INC., Registrant.	Cancellation No. 92028142
PATSY'S BRAND, INC., Petitioner, v. I.O.B. REALTY, INC., Registrant.	Cancellation No. 92029614

OPPOSITION BY PATSY'S BRAND, INC. TO I.O.B. REALTY'S REQUEST FOR RECONSIDERATION

I. INTRODUCTION

Patsy's Brand, Inc. ("Patsy's Brand") submits this memorandum in opposition to I.O.B. Realty, Inc.'s ("IOB") Request for Reconsideration, filed on July 27, 2007. IOB's request should be denied for the reasons set forth below.

II. ARGUMENT

A. IOB's Request For Reconsideration Fails To Satisfy The Requirements Of T.B.M.P. § 518 And Should Be Denied

IOB's request for reconsideration falls far short of meeting the standard for reconsideration of the Board's June 28, 2007 decision on IOB's motion for final orders. Under T.B.M.P § 518, requests for reconsideration are granted only if the movant demonstrates that "based on the facts

before it and the prevailing authorities, the Board erred in reaching the order or decision it issued." T.B.M.P. § 518. IOB has failed to meet the standard for reconsidering the Board's June 28, 2007 decision. Accordingly, its request for reconsideration should be denied.

IOB does not argue that, based on the facts before the Board and the applicable law, the Board's decision was in error. Instead, IOB impermissibly uses this request as a vehicle to introduce new evidence and seek advisory opinions from the Board.

First, IOB requests that the Board accept a Section 8 declaration filed almost two years after the statutory deadline. However, this belatedly submitted Section 8 declaration, as the Board held in the June 28, 2007 decision, is two years too late. As of July 13, 2007, the Commissioner cancelled IOB's registration for failure to file a Section 8 declaration and its submission and acceptance at this late stage is not only moot but would circumvent the entire statutory registration scheme.

IOB's second request for which it purportedly seeks reconsideration is unclear and non-sensical. The Board's June 28, 2007 decision made clear that the Board would update its files to indicate cancellation of IOB's registrations pursuant to Section 8, and that the proceeding was suspended pending the resolution of the civil action. The Board clearly stated that the proceedings were suspended and not final, and IOB admits as much in its papers. IOB seeks "reconsideration of the termination" of the cancellation proceedings (IOB's Request for Reconsideration, at 3), but provides absolutely no arguments or justifications for such reconsideration.

Finally, IOB asserts that it is not seeking an impermissible advisory opinion even as it seeks "guidance" from the Board on a Court's power to restore a cancelled registration for

failure to file a Section 8 declaration. However, IOB's request for "guidance" clearly is nothing more than a request for an impermissible advisory opinion from the Board, and should be denied.

In short, IOB's has not provided any basis for reconsideration, and its motion should be denied in all respects.

B. There Is No Basis For Reconsideration Of The June 28, 2007 Decision

1. The Board Should Reject IOB's Belatedly Submitted Section 8 Declaration For Former Registration No. 2,213,574 Because The Statutory Period For Filing Has Expired

Initially, it is noted that IOB's attempt to submit a Section 8 declaration has nothing to do with its request for reconsideration. IOB cannot change the facts now to obtain the outcome it desires.

Rather than file a Section 8 declaration at the appropriate time, IOB waited two additional years, and now, by turning a blind eye to the Board's June 28, 2007 decision and the Commissioner's July 13, 2007 order, IOB asks the Board to accept its late declaration without any factual basis or legal authority. The Board should reject IOB's belatedly submitted Section 8 declaration because IOB's registration already has been cancelled by the Commissioner for failure to comply with Section 8 and the Board has no discretion to accept it.

The alleged "unique situation" IOB claims that it faces is a situation of its own making.[1] IOB failed to file the required declaration to maintain its registration by the statutory deadline, namely, by June 29, 2005, and the time for it to do so has long expired. As such, the Commissioner correctly has ordered that its registration remain cancelled for failure to comply with Section 8. *See* 37 C.F.R. § 2.164(b) ("If the affidavit or declaration is not filed within the

[1] Contrary to IOB's claim, the Board did not cancel IOB's registration *sua sponte*. IOB's registration was cancelled in response to Patsy's Brand's cross-motion for rectification of the Register to show that the registration is cancelled pursuant to Section 8 of the Lanham Act. (June 28, 2007 Decision, at 27).

time periods set forth in section 8 of the Act . . . the registration will be cancelled. These deficiencies cannot be cured.") (emphasis added).

Although there is no doubt as to what the law requires and there is no doubt as to the current cancelled status of IOB's registration, IOB alleges that 15 U.S.C. § 1058(c)(2) allows for correction of a deficient Section 8 declaration after the expiration of the statutory six-month grace period and that the "[r]emoval of . . . [the Section 18] basis for cancellation was the first instance where correction of the deficiency could occur." (IOB's Request for Reconsideration, at 4). However, IOB's allegation is without merit for two reasons.

First, IOB's failure to submit a Section 8 declaration in connection with Registration No. 2,213,574 does not invoke application of 15 U.S.C. §1058(c)(2). Specifically, 15 U.S.C. § 1058(c)(2) is inapplicable to IOB's situation because it requires a timely-filed Section 8 declaration, albeit deficient, and does not provide for correction of a Section 8 declaration that was never timely filed. *See* 37 C.F.R. § 2.164. IOB knows this because it admits, as it must, that the statute is not on point here (IOB's Request for Reconsideration, at 4). For example, deficient Section 8 declarations are those that are filed prior to the expiration of the six-month grace period and 1) do not state that the mark is in use in commerce; 2) include insufficient fees to cover the filing for all classes to which the affidavit pertains; 3) are filed within the period specified in Section 8, but are executed prior to that period; 4) fail to list or incorporate by reference the goods or services in the registration; 5) do not include an acceptable specimen for each class of goods or services; or 6) do not designate a domestic representative. *See* October 30, 1999 *Post Registration: Changes To Requirements For Maintaining Trademark Registrations*, Section III (Exhibit 1). IOB's failure to file any declaration of use before the expiration of the six-month grace period set forth in 15 U.S.C. § 1058(c)(1), "cannot be cured

unless there is time remaining in the grace period."[2] *Id.* at Section III(L)(3). As IOB's six-month grace period expired more than two years ago, on June 29, 2005, IOB's late attempt to resuscitate its registration violates the statutory scheme and should be rejected.

Second, as the Board acknowledges in its June 28, 2007 decision (and which IOB ignores), regardless of the fact that IOB's registration was in cancelled status, IOB could have and should have filed its Section 8 declaration prior to June 29, 2005 with the Post-Registration Branch. (June 28, 2007 Decision, at 30). However, IOB did not do so and "cannot now argue that its affidavit would not have been accepted, or that if filed, it should have been accepted." (June 28, 2007 Decision, at 30, n. 24). *See e.g., Checkers Drive-In Restaurants, Inc. v. Commissioner*, 51 F.3d 1078, 1085 (D.D.C. 1995) ("[I]n establishing cancellation as a penalty for failure to file the required affidavit, Congress made no exception for the innocent or negligent."); *In Re Mother Tucker's Food Experience*, 925 F.2d 1402, 1405 (Fed. Cir. 1991); *Abraham's Seed v. John One Ten*, 1 U.S.P.Q.2d 1230, 1232 n. 7 (T.T.A.B. 1986) ("[T]he requirements of [Section 8] . . . must be complied with in order to maintain the registration irrespective of the pendency of a proceeding seeking its cancellation."). Despite the Board's admonition, IOB argues just that: that its Section 8 declaration would not have been accepted. (IOB's Request for Reconsideration, at 4).

IOB missed the deadline for filing its Section 8 declaration and now is attempting to turn back the clock at this late stage in contravention of the entire statutory scheme. IOB should have filed a Section 8 declaration before at least the June 29, 2005 deadline in order to preserve its

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[2] Indeed, this situation is akin to that where the declaration is filed in the name of the wrong party, and the grace period has expired. In that situation, "a substitute affidavit cannot be accepted, even upon payment of a deficiency surcharge. The registration will be cancelled." October 30, 1999 *Post Registration: Changes To Requirements For Maintaining Trademark Registrations*, Section III(D)(1) (Exhibit 1).

registration. Instead, IOB sat back and did nothing and the time has passed for it to do anything at this point because its registration has been cancelled by the Commissioner for failure to file a Section 8 declaration. Accordingly, the Board should refuse to accept IOB's belated submission of a Section 8 declaration in connection with former Registration No. 2,213,574. IOB has not provided any basis for the Board to accept the delinquent filing.

2. The Board Suspended The Proceeding, And It Is Clear That There Is No Final Or Appealable Order

IOB seeks confirmation from the Board that "no final, appealable orders for these cancellation proceedings were issued by the Board." Specifically, IOB requests reconsideration of the Board's decision if the Commissioner's actions of July 13, 2007, namely, cancellation of Registration Nos. 1,975,110 and 2,213,574 for failure to file declarations of continued use, amounts to a final order. However, the Board's June 28, 2007 decision is perfectly clear, and there is no basis for the "reconsideration" that IOB seeks. The June 28, 2007 decision recognizes that the '110 and '574 Registrations would be cancelled by the Commissioner pursuant to Section 8 of the Lanham Act and that the proceedings are suspended pending final resolution of the pending civil action. The Board stated the following:

> . . . (3) The files of IOB's Registration Nos. 2213574, 1975110 will be updated to indicate cancellation of those registrations pursuant to Trademark Act § 8.
>
> (4) This proceeding is suspended pending final resolution of the parties' civil action.

