

This Opinion is a
Precedent of the TTAB

Mailed: March 30, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Chestek PLLC

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Serial No. 88938938

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Pamela Chestek of Chestek PLLC
for Chestek PLLC

Charles L. Jenkins, Jr., Trademark Examining Attorney, Law Office 112,
Renee Servance, Managing Attorney.

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Before Thurmon, Deputy Chief Administrative Trademark Judge,
and Kuhlke and Lynch, Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background

Chestek PLLC (“Applicant”), a professional limited liability company organized under the laws of North Carolina, seeks registration on the Principal Register of the mark CHESTEK LEGAL in standard characters for “legal services” in International

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Class 45.¹ The application includes a claim of acquired distinctiveness as to the mark as a whole under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), and a disclaimer of LEGAL. The Examining Attorney refused registration because Applicant declined to provide a valid domicile address, which is an application requirement under Trademark Rule 2.189, 37 C.F.R. § 2.189 and Trademark Rule 2.32(a)(2), 37 C.F.R. § 2.32(a)(2).

In the application, signed by Applicant's owner, Pamela S. Chestek, Applicant provided a post office box number in Raleigh, North Carolina as its domicile address.² The Examining Attorney indicated that "[i]n most cases, a post office box is not acceptable. An address that is not a street address is not acceptable as a domicile address because it does not identify the location of applicant's headquarters where the entity's senior executives or officers ordinarily direct and control the entity's activities."³ The Examining Attorney therefore required Applicant to provide its domicile street address or "demonstrate that the listed address is, in fact, the applicant's domicile."⁴

¹ Application Serial No. 88938938 was filed on May 29, 2020, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on allegations of first use and first use in commerce on January 1, 2013.

² TSDR May 29, 2020 Application at 1. Citations to the examination record refer to the USPTO's online Trademark Status and Document Retrieval system (TSDR). Citations to the briefs are to the Board's online database, TTABVUE. Before the TTABVUE designation is the docket entry number; and after this designation are the page references, if applicable.

³ TSDR December 7, 2020 Office Action at 1.

⁴ *Id.*

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Applicant declined to do either, and instead maintained during prosecution, as it does on appeal, that the applicable rules requiring the domicile address and the accompanying guidance were unlawfully promulgated and should not be enforced.⁵ Although the United States Patent and Trademark Office (“USPTO”) offers procedures by which applicants and registrants may seek to avoid making the domicile address public,⁶ Applicant, a professional limited liability company, explicitly disavows any interest in the procedures, indicating that it does not wish to avail itself of them, and only wishes to challenge the enforcement of the rules.⁷

After the Examining Attorney made the refusal final, Applicant appealed. The appeal has been fully briefed.

Applicant asserts that “there are two errors in the Final Office Action”:⁸ (1) the rules requiring a street address were not validly promulgated; and (2) “unlawful nonfeasance” in connection with a third-party petition for rulemaking.

We address each in turn, and for the reasons set forth below, we affirm the refusal to register.

⁵ Although Applicant’s opening Brief cites Trademark Rule 2.63(b), 37 C.F.R. § 2.63(b), as “Not Validly Promulgated,” this longstanding rule merely provides that a requirement not complied with may result in the issuance of a final Office action refusing registration. We read Applicant’s complaints regarding the rulemaking process as relating not to this rule, but rather to Trademark Rules 2.189, 2.2(o) and 2.2(p), 37 C.F.R. §§ 2.189, 2.2(o) and 2.2(p), which specifically concern the domicile address. Other portions of Applicant’s Brief are consistent with this reading of its position.

⁶ See TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 601.01(d) (2021).

⁷ 4 TTABVUE 4 (Applicant’s Brief).

⁸ 4 TTABVUE 3 (Applicant’s Brief).

