

# Index

## ABANDONMENT

- Inter partes proceedings, **16:14, 16:32, 16:39**
- Loss of Rights** (this index)
- Partial, **4:22**
- Prosecuting federal applications, **4:22**

## ACCESS TO DOCUMENTS

- Trademarks
  - paper copies and access, **App J**

## ACQUIESCENCE

- Affirmative defenses, **16:27**
- Loss of rights by, **27:8**

## ACTUAL CONFUSION

- Responses, **6:12**

## ACTUAL USE

- Applications** (this index)

## ADDRESS OF APPLICANT

- E-mail address, electronic communications of certain notifications to international registration holders, **5:8**
- Formal rejections, responses, **5:8**

## ADEQUACY

- Formal rejections, inadequate or incorrect filing fee, **5:19**
- Initiating use of mark, **2:18**

## ADMISSION OF EVIDENCE

- Motions, **17:23**

## ADMISSIONS

- Discovery, request for admissions, **18:9**

## ADVERSE INTERESTS

- Opinions or decisions, **1:23**

## ADVERSE USE OR REGISTRATION

- Protect against trademark scams, **App D**

## ADVICE TO CLIENTS

- Applications, **3:68, 4:5**
- Checklist, **1:15**
- Foreign registration, **3:68, 23:26**
- Prosecuting federal applications, **4:5**

## AFFIDAVITS

- Combined sections 8 and 15 affidavits, **24:28; App C-5e**
- Federal Registration** (this index)
- Forms
  - generally, **App C-5**
  - PTO Form 1583
    - combined section 8 and 15 affidavits, **App C-5e**
    - section 8 affidavit, **App C-5c**
    - section 15 affidavit, **App C-5d**
  - PTO Form 1963, trademark renewal and section 8 affidavit, **App C-5f**
- Prosecuting federal applications, **4:10**
- Section 8 affidavits
  - Federal Registration** (this index)
  - forms
    - PTO Form 1583, combined section 8 and 15 affidavits, **App C-5e**
    - PTO Form 1583, section 8 affidavit, **App C-5c**
    - PTO Form 1963, trademark renewal and section 8 affidavit, **App C-5f**
- Section 15 affidavits
  - Federal Registration** (this index)
  - forms
    - PTO Form 1583, combined section 8 and 15 affidavits, **App C-5e**
    - PTO Form 1583, section 15 affidavit, **App C-5d**
- Witnesses, **19:5**

**AFFIRMATIVE DEFENSES**

**Inter Partes Proceedings** (this index)

**AGREEMENTS**

**Contracts and Agreements** (this index)

**ALLEGATIONS**

**Inter Partes Proceedings** (this index)

Prosecuting federal applications, **4:27**

**ALTERATION, AMENDMENT, OR MODIFICATION**

Appeals, **14:13**

Federal registration, **24:8**

Form, prosecution, amendment of trademark/service mark application, **App C-4a**

Fraud, amendment to allege use, **4:27**

Madrid Protocol, extensions of protection and international registrations under, **26:9**

Motions, **17:13, 17:15, 17:29**

Prosecuting federal applications, **4:8, 4:27**

Supplemental registration applications, **12:6**

**AMENDMENT**

**Alteration, Amendment, or Modification** (this index)

**AMERICAN NATIONAL RED CROSS**

Responses, **8:5.20**

**ANALYZING RESPONSES**

Discovery, **18:13**

**ANSWER**

**Inter Partes Proceedings** (this index)

**APPEAL AND REVIEW**

Generally, **14:1 et seq.**

Amendments after appeal, **14:13**

Applicant's appeal brief, **14:7**

Applicant's reply brief, **14:9**

Briefs, **14:7, 14:9**

Checklist, **14:5**

Common mistakes, **14:7**

**APPEAL AND REVIEW—Cont'd**

Conflicting arguments, **14:7**

Confusion rejection responses, **6:5**

Court of Appeals for Federal Circuit, **14:16**

Courts, appeals to generally, **14:14**

Court of Appeals for Federal Circuit, **14:16**

reconsideration by PTO, **14:19**

U.S. district court, **14:17**

District court, **14:17**

Federal Circuit, **14:16**

Federal registration, **24:32**

Filing with TTAB, **14:6**

Forms, prosecution

applicant's appeal brief (general form), trademark, **App C-4e**

examining attorneys' appeal brief (general form), **App C-4f**

notice of appeal (ex parte), **App C-4d**

notice of appeal to court, **App C-4h**

Oral argument, **14:10**

Petitions to director, **13:21**

Pre-appeal considerations, **14:3-14:5**

Process, generally, **14:2**

Prosecuting federal applications, **4:20**

PTO, **14:19**

Reconsideration, **14:12, 14:19**

Reply, **14:9**

Requests for reconsideration, **14:12**

Trademark Attorney's response, **14:8**

TTAB, **14:6, 14:11**

U.S. district court, **14:17**

**APPLICATIONS**

Generally, **3:1 et seq.**

Access to pending federal applications, **3:69**

Actual use

generally, **3:13**

applicant, **3:22**

application fee, **3:35**

certification mark applications, **3:37**

checklist to minimize PTO problems, **3:44**

## INDEX

### APPLICATIONS—Cont'd

Actual use—Cont'd  
claims of distinctiveness, **3:33**  
class number, **3:21**  
collective mark applications, **3:36**  
concurrent use applications, **3:38**  
dates of use of mark, **3:24**  
description of goods or services, **3:23**  
designation of domestic representative, **3:32**  
disclaimer, **3:34**  
drawing, **3:31**  
execution of application, **3:28**  
jurat, **3:29**  
living individuals, applications relating to, **3:42**  
manner or use of mark, **3:25**  
mark  
generally, **3:15**  
correspondence of mark and specimen, **3:18**  
defined, **3:16**  
describing mark, **3:20**  
selecting mark to be registered, **3:19**  
use as, **3:17**  
multiple class applications, **3:40**  
oath or declaration, **3:27**  
ownership of prior registrations, **3:43**  
power of attorney, **3:30**  
preparation, generally, **3:13-3:44**  
renewal applications, **3:41**  
specimens, **3:26**  
Supplemental Register applications, **3:39**  
Advice to clients, **3:68, 4:5**  
Appeals, **14:7, 14:9**  
Applicant  
actual use, **3:22**  
foreign rights, **3:54**  
intent to use (ITU), **3:46**  
Application fee, **3:35**  
Bars to registration  
generally, **3:6**  
certain distinctive marks (§ 2(f)), **3:12**

### APPLICATIONS—Cont'd

Bars to registration—Cont'd  
confusingly similar marks (§ 2(d)), **3:10**  
descriptive and deceptive marks (§ 2(e)), **3:11**  
identification of living individual (§ 2(c)), **3:9**  
immoral, deceptive, or scandalous matter (§ 2(a)), **3:7**  
national insignia (§ 2(b)), **3:8**  
Certain distinctive marks (§ 2(f)), **3:12**  
**Certification Marks** (this index)  
Checklist to minimize PTO problems, **3:44**  
Claims, **3:33, 3:58**  
Class, **3:40**  
Class number, **3:21**  
**Collective Mark Applications** (this index)  
Combined applications, **3:60**  
Common problems with applications, **3:51**  
**Concurrent Use Applications** (this index)  
Confusingly similar marks (§ 2(d)), **3:10**  
Confusion rejection responses, **6:15**  
Consistency Initiative, **App R**  
Correspondence of mark and specimen, **3:18**  
Deception, **3:7, 3:11**  
Definition, **3:16**  
Deposit accounts, **3:67**  
Describing mark, **3:20**  
Description of goods or services, **3:23, 3:48, 3:55**  
Descriptive and deceptive marks (§ 2(e)), **3:11**  
Designation of domestic representative, **3:32**  
Disclaimer, **3:34**  
Distinctive marks, **3:12**  
Distinctiveness, **3:33**  
Docket management, **3:66**  
Domestic representative, **3:32**  
Drawing, **3:31, 3:49, 3:59**  
Electronic filing, **3:65**

**APPLICATIONS—Cont'd**

Examination, **9:6, 10:12, 13:19.1, 24:31**

Execution of application, **3:28, 3:62**

**Federal Application** (this index)

**Federal Registration** (this index)

Fees, **3:35**

File organization, **3:63**

Filing application

generally, **3:64**

docket management, **3:66**

electronic filing, **3:65**

federal application, **3:64-3:66**

international applications filed with PTO, flowchart of application process, **App I**

Flowchart of application process, international applications filed with PTO, **App I**

**Foreign Applications** (this index)

Foreign registration, **3:68, 23:28**

**Foreign Rights** (this index)

Formal rejection responses

address of applicant, **5:8**

citizenship of applicant, **5:7**

control of mark, applicant's, **5:18**

identification of applicant, **5:6**

Forms

amendment of trademark/service mark application, **App C-4a**

applicant's appeal brief (general form), trademark, **App C-4e**

concurrent use of trademark/service mark application, principal register, corporation, **App C-1h**

intent to use (ITU), agreements, sample assignment (ITU application), **App C-7c**

plus application, **App C-1g.1**

PTO Form 4-8, collective membership application, **App C-1c**

PTO Form 4-9, certification mark application, **App C-1d**

PTO Form 1478, trademark application, **App C-1a**

PTO Form 1478a, collective mark application, **App C-1b**

**APPLICATIONS—Cont'd**

Forms—Cont'd

recordal of fastener insignia, **App C-10**

request to divide application, **App C-4j**

trademark application, supplemental register, corporation, **App C-1i**

Identification of living individual (§ 2(c)), **3:9**

Immoral, deceptive, or scandalous matter (§ 2(a)), **3:7**

Insignia, **3:8**

Intent to use (ITU)

generally, **3:45**

applicant, **3:46**

common problems with applications, **3:51**

description of goods or services, **3:48**

drawing, **3:49**

form, agreements, sample assignment (ITU application), **App C-7c**

mark, **3:47**

oath or declaration, **3:50**

**Prosecuting Federal Applications** (this index)

International applications filed with PTO, flowchart of application process, **App I**

ITU. Intent to use (ITU), above

Jurat, **3:29**

Lanham Act

generally, **3:2**

federal application, basis for, **3:5**

Supplemental Register, **3:3, 3:4**

words registrable on Supplemental Register, **3:4**

Living individual, **3:9, 3:42**

Manner or use of mark, **3:25**

Mark, **3:47, 3:53**

Multiple class applications, **3:40**

National insignia (§ 2(b)), **3:8**

Oath or declaration, **3:27, 3:50**

Ownership of prior registrations, **3:43**

Pending applications, **3:69**

Power of attorney, **3:30**

## INDEX

### APPLICATIONS—Cont'd

- Preparation
  - actual use, above
  - foreign rights, above
  - intent to use, above
- Priority claim, **3:58**
- Prior registrations, **3:43**
- Prosecuting Federal Applications**  
(this index)
- PTO** (this index)
- Rejection. Formal rejection responses, above
- Renewal applications, **3:41**
- Responses. Formal rejection responses, above
- Scandalous matter, **3:7**
- Section 44 application, **4:36**
- Selecting mark to be registered, **3:19**
- Similar marks, **3:10**
- Specimens, **3:18, 3:26, 3:57**
- Standard character claim, **3:20, 3:33, 3:49, 3:59, 3:65**
- State registration, **22:4, 22:5**
- Supplemental Register, **3:3, 3:4, 3:39**
- Supplemental Registration Applications** (this index)
- Time, **3:24, 3:56**
- Use. Actual use, above
- Verification, **3:28, 3:50, 3:62, 3:65**
- Witnesses, **19:7, 19:16**
- Words registrable on Supplemental Register, **3:4**

### ARRANGEMENT OF NICE

- Generally, **23:16**

### ASSIGNMENTS AND LICENSES

- Generally, **26:1 et seq.**
- Assignment, generally, **26:5**
- Duties of owner, **26:3**
- Foreign registration, **23:35, 26:9**
- Forms
  - assignment
    - sample (ITU application), **App C-7c**
    - sample (simple), **App C-7b**
    - license, sample (simple-non-exclusive), **App C-7d**
- License agreement, generally, **26:6**

### ASSIGNMENTS AND LICENSES—Cont'd

- Loss of rights, **27:5**
- Madrid Protocol, changes to extensions of protection and international registrations, **26:9**
- Ownership, **26:2-26:4**
- Product liability, **26:8**
- Recording documents, **26:7**
- Rights of owner, **26:4**

### ATTORNEYS

- Form, examining attorneys' appeal brief (general form), **App C-4f**
- Inter partes proceedings, **15:3-15:6**
- Motions, disqualify attorney, **17:19**
- Opinions or decisions, attorney-client confidentiality, **1:23**
- Trademark Attorney** (this index)

### AUDIT INQUIRIES

- Special opinions, **1:24**

### BARS TO REGISTRATION

- Applications** (this index)

### BASIC APPLICATION

- Generally, **23:7 et seq.**

### BASIC REGISTRATION

- Generally, **23:7 et seq.**

### BENELUX UNIFORM TRADEMARK ACT

- Foreign registration, international treaties, **23:17**

### BISX

- See common abbreviations in preliminary materials at front of publication

### BOARD

- Decisions, **11:15, 20:6**
- Jurisdiction, **16:33**

### BOYCOTT DECLARATIONS

- Foreign registration prosecution, **23:31**

### BREADTH OF USE

- Confusion rejection responses, **6:13**

## **BREXIT**

PTO proceedings and filings, **App Z**

## **BRIEFS**

Appeals, **14:7, 14:9, App C-4e**

Closing briefs, **20:2**

Forms, prosecution

applicant's appeal brief (general form), trademark, **App C-4e**

examining attorneys' appeal brief (general form), **App C-4f**

Length limitations, **20:2**

Motions, **17:25, 17:27**

Reply briefs, **14:9, 17:27**

## **BURDEN OF PROOF**

Concurrent use applications, **11:10**

## **BUSINESS RECORDS**

Generally, **19:14**

## **CANCELLATION**

Forms

answer to petition for cancellation (general form), **App C-8f**

petition for cancellation (general form), **App C-8d**

**Inter Partes Proceedings** (this index)

State registration, **22:8**

## **CANFIELD TEST**

Descriptive rejections, **7:3**

## **CENTRAL ATTACK**

Generally, **27:12**

## **CERTAIN DISTINCTIVE MARKS**

(§ 2(f))

