

§ 2.35

services in the same application. A basis under section 66(a) of the Act may not be combined with another basis.

[64 FR 48919, Sept. 8, 1999, as amended at 67 FR 79522, Dec. 30, 2002; 68 FR 55763, Sept. 26, 2003; 73 FR 67768, Nov. 17, 2008; 77 FR 30207, May 22, 2012; 80 FR 33179, June 11, 2015]

§ 2.35 Adding, deleting, or substituting bases.

(a) In an application under section 66(a) of the Act, an applicant may not add, substitute or delete a basis, unless the applicant meets the requirements for transformation under section 70(c) of the Act and § 7.31 of this chapter.

(b) In an application under section 1 or section 44 of the Act:

(1) Before publication for opposition, an applicant may add or substitute a basis, if the applicant meets all requirements for the new basis, as stated in § 2.34, § 2.44, or § 2.45. The applicant may delete a basis at any time.

(2) After publication, an applicant may add or substitute a basis in an application that is not the subject of an *inter partes* proceeding before the Trademark Trial and Appeal Board, but only with the express permission of the Director, after consideration on petition. Republication will be required. The amendment of an application that is the subject of an *inter partes* proceeding before the Board is governed by § 2.133(a).

(3) When an applicant substitutes one basis for another, the Office will presume that there was a continuing valid basis, unless there is contradictory evidence in the record, and the application will retain the original filing date, including a priority filing date under section 44(d), if appropriate.

(4) If an applicant properly claims a section 44(d) basis in addition to another basis, the applicant will retain the priority filing date under section 44(d) no matter which basis the applicant perfects.

(5) The applicant may add or substitute a section 44(d) basis only within the six-month priority period following the filing date of the foreign application.

(6) When the applicant adds or substitutes a basis, the applicant must list each basis and specify the goods, serv-

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ices, or collective membership organization to which that basis applies.

(7) When the applicant deletes a basis, the applicant must also delete any goods, services, or collective membership organization covered solely by the deleted basis.

(8) Once an applicant claims a section 1(b) basis as to any or all of the goods or services, or a collective membership organization, the applicant may not amend the application to seek registration under section 1(a) of the Act for identical goods or services or the same collective membership organization, unless the applicant files an allegation of use under section 1(c) or section 1(d) of the Act.

[68 FR 55763, Sept. 26, 2003, as amended at 80 FR 33180, June 11, 2015]

§ 2.36 Identification of prior registrations.

Prior registrations of the same or similar marks owned by the applicant should be identified in the application if the owner(s) last listed in Office records of the prior registrations differs from the owner(s) listed in the application.

[80 FR 2310, Jan. 16, 2015]

§ 2.37 Description of mark.

A description of the mark must be included if the mark is not in standard characters. In an application where the mark is in standard characters, a description may be included and must be included if required by the trademark examining attorney.

[73 FR 13784, Mar. 14, 2008]

§ 2.38 Use by predecessor or by related companies.

(a) If the first use of the mark was by a predecessor in title or by a related company (sections 5 and 45 of the Act), and the use inures to the benefit of the applicant, the dates of first use (§§ 2.34(a)(1) (ii) and (iii)) may be asserted with a statement that first use was by the predecessor in title or by the related company, as appropriate.

(b) The Office may require such details concerning the nature of the relationship and such proofs as may be necessary and appropriate for the purpose