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II. Analysis

A. Applicable Rules

Section 1(a)(2) of the Trademark Act provides that “[t]he application shall include specification of the applicant’s domicile” 15 U.S.C. § 1051(a)(2). Trademark Rule 2.189 sets forth the requirement that “[a]n applicant or registrant must provide and keep current the address of its domicile, as defined in § 2.2(o).” 37 C.F.R. § 2.189. Trademark Rule 2.32(a)(2) lists an applicant’s domicile address among the requirements for a complete application. 37 C.F.R. § 2.32(a)(2). According to the Trademark Rules of Practice, “[t]he term domicile as used in this part means 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). The TMEP further states that “[a]n applicant generally must provide its domicile street address.... In most cases, a post-office box, a ‘care of’ (c/o) address, the address of a mail forwarding service, or other similar variation cannot be a domicile address.” TMEP § 803.05(a) (2021).

One reason for the domicile requirement is to distinguish between domestic and foreign filers, because an applicant “whose domicile is not located within the United States or its territories must be represented by an attorney, as defined in § 11.1 of this chapter, who is qualified to practice under § 11.14 of this chapter.” 37 C.F.R. § 2.11(a); *see also* 37 C.F.R. § 2.22(a)(20). Applicants domiciled outside the United States also may designate domestic representatives. *See* 15 U.S.C. § 1051(e) (“If the applicant is not domiciled in the United States the applicant may designate ... the name and address of a person resident in the United States on whom may be served

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notices or process in proceedings affecting the mark.”); 15 U.S.C. §§ 1058(f), 1059(c), & 1060(b) (comparable provisions for registration owners and assignees). The various reasons for the collection of domicile address information, the benefits to the public, and the measures in place to shield domicile address information from public view are addressed in more detail in the Office’s decision on the third-party petition for rulemaking referenced above.⁹ Applicant raises the petition in this case, and so both the petition and resulting decision are discussed below.

In this case, Applicant concedes that it has not complied with the requirement to provide the domicile address of its “principal place of business” as a juristic entity.¹⁰ *See* 37 C.F.R. §§ 2.2(o) & (p). Applicant’s appeal rests exclusively on its contention that the Board should reject enforcement of the applicable rules. We conclude that an appeal to this Board is not the proper forum; the proper course for such a challenge would have been a petition for rulemaking. *See* 5 USC § 553(e) (“Each agency shall give an interested person the right to petition for the issuance, amendment, or repeal of a rule.”). While Applicant cites the APA,¹¹ Applicant offers no authority for making an APA challenge in an administrative forum that is part of the same agency that adopted the rules and policy guidance.¹²

⁹ 6 TTABVUE 8-16 (decision on “petition for rulemaking” by the Software Freedom Conservancy, Inc., an exhibit to the Examining Attorney’s Brief).

¹⁰ 4 TTABVUE 3 (Applicant’s Brief).

¹¹ 4 TTABVUE 10-11 (Applicant’s Brief).

¹² While Applicant cites 44 U.S.C. §§ 3507(a) and 3512, the former involves requirements for an agency’s information collection and the latter involves the failure to display a valid Office of Management and Budget control number for an information collection. Neither statutory provision states or suggests that an administrative agency board such as this one may decline

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Both Applicant and the Examining Attorney addressed the “Petition for Rulemaking” by the Software Freedom Conservancy, Inc.¹³ and the resulting petition decision.¹⁴

The Software Freedom Conservancy’s petition sought a suspension of the USPTO’s implementation of Trademark Rules 2.189 and 2.2(o) and (p) and “a new notice and rulemaking process to add more appropriately constrained rules,”¹⁵ and raised many of the same arguments that Applicant makes in this appeal about the unenforceability of rules based on allegedly improper rulemaking procedures. The petition decision addressed the USPTO’s compliance with the APA, the Paperwork Reduction Act, the Regulatory Flexibility Act, and Executive Order 13771 (now revoked) in connection with the challenged rules. Because the petition decision represents the USPTO’s views on the arguments Applicant now makes about the Trademark Rules, we incorporate it by reference in this decision and attach it as an

to enforce the agency’s rules. Applicant’s reliance on *United States v. Arthrex*, 141 S.Ct. 1970, 2021 USPQ2d 662 (2021) is also inapposite. That case involved a challenge in an Article III court to the constitutionality of a statute, not the authority of an administrative panel to review agency regulations under the APA.

¹³ 4 TTABVUE 19-34 (Applicant’s Brief, Exhibit B). The petition was signed by Applicant’s owner, Pamela S. Chestek, as the petitioner’s attorney.

