

**To:** [ew@cfaba.org](mailto:ew@cfaba.org)  
**Subject:** Proceeding No. PDIR-2023-000024 in U.S. Trademark Registration No. 2500525  
**Sent:** December 05, 2023 12:37:47 PM EST  
**Sent As:** [tmng.notices@uspto.gov](mailto:tmng.notices@uspto.gov)

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**Attachments**

**United States Patent and Trademark Office (USPTO)**

**Petition No.** PDIR-2023-000024

**U.S. Application Serial No.** 78030621

**U.S. Registration No.** 2500525

**Mark:** CITIZENS FOR A BETTER AMERICA

**Owner Name:** Colaco, Robert

**Owner Correspondence Email Address:** [ew@cfaba.org](mailto:ew@cfaba.org)

**Petitioner Name:** Robert Colaco

**Petitioner Correspondence Email Address:** [ew@cfaba.org](mailto:ew@cfaba.org)

**PETITION TO DIRECTOR GRANTED**

**Issue date:** December 5, 2023

Robert Colaco (petitioner) has petitioned the Director of the USPTO to accept a petition submitted by facsimile transmission, reinstate the above-identified registration, accept a late response to an outstanding Post Registration Division Office action, and waive the requirement for providing his domicile address. The Director has the authority to review this request under 37 C.F.R. §§2.146(a)(5), 2.148, and has delegated this matter to the Commissioner for Trademarks and the staff of the Office of the Deputy Commissioner for Trademark Examination Policy. 35 U.S.C. §3(a)-(b); 37 C.F.R. §2.146(h). The petition is granted.

**FACTS**

On April 22, 2022, petitioner filed a combined Trademark Act Section 8 declaration of use or excusable nonuse and Trademark Act Section 9 renewal application (combined filing). 15 U.S.C. §§1058, 1059. In an Office action dated October 28, 2022, the post registration specialist refused the combined filing because it did not contain the domicile address for the petitioner as required under Trademark Rule

2.189. Further, the post registration specialist notified petitioner he must file a response within six months of the issuance date of the Office action or before the end of the relevant filing period in Section 8(a), whichever was later, to avoid cancellation of the registration. The USPTO did not receive a response on or before October 22, 2022, and the grace period under Section 8(a)(3) had expired. The registration was cancelled on May 9, 2023.

Petitioner filed this petition by facsimile on July 10, 2023. Petitioner declares he made several attempts to contact the post registration specialist and others at the USPTO to find out how to respond to the Office action because he did not want to give his domicile address for fear of personal safety. (Pet. 28-31). Petitioner states that he has a disability which due to voice recognition software, makes it hard to send emails. (Pet. 28). Petitioner further declares that he tried to respond but could not use the *Trademark Electronic Application System* (TEAS) since he was not ID verified using ID.me. (Pet. 23-24). Petitioner does not want to use ID.me to verify his identity due to his safety concerns. (Pet. 28-31). With the petition, petitioner requests a waiver of the domicile address requirement due to personal safety concerns. *Id.*

## **DISCUSSION**

### *Standard of Review*

The Director may waive a Trademark Rule “in an extraordinary situation, when justice requires and no other party is injured.” 37 C.F.R. §§2.146(a)(5), 2.148, 2.163(b); *see Trademark Manual of Examining Procedure* (TMEP) §1708. To waive a rule, the Director must determine that all three conditions are satisfied. *See* TMEP §1708.

### *Waiver of Requirement to file electronically*

Trademark Rule 2.23(a) requires that, unless explicitly exempted, all trademark correspondence with the USPTO must be submitted through TEAS. 37 C.F.R. §2.23(a). However, Section 504 of the Americans with Disabilities Act (ADA) provides accommodation for citizens with disabilities. In light of the facts included in the petition, the USPTO waives the requirement for petitioner to submit filings through TEAS and accepts the petition filed via facsimile as properly and timely filed.

### *Waiver of Trademark Rule 2.163(b) to permit late response to Post Registration Office action*

When a registration owner files a combined filing but the Post Registration Division deems it to be unacceptable, the USPTO will issue a notice stating the reasons for refusal. *See* 15 U.S.C. §1058(e); 37 C.F.R. §2.163; TMEP §1604.15. The owner must file a response to the refusal within six months of the issue date of the Office action, or before the end of the filing period set forth in Section 8(a), whichever is later. 37 C.F.R. §2.163(b); TMEP §1604.16. If no response is filed within this time period, the registration will be cancelled, unless time remains in the grace period under Section 8(a)(3). 37 C.F.R. §2.163(c); TMEP §1604.16.

Petitioner did not file a response to the October 28, 2022 Office action within the six-month response period and the grace period under Section 8(a)(3) had expired. Accordingly, the USPTO properly cancelled the registration under Section 8. Petitioner, however, declares he was unable to respond to the Office action timely because he required assistance seeking an exception or waiver of Trademark Rule 2.189 requiring his domicile address due to personal safety concerns. (Pet 28-31). Petitioner further

states the delay in obtaining assistance, difficulty using TEAS because he is disabled, and the fact that his identify was not yet verified through ID.me resulted in his failure to timely respond. (Pet 23-24, 28-31).