Applications, registration bars, **3:12**

## **CERTIFICATE OF EXTENSION OF PROTECTION**

Generally, **23:7**

## **CERTIFICATES AND CERTIFICATION**

Extension of Protection, **23:7**

Forms

facsimile transmission, PTO, **App C-3b**

mailing, 37 C.F.R. § 1.8(a), **App C-3a**

## **CERTIFICATES AND**

### **CERTIFICATION—Cont'd**

Forms—Cont'd

registration certificate, letter to client accompanying, **App C-6c**

Marks. **Certification Marks** (this index)

## **CERTIFICATION MARKS**

Generally, **10:1 et seq.**

Applications

generally, **10:4**

actual use, **3:37**

certification mark, **10:8**

certification statement, **10:9**

commerce, use in, **10:7**

examination of applications, **10:12**

ownership, **10:5**

PTO Form 4-9, certification mark application, **App C-1d**

related company, use by, **10:6**

specimens, **10:10**

statement of non-use, **10:11**

Certification statement, **10:9**

Commerce, use in, **10:7**

Continued use, **10:13**

Contrasting other marks, **10:3**

Definition, **10:2**

Examination of applications, **10:12**

Form, PTO Form 4-9, certification mark application, **App C-1d**

Improper collective or certification mark, alleging, **16:15**

Ownership, **10:5**

Related company, use by, **10:6**

Specimens, **10:10**

Statement of certification, **10:9**

Statement of non-use, **10:11**

Use

application requirements

commerce, use in, **10:7**

related company, use by, **10:6**

statement of non-use, **10:11**

continued use, **10:13**

## **CERTIFIED COPIES**

Foreign registration prosecution, **23:32**

## INDEX

### CHECKLISTS

- Appeals, **14:5**
- Applications, checklist to minimize PTO problems, **3:44**
- Confusion rejection responses, **6:22**
- Descriptive rejection responses, **7:11**
- Notices and petitions, **16:20**

### CHIEF, TESTIMONY IN

- Generally, **19:2**

### CITIZENSHIP

- Formal rejection responses, **5:7**

### CLAIM AND ISSUE PRECLUSION

- Affirmative defenses, **16:29**

### CLAIMS, PRIORITY

- Applications, foreign rights, **3:58**

### CLAIMS OF DISTINCTIVENESS

- Applications, actual use, **3:33**

### CLASS

- Identification of class, **5:5**
- Multi-class registrations, **24:22**
- Multiple class applications, **3:40**
- Number, **3:21**

### CLASSIFICATION SCHEDULES

- PTO, **App A**

### CLOSING BRIEFS

- Generally, **20:2**

### COAT OF ARMS

- Responses, **8:5.40**

### COLLECTIVE MARKS

- Generally, **9:1 et seq.**
- Actual use applications, **3:36**
- Applications, generally, **9:1 et seq.**
- Comparison, **9:2, 9:4**
- Contrasting, **9:4**
- Definition, **9:2**
- Examination of applications, **9:6**
- Federal application preparation, **9:5**
- Form, PTO Form 1478a, collective mark application, **App C-1b**
- History, **9:3**
- Improper collective or certification mark, alleging, **16:15**
- Post-registration matters, **9:7**

### COLLECTIVE MEMBERSHIP

- Form, PTO Form 4-8, collective membership application, **App C-1c**

### COMBINED APPLICATIONS

- Foreign rights, **3:60**

### COMBINED SECTIONS 8 AND 15 AFFIDAVITS

- Federal registration, **24:28**
- Form, PTO Form 1583, **App C-5e**

### COMMERCE, USE IN

- Certification marks, **10:7**
- Federal registration, **24:14**

### COMMISSIONER

- Petitions to Director** (this index)

### COMMUNICATIONS

- Madrid Agreement and Protocol, electronic communications, **App Q**
- Prosecuting federal applications, **4:14**

### COMPEL DISCOVERY

- Motions, **17:8**

### COMPETITION

- Enforcement of Rights** (this index)

### CONCURRENT USE APPLICATIONS

- Generally, **11:1 et seq.**
- Abandonment effect, **11:7**
- Actual use, applications based on, **3:38**
- Adverse decision effect, **11:1**
- Agreements between parties, **11:11**
- Board, subsequent processing after decision by, **11:15**
- Burden of proof, **11:10**
- Contracts and agreements, sample agreement among users, form, **App C-7a**
- Corporations, principal register, form, **App C-1h**
- Court determination, **11:12**
- Court proceedings versus PTO proceedings, **11:4**
- Decisions, **11:5, 11:15**



**CONCURRENT USE****APPLICATIONS—Cont'd**

Determinations, court, **11:12**  
 Diagram, decision, **11:5**  
 Discovery, **11:14**  
 Forms  
   principal register, corporation,  
     **App C-1h**  
   sample agreement among users,  
     **App C-7a**  
 Initiation of proceedings, **11:13**  
 Parties, agreements between, **11:11**  
 Proceedings  
   generally, **11:8**  
   agreements between parties, **11:11**  
   burden of proof, **11:10**  
   court determination, **11:12**  
   discovery, **11:14**  
   initiation of proceedings, **11:13**  
   trial, **11:14**  
 PTO proceedings, **11:4**  
 Requirements for registration, **11:2**  
 Subsequent processing after decision  
   by board, **11:15**  
 Trial, **11:14**

**CONFIGURATION OF PRODUCT**

Marks consisting of, **App F**

**CONFLICTS**

**Enforcement of Rights** (this index)  
 Foreign registration, **23:36**  
 Formal rejection responses, **5:22**

**CONFUSINGLY SIMILAR MARKS**  
(§ 2(d))

Applications, registration bars, **3:10**

**CONFUSION, LIKELIHOOD OF**

Confusion rejection responses, **6:20, 6:21**  
 Inter partes proceedings, **16:11, 16:38**  
 Witnesses, **19:23**

**CONFUSION REJECTIONS**

Actual confusion, **6:12**  
 Applicant's rights, extent of, **6:15**  
 Breadth of use of mark, **6:13**  
 Checklist for responding, **6:22**  
 Consent agreements, **6:14**

**CONFUSION REJECTIONS**  
—Cont'd

Contracts and agreements, **6:14**  
 Evaluation. Responses, below  
 Examples of confusingly similar and  
   not confusingly similar marks,  
     **6:19**  
 Extent of applicant's rights, **6:15**  
 Extent of potential confusion, **6:16**  
 Fame of prior mark, **6:10**  
 Interface between parties/consent  
   agreements, **6:14**  
 Likelihood of confusion, **6:20, 6:21**  
 Parties, interface between parties/  
   consent agreements, **6:14**  
 Potential confusion, **6:16**  
 Presence of actual confusion, **6:12**  
 Prior mark, fame of, **6:10**  
 PTO, reconsideration of likelihood of  
   confusion rejection by, **6:21**  
 Purchasing environment, **6:9**  
 Reconsideration of likelihood of  
   confusion rejection by PTO,  
     **6:21**  
 Responses  
   generally, **6:1 et seq.**  
   breadth of use of mark, **6:13**  
   checklist for responding to likeli-  
     hood of confusion, **6:22**  
   evaluating likelihood, generally,  
     **6:3-6:18**  
   examples of confusingly similar  
     and not confusingly similar  
     marks, **6:19**  
   extent of applicant's rights, **6:15**  
   extent of potential confusion, **6:16**  
   fame of prior mark, **6:10**  
   interface between parties/consent  
     agreements, **6:14**  
   likelihood, **6:2**  
   likelihood of confusion, **6:20**  
   presence of actual confusion, **6:12**  
   probative facts, other, **6:17**  
   purchasing environment, **6:9**  
   reconsideration of likelihood of  
     confusion rejection by PTO,  
       **6:21**  
   review of factors to be considered,  
     **6:5**



## INDEX

### CONFUSION REJECTIONS

#### —Cont'd

- Responses—Cont'd
  - similarity of goods or services, **6:7**
  - similarity of marks, **6:6**
  - similarity of trade channels, **6:8**
  - strength of marks, **6:11**
- Review of factors to be considered, **6:5**
- Similarity of goods or services, **6:7**
- Similarity of marks, **6:6**
- Similarity of trade channels, **6:8**
- Strength of marks, **6:11**
- Trade channels, similarity of, **6:8**
- Use of mark, breadth of, **6:13**

### CONSENT

- Formal rejection responses, **5:17**

### CONSENT AGREEMENTS

- Confusion rejection responses, **6:14**

### CONSIDERATION

- Appeals, **14:12**
- Motions, **17:29**

### CONSISTENCY INITIATIVE

- Request for Consistency Review, **App R**

### CONSOLIDATE

- Motions, **17:20**

### CONTINUED USE

- Certification marks, **10:13**

### CONTRACTING PARTY

- Generally, **23:7 et seq.**

### CONTRACTS AND AGREEMENTS

- Assignments and Licenses** (this index)
- Concurrent use, **11:11; App C-7a**
- Confusion rejection responses, **6:14**
- Foreign registration, **23:4**
- Forms
  - generally, **App C-7**
  - assignment
    - sample (ITU application), **App C-7c**
    - sample (simple), **App C-7b**

### CONTRACTS AND AGREEMENTS

#### —Cont'd

- Forms—Cont'd
  - concurrent users, sample agreement among, **App C-7a**
  - license, sample (simple-non-exclusive), **App C-7d**

### CONTROLLED SUBSTANCES ACT

- Regulations, initiating use of mark, **2:19.50**

### CONTROL OF MARK

- Formal rejection responses, **5:18**

### CO-PENDING CONFLICTING APPLICATIONS

- Formal rejection responses, **5:22**

### COPIES AND COPYING

- Foreign registration, **23:32**
- Trademarks
  - paper copies and access, **App J**

### COPYRIGHT INTERFACE

- Enforcement of rights, **25:16, 25:18**

### CORPORATION

- Forms
  - concurrent use of trademark/service mark application, principal register, corporation, **App C-1h**
  - trademark application, supplemental register, corporation, **App C-1i**

### CORRECTING REGISTRATION

- Federal Registration** (this index)

### CORRESPONDENCE OF MARK AND SPECIMEN

- Actual use, **3:18**

### COSTS AND EXPENSES

- Foreign registration, **23:27**

### COUNTERCLAIMS

- Inter partes proceedings, **16:41**

### COUNTERFEITING

- Enforcement of rights, **25:12**

**COURT OF APPEALS FOR  
FEDERAL CIRCUIT**

Generally, **14:16**

**COURT PROCEEDINGS**

**Appeals** (this index)

Concurrent use applications, **11:4, 11:12**

Form, notice of appeal to court, **App C-4h**

**COURT REPORTER**

Form, inter partes proceedings, instructions, **App C-8l**

**CURRENT USE**

Federal registration, section 8 affidavits, **24:14**

**CYBERPIRACY**

Enforcement of rights, **25:15.50**

**DATA MANAGEMENT**

Witnesses, **19:29**

**DECEPTION**

Applications, registration bars, **3:7, 3:11**

Descriptive rejection responses, **7:6, 7:7**

Geo-significant marks, **7:7.50**

Inter partes proceedings, **16:8, 16:12**

Responses, **7:6, 7:7, 8:5**

**DECISIONS**

See also **Opinions** (this index)

Appeals, **13:21, 14:11, 20:6**

Concurrent use applications, **11:5, 11:15**

Decision of TTAB, **20:4**

Motions, **17:28, 17:29**

Petitions to director, **13:21**

TTAB decision, **14:11**

**DECLARATIONS**

Foreign registration prosecution, **23:31**

Forms, prosecution, **App C-4c**

Interference, **13:15**

Petitions, **13:15**

Prosecution, **4:10, 23:31, App C-4c**

**DEFENSES**

**Inter Partes Proceedings** (this index)

**DEFINITIONS**

Actual use, **3:16**

Certification marks, **10:2**

Collective mark applications, **9:2**

Descriptive rejection, **7:2**

Trademark, **1:4**

**DEPOSIT ACCOUNTS**

Applications, PTO deposit accounts, **3:67**

**DEPOSITIONS**

Discovery, **18:10**

Form, inter partes proceedings, notice of taking testimonial deposition (party to proceeding), **App C-8m**

Witnesses, **19:12, 19:26**

**DESCRIPTION OF GOODS OR  
SERVICES**

Applications  
actual use, **3:23**

foreign rights, **3:55**

intent to use (ITU), **3:48**

**DESCRIPTION OF MARK**

Applications  
actual use, **3:20**

Formal rejection responses, **5:4**

**DESCRIPTIVE AND DECEPTIVE  
MARKS (§ 2(e))**

Applications, registration bars, **3:11**

**DESCRIPTIVE REJECTIONS**

Canfield test, **7:3**

Checklist for evaluating and responding, **7:11**

Deceptively misdescriptive rejection, **7:7**

Deceptively rejection, **7:6**

Definition, **7:2**

Descriptiveness, criteria for determining, **7:3**

Distinctiveness, proof of, **7:9**

Evidence, **7:9**

## INDEX

### DESCRIPTIVE REJECTIONS

#### —Cont'd

- Examples of descriptive and non-descriptive marks, **7:4**
- Geographically descriptive or deceptively misdescriptive rejection, **7:7**
- Merely descriptive rejection, **7:5**
- Misdescription, **7:6, 7:7**
- Primarily geographically descriptive or deceptively misdescriptive rejection, **7:7**
- Primary significance test, **7:3**
- Proof of distinctiveness, **7:9**
- PTO, reconsideration of descriptive rejection by, **7:10**
- Reconsideration of descriptive rejection by PTO, **7:10**
- Responses
  - generally, **7:1 et seq.**
  - checklist for evaluating and responding, **7:11**
  - definition of descriptive rejection, **7:2**
  - descriptiveness, criteria for determining, **7:3**
  - evaluation
    - checklist, **7:11**
    - deceptively rejection, **7:6**
    - geo-significant marks, **7:7.50**
    - merely descriptive rejection, **7:5**
    - primarily geographically descriptive or deceptively misdescriptive rejection, **7:7**
    - surname rejections, **7:8**
  - examples of descriptive and non-descriptive marks, **7:4**
  - primary significance test, **7:3**
  - proof of distinctiveness, **7:9**
  - reconsideration of descriptive rejection by PTO, **7:10**
- Surname rejections, evaluating and responding to, **7:8**