June 28, 2007 Decision, pg. 35 (emphasis added). The Commissioner's July 13, 2007 cancellation for failure to file Section 8 declarations is entirely consistent with the June 28, 2007 Board decision and does not finalize the cancellation proceeding or make the decision

appealable.[3] Accordingly, the status of the proceedings is clear from the June 28, 2007 decision and IOB's request for reconsideration should be denied.

3. IOB Is Seeking An Impermissible Advisory Opinion From The Board

IOB alleges that "Judge Irizarry specifically requested briefing" on the topic of correcting the Register in connection with the pending civil actions, and as a result, asks the Board for "guidance" on this topic. Contrary to IOB's claim, IOB is seeking an impermissible advisory opinion. *See* T.B.M.P. § 605.03(f) ("[T]he Board does not issue advisory opinions."). Moreover, Judge Irizarry did not "specifically request briefing" on this issue. Rather, IOB and the other defendants filed a motion for partial summary judgment to correct the Register,[4] which has been fully briefed by the parties. In fact, Judge Irizarry recently has ordered that "further briefing by either party is NOT necessary" in connection with the motion for summary judgment. (Judge Irizarry's June 29, 2007 Minute Entry) (Exhibit 2). Thus, IOB's representation that the Court requested further briefing is incorrect.

IOB persists in seeking restoration of its cancelled registration even though there is no legal authority to justify restoring the registration. The plain language of 37 C.F.R. § 2.164 is that the failure to file a declaration of use is a deficiency that cannot be cured. *See* 37 C.F.R. § 2.164(b) ("If the affidavit or declaration is not filed within the time periods set forth in section 8 of the Act . . . the registration will be cancelled. These deficiencies cannot be cured."). It is well-established that unless there is some ambiguity in the language of a statute, a Court's analysis must end with the statute's plain language. *See Caminetti v. United States,* 242 U.S. 470

[3] The cancellation proceeding involves cancellation of IOB's registrations on grounds other than a failure to file Section 8 declarations.

[4] Indeed, that motion is moot in light of the Commissioner's July 13, 2007 Order vacating the May 27, 2003 Order and cancelling IOB's registrations pursuant to Section 8. The Register now has been corrected.

(1917). Nothing in 37 C.F.R. or the Lanham Act's legislative history supports a departure from the plain language of the provisions concerning Section 8 declarations. Indeed, a conclusion that a Court can ignore Section 8 and restore a cancelled registration by curing an "incurable" deficiency would override the "plain meaning" of the statute.

In any event, regardless of what a Court should or should not do, IOB's request constitutes an impermissible request for an advisory opinion which should be rejected by the Board.

III. CONCLUSION

For the reasons set forth above, Patsy's Brand respectfully requests that the Board deny IOB's request for reconsideration in its entirety.

Respectfully submitted,

COOPER & DUNHAM LLP

Dated: August 14, 2007

By: _____

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the attached **OPPOSITION BY PATSY'S BRAND, INC. TO I.O.B. REALTY'S REQUEST FOR RECONSIDERATION** has been served this 14th day of August, 2007, by first class mail, addressed to:

Paul Grandinetti, Esq.
Levy & Grandinetti
Suite 408
1725 K Street, N.W.
Washington, D.C. 20006-1419

Tonia A. Sayour

EXHIBIT 1

UNITED STATES DEPARTMENT OF COMMERCE

PATENT AND TRADEMARK OFFICE

OFFICE OF ASSISTANT COMMISSIONER FOR TRADEMARKS

POST REGISTRATION: CHANGES TO REQUIREMENTS FOR MAINTAINING TRADEMARK REGISTRATIONS

October 28, 1999

Effective: October 30, 1999

This notice discusses changes to the requirements for maintaining registrations, effective October 30, 1999.

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I. Summary of Trademark Law Treaty Implementation Act Changes

The Trademark Law Treaty Implementation Act of 1998 (TLTIA), Pub. L. No. 105-330, 112 Stat. 3064 (15 U.S.C. §1051), changed the requirements for filing affidavits or declarations of continued use or excusable nonuse under §8 of the Act (§8 affidavits), 15 U.S.C. §1058, and renewal applications under §9 of the Act, 15 U.S.C. §1059, effective October 30, 1999.

A. Requirements Prior to October 30, 1999

Prior to October 30, 1999, §8 affidavits were required between the fifth and sixth year after the date of registration or publication under §12(c) of the Act, 15 U.S.C. §1062(c). No further affidavits were required under §8 of the Act. There was no grace period for filing a §8 affidavit, and there were certain requirements that had to be satisfied before the expiration of the statutory deadline to avoid cancellation of the registration. The registrant was required to specify the type of commerce in which the mark was in use.

Renewal applications under §9 of the Act were required to be filed within six months before the expiration date of a registration, or within a three-month grace period thereafter upon payment of an additional fee. There were certain requirements that had to be met before the end of the grace period, or the registration would expire. Section 9 of the Act required that the renewal application include an affidavit or declaration of use of the mark in commerce or excusable nonuse, and a specimen of use for each class of goods or services.

B. Requirements on and After October 30, 1999

TLTIA amended §8 of the Act to: (1) add a six-month grace period for filing a §8 affidavit with a grace period surcharge; (2) require a §8 affidavit in the year before the end of every ten-year period after the date of registration, or within the grace period; (3) clarify that the current owner of the mark must file the §8 affidavit; and (4) provide for a period in which a deficient §8 affidavit may be corrected, upon payment of a deficiency surcharge. A §8 affidavit is still required between the fifth and sixth year after the date of registration, or within the six-month grace period. The Trademark Rules of Practice were amended to delete the requirement to specify the type of commerce in

which the mark is in use.

TLTIA amended §9 of the Act to: (1) extend the three-month grace period to six months; (2) extend the time for filing the renewal application from six months to twelve months before expiration of the registration; (3) remove the requirement for a declaration of continued use in commerce or excusable nonuse, and for a specimen of use, in a renewal application; and (4) provide for a period in which a deficient renewal application may be corrected, upon payment of a deficiency surcharge. No renewal application is required during the sixth year.

Accordingly, *both* a §8 affidavit and a §9 renewal application must be filed within the year before the expiration date of the registration, or within the six-month grace period. In substance, except as noted above, the requirements of the combined filing under amended §§8 and 9 of the Act will be the same as the requirements for renewal applications filed before October 30, 1999.

The statutory filing periods for the ten-year §8 affidavits are the same as the statutory filing periods for renewal applications. A §8 affidavit and renewal application may be combined in a single document. *See* §VI(A) of this Notice. Most deficiencies can be cured after expiration of the deadlines set forth in §§8 and 9 of the Act, upon payment of an additional deficiency surcharge. *See* §§III(L) and IV(L) of this Notice for information about the procedures, deadlines, and fees for correcting deficiencies.

TLTIA does not change the duration of a registration. *See* TMEP §1601 regarding the duration of a registration.

II. Effective Date and Transition

The effective date of TLTIA and the changes to the Trademark Rules of Practice is October 30, 1999.

A. Effective Date

1. Section 8 Affidavits

Under TLTIA §109(c), 112 Stat. 3069, the amended provisions of §8 of the Act, 15 U.S.C. §1058, apply to "the filing of an affidavit if the sixth or tenth anniversary of the registration, or the sixth anniversary of publication of the registration under §12(c) of the Trademark Act of 1946 for which the affidavit is filed is on or after [October 30, 1999]."

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

The provisions of §8(a)(3) of the Act, requiring the filing of a §8 affidavit at the end of each successive ten-year period after registration, do not apply to a registration issued or renewed for a twenty-year term (i.e., a registration issued or renewed before November 16, 1989) until a renewal application is due. *See* §II(B)(3) of this Notice.

2. Renewal Applications

Under TLTIA §109(d), 112 Stat. 3069, the amended provisions of §9 of the Act, 15 U.S.C. §1059, apply to "the filing of an application for renewal of a registration if the expiration date of the registration for which the renewal application is filed is on or after [October 30, 1999]."

The revised provisions of §9 of the Act do not apply to applications for renewal of registrations that expire before October 30, 1999, even if the applications are filed or examined after October 30, 1999. For example, if a registration expires on October 29, 1999, the registrant may file a renewal application within six months preceding that date, or within the three-month grace period provided under the old law, i.e., up through January 29, 2000. Neither the new six-month grace period, nor the deficiency period, applies to registrations with expiration dates prior to October 30, 1999.

B. Transition

1. Section 8 Affidavits Filed Before October 30, 1999, Where the Sixth Year Expires After October 30, 1999

The revised provisions of §8 of the Trademark Act apply to the filing of an affidavit of continued use or excusable nonuse under §8 of the Act if: (1) the sixth or any tenth anniversary of registration, or the sixth anniversary of publication under §12(c) of the Act, is on or after October 30, 1999; and (2) the affidavit is filed on or after October 30, 1999.

