

Examination Guide 1-22
Clarification of Examination Evidentiary Standard
for Marks Refused as Generic
May 2022

This examination guide makes clear that for an examining attorney to establish a prima facie case that an applied-for mark is generic, for the purpose of refusing to register the mark on the Principal or Supplemental Register, there must be sufficient evidence to support a “reasonable predicate” (i.e., reasonable basis) for finding the mark generic under the applicable legal standard. The standard for an examining attorney to establish a prima facie case of genericness is the same as for other substantive refusals.

Prior USPTO examination guidance suggested a heightened, “clear evidence” standard for an examining attorney to establish a prima facie case of genericness. Any heightened standard would be inconsistent with both (1) the standard for third parties to challenge the registration of marks as generic and (2) the “reasonable predicate” meaning of “prima facie case” in the context of other refusals in examination.¹

This examination guide clarifies that an examining attorney does not bear a greater burden in supporting a position that an applied-for mark is generic beyond the evidentiary showing required by the relevant legal test.

This revision does not change the nature or types of evidence needed to demonstrate genericness. Examining attorneys still consider the term’s primary significance to consumers (i.e., that the relevant consumers would use or understand the applied-for matter as indicating a class of goods or services with which it is used).² Likewise, the sources of relevant evidence continue to include “dictionaries, usage by consumers and competitors, and any other source of evidence bearing on how consumers perceive a term’s meaning,” including relevant and probative consumer surveys.³

This guidance supersedes any previous USPTO guidance on this topic to the extent there are any conflicts. The Trademark Manual of Examining Procedure (TMEP) will be updated to reflect the “reasonable predicate” standard.

Background

Generic terms are ineligible for federal registration.⁴ In the context of inter partes proceedings at the Trademark Trial and Appeal Board, a party opposing or petitioning to cancel a registration on genericness grounds must prove its claim by a preponderance of the evidence.⁵ But to refuse applied-for marks as generic in examination, the USPTO previously used the term “clear evidence.”⁶ As a result, there was confusion as to whether the standard for a third party to remove a presumptively valid registered mark from the register was lower than the standard for the USPTO to prevent the mark from being registered in the first place.

Though Federal Circuit precedent adopted the “clear evidence” language used by the USPTO in its examination guidance, either by citing directly to the TMEP, or through indirect citation to one or more cases that relied upon the TMEP, there is no statutory basis for applying a heightened standard.⁷

In 1987, the Federal Circuit decided the first case to refer to “clear evidence” in the context of a genericness refusal, *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*⁸ The Court cited to § 1305.04 of the First Edition of the TMEP (Revision 6 (1983)) as requiring a showing based on “clear evidence of generic use.”⁹ The cited discussion in § 1305.04 related to certification marks indicating regional origin. This section stated in pertinent part: “In order to refuse registration on the ground that matter is generic, there must be a substantial showing by the Examining Attorney that the matter is in fact generic. This is particularly true for indications of regional origin. The showing must be based on clear evidence of generic use, not on fragmentary uses or possible infringing uses.”¹⁰ Read in context, the term “clear” was meant to convey the ordinary meaning of the term, not an evidentiary burden.

In subsequent cases involving genericness refusals, the Federal Circuit cited to *Merrill Lynch*, its later decisions citing that case, and/or the TMEP, which was revised after *Merrill Lynch*, for the “clear evidence” standard.¹¹ The Federal Circuit further interpreted “clear evidence” to have an evidentiary burden meaning of “clear and convincing evidence”¹² that was not intended by the TMEP and is inconsistent with the preponderance of the evidence burden the Federal Circuit requires to prove claims that a registered mark is generic in the inter partes cancellation context. Moreover, for other types of refusals, the Federal Circuit has consistently held that to make a prima facie case supporting a particular refusal, the examining attorney must set forth a “reasonable predicate”¹³ or basis for the finding or conclusion underpinning the refusal.¹⁴

To resolve the confusion, the USPTO will no longer use the terminology “clear evidence” in the TMEP to refer to the examining attorney’s burden to support genericness refusals.

¹ See, e.g., H. Rep. No. 116-645, at 15 (2020) (explaining that “[t]he meaning of ‘prima facie case’ in the context of the bill [the Trademark Modernization Act],” which created new ex parte proceedings to cancel registrations, “is intended to have the same ‘reasonable predicate’ meaning that that term has been given in the context of trademark examination”); see generally *In re Pacer Tech.*, 338 F.3d 1348, 1351, 67 USPQ2d 1629, 1632 (Fed. Cir. 2003) (“to meet its prima facie burden, the PTO must, at a minimum, set forth a ‘reasonable predicate’ for its position of no inherent distinctiveness”) (citation omitted); *In re Loew’s Theatres, Inc.*, 769 F.2d 764, 768, 226 USPQ 865, 868 (Fed. Cir. 1985).