### DESIGNATION OF DOMESTIC REPRESENTATIVE

- Applications, actual use, **3:32**
- Form, PTO, **App C-3f**

### DESIRABLE FUNCTIONAL ATTRIBUTES OF MARK

- Selection of trademark, **2:4**

### DETERMINATIONS

- Concurrent use applications, **11:12**

### DIAGRAM

- Concurrent use applications decision diagram, **11:5**

### DILIGENCE

- Standard for, **12:8**

### DILUTION

- Allegations, grounds for opposition and cancellation, **16:17.1**
- Enforcement of rights, **25:15**

### DIRECTOR

- Petitions to Director** (this index)

### DISCLAIMER

- Applications, actual use, **3:34**
- Federal registration, **24:8**
- Formal rejection responses, **5:13**

### DISCLOSURE

- Protect against trademark scams, **App D**

### DISCOVERY

- Generally, **18:1 et seq.**
- Admissions, request for, **18:9**
- Analyzing responses, **18:13**
- Concurrent use applications, **11:14**
- Depositions, **18:10, 19:12**
- Document organization, **18:2**
- Forms
  - stipulated request to reset discovery and testimony periods, **App C-8k**
  - written statement in support of discovery motion, **App C-8j**
- Inter partes proceedings, generally, **16:46**
- Interrogatories, **18:7**
- Limitations. Restrictions, below
- Motions, **17:8, 17:9**
- Objections, asserting, **18:6**
- Privileged information, **18:5**
- Production of documents, **18:8**

**DISCOVERY—Cont'd**

Relevance, **18:4**  
 Request for admissions, **18:9**  
 Requests for production of documents, **18:8**  
 Responses, **18:12, 18:13, 19:25**  
 Restrictions  
     generally, **18:3**  
     objections, asserting, **18:6**  
     privileged information, **18:5**  
     relevance, **18:4**  
 Sanctions, **18:14**  
 Supplementing responses, **18:12**  
 Timing, **18:11**

**DISMISS**

Motions, **17:5**

**DISTINCTIVE MARKS**

Applications, registration bars, (§ 2(f)), **3:12**  
 Responses, matter related to the Olympics, **8:7.50**

**DISTINCTIVENESS**

Applications, actual use, **3:33**  
 Descriptive rejection responses, **7:9**  
 Inter partes proceedings, alleging § 2(e) and 2(f) grounds for opposition and cancellation, **16:12**  
 Involuntary abandonment of rights, **27:4**

**DISTRICT COURT**

Appeals, **14:17**

**DIVISIONAL APPLICATION**

Prosecuting federal applications, **4:37**

**DOCKET MANAGEMENT**

Applications, filing, **3:66**

**DOCTRINES**

Inter partes proceedings, **15:9**

**DOCUMENT ORGANIZATION**

Discovery, **18:2**

**DOMESTIC REPRESENTATIVE**

Applications, actual use, **3:32**  
 Federal registration, section 8 affidavits, **24:20**

**DOMESTIC REPRESENTATIVE  
—Cont'd**

Form, PTO, designation, **App C-3f**

**DRAWINGS**

Actual use, **3:31**  
 Applications, **3:31, 3:49, 3:59, 4:33**  
 Broken lines, **3:31, 3:44, 3:49, 3:59**  
 Examination procedures for drawings containing the color gray, **App K**  
 Foreign rights, **3:59**  
 Formal rejection responses, **5:9**  
 Forms, examples of drawings  
     generally, **App C-2**  
     special form (black and white), **App C-2b**  
     special form (showing color), **App C-2d**  
     special form (with shading), **App C-2c**  
     typed, **App C-2a**  
 Intent to use (ITU), **3:49, 4:33**  
 Motion mark, **3:31**  
 Non-visual mark, **3:31**  
 Prosecuting federal applications, **4:33**  
 Scanned image requirements, **3:31**  
 Size, **3:31, 3:44, 3:49, 3:59**  
 Standard character set, **3:31, 3:44, 3:49, 3:59**

**DRESS RIGHTS**

Evaluation of trademark, **2:13**

**DUE DILIGENCE INQUIRIES**

Special opinions, **1:25**

**DUPLICATION**

**Copies and Copying** (this index)

**ELECTRONIC COMMUNICATION**

Madrid Agreement and Protocol, certain notifications to holders of international registrations, **App Q**

**ELECTRONIC FILING**

Applications, filing, **3:65**  
 Madrid-protocol related documents, electronic forms for submitting, **App P**

## INDEX

### **ELECTRONIC FILING—Cont'd** **Trademark Electronic Application** **System (TEAS) (this index)**

#### **E-MAIL**

Madrid Agreement and Protocol,  
electronic communications of  
certain notifications to  
international registration hold-  
ers, **App Q**

#### **ENFORCEMENT OF RIGHTS**

Generally, **25:1 et seq.**  
Conflicts  
    generally, **25:2**  
    evaluating similar works for  
    infringement, **25:5**  
    identifying conflicting marks, **25:4**  
    letters of protest to PTO, **25:6**  
    litigation references, **25:8**  
    notice letters, **25:7**  
Copyright interface, **25:16, 25:18**  
Counterfeiting, unfair competition,  
    **25:12**  
Cyberpiracy, **25:15.50**  
Dilution, **25:15**  
Evaluating problems, **25:14**  
Evaluating similar works for  
    infringement, **25:5**  
Fair use of marks, **25:11**  
Federal preemption of rights, **25:19**  
History, **25:10**  
Identifying conflicting marks, **25:4**  
Infringement, **25:5**  
Interface  
    copyright interface, **25:16, 25:18**  
    patent interface, **25:16, 25:17**  
Letters, notice, **25:7**  
Letters of protest to PTO, **25:6**  
Litigation references, **25:8**  
Notice letters, **25:7**  
Patent interface, **25:16, 25:17**  
Preemption, **25:19**  
Protest to PTO, letters of, **25:6**  
PTO, letters of protest to, **25:6**  
Recording marks with U.S. Customs  
    Service, **25:20**  
References, litigation, **25:8**  
RICO claims, **25:13**

#### **ENFORCEMENT OF RIGHTS** **—Cont'd**

Similar works, evaluating for  
    infringement, **25:5**  
Unfair competition  
    generally, **25:9**  
    counterfeiting, **25:12**  
    evaluating problems, **25:14**  
    fair use of marks, **25:11**  
    history, **25:10**  
    RICO claims, **25:13**  
U.S. Customs Service, recording  
    marks with, **25:20**  
Use of marks as fair, **25:11**

#### **ENLARGE TIME**

Motions, **17:11**

#### **ENVIRONMENTAL PROTECTION** **AGENCY**

Initiating use of mark, **2:21**

#### **EQUITABLE DEFENSES**

Inter partes proceedings, **16:26**

#### **ESTIMATION**

Foreign registration costs, **23:27**

#### **ESTOPPEL**

Parties, loss of rights, **27:10**

#### **ESTTA**

Generally, **15:10**  
See also see common abbreviations  
    in preliminary materials at front  
    of publication

#### **ETAS**

See common abbreviations in prelim-  
    inary materials at front of publi-  
    cation

#### **E-TEAS**

See common abbreviations in prelim-  
    inary materials at front of publi-  
    cation

#### **ETEAS**

**Trademark Electronic Application**  
**System (TEAS) (this index)**

#### **ETHICS CONSIDERATIONS**

Opinions or decisions, **1:23**

**EUROPEAN ECONOMIC  
COMMUNITY TRADEMARK**

Foreign registration, **23:18**

**EVALUATION**

Generally, **2:7**

**Confusion Rejections** (this index)

**Descriptive Rejections** (this index)

Dress rights, **2:13**

Enforcement of rights, **25:5, 25:14**

Petitions to director, **13:8**

Professional searching organizations,  
**2:10**

Prosecuting federal applications, **4:4**

Requesting search, **2:11**

Searching organizations, **2:10**

Searching trademark, **2:9**

Search report, **2:12, App B**

Search request, **2:11**

Selection of trademark, **2:6**

Supplemental registration applica-  
tions, **12:4**

**EVIDENCE**

Burden of proof, **11:10**

Descriptive rejection responses, **7:9**

Forms, inter partes proceedings,  
proof of service (general form),  
**App C-8g**

Witnesses (this index)

**EXAMINATION**

Applications, **9:6, 10:12, 13:19.1,  
24:31**

Drawings containing the color gray,  
examination procedures for,  
**App K**

Federal registration, section 8  
affidavits, **24:23**

Form, prosecution, attorneys' appeal  
brief (general form), **App C-4f**

Merely Informational Matter (Exam  
Guide 02-17), **App O**

Petitions to director, return applica-  
tion to examiner, **13:19.1**

PTO Exam Guide No. 1-05, **App K**

PTO Exam Guide No. 02-17, **App O**

**EXCUSABLE NON-USE**

Federal registration, section 8  
affidavits, **24:15**

**EXECUTION**

Applications, **3:28, 3:62**

Federal registration, section 8  
affidavits, **24:21**

**EXHIBITS**

Witnesses, **19:9**

**EX PARTE MATTERS**

Form, prosecution, notice of appeal  
(ex parte), **App C-4d**

Witnesses, **19:21**

**EXPERT OPINIONS**

Generally, **19:18**

**EXTENSION OF TIME**

Forms

inter partes proceedings, request  
for extension of time to  
oppose, trademark, **App C-8b**

PTO Form 1581, extension of time  
to file statement of use, **App  
C-5b**

Inter partes proceedings, **15:10; App  
C-8b**

Prosecuting federal applications, **4:30**

Statements of use, **App C-5b**

**EXTENSIONS OF PROTECTION**

Certificate of extension of protection,  
**23:7**

Flowchart of application process for  
filing international applications  
and extensions of protection  
with PTO, **App I**

Madrid Protocol, extension to U.S.  
amendments, **26:9**

avoidance of provisional refusals,  
**App S**

examination of requests, **23:14**

maintaining, **24:34**

seeking, **App S**

**FACSIMILES**

Form, PTO, certificate of facsimile  
transmission, **App C-3b**

**FACT INVESTIGATION**

Generally, **1:19**

## INDEX

### FAIR USE

Enforcement of rights, unfair competition, **25:11**

### FAME OF PRIOR MARK

Confusion rejection responses, **6:10**

### FASTENER INSIGNIA

Form, recordal of application, **App C-10**

Initiating use of mark, **2:30**

### FEDERAL ACTS

Initiating use of mark, **2:24**

### FEDERAL APPLICATION

Access to pending applications, **3:69**

Collective mark applications, **9:5**

Filing, **3:64-3:66**

Lanham Act, **3:5**

**Prosecuting Federal Applications**  
(this index)

Supplemental registration applications, **12:6**

### FEDERAL CIRCUIT

Court of Appeals, **14:16**

### FEDERAL FOOD AND DRUG ADMINISTRATION

Initiating use of mark, **2:20**

### FEDERAL PREEMPTION

Enforcement of rights, **25:19**

### FEDERAL REGISTRATION

Affidavits

Section 8 affidavits, below

Section 15 affidavits, below

Amendment of registration, **24:8**

Application, **24:30, 24:31**

Class, multi-class registrations, **24:22**

Combined Section 8 and Section 15  
affidavits, **24:28**

Commerce, current use of mark in,  
**24:14**

Correcting registration

generally, **24:2**

format of request for correction,  
**24:6**

PTO mistake, **24:3**

registrant mistakes, **24:4-24:7**

### FEDERAL REGISTRATION

—**Cont'd**

Correcting registration—Cont'd  
requests requiring republication,  
**24:6**

Current use of mark in commerce,  
**24:14**

Disclaimers, **24:8**

Division of Registration, **24:8.50**

Domestic representative, **24:20**

Examination, **24:23, 24:31**

Excusable non-use, **24:15**

Execution, Section 8 affidavits, **24:21**

Expanding registration, Section 15  
affidavits, **24:25-24:27**

Fee, Section 8 affidavits, **24:17**

Final rejection, **24:32**

Format of request for correction, **24:6**

Inter partes proceedings, **16:4**

Maintaining

generally, **24:1 et seq.**

affidavits

combined Section 8 and Section  
15 affidavits, **24:28**

Section 8 affidavits, below

Section 15 affidavits, **24:25-  
24:27**

amendment of registration, **24:8**

combined Section 8 and Section 15  
affidavits, **24:28**

correcting registration, above

Division of Registration, **24:8.50**

expanding registration, Section 15  
affidavits, **24:25-24:27**

partial disclaimers of registration,  
**24:8**

renewal of registration, below

replacement of registration,  
**24:8.60**

restriction of registration, **24:33**

Section 8 affidavits, below

Section 15 affidavits

generally, **24:25-24:27**

combined Section 8 and Section  
15 affidavits, **24:28**

Mark, Section 8 affidavits, **24:18**

Mistakes, correcting

PTO mistake, **24:3**



## FEDERAL REGISTRATION

### —Cont'd

Mistakes, correcting—Cont'd  
 registrant mistakes, **24:4-24:7**  
 Multi-class registrations, Section 8  
 affidavits, **24:22**  
 Ownership, Section 8 affidavits,  
**24:12**  
 Partial disclaimers of registration,  
**24:8**  
 Preparation of Section 15 affidavits,  
**24:27**  
 Preserving registration. Section 8  
 affidavits, below  
 PTO mistake, **24:3**  
 Publication, **24:6**  
 Recited goods or services, **24:19**  
 Registrant mistakes, **24:4-24:7**  
 Rejection, **24:32**  
 Renewal of registration  
   generally, **24:29**  
   application, examination of, **24:31**  
   application requirements, **24:30**  
   subsequent review of final rejection  
   of renewal application,  
   **24:32**  
 Replacement of registration, **24:8.60**  
 Representative, domestic, **24:20**  
 Republication, **24:6**  
 Requests requiring republication,  
**24:6**  
 Restriction of registration, **24:33**  
 Review, subsequent, **24:32**  
 Section 8 affidavits  
   generally, **24:9**  
   current use of mark in commerce,  
   **24:14**  
   domestic representative, **24:20**  
   examination, **24:23**  
   execution, **24:21**  
   fee, **24:17**  
   maintaining, **24:28**  
   mark, **24:18**  
   multi-class registrations, **24:22**  
   ownership, **24:12**  
   recited goods or services, **24:19**  
   showing excusable non-use, **24:15**  
   specimens, **24:16**