Because TLTIA §109(c), 112 Stat. 3069, states that the amended provisions of §8 of the Act apply only to "the filing" of an affidavit if the sixth (or any tenth) anniversary of the registration, or the sixth anniversary of the date of publication under §12(c) of the Act, is on or after October 30, 1999, the Office will apply the revised provisions of §8 of the Act only to §8 affidavits *filed* on or after October 30, 1999. The old law will apply to §8 affidavits filed before October 30, 1999, even if the sixth anniversary is on or after October 30, 1999. This will assist in avoiding confusion and in providing assurance to registrants and attorneys who need to know which law will apply before papers are prepared and filed.

If a §8 affidavit is timely filed before October 30, 1999, for a registration whose sixth anniversary is on or after October 30, 1999, and found to be deficient, it is possible that no time will remain in the statutory period during which defects could be cured under the old law. In this situation, if there is time remaining in the new six-month grace period, the owner of the registration must file a complete new affidavit, with a specimen, filing fee, and grace period surcharge, in order to obtain the benefits of the TLTIA provisions for curing deficiencies.

If there is no time remaining in the new six-month grace period, the registration will be cancelled.

> *Example*: If the sixth year expires on November 5, 1999, and a §8 affidavit is filed October 15, 1999, without a specimen, the old law will apply. Under the old law, the registration must be cancelled if no specimen is filed before the end of the sixth year. TMEP §1603.08. To gain the benefit of the TLTIA provisions for curing deficiencies, the owner of the registration must file a complete new §8 affidavit within six months after the expiration of the sixth year (i.e., on or before May 5, 2000), with a specimen, a new filing fee, and grace period surcharge.

2. Renewal Applications Filed Before October 30, 1999, for Registrations That Expire After October 30, 1999

The revised provisions of §9 of the Trademark Act apply to the filing of a renewal application if: (1) the registration expires on or after October 30, 1999; and (2) the renewal application is filed on or after October 30, 1999.

Because TLTIA §109(d), 112 Stat. 3069, states that the amended provisions of §9 of the Act apply only to "the filing" of a renewal application if the expiration date of the registration is on or after October 30, 1999, the Office will apply the new law only to renewal applications *filed* on or after October 30, 1999. The old law will apply to renewal applications filed before October 30, 1999, even if the registration expires on or after October 30, 1999.

If a renewal application is timely filed before October 30, 1999, for a registration that expires on or after October 30, 1999, and found to be deficient, it is possible that no time will remain in the three-month grace period during which defects could be cured under the old law. In this situation, if there is time remaining in the new six-month grace period, in order to obtain the benefits of the TLTIA provisions for curing deficiencies, the registrant must file: (1) a complete new §9 renewal application, with a filing fee, and grace period surcharge; *and* (2) a complete §8 affidavit with a specimen, filing fee, and grace period surcharge, within six months after the expiration of the registration.

If there is no time remaining in the new six-month grace period, the registration will expire.

> *Example*: If the registration expires on November 5, 1999, and a renewal application is filed October 15, 1999, without a specimen, the old law will apply. Under the old law, the registration will expire if the registrant does not file a specimen (together with a grace period surcharge) before the end of the three-month grace period (i.e., on or before February 5, 2000). TMEP §1605.06. To gain the benefit of the TLTIA provisions for curing deficiencies, the owner of the registration must submit: (1) a complete new §9 renewal application (with a filing fee and grace period surcharge); and (2) a complete new §8 affidavit (with a specimen, filing fee, and grace period surcharge), within six months after the expiration of the registration (i e., on or before May 5, 2000).

3. Registrations in Twenty-Year Terms

The provisions of §8(a)(3) of the Act, requiring the filing of a §8 affidavit at the end of each successive ten-year period after registration, do not apply to a registration issued or renewed for a twenty-year term (i.e., a registration issued or renewed before November 16, 1989) until a renewal application is due.

> *Example*: If a registration was issued or renewed on November 5, 1989, no §8 affidavit is due between November 5, 1998 and November 5, 1999. Section 8(a)(3) of the Act does not apply until the renewal application is due, i.e., between November 5, 2008 and November 5, 2009.

Should the Office receive a §8 affidavit during the tenth year for a registration in a twenty-year term, the Office will refund the filing fee and notify the filer that the document will not be processed. The document will not be returned.

III. Affidavit of Continued Use or Excusable Nonuse of Mark in Commerce under Section 8

15 U.S.C. §1058. Duration.

(a) Each registration shall remain in force for 10 years, except that the registration of any mark shall be canceled by the Commissioner for failure to comply with the provisions of subsection (b) of this section, upon the expiration of the following time periods, as applicable:

(1) For registrations issued pursuant to the provisions of this Act, at the end of 6 years following the date of registration.

(2) For registrations published under the provisions of section 12(c), at the end of 6 years following the date of publication under such section.

(3) For all registrations, at the end of each successive 10-year period following the date of registration.

(b) During the 1-year period immediately preceding the end of the applicable time period set forth in subsection (a), the owner of the registration shall pay the prescribed fee and file in the Patent and Trademark Office--

(1) an affidavit setting forth those goods or services recited in the registration on or in connection with which the mark is in use in commerce and such number of specimens or facsimiles showing current use of the mark as may be required by the Commissioner; or

(2) an affidavit setting forth those goods or services recited in the registration on or in connection with which the mark is not in use in commerce and showing that any such nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark.

(c)(1) The owner of the registration may make the submissions required under this section within a grace period of 6 months after the end of the applicable time period set forth in subsection (a). Such submission is required to be accompanied by a surcharge prescribed by the Commissioner.

(2) If any submission filed under this section is deficient, the deficiency may be corrected after the statutory time period and within the time prescribed after notification of the deficiency. Such submission is required to be accompanied by a surcharge prescribed by the Commissioner.

(d) Special notice of the requirement for affidavits under this section shall be attached to each certificate of registration and notice of publication under section 12(c).

(e) The Commissioner shall notify any owner who files 1 of the affidavits required by this section of the Commissioner's acceptance or refusal thereof and, in the case of a refusal, the reasons therefor.

(f) If the registrant is not domiciled in the United States, the registrant shall 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. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, such notice or process may be served upon the Commissioner.

Under §8 of the Trademark Act, 15 U.S.C. §1058, the owner of the registration must file an affidavit or declaration of continued use or excusable nonuse within the following time periods, or the registration will be cancelled:

(1) between the fifth and sixth year after the date of registration or date of publication under §12(c) of the Act; *and*

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

Section 8(a)(3) of the Act, 15 U.S.C. §1058(a)(3), requires an affidavit or declaration of continued use or excusable nonuse at the end of each successive ten-year period following the date of registration for *all registrations*, including registrations issued under the Acts of 1881, 1905 and 1920. However, this requirement does not apply to a registration issued or renewed for a twenty-year term (i.e., a registration issued or renewed before November 16, 1989) until a renewal application is due. *See* §II(B)(3) of this Notice.

A. Requirements for Affidavit or Declaration of Continued Use or Excusable Nonuse

37 C.F.R. §2.161. Requirements for a complete affidavit or declaration of continued use or excusable nonuse

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

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

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

(1) a person with legal authority to bind the owner; or

(2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or

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

(c) Include the registration number;

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

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

(3) If at least one fee is submitted for a multi-class registration, but the class(es) to which the fee(s) should be applied are not specified, the Office will issue a notice requiring either the submission of additional fee(s) or an indication of the class(es) to which the original fee(s) should be applied. Additional fee(s) may be submitted if the requirements of §2.164 are met. If the required fee(s) are not submitted and the class(es) to which the original fee (s) should be applied are not specified, the Office will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class;

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

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

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

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

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

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

(2) Be flat and no larger than 8-1/2 inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long. If a specimen exceeds these size requirements (a "bulky specimen"), the Office will create a facsimile of the specimen that meets the requirements of the rule (i.e., is flat and no larger than 8-1/2 inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long) and put it in the file wrapper;

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

B. Time for Filing Affidavit

Under §8(a) of the Trademark Act, 15 U.S.C. §1058(a), the owner of the registration must file the affidavit or declaration of continued use or excusable nonuse: (1) at the end of six years after the date of registration or date of publication under §12(c) of the Act; *and* (2) at the end of every ten-year period after the date of registration. *See* Trademark Rule 2.160(a), 37 C.F.R. §2.160(a).

Section 8(b) of the Act, 15 U.S.C. §1058(b), provides that the owner may file the affidavit or declaration during the one year immediately preceding the deadline set forth in §8(a) of the Act.

Under §8(c)(1) of the Act, 15 U.S.C. §1058(c)(1), the affidavit or declaration may be filed within a grace period of six months after the expiration of the deadline set forth in §8(a) of the Act, upon payment of an additional grace period surcharge.

If the owner of the registration does not file an affidavit or declaration of continued use or excusable nonuse before the end of the grace period, the registration will be cancelled. 37 C.F.R. §§2.160(a) and 2.164(b).

The affidavit cannot be filed before the period specified in §§8(a) and (b) of the Act. The purpose of the affidavit is to show that the mark is still in use in commerce within the relevant period, which cannot be done by an affidavit filed prior to that period. *In re Holland American Wafer Co., 737 F.2d 1015*, 222 USPQ 273 (Fed. Cir. 1984). If an affidavit is filed before the period specified in §§8(a) and (b) of the Act, the Office will issue a notice advising the registrant that the affidavit is premature; of the appropriate time for filing the §8 affidavit; that the fee(s) submitted will be held; and that the registrant may file a new affidavit at the appropriate time or may request a refund at any time. There is no deficiency surcharge. The prematurely filed affidavit will be placed in the file. If a newly executed affidavit or declaration is not filed before the end of the grace period, the registration will be cancelled and the fees refunded.

