

**To:** De Niro, Robert ([pto@fkks.com](mailto:pto@fkks.com))  
**Subject:** TRADEMARK APPLICATION NO. 85713838 - ROBERT DE NIRO - 019364.0500  
**Sent:** 5/23/2020 12:38:37 PM  
**Sent As:** ECOMPET  
**Attachments:**

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

**U.S. Application**  
**Serial No.**  
85713838

**U.S. Registration**  
**No.** 4424146

**Mark:** ROBERT  
DE NIRO

**Correspondence**  
**Address:**  
Catherine  
M.C. Farrelly

FRANKFURT  
KURNIT KLEIN  
& SELZ PC  
28 Liberty  
Street  
NEW YORK  
NY 10005

**Owner:** De Niro,  
Robert

**Reference/Docket**  
**No.** 019364.0500

**Correspondence**  
**Email Address:**  
  
[pto@fkks.com](mailto:pto@fkks.com)

**PETITION TO DIRECTOR GRANTED**

**Issue date:** May 23, 2020

Robert De Niro (petitioner) has petitioned the Director of the United States Patent and Trademark Office (USPTO) requesting to waive the requirement for his domicile address regarding the above-identified registration. The Director has the authority to review petitioner's request. *See* 37 C.F.R. §§2.146(a)(5), 2.148. The petition is granted.

**FACTS**

On October 23, 2019, petitioner submitted a combined Trademark Act Section 8 declaration of use or excusable nonuse and Section 15 affidavit of incontestability (combined declaration). 15 U.S.C. §§1058, 1065. The assigned Post Registration specialist issued an Office action on November 27, 2019 requesting petitioner to submit his domicile address and noting that a care of (c/o) address would not satisfy this requirement.

On December 18, 2019, petitioner filed this petition requesting that the requirement to submit petitioner's personal street address be waived due

to “privacy and security concerns.” (Petition.) That same day, petitioner submitted a response to the Post Registration Office action noting that a petition to the Director was being separately filed. Petitioner provided the state and country of his domicile in the masked “domicile address” field of the Change Address or Representation (CAR) form, which will remain hidden from public view. Petitioner’s attorney of record then supplemented the petition on May 21, 2020 with a signed declaration under Trademark Rule 2.20 verifying that the domicile information submitted by petitioner is accurate.

## **DISCUSSION**

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. Trademark Rule 2.189 further requires that an applicant or registrant must provide and keep current the address of its domicile, 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.

The Director may waive Rule 2.189 only “in an extraordinary situation, when justice requires and no other party is injured.” 37 C.F.R. §§2.146(a)(5), 2.148; *see* TMEP §1708. To waive this rule, the Director must determine that all three conditions are satisfied. *See* TMEP §1708. The Director may not waive a statutory requirement. *Id.*

In this case, the Director finds that a waiver of Trademark Rule 2.189 is appropriate. The evidence of personal safety concerns submitted with the petition establish an extraordinary circumstance, in which the Director can conclude that no other party will be injured and justice requires a waiver of this rule. *See* TMEP §1708. Petitioner has complied with the statutory requirement to specify his domicile and citizenship, and will be permitted to use a c/o address for petitioner’s attorney rather than providing his personal street address.

Accordingly, the Director will permit petitioner to continue using a c/o address for petitioner’s attorney as the owner address of record . *See* 37 C.F.R. §§2.146(a)(5), 2.148.

## **DECISION**

The petition is granted. The registration file will be returned to the Post Registration Division to continue prosecution of the pending combined declaration.

/Sara Benjamin/  
Attorney Advisor  
Office of the Deputy Commissioner  
for Trademark Examination Policy  
sara.benjamin@uspto.gov  
571.272.8847