## FEDERAL REGISTRATION

### —Cont'd

Section 8 affidavits—Cont'd  
 timeliness, **24:11**  
 use of registered mark, **24:13-24:15**  
 Section 15 affidavits, maintaining  
 generally, **24:25-24:27**  
 combined Section 8 and Section 15  
 affidavits, **24:28**  
 Showing excusable non-use, Section  
 8 affidavits, **24:15**  
 Specimens, Section 8 affidavits,  
**24:16**  
 Subsequent review of final rejection  
 of renewal application, **24:32**  
 Timeliness, Section 8 affidavits,  
**24:11**  
 Use of registered mark, Section 8  
 affidavits, **24:13-24:15**

## FEDERAL TRADEMARK LAWS

Generally, **1:12**

## FEES

Applications, **3:35**  
 Federal registration, Section 8  
 affidavits, **24:17**  
 Formal rejection responses, inadequate or incorrect filing fee,  
**5:19**  
 Petitions to director, **13:7**  
 PTO, **App A**

## FILE ORGANIZATION

Applications, **3:63**

## FILING

**Records and Recording** (this index)

## FILING FEE

Formal rejection responses, **5:19**

## FINAL REJECTION

Federal registration, **24:32**  
**Prosecuting Federal Applications**  
 (this index)

## FIRST USE

Formal rejection responses, **5:11**

## FLAGS

Responses, **8:5.40**

## INDEX

### FOREIGN APPLICATIONS

Formal rejection responses, **5:16**

**Formal Rejections** (this index)

Witnesses, **19:16**

### FOREIGN ENTITIES

Appendix, **App X**

### FOREIGN MARKS

Witnesses, **19:16**

### FOREIGN PROTECTION

Generally, **1:17**

Supplemental registration applications, **12:8**

### FOREIGN REGISTRATION

Generally, **23:1 et seq.**, **23:16**, **App A**

Advice to clients, **3:68**, **23:26**

Advising clients, **23:26**

Applications, **3:68**, **23:28**

Arrangement of Nice, **23:16**

Assignments, **23:35**

Benelux Uniform Trademark Act, **23:17**

Boycott declarations, **23:31**

Certified copies, obtaining from PTO, **23:32**

Conflicting foreign trademarks, **23:36**

Contracts and agreements, **23:4**

Copies, **23:32**

Costs and expenses, **23:27**

Declarations, **23:31**

Estimating costs for registration, **23:27**

European Economic Community trademark, **23:18**

Initiating application, **23:28**

International treaties

generally, **23:2**

Arrangement of Nice, **23:16**

Benelux Uniform Trademark Act, **23:17**

European Economic Community trademark, **23:18**

Madrid Agreement, **23:4**

Madrid Protocol

generally, **23:5**

for detailed matters, see Madrid Protocol, below

### FOREIGN REGISTRATION

—**Cont'd**

International treaties—**Cont'd**

Pan American Convention, **23:15**

Paris Convention, **23:3**

Proposed International Registration Treaty, **23:20**

Trademark Law Treaty, **23:21**

Trademark Registration Treaty, **23:19**

Licenses, **23:35**

Madrid Agreement, **23:4**

Madrid Protocol

generally, **23:5 et seq.**

examination of requests for extension of protection, **23:14**

extension of protection, **23:13**, **23:14**, **26:9**, **App S**

implementation in U.S., **23:6 et seq.**

international applications originating in U.S., **23:7 et seq.**

irregularities, **23:10**, **23:11**

preparing and filing application with PTO, **23:8**

preparing and filing request for extension of protection, **23:13**

preparing and filing subsequent designations submitted through Office, **23:9**

provisional refusals, avoidance, extension of protection to U.S., **App S**

requests for protection of international registration to U.S., **23:12**

responding to irregularities in international application cited by PTO, **23:10**

responding to irregularities in subsequent designation, **23:11**

subsequent designations, **23:6 et seq.**

Maintaining registration, **23:34**

Nice, Arrangement of, **23:16**

Pan American Convention, **23:15**

Paris Convention, **23:3**

Part A and B registrations, **23:33**

**FOREIGN REGISTRATION**  
—Cont'd

Process  
generally, **23:22**  
advising clients, **23:26**  
laws, generally, **23:25**  
use, registration versus, **23:24**  
useful references, **23:23**  
Proposed International Registration Treaty, **23:20**  
Prosecution  
generally, **23:29**  
boycott declarations, **23:31**  
certified copies, obtaining from PTO, **23:32**  
maintaining registration, **23:34**  
part A and B registrations, **23:33**  
PTO, **23:32**  
References, **23:23**  
Trademark Law Treaty, **23:21**  
Trademark Registration Treaty, **23:19**  
Use, **23:23, 23:24**  
Witnesses, **19:16**

**FOREIGN RIGHTS**

Applicant, **3:54**  
Applications, generally, **3:52-3:61**  
Combined applications, **3:60**  
Dates and methods of use, **3:56**  
Description of goods or services, **3:55**  
Drawings, **3:59**  
Initiating use of mark, **2:28**  
Mark, **3:53**  
Priority claim, **3:58**  
Specimens, **3:57**

**FOREIGN WORDS**

Formal rejection responses, **5:15**

**FORMAL MATTERS**

Petitions to director, **13:9**

**FORMAL REJECTIONS**

Address of applicant, **5:8**  
Adequacy, **5:19**  
Applicant. Responses, below  
Citizenship of applicant, **5:7**  
Class, **5:5**  
Conflicting applications, **5:22**

**FORMAL REJECTIONS—Cont'd**

Consent to register surname, **5:17**  
Control of mark, applicant's, **5:18**  
Co-pending conflicting applications, **5:22**  
Description of mark, **5:4**  
Disclaimers, **5:13**  
Drawing, **5:9**  
Fees, **5:19**  
Filing fee, **5:19**  
First use, **5:11**  
Foreign applicants. Responses, below  
Foreign words, **5:15**  
Identification. Responses, below  
Improper or stale verification, **5:20**  
Inadequate or incorrect filing fee, **5:19**  
Inquiries by Trademark Attorney, **5:21**  
Pending acts and matters, **5:22**  
Prior registrations, **5:14**  
Responses  
generally, **5:1 et seq.**  
address of applicant, **5:8**  
applicants  
address of applicant, **5:8**  
citizenship of applicant, **5:7**  
control of mark, applicant's, **5:18**  
foreign applicants, **5:23, 5:24, 5:26**  
identification of applicant, **5:6**  
citizenship of applicant, **5:7**  
consent to register surname, **5:17**  
control of mark, applicant's, **5:18**  
co-pending conflicting applications, **5:22**  
dates of first use, **5:11**  
description of mark, **5:4**  
disclaimers, **5:13**  
drawing, **5:9**  
foreign applicants, **5:23, 5:24, 5:26**  
foreign applications, applications based on, **5:16**  
identification  
applicant, **5:6**  
class, **5:5**  
goods or services, **5:10**

## INDEX

### FORMAL REJECTIONS—Cont'd

- Responses—Cont'd
  - identification—Cont'd
    - mark, **5:3**
    - prior registrations, **5:14**
  - improper or stale verification, **5:20**
  - inadequate or incorrect filing fee, **5:19**
  - inquiries by Trademark Attorney, **5:21**
  - specimens, **5:12**
  - substantive rejections contrasted, **5:2**
  - translation of foreign words, **5:15**
- Specimens, **5:12, 5:26**
- Stale verification, **5:20**
- Substantive rejections contrasted, **5:2**
- Surname, **5:17**
- Time, **5:11**
- Trademark Attorney, **5:21**
- Translation of foreign words, **5:15**
- Use, **5:11**
- Verification, **5:20**
- Words, translation of, **5:15**

### FORMS

- Generally, **App C**
- Affidavits
  - generally, **App C-5**
  - PTO Form 1583
    - combined section 8 and 15 affidavits, **App C-5e**
    - section 8 affidavit, **App C-5c**
    - section 15 affidavit, **App C-5d**
  - PTO Form 1963, trademark renewal and section 8 affidavit, **App C-5f**
- Agreements
  - generally, **App C-7**
  - assignment
    - sample (ITU application), **App C-7c**
    - sample (simple), **App C-7b**
    - concurrent users, sample agreement among, **App C-7a**
    - license, sample (simple-non-exclusive), **App C-7d**
- Amendment of trademark/service mark application, **App C-4a**

### FORMS—Cont'd

- Answer
  - notice of opposition, trademark, **App C-8e**
  - petition for cancellation (general form), **App C-8f**
- Appeal
  - applicant's appeal brief (general form), trademark, **App C-4e**
  - examining attorneys' appeal brief (general form), **App C-4f**
  - notice of appeal (ex parte), **App C-4d**
  - notice of appeal to court, **App C-4h**
- Applications
  - generally, **App C-1**
  - amendment of trademark/service mark application, **App C-4a**
  - appeal brief (general form), trademark, **App C-4e**
  - concurrent use of trademark/service mark application, principal register, corporation, **App C-1h**
  - PTO Form 4-8, collective membership application, **App C-1c**
  - PTO Form 4-9, certification mark application, **App C-1d**
  - PTO Form 1478, trademark application, **App C-1a**
  - PTO Form 1478a, collective mark application, **App C-1b**
  - recordal of fastener insignia, **App C-10**
  - request to divide application, **App C-4j**
  - trademark application, supplemental register, corporation, **App C-1i**
  - trademark plus application, **App C-1g.1**
- Assignment
  - sample (ITU application), **App C-7c**
  - sample (simple), **App C-7b**
- Attorneys, examining attorneys' appeal brief (general form), **App C-4f**

**FORMS—Cont'd**

## Brief

- applicant's appeal brief (general form), trademark, **App C-4e**
- examining attorneys' appeal brief (general form), **App C-4f**

## Cancellation

- answer to petition for cancellation (general form), **App C-8f**
- petition for cancellation (general form), **App C-8d**

## Certificates and certification

- facsimile transmission, **App C-3b**
- mailing, 37 C.F.R. § 1.8(a), **App C-3a**
- PTO Form 4-9, certification mark application, **App C-1d**
- registration certificate, letter to client accompanying, **App C-6c**

Collective mark applications, PTO Form 1478a, **App C-1b**Collective membership application, PTO Form 4-8, **App C-1c**Combined section 8 and 15 affidavit, PTO Form 1583, **App C-5e**Commissioner, petition to (general form), **App C-4i**Concurrent use of trademark/service mark application, principal register, corporation, **App C-1h**Concurrent users, sample agreement among, **App C-7a**

## Corporation

- concurrent use of trademark/service mark application, principal register, corporation, **App C-1h**
- trademark application, supplemental register, corporation, **App C-1i**

Court, notice of appeal to, **App C-4h**Court reporter, instructions to, **App C-8l**Declaration (general form), **App C-4c**Deposition, notice of taking testimonial deposition (party to proceeding), **App C-8m****FORMS—Cont'd**Designation of domestic representative, **App C-3f**

## Discovery

- stipulated request to reset discovery and testimony periods, **App C-8k**
- written statement in support of discovery motion, **App C-8j**

Domestic representative, designation of, **App C-3f**

## Drawings, examples of

- generally, **App C-2**
- special form (black and white), **App C-2b**
- special form (showing color), **App C-2d**
- special form (with shading), **App C-2c**
- typed, **App C-2a**

Electronic forms for submitting Madrid-protocol related documents, **App P**Evidence, proof of service (general form), **App C-8g**Examining attorneys' appeal brief (general form), **App C-4f**Ex parte, notice of appeal, **App C-4d**

## Extension of time

- PTO Form 1581, extension of time to file statement of use, **App C-5b**

request for extension of time to oppose, trademark, **App C-8b**Facsimile transmission, certificate of, **App C-3b**Fastener insignia, recordal of, **App C-10**File statement of use, extension of time to, PTO Form 1581, **App C-5b**

## Format

- general format of motion (including points and authorities), **App C-8h**
- general format of response to PTO, trademark, **App C-4b**

General format of motion (including points and authorities), **App C-8h**

## INDEX

### FORMS—Cont'd

General format of response to PTO, trademark, **App C-4b**  
General form of response to motion, **App C-8i**  
Hearing, request for, **App C-4g**  
Infringement of client's rights by another, notice letter re, **App C-8a**  
Insignia, recordal of fastener insignia, **App C-10**  
Instructions to court reporter, **App C-8l**  
Inter partes proceedings  
    generally, **App C-8**  
    answer to notice of opposition, trademark, **App C-8e**  
    answer to petition for cancellation (general form), **App C-8f**  
    general format of motion (including points and authorities), **App C-8h**  
    general form of response to motion, **App C-8i**  
    instructions to court reporter, **App C-8l**  
    notice letter re infringement of client's rights by another, **App C-8a**  
    notice of opposition (general form), **App C-8c**  
    notice of reliance, **App C-8n**  
    notice of taking testimonial deposition (party to proceeding), **App C-8m**  
    petition for cancellation (general form), **App C-8d**  
    proof of service (general form), **App C-8g**  
    request for extension of time to oppose, trademark, **App C-8b**  
    stipulated request to reset discovery and testimony periods, **App C-8k**  
    written statement in support of discovery motion, **App C-8j**  
ITU applications, sample, assignment, **App C-7c**  
Letters, notice letter re infringement of client's rights by another, **App C-8a**

### FORMS—Cont'd

Letters to client  
    generally, **App C-6**  
    registration certificate, letter to client accompanying, **App C-6c**  
    report of PTO action to client (final), **App C-6b**  
    report of PTO action to client (non-final), **App C-6a**  
    state trademark/service mark registration, letter to client accompanying, **App C-6d**  
License, sample (simple-non-exclusive), **App C-7d**  
Mailing, certificate of, 37 C.F.R. § 1.8(a), **App C-3a**  
Membership application, collective, PTO Form 4-8, **App C-1c**  
Motion  
    general format of motion (including points and authorities), **App C-8h**  
    general form of response to motion, **App C-8i**  
    written statement in support of discovery motion, **App C-8j**  
Names, proper use of, **App C-9**  
Notice  
    answer to notice of opposition, trademark, **App C-8e**  
    appeal (ex parte), **App C-4d**  
    appeal to court, **App C-4h**  
    notice letter re infringement of client's rights by another, **App C-8a**  
    opposition (general form), **App C-8c**  
    reliance, **App C-8n**  
    taking testimonial deposition (party to proceeding), **App C-8m**  
Opposition  
    answer to notice of opposition, trademark, **App C-8e**  
    notice of opposition (general form), **App C-8c**  
    request for extension of time to oppose, trademark, **App C-8b**