C. Fees

1. Filing Fee for Affidavit or Declaration

Under §8(b) of the Trademark Act, 15 U.S.C. §1058(b), and Trademark Rule 2.161(d)(1), 37 C.F.R. §2.161(d)(1), an affidavit or declaration of continued use or excusable nonuse must include the fee required by §2.6 for each class of goods or services that the affidavit or declaration covers.

2. Grace Period Surcharge

If the affidavit or declaration is filed during the grace period under §8(c)(1) of the Act, it must include the grace period surcharge per class required by §2.6. 37 C.F.R. §2.161(d)(2).

The grace period surcharge applies only where no filing was made between the fifth and sixth year after the date of registration or date of publication under §12(c) of the Act, or within the year before the end of any ten-year period after the date of registration. Someone who files within these periods, but corrects a deficiency after these periods have expired, will be subject to the deficiency surcharge only. On the other hand, someone who files during the grace period and cures deficiencies after expiration of the grace period will be subject to both the grace period surcharge (for the ability to file the affidavit during the grace period) *and* the deficiency surcharge (for the ability to correct a deficiency after the end of the grace period).

Currently, the grace period surcharge is $100 per class.

3. Deficiency Surcharge

Section 8(c)(2) of the Trademark Act, 15 U.S.C. §1058(c)(2), requires a "deficiency surcharge" for correcting deficiencies after expiration of the deadlines specified in §8. *See* Trademark Rule 2.164, 37 C.F.R. §2.164, and §III (L) of this Notice regarding the deadlines and fees for correcting deficiencies.

Only a single deficiency surcharge is required for correcting deficienc(ies) in a multi-class registration. Similarly, only a single deficiency surcharge is required to correct several deficiencies within one document. Currently, the deficiency surcharge is $100.

4. Processing Affidavit or Declaration Filed With Insufficient Fees

An affidavit or declaration that does not include sufficient fees to cover the filing fee for all the classes to which the affidavit pertains (and the grace period surcharge, where applicable) is deficient. Deficiencies may be cured before expiration of the deadlines set forth in §8 of the Act for no fee, or after expiration of the deadlines set forth in §8 of the Act upon payment of the deficiency surcharge required by §8(c)(2) of the Act. *See* Trademark Rule 2.164, 37 C.F.R. §2.164, and §III(L) of this Notice for information about the procedures, deadlines, and fees for correcting deficiencies.

If the affidavit or declaration is accompanied by insufficient fees to cover all the classes to which the affidavit pertains, and the affidavit or declaration included an authorization to charge deficient fees to a deposit account, the filing fee (and grace period surcharge, where applicable) will be charged to the deposit account. If the deposit account authorization is included with the affidavit or declaration as filed, and the deposit account has sufficient funds to cover the fee(s) in question, there is no fee deficiency and no deficiency surcharge is required.

An authorization to charge fees to a deposit account with insufficient funds to cover the fee is regarded as a deficiency.

If a check submitted as payment of a filing fee for an affidavit of continued use or excusable nonuse is returned to the Office unpaid, this is also regarded as a deficiency. In addition to the deficiency surcharge (where applicable), there is a $50 fee for processing the returned check. 37 C.F.R. §1.21(m).

If at least one fee is submitted for a multi-class registration, but the class(es) to which the fee(s) should be applied are not specified, the Post Registration paralegal will issue a notice requiring either the submission of additional fee (s) or an indication of the class(es) to which the original fee(s) should be applied. If the required fee(s) are not submitted and the class(es) to which the original fee(s) should be applied are not specified, the Office will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class. 37 C.F.R. §2.161 (d)(3).

D. Ownership, and Who May File Affidavit

1. Affidavit or Declaration Must be Filed by Owner

The §8 affidavit must be filed by the owner of the registration. Filing by the owner is a minimum requirement that must be met before the expiration of the deadline set forth in §8(a) of the Act (i.e., before the end of the sixth year after the date of registration or publication under §12(c) of the Trademark Act, or before the end of every ten-year period after the date of registration), or within the six-month grace period under §8(c)(1) of the Act. Trademark Rule 2.164(b), 37 C.F.R. §2.164(b).

If the affidavit or declaration was filed in the name of the wrong party, and there is time remaining in the filing period or grace period, the true owner must file a complete new affidavit or declaration, together with the filing fee per class required by §2.6, and a specimen of use for each class. If the substitute affidavit or declaration is filed during the grace period, the grace period surcharge per class must also be included with the substitute affidavit.

If the affidavit or declaration was filed in the name of the wrong party, and there is no time remaining in the grace period, a substitute affidavit by the true owner cannot be accepted, even upon payment of a deficiency surcharge. The registration will be cancelled.

The filing fee for an affidavit filed in the name of the wrong party will not be refunded.

2. Establishing Ownership

If the owner set forth in the affidavit is not the owner of record according to the records of the Assignment Division of the Office, continuity of title from the original registrant to the present owner must be shown. *See*TMEP §1603.05(a) regarding the procedures for establishing ownership.

Evidence of ownership may be furnished even after expiration of the deadline set forth in §8 of the Act. If the party who filed the affidavit was the owner of the registration at the time of filing, there is no deficiency, and no deficiency surcharge is required.

The procedures for establishing ownership also apply to changes of name and other changes of legal entity.

The notification of acceptance of a §8 affidavit is issued in the name of the owner of record, as reflected in the records of the Assignment Division of the Office. TMEP §1603.05(c).

3. Correction of Mistake in Setting Forth the Name of the Owner

If the affidavit or declaration was filed in the name of an existing entity that did not own the mark as of the filing date, a substitute affidavit or declaration cannot be filed in the name of the true owner unless there is time remaining in the grace period set forth in §8 of the Act. *See* §III(D)(1) of this Notice. However, if there is no change of name or entity, but a mistake is made in setting out the name of the owner of the registration in the affidavit, the mistake can be corrected. *In re Atlanta Blue Print Co.*, 19 USPQ2d 1078 (Comm'r Pats. 1990).

No deficiency surcharge will be required for correcting a clerical error in setting forth the name of the owner of the registration.

E. Execution of Affidavit or Declaration

1. Persons Who May Sign Affidavit or Declaration

Trademark Rule 2.161(b), 37 C.F.R. §2.161(b), requires that the §8 affidavit or declaration include a statement that is signed and verified (sworn to) or supported by a declaration under §2.20 by a person properly authorized to sign on behalf of the owner. A "person who is properly authorized to sign on behalf of the owner" is: (1) a person with legal authority to bind the owner; or (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or (3) an attorney as defined in 37 C.F.R. §10.1(c) who has an actual or implied written or verbal power of attorney from the owner.

Generally, the Office no longer questions the authority of the person who signs a verification, unless there is an inconsistency in the record as to the signatory's authority to sign. The owner of the registration and/or the owner's attorney are in the best position to determine who has the knowledge and authority to sign a verification.

2. Date of Execution of Affidavit or Declaration

Under Trademark Rule 2.161(b), the verified statement must be executed on or after the beginning of the filing period specified in 37 C.F.R. §2.160(a), i.e., on or after the fifth anniversary of the date of registration or publication under §12(c), or on or after the beginning of each ten-year period after the date of registration. Because the purpose of the affidavit is to attest to the continued use or excusable nonuse of the mark within the time periods specified in §8 of the Act, the affidavit cannot be executed before these time periods begin.

An affidavit filed within the period specified in §8 of the Act, but executed before that period, is deficient. The owner of the registration will be required to submit a substitute or supplemental affidavit or declaration attesting to use in commerce (or excusable nonuse) on or in connection with the goods or services within the relevant period specified in §8 of the Act.

If the §8 affidavit was filed during the relevant period specified in §§8(a) and 8(b) of the Act (i.e., between the fifth and sixth year after the date of registration or publication under §12(c) of the Trademark Act, or within one year before the end of any ten-year period after the date of registration), the substitute affidavit may be filed before expiration of the relevant period for no fee, or after expiration of the relevant period upon payment of the deficiency surcharge required under §8(c)(2) of the Act. If the §8 affidavit was filed during the grace period, the substitute affidavit may be filed before expiration of the grace period for no fee, or after expiration of the grace period upon payment of the deficiency surcharge. *See* Trademark Rule 2.160(a), 37 C.F.R. §2.160(a), and §III(B) of this Notice regarding the deadlines for filing §8 affidavits. *See also* Trademark Rule 2.164, 37 C.F.R. §2.164, and §III(L) of this Notice for information about the procedures, deadlines, and fees for correcting deficiencies.

F. Goods and/or Services Set Forth in Affidavit or Declaration

1. Goods and/or Services Must be Specified or Expressly Incorporated by Reference

Sections 8(b)(1) and (2) of the Trademark Act, 15 U.S.C. §§1058(b)(1) and (2), and Trademark Rule 2.161(e)(1), 37 C.F.R. §2.161(e)(1), require that the affidavit or declaration specify the goods or services recited in the registration on or in connection with which the mark is in use in commerce, and/or the goods or services for which nonuse is claimed. The affidavit or declaration may incorporate by reference the identification set forth in the registration certificate. Incorporation by reference is recommended.

