Examination Guide 4-17

Summary of “Revival of Abandoned Applications, Reinstatement of Abandoned Applications and Cancelled or Expired Registrations, and Petitions to the Director”

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[I. DEADLINES 1](#_Toc489367721)

[A. Petitions to Revive 2](#_Toc489367722)

[B. Petitions to the Director, unless a different deadline is specified by rule 2](#_Toc489367723)

[C. Request for reinstatement 2](#_Toc489367724)

[1. Abandoned applications 2](#_Toc489367725)

[2. Expired/cancelled registrations 2](#_Toc489367726)

[II. Due diligence 3](#_Toc489367727)

[III. CLAIMS OF NON-RECEIPT OF OFFICE ACTION OR NOTICE OF ALLOWANCE LIMITED 3](#_Toc489367728)

[IV. NEW REINSTATEMENT RULE 3](#_Toc489367729)

[A. Abandoned Applications 3](#_Toc489367730)

[B. Cancelled/Expired Registrations: 4](#_Toc489367731)

[V. MISCELLANEOUS CHANGES 4](#_Toc489367732)

On June 29, 2017, the United States Patent and Trademark Office (USPTO or Office) published a final rule at 82 FR 29401 setting forth the requirements for petitions to revive an abandoned trademark application and petitions to the Director of the USPTO (Director) regarding other trademark matters. The rule also codifies USPTO practice regarding requests for reinstatement of abandoned trademark applications and cancelled or expired trademark registrations. The changes provide more detailed procedures regarding the deadlines and requirements for requesting revival, reinstatement, or other action by the Director. These rules will thereby ensure that the public has notice of the deadlines and requirements for making such requests, facilitate the efficient and consistent processing of such requests, and promote the integrity of application/registration information in the trademark electronic records system as an accurate reflection of the status of applications and registrations. The changes became effective July 8, 2017, and supersede the current edition of the Trademark Manual of Examining Procedure to the extent any inconsistency exists.

# DEADLINES

The rule harmonizes the deadlines for filing:

* Petitions to revive pursuant to Trademark Rule 2.66 (37 C.F.R. §2.66);
* Petitions to the Director pursuant to Trademark Rule 2.146 (37 C.F.R. §2.146); and
* Requests for reinstatement of abandoned applications or cancelled/expired registrations pursuant to Trademark Rule 2.64 (37 C.F.R. §2.64).

## Petitions to Revive

* If the notice of abandonment was received, not later than two months after the issue date of the notice of abandonment in full or in part; or
* If the notice of abandonment was not received, not later than two months after actual knowledge of abandonment **and** not later than six months after the date the trademark electronic records system indicates that the application is abandoned in full or in part.

## Petitions to the Director, unless a different deadline is specified by rule

* Not later than two months after the issue date of a USPTO action or date of receipt of an applicant/registrant filing from which relief is requested.
* If the applicant or registrant claims that it did not receive the action or where no action was issued:
	+ Not later than two months after actual knowledge of the abandonment of an application **and** not later than six months after the date the trademark electronic records system indicates that the application is abandoned in full or in part; or
	+ Where the registrant has timely filed an affidavit of use or excusable non-use under Section 8 or 71 of the Act, or a renewal application under Section 9 of the Act, not later than two months after the date of actual knowledge of the cancellation/expiration of a registration **and** not later than six months after the date the trademark electronic records system indicates that the registration is cancelled/expired; or
	+ Not later than two months after the date of actual knowledge of the denial of certification of an international application **and** not later than six months after the trademark electronic records system indicates that certification is denied.

The rule removes the requirement that a petition to the Director be filed no later than two months from the date when Office records are updated to show that a registration is cancelled or expired. In cases where no action or notice was issued, or where the registrant declares that it did not receive the action or notice, a petition to the Director or request for reinstatement must be filed not later than six months after the date the trademark electronic records system is updated, provided that the registrant declares that it did not receive the action or where no action was issued.

## Request for reinstatement

### Abandoned applications

* If the notice of abandonment was received, not later than two months after the issue date of the notice of abandonment; or
* If the notice of abandonment was not received, not later than two months after actual knowledge of abandonment **and** not later than six months after the date the trademark electronic records system indicates that the application is abandoned.

### Expired/cancelled registrations

* Not later than two months after the issue date of the notice of cancellation/expiration; or
* Where the registrant has timely filed an affidavit of use or excusable non-use under section 8 or 71 of the Act, or a renewal application under section 9 of the Act, no later than two months after the date of actual knowledge of the cancellation/expiration **and** not later than six months after the date the trademark electronic records system indicates that the registration is cancelled/expired, where the registrant declares that it did not receive the notice of cancellation/expiration or where the Office did not issue a notice.