¹⁴ 6 TTABVUE 7-16. Applicant attached to its Brief the third-party petition. The Examining Attorney attached to his Brief the USPTO’s decision denying the petition. Although the record in an application should be complete prior to the filing of an ex parte appeal to the Board, Trademark Rule 2.142d, 37 C.F.R. § 2.142(d), evidence submitted after an appeal may be considered by the Board when there is no objection to the evidence and it is either discussed or otherwise affirmatively treated as being of record by the nonoffering party. TBMP § 1207.03.

¹⁵ 4 TTABVUE 34 (Applicant’s Brief, Exhibit B).

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appendix.¹⁶ For the reasons explained in the petition decision, the arguments set forth in the petition and Applicant's briefs in this case are not a basis to avoid the domicile address requirement.

We also find unpersuasive Applicant's privacy arguments. In the Commissioner for Trademarks' August 11, 2021 cover letter to the petition decision, he noted that the majority of the USPTO's TEAS forms, including the application and change of address/representation forms, feature a special field for entry of the domicile address. Use of the field ensures that the domicile address "will not be publicly viewable nor retrievable in bulk-data downloads."¹⁷ *See also* TMEP § 803.05(a) (noting that the domicile address information on the TEAS application form is "hidden from public view"). Nonetheless, Applicant, a business entity, asserts that "[i]f a person needs to keep their street address a secret for their personal protection, the only way to make sure it remains a secret is never to disclose it.... It is unacceptable to have to rely on a government agency for one's personal safety"¹⁸ However, Applicant did not assert any such need for secrecy and, as noted above, explicitly disavows any interest in availing itself of the USPTO's established procedure for requesting a waiver of the rule.¹⁹ *See* 37 C.F.R. §§ 2.146(a)(5) & 2.148; TMEP § 1708.

¹⁶ 6 TTABVUE 8-16.

¹⁷ 6 TTABVUE 7.

¹⁸ 7 TTABVUE 9 (Applicant's Reply Brief).

¹⁹ 4 TTABVUE 4 (Applicant's Brief).

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B. Unlawful Nonfeasance

Applicant asserts that the final refusal to register at issue in this appeal should be reversed because of so-called “nonfeasance” in connection with the third-party petition for rulemaking, based on “failing to decide” that petition.²⁰ Applicant does not claim to be in privity with the Software Freedom Conservancy, Inc. The third-party petition is dated September 18, 2019. The denial decision is dated March 11, 2020, prior to Applicant’s Brief. However, a cover letter from the USPTO’s Commissioner for Trademarks to Ms. Chestek dated August 11, 2021, after Applicant’s Brief, indicates that while the denial decision was signed on the earlier date, “the physical mailing of the response [to Ms. Chestek as counsel for the petitioner] slipped through the cracks as [the USPTO] quickly transitioned to an all virtual work environment [at the onset of the pandemic].”²¹

We reject Applicant’s contention that the timing and content of the USPTO’s decision on a third-party petition entitle Applicant to a reversal of the refusal to register in this case. We do not agree that the USPTO’s handling of the petition, either in procedure or substance, constitutes what Applicant has called “unlawful nonfeasance.”²² Nor does the USPTO’s handling of the petition form any other basis for reversal of the requirement in this case. Regardless, a proper challenge to the

²⁰ 4 TTABVUE 5 (Applicant’s Brief).

²¹ 6 TTABVUE 7 (August 11, 2021 letter from David S. Gooder to Pamela S. Chestek). Because the petition for rulemaking was not associated with a particular application or registration, the decision did not process and issue electronically.

²² 4 TTABVUE 5 (Applicant’s Brief).

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USPTO's handling of the petition must be brought by the party who could potentially claim the injury, i.e., the petitioner. Applicant fails to convince us that it would be proper to address its assertion of so-called "unlawful nonfeasance" by the Office in an unrelated petition matter involving a third-party not in privity with Applicant.²³

Decision: We affirm the refusal to register Applicant's mark on the ground that Applicant failed to provide the domicile address required by the Trademark Rules of Practice.

²³ Even when a petition is filed by an applicant, rather than a third party, the petition does not stay the period for replying to an Office action and does not act as a stay in any appeal. 37 C.F.R. § 2.146(g).