2. No Goods or Services Listed

An affidavit or declaration that fails to list or incorporate by reference the goods or services in the registration is deficient. The owner must file a substitute or supplemental affidavit or declaration listing the goods or services, and stating that the mark was in use in commerce on or in connection with the goods or services during the relevant filing period specified in §8 of the Act. If the §8 affidavit was filed during the relevant period specified in §§8(a) and 8(b) of the Act (i.e., between the fifth and sixth year after the date of registration or publication under §12(c) of the Trademark Act, or within one year before the end of any ten-year period after the date of registration), the substitute affidavit may be filed before expiration of the relevant period for no fee, or after expiration of the relevant period upon payment of the deficiency surcharge required under §8(c)(2) of the Act. If the §8 affidavit was filed during the grace period, the substitute affidavit may be filed before expiration of the grace period for no fee, or after expiration of the grace period upon payment of the deficiency surcharge. *See* Trademark Rule 2.160(a), 37 C.F.R. §2.160(a), and §III(B) of this Notice regarding the deadlines for filing §8 affidavits. *See also* Trademark Rule 2.164, 37 C.F.R. §2.164, and §III(L) of this Notice for information about the procedures, deadlines, and fees for correcting deficiencies.

3. Failure to List All Goods or Services Recited in Registration

An affidavit or declaration that fails to list or incorporate by reference all the goods or services to which the affidavit pertains is deficient.

If the affidavit or declaration covers less than all the goods or services listed in the registration, and the owner does not expressly indicate an intention to delete the goods or services, the Post Registration Section of the Office should confirm that the owner intends to delete the goods or services. If the owner did not intend to delete the goods, the owner may file a substitute or supplemental affidavit or declaration adding the omitted goods or services, provided that the owner verifies that the mark was in use in commerce on or in connection with the goods or services during the relevant filing period specified in §8 of the Act. This substitute affidavit may be filed before expiration of the relevant deadline set forth in §8 of the Act for no fee, or after expiration of the deadline set forth in §8 of the Act upon payment of the deficiency surcharge required by §8(c)(2) of the Act. See Trademark Rule 2.164, 37 C.F.R. §2.164, and §III(L) of this Notice for information about the procedures, deadlines, and fees for correcting deficiencies.

If the owner does not file a substitute or supplemental affidavit or declaration that the mark was in use in commerce on or in connection with the omitted goods or services during the relevant filing period specified in §8 of the Act, the omitted goods or services will be deleted from the registration, and the registration will be deemed cancelled as to those items.

4. Deletion of Goods

If the owner of the registration intends to delete goods from the registration, this should be expressly stated in the affidavit or declaration. Trademark Rule 2.161(e)(2), 37 C.F.R. §2.161(e)(2). This will avoid an unnecessary inquiry by the paralegal as to whether the owner intends to delete the goods or services from the registration.

5. New Goods or Services Cannot be Added

Goods or services that are not listed in the registration should not be set forth in the §8 affidavit. If goods or services not listed in the registration are set forth in the affidavit, the Post Registration Section of the Office will notify the registrant that these items may not be added.

G. Use in Commerce

The §8 affidavit must state that the mark is in use in commerce on or in connection with the goods or services listed in the registration, unless excusable nonuse is claimed. 37 C.F.R. §2.161(f)(1). The §8 affidavit need not specify the type of commerce (e.g., interstate) in which the mark is used.

A §8 affidavit that does not state that the mark is in use in commerce is deficient. The owner must submit a substitute affidavit or declaration stating that the mark was in use in commerce on or in connection with the goods or services listed in the registration during the relevant period specified in §8 of the Act, as follows:

> (1) If the §8 affidavit was filed between the fifth and sixth year after the date of registration or publication under §12(c) of the Act, the substitute affidavit must state that the mark was in use in commerce on or in connection with the goods or services before the expiration of the sixth year after the date of registration or publication under §12(c); or
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> (2) If the §8 affidavit was filed within one year before the end of any ten-year period after the date of registration, the substitute affidavit must state that the mark was in use in commerce on or in connection with the goods or services within one year before the end of the ten-year period after the date of registration; or
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> (3) If the §8 affidavit was filed during the grace period, the substitute affidavit must state that the mark was in use in commerce on or in connection with the goods or services before the expiration of the grace period.

If the §8 affidavit was filed during the relevant period specified in §§8(a) and 8(b) of the Act (i.e., between the fifth and sixth year after the date of registration or publication under §12(c) of the Trademark Act, or within one year before the end of any ten-year period after the date of registration), the substitute affidavit may be filed before expiration of the relevant period for no fee, or after expiration of the relevant period upon payment of the deficiency surcharge required under §8(c)(2) of the Act. If the §8 affidavit was filed during the grace period, the substitute affidavit may be filed before expiration of the grace period for no fee, or after expiration of the grace period upon

payment of the deficiency surcharge. See Trademark Rule 2.160(a), 37 C.F.R. §2.160(a), and §III(B) of this Notice regarding the deadlines for filing §8 affidavits. See also Trademark Rule 2.164, 37 C.F.R. §2.164, and §III(L) of this Notice for information about the procedures, deadlines, and fees for correcting deficiencies.

If the substitute affidavit does not state that the mark was in use in commerce on or in connection with the goods or services within the period specified in §8 of the Act, the §8 affidavit will not be accepted, and the registration will be cancelled. While a substitute affidavit may be filed after the expiration of the period specified in §8 of the Act, §8 clearly requires that the substitute affidavit attest to use within the time period specified in §8 of the Act.

H. Specimen Showing Current Use of Mark in Commerce

1. Specimen for Each Class Required

An affidavit or declaration of continued use must include a specimen or facsimile showing current use of the mark for each class of goods or services, unless excusable nonuse is claimed. Sections 8(b)(1) and (2) of the Trademark Act, 15 U.S.C. §§1058(b)(1) and (2); Trademark Rule 2.161(g), 37 C.F.R. §2.161(g).

The specimen must show use of essentially the same mark as the mark shown in the registration on or in connection with the goods or services listed in the registration. See TMEP §§1603.08 and 1603.10.

An affidavit or declaration that does not include an acceptable specimen for each class of goods or services to which the affidavit pertains is deficient. The owner must file substitute specimen(s), together with an affidavit or declaration that the substitute specimen(s) was in use in commerce on or in connection with the goods or services during the relevant period specified in §8 of the Act. See §§III(H)(2) below regarding the filing of substitute specimen(s).

Under Trademark Rule 2.161(g)(2), 37 C.F.R. §2.161(g)(2), the specimen must be flat and no larger than 8-1/2 inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long. If a specimen exceeds these size requirements, the Office will create a facsimile of the specimen that meets the requirements of the rule (i.e., is flat and no larger than 8-1/2 inches wide by 11.69 inches long) and put it in the file wrapper.

2. Substitute Specimen(s)

If a specimen for any class is omitted or is deficient, the owner must file substitute specimen(s), together with an affidavit or declaration that the substitute specimen(s) was in use in commerce on or in connection with the goods or services during the relevant period specified in §8 of the Act, as follows:

> (1) If the §8 affidavit was filed between the fifth and sixth year after the date of registration or publication under §12(c) of the Act, the affidavit supporting use of the substitute specimens must state that the substitute specimen(s) was in use in commerce before the expiration of the sixth year after the date of registration or publication under §12(c), if accurate; or
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> (2) If the §8 affidavit was filed within one year before the end of any ten-year period after the date of registration, the affidavit supporting use of the substitute specimens must state that the substitute specimen(s) was in use in commerce within one year before the end of the ten-year period after the date of registration, if accurate; or
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> (3) If the §8 affidavit was filed during the grace period, the affidavit supporting use of the substitute specimens must state that the substitute specimen(s) was in use in commerce before the expiration of the grace period, if accurate.

If the §8 affidavit was filed during the relevant period specified in §§8(a) and 8(b) of the Act (i.e., between the fifth and sixth year after the date of registration or publication under §12(c) of the Trademark Act, or within one year before the end of any ten-year period after the date of registration), the substitute specimen(s) may be filed before expiration of the relevant period for no fee, or after expiration of the relevant period upon payment of the deficiency surcharge required under §8(c)(2) of the Act. If the §8 affidavit was filed during the grace period, the substitute specimen(s) may be filed before expiration of the grace period for no fee, or after expiration of the grace period upon payment of the deficiency surcharge. See Trademark Rule 2.160(a), 37 C.F.R. §2.160(a), and §III(B) of this

Notice regarding the deadlines for filing §8 affidavits. See also Trademark Rule 2.164, 37 C.F.R. §2.164, and §III(L) of this Notice for information about the procedures, deadlines, and fees for correcting deficiencies.

If the affidavit supporting the substitute specimen(s) does not state that the specimen(s) was in use in commerce prior to the end of the period specified in §8 of the Act, the §8 affidavit will not be accepted, and the registration will be cancelled as to any class for which a proper specimen was not provided. While a substitute specimen and supporting affidavit may be filed after the expiration of the period specified in §8 of the Act, §8 clearly requires that the substitute affidavit attest to use of the specimen within the time period specified in §8 of the Act.