# Due diligence

The rule makes it clear that petitions and requests for reinstatement must be filed no later than six months after the date the trademark electronic records system indicates that the application is abandoned or the registration is cancelled/expired. Thus, in order to revive or reinstate, applicants and registrants must check the status of their applications and registrations every six months after the filing of an application or other submission in connection with which the applicant or registrant expects the USPTO to take action. Even in cases where an office action, notice of abandonment or cancellation, or other notice is not received, petitions and requests for reinstatement will be denied if filed more than six months after the electronic record is updated. This requirement removes any uncertainty in the Office’s assessment of whether an applicant or registrant was duly diligent in monitoring the status of their application or post-registration maintenance filing.

A registrant or applicant who seeks relief outside the six-month period after the date the trademark electronic records system is updated has the option to file a petition to the Director under Trademark Rule 2.146(a)(5), 37 C.F.R. §2. 146(a)(5), to request a waiver of the relevant rule due to extraordinary circumstances.

# CLAIMS OF NON-RECEIPT OF OFFICE ACTION OR NOTICE OF ALLOWANCE LIMITED

A petitioner may only assert that the unintentional delay in responding is based on non-receipt of an Office action or notice of allowance **one time** as to the same Office action or the notice of allowance. A petitioner may not make that claim in a subsequent petition for the same Office action or the notice of allowance.

# NEW REINSTATEMENT RULE

Trademark Rule 2.64, titled “Reinstatement of applications and registrations abandoned cancelled, or expired due to Office error,” was created to codify current USPTO practice. 37 C.F.R. §2.64.

## Abandoned Applications

* No fee required
* Same deadlines for submitting request as other petitions
* Provides a listing of the types of proof/evidence required to request reinstatement:
	+ Proof that a response to an Office action, statement of use (SOU), or request for extension of time to file a statement of use (extension request) was timely filed, along with a copy of the relevant document;
	+ Proof of actual receipt by USPTO of the response, SOU, or extension request, along with a copy of the relevant document;
	+ Proof that the USPTO processed a fee in connection with the filing at issue and a copy of the relevant document;
	+ Proof that the USPTO sent an Office action or notice of allowance (NOA) to an address that is not the designated correspondence address; **or**
	+ Other evidence of USPTO error supported by declaration
* As appropriate, the rule allows the USPTO to construe a request as a petition to the Director or a petition to revive, when the applicant is not entitled to reinstatement
* Provides the option to request waiver of the timeliness requirement by submitting a petition to the Director alleging extraordinary circumstances

## Cancelled/Expired Registrations:

* No fee required
* Deadlines for submitting request:
	+ Two months after the issue date of the notice of cancellation/expiration; or
	+ Where the registrant has timely filed an affidavit of use or excusable non-use under section 8 or 71, or a renewal application under section 9, two months after the date of actual knowledge and not later than six months after the date the electronic records indicate the registration is cancelled/expired, provided that the registrant declares that it did not receive the notice of cancellation/expiration or where the Office did not issue a notice.
* Provides a listing of the types of proof/evidence required to request reinstatement:
	+ Proof that an affidavit or declaration of use or excusable nonuse, a renewal application, or a response to an Office action was timely filed and a copy of the relevant document;
	+ Proof of receipt by the Office of an affidavit or declaration of use or excusable nonuse, a renewal application, or a response to an Office action and a copy of the relevant document;
	+ Proof that the Office processed a fee in connection with the filing at issue and a copy of the relevant document;
	+ Proof that the Office sent the Office action to an address that is not the designated correspondence address; **or**
	+ Other evidence of USPTO error supported by declaration
* As appropriate, the rule allows the USPTO to construe a request as a petition to the Director or a petition to revive when registrant is not entitled to reinstatement
* Provides the option to request waiver of the timeliness requirement by submitting a petition to the Director alleging extraordinary circumstances

# MISCELLANEOUS CHANGES

The rule clarifies that:

* In an application filed under §1(b), the Director will not grant a petition to revive under §2.66 if doing so would permit an applicant to file a statement of use, or a petition to substitute a registration basis, more than 36 months after the issue date of the notice of allowance.
* If a petition to revive is filed after a final Office action, the petitioner is required to indicate whether they are filing a notice of appeal or petition to the Director, as appropriate, to review the final refusal and/or requirement.