Based on the unique facts of this case, the Director determines that petitioner has established an extraordinary situation to waive Rule 2.163(b). Specifically, petitioner's verified evidence that several documented attempts to obtain clarification from the USPTO regarding an exception or waiver to the domicile requirement, along with petitioner's difficulty using TEAS due to a disability and because he was not ID verified, in combination, establish an extraordinary situation. A review of the Trademark Register confirms no other party will be injured and justice requires a waiver of this rule. *See* TMEP §§1604.16, 1708.

Accordingly, the Director waives Rule 2.163(b) and permits petitioner to submit a late response to the October 28, 2022 Office action. *See* 37 C.F.R. §§2.146(a)(5), 2.148.

#### *Waiver of the Domicile Requirement*

Trademark Act Section 1(a)(2) requires that every trademark application include specification of the applicant's domicile and citizenship. 15 U.S.C. §1051(a)(2). Trademark Rule 2.189 further requires that an applicant or registrant must provide and keep current their domicile address, defined in Rule 2.2(o) as the permanent legal place of residence of a natural person or the principal place of business of a juristic entity. 37 C.F.R. §§2.2(o), 2.189.

In this case, the Director finds that a waiver of the requirement to provide petitioner's domicile address in Rule 2.189 is appropriate. The evidence of personal safety concerns submitted with the petition establish an extraordinary situation, in which the Director can conclude that no other party will be injured and justice requires a waiver of this rule. *See* TMEP §1708. Under the circumstances presented, petitioner has complied with the statutory requirement to specify his domicile by providing the state and country where he resides, and the Director will waive the requirement to provide petitioner's street address.

Accordingly, the Director will permit petitioner to continue using a post office box address as the mailing address of record and will accept the state and country information provided in the combined filing petitioner's domicile address. *See* 37 C.F.R. §§2.146(a)(5), 2.148.

#### **DECISION**

The petition is granted. The USPTO will reinstate on petition the above-identified registration. The registration will then be forwarded to the Post Registration Division to review the response submitted with the petition and take action consistent with this decision.

United States Patent and Trademark Office (USPTO)

## USPTO OFFICIAL NOTICE

Petition to Director No. PDIR-2023-000024

Petition to Director decision issued on **December 5, 2023** for  
U.S. Trademark Application Serial No. **78030621**  
**CITIZENS FOR A BETTER AMERICA**

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### DISCUSSION

#### *Standard of Review*

The Director may waive a Trademark Rule “in an extraordinary situation, when justice requires and no other party is injured.” 37 C.F.R. §§2.146(a)(5), 2.148, 2.163(b); *see*

*Trademark Manual of Examining Procedure (TMEP*

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§1708. To waive a rule, the Director must determine that all three conditions are satisfied. *See* TMEP §1708.

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Trademark Rule 2.23(a) requires that, unless explicitly exempted, all trademark correspondence with the USPTO must be submitted through TEAS. 37 C.F.R. §2.23(a). However, Section 504 of the Americans with Disabilities Act (ADA) provides accommodation for citizens with disabilities. In light of the facts included in the petition, the USPTO waives the requirement for petitioner to submit filings through TEAS and accepts the petition filed via facsimile as properly and timely filed.

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Based on the unique facts of this case, the Director determines that petitioner has established an extraordinary situation to waive Rule 2.163(b). Specifically, petitioner's verified evidence that several documented attempts to obtain clarification from the USPTO regarding an exception or waiver to the domicile requirement, along with petitioner's difficulty using TEAS due to a disability and because he was not ID verified, in combination, establish an extraordinary situation. A review of the Trademark Register confirms no other party will be injured and justice requires a waiver of this rule. *See* TMEP §§1604.16, 1708.

Accordingly, the Director waives Rule 2.163(b) and permits petitioner to submit a late response to the October 28, 2022 Office action. *See* 37 C.F.R. §§2.146(a)(5), 2.148.

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as the permanent legal place of residence of a natural person or the principal place of business of a juristic entity. 37 C.F.R. §§2.2(o), 2.189.

In this case, the Director finds that a waiver of the requirement to provide petitioner's domicile address in Rule 2.189 is appropriate. The evidence of personal safety concerns submitted with the petition establish an extraordinary situation, in which the Director can conclude that no other party will be injured and justice requires a waiver of this rule. *See* TMEP §1708. Under the circumstances presented, petitioner has complied with the statutory requirement to specify his domicile by providing the state and country where he resides, and the Director will waive the requirement to provide petitioner's street address.

Accordingly, the Director will permit petitioner to continue using a post office box address as the mailing address of record and will accept the state and country information provided in the combined filing petitioner's domicile address. *See* 37 C.F.R. §§2.146(a)(5), 2.148.

## **DECISION**

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