I. Nonuse of Mark

Under Trademark Rule 2.161(f)(2), 37 C.F.R. §2.161(f)(2), an affidavit or declaration claiming excusable nonuse must recite facts and circumstances that clearly demonstrate that nonuse is due to special circumstances beyond the owner's control that excuse the nonuse, and is not due to any intention to abandon the mark. *See* TMEP §1603.09 and cases cited therein for further information about affidavits claiming excusable nonuse.

The affidavit or declaration must state when use in commerce stopped and give the approximate date when use is expected to resume. It must also specify the reason for nonuse, the steps being taken to put the mark back in use in commerce, and any other pertinent facts.

The determination of whether the nonuse is excusable is made by the Post Registration paralegal. If the paralegal holds that the facts set forth do not show excusable nonuse, the owner may file supplementary evidence or explanation. If the affidavit included a showing of nonuse when filed, no deficiency surcharge will be required for supplementing this showing.

J. Designation of Domestic Representative

Under §8(f) of the Trademark Act, 15 U.S.C. §1058(f), and Trademark Rule 2.161(h), 37 C.F.R. §2.161(h), if the owner of the registration is not domiciled in the United States, the affidavit or declaration must include the name and address of a United States resident upon whom notices or process in proceedings affecting the registration may be served. *See* TMEP §604.

An affidavit or declaration that does not designate a domestic representative is deficient. This deficiency can be cured before expiration of the relevant deadline set forth in §8 of the Act for no fee, or after expiration of the relevant deadline upon payment of the deficiency surcharge required by §8(c)(2) of the Act. *See* Trademark Rule 2.164, 37 C.F.R. §2.164, and §III(L) of this Notice for information about the procedures, deadlines, and fees for correcting deficiencies.

K. Response to Office Action

Upon examination, the Office will issue a notice as to whether an affidavit or declaration is acceptable, or of the reasons for refusal. Under Trademark Rule 2.163(b), 37 C.F.R. §2.163(b), a response to a refusal must be filed within six months of the mailing date of the Office Action, or before the end of the relevant filing period set forth in §8 of the Act, whichever is later. If no response is received within that time, the registration will be cancelled.

If the §8 affidavit was filed by the owner of the registration during the relevant period specified in §§8(a) and 8(b) of the Act (i.e., between the fifth and sixth year after the date of registration or publication under §12(c) of the Trademark Act, or within one year before the end of any ten-year period after the date of registration), the owner may correct deficiencies before expiration of the relevant deadline set forth in §8 of the Act for no fee, or after expiration of the deadline set forth in §8 of the Act upon payment of the deficiency surcharge required by §8(c)(2) of the Act. If the §8 affidavit was filed during the grace period, the owner may correct deficiencies before expiration of the grace period for no fee, or after expiration of the grace period upon payment of the deficiency surcharge. *See* Trademark Rule 2.164, 37 C.F.R. §2.164, and §III(L) of this Notice for information about the procedures, deadlines, and fees for correcting deficiencies.

The registration will be cancelled if an affidavit or declaration of continued use or excusable nonuse is not filed before expiration of the grace period set forth in §8(c)(1) of the Act, or if the affidavit or declaration is filed by someone other than the current owner of the registration. These deficiencies cannot be cured. *See* 37 C.F.R.

§2.164(b) and §III(L)(3) of this Notice.

L. Correction of Deficiencies

Trademark Rule 2.164, 37 C.F.R. §2.164, provides for correction of deficiencies in an affidavit or declaration of continued use or excusable nonuse.

1. Correcting Deficiencies in Affidavits or Declarations Timely Filed Within the Periods Set Forth in Sections 8(a) and 8(b) of the Act

If the owner of the registration timely files the affidavit or declaration during the periods set forth in §§8(a) and 8(b) of the Act (i.e., between the fifth and sixth year after the date of registration or publication under §12(c) of the Trademark Act, or within one year before the end of any ten-year period after the date of registration), deficiencies may be corrected within the relevant period without paying a deficiency surcharge. Deficiencies may be corrected after the expiration of the relevant period, with payment of the deficiency surcharge required by §8(c)(2) of the Act. Trademark Rule 2.164(a)(1), 37 C.F.R. §2.164(a)(1).

The deficienc(ies) must be cured within the set period for response to the Office Action, i.e., within six months of the mailing date of the action, or before the end of the relevant filing period set forth in §8 of the Act, whichever is later. Trademark Rule 2.163(b), 37 C.F.R. §2.163(b).

2. Correcting Deficiencies in Affidavits or Declarations Filed During the Grace Period

If the owner of the registration files the affidavit or declaration during the six-month grace period under §8(c)(1) of the Act, deficiencies may be corrected before the expiration of the grace period without paying a deficiency surcharge, or after the expiration of the grace period upon payment of the deficiency surcharge required by §8(c)(2) of the Act. Trademark Rule 2.164(a)(2), 37 C.F.R. §2.164(a)(2).

The deficienc(ies) must be cured within six months of the mailing date of the Office action. Trademark Rule 2.163(b), 37 C.F.R. §2.163(b).

3. Defects That Cannot be Cured After Expiration of Grace Period

The registration will be cancelled if an affidavit or declaration of continued use or excusable nonuse is not filed before expiration of the grace period set forth in §8(c)(1) of the Act, or if the affidavit or declaration is filed by someone other than the current owner of the registration. These defects cannot be cured unless there is time remaining in the grace period. Trademark Rule 2.164(b), 37 C.F.R. §2.164(b).

M. Petition to Commissioner

The owner may petition the Commissioner to review the Post Registration paralegal's action on a §8 affidavit under 37 C.F.R. §§2.146(a)(2) and 2.165(b). The petition must be filed within six months of the mailing date of the action. A petition fee is required by 37 C.F.R. §§2.6 and 2.146(c).

A response to the paralegal's initial refusal to accept an affidavit or declaration is required before filing a petition to the Commissioner, unless the paralegal directs otherwise. Trademark Rule 2.165(a), 37 C.F.R. §2.165(a).

Under Trademark Rule 2.146(j), 37 C.F.R. §2.146(j), if the Commissioner denies a petition, the petitioner may file a request for reconsideration within two months of the mailing date of the decision denying the petition. A second petition fee must be paid with the request for reconsideration.

IV. Renewal of Registration

15 U.S.C. §1059. Renewal.

(a) Subject to the provisions of section 8, each registration may be renewed for periods of 10 years at the end of

each successive 10-year period following the date of registration upon payment of the prescribed fee and the filing of a written application, in such form as may be prescribed by the Commissioner. Such application may be made at any time within 1 year before the end of each successive 10-year period for which the registration was issued or renewed, or it may be made within a grace period of 6 months after the end of each successive 10-year period, upon payment of a fee and surcharge prescribed therefor. If any application filed under this section is deficient, the deficiency may be corrected within the time prescribed after notification of the deficiency, upon payment of a surcharge prescribed therefor.

(b) If the Commissioner refuses to renew the registration, the Commissioner shall notify the registrant of the Commissioner's refusal and the reasons therefor.

(c) If the registrant is not domiciled in the United States, the registrant shall 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. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, such notice or process may be served upon the Commissioner.

A. Requirements for Renewal

37 C.F.R. §2.183 Requirements for a complete renewal application.

A complete renewal application must include:

(a) A request for renewal of the registration, signed by the registrant or the registrant's representative;

(b) The fee required by §2.6 for each class;

(c) The additional fee required by §2.6 for each class if the renewal application is filed during the six-month grace period set forth in section 9(a) of the Act;

(d) If the registrant is not domiciled in the United States, the name and address of a United States resident on whom notices or process in proceedings affecting the registration may be served; and

(e) If the renewal application covers less than all the goods or services in the registration, a list of the particular goods or services to be renewed.

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

B. Time for Filing Application for Renewal

The application for renewal may be filed within one year before the expiration of the registration. There is a grace period of six months after the expiration of a registration during which a renewal application may be filed with payment of an additional grace period surcharge. If no renewal application is filed before the end of the grace period, the registration will expire. 15 U.S.C. §1059(a); 37 C.F.R. §2.182.

The renewal application may not be filed before the period specified in §9 of the Act. If an application for renewal is filed more than one year before the expiration date of the registration, the Office will advise the registrant that the renewal application is premature; of the appropriate time period for filing a renewal application; that the fees submitted will be held; and that the registrant may file a new application at the appropriate time or may request a refund at any time. The prematurely filed renewal application will be placed in the file. If a timely renewal application is not filed before the end of the grace period, the registration will be deemed expired and the fees refunded. There

is no deficiency surcharge for filing a timely substitute renewal application.

C. Fees

1. Fee for Filing Application for Renewal

Under §9(a) of the Trademark Act, 15 U.S.C. §1059(a), and Trademark Rule 2.183(b), 37 C.F.R. §2.183(b), a renewal application must include the fee required by §2.6 for each class of goods or services for which renewal is sought.

2. Grace Period Surcharge

Under §9(a) of the Trademark Act, 15 U.S.C. §1059(a), and Trademark Rules 2.6 and 2.183(c), 37 C.F.R. §§2.6 and 2.183(c), if the renewal application is filed during the six-month grace period following expiration of the registration, there is an additional grace period surcharge for each class for which renewal is sought.