**FORMS—Cont'd**

Oral hearing, request for, **App C-4g**  
 Parties, notice of taking testimonial deposition (party to proceeding), **App C-8m**  
 Petitions  
     answer to petition for cancellation (general form), **App C-8f**  
     cancellation (general form), **App C-8d**  
     Commissioner (general form), **App C-4i**  
 Post card, return receipt post card (reverse side), **App C-3c**  
 Principal register, concurrent use of trademark/service mark application, corporation, **App C-1h**  
 Proof of service (general form), **App C-8g**  
 Proper use of names, **App C-9**  
 Prosecution  
     generally, **App C-4**  
     amendment of trademark/service mark application, **App C-4a**  
     applicant's appeal brief (general form), trademark, **App C-4e**  
     declaration (general form), **App C-4c**  
     examining attorneys' appeal brief (general form), **App C-4f**  
     general format of response to PTO, trademark, **App C-4b**  
     notice of appeal (ex parte), **App C-4d**  
     notice of appeal to court, **App C-4h**  
     petition to Commissioner (general form), **App C-4i**  
     request for oral hearing, trademark, **App C-4g**  
     request to divide application, **App C-4j**  
 PTO  
     certificate of facsimile transmission, **App C-3b**  
     certificate of mailing, 37 C.F.R. § 1.8(a), **App C-3a**  
     designation of domestic representative, **App C-3f**

**FORMS—Cont'd**

PTO—Cont'd  
     electronic forms for submitting Madrid-protocol related documents, **App P**  
     general format of response to PTO, trademark, **App C-4b**  
     letters to client  
         report of PTO action to client (final), **App C-6b**  
         report of PTO action to client (non-final), **App C-6a**  
     return receipt post card (reverse side), **App C-3c**  
 PTO Form 4-8, collective membership application, **App C-1c**  
 PTO Form 4-9, certification mark application, **App C-1d**  
 PTO Form 1478, trademark application, **App C-1a**  
 PTO Form 1478a, collective mark application, **App C-1b**  
 PTO Form 1553, statement of use, **App C-5a**  
 PTO Form 1581, extension of time to file statement of use, **App C-5b**  
 PTO Form 1583  
     combined section 8 and 15 affidavits, **App C-5e**  
     section 8 affidavit, **App C-5c**  
     section 15 affidavit, **App C-5d**  
 PTO Form 1963, trademark renewal and section 8 affidavit, **App C-5f**  
 Receipt, return receipt post card (reverse side), **App C-3c**  
 Recordal of fastener insignia, **App C-10**  
 Registration certificate, letter to client accompanying, **App C-6c**  
 Reliance, notice of, **App C-8n**  
 Renewal, PTO Form 1963, **App C-5f**  
 Reports and reporting  
     instructions to court reporter, **App C-8l**  
     PTO action to client (final), **App C-6b**  
     PTO action to client (non-final), **App C-6a**



## INDEX

### FORMS—Cont'd

#### Requests

- divide application, **App C-4j**
- extension of time to oppose,  
trademark, **App C-8b**
- oral hearing, trademark, **App C-4g**
- stipulated request to reset  
discovery and testimony  
periods, **App C-8k**

#### Reset discovery, **App C-8k**

#### Response

- general format of response to PTO,  
trademark, **App C-4b**
- general form of response to  
motion, **App C-8i**

#### Return receipt post card (reverse side), **App C-3c**

#### Section 8 affidavits

- PTO Form 1583
  - combined section 8 and 15  
affidavits, **App C-5e**
  - section 8 affidavit, **App C-5c**
- PTO Form 1963, trademark  
renewal and section 8 affida-  
vit, **App C-5f**

#### Section 15 affidavits, PTO Form 1583

- combined section 8 and 15  
affidavits, **App C-5e**
- section 15 affidavit, **App C-5d**

#### Service mark

- amendment of trademark/service  
mark application, **App C-4a**
- concurrent use of trademark/  
service mark application,  
principal register, corporation,  
**App C-1h**
- state trademark/service mark  
registration, letter to client  
accompanying, **App C-6d**

#### Service of process (general form), **App C-8g**

#### Special form (black and white), **App C-2b**

#### Special form (showing color), **App C-2d**

#### Special form (with shading), **App C-2c**

### FORMS—Cont'd

#### Statement in support of discovery motion, **App C-8j**

#### Statements of use

- generally, **App C-5**
- PTO Form 1553, statement of use,  
**App C-5a**
- PTO Form 1581, extension of time  
to file statement of use, **App  
C-5b**

#### State trademark/service mark registration, letter to client accompanying, **App C-6d**

#### Stipulated request to reset discovery and testimony periods, **App C-8k**

#### Supplemental register, **App C-1i**

#### TEAS System

- trademark plus application, **App  
C-1g.1**

#### Third persons, **App C-8a**

#### 37 C.F.R. § 1.8(a), **App C**

#### 37 C.F.R. § 1.10, **App C**

#### Time, **App C-5b, App C-8b, App C-8k**

#### Trademark application, supplemental register, corporation, **App C-1i**

#### Trademark plus application, **App C-1g.1**

#### Typed, examples of drawings, **App C-2a**

#### Use

- concurrent use of trademark/  
service mark application,  
principal register, corporation,  
**App C-1h**
- concurrent users, sample agree-  
ment among, **App C-7a**
- proper use of names, **App C-9**
- statements of use, above

#### Witnesses

- notice of taking testimonial deposi-  
tion (party to proceeding),  
**App C-8m**
- stipulated request to reset  
discovery and testimony  
periods, **App C-8k**

#### Written statement in support of discovery motion, **App C-8j**

**FRAUD**

Generally, **3:27, 4:27, 16:7**  
Affirmative defenses, **16:40**  
Opposition and cancellation, grounds for, **16:16**

**FUNCTIONAL FEATURES NOT REGISTRABLE**

Responses, **8:3**

**GENERICNESS**

Allegations, grounds for opposition and cancellation, **16:13**

**“GENEVA CROSS”**

Responses, **8:5.20**

**GEOGRAPHICALLY DESCRIPTIVE REJECTION**

Responses, **7:7**

**GEO-SIGNIFICANT MARKS**

Deception, **7:7.50**

**GOODWILL**

Generally, **1:5**

**GOVERNMENTAL INSIGNIA**

Alleging § 2(b) grounds, grounds for opposition and cancellation, **16:9**  
Responses, **8:6**

**GREEK RED CROSS**

Responses, **8:5.20**

**HEARINGS**

Forms, prosecution, request for oral hearing, **App C-4g**

**HEARSAY**

Generally, **19:19**

**HISTORY**

Collective mark applications, **9:3**  
Enforcement of rights, **25:10**

**IB**

See common abbreviations in preliminary materials at front of publication

**ICON**

Universal symbols, responses, **8:5.60**

**IDENTIFICATION**

Applications, **3:9**  
Enforcement of rights, **25:4**  
**Formal Rejections** (this index)

**IMMORAL MATTERS (§ 2(a))**

Applications, registration bars, **3:7**  
Pleadings in inter partes proceedings, grounds for opposition and cancellation, **16:8**

**INADVERTENTLY ISSUED REGISTRATIONS**

Petitions to director, **13:19**

**INCONTESTABILITY OF RIGHTS**

Pleadings in inter partes proceedings, affirmative defenses, **16:35**

**INFORMATIONAL MATTERS**

Merely Informational Matter (Exam Guide 02-17), PTO, **App O**

**INFRINGEMENT**

Enforcement of rights, **25:5**  
Form, notice letter re infringement of client's rights by another, **App C-8a**

**INITIATING APPLICATION**

Foreign registration, **23:28**

**INITIATING PROCEEDINGS**

Concurrent use applications, **11:13**  
Pleadings in inter partes proceedings, **16:2**

**INITIATING USE OF MARK**

Generally, **2:14**  
Adequate and inadequate usage, **2:18**  
Controlled Substances Act, **2:19.50**  
Environmental Protection Agency, **2:21**  
Fastener insignia, **2:30**  
Federal acts affecting labeling, generally, **2:24**  
Federal Food and Drug Administration, **2:20**  
Foreign rights, rights based upon, **2:28**  
Intent to use, rights based on, **2:27**  
Labeling and usage regulations generally, **2:19**

## INDEX

### INITIATING USE OF MARK

#### —Cont'd

- Labeling and usage regulations
  - Cont'd
  - Controlled Substances Act, **2:19.50**
  - Environmental Protection Agency, **2:21**
  - federal acts affecting labeling, generally, **2:24**
  - Federal Food and Drug Administration, **2:20**
  - state labeling requirements, **2:25**
  - U.S. Department of Agriculture, **2:22**
  - U.S. Treasury Department, **2:23**
- Maintaining rights, **2:29**
- Rules of usage, **2:16**
- State labeling requirements, **2:25**
- U.S. Department of Agriculture, **2:22**
- U.S. Treasury Department, **2:23**

### INQUIRIES

- Formal rejection responses, **5:21**

### INSIGNIA

- Applications, **3:8; App C-10a**
- Form, application, recordal of fastener insignia, **App C-10**
- Initiating use of mark, fastener, **2:30**
- Pleadings in inter partes proceedings, **16:9**
- Responses, **8:6**

### INSTRUCTIONS

- Forms, inter partes proceedings, court reporter, **App C-8l**

### INTENT TO USE (ITU)

- Generally, **1:16**
- Applications** (this index)
- Form, agreements, sample assignment (ITU application), **App C-7c**
- Initiating use of mark, **2:27**
- Petitions to director, revival of ITU applications, **13:11**

### INTERFACE

- Confusion rejection responses, parties/consent agreements, **6:14**

### INTERFACE—Cont'd

- Enforcement of rights
  - copyright interface, **25:16, 25:18**
  - patent interface, **25:16, 25:17**

### INTERNATIONAL APPLICATION

- Generally, **23:7 et seq.**
- Flowchart of application process, international applications filed with PTO, **App I**

### INTERNATIONAL BUREAU

- Generally, **23:7 et seq.**

### INTERNATIONAL REGISTRATION

- Foreign Registration** (this index)
- Madrid Protocol** (this index)

### INTERNATIONAL TRADEMARK AGREEMENTS

- Members, **App Y**

### INTERNATIONAL TREATIES

- Foreign Registration** (this index)

### INTER PARTES PROCEEDINGS

- Generally, **15:1 et seq., 16:1 et seq.**
- Abandonment, **16:14, 16:32, 16:39**
- Acquiescence, **16:27**
- Adverse decision effect, **15:9, 20:4**
- Affirmative defenses
  - generally, **16:24**
  - abandonment, **16:32, 16:39**
  - acquiescence, **16:27**
  - claim and issue preclusion, **16:29**
  - equitable defenses compared, **16:26**
  - fraud, **16:40**
  - incontestability of rights, **16:35**
  - jurisdiction of Board, matters outside of, **16:33**
  - laches, **16:28**
  - likelihood of confusion, **16:38**
  - prior rights, **16:31**
  - special defenses, **16:38, 16:39, 16:40**
  - standing, lack of, **16:34**
  - unclean hands, **16:30**
- Allegations. Grounds for opposition and cancellation, below

**INTER PARTES PROCEEDINGS****—Cont'd**

Answer  
 affirmative defenses, above  
 filing answer, **16:42**  
 general preparation, **16:23**  
 notice of opposition, form, **App C-8e**  
 petition for cancellation (general form), **App C-8f**  
 processing of answer by TTAB, **16:43**  
 response, **16:44**  
 Board, matters outside of jurisdiction of, **16:33**  
 Cancellation  
   grounds for opposition and cancellation, below  
   petition to cancel federal registration, **16:4**  
 Certification mark, **16:15**  
 Checklist for notices and petitions, **16:20**  
 Claim and issue preclusion, **16:29**  
 Collective mark, **16:15**  
 Confidential materials, **19:27**  
 Confusion, likelihood of, **16:11**, **16:38**  
 Counterclaims, **16:41**  
 Deception, alleging § 2(a) grounds, **16:8**  
 Deceptiveness and distinctiveness, alleging § 2(e) and 2(f) grounds, **16:12**  
 Default, **16:44**  
 Defenses. Affirmative defenses, above  
 Deposition, notice of taking testimonial deposition (party to proceeding), forms, **App C-8m**  
 Dilution, alleging (under Trademark Amendments Act of 1999), **16:17.1**  
**Discovery** (this index)  
 Distinctiveness, alleging § 2(e) and 2(f) grounds, **16:12**  
 Doctrines, **15:9**  
 Equitable defenses compared, **16:26**  
 Extension of time, **15:10**

**INTER PARTES PROCEEDINGS****—Cont'd**

Federal registration, **16:4**  
 Filing answer, **16:42**  
 Filing notice or petition, **16:21**  
 Forms  
   generally, **App C-8**  
   answer to notice of opposition, trademark, **App C-8e**  
   answer to petition for cancellation (general form), **App C-8f**  
   general format of motion (including points and authorities), **App C-8h**  
   general form of response to motion, **App C-8i**  
   instructions to court reporter, **App C-8l**  
   notice letter re infringement of client's rights by another, **App C-8a**  
   notice of opposition (general form), **App C-8c**  
   notice of reliance, **App C-8n**  
   notice of taking testimonial deposition (party to proceeding), **App C-8m**  
   petition for cancellation (general form), **App C-8d**  
   proof of service (general form), **App C-8g**  
   request for extension of time to oppose, trademark, **App C-8b**  
   stipulated request to reset discovery and testimony periods, **App C-8k**  
   written statement in support of discovery motion, **App C-8j**  
 Fraud, **16:16**, **16:40**  
 General format of motion (including points and authorities), form, **App C-8h**  
 General form of response to motion, **App C-8i**  
 Genericness, alleging, **16:13**  
 Governmental insignia, alleging § 2(b) grounds, **16:9**  
 Grounds for opposition and cancellation  
   generally, **16:5**

