

time remains in the grace period, the owner may file a complete new affidavit.

**§ 2.164 Correcting deficiencies in affidavit or declaration.**

(a) If the affidavit or declaration is filed within the time periods set forth in section 8 of the Act, deficiencies may be corrected after notification from the Office, as follows:

(1) *Correcting deficiencies in affidavits or declarations timely filed within the periods set forth in sections 8(a)(1) and 8(a)(2) of the Act.* If the affidavit or declaration is timely filed within the relevant filing period set forth in section 8(a)(1) or section 8(a)(2) of the Act, deficiencies may be corrected before the end of this filing period without paying a deficiency surcharge. Deficiencies may be corrected after the end of this filing period with payment of the deficiency surcharge required by section 8(c) of the Act and § 2.6.

(2) *Correcting deficiencies in affidavits or declarations filed during the grace period.* If the affidavit or declaration is filed during the six-month grace period provided by section 8(a)(3) of the Act, deficiencies may be corrected before the expiration of the grace period without paying a deficiency surcharge. Deficiencies may be corrected after the expiration of the grace period with payment of the deficiency surcharge required by section 8(c) of the Act and § 2.6.

(b) If the affidavit or declaration is not filed within the time periods set forth in section 8 of the Act, the registration will be cancelled.

[75 FR 35976, June 24, 2010, as amended at 76 FR 69133, Nov. 8, 2011]

**§ 2.165 Petition to Director to review refusal.**

(a) A response to the examiner's initial refusal to accept an affidavit or declaration is required before filing a petition to the Director, unless the examiner directs otherwise. See § 2.163(b) for the deadline for responding to an examiner's Office action.

(b) If the examiner maintains the refusal of the affidavit or declaration, the owner may file a petition to the Director to review the action. The petition must be filed within six months of the date of issuance of the action main-

taining the refusal, or the Office will cancel the registration and issue a notice of the cancellation.

(c) A decision by the Director is necessary before filing an appeal or commencing a civil action in any court.

[64 FR 48925, Sept. 8, 1999, as amended at 73 FR 67773, Nov. 17, 2008]

EFFECTIVE DATE NOTE: At 86 FR 64332, Nov. 17, 2021, § 2.165 was revised, effective Dec. 1, 2022. At 87 FR 62032, Oct. 13, 2022, the effective date was delayed to Oct. 7, 2023. For the convenience of the user, the revised text is set forth as follows:

**§ 2.165 Petition to Director to review refusal.**

(a) A response to the examiner's initial refusal to accept an affidavit or declaration is required before filing a petition to the Director, unless the examiner directs otherwise. See § 2.163(b) and (c) for the deadline for responding to an examiner's Office action.

(b) If the examiner maintains the refusal to accept the affidavit or declaration, the owner may file a petition to the Director to review the action within the time periods specified in § 2.163(b) and (c).

(c) If no petition is filed within the time periods set forth in paragraphs (a) and (b) of this section, the registration will be cancelled and a notice of cancellation will issue.

(d) A decision by the Director is necessary before filing an appeal or commencing a civil action in any court.

**§ 2.166 Affidavit of continued use or excusable nonuse combined with renewal application.**

An affidavit or declaration under section 8 of the Act and a renewal application under section 9 of the Act may be combined into a single document, provided that the document meets the requirements of both sections 8 and 9 of the Act.

[64 FR 48925, Sept. 8, 1999]

AFFIDAVIT OR DECLARATION UNDER  
SECTION 15

**§ 2.167 Affidavit or declaration under section 15.**

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

(a) Be verified;

(b) Identify the certificate of registration by the certificate number and date of registration;

(c) For a trademark, service mark, collective trademark, collective service mark, and certification mark, recite the goods or services stated in the registration on or in connection with which the mark has been in continuous use in commerce for a period of five years after the date of registration or date of publication under section 12(c) of the Act, and is still in use in commerce; for a collective membership mark, describe the nature of the owner's collective membership organization specified in the registration in connection with which the mark has been in continuous use in commerce for a period of five years after the date of registration or date of publication under section 12(c) of the Act, and is still in use in commerce;

(d) Specify that there has been no final decision adverse to the owner's claim of ownership of such mark for such goods, services, or collective membership organization, or to the owner's right to register the same or to keep the same on the register;

(e) Specify that there is no proceeding involving said rights pending in the Office or in a court and not finally disposed of;

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

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

(h) If the affidavit or declaration fails to satisfy any of the requirements in paragraphs (a) through (g) of this section, the owner will be notified in an Office action that the affidavit or

declaration cannot be acknowledged. If a response is not received within the time period provided or does not satisfy the requirements of the Office action, the affidavit or declaration will be abandoned.

(i) If the affidavit or declaration satisfies paragraphs (a) through (g) of this section, the Office will issue a notice of acknowledgement.

(j) An affidavit or declaration may be abandoned by the owner upon petition to the Director under § 2.146 either before or after the notice of acknowledgement has issued.

(k) If an affidavit or declaration is abandoned, the owner may file a new affidavit or declaration with a new filing fee.

(Sec. 15, 60 Stat. 433; 15 U.S.C. 1065; 35 U.S.C. 6; 15 U.S.C. 1113, 1123)

[30 FR 13193, Oct. 16, 1965, as amended at 47 FR 41282, Sept. 17, 1982; 64 FR 48925, Sept. 8, 1999; 73 FR 67773, Nov. 17, 2008; 74 FR 54910, Oct. 26, 2009; 80 FR 33188, June 11, 2015]

**§ 2.168 Affidavit or declaration under section 15 combined with affidavit or declaration under sections 8 or 71, or with renewal application.**

(a) The affidavit or declaration filed under section 15 of the Act may also be used as the affidavit or declaration required by section 8, if the affidavit or declaration meets the requirements of both sections 8 and 15. The affidavit or declaration filed under section 15 of the Act may also be used as the affidavit or declaration required by section 71, if the affidavit or declaration meets the requirements of both sections 71 and 15.

(b) The affidavit or declaration filed under section 15 of the Act may be combined with an application for renewal of a registration under section 9 of the Act, if the requirements of both sections 9 and 15 are met.

[64 FR 48925, Sept. 8, 1999, as amended at 75 FR 35976, June 24, 2010]

CORRECTION, DISCLAIMER, SURRENDER,  
ETC.

**§ 2.171 New certificate on change of ownership.**

(a) *Full change of ownership.* If the ownership of a registered mark changes, the new owner may request that a new certificate of registration