The grace period surcharge applies only if no filing was made within the year before the expiration of the registration. Someone who files within one year before the expiration of the registration, but corrects a deficiency after expiration of the registration, will be subject to the deficiency surcharge only. On the other hand, someone who files during the grace period and cures a deficiency after expiration of the grace period will be subject to both the grace period surcharge (for the ability to file the renewal application during the grace period) *and* the deficiency surcharge (for the ability to correct a deficiency after the end of the grace period).

Currently, the grace period surcharge is $100 per class.

3. Deficiency Surcharge

Under §9(a) of the Trademark Act, 15 U.S.C. §1059(a), a "deficiency surcharge" is required for correcting a deficiency after expiration of the relevant deadline specified in §9 of the Act. If the renewal application is filed within one year before the expiration of the registration, a deficiency surcharge is required for correcting deficiencies after expiration of the registration. If the renewal application is filed during the grace period, a deficiency surcharge is required for correcting deficiencies after expiration of the grace period. *See* Trademark Rule 2.185, 37 C.F.R. §2.185, and §IV(L) of this Notice for further information regarding the procedures, deadlines and fees for correcting deficiencies.

Only a single deficiency surcharge is required for correcting deficienc(ies) in a multi-class registration. Similarly, only a single deficiency surcharge is required to correct several deficiencies within one document. Currently, the deficiency surcharge is $100.

4. Processing Renewal Application Filed With Insufficient Fees

A renewal application that does not include sufficient fees to cover the filing fee for all the classes to which the application pertains (and the grace period surcharge, where applicable) is deficient. If the renewal application is filed within one year before the expiration of the registration, the deficiency may be corrected before expiration of the registration for no fee, or after expiration of the registration upon payment of the deficiency surcharge required by §9(a) of the Act. If the renewal application is filed during the grace period, the deficiency may be corrected before expiration of the grace period for no fee, or after expiration of the grace period upon payment of the deficiency surcharge required by §9(a) of the Act. *See* Trademark Rule 2.185, 37 C.F.R. §2.185, and §IV(L) of this Notice for information about the procedures, deadlines and fees for correcting deficiencies.

If the renewal application is accompanied by insufficient fees to cover all the classes to which the renewal application pertains, and the renewal application includes an authorization to charge additional fees to a deposit account, the filing fee (and grace period surcharge, where applicable) will be charged to the deposit account. If the deposit account authorization is included with the renewal application as filed, and the deposit account has sufficient funds to cover the fee(s) in question, there is no fee deficiency and no deficiency surcharge is required.

An authorization to charge fees to a deposit account with insufficient funds to cover the fee is regarded as a

deficiency.

If a check submitted as payment of a filing fee for a renewal application is returned to the Office unpaid, this is also regarded as a deficiency. In addition to the deficiency surcharge (where applicable), there is a $50 fee for processing the returned check. 37 C.F.R. §1.21(m).

If at least one fee is submitted for a multi-class registration, but the class(es) to which the fee(s) should be applied are not specified, the Post Registration paralegal will issue a notice requiring either the submission of additional fee (s) or an indication of the class(es) to which the original fee(s) should be applied. If the required fee(s) are not submitted and the class(es) to which the original fee(s) should be applied are not specified, the Office will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class. 37 C.F.R. §2.183 (f).

D. Ownership

Section 9 of the Trademark Act, 15 U.S.C. §1059, and the Trademark Rules of Practice, no longer require that a renewal application be filed by the owner of the registration.

Therefore, if the renewal applicant is not the owner of record, the Office will no longer require that the renewal applicant show continuity of title from the original registrant before granting renewal.

However, registrations will be renewed in the name of the party who is the owner of record of the registration, according to the TRAM (Trademark Reporting and Monitoring) System. The registration will be renewed in the name of the new owner only if the owner: (1) records an assignment or other document evidencing change of title with the Assignment Division of the Office; and (2) notifies the Post Registration Section of the Office at the time the renewal application is filed that the document has been recorded with the Assignment Division.

E. Execution of Renewal Application

Trademark Rule 2.183(a), 37 C.F.R. §2.183(a), requires that a renewal application be signed by "the registrant or the registrant's representative." Verification is not required.

Generally, the Office no longer questions the authority of the person who signs a renewal application, unless there is an inconsistency in the record as to the signatory's authority to sign. The renewal applicant and/or the renewal applicant's attorney are in the best position to determine who is the proper party to sign a renewal application.

Section 9 of the Act, 15 U.S.C. §1059, and the Trademark Rules of Practice, no longer require that a renewal application be executed within any particular time period. Therefore, the Office will accept undated renewal applications, and renewal applications with a "stale" date of execution.

F. Designation of Domestic Representative

Under §9(c) of the Trademark Act, 15 U.S.C. §1059(c), and Trademark Rule 2.183(d), 37 C.F.R. §2.183(d), a renewal applicant who is not domiciled in the United States must set forth the name and address of a United States resident upon whom notices or process in proceedings affecting the registration may be served. *See* TMEP §604.

A renewal application that does not designate a domestic representative is deficient. If the renewal application was filed within one year before the expiration of the registration, the designation of domestic representative can be filed before expiration of the registration for no fee, or after expiration of the registration upon payment of the deficiency surcharge required by §9(a) of the Act. If the renewal application was filed during the grace period, the designation of domestic representative can be filed before expiration of the grace period for no fee, or after expiration of the grace period upon payment of the deficiency surcharge required by §9(a) of the Act. *See* Trademark Rule 2.185, 37 C.F.R. §2.185, and §IV(L) of this Notice for information about the procedures and fees for correcting deficiencies.

G. Goods and/or Services Set Forth in Application for Renewal

1. Listing of Goods and/or Services Required Only for Partial Renewal

Neither the Trademark Act nor the Trademark Rules of Practice require a listing of the goods or services in the registration if the renewal application covers all the goods and services in the registration. Under Trademark Rule 2.183(e), 37 C.F.R. §2 183(e), the renewal application must include a list of the goods or services only if the renewal application covers less than all the goods or services in the registration.

2. No Goods or Services Listed

If no goods or services are specified in the renewal application, it will be presumed that renewal is sought for all the goods or services in the registration.

3. Some Goods or Services Listed

If the renewal application lists only some of the goods or services set forth in the registration, it will be presumed that renewal is sought for only the goods or services listed, and the goods or services omitted from the renewal application will be deleted from the registration. If it is unclear whether the renewal applicant intends to delete the goods or services, the Post Registration Section of the Office should contact the renewal applicant to confirm that the goods or services are intended to be deleted. If the renewal applicant did not intend to delete the omitted goods or services, the renewal applicant may file a substitute renewal application or supplemental statement requesting renewal for additional goods or services. No deficiency surcharge will be required.

4. Goods or Services Not Listed in Registration Should Not Be Listed in Renewal Application

Goods or services that are not listed in the registration should not be listed in the renewal application. If goods or services not listed in the registration are set forth in the renewal application, the Post Registration Section of the Office will notify the registrant that these items may not be added.

H. Use in Commerce or Excusable Nonuse

Section 9 of the Trademark Act, 15 U.S.C. §1059, no longer requires that a renewal application include an affidavit or declaration of use in commerce, a specimen of use for each class of goods or services, or a showing that any nonuse is due to special circumstances that excuse such nonuse, and not due to any intention to abandon the mark.

I. Specimens

Section 9 of the Trademark Act, 15 U.S.C. §1059, and the Trademark Rules of Practice do not require that a renewal applicant submit a specimen showing use of the registered mark.

J. Notice of Renewal

Upon examination, if the renewal application is found acceptable, the Office will send the registrant a notice that renewal has been granted. No further confirmation will be sent. Effective October 30, 1999, the Office will no longer issue an Updated Registration Certificate (URC) for each renewed registration.

K. Response to Office Action

If the renewal application is not acceptable, the Office will notify the renewal applicant of the reasons for refusal. 15 U.S.C. §1059(b); 37 C.F.R. §2.184(b). Under Trademark Rule 2.184(b), 37 C.F.R. §2.184(b), a response to a refusal of renewal must be filed within six months of the mailing date of the Post Registration paralegal's Office Action, or before the expiration date of the registration, whichever is later, or the registration will expire.

The renewal applicant may correct deficiencies if the requirements of Trademark Rule 2.185, 37 C.F.R. §2.185, are met. *See* §IV(L) of this Notice for information about the procedures and fees for correcting deficiencies.

L. Correction of Deficiencies

1. Correcting Deficiencies in Renewal Applications Filed Within the Year Before the Expiration Date of the Registration

If the renewal application is filed within one year before the expiration date of the registration, deficiencies may be corrected before the expiration date without paying a deficiency surcharge, or after the expiration date with payment of the deficiency surcharge required by §9(a) of the Act. Trademark Rule 2.185(a)(1), 37 C.F.R. §2.185(a)(1).

The deficienc(ies) must be cured within the set period for response to the Post Registration paralegal's Office Action, i.e., within six months of the mailing date of the action, or before the expiration date of the registration, whichever is later. Trademark Rule 2.184(b), 37 C.F.R. §2.184(b).

2. Correcting Deficiencies in Renewal Applications Filed During the Grace Period.

If the renewal application is filed during the grace period, deficiencies may be corrected before the end of the grace period without paying a deficiency surcharge, or after the expiration of the grace period with payment of the deficiency surcharge required by §9(a) of the Act. Trademark Rule 2.185(a)(2), 37 C.F.R. §2.185(a)(2).