## INDEX

### INTER PARTES PROCEEDINGS

#### —Cont'd

Grounds for opposition and cancellation—Cont'd

abandonment, alleging, **16:14**

allegations, generally, **16:8-16:17.1**

checklist for notices and petitions, **16:20**

deceptiveness and distinctiveness, alleging § 2(e) and 2(f) grounds, **16:12**

dilution, alleging, **16:17.1**

fraud, alleging, **16:16**

genericness, alleging, **16:13**

governmental insignia, alleging § 2(b) grounds, **16:9**

immoral, deceptive or scandalous, alleging § 2(a) grounds, **16:8**

improper collective or certification mark, alleging, **16:15**

likelihood of confusion, alleging § 2(d) grounds, **16:11**

living individual, alleging § 2(c) grounds, **16:10**

misrepresentation of source, alleging, **16:17**

requesting relief, **16:19**

standing, establishing, **16:7**

Immoral, alleging § 2(a) grounds, **16:8**

Improper collective or certification mark, alleging, **16:15**

Incontestability of rights, **16:35**

Initiating proceeding, **16:2**

Insignia, **16:9**

Instructions to court reporter, form, **App C-8l**

Judicial notice, **19:17**

Jurisdiction of Board, matters outside of, **16:33**

Laches, **16:28**

Likelihood of confusion, **16:11, 16:38**

Living individual, alleging § 2(c) grounds, **16:10**

Misrepresentation of source, alleging, **16:17**

**Motions** (this index)

### INTER PARTES PROCEEDINGS

#### —Cont'd

**Notice** (this index)

Opposition

generally, **15:10**

forms

answer to notice of opposition, trademark, **App C-8e**

notice of opposition (general form), **App C-8c**

request for extension of time to oppose, trademark, **App C-8b**

grounds for opposition and cancellation, above

notice of opposition, **16:3**

requests for extension of time to oppose, **15:10**

**Petitions** (this index)

**Petitions to Director** (this index)

Pleadings, generally, **16:1-16:46**

Preclusion, **16:29**

Prior rights, **16:31**

Proof of service (general form), **App C-8g**

PTO, obtaining records from, **15:12**

Records from PTO, obtaining, **15:12**

Relevant issues, **16:45**

Reliance, notice, forms, **App C-8n**

Representation in proceeding, **15:3-15:6**

Request for extension of time to oppose, **15:10; App C-8b**

Requesting relief, **16:19**

Response, **16:44**

Rules, **15:8**

Sanctions, **15:13, 18:14**

Scandalous, alleging § 2(a) grounds, **16:8**

Settlement, **15:11**

Source misrepresentation, alleging, **16:17**

Special defenses

abandonment, **16:39**

fraud, **16:40**

likelihood of confusion, **16:38**

Standing, **16:7, 16:34**

## INTER PARTES PROCEEDINGS

### —Cont'd

Stipulated request to reset discovery and testimony periods, form, **App C-8k**

Strategy, **16:46**

Third persons, notice letter re infringement of client's rights by another, forms, **App C-8a**

Time, requests for extension of time to oppose, **15:10**

Trial order, **16:22**

TTAB, **15:7, 16:22, 16:22.50, 16:43**

Unclean hands, **16:30**

Watch services, **15:6**

**Witnesses** (this index)

Written statement in support of discovery motion, form, **App C-8j**

## INTERROGATORIES

Generally, **18:7**

## INTERVIEWS

Prosecuting federal applications, **4:12, 4:19**

## INVESTIGATION OF FACTS

Generally, **1:19**

## INVESTIGATION OF LAW

Generally, **1:20**

## ISSUANCE

Petitions to director, inadvertently issued registrations, **13:19**

Prosecuting federal applications, **4:25**

Supplemental registration applications and post-issuance treatment, **12:9**

## ITU

**Intent to Use (ITU)** (this index)

## JUDGMENTS

Motions

generally, **17:6**

alter or amend judgment, **17:15**

relief from judgment, **17:16**

summary judgment, **17:10**

## JUDICIAL NOTICE

Witnesses, **19:17**

## JURAT

Applications, actual use, **3:29**

## JURISDICTION

Affirmative defenses, **16:33**

## LABELING

**Initiating Use of Mark** (this index)

## LACHES

Affirmative defenses, **16:28**

Loss of rights, **27:9**

## LANHAM ACT

**Applications** (this index)

## LAW INVESTIGATION

Generally, **1:20**

## LETTERS

Forms

client, letters to

generally, **App C-6**

registration certificate, letter to client accompanying, **App C-6c**

report of PTO action to client (final), **App C-6b**

report of PTO action to client (non-final), **App C-6a**

state trademark/service mark registration, letter to client accompanying, **App C-6d**

notice letter re infringement of client's rights by another, **App C-8a**

Notice, **25:7; App C-8a**

Protest, **13:22, 25:6**

## LICENSES

**Assignments and Licenses** (this index)

## LIKELIHOOD OF CONFUSION

**Confusion, Likelihood Of** (this index)

## LIMITATIONS AND RESTRICTIONS

**Discovery** (this index)

Federal registration, **24:33**

## INDEX

### LITIGATION REFERENCES

Enforcement of rights, **25:8**

### LIVING INDIVIDUAL

Applications, **3:9, 3:42**

Inter partes proceedings, **16:10**

### LOSS OF RIGHTS

Generally, **27:1 et seq.**

Abandonment, **27:2**

Acquiescence, **27:8**

Distinctiveness, loss of, **27:4**

Estoppel, **27:10**

International registrations under  
Madrid Protocol, loss of rights  
in, **27:12**

Involuntary abandonment of rights  
generally, **27:3**  
distinctiveness, loss of, **27:4**  
licensing, loss of rights by, **27:5**  
unclean hands, loss of rights by,  
**27:6**

Laches, **27:9**

Licensing, loss of rights by, **27:5**

Madrid Protocol, loss of rights in  
international registrations under,  
**27:12**

Parties  
generally, **27:7**  
by acquiescence, **27:8**  
by estoppel, **27:10**  
by laches, **27:9**

Recapture, **27:11**

Unclean hands, loss of rights by, **27:6**

Voluntary abandonment of rights,  
**27:2**

### MADRID AGREEMENT

Generally, **23:4**

### MADRID EXPRESS DATABASE

Generally, **2:9**

### MADRID PROTOCOL

See also **Foreign Registration** (this  
index)

Application, in general, **23:6 et seq.**

Changes to extensions of protection  
and international registrations  
under, **26:9**

### MADRID PROTOCOL—Cont'd

Electronic forms for submitting  
Madrid-protocol related docu-  
ments, **App P**

Extensions of protection to U.S.  
amendments, **26:9**  
avoidance of provisional refusals,  
**App S**  
examination of request, **23:14**  
maintaining, **24:34**  
seeking, **App S**

**Foreign Registration** (this index)

International registrations  
see also **Foreign Registration**  
(this index)  
extensions of protection to U.S.,  
above  
loss of rights in international  
registration under Protocol,  
**27:12**

maintaining, **24:35**

International registrations (1891)  
electronic communication of  
certain notifications to hold-  
ers, **App Q**

Loss of rights in international  
registration under, **27:12**

Notice of irregularity (application),  
**23:10**

Preparation of application, **23:7**

Prosecution of application, **23:8 et  
seq.**

Tips for filing an outbound Madrid  
Protocol Application, **App G**

### MAILING

Form, PTO, certificate of mailing, 37  
C.F.R. § 1.8(a), **App C-3a**

### MAINTAINING REGISTRATION

Foreign registration prosecution,  
**23:34**

State registration, **22:7**

### MEMBERSHIP

Form, PTO Form 4-8, collective  
membership application, **App  
C-1c**

### MERELY DESCRIPTIVE REJECTION

Evaluating and responding to, **7:5**



**MISDESCRIPTION**

Descriptive rejection responses, **7:6, 7:7**

**MISREPRESENTATION**

Inter partes proceedings, grounds for opposition and cancellation, **16:17**

**MISTAKES**

**Federal Registration** (this index)

**MODEL STATE TRADEMARK ACT**

Generally, **1:13**

**MODIFICATION**

**Alteration, Amendment, or Modification** (this index)

**MORE DEFINITE STATEMENT**

Motions, **17:3**

**MOTIONS**

Generally, **17:1 et seq.**  
 Admit testimony, **17:23**  
 Alteration, amendment, or modification, **17:13, 17:15, 17:29**  
 Attorneys, disqualifying, **17:19**  
 Briefs, **17:25, 17:27**  
 Compel discovery, **17:8**  
 Consolidate, **17:20**  
 Decisions, **17:28, 17:29**  
 Discovery, **17:8, 17:9; App C-8j**  
 Dismiss, **17:5**  
 Disqualify attorney, **17:19**  
 Enlarge time, **17:11**  
 Forms  
     general format of motion (including points and authorities), **App C-8h**  
     general form of response to motion, **App C-8i**  
     written statement in support of discovery motion, **App C-8j**  
 Judgment  
     alter or amend judgment, **17:15**  
     on pleadings, **17:6**  
     relief from judgment, **17:16**  
     summary judgment, **17:10**  
 More definite statement, **17:3**

**MOTIONS—Cont'd**

New trial, **17:14**  
 Order  
     protective order, **17:7**  
     request for reconsideration or modification of order or decision, **17:29**  
     show cause, **17:21**  
 Other, **17:24**  
 Pleadings, judgment on, **17:6**  
 Preparation, **17:25**  
 Protective order, **17:7**  
 Reconsideration, **17:29**  
 Relief from judgment, **17:16**  
 Reopen testimony period, **17:12**  
 Reply brief, **17:27**  
 Request for reconsideration or modification of order or decision, **17:29**  
 Request to suspend proceedings, **17:17**  
 Response, **17:9, 17:26, App C-8i**  
 Show cause order, **17:21**  
 Stay, **17:22**  
 Strike, **17:4**  
 Substitute, **17:18**  
 Summary judgment, **17:10**  
 Suspend proceedings, motion or request to, **17:17**  
 Time, **17:11, 17:12**  
 Withdraw discovery responses, **17:9**  
 Witnesses, **17:12, 17:23**  
 Written statement in support of discovery motion, form, **App C-8j**

**MPIA**

Generally, **23:6**

**MPU**

See common abbreviations in preliminary materials at front of publication

**MULTI-CLASS REGISTRATIONS**

Federal registration, section 8 affidavits, **24:22**

**MULTIPLE CLASS APPLICATIONS**

Actual use, **3:40**

## INDEX

### NAMES

- Descriptive rejection responses, **7:8**
- Form, proper use of names, **App C-9**
- Formal rejection responses, **5:17**
- Responses, **5:17, 7:8, 8:7**

### NATIONAL INSIGNIA (§ 2(b))

- Applications, registration bars, **3:8**

### NATIONAL RED CROSS

- Responses, **8:5.20**

### NEW TRIAL

- Motions, **17:14**

### NICE, ARRANGEMENT OF

- Generally, **23:16, App A**

### NOTICE

- Generally, **16:20, 16:21**
- Checklist, grounds for opposition and cancellation, **16:20**
- Filing, **16:21**
- Forms
  - answer to notice of opposition, trademark, **App C-8e**
  - appeal (ex parte), prosecution, **App C-4d**
  - appeal to court, prosecution, **App C-4h**
  - letter re infringement of client's rights by another, **App C-8a**
  - opposition (general form), **App C-8c**
  - reliance, **App C-8n**
  - taking testimonial deposition (party to proceeding), **App C-8m**
- Letters, **25:7**
- Madrid Agreement and Protocol, electronic communications of certain notifications to international registration holders, **App Q**
- Opposition, **16:3, 16:20; App C-8c**
- TTAB proceedings, **16:22**
- Witnesses, judicial notice, **19:17**

### OATH OR DECLARATION

- Actual use, **3:27**
- Intent to use (ITU), **3:50**

### OBJECTIONS

- Discovery, **18:6**
- Witnesses, **19:3**

### OFFICE OF ORIGIN

- Generally, **23:6 et seq.**

### OLYMPICS OR U.S. OLYMPIC COMMITTEE

- Responses, Olympics-related matter, **8:7.50**

### OPERATIONS

- Tab, **16:22.50**

### OPINIONS

- See also **Decisions** (this index)
- Adverse interests, **1:23**
- Attorney-client confidentiality, **1:23**
- Audit inquiries, special opinions, **1:24**
- Confidentiality of clients, **1:23**
- Developing opinions, **1:21**
- Due diligence inquiries, special opinions, **1:25**
- Ethics considerations, **1:23**
- Fact investigation, **1:19**
- Law investigation, **1:20**
- Preparing written opinions, **1:18**
- Special opinions, **1:24, 1:25**
- Written opinion, generally, **1:22**

### OPPOSITION

- Inter Partes Proceedings** (this index)

### ORAL ARGUMENT

- Generally, **20:3**
- Appeals, **14:10**

### ORAL HEARING

- Forms, request for oral hearing, trademark, **App C-4g**

### ORDER

- Protective order, **17:7**
- Request for reconsideration or modification of order or decision, **17:29**
- Show cause order, **17:21**

### OWNERSHIP

- Assignments and licenses, **26:2-26:4**

**OWNERSHIP—Cont'd**

- Certification marks, application requirements, **10:5**
- Federal registration, section 8 affidavits, **24:12**
- Prior registrations, **3:43**
- Responses, **8:4**

**PAN AMERICAN CONVENTION**

- Generally, **23:15**

**PARIS CONVENTION**

- Generally, **23:3**

**PART A AND B REGISTRATIONS**

- Foreign registration prosecution, **23:33**

**PARTIAL DISCLAIMERS**

- Federal registration, maintaining, **24:8**

**PARTIES**

- Concurrent use applications, **11:11**
- Confusion rejection responses, **6:14**
- Form, inter partes proceedings, notice of taking testimonial deposition (party to proceeding), **App C-8m**
- Loss of Rights (this index)

**PATENT INTERFACE**

- Enforcement of rights, **25:16, 25:17**

**PATENT TRADEMARK OFFICE**

- PTO (this index)

**PENALTIES**

- Sanctions (this index)

**PENDING ACTS AND MATTERS**

- Applications, **3:69**
- Formal rejection responses, **5:22**
- Request for Consistency Review, **App R**

**PETITION FEE**

- Generally, **13:7**

**PETITIONS**

- Director. **Petitions to Director** (this index)

**PETITIONS—Cont'd**

Forms

- inter partes proceedings
  - answer to petition for cancellation (general form), **App C-8f**
  - petition for cancellation (general form), **App C-8d**
- prosecution, petitions to Commissioner (general form), **App C-4i**