² See TMEP § 1209.01(c).

³ *USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2307 n.6, 2020 USPQ2d 10729, at *7 n.6 (2020).

⁴ See 15 U.S.C. §§ 1052, 1064, 1091(a), and 1127; see also *Booking.com*, 140 S. Ct. at 2303, 2020 USPQ2d 10729, at *3-4 (“The name of the good itself (e.g., ‘wine’) is incapable of ‘distinguish[ing] [one producer’s goods] from the goods of others’ and is therefore ineligible for registration. . . . Indeed, generic terms are ordinarily ineligible for protection as trademarks at all.”) (citations omitted).

⁵ See, e.g., *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 965, 114 USPQ2d 1827, 1830 (Fed. Cir. 2015) (“In an opposition or cancellation proceeding, the opposer or petitioner bears the burden of proving genericness by a preponderance of the evidence.”), citing *Magic Wand, Inc. v. RDB, Inc.*, 940 F.2d 638, 641-42, 19 USPQ2d 1551, 1554 (Fed. Cir. 1991).

⁶ TMEP § 1209.01(c)(i).

⁷ Cf. 15 U.S.C. § 1064 (referencing “[t]he primary significance of the registered mark to the relevant public” as the test).

⁸ 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). In its 1999 decision in *In re Am. Fertility Society*, 188 F.3d 1341, 1346, 51 USPQ2d 1832, 1835 (Fed. Cir. 1999), the Court expressly acknowledged that the “clear evidence” burden stated in *Merrill Lynch* derived from its reading of § 1305.04 of the TMEP: “We quoted the Trademark Manual of Examining Procedure as requiring . . . ‘clear evidence of generic use.’”

⁹ 828 F.2d at 1571, 4 USPQ2d at 1143.

¹⁰ TMEP § 1305.04, (1st ed., rev. 6 1983).

¹¹ See *In re Steelbuilding.com*, 415 F.3d 1293, 1296, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (quoting *Am. Fertility*); *In re Hotels.com, L.P.*, 573 F.3d 1300, 1302, 91 USPQ2d 1532, 1533-34 (Fed. Cir. 2009) (quoting TMEP § 1209.01(c)(i) (4th ed. 2005)); *In re Nordic Naturals, Inc.*, 755 F.3d 1340, 1342-43, 111 USPQ2d 1495, 1497 (Fed. Cir. 2014) (quoting *Merrill Lynch* and TMEP); *In re Louisiana Fish Fry Products, Ltd.*, 797 F.3d 1332, 1335, 116 USPQ2d 1262, 1265 (Fed. Cir. 2015) (quoting *Merrill Lynch*); and *In re Cordua Restaurants, Inc.*, 823 F.3d 594, 600-601, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016) (citing, among other sources, TMEP § 1209.01(c)(i)).

¹² See *In re Hotels.com, L.P.*, 573 F.3d 1300, 1302, 91 USPQ2d 1532, 1533-34 (Fed. Cir. 2009).

¹³ For example, to establish a prima facie case that a design of an adhesive container cap is not inherently distinctive, the court held that the USPTO must “set forth a ‘reasonable predicate’ for its position” and found that evidence of “design patents showing other adhesive container cap designs are sufficient prima facie evidence from which one could conclude that [applicant’s] design is not unique or unusual in the relevant field and therefore not inherently distinctive.” *In re Pacer Tech.*, 338 F.3d 1348, 1350-52, 67 USPQ2d 1629, 1631 (Fed. Cir. 2003); (quoting *In re Loew’s Theatres, Inc.*, 769 F.2d 764, 768, 226 USPQ 865, 868 (Fed. Cir. 1985) (stating that in making its prima facie case that a mark is primarily geographically deceptively misdescriptive, the USPTO must establish a “reasonable predicate” for its conclusion that the public would be likely to make the goods/place association in question).

¹⁴ The Federal Circuit also has held that an examining attorney’s prima facie case for a refusal must be rebutted by “competent evidence,” which requires “proof by preponderant evidence.” See, e.g., *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1374, 102 USPQ2d 1372, 1376-77 (Fed. Cir. 2012).