The deficienc(ies) must be cured within six months of the mailing date of the Office Action. Trademark Rule 2.184(b), 37 C.F.R. §2.184(b).

3. Untimely Filing Cannot be Cured

If the renewal application is not filed before the end of the grace period set forth in §9(a) of the Act, 15 U.S.C. §1059(a), the registration will expire. The untimely filing of a renewal application cannot be cured. 37 C.F.R. §§2.182 and 2.185(b).

M. Petition to Commissioner

The registrant may petition the Commissioner to review the Office action on a renewal application under Trademark Rules 2.146(a)(2) and 2.186(b), 37 C.F.R. §§2.146(a)(2) and 2.186(b). The petition must be filed within six months of the mailing date of the action. A petition fee is required by 37 C.F.R. §§2.6 and 2.146(c).

A response to the initial refusal to renew a registration is required before filing a petition to the Commissioner, unless the Office action directs otherwise. 37 C.F.R. §2.186(a).

Under Trademark Rule 2.146(j), 37 C.F.R. §2.146(j), if the Commissioner denies a petition, the petitioner may file a request for reconsideration within two months of the mailing date of the decision denying the petition. A second petition fee must be paid with the request for reconsideration.

V. Affidavit or Declaration of Incontestability Under Section 15

A. Type of Commerce No Longer Required

The affidavit or declaration of incontestability under §15 of the Trademark Act, 15 U.S.C. §1065 (§15 affidavit), need not specify the type of commerce (e.g. interstate) in which the mark is used.

B. Persons Who May Sign Affidavit or Declaration

The §15 affidavit must be signed and verified (sworn to) or supported by a declaration under §2.20 by a person properly authorized to sign on behalf of the owner of the registration. A "person who is properly authorized to sign on behalf of the owner" is: (1) a person with legal authority to bind the owner; or (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or (3) an attorney as defined in 37 C.F.R. §10.1(c) who has an actual or implied written or verbal power of attorney from the owner.

Generally, the Office no longer questions the authority of the person who signs a §15 affidavit, unless there is an inconsistency in the record as to the signatory's authority to sign.

VI. Combined Filings

A. Section 8 Affidavit Combined with Section 9 Renewal Application

Under Trademark Rule 2.166, 37 C.F.R. §2.166, an affidavit or declaration under §8 of the Act and a renewal application under §9 of the Act may be combined into a single document, provided that the document meets the requirements of both §§8 and 9 of the Act.

The filing fee for the combined §8 and §9 filing is the sum of the cost of the individual filings. For example, if the filing fee for the §8 affidavit is $100 per class, and the filing fee for the renewal application is $300 per class, the filing fee for the combined §8 and 9 document is $400 per class.

If the combined §8 and §9 document is filed during the grace period, the filing fees per class and the grace period surcharge per class must be paid for both the §8 affidavit and the §9 renewal application.

> *Example:* A registration expires on December 1, 1999. A combined §8 and §9 document is filed January 1, 2000, during the six-month grace period. The proper fees are as follows: (1) filing fee for the §8 affidavit, per class, (2) grace period surcharge for the §8 affidavit, per class, (3) filing fee for the §9 renewal application, per class, and (4) grace period surcharge for the §9 renewal application, per class.

Failure to include the proper fees is a deficiency that may require a deficiency surcharge. *See* §§III(L) and IV(L) of this Notice for information about the procedures, deadlines, and fees for correcting deficiencies.

Only a single deficiency surcharge is required for curing deficienc(ies) in a combined §8 and §9 filing, even if both the §8 affidavit and the §9 renewal application are deficient. Similarly, only a single deficiency surcharge is required to correct several deficiencies within one document.

The Office provides a form for a combined "Section 8 and 9" filing. The form is available on the Office's home page at **www.uspto.gov**.

B. Combining Section 8 Affidavit With Section 15 Affidavit

Under Trademark Rule 2.168(a), 37 C.F.R. §2.168(a), the affidavit or declaration filed under §15 of the Act may be combined with the affidavit or declaration required by §8 of the Act, if the affidavit or declaration meets the requirements of both §§8 and 15.

The filing fee for the combined §8 and §15 affidavit or declaration is the sum of the cost of the individual filings. For example, if the filing fee for the §8 affidavit is $100 per class, and the filing fee for the §15 affidavit is $100 per class, the filing fee for the combined affidavit or declaration under §§8 and 15 is $200 per class.

If the combined §8 and §15 affidavit is filed during the §8 grace period, the grace period surcharge per class for the §8 affidavit must be paid. There is no "grace period surcharge" for a §15 affidavit.

If a combined §8 and §15 affidavit is filed, and the §8 affidavit is deficient, the deficiency may be corrected before expiration of the relevant deadline set forth in §8 of the Act for no fee, or after expiration of the relevant deadline upon payment of the deficiency surcharge required by §8(c)(2) of the Act. *See* Trademark Rule 2.164, 37 C.F.R. §2.164, and §III(L) of this Notice for information about the procedures, deadlines, and fees for correcting deficiencies in a §8 affidavit. There is no "deficiency surcharge" for the §15 affidavit.

The Office provides a form for a combined "Section 8 and 15" affidavit or declaration. The form is available on the Office's home page at **www.uspto.gov**.

VII. Signature of Requests to Amend, Correct, or Surrender a Registration

A request for amendment or correction of a registration under §7 of the Trademark Act, 15 U.S.C. §1057, must be signed and verified (sworn to) or supported by a declaration under §2.20 by the registrant. 37 C.F.R. §§2.173 and 2.175. An application to surrender a registration must be signed by the registrant. 37 C.F.R. §2.172. The following persons are authorized to sign on behalf of the registrant: (1) a person with legal authority to bind the owner; or (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or (3) an attorney as defined in 37 C.F.R. §10.1(c) who has an actual or implied written or verbal power of attorney from the owner. Generally, the Office no longer questions the authority of the person who signs on behalf of the registrant, unless there is an inconsistency in the record as to the signatory's authority to sign.

VIII. Updating Automated Records to Show the Status of Registrations

The Office's automated records will be regularly updated to indicate the status of registrations as follows:

(1) In the case of a registration for which an affidavit of use under §8 of the Act, 15 U.S.C §1058, is due, if Office records show that the registrant has not filed a §8 affidavit within one year after the filing due date, the automated records will be updated to indicate that the registration is cancelled. *See* §III(B) of this Notice regarding the due dates for §8 affidavits.

(2) In the case of a registration for which a renewal application under §9 of the Act, 15 U.S.C. §1059, is due, if Office records show that the registrant has not submitted a renewal application one year after the expiration of the previous term, the automated record will be updated to indicate that the registration is expired.

(3) If the applicant has submitted a timely §8 affidavit and/or application for renewal, the Office records will be updated to indicate receipt of the paper and the action taken on the paper.

Last Modified: 08/03/2007 10:39:41

EXHIBIT 2

Tonia Sayour

From: ecf_bounces@nyed.uscourts.gov
Sent: Friday, June 29, 2007 12:48 PM
To: nobody@nyed.uscourts.gov
Subject: Activity in Case 1:06-cv-00729-DLI-RER Patsy's Italian Restaurant, Inc. et al v. Banas et al Order

This is an automatic e-mail message generated by the CM/ECF system. Please DO NOT RESPOND to this e-mail because the mail box is unattended.
*****NOTE TO PUBLIC ACCESS USERS*** You may view the filed documents once without charge. To avoid later charges, download a copy of each document during this first viewing.**

U.S. District Court

Eastern District of New York

Notice of Electronic Filing

The following transaction was entered on 6/29/2007 at 12:47 PM EDT and filed on 6/29/2007
Case Name: Patsy's Italian Restaurant, Inc. et al v. Banas et al
Case Number: 1:06-cv-729
Filer:
Document Number: No document attached

Docket Text:
ORDER re (106 in 1:06-cv-05857-DLI-RER) Letter filed by Patsy's Brand, Inc., Patsy's Italian Restaurant, Inc. -- Application DENIED. The court finds that further briefing by either party is NOT necessary. SO ORDERED by Judge Dora Lizette Irizarry on 06/29/07. Associated Cases: 1:06-cv-00729-DLI-RER, 1:06-cv-05857-DLI-RER (Irizarry, Dora)

Case Name: Patsy's Italian Restaurant, Inc. v. Banas et al
Case Number: 1:06-cv-5857
Filer:
Document Number: No document attached

Docket Text:
ORDER re (106 in 1:06-cv-05857-DLI-RER) Letter filed by Patsy's Brand, Inc., Patsy's Italian Restaurant, Inc. -- Application DENIED. The court finds that further briefing by either party is NOT necessary. SO ORDERED by Judge Dora Lizette Irizarry on 06/29/07. Associated Cases: 1:06-cv-00729-DLI-RER, 1:06-cv-05857-DLI-RER (Irizarry, Dora)

1:06-cv-729 Notice has been electronically mailed to:
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Tonia A Sayour tsayour@cooperdunham.com
Paul Grandinetti mail@levygrandinetti.com
Rebecca Stempien mail@levygrandinetti.com

1:06-cv-729 Notice will not be electronically mailed to:

1:06-cv-5857 Notice has been electronically mailed to:
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1:06-cv-5857 Notice will not be electronically mailed to:

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