Inter partes proceedings

- federal registration, petition to cancel, **16:4**
- filing notice or petition, **16:21**
- forms
  - answer to petition for cancellation (general form), **App C-8f**
  - petition for cancellation (general form), **App C-8d**
- opposition and cancellation, grounds for, **16:20**

**PETITIONS TO DIRECTOR**

- Generally, **13:1 et seq.**
- Appeals from decision by director, **13:21**
- Contents of petition
  - generally, **13:3**
  - petition fee, **13:7**
  - supporting documentation, **13:5**
  - timeliness, **13:6**
- Decision, appeals from, **13:21**
- Declarations of interference, **13:15**
- Evaluation of petitions, **13:8**
- Examiner, return application to, **13:19.1**
- Fees, **13:7**
- Form, prosecution (general form), **App C-4i**
- Formal matters, petitions concerning, **13:9**
- Inadvertently issued registrations, **13:19**
- Interference, declaration of, **13:15**
- Issuance, **13:19**
- ITU applications, revival of, **13:11**
- Letters of protest, **13:22**

## INDEX

### PETITIONS TO DIRECTOR

#### —Cont'd

- Petitionable matters, **13:2**
- Processing, **13:20**
- Prosecuting federal applications, final rejection, **4:21**
- Protest, letters of, **13:22**
- Response period, restarting, **13:18**
- Restart response period, **13:18**
- Return application to examiner, **13:19.1**
- Revival, **13:10, 13:11**
- Special, petitions to make, **13:12**
- Supervisory authority, petition to exercise, **13:13**
- Supporting documentation, **13:5**
- Time, **13:18**
- Timeliness, **13:6**
- TTAB, matters before, **13:14**
- Withdrawal, **13:17**

### PETITION TO CANCEL FEDERAL REGISTRATION

- Pleadings in inter partes proceedings, **16:4**

### PHOTOCOPIES

- Witnesses, **19:20**

### PHRASE

- Responses, **8:5.20**

### PILOT PROGRAM

- Consistency Initiative, **App R**

### POST CARD

- Form, PTO, return receipt post card (reverse side), **App C-3c**

### POST-ISSUANCE TREATMENT

- Supplemental registration applications, **12:9**

### POST-REGISTRATION MATTERS

- Collective mark applications, **9:7**

### POST-TRIAL

- Trial and Post-Trial Practice** (this index)

### POTENTIAL CONFUSION

- Responses, **6:16**

### POWER OF ATTORNEY

- Applications, actual use, **3:30**
- Prosecuting federal applications, **4:11**

### PRECLUSION

- Claim and issue, **16:29**

### PREEMPTION

- Enforcement of rights, **25:19**

### PRESERVING REGISTRATION

- Federal Registration** (this index)

### PRIMARILY GEOGRAPHICALLY DESCRIPTIVE REJECTION

- Responses, **7:7**

### PRIMARY SIGNIFICANCE TEST

- Descriptive rejections, **7:3**

### PRINCIPAL REGISTER

- Form, concurrent use of trademark/service mark application, principal register, corporation, **App C-1h**

### PRINTED PUBLICATIONS

- Witnesses, **19:10**

### PRIORITY CLAIM

- Applications, foreign rights, **3:58**

### PRIORITY OF USE

- Witnesses, **19:24**

### PRIOR MARK

- Confusion rejection responses, **6:10**

### PRIOR REGISTRATIONS

- Applications, actual use, **3:43**
- Formal rejection responses, **5:14**

### PRIOR RIGHTS

- Affirmative defenses, **16:31**

### PRIVILEGED OR CONFIDENTIAL INFORMATION

- Discovery, restrictions, **18:5**
- Opinions or decisions, attorney-client confidentiality, **1:23**
- Witnesses, **19:27**

### PRODUCTION OF DOCUMENTS

- Requests for, **18:8**

**PRODUCT LIABILITY**

Assignments and licenses, **26:8**

**PROFESSIONAL SEARCHING ORGANIZATIONS**

Evaluation of trademark, **2:10**

**PROOF OF SERVICE**

Form, inter partes proceedings (general form), **App C-8g**

**PROPER USE OF NAMES**

Forms, **App C-9**

**PROPOSED INTERNATIONAL REGISTRATION TREATY**

Generally, **23:20**

**PROSECUTING FEDERAL APPLICATIONS**

Generally, **4:1 et seq.**

Abandonment, **4:22**

Advising client of action, **4:5**

Affidavits, **4:10**

Allegations, **4:27**

Amendments, **4:8, 4:27**

Appeal, **4:20**

Approval for publication, **4:24**

Communications, **4:14**

Declarations, **4:10**

Divisional application, **4:37**

Drawing problems, reexamination of ITU application, **4:33**

Evaluating actions by PTO, **4:4**

Extension of time to file statement of use, **4:30**

Filing communications with PTO, **4:14**

Filing statement of use, **4:30**

Final rejection of application

generally, **4:16**

abandonment, **4:22**

appeal, **4:20**

interviews after, **4:19**

petitions to Director, **4:21**

responses after, **4:18**

transfer to Supplemental Register, **4:23**

Handling subsequent PTO actions, **4:15**

Interviews, **4:12, 4:19**

**PROSECUTING FEDERAL**

**APPLICATIONS—Cont'd**

Issuance of federal registration, **4:25**

ITU application, § 1(b)

generally, **4:26**

amendment under § 1(c) to allege use, **4:27**

extension of time to file statement of use, **4:30**

publication of § 1(b) application, **4:28**

statement of use under § 1(d), **4:29**

Office action response periods, **4:2.50**

Petitions to Director, **4:21**

Power of attorney, **4:11**

Presentation of arguments, **4:9**

Presenting affidavits and declarations, **4:10**

Presenting new power of attorney, **4:11**

Processing, **4:2, 4:3**

PTO, **4:4, 4:14, 4:15**

Publication, approval for, **4:24**

Publication of § 1(b) application, **4:28**

Reexamination of ITU application, **4:32-4:34**

Registration, issuance of, **4:25**

Rejection. Final rejection of application, above

Responses

generally, **4:6**

amending application, **4:8**

final rejection of application, **4:18**

interviews, **4:12**

presentation of arguments, **4:9**

presenting affidavits and declarations, **4:10**

presenting new power of attorney, **4:11**

supplemental responses, **4:13**

Section 1(b) ITU application

drawing problems, reexamination of ITU application, **4:33**

reexamination of ITU application, **4:32-4:34**

specimen problems, reexamination of ITU application, **4:34**

## INDEX

### PROSECUTING FEDERAL APPLICATIONS—Cont'd

- Section 1(b) ITU application—Cont'd
  - timing of use document, **4:31**
- Section 44 application, **4:36**
- Specimen problems, reexamination of ITU application, **4:34**
- Statement of use, **4:29, 4:30**
- Status information, **4:3**
- Subsequent actions, **4:15**
- Supplemental Register, **4:23**
- Supplemental responses, **4:13**
- Time, **4:30**
- Timing of use document, **4:31**
- Transfer to Supplemental Register, **4:23**
- Use, **4:30, 4:31**

### PROSECUTION

- Federal applications. **Prosecuting Federal Applications** (this index)
- Foreign Registration** (this index)
- Forms
  - generally, **App C-4**
  - amendment of trademark/service mark application, **App C-4a**
  - applicant's appeal brief (general form), trademark, **App C-4e**
  - declaration (general form), **App C-4c**
  - examining attorneys' appeal brief (general form), **App C-4f**
  - general format of response to PTO, trademark, **App C-4b**
  - notice of appeal (ex parte), **App C-4d**
  - notice of appeal to court, **App C-4h**
  - petition to Commissioner (general form), **App C-4i**
  - request for oral hearing, trademark, **App C-4g**
  - request to divide application, **App C-4j**
- Supplemental registration applications, **12:8**

### PROTECTION OF RIGHTS

- Generally, **1:8**

### PROTECTIVE ORDER

- Motions, **17:7**

### PROTEST

- Enforcement of rights, **25:6**
- Petitions to director, **13:22**

### PROVISIONAL REFUSALS

- Avoidance, extension of international registration protection to U.S. under Madrid Protocol, **App S**

### PTO

- Appeals, **14:19**
- Applications
  - generally, **3:44**
  - deposit accounts, **3:67**
  - process, flowchart of application process for international applications filed with PTO, **App I**
- Brexit, **App Z**
- Classification schedules, **App A**
- Concurrent use applications, **11:4**
- Confusion rejection responses, **6:21**
- Consistency Initiative, **App R**
- Contacts, **App A**
- Descriptive rejection responses, **7:10**
- Electronic forms for submitting Madrid-protocol related documents, **App P**
- Enforcement of rights, **25:6**
- Exam Guide No. 1-05, **App K**
- Exam Guide No. 02-17, **App O**
- Exam Guide No. 3-06, **App N**
- Extension of registration protection
  - flowchart of application process for filing international applications and extensions of protection with PTO, **App I**
- Madrid Protocol** (this index)
- Fees, **App A**
- Foreign registration prosecution, **23:32**
- Forms
  - certificate of facsimile transmission, **App C-3b**

**PTO—Cont'd**

Forms—Cont'd

certificate of mailing, 37 C.F.R.

§ 1.8(a), **App C-3a**

designation of domestic representative, **App C-3f**

letters to client

report of PTO action to client (final), **App C-6b**

report of PTO action to client (non-final), **App C-6a**

prosecution, general format of response to PTO, trademark, **App C-4b**

return receipt post card (reverse side), **App C-3c**

Information, **App A**

Inter partes proceedings, obtaining records, **15:12**

Mistake, **24:3**

Nice agreement eleventh edition, version 2024 (NCL 12-2024), **App A**

Prosecuting federal applications evaluating actions by PTO, **4:4**  
filing communications with PTO, **4:14**

handling subsequent PTO actions, **4:15**

Schedules, classification, **App A**

**PTO FORM 4-8**

Collective membership application, **App C-1c**

**PTO FORM 4-9**

Certification mark application, **App C-1d**

**PTO FORM 1478**

Trademark application, **App C-1a**

**PTO FORM 1478A**

Collective mark application, **App C-1b**

**PTO FORM 1553**

Statement of use, **App C-5a**

**PTO FORM 1581**

Extension of time to file statement of use, **App C-5b**

**PTO FORM 1583**

Combined section 8 and 15 affidavits,

**App C-5e**

Section 8 affidavit, **App C-5c**

Section 15 affidavit, **App C-5d**

**PTO FORM 1963**

Trademark renewal and section 8 affidavit, **App C-5f**

**PUBLICATION**

Federal registration, **24:6**

Prosecuting federal applications, **4:24, 4:28**

Witnesses, **19:10**

**PURCHASING ENVIRONMENT**

Confusion rejection responses, **6:9**

**QUALIFICATION**

Motions to disqualify attorney, **17:19**

**REBUTTAL TESTIMONY**

Generally, **19:28**

**RECAPTURE**

Loss of rights, **27:11**

**RECITED GOODS OR SERVICES**

Federal registration, section 8 affidavits, **24:19**

**RECONSIDERATION**

Generally, **20:5**

Appeals, **14:12, 14:19**

Confusion rejection responses, **6:21**

Descriptive rejection responses, **7:10**

Motions, **17:29**

**RECORDS AND RECORDING**

Appeals, **14:6**

Assignments and licenses, **26:7**

Federal application prosecution, **4:14, 4:30**

Federal applications, **3:64-3:66**

Forms

fastener insignia, recordal of, **App C-10**

PTO Form 1581, extension of time to file statement of use, **App C-5b**

Inter partes proceedings answer, **16:42**



## INDEX

### RECORDS AND RECORDING

#### —Cont'd

Inter partes proceedings—Cont'd  
notice or petition, **16:21**

PTO, obtaining records from,  
**15:12**

Prosecuting federal applications,  
**4:14, 4:30**

U.S. Customs Service, recording  
marks with, **25:20**

Witnesses, **19:7, 19:14**

### “RED CROSS” OR “GENEVA CROSS”

Responses, **8:5.20**

### REEXAMINATION

ITU application, § 1(b), **4:32-4:34**

### REFERENCES

Litigation references, **25:8**

Useful references, **23:23**

### REFUSALS

Extension of international registration  
protection to U.S. under Madrid  
Protocol, avoidance, **App S**

### REGISTRATION CERTIFICATE

Form, letters to client, **App C-6c**

### REJECTIONS

**Prosecuting Federal Applications**  
(this index)

**Responses** (this index)

Supplemental registration applica-  
tions, **12:7**

### RELATED COMPANY

Certification marks, use by, **10:6**

### RELEVANCE

Discovery restrictions, **18:4**

Inter partes proceedings, **16:45**

### RELIANCE

Form, notice of reliance, **App C-8n**

### RENEWAL

Applications, actual use, **3:41**

**Federal Registration** (this index)

Form, PTO Form 1963, trademark  
renewal and section 8 affidavit,  
**App C-5f**

### REP

See common abbreviations in prelim-  
inary materials at front of publi-  
cation

### REPLY

Appeals, **14:9**

Motions, **17:27**

### REPORTS AND REPORTING

#### Forms

instructions to court reporter, **App  
C-8l**

letters to client

report of PTO action (final),

**App C-6b**

report of PTO action (non-final),

**App C-6a**

Search report, **2:12, App B**

Witnesses, summary reports, **19:13**

### REPRESENTATIVE, DOMESTIC

Applications, actual use, **3:32**

Federal registration, section 8

affidavits, **24:20**

Form, PTO, designation of domestic  
representative, **App C-3f**

### REPUBLICATION

Federal registration, **24:6**

### REQUESTS

Appeals, **14:12**

Consistency review, Consistency Ini-  
tiative, **App R**

Discovery, **18:8, 18:9**

Divide application, requests to, **4:37**

Extension of protection, **23:8 et seq.**

Extension of time to oppose, **15:10;**  
**App C-8b**

Federal registration, **24:6**

#### Forms

divide application, prosecution,  
**App C-4j**

extension of time to oppose,  
trademark, **App C-8b**

oral hearing, trademark, prosecu-  
tion, **App C-4g**

stipulated request to reset  
discovery and testimony  
periods, **App C-8k**

**REQUESTS—Cont'd**

- Grounds for opposition and cancellation, **16:19**
- Motions, **17:17, 17:29**
- Reconsideration, **17:29, 20:5**
- Search, **2:11**
- Suspend proceedings, **17:17**

**RESET DISCOVERY**

- Form, stipulated request to reset discovery and testimony periods, **App C-8k**

**RESPONSES**

- Generally, **8:1 et seq.**
- American National Red Cross, **8:5.20**
- Answer, **16:44**
- Appeals, **14:8**
- Coat of arms of Swiss Confederation, **8:5.40**
- Confusion Rejections** (this index)
- Deceptive and scandalous marks, **8:5**
- Descriptive Rejections** (this index)
- Discovery, **17:9, 18:12, 18:13**
- Distinctive marks, Olympics-related matter, **8:7.50**
- Flag of Swiss Confederation, **8:5.40**
- Formal Rejections** (this index)
- Forms
  - general format of response to PTO, trademark, **App C-4b**
  - general form of response to motion, **App C-8i**
- Functional features not registrable, **8:3**
- “Geneva Cross” phrase, **8:5.20**
- Government insignia, **8:6**
- Greek red cross, **8:5.20**
- Icon or image of universal symbol, **8:5.60**
- Insignia, government, **8:6**
- Motions, **17:9, 17:26, App C-8i**
- Names of individuals, **8:7**
- Not mark, **8:2**
- Olympics or U.S. Olympic Committee-related marks, **8:7.50**
- Ownership, **8:4**
- Petitions to director, **13:18**
- Phrases, **8:5.20**

**RESPONSES—Cont'd****Prosecuting Federal Applications**  
(this index)

- “Red Cross” or “Geneva Cross” phrases, **8:5.20**
- Scandalous marks, **8:5**
- Supplemental registration applications, **12:7**
- Suspension of further consideration, **8:8**
- Universal symbols, **8:5.60**
- Unlawful use of mark, **8:9**
- Use, unlawful, **8:9**
- Witnesses, **19:25**

**RESTRICTIONS****Limitations and Restrictions** (this index)**REVIEW**

- Appeal and Review** (this index)
- Consistency, Request for Consistency Review, **App R**

**REVIVAL**

- Petitions to director, **13:10, 13:11**

**RICO CLAIMS**

- Enforcement of rights, **25:13**

**RIGHTS**

- Generally, **1:7**
- Loss of Rights** (this index)

**SANCTIONS**

- Discovery, **18:14**
- Inter partes proceedings, **15:13**

**SCANDALOUS MATTERS**

- Alleging § 2(a) grounds, **16:8**
- Applications, registration bars, **3:7**
- Responses, **8:5**

**SCHEDULES**

- PTO, classification schedules, **App A**

**SEARCHES**

- Madrid Express database, **2:9**
- Professional searching organizations, **2:10**
- Requesting, **2:11**

## INDEX

### SEARCH REPORT

Evaluation, **2:12, App B**

### SECTION 66 APPLICATION

Generally, **23:12**

### SELECTION OF TRADEMARK

Generally, **2:1 et seq.**

Applications, actual use, **3:19**

Desirable functional attributes of mark, **2:4**

Evaluation of candidate marks, **2:6**

Generating candidate marks, **2:5**

Recommended procedure, generally, **2:2 et seq.**

### SERVICE MARK

Forms

amendment of trademark/service mark application, **App C-4a**

concurrent use of trademark/service mark application, principal register, corporation, **App C-1h**

letters to client, **App C-6d**

### SERVICE OF PROCESS

Forms

proof of service (general form), **App C-8g**

### SETTLEMENT

Inter partes proceedings, **15:11**

### SHOW CAUSE ORDER

Motions, **17:21**

### SIMILARITY

Confusingly similar marks (§ 2(d)), **3:10**

**Confusion Rejections** (this index)

Infringement, evaluating similar works for, **25:5**

### SPECIAL DEFENSES

Abandonment, **16:39**

Fraud, **16:40**

Likelihood of confusion, **16:38**

### SPECIAL OPINIONS

Audit inquiries, **1:24**

Due diligence inquiries, **1:25**

### SPECIMENS

Actual use, **3:18, 3:26**

Certification marks, **10:10**

Federal application prosecution, **4:34**

Federal registration, **24:16**

Foreign rights, **3:57**

Formal rejection responses, **5:12, 5:26**

### STALE VERIFICATION

Formal rejection responses, **5:20**

### STANDARD CHARACTER MARKS

Countries that have standard character marks or the equivalent, **App T**

### STANDING

Affirmative defenses, **16:34**

Grounds for opposition and cancellation, **16:7**

### STATE LABELING

Initiating use of mark, **2:25**

### STATEMENTS

Certification statement, **10:9**

Federal application prosecution, **4:29, 4:30**

Forms

use statements

generally, **App C-5**

PTO Form 1553, statement of use, **App C-5a**

PTO Form 1581, extension of time to file statement of use, **App C-5b**

written statement in support of discovery motion, **App C-8j**

Non-use statement, **10:11**

### STATE REGISTRATION

Generally, **22:1 et seq.**

Application, **22:4, 22:5**

Cancellation of registration, **22:8**

Form, letters to client, **App C-6d**

Handling registration, **22:6**

Maintaining registration, **22:7**

Process, generally, **22:2**

Statutes, **22:3**

**STAY**

Motions, **17:22**

**STIPULATED REQUEST**

Form, reset discovery and testimony periods, **App C-8k**

**STIPULATIONS**

Witnesses, **19:6**

**STRENGTH OF MARKS**

Confusion rejection responses, **6:11**

**STRIKE**

Motions, **17:4**

**SUBSEQUENT ACTIONS**

Prosecuting federal applications, **4:15**

**SUBSEQUENT DESIGNATION**

Generally, **23:6 et seq.**

**SUBSEQUENT PROCESSING**

Concurrent use applications, **11:15**

**SUBSEQUENT REVIEW**

Federal registration, **24:32**

**SUBSTITUTE**

Motions, **17:18**

**SUMMARY JUDGMENT**

Motions, **17:10**

**SUMMARY REPORTS**

Witnesses, **19:13**

**SUPPLEMENTAL REGISTER**

Forms

trademark application,  
supplemental register,  
corporation, **App C-1i**

Lanham Act, **3:3, 3:4**

Prosecuting federal applications, **4:23**

**Supplemental Registration**

**Applications** (this index)

**SUPPLEMENTAL REGISTRATION APPLICATIONS**

Generally, **12:1 et seq.**

Actual use, **3:39**

Amending federal application to seek, **12:6**

Evaluating desirability, **12:4**

Federal application, **12:6**

**SUPPLEMENTAL REGISTRATION APPLICATIONS—Cont'd**

Foreign protection, **12:8**

Issuance and post-issuance treatment, **12:9**

Post-issuance treatment, **12:9**

Preparation of application for registration of mark on Supplemental Register, **12:5**

Prosecution of applications required to obtain foreign protection of mark, **12:8**

Protection, **12:3**

Rejections, **12:7**

Responses to rejections, **12:7**

Supplemental Register, purpose of, **12:2**

**SUPPLEMENTAL RESPONSES**

Discovery, **18:12**

Prosecuting federal applications, **4:13**

**SUPPORTING DOCUMENTATION**

Petitions to director, **13:5**

**SURNAME**

Descriptive rejection responses, **7:8**

Formal rejection responses, **5:17**

**SURVEYS**

Witnesses, **19:15**

**SUSPENSION**

Motions, **17:17**

Responses, **8:8**

**SYMBOLS**

Responses, **8:5.60**

**TAC**

See common abbreviations in preliminary materials at front of publication

**TARR**

See common abbreviations in preliminary materials at front of publication

**TEAS**

See also common abbreviations in preliminary materials at front of publication

## INDEX

### TEAS—Cont'd

**Trademark Electronic Application System (TEAS)** (this index)

### THIRD PERSONS

Form, notice letter re infringement of client's rights by another, **App C-8a**

### 37 C.F.R. § 1.8(a)

Forms, **App C**

### 37 C.F.R. § 1.10

Forms, **App C**

### TICRS

See common abbreviations in preliminary materials at front of publication

### TIME

Actual use, **3:24**

**Extension of Time** (this index)

Foreign rights, **3:56**

Formal rejection responses, **5:11**

Forms

request for extension of time to oppose, trademark, **App C-8b**  
statements of use, PTO Form 1581, extension of time to file statement of use, **App C-5b**  
stipulated request to reset discovery and testimony periods, **App C-8k**

Inter partes proceedings, requests for extension of time to oppose, **15:10**

Motions, **17:11, 17:12**

Petitions to director, **13:18**

Prosecuting federal applications, **4:30**

### TIMELINESS

Federal registration, section 8 affidavits, **24:11**

Petitions to director, **13:6**

### TIMING

Discovery, **18:11**

Prosecuting federal applications, **4:31**

### TMSL

See common abbreviations in preliminary materials at front of publication

### TRADE CHANNELS

Confusion rejection responses, **6:8**

### TRADEMARK ATTORNEY

Appeals, **14:8**

Formal rejection responses, **5:21**

### TRADEMARK ELECTRONIC APPLICATIONS SYSTEM (TEAS)

Electronic filing, **3:65**

International treaties, **23:8**

### TRADEMARK LAW TREATY

Generally, **23:21**

### TRADEMARK REGISTRATION TREATY

Generally, **23:19**

### TRADEMARKS

Access to documents

paper copies and access, **App J**

### TRAM

See common abbreviations in preliminary materials at front of publication

### TRANSFERS

Prosecuting federal applications, **4:23**

### TRANSLATION

Formal rejection responses, **5:15**

### TRIAL AND POST-TRIAL PRACTICE

Generally, **20:1 et seq.**

Appeal from decision of Board, **20:6**

Board, appeal from decision of, **20:6**

Briefs, closing, **20:2**

Closing briefs, **20:2**

Concurrent use applications, **11:14**

Decisions, **20:4, 20:6**

Motions, **17:14**

Oral argument, **20:3**

Post-post-trial, **20:7**

Reconsideration, **20:5**

Request for reconsideration, **20:5**

Strategy, **16:46**

TTAB, **20:4**

**TTAB**

Answer, **16:43**  
 Appeals, **14:6, 14:11**  
 Decision, **20:4**  
 Notice, **16:22**  
 Operations, **16:22.50**  
 Organization, **15:7**  
 Petitions to director, **13:14**  
 Practice tips, advanced, **App U**

**TTABIS**

See common abbreviations in preliminary materials at front of publication

**TTABVUE**

See common abbreviations in preliminary materials at front of publication

**UNCLEAN HANDS**

Affirmative defenses, **16:30**  
 Involuntary abandonment of rights, **27:6**

**UNFAIR COMPETITION**

**Enforcement of Rights** (this index)

**UNITED STATES PATENT  
TRADEMARK OFFICE  
(USPTO)**

**PTO** (this index)

**UNIVERSAL SYMBOLS**

Responses, **8:5.60**

**UNLAWFUL USE**

Responses, **8:9**

**UPWS**

See common abbreviations in preliminary materials at front of publication

**U.S. CUSTOMS SERVICE**

Enforcement of rights, **25:20**

**U.S. DEPARTMENT OF  
AGRICULTURE**

Initiating use of mark, **2:22**

**U.S. DISTRICT COURT**

Appeals, **14:17**

**U.S. TREASURY DEPARTMENT**

Initiating use of mark, **2:23**

**USE AND USAGE**

**Applications** (this index)

Certification marks

commerce, use in, **10:7**

continued use, **10:13**

related company, use by, **10:6**

statement of non-use, **10:11**

**Concurrent Use Applications** (this index)

Confusion rejection responses, **6:13**

Fair use of marks, **25:11**

Federal registration, **24:13-24:15**

Foreign registration, **23:23, 23:24**

Formal rejection responses, **5:11**

Forms

concurrent use of trademark/  
 service mark application,  
 principal register, corporation,  
**App C-1h**

concurrent users, sample agreement among, **App C-7a**

proper use of names, **App C-9**

**Initiating Use of Mark** (this index)

Prosecuting federal applications,  
**4:30, 4:31**

Responses, **8:9**

Witnesses, **19:22, 19:24**

**USPTO**

**PTO** (this index)

**VERIFICATION**

Formal rejection responses, improper  
 or stale verification, **5:20**

**VOLUNTARY AND  
INVOLUNTARY ACTS AND  
MATTERS**

**Loss of Rights** (this index)

**WATCH SERVICES**

Inter partes proceedings, **15:6**

**WIPO**

See common abbreviations in preliminary materials at front of publication

## INDEX

### WITHDRAWAL

- Motions, **17:9**
- Petitions to director, **13:17**

### WITNESSES

- Generally, **19:1 et seq.**
- Affidavits, **19:5**
- Application files, **19:7**
- Applications, **19:16**
- Business records, **19:14**
- Chief, testimony in, **19:2**
- Confidential matters, **19:27**
- Confusion, establishing likelihood of, **19:23**
- Data management, **19:29**
- Deposition procedures, **19:26**
- Depositions, **19:12**
- Discovery, **19:12, 19:25**
- Evidentiary problems, generally, **19:4-19:27**
- Exhibits to pleadings, **19:9**
- Ex parte matters, **19:21**
- Expert opinions, **19:18**
- Foreign marks, **19:16**
- Forms
  - notice of taking testimonial deposition (party to proceeding), **App C-8m**
  - stipulated request to reset discovery and testimony periods, **App C-8k**
- Hearsay, **19:19**
- Judicial notice, **19:17**
- Likelihood of confusion, establishing, **19:23**
- Motions, **17:12, 17:23**

### WITNESSES—Cont'd

- Notice, judicial, **19:17**
- Objections, **19:3**
- Other proceedings, testimony from, **19:11**
- Photocopies, **19:20**
- Printed publications, **19:10**
- Priority of use, **19:24**
- Publications, printed, **19:10**
- Rebuttal testimony, **19:28**
- Records and recording
  - generally, **19:14**
  - application files, **19:7**
- Registrations, **19:8**
- Reports and reporting, **19:13**
- Responses, **19:25**
- Stipulations, **19:6**
- Summary reports, **19:13**
- Surveys, **19:15**
- Testimony in chief, **19:2**
- Usage evidence, **19:22**
- Use, priority of, **19:24**

### WORDS

- Applications, words registrable on supplemental register, **3:4**
- Formal rejection responses, translation of foreign words, **5:15**
- Responses, “Red Cross” or “Geneva Cross” phrases, **8:5.20**

### WRITTEN OPINIONS

- Preparation of, **1:18**

### WRITTEN STATEMENTS

- Form, inter partes proceedings, support of discovery motion, **App C-8j**